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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Gordon & Doner, P.A.

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Serial No. 77821445

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Carl J. Spagnuolo of McHale and Slavin, P.A. for Gordon & Doner, P.A.

Henry S. Zak, Trademark Examining Attorney, Law Office 117 (Brett J. Golden, Managing Attorney).

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Before Taylor, Wellington, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On September 8, 2009, applicant Gordon & Doner, P.A. filed an application to register on the Principal Register the mark FOR THE INJURED (in standard character form) for “legal services,” claiming as its date of first use of the mark anywhere and in commerce January 1, 2001. The examining attorney initially refused registration on the ground that the mark is merely descriptive of the recited services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Applicant responded by claiming acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). When the refusal was made final on both the

grounds that the mark is merely descriptive of the identified services and that applicant had submitted insufficient evidence to show acquired distinctiveness, applicant appealed and requested reconsideration. On December 14, 2011, the examining attorney denied the request for reconsideration, and the appeal was subsequently resumed. Applicant and the examining attorney have filed briefs and applicant has filed a reply brief.

Issue on Appeal

As a preliminary matter, as stated above, the examining attorney finally refused registration of applicant's mark FOR THE INJURED as merely descriptive and because applicant's evidence of acquired distinctiveness is not sufficient. We point out that when an applicant responds to a refusal based on mere descriptiveness of a mark, or portion of a mark, by claiming acquired distinctiveness, such amendment to seek registration under Section 2(f) of the Trademark Act is considered an admission that the proposed mark is not inherently distinctive. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990). However, when a claim under Section 2(f) is presented in the alternative, it does not serve as an admission of mere descriptiveness. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). In this case, applicant did not claim acquired distinctiveness in the alternative. Accordingly, the Section 2(e)(1)

refusal is moot, and the only issue before us on appeal is whether applicant has established that its mark has acquired distinctiveness.¹

Applicant's Evidence

The burden of establishing that a mark has acquired distinctiveness is on the applicant. *See Yamaha Int'l Corp.*, 6 USPQ2d at 1006; *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 949, 122 USPQ 372, 375 (C.C.P.A. 1959). “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11, 214 USPQ 1, 4 n.11 (1982).

Applicant has submitted the following evidence that its mark FOR THE INJURED has acquired distinctiveness under Trademark Action Section 2(f):

1. A declaration from applicant's Managing Partner, Robert Gordon, dated June 15, 2010 stating in part that applicant's mark has become distinctive of its services through at least five years of substantially exclusive and continuous use, and through “extensive expenditures of advertisement in television, radio, billboards, newspapers, magazines, excessive of One Million Dollars annually. In 2010, Applicant anticipates spending \$1,900,000 in advertising the applied for mark.”
2. A certificate of registration and claim of ownership of the prior-registered mark TRIAL LAWYERS FOR THE INJURED for legal services (Registration No. 3195410).
3. Four declarations (from an attorney, a Certified Public Accountant, and two Doctors of Chiropractic) stating that the declarants recognize the phrase “For the Injured” from applicant's advertising, and that the phrase immediately identifies legal services emanating from applicant and not from any other law firm in the field.

¹ Both applicant and the examining attorney solely addressed their appeal briefs to the question of whether applicant's evidence was sufficient to establish acquired distinctiveness.

4. Copies of third-party registrations for the following marks: ANSWERS FOR THE INJURED (Registration No. 2865998); JUSTICE FOR THE INJURED (Registration No. 2779624)²; and TRAINED BY INSURANCE COMPANIES, FIGHTING FOR THE INJURED (Registration No. 3863850). Each is or was registered on the Principal Register for legal services.

See Applicant's Brief, at 9-10.

Analysis

A term is deemed to be merely descriptive of services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services. *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978). "The 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); *see also In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

As noted, for procedural purposes, a claim of distinctiveness under § 2(f), whether made in the application as filed or in a subsequent amendment (as applicant did here), is 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. Once an applicant has claimed that matter has acquired distinctiveness under § 2(f), the issue to be determined is not whether the

² This registration was cancelled on June 12, 2010 for failure to file an acceptable declaration under Section 8 of the Trademark Act, 15 U.S.C. § 1058.

matter is inherently distinctive but, rather, whether it has acquired distinctiveness. *See, e.g., In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *see also In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960); *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. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657, 1659 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). The applicant may present any competent evidence to establish that a mark has acquired distinctiveness.

Applicant has submitted evidence of the basic types identified in 37 C.F.R. § 2.41 and TMEP § 1212 which may be used to establish secondary meaning: a claim of ownership of a prior registration, a statement of five years' substantially exclusive and continuous use, and asserted actual evidence of acquired

distinctiveness. Applicant's evidence, however, falls short of establishing acquired distinctiveness in view of the highly descriptive nature of applicant's mark.

A. Applicant's Prior Registration

First, applicant provided a claim of ownership of its prior registration No. 3195410 of the mark TRIAL LAWYERS FOR THE INJURED. Prior registrations of the same mark may be accepted as prima facie evidence of acquired distinctiveness in appropriate cases, but they must be (1) for the same mark and (2) registered on the Principal Register. *See* 37 C.F.R. § 2.41(b). TRIAL LAWYERS FOR THE INJURED is not the same mark as FOR THE INJURED. Applicant's prior registration, furthermore, seems to appear on the Principal Register in error.³ For these reasons, applicant's prior registration does not constitute prima facie evidence of acquired distinctiveness.

