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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re BGizunt, Inc.

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Serial No. 78699926

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Bob Schwartz for BGizunt, Inc.

Carol Spils, Trademark Examining Attorney, Law Office 104  
(Chris Doninger, Managing Attorney).

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Before Quinn, Grendel and Cataldo, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

BGizunt, Inc. filed an application to register the  
mark shown below



("SHOES" and "DIABETIC FOOTWEAR" disclaimed) for "prescription orthopedic footwear; prescription orthotic inserts for footwear."<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark TENDERFOOT for "orthopedic inner soles"<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant contends that sales of its expensive goods are made directly to podiatrists and medical foot care specialists and not to the general public; the doctor's patients, according to applicant, are not likely to encounter applicant's mark. There are extensive discussions between the doctor and the supplying laboratory to ensure an appliance with the correct fit and function. These discussions, applicant contends, result in a

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<sup>1</sup> Application Serial No. 78699926, filed August 24, 2005, based on a bona fide intention to use the mark in commerce. The application includes the following statement: "The word 'tenderfeet' is lowercase and is grey, the word 'shoes' is lowercase and is blue and the image of a shoe is blue, the words 'Diabetic Footwear' are in red, and the outline of the shoe is in black."

<sup>2</sup> Registration No. 2550807, issued March 19, 2002.

partnership, thereby precluding any confusion relating to the source of the goods. As to the marks, applicant claims that the disclaimed terms in its mark play an important role in distinguishing applicant's mark from the registered mark in terms of appearance, sound and connotation.

Applicant contends that the term "tenderfoot" is weak in relation to foot care products. Applicant sums up its arguments as follows: "Our analysis is based on the cumulative differences between the marks and the essential differences between the individually produced custom molded shoe inserts. Additionally, the high degree of care taken by the medical foot care specialist in selecting a laboratory supplier of orthotic appliances insures that source confusion would be highly unlikely." (Reply Brief, p. 1). In urging that the refusal to register be reversed, applicant submitted several documents, including dictionary definitions, third-party registrations, excerpts of third-party websites, excerpts of articles in printed publications retrieved from the NEXIS database, materials relating to the practice of pedorthics and the manufacturing process for applicant's goods, and letters and follow-up declarations of three podiatrists.

The examining attorney maintains that applicant's mark is dominated by TENDERFEET, a term that is virtually

identical to the entirety of registrant's mark TENDERFOOT. Even if the terms were weak in the foot care industry, the marks are similar enough to cause confusion when used in connection with closely related goods. The examining attorney also contends that the goods are related. In support of the refusal, the examining attorney submitted third-party registrations to show the relatedness of the goods, and a dictionary definition that will be considered pursuant to the request to take judicial notice thereof.<sup>3</sup>

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d

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<sup>3</sup> The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

1531 (Fed. Cir. 1997).

We first turn to a consideration of the goods. It is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Early on in the prosecution of this case applicant stated that "the goods are at least in part related" (Response, September 6, 2006), but applicant subsequently limited its identification of goods to "prescription" products, and then argued at length about the sophisticated method of sale and classes of purchasers (medical professionals) for its products.

In determining the issue of likelihood of confusion in *ex parte* cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. *In re Elbaum*, 211 USPQ 639, 640

(TTAB 1981). In the present case, applicant's goods are identified as "prescription orthopedic footwear; prescription orthotic inserts for footwear," and registrant's goods are identified as "orthopedic inner soles." Where the goods in the cited registration and/or application are broadly identified as to their nature and type (as is the case herein with respect to the cited registration), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Id.* Accordingly, we must presume that registrant's goods include not only orthopedic inner soles sold directly to consumers, but that the goods also include prescription orthopedic inner soles. This presumption about registrant's goods is buttressed by the excerpt of registrant's website introduced by applicant. (Response, March 12, 2007, ex. no. 13). Registrant's goods offered for sale under the TENDERFOOT mark are "custom made orthoses" that are "computer generated from your cast of

the patient," and, according to the website, give "more control and comfort than with most similar items found in drug stores." Further, registrant's goods are identified broadly enough to include prescription inner soles to be used by diabetics. The same class of purchasers, namely podiatrists and other medical professionals, would buy the goods.<sup>4</sup>

The examining attorney introduced numerous third-party registrations to establish the relatedness of the goods. The use-based registrations show that each registrant adopted a single mark for goods such as orthopedic footwear, inserts and inner soles. Although the goods in the registrations are not specifically limited to "prescription" orthopedic foot products, the identifications are worded broadly enough to cover such products. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and

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<sup>4</sup> Applicant states that "we do not dispute that the marks can be encountered by the same purchasing physicians; what we do dispute is whether those physicians would be confused by the dissimilar marks on goods in which the doctors have made a direct contribution towards their production." (Reply Brief, p. 10).

