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2955U.000002 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77821445

MARK: FOR THE INJURED



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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: Gordon & Doner, P.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

2955U.000002

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's refusal to register the word mark FOR THE INJURED, the evidence submitted under Section 2(f) of the Trademark Act not establishing acquired distinctiveness of the term as a mark registrable on the Principal Register. 15 U.S.C. section 1052(f).

FACTS

On September 11, 2009 the applicant filed an application to register the term FOR THE INJURED in Standard word format, for legal services. Registration was refused under the provisions of Section 2(e)(1), on grounds that the term merely described the group to whom the services were directed—injured parties. The applicant responded on June 21, 2010, asserting a claim of distinctiveness based on length of use of the mark in commerce, under the provisions of 37 C.F.R. 2.41(b), and a declaration stating annual advertising expenditures by the applicant in promoting the term as a mark, under the

provisions of 37 C.F.R. section 2.41(a). The Examining Attorney rejected such a claim, based on the nature of the term. On February 4, 2011, the applicant made a further claim of acquired distinctiveness under Section 2(f), based on affidavits, stating that the term was recognized as a mark for the applicant. Again, the evidence was rejected, and a Final refusal was issued.

The Examining Attorney issued a subsequent Final refusal on March 12, 2011, introducing further evidence of common use of the term FOR THE INJURED by other parties in the legal profession.

On September 29, 2011, the applicant appealed the Final refusal, and filed a Request for Reconsideration, which was granted by the Trademark Trial and Appeal Board.

Jurisdiction was restored to the Examining Attorney. The Request for Reconsideration was denied, and the application was returned to the Trademark Trial and Appeal Board for resumption of the appeal.

ARGUMENTS

I. PROPOSED MARK IS HIGHLY DESCRIPTIVE FOR IDENTIFIED SERVICES

Registration of the term FOR THE INJURED is refused under the provisions of Section 2(e) (1) of the Trademark Act, on grounds that this term is commonly used descriptively in the legal profession.

Research shows that third parties in applicant's field use the same or substantially the same wording in a descriptive or informational manner, indicating that the mark is at

least highly descriptive. TMEP section 1212.01. Use of the term FOR THE INJURED in association with legal services is not unique to the applicant but rather, is frequently used by many third party legal practitioners to identify the type of clientele to whom the services are offered—injured parties, usually in accident or negligence cases. The Examining Attorney has produced over 10 Internet websites of legal firms around the United States, including the state of Florida, where the applicant is located, which use the term “ for the injured” in a descriptive or informational manner:

WELCOME TO ARNDT LAW—LEGAL SERVICES FOR THE INJURED
(Office Action of 4/12/11, p.2)

THE MULLIGAN LAW FIRM—NATIONALWIDE HELP FOR THE
INJURED AND
THEIR FAMILIES Office Action of 4/12/11, p.4)

ABOUT STEIGERWALT & ASSOCIATES We are here to Provide
Nationwide Legal
Assistance for the Injured and Their Families Throughout the Country (Office
Action of
4/12/11, p.8)

THE NATION LAW FIRM—Legal Help for the Injured (Office Action of
4/12/11,pp
10-11)

McCARDELL & ASSOCIATES Vancouver Personal Injury Law-Legal
Services for the
Injured (Office Action of 4/12/11, p.18)

WARREN McGRAW Fighting for the Injured & Disabled (Office Action of
4/12/11,
p.16)

JOSEPH SMITH, LTD. Attorneys for the Injured (Office Action of
4/12/11,p.17)

LEGAL CENTER FOR THE INJURED (Office Action of 4/12/11, p.19)

J. STANFORD MORSE, P.A. We Speak for the Injured. (Office Action of 4/12/11, p.22)

THE FRICKEY LAW FIRM Comprehensive Legal Services for the Injured (Office Action of 4/12/11, p.25)

ATTORNEYS FOR THE INJURED Seeking Justice for the Injured (Office Action Of 4/12/11, p.26)

While the applicant asserts that such third party use of the term FOR THE INJURED is informational in nature, unlike the applicant's use of the term in relation to its promotion of legal services, an examination of the applicant's specimen of record shows little, if any, distinction in display of the phrase FOR THE INJURED from that of the third party law firms listed above.

