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Subject: U.S. TRADEMARK APPLICATION NO. 77147075 - NATIONAL  
CHAMBER - 11904-185

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**Rce.UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77147075

**MARK:** NATIONAL CHAMBER

**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** The Chamber of Commerce of the United St ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

11904-185

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, The Chamber of Commerce of the United States of America, has appealed the trademark examining attorney's final refusal on the grounds that the proposed mark NATIONAL CHAMBER describes characteristics or features of applicant's services in application Serial Nos. 77147075 and 77975745. Trademark Act Sections 2(e)(1), 15 U.S.C. Sections 1052(e)(1). In addition, the examining attorney refused registration in application Serial No. 77147075 because applicant did not comply with a request for information pursuant to Trademark Rule 2.61(b). The Board consolidated both applications for briefing of the appeal.

**FACTS**

On April 3, 2007, applicant filed an application to register the wording NATIONAL CHAMBER on the Principal Register, for “providing on line directory information services; providing business information and news; membership services, namely providing information about membership benefits and providing discounts for the services of others” in International Class 35; and “analysis of data, policy and regulatory activity” in International Class 45.

In the first office action mailed on June 5, 2007, the examining attorney refused registration on the basis of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because the proposed mark merely describes applicant’s services as illustrated by web pages retrieved from applicant's website and attached to the office action. The initial office action offered applicant the opportunity to amend the application to the Supplemental Register. It also included a requirement to claim prior registrations owned by applicant and amend the broadly stated identification of services.

On December 5, 2007, applicant filed a response arguing against the Section 2(e)(1) refusal and it amended the identification of services to indicate that the directory information services featured information on local and state Chambers of Commerce. The response included a disclaimer of CHAMBER offered by applicant.

On December 27, 2007, the examining attorney issued a final office action maintaining the descriptiveness refusal under Section 2(e)(1) as to services in International Class 35. The requirement for an acceptable amendment to the identification of services was also made final. On June 26, 2008, applicant filed a request

to divide the application so that the services in classes 35 and 45 would be divided in separate applications.

On July 15, 2008, the Office granted applicant's request to divide by maintaining the services in class 35 in application Serial No. 77147075 (parent application) and placing the services in class 45 in application Serial No. 77975745 (child application). That same date applicant filed a response to the final office action again arguing against the Section 2(e)(1) refusal and notifying the examining attorney of its intention to appeal the refusal.

**Application Serial No. 77147075**

On August 22, 2008, the examining attorney issued a non-final office action for application Serial No. 77147075 because after further review, the amended identification of services in class 35 was deemed to be unacceptable. The Section 2(e)(1) refusal was continued. On February 3, 2009, applicant filed a response that included an amended identification of services that remained unacceptable. On February 18, 2008, the examining attorney issued a non-final office action that included an information request requirement asking applicant whether the proposed mark would be used in connection with a national directory of chambers of commerce. Again, the requirement for an acceptable identification of services was continued and so was the Section 2(e)(1) refusal.

On August 7, 2009, applicant filed a response that argued against the Section 2(e)(1) refusal and included copies of registrations that applicant entered into the record. On August 12, 2009, the examining attorney made final the Section 2(e)(1) refusal, the

requirement for an acceptable identification of services and the requirement for information. On November 20, 2009, applicant filed a request for reconsideration that included an acceptable amendment to the identification of services but withdrew the disclaimer of CHAMBER in part; although the disclaimer remained as to “providing online directory information services featuring information regarding local and state Chambers of Commerce”.

Finally, on December 16, 2009, the examining attorney issued an office action denying the request for reconsideration as to the Section 2(e)(1) refusal and continued the requirement for information that was not addressed by applicant. The application was returned to the Board for the resumption of the appeal.

**Application Serial No. 77975745**

On August 27, 2008, the examining attorney issued a non-final office action for application Serial No. 77975745 because after further review, the amended identification of services in class 45 was deemed to be unacceptable. On January 28, 2009, applicant filed an acceptable amendment to allege use along with specimens showing the mark used in connection with the services. On February 18, 2009, the examining attorney issued a final office action based on the requirement for an acceptable identification of services.

