

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: August 29, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Women's Bar Foundation*  
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Serial No. 85240460  
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Anne McGovern Burkhart of Excellere IP International,  
for Women's Bar Foundation.

Alex S. Keam, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.

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Before Kuhlke, Cataldo and Taylor,  
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Women's Bar Foundation ("Applicant") seeks registration on the Principal Register of the mark WOMEN'S BAR FOUNDATION and design, shown below, for "Charitable foundation services, namely, providing fundraising activities, funding, scholarships and/or financial assistance for women in law school and public service legal positions; Providing educational scholarships" in International Class 36.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85240460 was filed on February 11, 2011, based upon applicant's claim of first use anywhere and in commerce at least as early as August 24, 2010. The application recites the following description: "The mark consists of a woman in black and white and tan holding a white and black scroll within a circle with a background of



The Trademark Examining Attorney issued a final requirement under Section 6 of the Trademark Act, 15 U.S.C. § 1056, that Applicant disclaim the exclusive right to use “WOMEN’S BAR FOUNDATION” as it is merely descriptive of the identified services because Applicant is composed of women attorneys who are members of the bar that provide foundation services of providing charitable donations.

Applicant requested reconsideration of the final requirement, submitting the following claim in accordance with Section 2(f) of the Trademark Act, 15 U.S.C.

§ 1052(f), and requesting a withdrawal of the refusal on the bases that any portion of the mark is merely descriptive.

The mark has become distinctive of the services through the applicant’s substantially exclusive and continuous use for at least the five years immediately before the date of the statement.

The Examining Attorney denied the request, finding Applicant’s claim of acquired distinctiveness based on five years’ use insufficient and maintaining the disclaimer requirement.

Applicant responded with additional evidence to support its claim of acquired distinctiveness, after which the Examining Attorney issued a second Final Action requiring Applicant to disclaim the exclusive right to use “WOMEN’S BAR

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gradations of orange to yellow, the circle outlined by a white border, all enclosed within an outer yellow border with scalloped edging.”

FOUNDATION” because it is merely descriptive and generic<sup>2</sup> for the identified services, and finding Applicant’s claim of acquired distinctiveness unacceptable based on insufficient evidence.

On July 12, 2013, a Notice of Abandonment issued, but the application was successfully revived. Applicant again requested reconsideration of the final requirement which was denied on December 10, 2013, and this appeal subsequently resumed.

For the reasons discussed, we affirm the requirement for a disclaimer of the wording WOMEN’S BAR FOUNDATION.

As an initial matter we note that Applicant, in its appeal brief, has expressly stated that “[t]he refusal of registration was based on an erroneous assertion that the literal portion of the mark ‘Women’s Bar Foundation’ is unregistrable as descriptive ... [and, that it] submitted additional evidence of substantially exclusive use to the Examining Attorney,” br. unnumbered p. 2, and, has further argued that, it has “provid[ed] sufficient evidence to support a claim of acquired distinctiveness.” Br. unnumbered p. 5. We note, too, that the Examining Attorney has presented arguments in her brief directed toward the issue of whether the words “WOMEN’S

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<sup>2</sup> The Examining Attorney for the first time in this action additionally asserted that the wording WOMEN’S BAR ASSOCIATION must be disclaimed because it is generic for the identified services. We note, however, that other than the assertion, no specific arguments regarding genericness were made and, when setting forth the issue on appeal in the Examiner’s Statement, the Examining Attorney solely argued that the wording is merely descriptive, albeit “highly descriptive,” of the services. Accordingly, we find that to the extent that a genericness argument was made, it has been withdrawn. Notably, Applicant did not argue the issue. We otherwise consider the Examining Attorney’s arguments in that regard as amplifications of his contention that Applicant’s showing of acquired distinctiveness is insufficient.

BAR FOUNDATION” are merely descriptive of the identified services as well as whether applicant has made a sufficient showing that the wording “WOMEN’S BAR FOUNDATION” has acquired distinctiveness under Section 2(f). We point out, however, that because Applicant amended its application to seek registration under Section 2(f) based on acquired distinctiveness, and did not make its request in the alternative, Applicant has conceded the mere descriptive nature of “WOMEN’S BAR FOUNDATION” insofar as it now seeks registration of the mark as to that wording under Section 2(f).<sup>3</sup> Compare *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). That is, Applicant’s 2(f) claim of acquired distinctiveness is a concession that the wording “WOMEN’S BAR FOUNDATION” is not inherently distinctive and that it is therefore not registrable on the Principal Register absent a sufficient showing of acquired distinctiveness. *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent

