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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ernesto G. Castro

Serial No. 75782548

Martin L. Stoneman of Stoneman Law Offices, Ltd. for applicant.

Marlene Bell, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Ernesto G. Castro to register the mark ARIZONA AFO ("AFO" disclaimed) for "orthotic footwear."[1] Applicant claims that the mark has acquired distinctiveness as provided under Section 2(f) of the Trademark Act.

The trademark examining attorney refused registration

[1] Application Serial No. 75782548, filed on August 18, 1999, alleging first use and first use in commerce on June 11, 1999. Applicant states that "AFO" means "ankle and foot orthosis."

under Section 2(e)(2) of the Trademark Act on the ground that the proposed mark is primarily geographically descriptive, and that the Section 2(f) evidence of acquired distinctiveness is insufficient.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.[2] An oral hearing was not requested.

A brief review of the pertinent prosecution history sheds light on the specific issue on appeal. In the first Office action, the examining attorney refused registration on the basis of geographical descriptiveness under Section 2(e)(2). In response to the refusal, while indicating that his goods are made in Arizona, applicant also claimed acquired distinctiveness. In a second response, applicant asserted that the proposed mark was not geographically descriptive because the mark "simply refers to the place of origin where Applicant's goods are manufactured." And, according to applicant, "[t]he real issue is truly one of acquired distinctiveness." (response, October 3, 2001). The examining attorney's final refusal is based on a refusal under Section 2(e)(2) and the insufficiency of the Section 2(f) evidence in support of the claim of acquired

[2] Applicant's request that the examining attorney's appeal brief be stricken as nonresponsive is denied.

distinctiveness. In a request for reconsideration, applicant maintained that "the mark is not primarily geographically descriptive, and further, that the mark has acquired distinctiveness in the marketplace." (May 5, 2003). Applicant's appeal brief focuses entirely on the issue of acquired distinctiveness; not a single mention is made of the issue of geographical descriptiveness. In his reply brief, applicant states that "[s]ince June 8, 2000, when Applicant stated that the goods are made in Arizona, Applicant has licensed a company in Pittsburgh, Pennsylvania to make Applicant's goods under the trademark." Applicant states that "ARIZONA is no longer merely [sic] geographically descriptive of Applicant's goods." (reply brief, p. 5).

For procedural purposes, a claim of acquired distinctiveness under Section 2(f) may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. Once an applicant has claimed that matter has acquired distinctiveness under Section 2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. TMEP §1212.02(b) (3rd ed. 2002). Although

applicant, during some of the prosecution of the application, continued to claim that his mark was not primarily geographically descriptive, applicant did not indicate at any time that he was claiming distinctiveness in the alternative. Offering a claim of acquired distinctiveness in the alternative is not an admission that the proposed mark is not inherently distinctive. See TMEP §1212.02(c) (3rd ed. 2002), and TBMP §1215 (2d ed. rev'd March 2004).

We are construing applicant's Section 2(f) claim as a concession that the matter sought to be registered is not inherently distinctive. We view applicant's statements as essentially saying the following: the mark is not primarily geographically descriptive because it has acquired distinctiveness (and not because it is inherently distinctive). Thus, according to applicant, his mark is registrable on the Principal Register under the provisions of Section 2(f).[3] Accordingly, we will directly turn our

[3] We hasten to add that, in any event, the examining attorney has established that the mark ARIZONA AFO is primarily geographically descriptive under Section 2(e)(2). The term "Arizona" is well known as the name of a western state. Further, the goods, at least at the time of the filing of the application, were manufactured in Arizona and applicant resides in Arizona. Accordingly, a goods/place association is presumed. In re JT Tobacconists, 59 USPQ2d 1080 (TTAB 2001). The addition of the generic (and disclaimed) abbreviation "AFO" does not diminish the primary geographic descriptiveness of the mark as a whole. See In re Wada, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

focus, as has applicant, on the sufficiency of the evidence of acquired distinctiveness.

In determining whether a designation has acquired distinctiveness, we must look at the nature of the mark sought to be registered, and the specific evidentiary record presented. This is clearly a subjective factual determination and the question and character of the evidence necessary to satisfactorily prove acquired distinctiveness varies from case to case.

In support of his claim of acquired distinctiveness, applicant furnished two affidavits signed by applicant, Ernesto G. Castro, as president of Custom Footwear, Inc. (which is owned jointly by Mr. Castro and his wife).[4] Mr.

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[4] During the prosecution of the application, the examining attorney inquired as to the relationship between Mr. Castro and Custom Footwear, Inc. TMEP §§1201.03 and 1201.07 (3rd ed. 2002). Applicant provided a detailed response which, in applicant's words, "addresses the Examiner's concerns regarding ownership by properly addressing the issue involving 'unity of control', and further concludes that both parties, i.e., Ernesto G. Castro and Custom Footwear, Inc., form a single source." (Response, October 3, 2001). The examining attorney was satisfied, as are we, with applicant's explanation regarding the relationship. The response comprises Mr. Castro's affidavit wherein he sets forth the following pertinent facts:

> That I am a joint owner of Custom Footwear, Inc., with my wife owning 25% of the company, and I owning 75% of the company; and therefore, the relationship between Applicant, Ernesto G. Castro, and Registrant, Custom Footwear, Inc., though separate legal entities, constitute a
> (footnote continued)

Castro, in stating that the mark ARIZONA AFO has become distinctive of his custom orthotic footwear through substantially exclusive and continuous use of the mark in commerce for over three years, makes the following averments, in pertinent part:

> Use of the mark "Arizona AFO" by Applicant has been continuous since June 11, 1999.
>
> The applicant has sold over 15,000 units of the custom ankle brace in the United States since June 11, 1999, under the mark "Arizona AFO."
>
> The Applicant has spent over $100,000 in advertising and promoting its custom ankle brace under the mark "Arizona AFO", from June 11, 1999, to present.
>
> "Arizona AFO", such mark for custom ankle brace sales[,] have [sic] been heavily advertised in the United States, including as follows: O and P News, BioMechanics Magazine, Podiatry Management, Podiatry Today, Current Pedorthics, and direct mailing and brochures and catalogs.
>
> The Applicant has made extensive efforts to educate customers that the Applicant's mark, "Arizona AFO" custom ankle brace sales originate only with the Applicant and the Applicant's company, Custom Footwear, Inc.

