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PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barnhorst

Serial No. 78480554

Marnie Wright Barnhorst of The Trademark Group, APLC.

Carrie Achen, Trademark Examining Attorney, Law Office 115
(Tomas V. Vlcek, Managing Attorney).

Before Hairston, Grendel and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Marnie Wright Barnhorst (applicant), on September 8, 2004, filed an application to register the mark "THE TRADEMARK GROUP" (in standard character form) for services ultimately identified as "intellectual property consultation in the field of trademarks; legal services in the field of trademark law" in International Class 42. The application was filed under Trademark Act Sections 1(a) and 2(f), 15 U.S.C. §1051(a) and 1052(f), asserting December 22, 1997 as the date of first use and first use in commerce, and alleging that the mark has become distinctive

of the services based on the declaration of applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of the statement.

In the first Office Action, issued April 12, 2005, the examining attorney, inter alia, entered a disclaimer of the word GROUP by Examiner's Amendment in accordance with the authorization granted by applicant, and required an amendment to the recitation of services. On May 20, 2005, the examining attorney issued a Final Office Action on the requirement for an amendment to the recitation of services. On November 7, 2005, the Administrator for Trademark Classification & Practice in the Office of the Commissioner for Trademarks, forwarded a Letter of Protest to the examining attorney. Subsequently, on November 17, 2005, the examining attorney issued an Office Action refusing registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that "THE TRADEMARK GROUP" is generic or, in the alternative, highly descriptive and the claim of acquired distinctiveness under Section 2(f) of the Trademark Act is insufficient. Office Action dated November 17, 2005. On August 31, 2006, the examining attorney accepted applicant's amendment to her recitation

of services and issued a final refusal under Section 2(e)(1).

Applicant has appealed to the Board and briefs have been filed.

Before reaching the merits, we address a few preliminary issues. First, the examining attorney's objection to the third-party registrations referenced by applicant in her brief is sustained. As noted by the examining attorney, the mere submission of a list of registrations does not make them of record. In re Duofold Inc., 184 USPQ 638 (TTAB 1974). See also Trademark Rule 2.142(d) (record must be complete prior to appeal). Second, applicant's request, made for the first time in her brief, that in the alternative registration be allowed on the Supplemental Register, has not been considered. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1047 n. 2 (TTAB 2002) (request in applicant's brief that if the refusals are maintained the application be amended to the Supplemental Register denied because application which has been decided on appeal will not be reopened). See also TBMP §1218 (2d ed. rev. 2004) and cases cited therein. Finally, we note that in her response to the first Section 2(e)(1) refusal and again in her brief, applicant has asserted that the Letter of Protest was improperly granted

in that there was not sufficient evidence to support a prima facie case of genericness. The appropriateness of the granting of the Letter of Protest is not a question for the Board. If applicant wished to raise the issue of the propriety of the granting of the Letter of Protest, she should have done so by way of petition to the Commissioner. This is not an issue for appeal. See TBMP §1201.05 (2d ed. rev. 2004).

We now turn to the merits of the case before us. We must determine whether the mark is generic and, if not, so highly descriptive that applicant's evidence of secondary meaning is insufficient to allow registration pursuant to Section 2(f).

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs*,

Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" Ginn, *supra*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

We find that the genus of services at issue in this case is adequately defined by applicant's recitation of services, namely, "intellectual property consultation in the field of trademarks; legal services in the field of trademark law." Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration.") Applicant's specimen of use and advertising provide further clarification that the services involve providing consultation and legal services in the

field of trademarks. See Specimen of Use ("The Trademark Group provides clients with the infrastructure of unique resources and services necessary to cope with the critically important and ever-changing deadlines involved with patent, trademark and domain name registration issues"). See also *In re Web Communications*, 49 USPQ2d 1478, 1479 (TTAB 1998).

Turning to the second inquiry, the public's understanding of the term, the relevant public as shown in the specimen of use and by applicant's statements and exhibits in her May 19, 2006 Response, consists of prospective clients in need of consultation or legal services in the field of trademarks. See, e.g., applicant's specimen of use. This category would include other lawyers and laypersons seeking assistance.

In support of her position that the relevant public understands applicant's mark to primarily refer to consultation and legal services in the field of trademarks, the examining attorney submitted excerpts from third-party websites where the phrases "the trademark group" or "trademark group" are used to identify intellectual property consultation and legal services in the field of trademarks. A representative sampling of the website excerpts follows (emphasis added):

Wiley Rein & Fielding LLP ... **The Trademark Group** is fully integrated with the firm's other practice areas. We welcome the opportunity to provide effective representation on a wide variety of practice area issues. www.wrf.com;

Mathews, Shepherd, McKay & Bruneau has substantial expertise in virtually every aspect of the practice of trademark law ... **the trademark group** litigates matters involving the infringement of trademarks. www.mathewslaw.com;

The Trademark Group and Holland & Hart ... Holland & Hart's trademark practice is staffed by nine lawyers and legal assistants. Several of those lawyers and legal assistants spend all or nearly all of their time working in the trademark field. We are responsible for the marks of hundreds of our clients, having trademark portfolios ranging in size from one U.S. registration to Fortune 100 companies ... www.iph2.com;

