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Precedent of the TTAB

Mailed: February 27, 2019

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**

*In re Naboso Technology, LLC*

Serial No. 87236262

S. Roxanne Edwards, Klemchuk LLP, for Naboso Technology, LLC.

Samuel R. Paquin, Trademark Examining Attorney, Law Office 101, Ronald R. Sussman, Managing Attorney.

**Before Mermelstein, Kuczma, and Heasley, Administrative Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Naboso Technology, LLC, filed an application<sup>1</sup> to register **NABOSO** (in standard characters) on the Principal Register for goods including:<sup>2</sup>

Orthotics for feet. International Class 10.

Flooring comprised of rubber adapted for physical fitness, performance, and rehabilitation activities. International Class 19.

Yoga mats. International Class 27.

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<sup>1</sup> Filed November 14, 2016, alleging a *bona fide* intent to use the mark in commerce. Trademark Act § 1(b); 15 U.S.C. § 1051(b).

<sup>2</sup> The application includes additional goods in International Classes 10 and 28 that are not at issue in this appeal.

Personal mats for use in connection with exercise and physical fitness. International Class 28.

Applicant appeals from the Examining Attorney's final partial refusal to register pursuant to Trademark Act § 2(d), 15 U.S.C. § 1152(d), on the ground that Applicant's mark — as used on the goods listed above — is likely to cause confusion in view of the marks and goods in the following four registrations:

Reg. No.	Reg. Date <sup>3</sup>	Mark	Goods	Disclaimer
2040104	Feb. 25, 1997	 BAREFOOT ARCH SUPPORTS	<ul style="list-style-type: none"><li>Orthotics for normalizing the position of bones, ligaments, and tendons for feet, legs, hips and back. International Class 10.</li></ul>	ARCH SUPPORTS
2326646	Mar. 7, 2000	BAREFOOT	<ul style="list-style-type: none"><li>Orthotics for normalizing the position of bones, ligaments and tendons for feet, legs, hips and back. International Class 10.</li></ul>	
2746817	Aug. 5, 2003	BAREFOOT	<ul style="list-style-type: none"><li>Rubber floor mats. International Class 27.</li></ul>	
3038723	Jan. 10, 2006	 barefoot YOGA CO.	<ul style="list-style-type: none"><li>Silk eye pillows containing aromatic and non-aromatic substances for relief from headaches, insomnia and sinus discomfort. International Class 5.</li><li>Yoga mat bags, namely, sports bags for carrying yoga mats or exercise mats. International Class 18.</li><li>Yoga accessories, yoga products and yoga props, namely, personal yoga exercise mats, personal yoga exercise rugs, personal yoga exercise blankets, personal yoga exercise straps, and personal yoga exercise blocks. International Class 28.</li></ul>	YOGA CO.

We reverse the refusal to register.

## I. Discussion

### A. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the pro-

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<sup>3</sup> In each case affidavits of continued use and renewals pursuant to Trademark Act §§ 8–9 have been accepted and granted.

bative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

## **B. Analysis**

### **1. Similarity or dissimilarity and nature of the goods, trade channels, and relevant purchasers**

In comparing the goods in question, “[t]he issue to be determined . . . is not whether the goods . . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). It is not necessary that the parties’ goods be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the goods are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that the goods come from or are associated with the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

The Examining Attorney maintains that Applicant's goods at issue "include, encompass, []or overlap" with goods in the cited registrations. *Ex. Att. Br.* 10 TTABVUE 14. As the Examining Attorney notes, "[A]pplicant does not dispute that the goods are related." *Id.* We consider the goods as to which registration has been refused.

**a. "Orthotics for feet"**

Applicant's goods in International Class 10 include "orthotics for feet." The goods in the '646 Registration<sup>4</sup> include "orthotics for normalizing the position of bones, ligaments and tendons for feet, legs, hips and back." Because the goods in the cited registration include "orthotics . . . for feet," they encompass, and are to that extent identical to, Applicant's "orthotics for feet." Although the Registrant's orthotics are limited in purpose ("for normalizing the position of bones, ligaments and tendons"), Applicant's orthotics are not so limited, and must be considered to include orthotics for feet suitable for all purposes — including those specified in the cited registration. Unless expressly limited, goods identified in an application or registration must be considered to include all goods of the type described. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)).

