

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
August 8, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Z-Tech, Inc.

---

Serial No. 78267663

---

Ray R. Regan of Law Office of Ray R. Regan, P.A. for Z-Tech, Inc.

Rudy Singleton, Trademark Examining Attorney, Law Office  
102 (Thomas V. Shaw, Managing Attorney)

---

Before Seeherman, Bergsman and Wellington, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Z-Tech, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register PAIN RELIEF FOOTWEAR, with the word FOOTWEAR disclaimed, for footwear, shoes, shirts and hats.<sup>1</sup> Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C.

---

<sup>1</sup> Application Serial No. 78267663, filed June 27, 2003, based on Section 1(b) of the Trademark Act (intent-to-use).

§1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified goods.

The appeal has been fully briefed. We affirm the refusal.

It is the Examining Attorney's position that the term PAIN RELIEF FOOTWEAR describes footwear that reduces and relieves pain. In support of his position, the Examining Attorney has made of record Internet evidence regarding both applicant's and third parties' footwear products, and dictionary definitions<sup>2</sup> of the words "pain" and "relief," to wit:

Pain: 1. An unpleasant sensation occurring in varying degrees of severity as a consequence of injury, disease, or emotional disorder.  
2. Suffering or distress.

Relief: 1. The easing of a burden or distress, such as pain, anxiety, or oppression.  
2. Something that alleviates pain or distress.

The Examining Attorney has also pointed out that applicant has identified its goods as, inter alia, "footwear," and has disclaimed exclusive rights to that word, thereby acknowledging its descriptiveness.

---

<sup>2</sup> The American Heritage Dictionary of the English Language, 3d ed. © 1992.

Although applicant filed its application on the basis of an intention to use the mark, applicant has stated that it "is selling similar footwear under the Z-Coil® mark that Applicant intends to sell under the PAIN RELIEF FOOTWEAR mark." Brief, p. 6. Applicant is also currently advertising its footwear and shoes in conjunction with the mark, id., and has submitted advertisements showing the same types of footwear that it intends to sell under the mark PAIN RELIEF FOOTWEAR, as well as advertisements for its shoes which use the slogan PAIN RELIEF FOOTWEAR. In addition to advertising and other materials submitted by applicant, applicant has made of record copies of third-party registrations.

The evidence of record shows that applicant advertises its footwear as having features that reduce pain, e.g., "Extra Forefoot Cushioning" is listed as a "Primary factor in reducing forefoot pain"; while the "Spring Suspension System" is "the primary factor in reducing skeletal pain and absorbing shock." Its Internet advertisement, at [www.zshoes.com/ztechnology.cfm](http://www.zshoes.com/ztechnology.cfm), states that rigid support is "the key to preventing foot pain," and explains that foot pain is often caused by plantar fasciitis or heel spurs, and that applicant's orthotic prevents the plantar ligament from stretching, which causes mid-foot pain or

plantar fasciitis, and that it also prevents the plantar ligament from detaching from the heel bone, which is the cause of heel spurs and the cause of most heel pain. A poster for applicant's goods, headed "pain relief footwear," bears the slogan "Cut the pain," and include the testimonials:

When I wear Z-CoilS my feet do not feel tired or sore at the end of the day;  
and

Thanks to my Z-CoilS, at the end of the day my back and feet do not hurt anymore.

Another poster, also bearing the slogan "pain relief footwear," has the following testimonials:

I now have a fuller and more productive life that is pain-free;

The part that amazes me is that I walk with NO pain!; and

With less foot pain, I am in a better mood and just feel better all over.

The Examining Attorney has made of record various articles about applicant's footwear, which include the following statements:

The Z-COIL® Shoe is marketed as a pain relief shoe, and it is, but it is a new tool for walking better.  
"Ambulation News," September 2002

It was a testimonial to the effectiveness of the pain relief being provided. It also guided the company in

a new direction, away from running shoes to developing a whole new industry: pain relief footwear.™

\*\*\*

The focus on pain relief has led to many improvements and modifications to the design of the footwear. ... Thanks to their growing availability, thousands of people are finding pain relief in the form of Z-Coil® footwear.

\*\*\*

Z-Coil has evolved from Al Gallegos' quest to end his own pain to his quest to end the pain of countless people who are suffering daily from foot, leg, and back pain.

"Realizing the Impossible Dream, The Story Behind Z-Coil® Footwear"  
www.zcoil.com (applicant's website)

Cheryl's suffering led her to try nearly anything to find relief from the pain. ... An ER nurse introduced her to Z-Coil® footwear, a revolutionary line of pain-relief footwear designed to help ease pain associated with foot, leg, hip, knee and back problems.

Z-COIL SHOES are special pain relief shoes with a build-in orthotic, extra cushioning (200% more than other shoes) and a patented spring suspension system that reduces the impact on the body.

Z-COILS don't cure anything, they provide pain relief for conditions like heel spurs, plantar fasciitis, ankle, knee, hip, leg, and back discomfort.

