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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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Date	03/09/2011

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

In the Matter of Service Mark Applications

Serial Nos.:	77/147075	:
	77/975745	:
Applicant:	The Chamber of Commerce of the United States of America	:
Filed:	April 3, 2007	:
Mark:	NATIONAL CHAMBER	:

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

NOTICE OF APPEAL

Pursuant to 37 CFR § 2.145, Applicant, The Chamber of Commerce of the United States of America, respectfully gives notice that it appeals to the United States Court of Appeals for the Federal Circuit that portion of the January 10, 2011, decision of the Trademark Trial and Appeal Board in which the Board affirmed refusals to register U.S. Serial Nos. 77/147075 and 77/975745 for the mark NATIONAL CHAMBER under Section 2(e)(1) of the Trademark Act (15 USC § 1052(e)(1)). A copy of the Board's decision is attached hereto. The Board consolidated proceedings involving the two referenced applications on February 23, 2010.

A copy of this Notice of Appeal is simultaneously being filed in triplicate with the Clerk for the United States Court of Appeals for the Federal Circuit, along with payment of the fee(s)

required under Federal Circuit Local Rule 52. Pursuant to 37 CFR § 2.145(b)(3) and 37 CFR Part 104, a copy of this Notice of Appeal is being sent by certified or registered mail to the Office of General Counsel for the United States Patent and Trademark Office, in addition to being filed directly with the Board using the Board's online ESTTA system.

Respectfully submitted,

KENYON & KENYON LLP

Dated: March 9, 2011

By: /William M. Merone/
Edward T. Colbert
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Counsel for Applicant

Attachment

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
January 10, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Chamber of Commerce of
the United States of America

Serial No. 77147075
Serial No. 77975745

William M. Merone, Edward T. Colbert, and Erik C. Cane of
Kenyon & Kenyon LLP for The Chamber of Commerce of the
United States of America.

Christopher L. Buongiorno, Trademark Examining Attorney,
Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Seeherman, Cataldo and Ritchie, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

The Chamber of Commerce of the United States of
America ("applicant"), filed an application on the
Principal Register for the mark NATIONAL CHAMBER, in
standard character format, for services ultimately
identified as "providing online directory information

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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 as it relates to and can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services; 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"¹ in International Class 35. The trademark examining attorney refused registration on the ground that applicant's mark is merely descriptive of the identified services under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The examining attorney further issued a final refusal for applicant's

¹ Application No. 77147075, filed April 3, 2007, based on applicant's assertion of a *bona fide* intent to use the mark in commerce under section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant offered a disclaimer of the exclusive right to use the term "COMMERCE" apart from the mark as shown, limited to the following services: "Providing online directory information services featuring information regarding local and state chambers of commerce." Office practice does not allow the printing of anything other than standard form disclaimers. Apparently the examining attorney did not discuss the acceptability of applicant's disclaimer because of his position that the mark as a whole is merely descriptive, and therefore a disclaimer of a portion of the mark would not obviate the refusal. We do not discuss the acceptability of the "limited" disclaimer herein, as it is not at issue on appeal.

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failure to furnish information as required under Rule 2.61(b); 37 C.F.R. § 2.61(b).

Applicant later filed a request to divide its application in order to place in a "child" application the International Class 35 services of "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."² The trademark examining attorney refused registration of this application also on the ground that applicant's mark is merely descriptive of the identified services under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

Applicant appealed the final refusals in both cases, and the Board consolidated them, since they contain common questions of law and fact. Both applicant and the examining attorney filed briefs, and applicant filed a reply brief.

² Application No. 77975745. As the child application, this retains the filing date of the original, April 3, 2007. However, at the time applicant requested that the application be divided, it amended the "child" application to assert as the filing basis, section 1(a) of the Trademark Act; 15 U.S.C. § 1051(a), alleging dates of first use and first use in commerce of December 7, 2006.

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2(e)(1) refusal

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

Whether a term 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. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, 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);

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See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

We consider a composite mark in its entirety. If the individual components of a composite mark are descriptive, the composite is registrable only if it has a non-descriptive meaning. The examining attorney made of record a dictionary definition of "chamber," and we have taken judicial notice of the word "national":³

NATIONAL: Of, relating to, or belonging to a nation as an organized whole. *American Heritage Dictionary* (4th ed. 2000).

CHAMBER: A council or board; a chamber of commerce. *Yourdictionary.com*.

Applicant admitted in its brief that "national" is descriptive of services that are "nationwide in scope," citing TMEP § 1209.03(o). (appl's brief at 8). Applicant further admitted that "chamber" is commonly used to refer to a "chamber of commerce." *Id.* Definitions of "chamber of commerce" include the following:

³ 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); and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

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CHAMBER OF COMMERCE: An association of businesspersons and merchants for the promotion of commercial interests in the community. *American Heritage Dictionary (4th ed. 2000)*.

