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

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Applicant	Gordon & Doner, P.A.
Applied for Mark	FOR THE INJURED
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re

Serial Number 77/821,445

Filing Date: September 9, 2009

Gordon & Doner, P.A.
(A Florida Corporation, U.S.)

for the mark "FOR THE INJURED"

On Appeal from the United States
Patent and Trademark Office

REPLY BRIEF FOR THE APPELLANT

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ARGUMENT

The Examining attorney maintains that the Applicant has not provided enough evidence to show that the mark has acquired distinctiveness, asserting that the phrase "for the injured" is highly descriptive, and, as such, an extraordinary amount of evidence is needed in order to show that the mark has become distinctive. In support of this assertion, the Examiner claims that the phrase is "a common descriptive term" freely used by the legal profession. However, the Examiner's use of this terminology is not a proper basis for his conclusion that the applied-for mark is "highly descriptive." The relevant test for determining whether a mark is highly descriptive is whether there is frequent usage by third parties in the applicant's field of the *same or substantially the same mark*. Here, there is not frequent usage by third parties of the same or substantially the same wording as the proposed mark. Accordingly, the mark is not highly descriptive. Moreover, the "general case law" used by the Examiner was improperly applied and the Applicant properly applied the rules found in *In re Thomas Nelson*. Therefore, the evidence submitted is certainly sufficient to show that the mark has acquired distinctiveness.

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The terminology "common descriptive term" or "common descriptive name" is used to define generic names, not merely descriptive marks or highly descriptive marks. TMEP 1209.01(c)(iii) provides that there is no distinction between "generic" names and "apt or common descriptive" names and therefore the terminology must be consistently used in refusals issued against purported generic terms. The Examining attorney has not claimed that the applied-for mark is generic. Rather, the Examiner has asserted that the applied-for mark is "merely descriptive" and thus eligible for consideration under Section 2(f). Therefore, the Examiner's claim that the applied-for mark is a "common descriptive term" is inappropriate.

Secondly, the Examiner has not applied the correct test to determine whether the mark is highly descriptive. The Examiner claims that the mark is highly descriptive because it is "frequently used by third party legal practitioners to identify the ***type of clientele to whom the services are offered.***" (emphasis added) However, what tends to indicate that a mark is highly descriptive is frequent usage by third parties in Applicant's field of the *same or substantially the same mark*. TMEP 1212.01.

Here, the Examiner has provided 13 examples of third party websites using the term "for the injured" in a descriptive manner. However, none of the examples provided by the Examiner show use of

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the term in the same or substantially the same manner as Applicant uses the term. Instead, in every example provided by the Examiner, the term "for the injured" is used with other words or phrases, such as "Welcome to Arndt Law - Legal Services for the Injured," "The Mulligan Law Firm - Nationwide Help for the Injured and their Families," "We are Here to Provide Nationwide Legal Assistance for the Injured and Their Families Throughout the Country," "Legal Help for the Injured," "Legal Services for the Injured," "Fighting for the Injured & Disabled," etc.

The complete sentence "We are here to provide nationwide legal assistance for the injured and their families" is not substantially the same as the phrase "For The Injured" alone. Similarly, the phrase "fighting for the injured and disabled" is not substantially the same as Applicant's "For The Injured." The only similar example provided by the Examiner is "Attorneys for the Injured." However, only 2 websites out of the 13 examples use this phrase in this manner. Even if the Board were to find that these examples are substantially the same as Applicant's use of the phrase, merely 2 examples of third party use is certainly not "frequent use" to support a finding that Applicant's mark is highly descriptive.

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Additionally, Applicant notes that many of the uses of the phrase are not even displayed prominently on the websites. If one can even locate the term "for the injured" in the following examples provided by the Examiner, one would readily notice that the term is insignificantly displayed:

STEIGERWALT & ASSOCIATES

TOPICS | HOME | ABOUT US | BREAKING NEWS

Home Page
About Our Firm
How To Get Help
Nationwide Legal Network
Chemical Exposure
Criminal Law
Defective Drugs
Defective Products
Medical Devices
Medical Malpractice
Occupational Disease/
Toxic Torts
Personal Injury
Other Types of Cases
Sitemap

About Steigerwalt & Associates

Home » About Our Firm

We are Here to Provide Nationwide Legal Assistance for the Injured and Their Families throughout the Country.

Contact us today if you or a loved one are in need of legal help

About our Law Firm - Nationwide Legal Assistance

Steigerwalt & Associates is one of the most successful and prestigious law firms in the country. Our firm is nationally recognized as a leader in civil litigation and sets the pace for competition to follow.

