

ESTTA Tracking number: **ESTTA454826**

Filing date: **02/06/2012**

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

Proceeding	77821445
Applicant	Gordon & Doner, P.A.
Applied for Mark	FOR THE INJURED
Correspondence Address	CARL J SPAGNUOLO MCHALE & SLAVIN PA 2855 PGA BLVD PALM BEACH GARDENS, FL 33410-2910 UNITED STATES ustrademarks@mchaleslavin.com
Submission	Appeal Brief
Attachments	2955U.002_AppealBrief020612.pdf (25 pages)(147580 bytes)
Filer's Name	Carl J. Spagnuolo
Filer's e-mail	ustrademarks@mchaleslavin.com
Signature	/Carl J. Spagnuolo/
Date	02/06/2012

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

BRIEF FOR THE APPELLANT

Carl J. Spagnuolo

McHALE and SLAVIN, P.A.
Attorneys for the Appellant
2855 PGA Blvd.
Palm Beach Gardens, FL 33410
Telephone: (561) 625-6575

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

TABLE OF CONTENTS

STATEMENT OF JURISDICTION	3
SUMMARY OF THE MARK	3
QUESTIONS PRESENTED	3
INDEX OF CITED AUTHORITIES	4
STATEMENT OF THE FACTS	5
SUMMARY OF THE ARGUMENT	7
ARGUMENT	9

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

STATEMENT OF JURISDICTION

The Trademark Trial and Appeal Board has jurisdiction over this matter pursuant to Section 20 of the Trademark Act (15 U.S.C. § 1070).

SUMMARY OF THE MARK

The mark comprises the words "FOR THE INJURED" presented in standard character format without any claims to font, style, size, format or color.

QUESTIONS PRESENTED

- I. Whether Applicant's demonstration of evidence of Acquired Distinctiveness is sufficient under 15 U.S.C. § 1052(f).

INDEX OF CITED CASES

In re Boston Beer Co., 198 F.3d 1370, 53 U.S.P.Q. 2d (BNA) 1056 (Fed. Cir. 1999).

In re Busch Entm't Corp., 60 U.S.P.Q. 2d (BNA) 1130 (T.T.A.B. 2000).

In re Capital Formation Counselors, Inc., 219 U.S.P.Q. (BNA) 916 (T.T.A.B. 1983).

In re Consol. Foods Corp., 200 U.S.P.Q. (BNA) 477 (T.T.A.B. 1978).

Dieter v. B & H Indus. of S.W. Fla., 880 F.2d 322, 11 U.S.P.Q. 2d (BNA) 1721 (11th Cir. 1989).

E.T. Browne Drug Co. v. Cococare Prods., Inc., 538 F.3d 185, 87 U.S.P.Q. 2d (BNA) 1655 (3d Cir. 2007).

Goodyear Tire & Rubber Co. v. H. Rosenthal Co., 246 F. Supp. 724, 147 U.S.P.Q. (BNA) 92 (D.C. Minn. 1965).

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).

Leelanau Wine Cellars v. Black & Red, 502 F.3d 504 (6th Cir. 2007).

In re Loew's Theaters, Inc., 769 F.2d 764, 226 U.S.P.Q. (BNA) 865 (Fed. Cir. 1985).

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 15:48, at 15-77-78 (4th ed. Supp. Rel. 55 Sept. 2010, Thomson Reuters 2010).

In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 227 U.S.P.Q. (BNA) 417 (Fed. Cir. 1985).

Park'N'Fly, Inc. v. Dollar Park and Fly, 469 U.S. 189 (1985).

In re Pennzoil Prods. Co., 20 U.S.P.Q. 2d (BNA) 1753, (T.T.A.B. 1991).

In re Personal Counselors Inc., 184 U.S.P.Q. (BNA) 761 (T.T.A.B. 1975).

Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc., 132 U.S.P.Q. (BNA) 627 (C.C.P.A. 1962).

In re Seats, Inc., 757 F.2d 274, 225 U.S.P.Q. (BNA) 364 (Fed. Cir. 1985).

In re Thomas Nelson Inc., 97 U.S.P.Q. 2d (BNA) 1712 (T.T.A.B. 2011).

In re Women's Publ'g Co., Inc., 23 U.S.P.Q. 2d (BNA) 1876 (T.T.A.B. 1992).

Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572; 6 U.S.P.Q. 2d (BNA) 1001 (Fed. Cir. 1988).

