

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

Hearing:
June 14, 2001

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Collen IP Intellectual Property Law, P.C.

Serial Nos. 77513717 and 77513748

Jess M. Collen and Audra Kemp of Collen IP Intellectual Property Law, P.C. for Collen IP Intellectual Property Law, P.C.¹

Zachary R. Bello, Trademark Examining Attorney, Law Office 111 (Robert Lorenzo, Managing Attorney).

Before Seeherman, Walters and Kuhlke, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Collen IP Intellectual Property Law, P.C. has appealed from the final refusals of the trademark examining attorney to register A BRAND NAME LAW FIRM in standard characters for "legal services,"² and A BRAND NAME ADVISOR in standard

¹ Mr. Collen and Ms. Kemp have identified themselves as the attorneys for the applicant. We note that their firm actually is the applicant.

² Application Serial No. 77513717, filed July 2, 2008, based on Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (intent-to-use). The mark as depicted on the drawing of the application

characters for "business consultation services, namely, product and marketing evaluation; advertising services, namely, creating corporate and product identity for others; creating trademarks for others."³ Registration of both marks has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that each mark is merely descriptive of the respective services. Because of the similarity of the marks, issue and evidence, one oral hearing with respect to both appeals was held, and we decide both appeals in this single opinion.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be

is shown in upper and lower case letters: A brand name law firm. However, we have followed our normal style for depicting standard character trademarks by showing the mark in all upper case letters.

³ Application Serial No. 77513748, also filed on July 2, 2008, based on an asserted bona fide intention to use the mark in commerce. Again, although the mark is depicted in the application as A brand name advisor, we have shown the mark in all upper case letters in this opinion.

considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). 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 the 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, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

There are certain preliminary matters that pertain to both appeals that we must discuss.

In the examining attorney's briefs he states that on December 11, 2009 he advised the Board that applicant's notices of appeal were untimely. However, as applicant

points out in its reply briefs, "the record does not reflect any notification of December 11, 2009 to the Board regarding the timeliness of Applicant's Appeal." p. 5. In reviewing the files, we note that the examining attorney issued a final Office action in each application on April 13, 2009, and therefore a notice of appeal, to be timely, should have been filed by October 13, 2009. On October 8, 2009 applicant filed requests for reconsideration, each of which included the statement that "The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration." However, there is no indication in the Office records that applicant did, in fact, file notices of appeal at that time. On October 30, 2009, the examining attorney denied applicant's request for reconsideration. The prosecution history in the Office's electronic file database includes an entry on October 30, 2009 of "action continuing final." On November 18, 2009, at a point where the applications should have been deemed to be abandoned for failure to file a timely notice of appeal, applicant's attorney had an interview with Craig Taylor, the then-managing attorney of the law office handling the applications, and Mr. Taylor, according to applicant's report of the conversation as set forth in the requests for reconsideration filed November 9, 2009,

indicated that applicant could submit the supplemental evidence that applicant's attorney presented to Mr. Taylor and file appeals with the Board. Office records show that on November 19, 2009, applicant filed a notice of appeal for each application through the Board's electronic ESTTA filing system, and the system automatically generated an order instituting each appeal and remanding the application to the examining attorney. The ESTTA filing system will not accept an untimely appeal. While it is unclear how the time for filing the appeal was extended, the Office has treated the appeals filed on November 19, 2009 as timely.

Second, applicant has objected to new evidence set forth in the examining attorney's briefs. This evidence is not actually attached to the briefs, but is reported as part of the text in the briefs. To the extent that the evidence consists of dictionary definitions, we grant the examining attorney's request that we take judicial notice of them. 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).⁴

⁴ The better practice in such a situation is that the examining attorney submit the printout or copy of the dictionary definition, rather than merely including it as text in the brief. However, we note that applicant also, in its March 23, 2009 response, provided dictionary definitions as part of the text of

However, in his briefs the examining attorney has also, for the first time, quoted excerpts from various third-party websites. This material was never properly made of record during the examination of the applications, nor is it proper matter for judicial notice. See TBMP § 1208.04 (3d rev. 2011). The examining attorney has also referred for the first time in his briefs to certain third-party registrations which were never made of record. No consideration has been given to the website material or the third-party registrations. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal).