The fact that these goods are identical in part means that we must also assume that the relevant purchasers and channels of trade are identical to the same extent.

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<sup>4</sup> The '104 and '646 registrations are commonly owned and identify the same goods. The mark in the '104 registration consists of the words **BAREFOOT ARCH SUPPORTS** and the design of a foot, while the '646 registration is for the standard-character mark **BAREFOOT**. As between these two registrations, we concentrate on the latter because the mark is closest to Applicant's.

*In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”); see *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Accordingly, because Applicant’s orthotics are identical to goods identified in the ’646 registration, we also find their channels of trade and usual purchasers to be the same.

**b. “Yoga mats” and “Personal mats. . .”**

Applicant’s goods in International Class 27 are “yoga mats,”<sup>5</sup> and its goods in Class 28 include “personal mats for use in connection with exercise and physical fitness.” The goods identified in the ’723 registration include “yoga exercise mats” in International Class 28. We find the Registrant’s “yoga exercise mats” to be identical to Applicant’s “yoga mats.” Likewise, because Applicant’s “personal mats for use in connection with exercise and physical fitness” (in Class 28) could be used for “yoga exercise,”

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<sup>5</sup> As originally filed, the application included “yoga mats” in Class 28. While correct at the time of filing, effective January 1, 2017, “yoga mats” were re-classified in Class 27, in compliance with a revision in the Nice Classification. In his first office action, the Examining Attorney required Applicant to move “yoga mats” to International Class 27, *Ofc. Action* (Feb. 21, 2017), and Applicant complied, *Resp. to Ofc. Action* (Mar. 27, 2017). Although Applicant should have been given the option to either retain the classification as filed or conform to the new classification, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1401.09 (Oct. 2017), the requirement is not before us on appeal, and the classification of goods or services is irrelevant to the determination of likelihood of confusion. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993).

they encompass the Registrant’s “yoga exercise mats,” and are to that extent identical.

And again, because these goods are identical, we further find the respective channels of trade and usual purchasers to be the same.

**c. “Flooring comprised of rubber . . .”**

Applicant’s International Class 19 goods are identified as “flooring comprised of rubber adapted for physical fitness, performance, and rehabilitation activities.” The goods in the ’817 registration are identified as “rubber floor mats.” The cited Registrant’s floor mats are not limited as to their purpose or use, so we must consider them to include rubber floor mats “adapted for physical fitness, performance, and rehabilitation activities.” *See Elbaum*, 211 USPQ at 640.

We construe *flooring*, as identified by Applicant, to refer to a floor covering which would be permanently installed in a room for use in “physical fitness, performance, and rehabilitation activities.”<sup>6</sup> While the term *mat* (as used in the ’817 registration’s “rubber floor mats”) does not have the connotation of a permanent floor covering, a mat can clearly be used as a temporary floor covering for the same or similar purposes as Applicant’s flooring, *i.e.*, as a “thick pad or cushion”<sup>7</sup> used for “physical fitness,

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<sup>6</sup> We take judicial notice of the definition of *flooring* as “1: FLOOR, BASE” or “2: material for floors.” MERRIAM-WEBSTER DICTIONARY *flooring* <http://www.merriam-webster.com> (visited Feb. 26, 2019). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>7</sup> We take judicial notice of the definition of *mat* as “1 . . . c: a large thick pad or cushion used as a surface for wrestling, tumbling, and gymnastics.” MERRIAM-WEBSTER DICTIONARY *mat* <http://www.merriam-webster.com> (visited Feb. 26, 2019).

performance, and rehabilitation activities.” Although Applicant’s rubber flooring is not identical to the Registrant’s rubber floor mats, it is similar in its nature, purpose, and use, and we accordingly find the two to be similar.

Because these goods are not identical, we do not apply any presumption as to their channels of trade or usual purchasers, and neither Applicant nor the Examining Attorney introduced any evidence relevant to this question. We accordingly consider the factors addressing the channels of trade and buyers to whom sales are made to be neutral with respect to Applicant’s flooring.