CHAMBER OF COMMERCE: A form of business network, e.g., a local organization of businesses whose goal is to further the interests of businesses. *Wikipedia*.

CHAMBER OF COMMERCE: An association of businesspeople to promote commercial and industrial interests in the community. *Merriam-Webster*.

The examining attorney cited several third-party registrations as evidence that the terms "NATIONAL" and "CHAMBER" are merely descriptive of the services for which applicant seeks registration. In particular, the examining attorney submitted a half-dozen third-party registrations that contain the term "NATIONAL" and either "CHAMBER" or "CHAMBER OF COMMERCE" for "association," "business," or "directory" services, wherein the terms were disclaimed, the mark as a whole was registered with a Section 2(f) claim of acquired distinctiveness, or it was registered on the Supplemental Register. To counter this point, applicant submitted its own registrations for "NATIONAL CHAMBER" (now cancelled), and "NATIONAL CHAMBER FOUNDATION," for "association services, namely promoting the interests of businessmen and businesswomen," and

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disclaiming only "FOUNDATION."⁴ However, we note that in another registration for the same services, for the mark NCF NATIONAL CHAMBER FOUNDATION and design, applicant disclaimed both "NATIONAL" and "FOUNDATION."⁵

Regardless of the evidence presented by either applicant or the examining attorney, neither third-party registrations nor applicant's own registrations are conclusive on the question of descriptiveness. Each case must stand on its own merits. A mark that is merely descriptive should not be registered on the Principal Register simply because other marks that share some characteristics with it appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977) ("we are not so much concerned with what has been registered, but rather what should or should not be registered"). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Nett*

⁴ Registration No. 2804476. We note that applicant's now cancelled registration is not evidence of anything except that it issued. See TBMP §704.03(b) (2d ed. rev. 2004) and cases cited therein. See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act, were lost when the registration expired. See, e.g., *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973). Applicant also submitted a few registrations that it said were from "affiliate entities."

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Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

Unsurprisingly from the identification of services, applicant's own website shows that it offers a "national" network for "chambers" of commerce. Indeed, applicant's own name is "The Chamber of Commerce of the United States of America." Applicant's website offers the following as search tools and images for those seeking information about local and state chambers of commerce:

⁵ Registration No. 2947298.

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Chamber Directory Search Page

Learn how your Chamber of Commerce can [become a member](#) of the U.S. Chamber of Commerce and take advantage of benefits, discounts and other offers available exclusively to members.



Search By: (select ONE)

Chamber Name:

Address:

City:

State:

Zip:

State Chambers

Accredited (what is an [Accredited Chamber?](#))

SEARCH ALPHABETICALLY BY NAME

[A](#) [B](#) [C](#) [D](#) [E](#) [F](#) [G](#) [H](#) [I](#) [J](#) [K](#) [L](#) [M](#) [N](#) [O](#) [P](#) [Q](#) [R](#) [S](#) [T](#) [U](#) [V](#) [W](#) [X](#) [Y](#) [Z](#) [Other](#)

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Applicant's website also offers a directory of information including a national network of local and state chambers of commerce:



Accordingly, it is clear that a consumer would immediately understand NATIONAL CHAMBER, used in connection with applicant's services, namely, "providing online

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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 as it relates to and can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services" as well as "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," as conveying information about them. See *In re Tower Tech Inc.*, 64 USPQ2d at 1316-17.

It takes no mental leap to understand that applicant is using the mark for the services in both applications as a national chamber of commerce, whether promoting the interests of businesspersons or industry on a national level, or connecting local chambers of commerce through a nationwide network.

Accordingly, we affirm the refusals to register under 2(e)(1).

Requirement for Information

The examining attorney further issued a final refusal in Application No. 77147075 for applicant's failure to

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furnish information as required under Rule 2.61(b); 37 C.F.R. § 2.61(b). Specifically, the examining attorney issued an information requirement asking applicant, "Will applicant use the proposed mark in connection with a national directory of chambers of commerce?" Applicant responded as follows:

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 as it relates to and 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.

Applicant could certainly have been more forthcoming, and responded more directly to the examining attorney's "yes or no" question, rather than simply repeating the services set forth in its identification. However, because the services specifically include "providing directory information services" and since such services would encompass a national directory, in this case we deem applicant's response to have satisfied the information request.

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Decision: We deem the requirement for information to be satisfied in Application No. 76487556. However, we affirm the refusals to register for both applications under Section 2(e)(1).