Third, in both appeal briefs, applicant refers to a "requirement of the disclaimer in this case." Briefs, p. 14. However, a requirement for a disclaimer of BRAND NAME is not an issue in these appeals. The sole ground for refusal is that the applied-for marks as a whole are merely descriptive, not that a portion of each mark is merely descriptive and must be disclaimed.

We now turn to the substantive ground for refusal of the applications, namely, whether the marks are merely descriptive of the respective services. We consider first

its response, rather than submitting printouts of the definitions.

the application for A BRAND NAME LAW FIRM for legal services. It is the examining attorney's position that the mark is merely descriptive because "brand name" is a feature, characteristic, function or purpose of applicant's legal services, that the additional term "law firm" also describes the legal services, and that when these elements are combined in the phrase A BRAND NAME LAW FIRM the entire mark is merely descriptive.

In support of his position, the examining attorney has submitted, inter alia, definitions of "brand-name" and "law firm," and webpages advertising applicant's services. These webpages depict the phrase "Intellectual Property Law" under "COLLEN IP" and list, among applicant's various activities, defending a client's trademark, bringing a trademark infringement claim, and managing over 3,000 trademarks.

There is really no issue that A BRAND NAME LAW FIRM describes legal services, in that it directly tells consumers that a major characteristic of the legal services rendered by applicant involves the protection of brand names or trademarks. Applicant acknowledges that it is "a firm that practices the law of Brand Names (Trademarks)." Response filed March 23, 2009. "Applicant's firm provides services across a wide range of fields, such as ...trademark

law..., and litigation in all of these disciplines." Brief, p. 4. "To the extent that Applicant is an Intellectual Property law firm, with a long history and active practice in Trademark Law, Applicant acknowledges that it is a Trademark Law Firm, or a Brand Name Law Firm." Brief, p. 12. Thus, applicant does not dispute that this meaning of its mark is descriptive.

However, applicant contends that its mark is registrable because the mark is a double entendre. The second meaning asserted by applicant is that "brand name" means "well known or premier" and that "to say that one is a 'Brand Name [fill is the blank]'" is to say that one is notable or famous in a particular field." Id. Applicant has submitted a definition of "brand name," taken from Merriam-Webster OnLine, www.merriam-webster.com, as meaning "one having a well-known and usually highly regarded or marketable name."⁵ Applicant contends that the term "BRAND NAME, in addition to being synonymous with 'trademark,'

⁵ See also the following definitions submitted by applicant and the examining attorney: From Dictionary.com (based on Random House Dictionary (2009))--"1. having or being a brand name; *nationally known brand-name food products*; 2. *Informal*. Widely familiar; well-known: *Several brand-name personalities will be performing at the benefit*"; From dictionary.infoplease.com (based on Random House Unabridged Dictionary (1997))--"3. *Informal* a person who is notable or famous, esp. in a particular field: *The reception was replete with brand names from politics and the arts.*"

[has] another prominent meaning, 'widely familiar,' which also means 'well-known,' 'notable, famous'" and "'household name.'" Response filed October 8, 2009. As a result, applicant asserts that its mark connotes "the standard in the industry." Id.

The evidence submitted by applicant shows that the term "brand name" is used in the manner indicated by the latter definitions of "well-known" or "notable," to, as characterized by applicant, "identify an article, place, person or thing that is famous, or a 'household word.'"