\* \* \*

We conclude that Applicant’s goods subject to the refusal are identical or similar to the goods identified in the cited registrations, and that (with the exception of Applicant’s flooring) the channels of trade and relevant purchasers are the same. These *du Pont* factors favor a finding that confusion is likely.

**2. Strength of the Prior Marks; Number and Nature of Similar Marks in Use on Similar Goods.**

Applicant argues that marks comprising the term **BAREFOOT** “are weak and entitled to a narrow scope of protection.” *App. Br.*, 8 TTABVUE 21. As evidence of this weakness, Applicant points to the co-existence of the cited registrations, as well as third-party registrations, and evidence of third-party use. *Id.* at 21–22. “A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).” *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (citing J. Thomas McCarthy, **MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION** § 11.83 (4th ed. 2008)).

**a. Market or commercial strength**

Under the sixth *du Pont* factor, we consider “[t]he number and nature of similar marks in use on similar goods.” *Du Pont*, 177 USPQ at 567. As Applicant notes, “[i]f the evidence establishes that the consuming public is exposed to third-party use of similar marks on or in connection with similar goods . . . , this evidence ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” *App. Br.*, 8 TTABVUE 21 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)). Because the inference Applicant seeks to establish is that the public is accustomed to seeing similar marks used on similar goods, we look to evidence that the public is actually exposed to the asserted third-party marks. In the context of determining market or commercial strength, “[t]he probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 73 USPQ2d at 1693.

With its request for remand and reconsideration, Applicant listed eleven registrations comprising the terms **BAREFOOT**, **BARE FOOT**, or **BARE FEET** for a variety of goods and services. 4 TTABVUE 7–9. Attached to the filing as exhibits were registration certificates for the first six listed registrations. 4 TTABVUE 12, 25, 30, 32, 34, 43. Web pages were submitted showing the actual use of four of the marks covered in these registrations.

We first note that the submitted registration certificates are not proper evidence of the registrations. To make a third party registration of record, a copy of the registration showing the current status of and title to the registration must be submitted.

(June 2018). The registration certificates filed by Applicant are inadequate because they reflect the status of and title to the registrations on the day the registrations issued, not contemporaneous with when they were submitted in evidence.<sup>8</sup> But in responding to Applicant’s request for reconsideration, the Examining Attorney did not object to any of Applicant’s evidence or advise Applicant that the registration certificates were inadequate to make the registrations of record. Instead, the Examining Attorney considered the registrations on the merits. *See Ofc. Action* (Dec. 19, 2017) (continuing and maintaining final refusal). Further, although registration certificates were filed for the first six listed registrations, no evidence of the remaining five listed registrations was submitted. But again, the Examining Attorney did not object to Applicant’s reliance on its list of registrations, or advise Applicant that the listed registrations were not properly of record. *See* TBMP § 1208.02. Accordingly, we consider the record on appeal to include (1) the first six registrations; and (2) the list of the remaining registrations “for whatever limited probative value such evidence may have.” *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).

While we will partially consider Applicant’s third-party registrations, we note in agreement Applicant’s own observation that the question is whether “the consuming public is exposed to third-party use of similar marks on or in connection with similar

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<sup>8</sup> For future reference, a copy of the complete Trademark Status and Document Retrieval (TSDR) Status page for the registration, made reasonably contemporaneous with its submission, is competent evidence of a registration and its title and status. The registration certificate is unnecessary.

goods.” *App. Br.* 8 TTABVUE 21 (quoting *Palm Bay*, 73 USPQ2d at 1693). Although third-party registrations are relevant, the registrations by themselves “have little evidentiary value” on the question of commercial weakness because “[t]he purchasing public is not aware of registrations reposing in the Patent Office.” *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *see also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269–70 (CCPA 1973) (“The existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them. . . .”). “The probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 73 USPQ2d at 1693.

