

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Citizens Disability, LLC

Serial No. 85887875

Michael R. Reinemann of Cesari and McKenna LLP for Citizens Disability, LLC.

Betty Chang, Trademark Examining Attorney, Law Office 115 (John Lincoski,
Managing Attorney).

Before Seeherman, Zervas and Greenbaum, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Citizens Disability, LLC (“Applicant”) seeks registration on the Principal
Register of the mark CITIZENS DISABILITY HELPLINE (in standard character
form) for:

“Counseling and assisting others in obtaining medical or disability
related benefits, namely, Social Security Disability and Supplemental
Security Income benefits” in International Class 36; and

“Representing others in obtaining medical or disability related benefits, namely Social Security Disability and Supplemental Security Income benefits” in International Class 45.”¹

Applicant entered a disclaimer of “disability helpline.”

The Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), having determined that Applicant’s mark is likely to cause confusion or mistake or to deceive in view of Reg. No. 3991304, registered on the Supplemental Register, for the standard character mark DISABILITY HELPLINE for “Advertising services; Attorney referrals, namely, forwarding inquiries by potential clients to social security lawyers and advocates” in International Class 35.²

When the refusal was made final, Applicant appealed and filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

Evidentiary Issue

Applicant, with its brief, submitted for the first time two Office actions from the file of the cited registration. The Examining Attorney raised an objection to “evidence filed after appeal,” stating:

The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. ... Applicant has not shown that its evidence (i.e., the cited case opinion) had previously been unavailable and applicant has not sought to remand this case for

¹ Application Serial No. 85887875 was filed on March 27, 2013, based on an allegation of first use and first use in commerce of July 2, 2010 for the services in both International Classes.

² Registered July 5, 2011. Registration No. 3991304 contains a disclaimer of “helpline.”

further examination. Therefore, the Board should disregard applicant's evidence on this point.³

We construe the objection to be directed to the two Office actions and not to a published "case opinion," which, of course, would not be part of an evidentiary record. Thus, the Examining Attorney's objection is sustained because the two Office actions do not form part of the record of the present application by operation of the rules and because the evidentiary record in an application should be complete prior to the filing of an appeal to the Board. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP § 207.01 (2014).

Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Each of these factors may, from case to case, play a dominant role. *du Pont*, 177 USPQ at 567.

In this case, the strength of the cited registration, or rather the lack of strength, plays a significant role in our analysis. The cited registration, as noted above, is on the Supplemental Register. Marks that are not registrable on the Principal Register, such as those that are merely descriptive within the meaning of Section

³ Brief at unnumbered p. 12.

2(e)(1) of the Trademark Act, may be registrable on the Supplemental Register. The registration of DISABILITY HELPLINE on the Supplemental Register, rather than on the Principal Register, indicates that it is a merely descriptive term, and therefore is entitled to a limited scope of protection. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (an application for registration on the Supplemental Register of a particular term is an admission of descriptiveness).

The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). That is, the descriptiveness of a mark may result in a more narrow scope of protection. As the predecessor to our primary reviewing court stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958), in which no likelihood of confusion was found between SURE-FIT and RITE-FIT for ready-made slip covers:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

When marks are registered on the Supplemental Register because they are descriptive, the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and

goods or services are substantially similar. *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

With the foregoing in mind, we consider the similarity or dissimilarity of the marks. The Examining Attorney contends that Applicant has merely added the suggestive wording “CITIZENS” to the registered mark “DISABILITY HELPLINE”; and that merely adding a term to a registered mark generally does not obviate the similarity between the compared marks.⁴ Applicant, on the other hand, argues that “CITIZENS” is the dominant element of its mark; “enjoys a positive connotation relating to patriotism, civic responsibility, and civilian membership of a nation”; and results in a mark that creates a different connotation and commercial impression from the registered mark.⁵

The Examining Attorney’s argument ignores that the entirety of the cited mark is merely descriptive of a feature of the registrant’s services. The common term, DISABILITY HELPLINE, is also merely descriptive of a feature of Applicant’s services, and the Examining Attorney required Applicant to disclaim this term, and submitted evidence in support of her requirement. Applicant disclaimed DISABILITY HELPLINE. We agree with Applicant that the term CITIZENS is the dominant element of CITIZENS DISABILITY HELPLINE. Its significance as the dominant element of Applicant’s mark is further reinforced by its location as the first part of the mark. See *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is

⁴ Brief at unnumbered p. 3.

⁵ Brief at pp. 4-5.

most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imports*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word). When the marks are compared as a whole, they therefore convey different connotations and commercial impressions.

Turning to the similarity or dissimilarity of the services, the attorney referral services identified in the cited registration are the closest to Applicant’s counseling, assisting and representational services pertaining to social security disability and supplemental security income benefits. However, despite the evidence submitted by the Examining Attorney of a relationship between these services, we point out that by no means are the services identical, and in fact, there are differences.

Thus, despite the Examining Attorney’s evidence of a commercial relationship between Applicant’s and the registrant’s identified services, given the differences in the marks and services and the limited scope of protection to which the cited Supplemental Registration is entitled, we find that confusion is not likely between Applicant’s and the cited registered mark.

Decision: The refusal of registration is reversed.