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<sup>3</sup> Accordingly, the arguments directed solely to the issue of mere descriptiveness will not be further considered. We hasten to point out that even if we had considered the issue, the record independently supports a finding that the wording “WOMEN’S BAR FOUNDATION” is merely descriptive. Indeed, the definitions submitted by the Examining Attorney, alone, would support such a finding. That is, the definition of “WOMEN’S,” “BAR” and “FOUNDATION,” separately or together as WOMEN’S BAR FOUNDATION have meaning in relation to Applicant’s services, namely, that Applicant’s charitable organization is comprised of women bar members. Indeed, Applicant, in October 17, 2011 Response to Office Action acknowledges that:

[Applicant] is formed of members of the women’s bar that raise money from many sources, including endowments, to grant scholarships to non-lawyers who are not members of the bar.

distinctiveness as an established fact.” (emphasis in original)). To the extent that Applicant argues that its mark is suggestive, we consider such claim to be directed to the mark in its entirety, i.e., both words and logo, and not as to the wording “WOMEN’S BAR FOUNDATION.” As such mere descriptiveness is not an issue in this appeal. Rather, the issue before us is whether the merely descriptive wording “WOMEN’S BAR FOUNDATION,” as applied to “Charitable foundation services, namely, providing fundraising activities, funding, scholarships and/or financial assistance for women in law school and public service legal positions; Providing educational scholarships,” has acquired distinctiveness and thus Applicant’s mark is registrable on the Principal Register without a disclaimer of that wording under Section 2(f) of the Act.

#### Acquired Distinctiveness

Turning then to that issue, it is Applicant who has the burden to establish, by a preponderance of the evidence, a *prima facie* case that the wording “Women’s Bar Foundation” has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 6 USPQ2d 1001 (Fed. Cir. 1988). The greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. See *Yamaha Int’l Corp v Hoshino Gakki, supra*. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competitors than are less descriptive terms. More evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.

To prove that its mark has acquired distinctiveness under Section 2(f) of the Trademark Act, an applicant may submit any “appropriate evidence tending to show the mark distinguishes [applicant’s] goods.” *Yamaha Int’l Corp v Hoshino Gakki*, 6 USPQ2d at 1010, *quoting* Trademark Rule 2.41(a), 37 C.F.R. 2.41(a). Such evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. *See In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990).

Applicant claims use of WOMEN’S BAR FOUNDATION for at least five years to demonstrate that the wording has acquired distinctiveness. As evidentiary support for its claim, Applicant has made of record with its November 22, 2012 Response to Office Action and its September 3, 2013 Petition to Revive, the following which it contends shows that state agencies, businesses and the public recognize the substantially exclusive use of Women’s Bar Foundation for charitable services for more than five years:

- A notice in the IP Hall of Fame and a second notice referencing “2003 Laureate Award Winners/Illinois ... regarding Delores Hanna, both listing Ms. Hanna as a past present of the Women’s Bar Foundation
- A write-up featuring a 2001 Scholarship Awards Luncheon held by the Women’s Bar Association.
- A facsimile transmission from the City of Chicago-Department of Law regarding the Tax I.D. Number for the Women’s Bar Foundation, dated August 1, 2003.

- A “LETTER FROM THE PRESIDENT” under the heading WBF Women’s Bar Foundation YEAR 2005 ANNUAL REPORT.
- A mark-up presumably for the WOMEN’S BAR FOUNDATION entry in Sullivan’s Law Directory, 2006-2007 edition.
- A proof from Graphic Copy, dated February 6, 2005, for letterhead. Again, there is no information as to whether the letterhead was purchased and how it was used.
- A fax cover letter from W.M. Roche & Associates, Inc., dated September 14, 2006, indicating that a renewal application for the Women’s Bar Foundation Director’s & Officer’s Liability Coverage. There is no confirmation that the coverage was renewed and, more importantly, how the renewal affected the public’s perception of the applied-for mark.
- A flyer for a luncheon with the Vassar Alum, dated October 7, 2007 for The Women’s Bar Foundation Annual Scholarship Awards Luncheon. No information as to circulation or attendance.
- A photograph in the ISBA News dated December 2, 2002, the caption stating “the Women’s Bar Foundation awarded 10 law scholarships ...” No information regarding the circulation of the newspaper.

The Trademark Act provides that the United States Patent and Trademark Office (“USPTO”) may accept five years use as *prima facie* evidence of distinctiveness. However, such use must be “substantially exclusive and continuous.” Trademark Act § 2(f). In that regard, it has been held that:

In respect of registration, there must be a trademark, i.e., purchasers in the marketplace must be able to recognize that a term or device has or has acquired such distinctiveness that it may be relied on as indicating one

source of quality control and thus one quality standard. When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking in such circumstances.

*Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984); see also *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1682 (TTAB 2007).