Merchant & Gould ... Drawing on the collective expertise of **the Trademark Group**, and the extensive resources of a top flight intellectual property litigation firm, Merchant & Gould's trademark trial attorneys provide superior counseling and representation in matters affecting brands and related intellectual property rights. www.merchantgould.com;

Perkins Coie LLP ... **The Trademark Group** focuses on counseling, screening, registering and policing intellectual property rights as well as on transactions involving intellectual property rights excluding patents. www.perkinscoie.com;

Baker Botts LLP ... Priscilla Dunckel heads up **the Trademark Group** in Baker Botts' Dallas Office ... www.bakerbotts.com;

Klarquist Sparkman, LLP ... Klarquist Sparkman's **trademark group** includes attorneys with extensive experience in all areas of trademark and service mark protection and practice. ... The trademark group includes a number of highly capable

trademark paralegals who assist with this process, to ensure cost-effective service. www.klarquist.com;

Kenyon & Kenyon ... Attorneys in our **trademark group** base their practice on a thorough understanding of the clients' technologies and marketing strategies ... We routinely advise large and small businesses in a wide variety of industries in the maximization of their current trademark portfolios ... www.kenyon.com;

Holland & Knight ... Our **trademark group** offers a variety of services to assist clients with large trademark portfolio management ... www.hklaw.com; and

Strook ... Our **trademark group** obtains and maintains trademarks, trade names and copyrights for many of our clients... www.strook.com.

In addition, the examining attorney submitted several excerpts from various publications and newswires retrieved from the Lexis/Nexis database where the wording "the trademark group" or "trademark group" is used to identify a subgrouping of professionals within an organization (emphasis added):

...joins as an associate in **the trademark group**. Previously she was a legal specialist ... Legal Times (November 22, 2004);

...has retained the law firm of Quirk & Tratos to handle its intellectual property needs. Jason Firth, who leads the firm's **Trademark Group**, will handle the account. Business Wire (November 6, 2003);

... **The trademark group** at Barnes & Thornburg now ranks in the top 10 for the entire United States. South Bend Tribune (August 10, 2003);

...He joined as head of **the trademarks group** and worked his way up from assistant into the equity partnership. The Lawyer (April 21, 2003);

... international work that gets traded back and forth may be less necessary," said Douglas Hendricks, head of Morrison & Foerster's **trademark group**. The Recorder (May 3, 2001);

... But the venerable IP boutique's focus was on a strong patent prosecution and protection group and Roberta Jacobs-Meadway's **trademark group**. ... The firm took heart in that it retained six of seven associates from the trademark group. The Legal Intelligencer (April 24, 2001);

The recognition that Ms. Abel, who also is head of **the trademark group** at the Palo Alto based law firm of Fenwick & West, helped bring about was that ... Business Journal-San Jose (October 15, 1999); and

As a result, lawyers knowledgeable about patents, trademarks and copyright law are in high demand to help handle a ton of new issues related to the Internet. Most large law firms have added patent litigation **and trademark groups** to keep that business in-house and gain a share of a lucrative, growing market. City Business-Minneapolis (July 16, 1999).

Finally, the examining attorney submitted the following dictionary definitions:

Trademark: A peculiar distinguishing mark or device affixed by a manufacturer or a merchant to his goods, the exclusive right of using which is recognized by law. Webster's Revised Unabridged Dictionary (1998);

Group: 1. An assemblage of persons or objects gathered or located together, an aggregation. The American Heritage Dictionary of the English Language (4th ed. 2000).

The examining attorney argues that the evidence listed above demonstrates that "prospective consumers would immediately understand the wording in the mark describes that applicant offers trademark legal services provided by a group of attorneys." Br. p. 6.

In response to the refusal, applicant submitted, inter alia, a picture of the sign outside her office, a business card, letterhead, a billing statement, a printout from The Trademark Group website, brochures, copies of the cover of The San Diego Daily Transcript Law Journal, and printouts of advertising in publications. All of the above-listed items display the phrase THE TRADEMARK GROUP. In addition, she submitted several declarations. Twelve of these declarations are from foreign agents and as such are of no probative value inasmuch as we must determine the perspective of U.S. consumers not the perspective of applicant's foreign affiliates. The six remaining declarations are from local businessmen, lawyers and one employee from a trademark search firm attesting, inter alia, to their personal view of the phrase THE TRADEMARK GROUP and their opinion as to its relevance in the trade. Finally, applicant stated that THE TRADEMARK GROUP'S billings between 1997 and 2006 have amounted to over \$11,000,000 and its expenditures for marketing and

advertising over the same time period have been approximately \$100,000. Response p. 6 (May 19, 2006).¹

Citing *In re American Fertility Society*, 51 USPQ2d 1832 (Fed. Cir. 1999), applicant argues that the "majority of the evidence made of record by the Examining Attorney does not show generic use of Applicant's phrase as a whole," noting that "only 12 use the phrase as a whole, 'the trademark group', in a descriptive manner." Further, she argues that:

The majority of the references ... use only two of the three words and/or use the words with initial capitalization, as is traditional for trademark use, not generic or descriptive use. For example, several references refer to 'our trademark group' and some mention 'the firm's Trademark Group.' These references do not show use of 'the trademark group' as a whole as is required by *In re American Fertility Society*.
Br. p. 2.