STATEMENT OF THE FACTS

On September 8, 2009, Gordon & Doner, P.A., filed for federal service mark registration for the mark "FOR THE INJURED" and was issued Serial Number 77/821,445. The mark is owned by the Appellant and has been used in commerce since January 1, 2001.

Applicant received a merely descriptive refusal in an Office Action dated December 15, 2009. On June 15, 2011, the Applicant responded to the Office Action by submitting prima facie evidence of secondary meaning through substantially exclusive and continuous use in commerce for more than five years under 15 U.S.C. Section 1052(f). In addition, Applicant submitted evidence of advertising expenditures in promoting the mark in connection with Applicant's services excessive of \$1 million annually and plans to spend \$1.9 million on advertising same in the upcoming year. Notwithstanding, the Examiner maintained the descriptive refusal, claiming evidence of excessive advertising did not establish the effectiveness of such and that evidence in the nature of consumer or relevant public recognition of the mark as a source indicator was necessary.

In response, the Applicant submitted four additional declarations from prominent physicians, attorneys, members of the medical community, and a CPA, stating that Applicant's mark is recognized through its extensive advertisements on television, billboards, the radio, buses, sponsored and charity events and that the Applicant's mark immediately identifies legal services emanating exclusively from the Applicant. Nevertheless, the Examiner issued a FINAL Office Action, dated March 8, 2011, claiming such evidence was insufficient to establish secondary meaning. Thereafter, the Examiner issued an additional FINAL Office

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

Action to introduce website printouts from third parties using the phrase "for the injured," in various ways in connection with the services they offer. In addition, the Examiner, for the first time, claimed that the Applicant's mark was "highly descriptive," and therefore "an extraordinary amount of evidence" was required to demonstrate secondary meaning.

Subsequently, the Applicant filed a Notice of Appeal and Request for Reconsideration. In its Request for Reconsideration, the Applicant submitted evidence rebutting the Examiner's new claim that the applied-for mark was "highly descriptive." Applicant submitted the U.S. Registration Certificate of the mark "TRIAL LAWYERS FOR THE INJURED," of which the Applicant is the owner, and for which the Applicant was able to overcome a refusal for descriptiveness using significantly less evidence than that which was presented in the present case. In addition, the Applicant submitted U.S. Registration Certificates for three marks containing the phrase "for the injured," relating to legal services, all of which are more descriptive than the Applicant's mark, all of which were entitled to registration on the Principle Registry, and none of which received a "highly descriptive" refusal.

However, the Examiner again refused registration, asserting that Applicant's prior registered mark, "TRIAL LAWYERS FOR THE INJURED" and the additional marks containing the term "for the injured" does not mandate that the applied-for mark must be registered.

Accordingly, on December 21, 2011, this appeal to the Trademark Trial and Appeal Board was resumed.

SUMMARY OF THE ARGUMENT

The evidence submitted by Applicant is sufficient to prove a claim of acquired distinctiveness under 15 U.S.C. § 1052(f). Although registration of descriptive marks may be refused, Section 2(f) of the Trademark Act permits registration of descriptive marks that have become distinctive of an applicant's goods/services. To prove distinctiveness, applicants may submit any appropriate evidence tending to show that the mark distinguishes the applicant's goods/services.

Applicant provided the Trademark Office with prima facie evidence of distinctiveness through continuous and exclusive use in commerce for a period of ten years. Although this fact alone may be considered, Applicant submitted a plethora of additional evidence showing that the applied-for mark is distinctive, including: evidence of extensive advertisement expenditures in television, radio, billboards, newspapers and magazines exceeding \$6 million; evidence of the success of Applicant's advertisements and recognition of the applied-for mark as an indicator of source from relevant professionals in Applicant's trade; third party certificates of registration which are more descriptive than Applicant's mark and for which significantly less evidence was required to overcome a descriptive refusal; and a claim of ownership of a prior registration on the Principal Register, comprising in part the proposed mark, which has become eligible for "incontestable status."

Proof of advertising expenditures has been held on many occasions to be sufficient to establish distinctiveness. While the Examiner cited to several cases to the contrary, the Examiner improperly misconstrued and mischaracterized these authorities. Each authority the Examiner used to support his position found that the mark at issue was

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

unregistrable. Accordingly, no amount of evidence would have been sufficient to establish distinctiveness. Therefore, the Examiner inappropriately claimed that Applicant's expenditures of over \$6 million was insufficient to establish distinctiveness.

