

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

Hearing:
21 July 2009

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28 August 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Lex Group VA

Serial No. 76665046

Edward A. Pennington of Hanify & King, P.C. for The Lex Group VA.

David E. Tooley, Jr., Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Quinn, Bucher, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 23, 2006, applicant The Lex Group VA, a Virginia corporation, applied to register the mark E-LEX in standard character form on the Principal Register for services ultimately identified as: "Litigation support services for attorneys provided via an electronic network with court-specific consultation on the rules and implementation of procedures for filing electronically" in

Class 42. Serial No. 76665046. The application is based on an allegation of a bona fide intent to use the mark in commerce.

The examining attorney has refused to register applicant's term on the ground that the mark is merely descriptive for the identified services under Section 2(e)(1) of the Trademark Act. 15 U.S.C. § 1052(e)(1).

The examining attorney held the mark to be merely descriptive because:

The letter 'e' used as a prefix has become commonly recognized as a designation for services that are electronic in nature or are sold or provided electronically. In this case, applicant's identification of services indicates that its services are delivered "via an electronic network."

The term "lex" is an **English** word meaning "law."

[A]pplicant's services are for *lawyers* in assisting in *legal contests* or, more broadly, law or legal services.

[T]he attorney consumers will immediately recognize that applicant provides law or legal services via electronic means.

Brief at unnumbered pp. 3, 6, and 8.

On the other hand, applicant maintains that:

Despite the examining attorney's reliance on definitions of "lex" as simply "law," neither the applied-for service nor the intended customer base is "law."

The services are complex and court-specific filing assistance - helping attorneys ensure that filings are in compliance with the particular and unique

electronic submission requirements of various courts and jurisdictions.

No definition offered by the examining attorney included any mention of electronic filing, submission assistance, or rule compliance...

[T]he applied-for services are not solely electronic; rather, there is a human element to the filing services.

Brief at 2 - 5.

After the examining attorney made the refusal final, applicant filed a request for reconsideration and a notice of appeal. A hearing was held on July 21, 2009.

For a mark to be merely descriptive, it must immediately convey "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). While we must consider the mark in its entirety, "[i]t is perfectly acceptable to separate a compound mark and

discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in its entirety." *In re Hester Industries, Inc.*, 230 USPQ 797, 798 n.5 (TTAB 1986).

The examining attorney submitted numerous definitions to support his position that the terms "e-" and "lex" are descriptive of applicant's services.

1. "e-"

- electronic data transfer via the internet.

MSN Encarta

- Computer or computer: e-cash; e-zine

Bartleby.com

- abbreviation for electronic

<http://dictionary.cambridge.org>

- electronic <e-commerce>

*Merriam-Webster's Online Dictionary*¹

2. Lex

- Law

Merriam-Webster Online

- Law

Bartleby.com

- Law

The American Heritage Dictionary of the English Language

¹ "The Board may take judicial notice of online reference works which exist in printed format or have regular fixed editions." *In re Dietrich*, 91 USPQ2d 1622, 1631 n. 15 (TTAB 2009) (Board took judicial notice of the *Merriam-Webster Online Dictionary*). See also *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (same).

To these definitions, we add another definition of "Lex" as "Law." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We also take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We also point out that the term "e-" has been found to be a term that simply describes the fact that the goods or services are associated with the internet. *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1679 (TTAB 2006) ("We find that in the context of applicant's identified goods, which fall within the definition of a 'server,' and in light of the term SERVER in applicant's mark, the 'E' in ESERVER would be perceived as a prefix standing for 'electronic,' and identify a server involved with the Internet") and *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1447 (TTAB 2000) ("[T]he term E FASHION immediately describes, without conjecture or speculation, a significant characteristic or feature of the goods and/or services, namely, that they involve retrieving fashion information and/or shopping for fashions electronically via software and retail websites on the Internet. To consumers for applicant's goods and/or services, there is nothing in the term E FASHION which, in the context of such goods

and/or services, would be ambiguous, incongruous or susceptible to any other plausible meaning").

The examining attorney also submitted evidence of the use of the term "e-" to refer to services performed on the internet. See www.amazon.com (e-counsel: The Executive Legal Guide to Electronic Commerce); www.e-law.com (eLaw The Easier Way to Practice Law; eWatch - Alerts you of dates and changes to your cases; eDocket - High-speed advanced searching; eServe/eFile - Safe, secure electronic exchange of documents; eCopy - Get copies of court documents; eCalendar - View your future court dates).

Furthermore, we note that the addition of the hyphen is not significant. *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637, 1640 (TTAB 2006) ("[T]he addition of hyphens to marks, as in this case ["3-0'S"], has not been successful in changing the descriptive nature of the term"); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55 (TTAB 1984) (presence of slash in the mark "designers/fabric" does not negate mere descriptiveness of mark).

Applicant's services involve providing "litigation support services for attorneys provided via an electronic network." The letter "e-" would inform prospective consumers its services are provided electronically through the internet. Also, inasmuch as its services are directed

to attorneys for litigation support services, the term "lex" would describe the fact that applicant is providing a type of legal or law-related services. The examining attorney points out that "litigation" means "to contest at law." Brief at 6.

