

ESTTA Tracking number: **ESTTA726415**

Filing date: **02/11/2016**

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

Proceeding	86087067
Applicant	Marotta, Paul David
Applied for Mark	THE CORPORATE LAW GROUP
Correspondence Address	PAUL DAVID MAROTTA THE CORPORATE LAW GGROUP 1342 ROLLINS RD BURLINGAME, CA 94010-2410 UNITED STATES paul@tclg.com
Submission	Appeal Brief
Attachments	Appeal Brief 2016-02-11 FINAL.pdf(134638 bytes )
Filer's Name	Megan Jeanne
Filer's e-mail	megan@tclg.com, paul@tclg.com
Signature	/Megan Jeanne/
Date	02/11/2016

PAUL DAVID MAROTTA (CA State Bar No. 111812)  
MEGAN JEANNE (CA State Bar No. 251294)  
THE CORPORATE LAW GROUP  
1342 ROLLINS ROAD  
BURLINGAME, CA 94010  
Telephone: (650) 227-8000  
Facsimile: (650) 227-8001  
Email: paul@tclg.com  
megan@tclg.com

---

**IN THE TRADEMARK TRIAL AND APPEALS BOARD**  
**APPEAL BRIEF RE: THE CORPORATE LAW GROUP**

---

In re Application:	)	Appeal No. 86087067
	)	
Serial No.: 86087067	)	Examining Atty: Jonathon R. Falk
	)	
Mark: THE CORPORATE LAW GROUP	)	
	)	
Applicant: Paul David Marotta	)	
	)	
Class No.: 42	)	
	)	
	)	
	)	

---

COMES NOW, Paul David Marotta (“Applicant”) doing business as The Corporate Law Group and respectfully presents the opening brief in his appeal of the final office action of trademark Examiner Jonathon R. Falk (“Examiner”) denying registration of “THE CORPORATE LAW GROUP” ( the “Mark” and the “Marks” for both prior registrations) based on claims of genericness and descriptiveness.

**Alphabetical Index of Cases**

Cases

*Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, Cancellation No. 92050879 against Registration No. 3048114 (TTAB July 2, 2013)..... 12

*Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*,  
Cancellation No. 92051369 (TTAB September 17, 2012)..... 10, 12

*Coach/Braunsdorf, Inc. v. 12 Interactive, LLC*, Cancellation No. 92051006 (TTAB March 24, 2014) ..... 8

*Devcon Corp. v. Woodhill Chem. Sales Corp.*,  
45 F.2d 830, 172 U.S.P.Q. 417, 173 U.S.P.Q. 257 (1<sup>st</sup> Cir.), *cert. denied*, 400 U.S. 916 (1970)..... 19

*Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538 (1920)..... 18

*G. Heilman Brewing Company, Inc., v. Anheuser-Busch, Inc.*, 873 F.2d 985 (1989) ..... 18

*H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*,  
782 F.2d 987, 228 USPQ 528, (Fed. Cir. 1986)..... 8, 12

*In re Aloe Bioscience, LLC*, Serial No. 85531266 (TTAB May 13, 2015)..... 10, 11

*In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2006) ..... 12

*In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999)..... 10, 15

*In re County Music Association, Inc.*, 100 USPQ2d 1824 (TTAB 2011)..... 10, 14, 15

*In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) ..... 10, 23

*In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005)..... 9

*In re Loew’s Theatres, Inc.*, 769 F.2d 764 (Fed. Cir. 1985) ..... 20

*In re Meridian Rack & Pinion DBA buyautoparts.com*  
(TTAB Serial No. 85504151, April 21, 2015)..... 9, 10

*In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*,  
828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987)..... 9, 12

*In re Nat’l Data Corp.*, 753 F.2d 1056 (Fed.Cir.1985)..... 18

*In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985)..... 11

*In re Oppedahl & Larson LLP*, 373 F. 3d 1171 (Fed. Cir. 2004)..... 18

*In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971)..... 19

*In re Societe Generale des Eaux Minerales de Vittal S.A.*,  
824 F. 2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987)..... 12

<i>In re Steelbuilding.com</i> , 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) .....	10
<i>In re Tennis Industry Association</i> , 102 USPQ2d 1671 (TTAB 2012) .....	10
<i>In re the American Academy of Facial Plastic and Reconstructive Surgery</i> , 64 USPQ2d 1748 (TTAB 2002).....	21, 22
<i>In re The Country Vintner</i> , Serial No. 85567206 (TTAB, October 8, 2014).....	10, 11
<i>In re Thomas Nelson, Inc.</i> , 97 USPQ2d 1712 (TTAB 2011).....	23
<i>Magic Wand, Inc. v. RDB Inc.</i> , 940F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991) .....	8
<i>Q-Tips, Inc. v. Johnson &amp; Johnson</i> , 98 U.S.P.Q. 86 (3 <sup>rd</sup> Cir.), <i>cert. denied</i> , 346 U.S. 867 (1953) .....	18