The Examiner also inappropriately claimed that Applicant's additional evidence was not enough to establish distinctiveness. In response to Applicant's submission of evidence showing the success of Applicant's advertising expenditures, the Examiner again refused registration by citing to authorities that were not on point. In addition, the Examiner claimed that Applicant's mark was "highly descriptive" and "an extraordinary amount of evidence" was required to establish distinctiveness. However, the evidence the Examiner submitted in support of this position is not probative of whether Applicant's mark is capable of functioning as an indicator of source. Furthermore, the Examiner yet again relied on authorities that are completely irrelevant to the issue in this case. Moreover, Applicant has submitted ample evidence to show that the applied-for mark is not "highly descriptive."

Lastly, Applicant's prior registered mark is highly probative in this case. Where an applicant has a prior federal registration under Section 2(f) for a mark that comprises in part the subject of the proposed mark for the same services, the prior registration is highly probative of whether the mark has acquired distinctiveness and may obviate the necessity of determining distinctiveness. Here, in its Request for Reconsideration, Applicant claimed the ownership of the mark, "TRIAL LAWYERS FOR THE INJURED," comprising in part the proposed mark. Because this registration was granted under Section 2(f), this evidence has obviated the necessity of determining distinctiveness.

ARGUMENT

I. THE EVIDENCE SUBMITTED BY APPLICANT WAS SUFFICIENT TO SHOW A CLAIM OF ACQUIRED DISTINCTIVENESS UNDER SECTION 2(f)

15 U.S.C. § 1052(f) serves as an exception to a merely descriptive refusal under the provisions of Section 2(e), *In re Loew's Theaters, Inc.*, 769 F.2d 764, 766 n.4, 226 U.S.P.Q. (BNA) 865, 867 n.4 (Fed. Cir. 1985), permitting registration of descriptive marks that "become distinctive of the applicant's goods in commerce." Thus, "Section 2(f) is not a provision on which registration can be refused," *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. (BNA) 916, 917 (T.T.A.B. 1983), but is a provision under which an applicant may prove he is entitled to registration which would otherwise be refused. *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 U.S.P.Q. 2d (BNA) 1001 (Fed. Cir. 1988).

To prove distinctiveness under 15 U.S.C. § 1052(f), applicants may submit any appropriate evidence tending to show that the mark distinguishes the applicant's goods/services. 37 C.F.R. § 2.41(a) (2011). Here, Applicant submitted the following evidence in support of Registration:

- (1) Evidence of continuous and exclusive use of the mark since January, 2001;
- (2) The Certificate of Registration and a claim of ownership of the prior registration on the Principal Register of the mark TRIAL LAWYERS FOR THE INJURED, U.S. Registration No. 3,195,410, for the same services as those named in the pending application;
- (3) Evidence of extensive expenditures by Applicant of advertisement in television, radio, billboards, newspapers, and magazines;
- (4) Evidence of advertising exceeding \$1 million annually and \$6 million total as of June 15, 2010;

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

(5) Four declarations from prominent physicians and members of the medical community, an attorney, and a CPA, all of whom are professionals in Applicant's trade, claiming recognition of Applicant's mark through its extensive advertising on television, billboards, radio, buses, mailings, Bar and newspaper publications, and sponsored and charity events Applicant has supported; and

(6) Certificates of registration of three third-party registrations for legal services which combine the phrase "for the injured" with other words or phrases which have the effect of conveying a phrase that is more descriptive than the applied-for mark.

Accordingly, Applicant has submitted an overabundance of evidence to establish distinctiveness of the mark "FOR THE INJURED."

A. Applicant Has Provided *Prima Facie* Evidence of Acquired Distinctiveness in the Mark "FOR THE INJURED."

"The Statute is silent as to the weight of evidence required for a showing under Section 2(f) 'except for the suggestion that substantially exclusive use for a period of five years immediately preceding the filing of an application may be considered *prima facie* evidence.'" *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 U.S.P.Q. (BNA) 417 (Fed. Cir. 1985). Here, the Applicant has demonstrated continuous and exclusive use of the mark in commerce since January, 2001. Accordingly, this fact alone may be considered *prima facie* evidence of a showing under Section 2(f). Therefore, a *prima facie* case of acquired distinctiveness has been established.

