

**EXPRESS MAIL
POST OFFICE TO ADDRESSEE
NO. EL568551274US
DATE OF DEPOSIT: December 27, 2002**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**



In re Application of
Pepper Hamilton LLP

For "WE COUNSEL EACH CLIENT AS
IF IT WERE OUR ONLY CLIENT"

Serial No. 76/291,540

Filed: July 27, 2001

12-27-2002

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #67

NOTICE OF APPEAL

TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS:

Pepper Hamilton LLP (the "Applicant"), by and through its undersigned counsel, hereby appeals to the Trademark Trial and Appeal Board from the final refusal of the Examining Attorney dated July 3, 2002. The Applicant counsel's check payable to the Commissioner of Patents and Trademarks, covering payment of the applicable filing fee (\$100.00 for one class), is included herewith. The Applicant hereby authorizes deduction of any additional fees that may be necessary, from its attorneys' Deposit Account No. 16-1322.

The Applicant also attaches hereto as an exhibit the Response to Office Action Mailed July 3, 2002 Qua Request for Reconsideration that it is concurrently filing this date, addressed to the Examining Attorney on the file, Mary Jo Rossman of Law Office 109.

01/03/2003 6THOMAS2 00000192 76291540

01 FC:6403

100.00 0P

A duplicate copy of this notice and attachment is enclosed herewith.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph J. Serritella", written over a horizontal line.

JOSEPH J. SERRITELLA
TRACEY S. PACHMAN
Pepper Hamilton LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4097

Date: December 27, 2002

Attorney for the Applicant
PEPPER HAMILTON LLP

**EXPRESS MAIL
POST OFFICE TO ADDRESSEE
NO. EL568551265US
DATE OF DEPOSIT: December 27, 2002**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Pepper Hamilton LLP

For: "WE COUNSEL EACH CLIENT AS
IF IT WERE OUR ONLY CLIENT"

Serial No.: 76/291,540

Filed: July 27, 2001

Trademark Law Office 109
(703) 308-9109, ext. 147

Examining Attorney:
Mary Jo Rossman

**RESPONSE TO OFFICE ACTION MAILED JULY 3, 2002
QUA REQUEST FOR RECONSIDERATION**

TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS:

Pepper Hamilton LLP (the "Applicant"), by and through its undersigned counsel, hereby responds to the Office Action Mailed July 3, 2002, on the above-captioned service mark application.

Mark Merely Descriptive - Final Refusal

The Examining Attorney has refused Applicant's application for the mark WE COUNSEL EACH CLIENT AS IF IT WERE OUR ONLY CLIENT on the grounds that the mark is merely descriptive of the identified services. Applicant respectfully disagrees. Rather, the mark creates an inventive impression by reason of its incongruous meaning. Indeed, this mark could not be descriptive because it states a paradox. The mark plainly implies, by referring to "each client," that the Applicant, which is a large law firm, has numerous clients. In the same phrase, though, the mark states the conceit that the law firm treats everyone of these clients as if the firm has

EXHIBIT

only one client. This, of course, is literally impossible, but the mark suggests the Applicant's aspiration to provide legal services to each of its many clients, regardless of their size and status, as if it were the firm's only client. Thus the mark, by posing a seeming conundrum, ultimately conveys a sense of the Applicant's culture of devotion to the individual needs of its clients. Such conveyance of meaning through indirection, requiring intellection on the part of the reader, meets the standard of suggestiveness for a valid service mark.

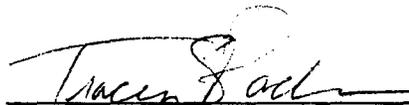
Appeal

Failing a reversal of position by the examiner, the Applicant notes that it is simultaneously filing a Notice of Appeal in connection with the final refusal.

Conclusion

Based upon the foregoing remarks, the Applicant respectfully requests that the Examining Attorney reconsider her final refusal and allow the Applicant's mark to proceed to publication and ultimately registration.

Respectfully submitted,



JOSEPH J. SERRITELLA
TRACEY S. PACHMAN
Pepper Hamilton LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4000

Dated: December 27, 2002

Attorneys for the Applicant
PEPPER HAMILTON LLP

**EXPRESS MAIL
POST OFFICE TO ADDRESSEE
NO. EL568551265US
DATE OF DEPOSIT: December 27, 2002**

CERTIFICATION OF MAILING

Tracey S. Pachman hereby certifies that the foregoing Response to Office Action Mailed July 3, 2002 Qua Request for Reconsideration of Pepper Hamilton LLP for "WE COUNSEL EACH CLIENT AS IF IT WERE OUR ONLY CLIENT," Serial No. 76/291,540, is being deposited with the United States Postal Service as Express Mail, mailing label no. EL568551265US, postage-prepaid, in an envelope addressed to Assistant Commissioner for Trademarks, BOX RESPONSE -- NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on this 27th day of December, 2002.



TRACEY S. PACHMAN

EXPRESS MAIL
POST OFFICE TO ADDRESSEE
NO. EL568551274US
DATE OF DEPOSIT: December 27, 2002

CERTIFICATION OF MAILING

I hereby certify that the original and one copy of the foregoing Notice of Appeal of Pepper Hamilton LLP for "WE COUNSEL EACH CLIENT AS IF IT WERE OUR ONLY CLIENT," Serial No. 76/291,540, and Pepper Hamilton LLP Check No.268415 in the amount of \$100.00 are being deposited with the United States Postal Service as Express Mail, mailing label no. EL568551274US, postage-prepaid, in an envelope addressed to Assistant Commissioner for Trademarks, BOX TTAB — FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513, Attention: Trademark Trial and Appeal Board, on this 27th day of December, 2002.



TRACEY S. PACHMAN

TTAB

Pepper Hamilton LLP
Attorneys at Law

3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
215.981.4000
Fax 215.981.4750

215-981-4604
pachmant@pepperlaw.com

December 27, 2002



EXPRESS MAIL
POST OFFICE TO ADDRESSEE
NO. EL568551274US
DATE OF DEPOSIT: December 27, 2002

12-27-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #67

Assistant Commissioner for Trademarks
2900 Crystal Drive
BOX TTAB — FEE
Arlington, VA 22202-3513

ATTENTION: Trademark Trial and Appeal Board

Re: Application of Pepper Hamilton LLP for:

“WE COUNSEL EACH CLIENT AS IF IT WERE
OUR ONLY CLIENT,” Serial No. 76/291,540
Filed July 27, 2001

Trademark Law Office 109
Examining Attorney: Mary Jo Rossman

Notice of Appeal

Madam:

I enclose in duplicate (original and one copy) the Notice of Appeal of Pepper Hamilton LLP on the above-identified service mark application.

Also enclosed is Pepper Hamilton LLP Check No. 268415 made payable to Commissioner of Patents and Trademarks in the amount of \$100.00 to cover the required fee for the one class affected by the notice of appeal. An additional copy of this letter is included for accounting purposes.

Assistant Commissioner for Trademarks

Page 2

December 27, 2002

Finally, also enclosed is a reply postcard for the mail room to acknowledge receipt of the enclosed.

Respectfully,

A handwritten signature in black ink, appearing to read "Tracey S. Pachman". The signature is fluid and cursive, with a long horizontal line extending to the right.

Tracey S. Pachman

TSP/mjs
Enclosures