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

Proceeding	77147075
Applicant	The Chamber of Commerce of the United States of America
Applied for Mark	NATIONAL CHAMBER
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of Service Mark Application

Serial Nos.:	77/147075	:	
	77/975745	:	Int’l. Class 35
		:	
Applicant:	The Chamber of Commerce of	:	
	the United States of America	:	
		:	Ex. Atty: Christopher L. Buongiorno
Filed:	April 3, 2007	:	Law Office 102
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Mark:	NATIONAL CHAMBER	:	

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**APPLICANT’S REPLY BRIEF**

Applicant, The Chamber of Commerce of the United States of America, submits this reply brief in support of its appeal from the Examining Attorney’s final rejections of Application Nos. 77147075 and 77975745 for the mark NATIONAL CHAMBER on the Principal Register.

**REPLY ARGUMENT**

As Applicant pointed out in its opening brief, although the Examining Attorney has repeatedly maintained that the phrase NATIONAL CHAMBER is descriptive for each of the services for which registration is being sought, he has never made clear *what information* about each specific service is supposedly being conveyed by the mark as a whole. *See App. Br.*, pp. 8-

9; *cf. App. Br.*, Exs. A (p. 2), C (p. 2), E (p. 2), G (p. 2), I (p. 2), K (pp. 3-4), Q (p. 2), S (pp. 3-4). Rather than provide that information in his responding brief, however, the Examining Attorney instead takes an improper approach to the issue of descriptiveness. Further, the Examining Attorney fails to explain why Applicant's response to the Request for Information in Serial No. 77147075 was supposedly inadequate. Finally, he raises a new argument in support of his refusal of Serial No. 77975745, which is procedural improper and unsupported by the record.

Applicant will address each of these points in turn.

### **Serial No. 77147075**

#### **A. The Examining Attorney's Piecemeal Approach to the Issue of Descriptiveness Was Improper**

The Examining Attorney's position is that because NATIONAL is recognized as descriptive for services that are national in scope, and because CHAMBER is commonly used to identify a chamber of commerce, the combination of those two words, by definition, must necessarily be descriptive for *any service* that a chamber of commerce may offer on a nationwide basis. *See Ex. Br.*, pp. 8-12 (failing to discuss the differences among the services). This explains why the Examining Attorney in his argument can so easily lump "*providing online directory information services*" in with "*providing information and news in the field of business*" and with "*administration of a discount program*" (the three services at issue in Serial No. 77147075) and simply claim that NATIONAL CHAMBER is merely descriptive for all of these disparate services, and for the same exact reason. *See id.*, p. 12 (arguing generally that when consumers "view[] 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"). There is no logical support, however, for this position. Simply put, one may not dissect a mark into its elements and base a

descriptiveness refusal on the supposed descriptive meaning of each of those elements in the absence of evidence that consumers would continue to ascribe those same descriptive meanings to the words when they are later reassembled into the mark as whole and used for the services.

Put another way, the flaw in the Examining Attorney's analysis of Serial No. 77147075 is as follows. Although it may be true that the word NATIONAL alone can in some situations describe a characteristic of a service (namely, that it is offered nationwide), the word CHAMBER tells consumers something about the *source* of that service (that the source is likely to be a chamber of commerce). *Accord Ex. Br.*, p. 12. And when a consumer encounters those two words *together*, he or she is unlikely to view the mark as a whole as *simultaneously* conveying descriptive information about both the service *and* the source. Consumers' minds are not that schizophrenic. Any meaning a consumer would ascribe to the NATIONAL component when encountering it *within the mark as a whole* must "fit" in with the meaning they would give the CHAMBER element. Otherwise they would be combining linguistic apples and oranges.<sup>1</sup>

It would be different, of course, if both terms individually conveyed complementary descriptive information about the service. In such a case, it would be proper to aggregate the meanings in a descriptive analysis even without evidence that the mark as a whole is descriptive. *Accord* TMEP, § 1209.03(d); *see also, e.g., In re Gould Paper Corp.*, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (the mark SCREENWIPE informs consumers that the product is a "WIPE" for a "SCREEN"). So, for example, NATIONAL BUSINESS UPDATE would be descriptive for "*providing information and news in the field of business*" because BUSINESS UPDATE

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<sup>1</sup> From a grammatical standpoint, this necessary relationship between the words stems from the fact that NATIONAL is an adjective that *modifies* the CHAMBER noun. Thus, NATIONAL would be perceived by consumers as providing additional information about whatever it is that CHAMBER is supposedly describing. And here, the phrase NATIONAL CHAMBER as a whole identifies Applicant, which used the name "National Chamber" for "association services" for roughly ninety years. *See*, U.S. Reg. No. 1436813 (*App. Br.*, Ex. H).

describes the type of service, while NATIONAL indicates that the service is offered nationwide.<sup>2</sup> Similarly, if the proposed mark in its entirety was the generic name for the entity providing the services—say, CHAMBER OF COMMERCE—then it too would be merely descriptive because consumers would understand that the phrase merely identifies the type of entity providing the service, as opposed to denoting a specific source. Neither situation, however, is applicable here.