B. The Additional Evidence Submitted by Applicant Establishes Distinctiveness

In addition to the submission of *prima facie* evidence under Section 2(f), evidence of acquired distinctiveness may also include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. 37 C.F.R. §

2.41(a) (2011). Here, Applicant has submitted an overabundance of evidence to show distinctiveness.

i. Applicant's Extensive Expenditures in Advertising the Mark is Strong Evidence of Secondary Meaning

Applicant submitted evidence that, as of June, 2010, it had spent over \$6 million in advertising the applied-for mark. *See Decl. of Robert Gordon, Managing Partner, dated June 15, 2010.* These expenditures included advertisements in television, radio, billboards, newspapers, and magazines exceeding one million dollars annually. *Id.* As Applicant noted, "[t]he Applicant engages in what can be best described as a 'flood' of advertisements prominently featuring the mark" and "sponsors radio traffic reports where the applied-for mark is prominently repeated in the 12th and 47th largest radio markets in the country, nearly every 10 minutes during morning and afternoon rush-hours." *Response to Office Action dated June 15, 2010.*

However, the Examining Attorney claimed that such evidence was insufficient to establish distinctiveness. The Examiner asserted that Applicant's commercial success did not demonstrate that relevant consumers view the matter as a mark. *See Office Action dated August 4, 2010.* In addition, the Examiner noted: "To date, no such material, such as recognition among consumers or members of the bar of this term as uniquely identifying the applicant, is of record." *Id.* However, there are cases and authorities which state the contrary. Professor McCarthy states:

The easiest and least expensive manner of proving secondary meaning is to introduce evidence of the amount and nature of advertising of the mark; the length of time the mark has been in use; and the amount of goods or services sold under the mark. Such evidence is purely circumstantial as to the mental associations of buyers, but it is relevant evidence from which buyer association may be inferred.

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 15:48, at 15-77-78 (4th ed. Supp. Rel. 55 Sept. 2010, Thomson Reuters 2010).

Furthermore, "[p]roof based essentially on use in advertising and promotion in conjunction with other circumstantial factors has been deemed sufficient to establish secondary meaning" and the "absence of consumer surveys need not preclude a finding of acquired distinctiveness." *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1583, 6 U.S.P.Q. 2d (BNA) 1001, 1010 (Fed. Cir. 1988). Moreover, parties attempting to establish secondary meaning through advertising expenditures do not always have to show that marketing materials succeeded in creating buyer association. *E.T. Browne Drug Co. v. Cococare Products, Inc.*, 538 F.3d 185, 200, n. 15, 87 U.S.P.Q. 2d (BNA) 1655, 1665 n. 15 (3d Cir. 2007). In fact, the size of advertising expenditures alone has been found to serve as strong evidence of acquired distinctiveness. *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 147 U.S.P.Q. (BNA) 92 (D.C. Minn. 1965).

In addition, the cases the Examiner cited to which were claimed to stand for the proposition that advertising expenditures are not sufficient to show that a mark is a successful indicator of source can all be distinguished from this case. In those cases, the court or the Board found that the mark at issue was either generic or unregistrable.¹

¹ See *In re Boston Beer Co.*, 198 F.3d 1370, 1373, 53 U.S.P.Q. 2d (BNA) 1056, 1058 (Fed. Cir. 1999) (the mark, THE BEST BEER IN AMERICA, so highly descriptive that it is "incapable of acquiring distinctiveness"); *In re Busch Entm't Corp.*, 60 U.S.P.Q. 2d (BNA) 1130, 1133 (T.T.A.B. 2000) (the term, EGYPT, for "amusement park services" is "not registrable"); *In re Pennzoil Prods. Co.*, 20 U.S.P.Q. 2d (BNA) 1753, 1758 (T.T.A.B.

If a mark is deemed to be generic or unregistrable, it logically follows that no amount of evidence of acquired distinctiveness is sufficient to prove that the mark can function as an indicator of source. The Examiner here has made no claim that the applied-for mark is generic or unregistrable. Accordingly, the cases cited by the Examiner, standing for the proposition that proof of the success of advertising efforts is required, are inapplicable. Therefore, the evidence submitted by Applicant is sufficient to establish that the mark has acquired distinctiveness.

ii. The Declarations Submitted by Applicant Demonstrating the Success of Applicant's Advertising Efforts Show the Mark has Acquired Distinctiveness

Despite the sufficiency of Applicant's evidence of acquired distinctiveness, Applicant responded to the Examiner's claims by submitting precisely what the Examiner claimed was lacking: proof of the success of Applicant's advertising efforts. This evidence consisted of four declarations from prominent physicians and members of the medical community, an attorney, and a CPA, all of whom are the type of professionals who refer consumers in need of Applicant's services. See *Declarations of Joshua Smith, D.C., Russ M. Seger, D.C., Scott Stein, CPA, and Stanley Dale Klett, Jr., in support of Response to Office Action dated February 4, 2011*. These individuals claimed recognition of the mark "FOR THE INJURED" in connection with Applicant's legal services through Applicant's extensive advertising on television, billboards,

1991) (the term, MULTI-VIS, for "multiple viscosity motor oil," is generic and incapable of registration); *In re Consol. Foods Corp.*, 200 U.S.P.Q. (BNA) 477 (T.T.A.B. 1978) (serious question of registrability of PRE-INKED because of ambiguous manner in which applicant used the mark in its promotional literature).

