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

Proceeding	77826338
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Submission	Reply Brief
Attachments	Applicant's Reply - 77826338 - BEREAN COMMUNICATIONS.pdf (4 pages) (30793 bytes)
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UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 77/826,338

Applicant: Macor, Janet

Mark: BEREAN COMMUNICATIONS

Filed: September 15, 2009

BEFORE THE TRADEMARK TRIAL AND
APPEAL BOARD ON APPEAL

APPLICANT'S REPLY BRIEF

I. STANDARD OF REVIEW

If a portion of a mark is descriptive, then the mark is inherently weak and is entitled to a narrow scope of protection. The narrow scope of protection extended to descriptive marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar services. *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975). Not just a portion, but the entirety, of Registrant's marks is descriptive and, therefore, Registrant's marks are inherently weak and entitled to only a narrow scope of protection.

II. REBUTTAL

The Examiner has attempted to take a different tactic and position in the Examining Attorney's Appeal Brief than that taken during prosecution in support of the refusal to register Applicant's mark on the basis of likelihood of confusion. The term BEREAN has been established affirmatively on the prosecution and appeal record as being descriptive ["there is no dispute as to the descriptiveness of the term BEREAN" (See Examining Attorney's Appeal Brief, page 8, Section C, second paragraph)]. Yet, in the Examining Attorney's Appeal Brief, the Examiner now tries to persuade the Trademark Trial & Appeal Board that "regardless of the *potential* descriptiveness of the term BEREAN, registrant's marks are entitled to protection against applicant's use of a confusingly similar mark for *highly related* services (emphasis added)" and that the "dominant portion of the marks is identical; and, regardless of the descriptiveness of the term BEREAN, this common element in the marks, is likely to confuse purchasers

into mistakenly believing that the services come from a single source.” (See Examining Attorney’s Appeal Brief, page 11, first and second full paragraphs.)

After establishing the descriptiveness of the term BEREAN with supporting evidence of the same during prosecution, the Examiner contradicts herself in the Examining Attorney’s Appeal Brief and asserts that “Applicant has provided no evidence to show that BEREAN is such a common term that it is viewed by the general public – or even the relevant purchasing public – as a generic or even highly descriptive term (See Examining Attorney’s Appeal Brief, page 9, second paragraph). The Examiner further contradicts herself and asserts that “Applicant submits neither “real world” evidence, i.e., showing that BEREAN is a commonly-used term, recognized by many, nor even a dictionary definition, to support its contention that BEREAN is a term which is deserving of limited protection (See Examining Attorney’s Appeal Brief, page 9, second and third paragraphs).

As Applicant set forth above, the legal standard of review is that if a portion of a mark is descriptive, then the mark is inherently weak and is entitled to a narrow scope of protection. The term BEREAN is descriptive. Accordingly, Applicant has no burden of proof to provide additional, cumulative evidence that the term BEREAN is descriptive and weak, such as the Examiner newly requires and attempts to fault Applicant for in the Examining Attorney’s Appeal Brief.

III. ANALYSIS

A. Registrant’s Mark is Descriptive and Weak

A primary and important factor in this appeal is that the term BEREAN has been established as descriptive. Additionally, in both its trademark registrations at issue, Registrant has disclaimed the descriptive terms CHURCH OF GOD INTERNATIONAL. Accordingly, both of Registrant’s marks (BEREAN CHURCH OF GOD INTERNATIONAL and THE BEREAN CHURCH OF GOD INTERNATIONAL & Design) are comprised entirely of descriptive terms, and, therefore, are inherently weak and entitled to a narrow scope of protection.

B. Non-identical Notation

The narrow scope of protection extended to descriptive marks has been limited to substantially identical notation. As set forth extensively in Applicant's Appeal Brief, upon comparison of Registrant's marks (five words and six words, respectively) and Applicant's mark (two words, BEREAN COMMUNICATIONS & Design) in their entireties, it is readily apparent that the marks bear only one descriptive term in common, BEREAN, and, therefore, the marks are *not* substantially identical in notation.

C. Dissimilar Services

The narrow scope of protection extended to descriptive marks has been limited to subsequent use and registration thereof for substantially similar services. As set forth extensively in Applicant's Appeal Brief, upon comparison of Applicant's services (writing texts in Class 041) used with its marks and Registrant's services (providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 041; and for use in conjunction with evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 045) used with its marks, it is clear that their respective services are *not* substantially similar. The Examiner's likelihood of confusion rejection is based not on Applicant's and Registrant's services actually being the same or substantially similar, but rather on a conjecture as to what related services—with which Registrant's marks are not registered—Registrant *may, but does not*, offer.

IV. CONCLUSION

Registrant's marks fail to meet either of the elements needed to substantiate a likelihood of confusion under the narrow scope of protection accorded Registrant's marks, namely, substantially identical notation and/or substantially similar services. Applicant's mark does not have substantially identical notation to Registrant's marks and Applicant's mark is not used with services substantially similar to Registrant's services. Therefore, Applicant respectfully submits that there is no likelihood of

confusion between Applicant's mark and Registrant's marks. Having rebutted the refusal to register on the grounds of likelihood of confusion, Applicant requests that the Trademark Trial and Appeal Board reverse the refusal to register and remand Applicant's trademark application to the Examiner for approval for registration.

Respectfully submitted this 22nd day of December 2010,

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