Applicant submitted evidence of the use of four of the third-party registered marks:

- **BARE FEET WANTED** — Reg. No. 4884085 for “electric floor heating systems, namely, cables and mats for floor heating systems sold as a system.” 4 TTABVUE 12. Evidence shows use of the mark in the advertisement of heated flooring systems.
- **BAREFOOT SCIENCE** — Reg. No. 3631418 for “non-orthotic orthopaedic insoles having a proprioceptive neuromuscular stimulative effect.” 4 TTABVUE 25. Evidence shows use of the mark on customizable insoles used to alleviate various health conditions.
- **VIVOBAREFOOT** — Reg. No. 4303162 for handbags, purses, all-purpose carrying bags, wallets, etc. in Class 18; footwear, clothing, headwear, etc. in Class 25; providing instruction and training in walking, sporting activities, exercise and fitness, etc. in Class 41. 4 TTABVUE 34. Evidence shows use of the mark on footwear.
- **BARE FOOT** — Reg. No. 1983825 (**FOOT** disclaimed) for “foot care products, namely foot lotions, foot scrubs and foot cleansing and softening gels.” Evidence shows use of the mark on foot scrub, overnight foot treatment, and foot butter. 4 TTABVUE 43.

The goods on which the first two third-party registered marks are used — “electric floor heating systems,” and “non-orthotic orthopaedic insoles” — are related, albeit not closely, to the “rubber floor mats” in the cited ’817 Registration and “orthotics” in the cited ’104 and ’646 Registrations. On the other hand, while the “all-purpose carrying bags” identified in the ’162 third-party Registration are similar to the “yoga mat bags” in the cited ’723 Registration, Applicant’s evidence indicates *use* of the **VI-VOBAREFOOT** mark only on footwear. 4 TTABVUE 36–41. And we see no relevance at all to the registration and use of **BARE FOOT** for “foot care products, namely foot lotions, foot scrubs and foot cleansing and softening gels.”

In sum, none of the cited uses covers goods substantially similar to those of the cited Registrants. As the Federal Circuit recently emphasized, under the sixth *du Pont* factor, “the controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services. . . . ‘It is less relevant that [the mark] is used on unrelated goods or services. . . .’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).<sup>9</sup> Moreover, the evidence does not show use by a substantial number of third parties or that the use by the identified third parties is so substantial as to have been likely to affect consumers’ perception of the cited Registrants’ marks.

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<sup>9</sup> Although we have considered them, we give Applicant’s other listed third-party registrations — those for which Applicant did not provide any evidence of use — little weight in considering the commercial strength of the cited marks, as there is no indication that the relevant public is aware of the registered marks or that they are in use so as to affect the public’s perception. *Smith Bros.*, 177 USPQ 462–63.

**b. Inherent strength**

We next consider the inherent conceptual strength, or distinctiveness of the marks in the cited registrations. For this purpose, we consider evidence probative of any meaning the cited marks may have that is suggestive or descriptive of the goods or services for which they are registered.

We take judicial notice of the fact that the term “barefoot,” which is common to all of the cited marks, means *with the feet bare*. MERRIAM-WEBSTER DICTIONARY *barefoot* <http://www.merriam-webster.com> (visited Feb. 26, 2019). “Barefoot” is suggestive of the goods in the cited registrations because such goods may be used on or with bare feet. The orthotics identified in the ’646 Registration and the floor mats and yoga exercise mats identified in the ’817 and ’723 Registrations can be used on or with bare feet, and the term **BAREFOOT** as used in all three registrations is suggestive of them.

Although they have little probative value when considering the market or commercial strength of a mark, “third-party registrations are relevant evidence of the inherent . . . strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745 (TTAB 2016). As discussed, Applicant submitted (or listed) eleven third-party registrations for marks including **BAREFOOT** or **BARE FOOT** registered for goods or services relating to feet. 4 TTABVUE 7–9. The most probative of these is Registration No. 4954514, **MASAI BAREFOOT TECHNOLOGY (BAREFOOT TECHNOLOGY** disclaimed) for “orthopedic footwear; orthopedic soles; orthopedic shoes.” The goods in this registration appear related to the “orthotics”

identified in the cited '646 Registration, and the mark was registered with a disclaimer suggesting recognition that **BAREFOOT** is descriptive of such goods. Although the goods and services in the remaining third-party registrations do not appear as closely related to those in the cited registrations, they are sufficient to show that **BAREFOOT** is generally suggestive of foot-related goods and services.