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

radio, buses, mailings, Bar and newspaper publications, and sponsored and charity events Applicant has supported. Not only had Applicant submitted sufficient evidence of acquired distinctiveness through significant advertising expenditures, Applicant demonstrated the success of those efforts through declarations of professionals in Applicant's relevant trade. Therefore, this evidence demonstrates that the mark has acquired distinctiveness.

Despite Applicant's ample efforts to overcome the Examiner's refusal under Section 2(e), the Examiner maintained, in a FINAL Office Action, that it was insufficient to show secondary meaning. See *Office Action dated March 8, 2011*. In support of this determination, the Examiner cited two cases: *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 132 U.S.P.Q. (BNA) 627 (C.C.P.A. 1962) and *In re Personal Counselors Inc.*, 184 U.S.P.Q. (BNA) 761 (T.T.A.B. 1975).

The Examiner claims that the *Roselux* case stands for the proposition that "proof of distinctiveness requires more than proof of a relatively small number of people who associate the term as a primary source indicator." However, citing this case for such proposition is misleading because the court in that case found that the term "sudsy" was a "common descriptive" name/adjective for the product. *Roselux*, 132 U.S.P.Q. (BNA) at 632. The 1988 Revision of the Trademark Act, Section 14, which refers to the cancellation of a mark that has become generic, had previously pertained to a mark that "becomes the common descriptive name of an article or substance." TMEP 1209.01(c)(ii) (2011). Prior to the 1988 Amendment, cases distinguished between generic names and "apt or common descriptive names"; however, this distinction is

inappropriate. *Id.* Accordingly, it is impossible to determine the basis for the court's ruling in *Roselux*: whether the mark was incapable of acquiring secondary meaning; or whether the evidence was simply insufficient to overcome a descriptive refusal. Therefore, citing the *Roselux* case is inappropriate for the proposition that Applicant's evidence is insufficient.

Secondly, the *Personal Counselors* case, stating that "de facto recognition is not enough to show that a mark has become entitled to registration" is not on point. In that case, the court held that the applicant was not using the term "co-counseling" as an indicator of source. *Personal Counselors*, 184 U.S.P.Q. (BNA) at 763. Rather, the applicant was using the term "in a merely descriptive, if not, generic sense to demonstrate and describe the psychological counseling method that it employs in rendering its services." *Id.* This purely descriptive use was evidenced by the applicant's brochure, which stated: "It is possible for intermediate co-counselors to pursue co-counseling intensively and economically." *Id.* However, here, Applicant is not using the applied-for mark in a descriptive sense, but as an indicator of source.² Accordingly, the cited case is inapplicable. Therefore, the evidence submitted by Applicant in this case is more than sufficient to prove the mark's distinctiveness.

² See Applicant's argument in Section iii, *infra*, where Applicant demonstrates this point at length.

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

iii. The Mark is Not "Highly Descriptive" and Therefore the Evidence Submitted is Sufficient to Show Secondary Meaning.

In addition to the FINAL Office Action dated March 8, 2011, the Examiner issued an additional FINAL Office Action, dated April 12, 2011, to introduce additional evidence and arguments. In that Office Action, the Examiner claimed, for the first time, that the mark, "FOR THE INJURED," is so highly descriptive that "an extraordinary amount of evidence is required to demonstrate that a single party should possess legal rights in this term, as a source identifier for one party's particular legal services." See *Office Action dated April 12, 2011*. However, the evidence the Examiner submitted is not probative of whether Applicant has proven that its mark functions as an indicator of source. In addition, even if the mark is deemed "highly descriptive," the cases the Examiner cited in support of the proposition that the evidence was insufficient are, again, not on point. Therefore, Applicant is still entitled to registration based on its showing of distinctiveness.