Brief, p. 5. See, for example:⁶

Aggressive newcomer Hayden vs. brand-name
politician Toplikar [title]
Prime buzz, The Star, October 28, 2008
KansasCity.com

Theater Review-"Kentucky Cycle" Makes Impression
on Broadway

⁶ In past decisions the Board has criticized applicants and examining attorneys for "dumping" evidence into the record without specifically identifying the most relevant evidence in their briefs. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). Despite this, applicant has submitted over 100 pages of evidence taken from various websites without highlighting the specific pages or portions of the articles that it considered relevant. In fact, in its brief, applicant stated only that "[t]he common understanding of the term 'BRAND NAME' is also evidenced in the news excerpts submitted for the record by the Applicant." Brief, p. 7. Applicant is advised that the Board considers such "dumping" of evidence to be unhelpful and a waste of the Board's time as the Board must search through these pages to find anything relevant, and to guess at what applicant may consider to be particularly useful. "The Board frowns equally upon an applicant or examining attorney submitting hundreds of pages of evidence in the hope that, as the Board wades through it we will find something that is probative." *In re Max Capital Group Ltd.*, 93 USPQ2d at 1246.

...your only brand-name actor is Stacy Keach...
Los Angeles Times, February 3, 1992

... as Eugene McCarthy, a brand-name politician,
learned when he ran as an independent in 1976...
The New York Observer, July 24, 2008
Observer.com

Berkshire Is Still a Brand Name [title]
[article about Berkshire Hathaway]
The New York Times, April 30, 2009
www.nytimes.com

Well, you start with the fact that there isn't a
brand-name actor in the young, good-looking crew.
BusinessWeek, January 18, 2008
www.businessweek.com

Seattle FAI arthroscopy surgeons [title]
I found no fault in the other two Seattle
surgeons, but after meeting Dr. Johnston I was
quite confident that I didn't need to spend
\$7,500 for a brand-name surgeon to fix my hip.
June 2, 2009
<http://help4hips.com>

The entire family gathered at Sloan-Kettering in
the office of a brand-name surgeon—the greatest
in America," a "top man," people said.
Thelma & Marie
Vogue [sic], March 2000

He's a Brand Name: Mike Winter [title]
Pharmacists around the world know him as author
of the ever popular textbook *Basic Clinical
Pharmacokinetics*, soon to be in its fifth edition
and published in English, Spanish and Japanese.
At the UCSF School of Pharmacy students know him
not only as author, but also as top-notch
teacher. His colleagues know him as leader,
mentor, adviser and citizen. Patients and
physicians at the UCSF Medical Center know him as
an exceptional clinician.
Pharmacy Alumni Association Alumni Voice,
Spring 2009

It is well-established that if a mark is a double entendre, that is, has two meanings, one of which is descriptive but the second one is not, then the mark is not merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act. Applicant has cited a number of cases in which this principle has been applied. For example, in *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mark SUGAR & SPICE was found not merely descriptive of bakery products because, although the words sugar and spice describe ingredients in the products, the mark also evokes the phrase "sugar & spice and everything nice" in the nursery rhyme. And in *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965), the mark NO BONES ABOUT IT for ham not only described that the ham was boneless, but also had the connotation of the commonly used phrase "no bones about it."

Although applicant has argued that its mark is also a double entendre like the foregoing, we disagree. As noted, in the double entendre cases in which a mark has been found to be not merely descriptive, it is because it has a second, non-descriptive meaning. However, in the present case A BRAND NAME LAW FIRM does not have a non-descriptive meaning. On the contrary, the evidence submitted by applicant shows that "brand name" also means someone or

something of repute or renown. Applicant has said as much: "The term 'a brand name law firm,' has another meaning, which is that a firm is well-known," and "a household name law firm" or "a first-rate law firm." Response filed October 8, 2009.

Thus, A BRAND NAME LAW FIRM, when used in connection with legal services, has not only the meaning of a law firm that specializes in brand name or trademark law, but a law firm that is known or has a good reputation. In fact, applicant's evidence shows that the term "brand name" is used in this manner in connection with doctors and pharmacists and companies, and the term would be immediately understood as having the same meaning when applied to a law firm, i.e., that the law firm itself has a notable reputation, or is highly regarded or well known. Thus, although applicant's mark has a second meaning, it is a laudatory descriptive one, and whichever meaning that one would ascribe to the mark, it is merely descriptive of the identified legal services.