Finally, the applicant has made of record several third party registrations containing the term FOR THE INJURED as part of the mark:

ANSWERS FOR THE INJURED (Reg. No. 2,865,998)

JUSTICE FOR THE INJURED (Reg. No. 2,779,624)

TRAINED BY INSURANCE COMPANIES, FIGHTING FOR THE INJURED (Reg. No. 3,863,850)

While the applicant introduced this material to demonstrate that descriptive marks containing the term FOR THE INJURED are registrable, the Examining Attorney asserts that such documents, in which the term FOR THE INJURED appears in registered marks owned by different parties, clearly shows that such terminology is commonly used in the legal field, and has little, if any significant source origin impact in the field. All parties have registered different marks containing this term, FOR THE INJURED, with little

comment either by the Office, or by other legal firms, regarding confusion as to source origin of marks containing this term. Therefore, it would be implied that this phrase, FOR THE INJURED, is regarded as a common descriptive term, freely used among the legal profession to identify, not source of origin, but the group to whom such legal services are offered. The applicant has also included in the record specimens from the files for these three registrations. See Applicant's Request for Reconsideration, 10/12/2011, pp. 15-29. It is maintained that such usage of the term by these parties is highly similar to that of the applicant in its specimen of record. As such, the term may be regarded as "highly descriptive" within the industry, requiring a substantial amount of evidence to establish a claim of distinctiveness as a source origin indicator of legal services to any one party. In its brief on Appeal, the applicant argues that, since the cases cited by the examining attorney analyzing the "highly descriptive" nature of marks dealt with terms incapable of registration or not functioning as marks, the general rules or interpretations of case law were inaptly applied or mis-analysed. However, courts have consistently held that, while particular cases may be inapplicable, based on different **factual situations**, such cases may be used to consistently apply **general rules or interpretations of such rules**. **(emphasis added)** The examining attorney asserts that the cases introduced interpreting general case law regarding the burden of proof of a party to establish acquired distinctiveness **are apt and correctly applied, with respect to the general rules or case law interpretation of such rules**. See: *Faultless Starch Co. v. Sales Producers Associates Inc.*, 530 F.2d 1400, 189 USPQ 141 (C.C.P.A. 1976); *Curtice-Burns Inc. v. Northwest sanitation Products Inc.*, 520 F. 2d 1376, 200 USPQ 54 (TTAB 1979).

II. APPLICANT HAS NOT MET BURDEN OF SUPPORTING 2(f) CLAIM

For procedural purposes, a claim of distinctiveness under Section 2(f) may be construed as conceding that the matter to which it pertains is not inherently distinctive and thus not registrable on the Principal Register absent proof of acquired distinctiveness *In re Cabot Corp.*, 15 USPQ2d 1224,1229 (TTAB 1990). Whether acquired distinctiveness has been established is a question of fact *In re Loew's Theatres, Inc.*, 167 F. 2d 945,949, 122 USPQ 375 (C.C. P. A. 1959). The amount and character of evidence required to establish distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered *In re Gammon Reel, Inc.*, 227 USPQ 729,730 (TTAB 1985). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984).

III. EVIDENCE INSUFFICIENT TO ESTABLISH ACQUIRED DISTINCTIVENESS

The applicant claims acquired distinctiveness of the term FOR THE INJURED, based on length of use of the term in relation to its services (over a decade, 2001-2012), a separate showing of evidence consisting of advertising expenditures, affidavits from third parties asserting the source origin function of the term as unique to the applicant and its legal services, and claim of ownership of a companion application, Registration No. 3,195,410, TRIAL LAWYERS FOR THE INJURED for legal services.

However, the Examining Attorney asserts that such evidence is insufficient to establish the applicant as the unique source origin indicator of the term FOR THE INJURED with respect to legal services.

A). Evidence of Length of Use/ Advertising and Promotional Expenditures:

An allegation of five years use alone will be insufficient evidence of distinctiveness where terms are seen as highly descriptive of the goods or services. *In re Kalmbach Pub'l'g Co.*, 14 USPQ2d 1490 (TTAB 1989). The evidence of applicant's claimed significant advertising expenditures of over \$6 million dollars spent since use of the term to promote recognition as a mark is not dispositive of whether the proposed mark has acquired distinctiveness; such material is merely indicative of its efforts to develop distinctiveness, not evidence that the mark has acquired such distinctiveness. *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). **It should also be noted that the applicant appears to have not submitted any evidence (photographs, flyers, and other promotional material apart from the specimens of record) demonstrating how the term is promoted as a mark to the relevant consuming public. (While the affidavits mention such advertising by billboard, radio ads, bus ads and television ads, no examples of such usage is of record, other than the affidavit statements themselves).**

B). Affidavits of Consumer Recognition:

The key test in establishing a successful claim of acquired distinctiveness is the effectiveness of the advertising and promotional efforts among the relevant customers. *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978). However, the value of the affidavits or declarations depends on the statements made and the identity of the affiant

or declarant See: TMEP section 1212.06 (c). Notably there is no documentation from the group to whom the services are primarily directed: injured members of the general public, which would demonstrate that, within the relevant field of users, the term FOR THE INJURED functions as a source origin indicator. Rather the applicant has submitted four declarations, two from chiropractic practitioners, one from a public accountant, and one from a practicing attorney. Substantively, all documents make the same statements: based on specific advertising of the applicant of the term FOR THE INJURED, the term is immediately identified as issuing from the applicant's law firm. However, it is believed that, since no evidence of the applicant's actual forms of promotion or advertisement is of record or part of the affidavits, such statements are of minimal value.