Firstly, the Examiner submitted additional evidence, in the form of screen shots from third-party websites using the phrase "for the injured" to support its assertion that Applicant's mark was "highly descriptive." However, this evidence is not probative of whether the applied-for mark is capable of functioning as an indicator of source. Courts have found, and the Board has recognized, that registration of a descriptive mark, even a highly descriptive mark, does not preclude third parties from using a term or phrase in a purely descriptive manner. See *In re Seats, Inc.*, 757 F. 2d 274, 276, 225 U.S.P.Q. (BNA) 364, 366-67 (Fed. Cir. 1985) (registration of the term "seats," for

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

reservation services, though highly descriptive, would not preclude others from using the term descriptively in presenting the same services); *Henri's Food Prods. Co., Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1307, 2 U.S.P.Q. 2d (BNA) 1856, 1859 (7th Cir. 1987) (if the term "tasty," as applied to salad dressing, had acquired secondary meaning, competitors would not be precluded from using the term in a purely descriptive manner or its primary sense).

The website printouts submitted by the Examiner show the phrase "for the injured" used in connection with a complete sentence or a qualified prepositional phrase. For example, in the "About" section of Steigerwalt Associate's website, the phrase appears as: "We are Here to Provide Nationwide Legal Assistance for the Injured and Their Families throughout the Country." This example is a complete sentence that is not displayed prominently on the firm's website, nor is it being used as an indicator of source. In addition, J. Stanford Morse, P.A.'s website contains the sentence, "We speak for the injured." The other evidence submitted also shows the phrase being used in a purely descriptive manner, as "comprehensive legal services for the injured," "legal services for the injured," "legal center for the injured," "seeking justice for the injured," etc. In fact, none of the evidence submitted shows the term "for the injured" being used alone without other qualifying words.

The usage and grammatical makeup of the phrases the Examiner cites to creates an entirely different impression upon the consumer than the way in which Applicant uses its phrase. The phrase "for the injured" is a prepositional phrase, consisting of a preposition ("for"), a

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

determiner ("the"), and the object of the preposition ("injured"), which is a nominative adjective functioning as a count noun. On the other hand, the phrase "we offer legal services for the injured" is a complete sentence consisting of a subject ("we"), predicate ("offer"), direct object ("services"), and prepositional phrase ("for the injured"). Similarly, even the phrase "legal services for the injured" conveys a complete sentence because the words "we offer" or "we provide" are inferred.

Unlike the inference drawn from the qualified prepositional phrases the Examiner points out, it is much more difficult to infer "we offer legal services" from the phrase "for the injured" alone. Such a phrase conveys little meaning without a qualifying phrase or word(s). In addition, Applicant is using the mark prominently by itself, not in connection with a description of Applicant's services. As such, Applicant is using the phrase "for the injured" as an indicator of source in fact while the cited third parties are using the phrase literally to describe their services. Consequently, the registration of the applied-for mark will not preclude third parties from using the phrase in a descriptive nature as applied to legal services. Therefore, the third-party uses of the phrase "for the injured" are of little probative value in determining the nature of Applicant's use of the phrase.

Yet again, despite the fact that the third-party use is of little value, Applicant submitted additional evidence to show that the Examining Attorney is mistaken. Applicant has submitted far more evidence to support its claim of acquired distinctiveness here than it

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

submitted in support of Applicant's prior registered mark, "TRIAL LAWYERS FOR THE INJURED," U.S. Registration No. 3,195,410. Despite an initial descriptiveness refusal for that mark, Applicant was able to overcome such by submitting a declaration of continuous and exclusive use of the mark for four years and evidence of advertising expenditures of \$2 million. See *Declaration of Robert E. Gordon supplementing Response to Office Action dated March 15, 2005, for '410 mark.*

The significance of Applicant's prior registered mark is that the phrase "trial lawyers for the injured" is more descriptive than the partial phrase "for the injured." The phrase "trial lawyers for the injured" is a complete phrase which sets forth that the Applicant's "trial lawyers" provide services "for the injured." However, the phrase "for the injured" alone, without more, does not immediately convey to a consumer that services are necessarily related to legal representation. The phrase could be related to a variety of fields, including medical and charity services for victims of domestic abuse and natural disasters and goods and services for injured athletes. Therefore, it is puzzling that the Examiner has claimed that the phrase "for the injured," alone, is "so highly descriptive" of legal services as to require more evidence of secondary meaning than had been required to register the descriptive phrase "trial lawyers for the injured."