On August 7, 2009, applicant filed a request for reconsideration which reclassified the services in class 35 and specified the subject matter of the services in an

acceptable amendment to the identification of services. Because the amended services indicated that the purpose of the analysis services was to promote the interests of businessmen and businesswomen, a common purpose of chambers of commerce, the examining attorney issued a Section 2(e)(1) refusal. On November 20, 2009, applicant filed a response to the non-final office action arguing against the refusal and withdrew the disclaimer of the term CHAMBER in the mark. Subsequently, a final office action was issued on December 16, 2009, refusing the mark under Section 2(e)(1).

Applicant filed an appeal on February 3, 2010. On February 4, 2010, applicant filed a motion to consolidate both appeals which the Board granted on February 23, 2010.

### **ARGUMENT**

Whether a mark 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 those 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. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b). The fact that terms may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

It is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether

someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also, In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of risk-management services related to natural gas).

Applicant is The Chamber of Commerce of the United States of America. The proposed mark NATIONAL CHAMBER conveys multiple descriptive meanings when used in connection with the following services: providing online directory information services featuring information regarding local and state chambers of commerce; providing information and news in the field of business, namely, information and news on current events and on economic, legislative, and regulatory developments that as it relates to and can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services; and analysis of governmental policy relating to businesses and analysis of regulatory activity relating to businesses, all for the purpose of promoting the interests of businessmen and businesswomen; business data analysis.

The examining attorney issued an information requirement consistent with 37 C.F.R. §2.61(b) in conjunction with the Section 2(e)(1) refusal in the office action dated February 18, 2009, for application Serial No. 77147075. Applicant was specifically asked whether the proposed mark would be used in connection with a national directory of chambers of commerce. There is nothing ambiguous about the format of the question posed to applicant especially when the examining attorney attached pages of a website of a nationwide directory of chambers of commerce to the initial office action. This inquiry

was necessary due to applicant questioning the probative value of the web pages that were retrieved from applicant's website and attached to the initial office action.

Applicant stated in its December 5, 2007, response the following:

“[a]pplicant has not yet made use of its mark NATIONAL CHAMBER in commerce in connection with the services for which registration is being sought. As such, the evidence provided by the Examining Attorney is of no probative value of to the descriptiveness of the mark NATIONAL CHAMBER for those services.”

In applicant's request for reconsideration filed on November 20, 2009, applicant neglected to provide a direct answer to the final requirement for information issued in the office action dated August 12, 2009. Applicant stated the following in its request:

“In response, Applicant states that it intends to use its NATIONAL CHAMBER mark in connection with the services at issue in this application, which services (as amended) presently include ‘providing online directory information services featuring information regarding local and state Chambers of Commerce; providing information and news in the field of business, namely information and news on current events and on economic, legislative, and regulatory developments that can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services’ Applicant believes this information should be sufficient for proper examination.”

There are times when it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly. 37 C.F.R. §2.61(b); *see also In re Air Products and Chemicals, Inc.*, 192 USPQ 157 (TTAB 1976); 37 C.F.R. §2.61(b). If applicant does not comply with a requirement for information, registration may be refused. *See* 37 C.F.R. §2.61(b).

Applicant was given opportunities to answer the information requirement. The examining attorney has sufficient grounds for requesting the information given that the application is an intent-to-use application without an allegation of use or specimens. Applicant was asked to simply provide a yes or no answer to the information requirement but failed to do so. Accordingly, the Board should refuse registration of application Serial No 77147075 on these additional grounds.

In determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”).

The term NATIONAL has been held to describe the geographical scope of services. See *In re Nat'l Rent A Fence, Inc.*, 220 USPQ 479 (TTAB 1983) (holding NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); and *Nat'l Fid. Life Ins. v. Nat'l Ins. Trust*, 199 USPQ 691 (TTAB 1978) (holding NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys). The web pages retrieved from applicant's website and attached to the initial office action show applicant providing a directory of chambers of commerce located throughout the nation. Although the web pages do not show use of the mark with the specified services, there is evidence in the record of applicant providing a national directory for chambers of commerce.