Pain Away Footwear

<http://painawayfootwear.com>

Applicant's website also lists articles and TV segments featuring its shoes, including the following titles:

Special shoes relieve foot, back pain  
KVUE News, April 26, 2004

Strange looking shoe offers pain relief  
News 8 Austin, February 18, 2004

Can Shoes Relieve Foot and Leg Pain?  
KUTZ, June 24, 2004

In addition, articles about and advertisements for third-party products refer to their "pain relief" characteristics as follows:

Corn/Calluses/Forefoot  
Ball-of-Foot Pain  
Relieve ball of foot pain with ball of  
foot cushions, foot insoles, and other  
ball of foot pain relief products  
FootSmart  
[www.footsmart.com](http://www.footsmart.com)

The Heel-Right patented foot pain relief sock has been proven to work in clinical studies where subjects, who exhibited confirmed cases of plantar fasciitis or heel pain syndrome, reported an average foot pain improvement of over 73 percent in just 3 weeks.  
[www.prweb.com](http://www.prweb.com)

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific

feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

The evidence of record clearly shows that a central characteristic of applicant's footwear is that it is designed to reduce or eliminate or prevent pain. Applicant acknowledges that reducing and preventing foot pain is a

feature of the goods, and that in its advertising "emphasis is on the prevention and reduction of foot pain." Brief, p. 6. The evidence also shows that "pain relief" is a term that customers and writers use to refer to products that reduce or eliminate pain. When the term PAIN RELIEF is combined with the generic word FOOTWEAR, the mark PAIN RELIEF FOOTWEAR immediately and directly informs consumers of a major feature of the goods, namely, that the footwear provides relief from pain.

Applicant has asserted that its mark is suggestive of types of footwear and shoes, but not merely descriptive. It is not entirely clear what the basis for applicant's assertion is. Applicant makes its conclusory statement after the following paragraphs in its brief:

...A built-in orthotic reduces chances of forming heel spurs or plantar fasciitis (pain in the mid-foot). Extra forefront cushioning is a primary factor in reducing forefoot pain. The spring suspension system is the primary factor in reducing skeletal pain and absorbing shock. Shoes sold under the Z-Coil marks reduce impact, a major cause of foot, leg, and back pain. Rigid support is the key to preventing foot pain.

Testimonials confirm that the footwear has additional benefits besides reducing and preventing foot pain. See Exhibit 2, Applicant's Response of 26 May 2004, and the poster emphasizing "cut the pain" in conjunction with PAIN

RELIEF FOOTWEAR. Also, see Exhibit 4, Applicant's Response of 26 May 2004, and the poster emphasizing "Enjoy Walking Again" in conjunction with PAIN RELIEF FOOTWEAR, which features testimonials that wearing Z-Coils causes a pain-free life, enable walking with no pain, and causes less foot pain. See also Exhibit 5 Applicant's Response of 26 May 2004, and the banner advertising "Authorized Z-Coil Pain Relief Center" in conjunction with PAIN RELIEF FOOTWEAR.

Brief, pp. 6-7.

To the extent that applicant's assertion that its mark is suggestive is based on the position that PAIN RELIEF FOOTWEAR does not describe all of the features of applicant's goods, as we have already stated, it is not necessary that a mark do so in order to be found merely descriptive, as long as it describes a single, significant feature. Or it may be applicant's position that because its footwear "prevents" pain, "relief" does not describe what the goods do, since "relief" refers to reducing or alleviating pain, but not to preventing it. However, applicant itself admits that its advertising emphasizes that its footwear reduces foot pain. More importantly, the various uses of the term "pain relief" by third parties, and by the testimonials featured in applicant's own posters, show that the public views and understands the term "pain relief" as referring to preventing or reducing

or eliminating pain. We note applicant's point that the uses of "pain-relief" in a descriptive sense are not "authored by Applicant." Reply brief, p. 4. Aside from the fact that applicant itself has publicized many of the articles and other references that use "pain relief" descriptively, this use by third parties demonstrates public understanding of the term.

Applicant also points to the existence of various third-party registrations for marks that contain the term PAIN RELIEF as showing that the term is "presumptively suggestive," brief, p. 8, or "presumptively incongruous," brief, p. 10. However, most of the registrations that were submitted by applicant are on the Supplemental Register, or if they are on the Principle Register, "PAIN RELIEF" has been disclaimed, thus indicating the descriptive nature of the term. See, for example, Registration No. 2993196 for DAILY BALANCE PAIN RELIEF CREAM for topical analgesic preparation, with DAILY and PAIN RELIEF CREAM disclaimed; Registration No. 3008075 for CARPAL TUNNEL PAIN RELIEF STRIPS for splints, which is on the Supplemental Register; Registration No. 2819498 for PHYSICIAN'S PAIN RELIEF CREAM for topical analgesic cream, with PAIN RELIEF CREAM disclaimed; Registration No. 2395846 for ALTERNATIVE PAIN RELIEF PRODUCTIONS for a series of video tapes featuring

self-help instructions relating to pain relief, with PAIN RELIEF PRODUCTIONS disclaimed; Registration No. 2583908 for NATURAL PAIN RELIEF for jewelry, registered on the Supplemental Register; Registration No. 2336734 for BMI THE NAUTRAL PAIN RELIEF SYSTEM for support bandages containing magnets used for pain relief, with THE NATURAL PAIN RELIEF SYSTEM disclaimed; and Registration No. 2771960 for PAIN RELIEF TECHNOLOGY and design for pillows, lumbar rolls, back supports and back cushions, with PAIN RELIEF TECHNOLOGY disclaimed.<sup>3</sup>