> single source, and have unity of control over the use of its trademarks.
>
> That Applicant controls the nature and quality of the goods with which the mark is used, and has adopted and is using the mark, "ARIZONA AFO", through the related company, Custom Footwear, Inc.

The record also includes six affidavits of customers (out of a customer base which applicant estimates at 3,000) of applicant's orthotic footwear who assert that they are familiar with applicant's marketing. The affiants further assert as follows (identical wording in all six affidavits):

> Among the products that I have contact with is the "Arizona AFO" brand of custom ankle footwear/braces.
>
> The mark "Arizona AFO" is used by those in the trade to identify Custom Footwear, Inc.'s products; and it has always been our policy to use "Arizona AFO" to indicate source in Custom Footwear, Inc.
>
> Additionally, in operating our business, I come into contact with retailers of orthotic footwear, both as competitors and in such organizations as the American Association of Orthotics and Prosthetics, the Board for Orthotist/Prosthetist Certification, and the Board for Certification in Pedorthics, among others; and it is common practice among such retailers and professionals to use "Arizona AFO" to identify the source of Custom Footwear, Inc.'s custom ankle footwear/brace.
>
> The mark "Arizona AFO" means, in the trade, quality custom orthotic braces made by Custom Footwear, Inc. (not a geographical reference to a location of an AFO or business).

In our view, applicant has submitted sufficient evidence to make out a prima facie case for acquired distinctiveness pursuant to Section 2(f) of the Act and to warrant publication of the designation for purposes of opposition.[5] As indicated above, the amount of evidence necessary to establish acquired distinctiveness varies; the greater the degree of descriptiveness of a term, the heavier the burden to prove it has attained distinctiveness. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990); and Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. TMEP §1212.06 (3rd ed. 2002).

In the present case, we view the prima facie amount of evidence necessary to show acquired distinctiveness to be relatively small. Although applicant's claim of more than three years of use standing alone would not be sufficient,

[5] Custom Footwear, Inc.'s ownership of a registration of ARIZONA BRACE on the Supplemental Register for the identical products as those herein is of no aid in establishing acquired distinctiveness. In re Canron, Inc., 219 USPQ 820 (TTAB 1983).

all of the evidence submitted by applicant, taken as a whole, establishes a prima facie showing of acquired distinctiveness in the marketplace. TMEP §§1210.06(b) and 1212.05(a) (3rd ed. 2002).

In weighing the sufficiency of the evidence in this case, we have considered, of course, the nature of the mark in relation to the goods. Here, the goods are orthotic footwear, and there is no evidence of record showing that the state of Arizona is known for such goods. Nor is there any evidence that any other entity has a compelling need to so label their competing goods.

Mr. Castro's affidavits establish that his use of ARIZONA AFO on orthotic footwear has been substantially exclusive and continuous for over three years. In connection with his claim of substantially exclusive use, we note the absence of evidence of any uses of ARIZONA marks by competitors or by the public. It would appear that competitors have recognized or acquiesced in applicant's claim of trademark rights. In re Synergistics Research Corp., 218 USPQ 1675 (TTAB 1983) [no evidence of use of the term by competitors or the public]. In addition, as shown by the evidence accompanying the June 12, 2000 response, applicant's advertising and web site use ARIZONA AFO in a prominent manner.

The record further shows that applicant has sold more than 15,000 units of his product bearing the mark, and that over $100,000 has been spent on advertisements. Although the examining attorney states that these figures demonstrate only applicant's efforts to achieve distinctiveness, rather than the success of such efforts, we view this evidence to be somewhat probative, and when viewed together with the affidavits of six customers to be sufficient to establish a showing of acquired distinctiveness. Unlike the examining attorney, we are not overly concerned with the fact that the affidavits are identical in form. In re Flex-O-Glass, Inc., 194 USPQ 203, 206 (TTAB 1977).

We also are not troubled by the fact that applicant furnished only six affidavits. We take judicial notice of the definitions of "orthotics" as "a branch of medicine dealing with the making and fitting of orthotic devices" and "orthotic" as "a device or support, esp. for the foot, used to relieve or correct an orthopedic problem." The Random House Dictionary of the English Language (2d ed. Unabridged 1987). By definition, it is unlikely that applicant's "orthotic footwear" would be sold at retail stores. Rather, these definitions suggest that applicant's product would be sold to medical professionals who then fit

their patients for the appropriate orthotics. In point of fact, the evidence of record shows that applicant's orthotics are custom-made and are sold to foot-care specialists. In this connection, applicant asserts that his customer base is relatively small, estimating it at around 3,000. We find, especially in view of the nature of the mark and the goods sold thereunder, that the number of affidavits is sufficient. The affidavits furnish direct evidence of source recognition by at least a segment of the purchasers of these goods.

Decision: The refusal to register is reversed. [6]

[6] The disclaimer of "AFO" will remain in the application. See In re Creative Goldsmiths of Washington, Inc., 229 USPQ 766, 768 (TTAB 1986) ["[W]e conclude that it is within the discretion of the Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f)."]. See also, TMEP §1212.02(e) (3rd ed. 2002).