Other evidence of applicant's services being national in scope can be determined by reviewing web pages from applicant's website. For example, on the web page with the heading "U.S. Chamber Policy Priorities for 2009 and 2010" attached to the denial of the request for reconsideration dated December 16, 2009, it states that the Chamber's top priority is restoring the nation's economic health. An examination of the specimens submitted with the amendment to allege use by applicant for application Serial No. 77975745 shows applicant providing information about federal or national laws. Specifically, one specimen that includes the heading "A Regulatory Burden: The Compliance Dimension of Regulating CO<sub>2</sub> as a Pollutant," is a report about the costs of emissions to businesses. A closer examination of the summary of the report underneath the heading illustrates the national scope of applicant's services. It states, in relevant part, "[b]ut generally missing from economic analyses to date is inclusion of the

regulatory and bureaucratic costs from complying with and enforcing federal pollution laws should the U.S. Environmental Protection Agency regulate CO2 and other greenhouse gases under the Clean Air Act (CAA).” Another web page specimen with the heading “U.S. Chamber of Commerce Reports and Studies” discusses U.S. trade agreements with Columbia, Panama and South Korea. This evidence demonstrates applicant’s services are national in scope and address national issues as they pertain to businesses.

Applicant’s brief primarily discusses the procedural history of the two applications, however, there are no grounds asserted by applicant for withdrawing the refusals. In its brief, applicant states that the examining attorney was required to show evidence of the wording NATIONAL CHAMBER descriptively used as a phrase in connection with the respective services. (App’s Br. 2-3). Applicant does not cite any case which would support such a requirement. Even if applicant is the first to use a combination of words, it does not mean that the combination is not descriptive. *See In re National Shooting Sports Foundation Inc.*, 219 USPQ 1018 (TTAB 1983). Applicant has not shown why the term NATIONAL in the proposed mark NATIONAL CHAMBER would be perceived as conveying a meaning other than its geographically descriptive meaning.

A mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB

2006) (holding THE BREATHABLE MATTRESS merely descriptive of “beds, mattresses, box springs and pillows”); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services). Such a mark is registrable only if the composite creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (CCPA 1968).

Both of the individual components and the composite result are descriptive of applicant’s services and do not create a unique, incongruous or nondescriptive meaning in relation to the services. The term NATIONAL describes the geographical scope of the services as shown by applicant’s own website pages and specimens, and the term CHAMBER identifies the type of entity that provides the services.

Applicant conceded the descriptive nature of the term CHAMBER in a response to the Section 2(e)(1) refusal issued in the parent application Serial No. 77147075 filed on December 5, 2007. Applicant does not dispute that the term CHAMBER is descriptive of “providing on line directory information services of local and state Chambers of Commerce”. In its response, applicant stated “[i]n the context of those services, the term CHAMBER is admittedly descriptive, which is why Applicant offered the disclaimer.” [*emphasis added*] Applicant’s own admission supports finding the term CHAMBER descriptive in connection with the relevant services in application Serial No. 77147075. It has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term, as applied to the goods or services in

connection with which it is registered, and an acknowledgment of the lack of an exclusive right therein at the time of the disclaimer. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972).

Attached to the office action dated December 16, 2009, are web pages retrieved from applicant's website that show the wording "U.S. Chamber of Commerce" appearing at the top of the web page to the left of the wording "Chamber Directory Search Page" and a map of the United States. Additionally, website pages attached to that same office action show a directory of various chambers of commerce throughout the United States. What is of particular importance as to this evidence is the manner in which each chamber is identified. The wording "State Chamber(s) for your search" appears at the top of the directory search. Each chamber is identified by "Chamber Name" and then the address. This evidence demonstrates that it is common for chambers of commerce to be referred as simply "chambers". Consequently, when one views the wording NATIONAL CHAMBER in connection with the services, they will simply conclude that the term NATIONAL denotes the geographic scope of the services and the term CHAMBER indicates the entity type providing the services.