In addition to pointing out Applicant's prior registration, Applicant also submitted evidence of third-party registrations tending to prove that the phrase "for the injured" is not "highly descriptive." Although third-party registrations are not *conclusive* on the issue of descriptiveness, they can be considered by the Board. *In re Thomas*

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

Nelson Inc., 97 U.S.P.Q. 2d (BNA) 1712, 1717 (T.T.A.B. 2011). First, the mark, "ANSWERS FOR THE INJURED," U.S. Registration No. 2,865,998, for legal services, has been registered on the Principal Register. Although the phrase "answers for the injured" is more descriptive than the phrase "for the injured" as it relates to legal services, the '98 applicant was able to overcome a descriptive refusal with a single declaration and evidence of advertising expenditures equaling the sum of \$360,000, merely 6% of the advertising expenditures evidenced by Applicant in this case.

Secondly, the mark, "JUSTICE FOR THE INJURED," U.S. Registration No. 2,779,624, was also registered on the Principal Register, even though this mark is highly descriptive of legal services. The phrase "justice for the injured" immediately conveys to the consumer that the source provides legal services. Thirdly, the mark, "TRAINED BY INSURANCE COMPANIES, FIGHTING FOR THE INJURED," U.S. Registration No. 3,863,850, is also registered on the Principal Register. Combining the phrase "for the injured" with the phrase "trained by insurance companies" and the word "fighting" also immediately conveys to consumers that the services are related to legal representation.

Despite the highly descriptive nature of the above-referenced marks, there is no indication that the USPTO claimed these marks as "highly descriptive" or required "an extraordinary amount of evidence" to show acquired distinctiveness. Accordingly, Applicant's mark is not "so highly descriptive" as to require any further evidence to support its claim of acquired distinctiveness in this case.

Moreover, even if the mark is deemed to be "highly descriptive,"

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

Applicant has still submitted ample evidence to establish distinctiveness. To support its claim that Applicant's evidence was insufficient, the Examiner cited to cases which are, again, not applicable here. Every case cited by the Examiner held that a claim of acquired distinctiveness could not be made because the mark in question was either "so highly descriptive that it is incapable of registration" or generic.³

A refusal that an applicant's mark is "so highly descriptive that it is incapable of acting as a trademark" is not a ground of refusal. TMEP 1209.01(c)(ii) (2011); *In re Women's Publ'g Co., Inc.*, 23 U.S.P.Q. 2d (BNA) 1876, 1877 (T.T.A.B. 1992). An Examiner may refuse registration on the basis that the mark is generic or, alternatively, on the basis that the mark is merely descriptive. *Id.* Here, the Examiner has asserted that Applicant's mark is descriptive. As descriptive marks are capable of acquiring distinctiveness, the Examiner should not be permitted to claim that the evidence submitted is insufficient to establish such, while basing those claims on authorities finding marks unregistrable regardless of the amount of evidence submitted. In essence, the Examiner is attempting to piggyback his descriptive refusal

³ These cases were also cited previously in the August 4, 2010 Office Action, and were distinguished supra: *In re Boston Beer Co.*, 198 F.3d 1370, 1373, 53 U.S.P.Q. 2d (BNA) 1056, 1058 (Fed. Cir. 1999) (the mark, THE BEST BEER IN AMERICA, so highly descriptive that it is "incapable of acquiring distinctiveness"); *In re Busch Entm't Corp.*, 60 U.S.P.Q. 2d (BNA) 1130, 1133 (T.T.A.B. 2000) (the term, EGYPT, for "amusement park services" is "not registrable"); *In re Pennzoil Prods. Co.*, 20 U.S.P.Q. 2d (BNA) 1753, 1758 (T.T.A.B. 1991) (the term, MULTI-VIS, for "multiple viscosity motor oil," is generic and incapable of registration)

with a refusal on the basis that the mark is generic. However, the Examiner has not claimed that the applied-for mark is generic. Accordingly, Applicant has submitted ample evidence that the mark is capable of registration.

C. Applicant's Prior Registration is Highly Probative of Secondary Meaning.

Applicant's claim of ownership of its prior registration on the Principal Register of the mark, "TRIAL LAWYERS FOR THE INJURED," is extremely probative of the applied-for mark's having acquired distinctiveness. Ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. 37 C.F.R. § 2.41(b) (2011). 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 (T.T.A.B. 2011); TMEP § 1212.