THE MULLIGAN LAW FIRM
A NATIONAL LAW FIRM

Home | Areas of Practice | About The Firm | Verdicts & Settlements | Our Commitment to You | For Att

The Mulligan Law Firm - Nationwide Help for the Injured and Their Families

The Mulligan Law Firm provides legal information and resources for injured individuals and their families in all 50 States.

Drug Injuries

- Actos® Side Effects
- Botox®
- Fosamax® Femur Fractures
- Levaquin® Tendon Ruptures
- Reglan® Tardive Dyskinesia
Lawyers / Attorneys
- Statins: Diabetes & Cardiomyopathy
- Topamax® Side Effects
- Yaz® / Yasmin®
- Zolof® and SSRI Birth Defects

Medical Devices

- CALAXO® Screw Injuries

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The screenshot displays the homepage of The Frickey Law Firm. At the top left, there is a call to action: "Call 303-237-7373 today! 303-59-LEGAL". The firm's logo, a stylized 'F' and 'L' in red, is prominently displayed above the name "THE FRICKEY LAW FIRM". To the right, a city skyline at night is featured with the tagline "Dependability. Dedication. Experience." Below this, a navigation menu lists various legal services: CAR ACCIDENTS, OTHER MOTOR VEHICLE ACCIDENTS, OTHER PERSONAL INJURY MATTERS, CATASTROPHIC AND FATAL ACCIDENTS, SOCIAL SECURITY DISABILITY, and WORKERS' COMPENSATION. A "CONTACT US" section provides the firm's address (1400 18th Street, Lakewood, CO 80214) and phone numbers. A "CHAT LIVE ONLINE NOW" button is visible, along with social media icons for Facebook and LinkedIn. The bottom of the page features a "SuperLawyers" badge and a "PeerReviewRated" badge. On the right side, there is a form titled "INJURED? NEED HELP?" with fields for Name, E-mail Address, Phone, and a description of the legal issue. A "submit" button is located below the form.

On the other hand, Applicant's specimen of record shows the mark displayed in a completely different manner. First of all, the phrase is immediately recognizable as a stand-alone term on Applicant's website, it being strategically placed directly beneath Applicant's household name, and in a place where the eye naturally travels first when viewing the page. In addition, the mark is being used prominently in bold white lettering against a dark blue background, rather than three quarters of the way down the page in small type, with other words:

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Considering the foregoing, Applicant is puzzled by the Examiner's statement: "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." There is a significant difference between prominent use of the term alone in bold type and insignificant use of the term, in small print with other words, especially considering that the test for highly descriptive marks requires "frequent use of the same or substantially the same mark." TMEP 1212.01. Therefore, the third party use of the phrase is of very little value in determining how descriptive Applicant's mark is.

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Furthermore, the fact that others use the phrase "for the injured" to describe the persons to whom services are directed does not dictate that the mark is highly descriptive. TMEP 1209.03 (i) states: "[a] term that identifies a group to whom the applicant directs its services is merely descriptive." Applicant admittedly uses the mark "for the injured" in connection with legal services directed to those individuals that are injured. Thus, it appears that Applicant's mark falls squarely within this category of marks. As a practical matter, the fact that some use a descriptive term to describe something, despite one's ability to obtain registration under Section 2(f) in that same term is implied from the rule. Descriptive marks, by definition, describe. The rule isn't that a mark may acquire distinctiveness in a descriptive term *only if no one else uses that term* to describe the related goods or services. The rule is that a descriptive mark may acquire distinctiveness if the mark comes to identify not only the goods/services but the source of those goods/services. TMEP § 1212. If the former were the case, no mark could ever acquire distinctiveness.

In fact, it has long been held that descriptive words may become trademarks and subject to protection as such, without inhibiting the use of the same words in a non-trademark sense. *In re Automatic Mfg. Co.*, 56 C.C.P.A. 817, 404 F.2d 1391, 160

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U.S.P.Q. (BNA) 233 (1969); *In re Seats, Inc.*, 757 F.2d 274, 225 U.S.P.Q. (BNA) 364 (Fed. Cir. 1985); *Henri's Food Prods. Co., Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 2 U.S.P.Q. 2d (BNA) 1856 (7th Cir. 1987); *In re Reynolds Metals Co.*, 480 F.2d 902 (C.C.P.A. 1973). For example, in *In re Seats*, the court found that registration of the term "seats" for ticket reservation services would still allow competitors to advertise "seats are available," "balcony seats," "reserve your seats through us," etc.