As regards the applied-for mark which includes the wording WOMEN'S BAR FOUNDATION, Applicant's asserted date of first use is August 24, 2010. This date demonstrates use of the mark for only four years, a period of time less than that required for the statutory presumption of acquired distinctiveness under Section 2(f). With regard to Applicant's use solely of the wording WOMEN'S BAR FOUNDATION, while the evidence shows that applicant has been using the wording WOMEN'S BAR FOUNDATION for at least five years, it is insufficient to demonstrate that the public has come to view this term as a source identifier of Applicant. Specifically, the facsimile regarding Applicant's Tax ID number, the markup for Applicant's entry in the 2006-2007 edition of Sullivan's Law Dictionary, the proof for applicant's stationary and the notice of the renewal for insurance premiums only show that the providers of the goods and services are aware that Applicant uses the wording WOMEN'S BAR FOUNDATION. Moreover, with further regard to the dictionary entry, stationary proof and renewal notice, there is no confirmation that Applicant ordered and used the stationary, was included in the law dictionary or renewed its insurance. As regards the event fliers, and the unsolicited media attention, we have no way to ascertain the attendance at any of



the advertised events, the circulation of the magazines or journals that publicized Applicant's events and/or achievements of Applicant or its individual members or scholarship fund recipients. The information is too vague to demonstrate whether the relevant public recognizes WOMEN'S BAR FOUNDATION as a source indicator of applicant.

Moreover, with regard to the requirement that Applicant's use be substantially exclusive, the Examining Attorney has made of record evidence showing that numerous third parties have used the same or similar wording in relation to similar or related charitable and scholarship services.<sup>4</sup> These third parties include:

Women's Bar Foundation of Massachusetts – Family Law Project

The Ohio Women's Bar Foundation, the charitable counterpart of the Ohio Women's Bar Association.  
[http://www.supremecourt.ohio.gov/PIO/news/leadershipInstitute\\_032911.asp](http://www.supremecourt.ohio.gov/PIO/news/leadershipInstitute_032911.asp)<sup>5</sup>

The Montgomery County Women's Bar Foundation, the charitable and educational arm of the Montgomery County Women's Bar Association.  
(<http://www.preparingforsuccess.org/whatismcwbf.asp>)

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<sup>4</sup> The Examining Attorney also made of record with the December 14, 2012 Final Office Action evidence of several third-party "Bar Foundations" that participate in charitable activities, including the granting of scholarships. These entities include the Hudson Valley Bar Foundation, the California Bar Foundation, the Mercer County Bar Foundation, the Michigan State Bar Foundation, the Macomb County Bar Foundation, the Allegheny County Bar Foundation, the Tulsa County Bar Foundation, the Beverly Hills Bar Foundation and the Gloucester County Bar Foundation. Although the term WOMEN'S BAR FOUNDATION is not used in its entirety, these third-party uses confirm the descriptive significance of BAR FOUNDATION with respect to charitable endeavors.

<sup>5</sup> We note that the Examining Attorney submitted multiple articles referencing the Massachusetts, Ohio and Montgomery County [Maryland] Women's Bar Foundations.

BEXAR COUNTY WOMEN'S BAR FOUNDATION  
(<http://www.bexarcountywomen'sbar.org/mc/page.do?sitePageld=91320&orgld=bcwba>, retrieved May 17, 2011)

Queens County Women's Bar Foundation  
<http://qcwba.com/committees.html>

Although absolute exclusivity of use is not required by Applicant, *see L.D. Kitchler Co. v Davoli, Inc.* 192 F3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999), the numerous third-party uses clearly show that others are using the wording "WOMEN'S BAR FOUNDATION" to describe substantially similar charitable fundraising services and the provision of scholarships. Because Applicant's use is not "substantially exclusive," Applicant may not rely on its asserted five years' use to show that the wording in the applied-for mark has acquired distinctiveness.

In conclusion, the record simply does not support a finding that the wording "Women's Bar Foundation" has acquired distinctiveness as an indicator of source of Applicant's charitable foundation services and its services of providing educational scholarships. Accordingly, we find that the wording has not acquired distinctiveness in connection with the identified services.

**Decision:** The refusal to register based on the requirement for a disclaimer of the wording WOMEN'S BAR FOUNDATION is affirmed, and we find that Applicant has failed to establish acquired distinctiveness of that term. However, if Applicant submits the required disclaimer of WOMEN'S BAR FOUNDATION to the Board within thirty days of the mailing date of this decision, the decision will be set

aside as to the affirmance of the disclaimer requirement.<sup>6</sup> See Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g).

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<sup>6</sup> The standard printing format for the required disclaimer text is as follows: “No claim is made to the exclusive right to use Woman’s Bar Foundation apart from the mark as shown.” TMEP § 1213.08(a)(i) (8<sup>th</sup> ed. 2011).