Moreover, it is believed that, despite \$6 million worth of promotion and advertisements over a decade of business, the four affidavits of record are insufficient to demonstrate "general consumer recognition". Proof of distinctiveness requires more than proof of a relatively small number of people who associate the term as a primary source indicator.

Poselux Chemical Co. v. Parsons Ammonia Co. Inc., 132 USPQ 627 (C.C.P.A. 1962).

There are no articles from bar associations or other legal organizations, local newspapers or other types of organizational publications recognizing use of the term FOR THE INJURED as a mark with a specific source origin. No awards or other statements of recognition of the applicant's services to clients under the term FOR THE INJURED has been made of record. Such a small amount of de facto recognition is not enough to show that the term FOR THE INJURED has become entitled to registration as a mark on the Principal Register. *In re Personal Counselors Inc.*, 184 USPQ 761 (TTAB 1975).

C). Reliance upon Applicant's Prior Registration:

Finally, the applicant asserts that ownership of Registration No. 3,195,410, for the mark TRIAL LAWYERS FOR THE INJURED for legal services, on the Principal Register, is “highly probative of whether the mark has acquired distinctiveness and may **obviate the necessity of determining distinctiveness**” (emphasis supplied) Applicant’s Brief on Appeal, p. 8. However, it is believed that this statement is inaccurate in determining registrability of a term under Section 2(f). The applicant appears to be stating that, since a companion application has registered on the Principal Register, such a fact would obviate any necessity of determining distinctiveness of the same or similar mark for the same goods or services. However, based on the holding in *In re McDonald’s Corp*, 230 USPQ 304 (TTAB 1986), a term which is not inherently distinctive based on provisions of Section 2 requires a claim of secondary meaning, regardless of the strength of the term based on ownership of prior registrations for the same term, in which distinctiveness has been established for those registered marks alone.

Does applicant’s ownership of the claimed registration entitle it to claim acquired distinctiveness under the provisions of Section 2(f)? Existence of such registrations “for the same mark” may, at the discretion of the examining attorney, support a claim of acquired distinctiveness for another mark; however, if the term is “highly descriptive” as is the case in the current instance, the examining attorney may require additional evidence of distinctiveness. *In re Loew’s Theatres, Inc.*, 769 F.2d 764,769, 226 USPQ 869 (Fed. Cir.1985). In this instance, ownership of the prior registration does not establish acquired distinctiveness. The Examining Attorney asserts that such a mark is not “the same mark” as the one in issue. Ownership of the mark TRIAL LAWYERS FOR THE INJURED on the Principal Register does not establish that a portion of the

mark sought to be registered, the words FOR THE INJURED, by itself, is demonstrated to have acquired distinctiveness. Obviously, any evidence made of record in the cited registration, dealing with a mark different from the one in issue, would only support a finding of distinctiveness for that mark, TRIAL LAWYERS FOR THE INJURED; such evidence would not address registrability of a portion of such a mark, FOR THE INJURED. Therefore, since the marks are not the “same”, ownership of Registration No. 3,195,410 does not mandate registration of another mark, even if portions of such a mark appear in the registration document. Trademark Rule 2.41(b); 37 C.F.R. section 2.41(b); TMEP section 1212.04(b).

The applicant likens this situation to the one found in *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712,1713 (TTAB 2011), where the Trademark Trial and Appeal Board held that ownership by the applicant of two incontestable registrations of the same or similar mark were sufficient to allow registration of the recognized acronym NKJV, for bibles. However, the factual situations in this case are different: in *Thomas Nelson*, the marks in issue were , for all intents and purposes, identical: the acronym NKJV, a registration for the same letters NKJV in stylized format, and a registration for the acronym NKJV and the words defining the acronym ,“ New King James Version”. The marks and the commercial impressions generated by the marks were identical or highly similar. In this case, the term FOR THE INJURED is NOT the same mark, or even similar to the registrant’s mark of TRIAL LAWYERS FOR THE INJURED. Moreover, to date, there is no information in the Patent and Trademark Office databases to indicate that the claimed registration is now incontestable, as was the case in *Thomas Nelson*.

In this case, the mark in the current application and applicant's mark in Registration No .3,195,410 are significantly different in sound, appearance and meaning and evoke different commercial impressions. As such applicant's reliance on its prior registration is misplaced.

In sum, applicant's approximately 11 year's use of the mark, together with its advertising and affidavits, fail to establish acquired distinctiveness of the highly descriptive wording FOR THE INJURED.

CONCLUSION

For these reasons, the evidence of record fails to show that the highly descriptive wording FOR THE INJURED has acquired distinctiveness in connection with applicant's legal services. Accordingly registration is refused under Trademark Act Section 2(e)(1) and applicant's claim of acquired distinctiveness under Section 2(f) is insufficient to obviate the refusal.

Respectfully submitted,

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