We must consider not only the meaning of the individual terms but the mark as a whole because the combined terms may have a non-descriptive meaning. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products inasmuch as it is suggestive of a nursery rhyme). Also, we must determine whether a mark is merely descriptive of a mark by considering the mark in relation to the particular services for which registration is sought and not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"). Here, the combined term "E-LEX" does not have any unique meaning that would be different from the individual terms when used in association with applicant's litigation support services. It would merely inform prospective

purchasers that applicant provides a type of "law or legal services via electronic means." Examining Attorney's Brief at 8.

Applicant argues that there are "many other marks containing the word 'LEX' [that] have been registered for the provision of law-related goods and services." Brief at 5.² These registrations do not persuade us that applicant's mark is not merely descriptive.

First, we are required to consider the descriptiveness in the context of the record in this case.

Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.

Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board.

In re Nett Designs Inc., 236 F.2d 1229, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also *In re Hotels.com L.P.*, 87 USPQ2d 1100, 1108 (TTAB 2008), *aff'd*, ___ F.3d ___, 91

² While these registrations were submitted with applicant's brief, the examining attorney has not objected to them and he has discussed them in his brief (p.7). Therefore, we will consider them to be of record. *In re Litehouse Inc.*, 82 USPQ2d 1471, 1475 n.2 (TTAB 2007) and TBMP § 1207.03 (2d ed. rev. 2004).

USPQ2d 1532 (Fed. Cir. 2009) ("Nor do these third-party registrations establish that there is an Office practice holding such marks are generally registrable").

Secondly, the registrations that applicant submitted do not tell a consistent story. In one, LEX MUNDI, the term "Lex" is disclaimed. No. 1610249. In another, LEX MUNDI THE WORLD'S LEADING ASSOCIATION OF INDEPENDENT LAW FIRMS and design, the term is not disclaimed. No. 3128878. Many registrations include the word LEX, with a translation for the word, and an English word. Nos. 20267392, 2955791, and 3128878. It has been held that "the doctrine [of foreign equivalents] does not apply when a mark is a combination of foreign and [E]nglish words." *French Transit Ltd. v. Modern Coupon Systems Inc.*, 818 F. Supp. 635, 29 USPQ2d 1626, 1626 (S.D.N.Y. 1993) (LE CRYSTAL NATUREL for body deodorant is suggestive). Two other registrations are for compressed terms that apparently contain non-descriptive elements. See Nos. 1379763 (LEXSEE) and 3192723 (LEXWORK INTERNATIONAL). Thus, the fact that there are two registrations for the mark LEX SOLUTIO for legal document management services and legal support services (Nos. 2668467 and 2720634) hardly demonstrates that applicant's mark is not descriptive. "It is well settled that each case must be taken on its own

facts." *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001). *See also In re Best Software Inc.*, 63 USPQ2d 1109, 1113 (TTAB 2002).

In the present case, the evidence shows that the term LEX is an English term and it is combined with the English language abbreviation for electronic. The mark immediately informs consumers that the services involve legal work that is performed over the internet. Therefore, the registrations that applicant has submitted do not rebut the examining attorney's evidence that shows that applicant's mark is merely descriptive.

Applicant also argues that its "services are complex and court-specific filing assistance - helping attorneys ensure that filings are in compliance with the particular and unique submission requirements of various courts and jurisdictions. The applied-for services, as explained in the application, are not general legal assistance (as may be suggested by the mark), but rather a very specific type of electronic filing rule compliance." Brief at 3.

However, we note that the refusal here is not that applicant's mark is the name of the services. The question before us is whether the mark describes a significant feature of the services. Thus, while the term "lex" is descriptive of a broad range of legal services, it

nonetheless provides significant information about applicant's services, i.e., that they are electronic legal-related services. *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792, 1795 (TTAB 1996) ("Any computer program, including applicant's, which has as a basic function or purpose the creation of new or customized programs for controlling the acquisition of data from measurement devices is thus aptly described as a visual design program or, more simply, a 'visual designer'"). *See also In re Box Solutions Corp.*, 79 USPQ2d 1953, 1956 (TTAB 2006) ("In the context of computer goods [computer hardware, namely, communications servers], SOLUTIONS is a term that is used to describe the purpose of the computer to resolve a problem. In view thereof, we find that SOLUTIONS is descriptive of applicant's goods and that the required disclaimer is appropriate").

Also, the fact that the term "e-" and "lex" can have more than one meaning does not mean that they are not merely descriptive when they are applied to applicant's services. *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999) ("If applicant produced goods related to the medical field, or specifically related to physicians, then the term 'DOC' would be readily understood by the public as referring to 'doctor.' However, here applicant's goods are

computer software for document management, and 'DOC' will be readily understood as referring to documents"). When we look at these terms in the context of applicant's services, attorneys (to whom applicant's services are directed) will understand that applicant's mark merely describes a feature of these services. Finally, applicant maintains its services "are not solely electronic, rather, there is a human element to the filing services." There is no requirement that "electronic" services performed on the internet must be performed without human involvement. Indeed, the now classic term "email"³ involves messages, often created by human beings, sent over the internet. Thus, even if applicant's services involve some human involvement, it would hardly mean that the term is not merely descriptive.

We conclude that when the mark E-LEX is used on litigation support services for attorneys provided via an electronic network with court-specific consultation on the rules and implementation of procedures for filing electronically, it would immediately describe the fact that applicant's services are legal services that are performed

³ Email - "electronic communication." *The American Heritage Student Dictionary* (1998).

online. Thus, the term is merely descriptive of these services.

Decision: The examining attorney's refusal to register applicant's mark E-LEX under Section 2(e)(1) of the Trademark Act is affirmed.