In *In re Thomas Nelson*, the applicant filed an application to register the mark "NKJV" (words only) for "bibles." *Id.* at 1712. Registration was refused on the ground that the mark was merely descriptive in that it immediately informed consumers that applicant's bible was the New King James Version. *Id.* The applicant submitted evidence that the mark had acquired distinctiveness, consisting of: (1) a declaration attesting to applicant's substantially exclusive and

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

continuous use of the mark; (2) declarations of applicant's Vice President of extensive sales and advertising (\$4 million in advertising); written statements from book retailers stating that they recognize NKJV as identifying the products of applicant; and (3) written statements from customers stating that they recognize NKJV as identifying the products of applicant. *Id.*

Most significantly, applicant claimed ownership of two prior incontestable registrations comprising in part the letters NKJV registered under Section 2(f) for bibles. *Id.* at 1717-18. In response to this evidence, the Board stated, as a preliminary matter:

It is surprising that this application could reach the Board on appeal without resolution by the applicant and examining attorney...in view of the fact that applicant owns the two registrations noted above for NKJV NEW KING JAMES VERSION and NKJV and design issued under the provisions of Section 2(f).

Id. at 1713. While the Board did not find that the prior registrations were prima facie evidence of acquired distinctiveness pursuant to Trademark Rule 2.41(b), it stated: "the fact remains that applicant is the owner of the marks NKJV and design and NKJV NEW KING JAMES VERSION, in typed drawing form, for bibles registered under the provisions of Section 2(f)." *Id.* at 1718. Accordingly, the Board held that the applicant had submitted sufficient evidence to show acquired distinctiveness. *Id.* at 1718. Notably, in so holding, the Board did not address the applicant's submission of the additional evidence consisting of third-party declarations from retailers and consumers:

In view of the evidence of acquired distinctiveness submitted by the applicant (i.e., substantially exclusive and continuous use over a long period of time, substantial sales and advertising expenditures) as well as applicant's two previously registered marks, *to hold that the initials NKJV has not acquired*

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

distinctiveness when the same term is the subject of two incontestable registrations under the provisions of Section 2(f) appears illogical on its face. Thus, under the facts before us, we find that the evidence of record is sufficient to support the finding that the mark NKJV used in connection with bibles has acquired distinctiveness.

In re Thomas Nelson, Inc., 97 U.S.P.Q. 2d (BNA) at 1718 (emphasis added).

The circumstances surrounding the decision in *In re Thomas Nelson* can be likened to the circumstances in this case. As in *In re Thomas Nelson*, the Applicant submitted a declaration of exclusive and continuous long-term use since January of 2001, evidence of significant sales and advertising expenditures well over \$6 million, and declarations from professionals in Applicant's relevant market recognizing the mark as identifying legal services emanating from Applicant's law firm.

What is most significant, however, is Applicant's claim of ownership of the prior registration, "TRIAL LAWYERS FOR THE INJURED," U.S. Registration No. 3,195,410, on the Principal Register, which comprises in part the phrase "for the injured," the subject of the applied-for mark. In addition, the Examining Attorney for the '410 mark did not require a disclaimer of the phrase "for the injured" and Applicant was able to overcome a descriptive refusal based on a declaration of substantially exclusive and continuous use in commerce for a period of four years and evidence of advertising expenditures of approximately two million dollars.

Furthermore, the status of the '410 registration is probative of the applied-for mark's acquiring distinctiveness. Applicant's '410 mark

In re: Serial Number 77/821,445
Brief for the Appellant Gordon & Doner, P.A.

is now eligible for incontestable status.⁴ Once a mark has become incontestable, it is presumed to be at least descriptive with secondary meaning, and therefore a relatively strong mark. *Leelanau Wine Cellars v. Black & Red*, 502 F.3d 504 (6th Cir. 2007). Furthermore, once a mark has achieved incontestable status, its validity cannot be challenged on the ground that it is merely descriptive, even if the challenger can show that the mark was improperly registered initially. *Dieter v. B & H Indus. of S.W. Fla.*, 880 F.2d 322, 329; 11 U.S.P.Q. 2d (BNA) 1721,1726 (11th Cir. 1989) (citing *Park'N'Fly, Inc. v. Dollar Park and Fly*, 469 U.S. 189 (1985)).

As in *In re Thomas Nelson*, where the Board found that the USPTO had already recognized that the letters NKJV had acquired distinctiveness due to its prior registrations, 97 U.S.P.Q. 2d (BNA) at 1713, the USPTO has already recognized here that the phrase "for the injured" has acquired distinctiveness. Therefore, Applicant's prior registration is highly probative of acquired distinctiveness and has "obviated" the necessity of determining secondary meaning.

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.

⁴ Under 15 U.S.C. Section 1065, marks become eligible for incontestable status after continuous use in commerce for a period of five years after the date of registration. Applicant's '410 mark was granted registration on January 7, 2007. Accordingly, it is now eligible for incontestable status.