In addition to the word **BAREFOOT**, the mark in the '723 Registration includes the words **YOGA CO.**, which is disclaimed, and appears to be descriptive of the Registrant's identified yoga equipment. While descriptive, generic, or otherwise disclaimed matter is not removed from the mark, and we must consider the marks in their entireties, the "descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)).

We conclude that **BAREFOOT**, as used in the cited registrations is somewhat suggestive of the identified goods.

**c. Coexistence of cited marks**

Finally, Applicant cites the coexistence on the register of the four cited registrations as evidence that **BAREFOOT** is weak. *App. Br.*, 8 TTABVUE 21. To the extent that Applicant is relying on the cited registrations as evidence that the decisions of prior Examining Attorneys to allow registration of the cited marks is evidence that confusion is not likely between them and Applicant's mark, we disagree.

Although it is somewhat unusual to see four registrations (owned by three entities) cited as a bar to registration, it must be noted that the subject application covers a number of goods in different classes. As for the cited registrations, except for the commonly owned '104 and '646 Registrations, it is not at all obvious that any of the cited registrations are in conflict with each other. More importantly, the question before us is the registrability of Applicant's mark in view of the cited registrations. We are not bound by the decisions of the Examining Attorneys who deemed the cited marks registrable. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). And while we do not suggest that any mistake was made in registering the cited marks, "the existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark." *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (citing *In re Helene Curtis Indus., Inc.*, 305 F.2d 492, 134 USPQ 501 (CCPA 1962)).

### **3. Similarity or dissimilarity of the marks.**

In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation, and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation and internal quotation marks omitted).

**a. Pronunciation**

While “there is no single ‘correct’ pronunciation of a trademark that is not a common English word,” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1401–02 (TTAB 2010), we can imagine no reasonable way to pronounce **NABOSO** that would bear any similarity at all to the likely English pronunciation of the registered marks.

**b. Appearance**

Applicant seeks registration of **NABOSO** in standard characters. The mark in the cited ’723 registration is registered in “special form,” *see* Trademark Rule 2.52(b), and includes the stylized words **BAREFOOT YOGA CO.** and a foot design. The marks in the ’646 and ’817 registrations consist solely of the word **BAREFOOT**, in standard characters.

A standard-character mark is one that is applied for or registered “without claim to any particular font style, size, or color.” Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). A registrant is not limited to “‘reasonable manners’ of depicting its standard-character mark.” *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258–59 (Fed. Cir. 2011). We thus consider that Applicant’s mark could be used in any stylization, including the same stylization as that used by the cited Registrants. Nonetheless, even if identical in font style, size, or color, the appearance of Applicant’s mark would be considerably more dissimilar than similar to those in the cited registrations because of the entirely different words used in them, and the design in the ’723 Registration.

The mark in the '723 Registration includes the words **BAREFOOT YOGA CO.** and the design of a stylized foot. **YOGA CO.** is disclaimed, and appears to be descriptive of the Registrant's identified yoga equipment. While descriptive, generic, or otherwise disclaimed matter is not removed from the mark, and we must consider the marks in their entireties, the "descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion." *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 (quoting *In re Nat'l Data Corp.*, 224 USPQ at 752).

The foot design in the '723 Registration is comparatively large, visually dominating and surrounding the wording **BAREFOOT YOGA CO.** Although it is often said that "[i]n the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed," *Viterra*, 101 USPQ2d at 1908 (internal quotation marks and citations omitted), there is no doubt that the design element of a word-and-design mark may sometimes have important, or even dominant significance. See *Kangol Ltd. v. Kangaroos U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1945–46 (Fed. Cir. 1992). In the '723 Registration, the wording comprises the suggestive term **BAREFOOT** and the descriptive **YOGA CO.**, both of which are dominated by the relatively large and distinctive design of a stylized foot. We find that the design in the '723 Registration assumes a highly significant, possibly dominant, role in the perception of the mark as a whole. *Nat'l Data Corp.*, 224 USPQ at 751 ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark,

provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). The design of the ’723 Registration — and to a much lesser extent, the descriptive wording **YOGA CO.** — further distinguish it from Applicant’s mark in appearance.