Other web pages retrieved from the website [www.2chambers.com](http://www.2chambers.com) attached to the initial office action show a national directory of chambers of commerce. Attached to the denial of the request for reconsideration dated December 16, 2009, are web pages showing a "Chamber Find" search engine for locating chambers of commerce in the United States and throughout the world. These web pages demonstrate that directories

of chambers are not uncommon and assisting a person in locating a chamber can be achieved by geographical scope indicators.

There is sufficient evidence in the record which demonstrates that the term CHAMBER is recognized as an entity type. From that evidence, it may be concluded that chambers of commerce are commonly referred to as simply “chambers”. Applicant is identified in the application as The Chamber of Commerce of the United States of America. Attached to the August 12, 2009, office action pertaining to application Serial No. 77975745 is a dictionary definition of the term “chamber” retrieved from [www.yourdictionary.com/chamber](http://www.yourdictionary.com/chamber) on August 12, 2009, taken from taken from *Webster's New World College Dictionary* (2005). The term “chamber” is defined as “a chamber of commerce”. Consequently, it is reasonable to conclude that the term CHAMBER would be perceived by individuals using applicant’s services as an entity designation, like “Co.,” “Corporation,” or “Ltd.”. See *In re JT Tobacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001) (“company” is generic); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984) (the entity designation “INC.” in a trademark has no source indication or distinguishing capacity).

The examining attorney’s arguments, applicant’s own admission, evidence, and case law, all support a finding that the term CHAMBER lacks source-indicating significance. As the Board found in *In re Old Boone Distillery Co.* 172 USPQ 697 (TTAB 1972), a term that describes the provider of goods or services is descriptive. In that case, the Board found that the proposed mark DISTILLER'S LIGHT was merely descriptive of Scotch whisky because it was obvious that the term DISTILLER’S

described the provider of the whisky, not the whisky itself. When the geographically descriptive term NATIONAL is combined with a term that describes the provider, the result is simply the combination of two descriptive terms.

Turning to the services in application Serial No. 77975745, applicant provides analysis of governmental policy relating to businesses and analysis of regulatory activity relating to businesses, all for the purpose of promoting the interests of businessmen and businesswomen; and business data analysis. Web pages retrieved from applicant's website along with specimens submitted by applicant show services that are national in scope and address national policy issues. Other evidence in the record supports a finding that the wording NATIONAL CHAMBER may be perceived as the type of chamber of commerce that provides the services.

Attached to the denial of the request for reconsideration are web pages retrieved from Wikipedia which explain the characteristics of a chamber of commerce. In the entry for "Chamber of commerce," it states chambers of commerce can range in scope from individual neighborhoods within a city or town or up to an international chamber of commerce. The same entry states some chambers have joined national bodies. Attached to the initial office action is a web page retrieved from applicant's website with the heading "Chamber Directory Search Page". Under that heading there is an area on the web page that offers other chambers the means for becoming a member of the U.S. Chamber of Commerce or the national body.

The examining attorney attached to the office action dated August 12, 2009, the following excerpts from the LEXIS/NEXIS database of news articles which illustrate that a common purpose of chambers of commerce is to promote business:

“. . . said Steve McLellan, CEO of the Saskatchewan Chamber of Commerce. ‘Being an ABEX finalist is a testament to a business’ success and as a chamber we work hard to promote these businesses and celebrate their accomplishments’”;<sup>1</sup>

“Singelis said the Flint Area Chamber of Commerce is not trying to be a rival to anyone. The organization is just trying to promote business and strengthen the economy by making sure all businesses are involved in the city’s policies and decisions’”;<sup>2</sup>

“The mission of the Schertz Chamber of Commerce as a non-profit organization is to promote growth and retention of businesses by providing advocacy, training and support to its members’”;<sup>3</sup>

“. . . for the Rancho Cucamonga Chamber of Commerce . . . Proceeds go right back into the business community in a continual effort to promote local businesses and to keep the chamber strong’”.<sup>4</sup>

In supplementing the evidentiary record to show the descriptive nature of the proposed mark, the examining attorney attached to the December 16, 2009, final office action copies of several third-party registrations and a third-party application, all incorporating the words “NATIONAL” and “CHAMBER,” all with disclaimers that

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1 *The Star Phoenix*, April 11, 2009.