We note that applicant has argued that the examining attorney's assertion, made for the first time in his brief, that the second meaning of applicant's mark is laudatorily descriptive is a "new ground for refusal," and that the application should be remanded to the examining attorney

for further examination "in order to determine whether the additional ground for refusal should be withdrawn or made final." Reply brief, p. 6. However, the examining attorney's argument that the second meaning of applicant's mark is laudatory is not a new ground for refusal. The ground for refusal throughout examination has been that the mark is merely descriptive under Section 2(e)(1) of the Act. The examining attorney is not precluded from raising, during appeal, new arguments in support of a ground for refusal which was timely raised and is a subject of the appeal. See TBMP § 1217. Applicant has certainly had the opportunity to argue, and has in fact argued throughout its prosecution of the application, that its mark is suggestive. It is also applicant who has asserted, throughout prosecution, that the mark means that the law firm is well-known, and that this is a desirable trait, see response filed October 8, 2009. While applicant asserts that this meaning is suggestive rather than descriptive, applicant's statements reflect applicant's recognition that this meaning of the mark is laudatory. In any event, even if the examining attorney had not made the argument that the mark has a laudatory descriptive meaning, the Board may rely on a different rationale from that argued by the examining attorney. Id. In other words, regardless of

whether the examining attorney had argued that the second meaning for the mark is laudatorily descriptive, we can still make such a finding in determining that the mark is merely descriptive.

As mentioned above, applicant argues that the second meaning of its mark is only suggestive, not descriptive. However, because of the evidence that "brand name" is used in a laudatory manner to describe people or companies recognized in their respective fields, we find that A BRAND NAME LAW FIRM conveys, in addition to the meaning of a firm that specializes in brand names or trademarks, a second laudatory descriptive meaning that the law firm is well known or highly regarded.

Applicant has also pointed to several third-party registrations for marks which include the term BRAND NAME in which this term was not disclaimed, and which were not registered under Section 2(f), arguing that these registrations support its position that the term "brand name" is not to be viewed as merely descriptive. There are several problems with this argument. First, given applicant's statements arguing against a requirement for a disclaimer, see discussion supra, it appears that these registrations may have been cited for a point that is not at issue in this appeal. More importantly, applicant seeks

to register not BRAND NAME per se, but A BRAND NAME LAW FIRM. It is not just the words "brand name" that the examining attorney asserts are merely descriptive, but the phrase as a whole. As opposed to the mark at issue herein, the marks in the third-party registrations include non-descriptive material, so that the entire marks are not merely descriptive. Further, the third-party registrations are for what appear to be slogan marks, e.g., MARSHALLS BRAND NAMES FOR LESS EVERY DAY and MAKING THE WORLD SAFE FOR BRAND NAMES. Slogans are considered to be unitary marks and Office practice is that they should not be broken up for purposes of requiring a disclaimer. See TMEP § 1213.05(b). We note that one of the third-party registrations submitted by applicant, No. 1869907, is for a word and design mark, where the phrase THE BRAND NAME appears to be separate from the other wording (PRS and 1st AND STILL BEST). However, the phrase THE BRAND NAME does not appear to describe the identified services, but appears to relate to the other words in the mark, such that the examining attorney may have treated it as a slogan. In any event, this single registration is insufficient to demonstrate that Office practice is inconsistent with respect to disclaimers of the term BRAND NAME, nor does it in any way show that applicant's mark is not descriptive.

In short, we find that the mark A BRAND NAME LAW FIRM immediately conveys that the identified legal services are performed by a firm of lawyers that specialize in trademarks and, to the extent that consumers would understand the mark to convey a double entendre or second meaning, that meaning is laudatorily descriptive. Because both meanings of the mark are descriptive, the mark is merely descriptive. Accordingly, we affirm the refusal of registration of this mark.

This brings us to a consideration of applicant's mark A BRAND NAME ADVISOR for "business consultation services, namely, product and marketing evaluation; advertising services, namely, creating corporate and product identity for others; creating trademarks for others."