In addition, she argues that "In order to be generic of a service, a phrase must refer to the genus of service

¹ In addition, applicant points to her expired registration for THE TRADEMARK GROUP on the Supplemental Register, noting that in 1998 "the PTO made the determination that THE TRADEMARK GROUP was capable of becoming a distinctive trademark [because i]t approved the mark for registration on the Supplemental Register and a registration issued on September 8, 1998." Response p. 5 (May 19, 2006). However, as noted by the examining attorney, a claim of acquired distinctiveness cannot be based on an expired registration or on a Supplemental Registration. We add that it is well established that we are not bound by prior decisions. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought).

at issue" and "there is insufficient evidence of use of the phrase to describe the *genus* of Applicant's services. The 12 pieces of evidence presented by the Examining Attorney that show use of "the trademark group" *as a whole*, all show use of the phrase to describe a group of attorneys within a law firm or corporation. THE TRADEMARK GROUP is the name of the law firm, which is a professional law corporation. Applicant contends, and has provided a third party declaration to support its contention, that no other law firm is known by this name." Br. p. 3.

As noted above, the evidentiary burden of establishing genericness of a term rests with the Office and the showing must be based on clear evidence. *Merrill Lynch, supra*, 4 USPQ2d at 1143. Based on this record, we find that there is clear evidence to support a finding that the relevant public, when they consider THE TRADEMARK GROUP in conjunction with the class of involved services, would readily understand the term to identify a group that provides consultation or legal services in the field of trademarks.

As noted by the examining attorney, the presence of the article "the" does not add any source identifying significance to applicant's mark. *In re Weather Channel, Inc.*, 229 USPQ 854, 856 (TTAB 1986); and *In re The Computer*

Store, Inc., 211 USPQ 72, 74-75 (TTAB 1981). Thus, even the examples of use of "trademark group" in the record are relevant. Moreover, despite the capitalization of certain examples, we find these uses to be generic, i.e., naming an entity that provides certain services. In fact, the evidence shows, similar to *In re Reed Elsevier Properties, Inc.*, 77 USPQ2d 1649 (TTAB 2005), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007), that this case "does not involve a perceived need for others to use a term, but involves a demonstrated use of the term by others." *In re Reed Elsevier*, *supra*, 77 USPQ2d at 1657. Here, we have evidence of use of the phrase THE TRADEMARK GROUP by entities that provide the same or very similar services as applicant's consultation and legal services in the field of trademarks. Applicant's evidence of her use does not rebut the examining attorney's prima facie case of genericness. Applicant's attempt to distinguish the examples of generic use by arguing that they name a group within a group whereas her services are provided by a stand alone group is not persuasive. Whether referring to a sub group or a stand alone group, the phrase when used in conjunction with these services clearly names the services. We are also not persuaded by applicant's argument that none of the examining attorney's evidence predates applicant's first

use of the phrase. Response p. 3 (May 19, 2006). The fact that an applicant may be the first user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

With regard to applicant's evidence of source indicating significance, we note that no amount of evidence can transform a generic phrase into a registrable trademark. See *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984). See also *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977).

While we have found the phrase THE TRADEMARK GROUP to be generic for applicant's services, for completeness we also determine, in the alternative, that if applicant's proposed mark THE TRADEMARK GROUP is not generic it is highly descriptive and applicant's showing to support acquired distinctiveness is not sufficient.

By applying for registration based on acquired distinctiveness under Section 2(f), applicant has conceded that the proposed mark is merely descriptive and it is applicant's burden to prove acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d

1572, 6 USPQ2d 1001, 1005-1006 (Fed. Cir. 1988); In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”).

“[L]ogically that standard becomes more difficult as the mark’s descriptiveness increases.” Yamaha, supra, 6 USPQ2d at 1008. A claim that applicant has been using the subject matter for a long period of substantially exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See In re Gibson Guitar Corp., 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, Roux Laboratories, Inc. v. Clairol Inc., 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. See In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition.

However, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

After a careful review of the record, we find that applicant has not shown that the phrase THE TRADEMARK GROUP has acquired distinctiveness. The evidence of record discussed above clearly establishes that the phrase THE TRADEMARK GROUP is highly descriptive and the evidence submitted by applicant is insufficient to show that the relevant consumers recognize this phrase a mark. See In re The Paint Products Co., 8 USPQ2d 1863, 1867 (TTAB 1988) (declarations must be weighed against the highly descriptive nature of the words that compose the mark). Thus, despite the many years of use, given the highly descriptive nature of the phrase, we do not find that THE TRADEMARK GROUP has come to signify the commercial source of the services, but rather continues merely to inform the consumers about the nature of the services.

Decision: The refusal to register based on genericness is affirmed. Further, in view of the fact that applicant has not shown that her mark is entitled to registration pursuant to Section 2(f) of the Trademark Act, the refusal based on mere descriptiveness is affirmed.