Also, it appears that the Examining Attorney was led astray in part because he mistakenly assumed that “CHAMBER” is an “entity designation,” similar to “‘Co.,’ ‘Corporation,’ or ‘Ltd.’,” and that, as an entity designation, it therefore “has no source indication or distinguishing capacity.” *See Ex. Br.*, p. 13 (emphasis added) (citing *In re JT Toacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984)); *see also Ex. Br.*, pp. 12 (claiming that “CHAMBER indicates the entity type”). This mistake is also evidenced by the Examining Attorney’s reliance on cases such as *In re Hotels.com, L.P.*, 91 USPQ2d 1532 (Fed. Cir. 2009), and *In re Oppendahl & Larson LLP*, 71 USPQ2d 1370 (Fed. Cir. 2004), *see Ex. Br.*, p. 8, in which the “.COM” designator was essentially ignored during the descriptiveness analysis, much like the entity designations “INC.” and “CORP.” *See, e.g., Oppendahl & Larson*, 71 USPQ2d at 1373; *accord* TMEP, §§ 1209.03(d), (m).

The word CHAMBER, however, is not an “entity designation” like .COM, INC., or CORP, and it cannot be treated as such. To be sure, when the word CHAMBER is used in the context of certain association services, it undoubtedly is most often understood by consumers to refer to a “chamber of commerce” (although when used with musical performances, one would think of a “chamber orchestra”), and in many cases it must be disclaimed during prosecution,

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<sup>2</sup> Or, to use an example from the Examining Attorney’s brief, *see Ex. Br.*, pp. 11-12, if the mark was CHAMBER FIND for an online search engine for chambers of commerce, that too would be descriptive because FIND says what the search engine does and CHAMBER identifies what it is trying to “find.” Both words therefore provide complementary descriptive information about the *service*, which is unlikely the situation presented here.

such as was done here when the directory services were amended to refer to “*featuring information regarding local and state Chambers of Commerce.*”<sup>3</sup> In that respect, however, CHAMBER is no different than scores of other terms that describe the *nature* of an entity, such as MUSEUM, UNION, AIRLINE, BOOKSTORE, RESTAURANT, or MALL. Cf. TMEP, § 1209.03(d) (identifying “Corporation, Corp., Co., Inc., Ltd” as the only examples of “entity designators”). That is, CHAMBER does not merely inform consumers that the source of the services is a corporate entity (as opposed to true designators, such as CORP. or INC.), it tells consumers something *about* the entity, thereby potentially making it source identifying.

Here, the mark in its entirety is NATIONAL CHAMBER, which is a name Applicant first used in connection with the provision of association services back in 1915, *see* U.S. Reg. No. 1436813 (*App. Br.*, Ex. H), and which it continues to use today in a variety of forms, including for the NATIONAL CHAMBER FOUNDATION and the NATIONAL CHAMBER LITIGATION CENTER. *See* U.S. Reg. Nos. 2892713 and 2804476 (*App. Br.*, Ex. H). The use of NATIONAL CHAMBER in connection with the services for which registration is being sought thus refers to Applicant.<sup>4</sup> The mark as a whole does not tell consumers anything about the services offered other than that Applicant—known by many as the “National Chamber”—happens to be the *source* of those services. That, however, is the essence of what a trademark is supposed to do. The Examining Attorney’s dissection of the mark into its component parts is insufficient to support a refusal on the grounds that the mark as a whole is merely descriptive.

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<sup>3</sup> The Examining Attorney highlights the fact that Applicant offered a disclaimer of CHAMBER in connection with “*providing online directory service featuring information regarding local and state Chambers of Commerce s.*” *Ex. Br.*, p. 10. However, the fact that Applicant recognized that it cannot claim exclusive right to the word CHAMBER for services that provide “information regarding ... Chambers of Commerce” (*cf.*, *e.g.*, n.2, *supra*) is not an acknowledgment that NATIONAL CHAMBER *as a whole* is descriptive for those services.

<sup>4</sup> The Examining Attorney never suggested during prosecution, nor could it be established anyway, that “NATIONAL CHAMBER” is generic as identifying a *type* of chamber of commerce. *See also* pp. 7-8, *infra*.