While the vast majority of the third-party registrations submitted by applicant fall into the above categories, we note that there are five marks that were registered on the Principle Register without a disclaimer or resort to Section 2(f). They are Registration No. 2318703 for PAIN RELIEF THAT WORKS for analgesic balm and Registration No. 2469031 for YOUR NATURAL CHOICE FOR MAXIMUM PAIN RELIEF for topical analgesics, both owned by the same entity; Registration No. 2880296 for A DIFFERENT KIND OF PAIN RELIEF for treatments for pain and for disorders of the central nervous system; Registration No.

---

<sup>3</sup> Applicant submitted only the first page of the printout of this last registration from the TESS database, and the disclaimer information was therefore omitted. We have confirmed that Office records show that the above-noted disclaimer was entered.

2506804 for THE PODIATRIST'S PRESCRIPTION FOR PAIN RELIEF!  
for orthotic shoe inserts; and Registration No. 2140754 for  
CAR BUYING PAIN RELIEF for promoting and advertising  
automobiles via a global computer network. Of course, we  
do not know what went into the Examining Attorneys'  
decisions in allowing these registrations without a  
disclaimer, but we do note that slogans are treated as  
unitary terms, such that, unless the entire slogan is  
merely descriptive, no disclaimer of part of a slogan mark  
is required. See TMEP §1213.05(b). With respect to the  
fifth mark, the term PAIN RELIEF in that mark obviously  
does not refer to actual pain, but suggests the annoyances  
involved in buying a vehicle. In short, we do not regard  
these registrations as showing that the words PAIN RELIEF  
in applicant's mark are not descriptive, or that, as  
applicant would have it, its mark PAIN RELIEF FOOTWEAR is  
incongruous and therefore registrable. If anything, the  
large number of third-party registrations for marks which  
contain the term PAIN RELIEF, as well as those  
registrations which use "pain relief" as part of their  
identification of goods, show that this term has a readily  
recognized meaning. As a result, they provide further  
support for our conclusion that the public would  
immediately understand, when seeing the mark PAIN RELIEF

FOOTWEAR used for footwear, that the footwear reduces or eliminates pain.

Applicant has asserted, citing TMEP §1209.03(d), that "a mark comprised of a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or, if the composite has a bizarre or incongruous meaning as applied to the goods." Brief, p. 9. While applicant is correct about this general principle, it has failed to explain why its mark should be deemed to have a nondescriptive or incongruous meaning. The cases applicant has cited are readily distinguishable from applicant's situation. For example, in *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the first case cited by applicant, the mark involved therein, SUGAR & SPICE for bakery products, had a second, nondescriptive meaning relating to the nursery rhyme. Applicant has not explained what additional, nondescriptive meaning PAIN RELIEF FOOTWEAR has, or why this term should be considered incongruous when used for footwear.

Applicant has asserted that its mark is incongruous when applied to nonfootwear items, such as the shirts and hats which are also identified in the application. However, as stated above, if a mark is descriptive of any

of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. Otherwise, applicants could obtain exclusive rights to merely descriptive marks simply by including in their applications an item for which the mark is not descriptive.

Applicant has also argued that PAIN RELIEF FOOTWEAR has "other functional equivalents that can be used to describe the genus at issue, such as 'pain prevention shoes,' 'pain easing footwear,' comfortable footwear,' 'less tiring footwear,' 'back saving footwear,' 'ankle easing footwear,' and so on, which makes it registrable." Brief, pp. 8-9. Even if we accept that the terms suggested by applicant are "functional equivalents" of PAIN RELIEF FOOTWEAR, the fact that competitors and the public at large use the term "pain relief" for its recognized meaning, as shown by the various articles and other Internet evidence, demonstrates that there is a competitive need for the use of this term, and that applicant is not entitled to exclusive rights to it. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983) (to be held a generic or common descriptive name, it is not necessary that the designation in question be the only apt or common name of the goods or services or that the name be universally recognized as such).

Finally, we note applicant's reliance on the principle that when there is doubt on the issue of whether a mark is merely descriptive, that doubt should be resolved in favor of the applicant. However, in the present case we have no doubt whatsoever that applicant's mark is merely descriptive of some of the goods identified in its application.

Decision: The refusal of registration is affirmed.