Moreover, the decision to register applicant's prior registration (on either the Principal or Supplemental Register) is not controlling. *See In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007); *In re Local Trademarks, Inc.*, 220 USPQ 728, 730 (TTAB 1983). The Board must decide each case on its own facts and record. *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Int'l Taste Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000).

B. Statement of More Than Five Years' Use

Second, applicant submitted a statement from its managing partner that FOR THE INJURED has been in substantially exclusive and continuous use by the

³ Applicant authorized amendment of the application to the Supplemental Register on September 1, 2006. The Post Registration division of the Patent and Trademark Office has been notified of this apparent error.

applicant in commerce for at least the preceding five years. Although such a statement may be accepted as prima facie evidence that the mark has acquired distinctiveness, Section 2(f) of the Trademark Act and 37 C.F.R. § 2.41(b) state that reliance on a claim of five years' use to establish secondary meaning is acceptable in "appropriate cases," depending largely on the nature of the mark in relation to the specified services. If a mark is highly descriptive of the services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness. *See In re Noon Hour Food Prods., Inc.*, 88 USPQ2d 1172, 1181 (TTAB 2008); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (TTAB 2007); *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987).

Applicant admits that it "uses the mark 'for the injured' in connection with legal services directed to those individuals that are injured." Reply Brief, at 9. "For the injured" thus immediately conveys information about the nature of applicant's specified services, namely, that said services are directed to clientele suffering from an injury. Therefore, the mark is highly descriptive of the recited services.

In addition, the examining attorney has submitted printouts from websites of third-party providers of legal services using the phrase "for the injured" in a descriptive or informational manner, as follows:

1. Welcome to Arndt Law – Legal Services for the Injured
2. The Mulligan Law Firm – Nationwide Help for the Injured and Their Families

3. About Steigerwalt & Associates We are Here to Provide Nationwide Legal Assistance for the Injured and Their Families Throughout the Country.
4. The Nation Law Firm – Legal Help for the Injured
5. McCARDELL & ASSOCIATES Vancouver Personal Injury Law – Legal Services for the Injured
6. Warren McGraw Fighting for the Injured & Disabled
7. JOSEPH SMITH, LTD. Attorneys for the Injured
8. Legal Center For The Injured
9. J. STANFORD MORSE, P.A. We Speak for the Injured. We Speak for Their Families.
10. THE FRICKEY LAW FIRM Comprehensive Legal Services for the Injured
11. Attorneys for the Injured Seeking Justice for the Injured

The evidence submitted by the examining attorney, as well as applicant's admission that it uses the mark FOR THE INJURED for legal services directed to the injured, demonstrate that applicant's mark is highly descriptive of the services named in the application. Given the highly descriptive nature of applicant's mark, the statement of more than five years' use is insufficient to establish acquired distinctiveness.

C. Advertising Figures and Third-Party Declarations

Applicant also submitted evidence of acquired distinctiveness in the form of advertising figures and third-party declarations. Turning first to advertising, applicant stated that it spends more than \$1 million on advertisements in several types of media per year and anticipated spending \$1.9 million on advertising in 2010. Applicant, however, provided no examples or other evidence concerning the

nature of those advertisements. It is therefore impossible to determine how the phrase “for the injured” is used in that advertising, and particularly whether the phrase is used in a manner sufficient to create secondary meaning among consumers. *See* 37 C.F.R. § 2.41(a) (stating that applicant may submit evidence of advertising expenditures “attaching typical advertisements”). Evidence of the amount of applicant’s advertising expenditures, without more, merely substantiates its efforts to develop distinctiveness and does not prove that the advertising has been effective. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1760 (TTAB 1991); *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971) (“It is necessary to examine the advertising material to determine how the term is being used therein, what is the commercial impression created by such use, and what would it mean to purchasers.”).

Similarly, affidavits or declarations that assert recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. However, the value of the affidavits or declarations depends on the statements made and the identity of the affiant or declarant. *See In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, (TTAB 2009); *In re Dimitri’s Inc.*, 9 USPQ2d 1666, 1668 (TTAB 1988). Proof of distinctiveness also requires more than a small number of people who associate a mark with the applicant. *See In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988); *see also Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (finding sixteen declarations of little persuasive value, as they were nearly identical in wording and only one of the declarants was described as an

end consumer). The four form declarations applicant provided – each of which appears to be from a professional with whom applicant may do business rather than from a consumer of legal services for injured individuals – are insufficient to prove secondary meaning in applicant’s highly descriptive mark. *See, e.g., Poselux Chemical Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 862, 132 USPQ 627, 633 (C.C.P.A. 1962); *In re Personal Counselors Inc.*, 184 USPQ 761, 763 (TTAB 1975).

D. Third-Party Registrations

Finally, applicant also submits three third-party registrations (one of which has been canceled) of marks incorporating the term “for the injured” for legal services. Like applicant’s prior registration, such third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive must not be registered on the Principal Register simply because other such marks appear on the register. *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977).

Conclusion

The evidence of record supports the examining attorney’s refusal to register applicant’s mark on the basis that it has not acquired distinctiveness. We find that consumers encountering applicant’s mark in connection with the recited services will immediately understand the term FOR THE INJURED to describe the type of legal services offered by applicant, that is, legal representation for those who are injured, and not the source of the services. The evidence of acquired distinctiveness

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is insufficient for registration under Section 2(f) of the Trademark Act given that the mark is highly descriptive of applicant's recited services.

Decision: The refusal of registration is affirmed.