**c. Meaning**

The gravamen of the Examining Attorney’s refusal to register is that Applicant’s mark, **NABOSO**, means *barefoot* in Czech, and under the “doctrine of foreign equivalents,” **NABOSO** should be considered identical in meaning to **BAREFOOT** in the cited registrations. Applicant does not dispute the Examining Attorney’s translation, but rather disputes the application of the doctrine of foreign equivalents to the Czech language:

The doctrine of foreign equivalents applies to words or terms from *common*, modern languages, which encompasses all but dead, obscure, or unusual languages. However, the doctrine “is not an absolute rule and should be viewed merely as a guideline” and, therefore, does not apply to every foreign word that appears in a trademark or service mark. Even if Czech is considered a modern language,<sup>[10]</sup> the doctrine only applies to *common* modern languages. Since Czech is not spoken by an appreciable number of the U.S. population, it should not be characterized as a “common” language for purposes of the doctrine of foreign equivalents.

*App. Br.*, 8 TTABVUE 8–9 (citations omitted).

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<sup>10</sup> Czech is undoubtedly a “modern” language. The evidence of record indicates that Czech is *currently* spoken by “about 10 million” people in the Czech Republic and about 200,000 people in other countries. *Ofc. Action* (Feb. 21, 2017) (Penn Language Center, <https://plc.sas.upenn.edu/czech> (Feb. 21, 2017)); *Resp. to Ofc. Action* (Mar. 27, 2017), Exh. A (2009–2013 U.S. Census data (Czech spoken in U.S. households)). Czech is clearly not a “dead” language such as Old English. *See In re Winegard Co.*, 162 USPQ 261, 263 (TTAB 1969).

We need not reach Applicant's arguments. Even where the doctrine of foreign equivalents applies, it establishes only the similarity of the terms in meaning or connotation, and "such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source." *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983). While it is true that a likelihood of confusion may be found where the marks are similar in meaning alone, such similarity is not *necessarily* sufficient. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) ("Assuming arguendo that the marks **RITE-FIT** and **SURE-FIT** are similar in meaning, we are of the opinion that they are so distinct in sound and appearance as to overcome such similarity in meaning." (internal quotation marks omitted)). Any conclusion on the likelihood of confusion must be predicated on consideration of the marks in their entireties, and in light of the evidence bearing on the other *du Pont* factors. Because it would not change the result, we will assume, without finding, that the doctrine of foreign equivalents applies to the Czech language, and that Applicant's mark, **NABOSO**, is therefore identical in meaning to the word **BAREFOOT** in the cited marks.

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The marks at issue are entirely different in pronunciation and (except for stylization) appearance. Although we have assumed that the marks are identical or similar in meaning, we conclude that, when considered in their entireties, Applicant's mark is more dissimilar than similar to the marks in the cited registrations.

**C. Balancing the factors.**

As we have found, Applicant's goods are identical or related in part to those in the cited registrations and (except for Applicant's flooring) share the same customers and channels of trade. But we have also found **BAREFOOT** to be suggestive, and therefore inherently weak. Such weakness does not eliminate the possibility of confusion, but it is a factor which must be considered. We have also found Applicant's mark dissimilar to those in the cited registrations in their pronunciation and appearance. Even assuming that prospective purchasers would consider Applicant's mark to be identical in meaning to the word **BAREFOOT** in the cited registrations, such similarity is not, on this record,<sup>11</sup> sufficient to support a finding that confusion is likely.

**II. Conclusion**

Having carefully considered all of the evidence and argument of record, we find that the record does not support the refusal to register under Trademark Act Section 2(d).

**Decision:** The refusal to register is reversed.

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<sup>11</sup> We note that our decision is without prejudice to any *inter partes* proceeding that might be filed by an aggrieved party. It is possible that we would reach a different result on a more complete record such as may be adduced in an *inter partes* proceeding.