The examining attorney has submitted the same evidence as to the meaning of "brand name" that he submitted in the application for A BRAND NAME LAW FIRM. He also submitted definitions of "advisor," including "one who gives advice," Dictionary.com, based on Random House Dictionary (2009). Also of record is an excerpt from the website for Investment Marketing Inc., www.investmentmarketing.com:

We create intelligent and uncommon marketing strategies for each firm we work with—strategies that are unique to your firm, built on competitive advantages that differentiate you from others. We establish you as "brand name"

advisor, a specialist in untapped but remunerative niche markets, and build a compelling narrative to communicate the benefits of your expertise and services to pre-qualified audiences.

The evidence submitted by applicant is the same as that submitted in the application for A BRAND NAME LAW FIRM, which has been set forth previously in this opinion.

Again, there is no real dispute that one meaning of A BRAND NAME ADVISOR is descriptive of the services.

Applicant has acknowledged that "brand name" is a synonym for "trademark." Response filed March 23, 2009.

Applicant's identified services include "creating trademarks" and "creating product identity"; in effect, advising on trademarks or brand names. Applicant "does not dispute that it gives advice, among other things, in the field of brand identity," response filed October 8, 2009; that "Applicant's services include advising on issues of trademark adoption and use," brief, p. 4; and "acknowledges that it is a Trademark Law advisor, or a Brand Name advisor." Brief, p. 12.

The question, then, is whether applicant's mark has a second, non-descriptive meaning such that it would not be merely descriptive of the identified services. In this connection, applicant argues that the mark

suggests that Applicant's services are "brand name," that is to say, "premier," as opposed to generic or "run of the mill." In the vernacular, to say that one is a "Brand Name" is to say that one is notable or famous in a particular field.

Brief, p. 6.

The examining attorney contends that the mark is not a double entendre "because its descriptive significance as to commercial impression is more powerful down [sic] double entendre." Brief, unnumbered p. 5. We interpret this as saying that the connotation of the mark describing that applicant provides advising services regarding brand names so dominates the mark that consumers will not view the mark as having any other meaning. To the extent that the examining attorney is correct, and that consumers will not understand the mark to have a second meaning, the mark is merely descriptive of brand name or trademark advising services, since to them the mark would not have a double entendre.⁷ On the other hand, if consumers understand the second meaning of the mark as premier advising services or an advisor who is notable or well known, then the mark is laudatorily descriptive.

⁷ The examining attorney made a similar argument in connection with the mark A BRAND NAME LAW FIRM: "the double entendre is not apparent in anyway." Brief, unnumbered p. 5. However, because one would normally refer to a firm that specializes in trademark law by the generic term "a trademark law firm," rather than "a brand name law firm," we find that consumers will recognize the double entendre for this mark.

We acknowledge that applicant asserts, with respect to this second meaning, that its mark is suggestive rather than descriptive, but we are not persuaded by this argument. The evidence submitted by applicant, and the dictionary definitions, show that "brand name" has the recognized meaning referenced in applicant's statement, quoted above, i.e., that the services are premier or performed by an advisor that is notable. Applicant itself states that the "definitions articulate well the term 'BRAND NAME' used in the sense of notability, or fame," and that "[t]he common understating of the term 'BRAND NAME' is also evidenced in the news excerpts submitted for the record by the Applicant." Brief, p. 7. To the extent that consumers consider the phrase A BRAND NAME ADVISOR to have a second meaning, this laudatory descriptive meaning will be readily conveyed, such that consumers will immediately understand that the mark describes applicant's services as trademark advice being rendered by a highly regarded or well-known advisor.

Applicant has made essentially the same arguments in connection with its appeal of the refusal of A BRAND NAME ADVISOR as it did with A BRAND NAME LAW FIRM, and our comments with respect to those arguments are equally

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applicable here. In short, we do not find applicant's arguments to be persuasive.

In conclusion, although we agree that applicant's marks A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR have a double entendre, because both meanings for the respective marks are descriptive of the respective services, the marks are merely descriptive, and prohibited from registration by Section 2(e)(1) of the Trademark Act.

Decision: The refusals of registration of application Serial Nos. 77513717 and 77513748 are affirmed.