**B. The Examining Attorney Offers No Argument as to Why Applicant’s Response to the Request for Information Was Supposedly Insufficient**

As discussed in Applicant’s opening brief, Applicant responded to the Examining Attorney’s request for information in Serial No. 77147075<sup>5</sup> as clearly as it could. To recap, in response to the Examining Attorney’s question as to whether Applicant intended to “use the proposed mark in connection with a national directory of chambers of commerce,” Applicant reaffirmed that it intended to offer services that fell within the scope of the identification then at issue in its intent-to-use application, which included “*providing online directory information services featuring information regarding local and state Chambers of Commerce.*” See *App. Br.*, pp. 11-12, Ex. H. Consequently, if the service of providing “a national directory of chambers of commerce” (which was a vague description and not an accepted identification) could fairly be regarded as being included within the scope of Applicant’s services, Applicant’s answer was a “yes.” On the other hand, if offering a “national directory of chambers of commerce” was *not* covered by Applicant’s recitation, then the question was irrelevant and required no response.

The Examining Attorney responds by claiming that there was “nothing ambiguous” in his request. See *Ex. Br.*, pp. 6-7. Tellingly, though, the Examining Attorney fails to address the key question of *why* Applicant’s response was supposedly inadequate in the first place.

If the Examining Attorney believed that the propounded hypothetical service of “[providing] a national directory of chambers of commerce” was subsumed within the actual recitation of services then in place (which would be necessary for the request to be relevant to

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<sup>5</sup> Although the Examining Attorney suggests that his request as to whether “applicant [will] use the proposed mark in connection with a national directory of chambers of commerce” was applicable the *entirety* of Serial No. 77147075, see *Ex. Br.*, p. 8, in point of fact the request could only logically have pertained to the first of the three Class 35 services for which registration was being sought—namely, “*providing online directory information services featuring information regarding local and state Chambers of Commerce.*” Clearly, the request could have no bearing on the examination of the other services at issue in the application—namely, “*providing information and news in the field of business*” and “*administration of a discount program.*”

examination), then Applicant’s response that it intended to use the mark in connection with the services set forth in the intent-to-use application could only be interpreted as a “yes” to the question posed. *See App. Br.*, Ex. H; *see also* TMEP, § 1402.07(a) (it is presumed for examination purposes that an applicant is using (or intends to use) a mark for all of the services covered by an identification). Applicant, however, could not simply answer “yes”/“no” to this type of inquiry because an applicant can never be sure exactly how it will use a mark until *it actually uses it*.<sup>6</sup> Nonetheless, unless the Examining Attorney was asking an irrelevant question, he received all of the information he needed to conduct the examination.

### **Serial No. 77975745**

#### **A. The Examining Attorney Has Improperly Raised a New Argument in Support of the Descriptiveness Refusal in Serial No. 77975745**

The argument the Examining Attorney made during prosecution of Serial No. 77975745 in support of his descriptiveness refusal was very similar to the one he advanced with respect to Serial No. 77147075. Specifically, the Examining Attorney argued that NATIONAL identified “services that are nationwide in scope” and that CHAMBER separately identified “[A]pplicant’s entity type.” *See App. Br.*, Exs. Q (p. 2), S (p. 4). The one twist was that the Examining Attorney further claimed that CHAMBER was separately descriptive of the services because it was supposedly “a term used in connection with promoting a cause.” *Id.*, Ex. S (p. 4).

The primary basis for the Examining Attorney’s refusal has already been addressed above, and the secondary basis (“promoting a cause”) is addressed below. In his brief, however,

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<sup>6</sup> Further to this point, Applicant submits that an applicant with an intent-to-use application should not be required to commit to a specific use of a mark before it has commenced actual use. After all, what if an applicant believes that it is not going to use the mark for some subset of services (although it continues to intend to use the mark for the services themselves) but later *changes* its mind after allowance? Would the presumption of validity afforded by registration be suspect in a later proceeding because of the “change” in the scope of use? Given that it is presumed for examination purposes that an applicant is using (or intends to use) a mark for all of the services covered by an identification, *see, e.g.*, TMEP, § 1402.07(a), there should be no need to ask such a question.

the Examining Attorney seems to advance a new argument—namely, that NATIONAL CHAMBER is supposedly generic for identifying a “type of chamber of commerce.” *See Ex. Br.*, p. 14. However, not only should this be ignored as procedurally improper, *see, e.g.*, 37 CFR 2.142(d); TMEP, §§ 704.01, 706, it is inaccurate. For some ninety years Applicant has used the mark NATIONAL CHAMBER for chamber of commerce services, and for a little less than twenty of those years, that use was subject to an incontestable registration that carried with it the presumption that the mark was not generic. *See* U.S. Reg. No. 1436813 (*App. Br.*, Ex. H); 15 U.S.C. 1115(b). There is simply no evidence to support the Examining Attorney’s presumption that NATIONAL CHAMBER would be perceived as a “type of chamber of commerce.”