In addition, this case can be analogized to the facts in *Hunter Publishing Co. v. Caulfield Publishing, Ltd.*, 1 U.S.P.Q. 2d (BNA) 1996 (T.T.A.B. 1986). In *Hunter*, the applicant attempted to register the mark "SYSTEM USER" for use in connection with periodic trade journals sold to users of computer systems. Despite findings that the applicant's mark described the type of individuals to whom its goods were directed, that the phrase "systems user" was actually used in the relevant field to describe those individuals, and that there was no direct evidence that the purchasing public recognized the mark as identifying the applicant's publication, the Board held that the mark had acquired distinctiveness, based on 5 years of continuous use and 34,000 circulations. *Id.*

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Here, the facts are comparable, but are even more in favor of finding acquired distinctiveness. Applicant is attempting to register the term "For The Injured" for legal services directed in part to injured individuals. The term "For The Injured," albeit not alone, is sometimes used in the relevant field to describe those individuals. However, unlike the term "SYSTEMS USER," which is the exact term used to refer to the applicant's consumers in *Hunter*, one would not use the term "for the injured" to refer to Applicant's clients. Instead, one would use the term "injured parties" or "injured individuals." Accordingly, Applicant's mark is even less descriptive than the mark in *Hunter*. Moreover, Applicant has submitted significantly more evidence of acquired distinctiveness than that submitted in *Hunter*. Therefore, Applicant has met its burden.

The Examiner also argues that he has aptly and correctly applied the authorities, finding terms incapable of acquiring distinctiveness, for his general proposition that more evidence of acquired distinctiveness is required here. In support, the Examiner claims that the general rules of case law apply, despite the fact that the cases applying those general rules are distinguishable. However, it is common knowledge in the practice of law that general rules mean very little without analyzing the facts and findings leading to the application of those rules.

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The difficulty with the rules the Examiner cites to arises because determining the amount of evidence needed to show that a mark has acquired distinctiveness entirely depends on how descriptive a mark is. *In re Gammon Reel, Inc.*, 227 U.S.P.Q. (BNA) 729, 730 (T.T.A.B. 1985). If a case stands for the proposition that more evidence of distinctiveness is required, one must look to the mark in question to determine how descriptive the mark is. If the mark was held to be incapable of registration, then it logically follows that no amount of evidence would have overcome a descriptive refusal. How then, can these cases be used to raise the standard to that which is impossible, while still claiming that Applicant can reach that standard?

Moreover, Applicant respectfully points out that the Examiner has again mischaracterized the cases he cites to in support of his claim that these general rules apply. In *Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 U.S.P.Q. (BNA) 141 (C.C.P.A. 1976), the court stated clearly that, in trademark law, ultimate conclusions must be drawn from all probative facts in evidence in each individual case and that "[t]here is no litmus rule which can provide a ready guide to all cases and each evidentiary element may from case to case play a dominant role." *Id.* (internal citations omitted).

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What's even more baffling is the case *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 530 F.2d 1396, 189 U.S.P.Q. (BNA) 138 (C.C.P.A. 1976), to which the Examiner also cites in support of his claim, where the court rejected the Appellant's reliance on a general rule from a prior case because the factual differences in that case made that rule completely inapplicable. Although Applicant concedes that there are general rules to apply broadly to different fact scenarios, those rules must in fact be applicable. Applicant re-asserts that the cases the Examiner cites, purportedly to stand for the proposition that "additional evidence of acquired distinctiveness was needed," are not on point. To the contrary, ample evidence *has* been submitted in this case.

Lastly, the Examiner claims that the case *In re Thomas Nelson*, 97 U.S.P.Q. 2d (BNA) 1712 (T.T.A.B. 2011) is distinguishable from this case because the marks in that case were essentially identical. However, the marks in that case were not identical. The proposed mark was the standard character mark "NKJV." The applicant in that case owned two prior registrations: "NKJV" and design and the standard character mark "NKJV NEW KING JAMES VERSION." The marks "NKJV" and "NKJV NEW KING JAMES VERSION" are clearly not identical. In addition, the registered design mark was not found to be identical to the proposed mark.

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Moreover, the registered design mark containing the letters "NKJV" was not the deciding factor in the case. Rather, the holding of that case was: If an applicant has one or more prior federal registrations under 2(f) for a different depiction of the same mark or *one that comprises in part the subject of the proposed mark for the same goods/services*, the prior registrations are probative and may obviate the necessity of determining acquired distinctiveness of the proposed mark. *In re Thomas Nelson, Inc.*, 97 U.S.P.Q. 2d (BNA) 1712, 1713-18 (T.T.A.B. 2011); TMEP § 1212. Therefore, the *Thomas Nelson* case does in fact support Applicant's assertions that its prior registered mark is highly probative in determining acquired distinctiveness.

For the reasons set forth above, the Appellant respectfully requests that the Examiner's determination that Applicant's evidence of acquired distinctiveness is insufficient to overcome the 2(e) refusal of the mark "FOR THE INJURED" be reversed.