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*In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

With respect to the involved marks, applicant's TENDERFEETSHOES DIABETIC FOOTWEAR and design and registrant's TENDERFOOT, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["There 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.”].

Where both words and a design comprise the mark (as in applicant’s mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation’s Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Thus, in the case of applicant’s mark, we find that the dominant portion is the literary portion of the mark, namely TENDERFEETSHOES DIABETIC FOOTWEAR.

In considering the literary portion of applicant’s mark, this portion, in turn, is dominated by the term TENDERFEET. We so find because descriptive matter generally is subordinate to source-identifying portions of a mark. For example, in the past merely descriptive matter that is disclaimed has been accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1533-34; and *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) [Disclaimed matter is often “less significant in creating

the mark's commercial impression"]. In the present case, applicant has disclaimed the highly descriptive/generic terms DIABETIC FOOTWEAR. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 224 USPQ at 752 ["Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion'"]. Further, the term SHOES, although combined with the term TENDERFEET, is highly descriptive/generic; the term undoubtedly would be disclaimed if it were not displayed in a combined manner with TENDERFEET.<sup>5</sup>

In view of the above, we find that the term TENDERFEET is the dominant portion of applicant's mark. This term is very similar to the entirety of registrant's mark TENDERFOOT.<sup>6</sup>

Although the dominant portion, TENDERFEET, of applicant's mark is highly similar to registrant's mark TENDERFOOT in sound, appearance, meaning and commercial impression, we must do more than just compare the

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<sup>5</sup> Moreover, although the words TENDERFEET and SHOES are combined, the term "SHOES" appears in a different color from the rest of the mark.

<sup>6</sup> To state the obvious, the term "feet" is the plural of "foot." The American Heritage Dictionary of the English Language (3d ed. 1992).

individual components of the marks; it is necessary that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. While we have considered the SHOES and DIABETIC FOOTWEAR portions of applicant's mark, purchasers are likely to view these commonly understood and recognized terms to describe applicant's goods.

Applicant's reliance on four third-party registrations and two third-party applications of TENDERFOOT marks for foot care goods or services does not compel a different result herein. Third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Further, third-party applications have no evidentiary value other than to show that they were filed. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992). We note, however, that none of the third-party marks cover goods as close to registrant's product as are applicant's goods.

Third-party registrations, however, may be relied upon to show that a word common to each mark has a readily

understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). Each of the TENDERFOOT marks serves to indicate that the goods are easy on or tender to the wearer's feet. To the extent that both marks are suggestive, they suggest the same meaning.<sup>7</sup>

We find that the marks, when considered in their entirety, are similar in sound, appearance, meaning and commercial impression.

Applicant also argues at length about the sophisticated conditions of sale of its goods to discriminating purchasers. Applicant asserts that sales of its goods are made directly to podiatrists and medical foot care specialists and not to the general public. In this connection, applicant introduced letters and follow-up declarations from three podiatrists who attest to their concern to provide their patients with orthopedic devices that conform to a high degree of professional standards.

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<sup>7</sup> Applicant's contention that the term "tenderfoot" means "newcomer or novice," although factually correct, is of little consequence herein. The meanings of the involved marks must be analyzed in the context of applicant's and registrant's foot products. Alternatively, applicant's statement (with supporting evidence) that the term "tenderfoot" is connected with the Boy Scouts of America likewise is of no consequence considering the nature of the involved goods.

These podiatrists indicate that they have chosen applicant as a supplier of inserts for their patients, and they have a close working relationship with applicant and recognize applicant's high standard of workmanship. According to applicant, "[w]hen the level of interaction between buyer and seller becomes one of a close-knit partnership, there can be no confusion regarding source." (Brief, p. 3).

Although we have considered the statements of these three customers for applicant's goods, we find that the letters and declarations are entitled to minimal probative value. The custom nature of the involved products and the working relationship between the podiatrist and the laboratory, while a factor in applicant's favor, does not outweigh the cumulative similarities between the marks and the goods sold thereunder. As often stated, even knowledgeable purchasers may not be sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Given the similarities between the marks and the commercial relatedness of the goods, even knowledgeable purchasers are likely to be confused. Further, contrary to applicant's claim that the goods are "expensive" (Response, September 8, 2006), the invoices introduced by applicant

show that the goods are relatively inexpensive, especially in light of the fact that they are medical products.<sup>8</sup>

We conclude that purchasers familiar with registrant's orthopedic inner soles sold under the mark TENDERFOOT would be likely to believe, upon encountering applicant's mark TENDERFEETSHOES DIABETIC FOOTWEAR and design for prescription orthopedic footwear and prescription orthotic inserts for footwear, that the goods originate from or are associated with or are somehow sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

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

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<sup>8</sup> Applicant filed the invoices under seal, maintaining that the cost of its products is proprietary information.