**B. The Examining Attorney’s Argument About the “Purpose” of a Chamber of Commerce is Irrelevant to Descriptiveness**

Finally, the Examining Attorney suggests that the word CHAMBER, in addition to being an “entity designation,” *see Ex. Br.*, p. 12; *accord App. Br.*, Ex. S (p. 4), is also descriptive for the services at issue in Serial No. 77975745 (which covers “*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*”) because the record supposedly shows that “CHAMBER [is] a term used in connection with promoting a cause.” *App. Br.*, Ex. S (p. 4); *see also Ex. Br.*, pp. 14-17. The Examining Attorney’s contentions in this regard, however, are irrelevant to the descriptiveness issue.

To begin with, of course, even under the Examining Attorney’s approach, this “purpose” refusal is limited to the services of “*analysis of governmental policy data*,” as the services of “*business data analysis*” contain no such purpose restriction. More fundamentally, though, the relevant question is not whether CHAMBER is *used* in the names of organizations that promote certain purposes, but whether the word conveys information *about the purpose* of the services.

The Examining Attorney does not suggest that CHAMBER (let alone NATIONAL CHAMBER) describes the purpose of “*analysis of governmental policy data.*” After all, the purpose of that services is not “chamber”; it is, as stated, “*to promote the interests of businessmen and businesswomen.*” And although many chambers of commerce with “CHAMBER” in their names may promote the same goals, the word CHAMBER itself does not *describe* the goals. Rather, as the references cited by Examining Attorney made clear, *see App. Br.*, Ex. Q, the word “chamber” simply means, among other things, a “chamber of commerce.”

Thus, the fact that the purpose of one of the proposed services may be “a common purpose of chambers of commerce,” *see Ex. Br.*, p. 5, does not automatically render the term CHAMBER (or, for that matter, CHAMBER OF COMMERCE) merely descriptive for any services that are designed to promote that purpose. Were this not so, then the term CHAMBER (along with MUSEUM, UNION, and any other generic term used to refer to a specific type of organization) would be *de jure* descriptive for all services if those services could be seen as promoting the same purposes as the organization (which is what one would expect, for why else would an organization provide such services?), which is a position not supported by the law.

Turning now to the Examining Attorney’s listing of third-party applications and restrictions—which, Applicant notes, the Examining Attorney only added to the record in his final refusal and were not relied on by the Examining Attorney during prosecution for the point he is attempting to make here; *compare App. Br.*, Ex. S (pp. 2-3) *with Ex. Br.*, pp. 15-17—it must be noted that none of these records is even remotely relevant to the question at hand. For example, each of the references the Examining Attorney identified as being for services that “promote” a particular purpose (specifically, U.S. Reg. Nos. 3470754, 3600592, 3666086, and 3249060) (*see Ex. Br.*, p. 16) is for “chamber of commerce service” or for “association services”

(which is closely related to “chamber of commerce” services; *cf.*, *e.g.*, U.S. Reg. No. 1436813 (*App. Br.*, Ex. H)). Thus, it is hardly surprising that CHAMBER OF COMMERCE was disclaimed in each of those records and that each mark as a whole (despite the inclusion of NATIONAL) was found to be merely descriptive. (After all, the mark NATIONAL GAY & LESBIAN CHAMBER OF COMMERCE aptly describes *chamber of commerce* services that are for the purpose of promoting *gay and lesbian* interests on a *nationwide* basis) (*cf.* pp. 3-5, *supra*).

Here, however, the services are “*analysis of governmental policy data*” and “*business data analysis*”—not “chamber of commerce services”—and in that context NATIONAL CHAMBER does not describe the services at all. If the mark was NATIONAL ANALYSIS or some other combination of words where each word described the services and the consumer would recognize those words in combination in the mark as a whole as continuing to retain those same meanings, then it would likely be descriptive. *Accord* pp. 3-5, *supra*. However, that is not the case here, nor is that the case in connection with any of the services at issue in Serial No. 77147075. The mark NATIONAL CHAMBER as a whole does not immediately convey any information about an ingredient, quality, characteristic, function, feature, purpose, attribute, or use of any of the services for which registration is being sought. As such the mark should not have been considered to be merely descriptive, and the refusal should be reversed.

Respectfully submitted,

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