2 *Flint Journal*, August 7, 2009.

3 *San Antonio Express-News*, August 6, 2009.

4 *Inland Valley Daily Bulletin*, August 3, 2009.

include the word CHAMBER, some registered under Section 2(f) of the Trademark Act; and one on the Supplemental Register. It is clear that the term NATIONAL was not recognized as an inherently distinctive element in each mark associated with promoting business. Summaries of the third-party registrations and an abandoned application are provided below.

<b>Reg./Serial No.</b>	<b>Mark and Services</b>	<b>Disclaimer</b>
3470754	NATIONAL GAY & LESBIAN CHAMBER OF COMMERCE for “ <u>promoting</u> business for the lesbian, gay, bisexual, and transgender business community in the United States.”	2(f) with a disclaimer of “CHAMBER OF COMMERCE”
77433060 (abandoned)	NATIONAL CHAMBER OF COMMERCE for “administration of an exchange program for small business owners to barter for the goods and services of others to create cross-marketing opportunities.”	2(f) with a disclaimer of “CHAMBER OF COMMERCE”
3600592	NATIONAL FRIENDS OF ANIMALS CHAMBER OF COMMERCE for “chamber of commerce services, namely, <u>promoting</u> business for the animal rights business community in the United States.”	SUPPLEMENTAL with a disclaimer of “CHAMBER OF COMMERCE”
3666086	NATIONAL BLACK CHAMBER OF COMMERCE for “association services, namely, <u>promoting</u> the interests of black owned business.”	2(f) with a disclaimer of “CHAMBER OF COMMERCE”
3249060	NATIONAL US-ARAB CHAMBER OF COMMERCE for “association services, namely <u>promoting</u> the interests of business persons by supporting and strengthening US-Arab business and economic cooperation; organizing and conducting business conferences in the field of economic and business strategies for investment and trade between the US and the Arab world.”	2(f) with a disclaimer of “CHAMBER OF COMMERCE”
3424735	INTERNATIONAL CHAMBER OF E-COMMERCE for “providing on-line <u>directory</u> information services also featuring hyperlinks to other web sites.”	Disclaimer of “INTERNATIONAL CHAMBER OF E-COMMERCE”

These copies of third-party registrations feature services promoting business. Applicant is also engaged in promoting business as indicated its identification of services in application Serial No. 77975745, e.g., “all for the purpose of promoting the interests of businessmen and businesswomen”. The examining attorney asks the Board to treat these registrations as probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

The record establishes that the designation NATIONAL CHAMBER, as a whole, is descriptive of the identified services on multiple levels. When the words NATIONAL CHAMBER are viewed in connection with the services, there is nothing in the mark which is incongruous, nor is there anything which would require gathering further information in order for the merely descriptive meaning to be readily apparent to viewer. *See, e.g., In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043-1044 (TTAB 2007) (“THEATL” held merely descriptive of magazines, newspapers, and directories, since at least one class of relevant purchasers are residents of Atlanta, Georgia, and visitors to Atlanta area.). Contrary to applicant's contention, the combination of the two descriptive words “national” and “chamber” fails to create a new and distinct commercial impression apart from their individual descriptive meanings.

## **CONCLUSION**

In view of the above arguments, applicant's admission, case law and evidence, the wording NATIONAL CHAMBER is merely descriptive of the services. Applicant failed to answer an information requirement under Trademark Rule 2.61(b). Therefore, the examining attorney requests that the Board affirm the final refusals to register the proposed marks on the Principal Register in both application Serial Nos. 77147075 and 77975745.

Respectfully submitted,

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