Statutes

15 U.S.C. § 1052(f).....	22, 23
37 C.F.R. § 2.41(b) .....	23
37 C.F.R. § 2.41 (a).....	22

Other Authorities

TMEP 1212.02(c) .....	26
TMEP 1212.02(f)(i) .....	26
TMEP 1212.04(b) .....	26
TMEP 1212.05 .....	23
TMEP 1212.06.....	22

**Table of Contents**

**Page No.**

I.	INTRODUCTION.....	5
II.	DESCRIPTION OF THE RECORD.....	5
III.	STATEMENT OF THE ISSUES.....	7
IV.	STATEMENT OF FACTS .....	7
V.	APPLICANT’S MARK IS NOT GENERIC .....	7
	A. The Test for Genericness.....	8
	B. The Burden to Prove Genericness Rests on Patent and Trademark Office.....	9
	C. Applicant’s Mark Should be Judged as a Whole Phrase.....	9
	D. The Proffered Evidence Falls Short of the USPTO’s Burden.....	12
	E. Applicants Mark is no more Generic than Other, Similar, Registered Marks.....	15
	F. Applicant’s Mark is a Source Identifier.....	16
VI.	APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE.....	17
VII.	APPLICANT’S MARK HAS ACHIEVED ACQUIRED DISTINCTIVENESS.....	19
	A. Test.....	19
	B. Proof.....	19
	C. Long-Term Usage by Applicant.....	20
	D. The Mark Had Previously Been Granted Incontestability.....	20
	E. Applicant’s Promotional Efforts Have Reached Millions of People.....	20
	F. Applicant’s Sales under the Mark are Not Insignificant.....	21
	G. The Mark is a Recognized Source Identifier in the Industry.....	21
	H. The Prior Registrations Show Secondary Meaning.....	22
VIII.	SUMMARY .....	23

## I. INTRODUCTION

Applicant has used the Mark THE CORPORATE LAW GROUP continuously in interstate and international commerce since August 1, 1991. On January 12, 2001, after using the Mark for almost 10 years, Applicant applied to register the Mark. The Mark was registered on the principal register with a finding of secondary meaning on April 16, 2002 under Registration number 2561953. The typed drawing submitted with that Registration was typed in all capital letters. Applicant will refer to this registration herein as the “Standard Character Registration.”

On September 6, 2007 Applicant filed a Combined Declaration of Use and Incontestability Under Sections 8 & 15 for the Standard Character Registration.

Applicant also registered the Mark on August 12, 2003, THE CORPORATE LAW GROUP as a design plus words, letters, and/or numbers, as Registration number 2750351. In connection with this Mark

Applicant submitted a stylized design substantially as follows:  Applicant will refer to this registration herein as the “Design Registration.”

On June 23, 2009 Applicant filed a Declaration of Use of Mark in Commerce Under Section 8 for the Design Registration.

Unfortunately, due to calendaring errors Applicant failed to timely file Statements of Continued Use for the Standard Character Registration and the Design Registration and both Marks were cancelled.

## II. DESCRIPTION OF THE RECORD

The Record substantively consists of Applicant’s application and standard character drawing, four outgoing office actions and four responses thereto.

### The Four Office Actions

In the course of this Registration, Applicant received four office actions from the Examiner. The first office action is dated January 27, 2014 and included two issues: (i) A refusal to register the Mark as descriptive, and (ii) a request to have the prior registration claimed.

Applicant responded on May 12, 2014 claiming the prior registrations and arguing that the Mark is

not merely descriptive based on acquired distinctiveness; an argument that Applicant made in the initial registrations and which carried the day there.

The Examiner responded with an office action dated May 30, 2014 in which it argued that (i) the acquired distinctiveness claim was insufficient, and (ii) again refusing to register on a claim of mere descriptiveness.

Applicant responded to this office action on November 25, 2014 responding to certain arguments made by the Examiner and submitting therewith declarations from over twenty clients. Each of these clients declared that (i) they associated the Mark with, and only with Applicant, (ii) they had never seen anyone else using any kind of identification or branding similar to the Mark, (iii) if they saw anyone using the Mark they would immediately associate the person or firm using the Mark with Applicant, (iv) to their knowledge there is only one law firm doing business under the Mark, and (v) they associate the Mark with Applicant's firm and Applicant's firm alone.

The Examiner responded with an office action dated December 17, 2014 in which it argued that (i) it was refusing registration of the Mark based on genericness, (ii) it was refusing registration of the Mark as merely descriptive in the alternate, and (iii) the acquired distinctiveness claim was insufficient.

On June 17, 2015, Applicant responded to this third office action arguing, *inter alia*, that the Mark is a source identifier, the Mark is an indicia of origin, and the Mark is Applicant's brand. With this response to office action, Applicant submitted nine declarations from lawyers who declared that (i) the Mark is well-known in the start-up corporation field, (ii) they know that Applicant's firm using the Mark has been in business continually for over 20 years doing business exclusively under the Mark, (iii) they had worked with Applicant and his firm using the Mark on many occasions and have always heard Applicant's law firm referred to by the Mark, and (vi) whenever they hear the Mark used they immediately think of Applicant's law firm located in Burlingame, California.

Throughout the first three office actions the Examiner argued that (i) the prior registrations were both completely irrelevant, (ii) the prior proof of secondary meaning was completely irrelevant, (iii) the continuous, open, and notorious use since 1991 was completely irrelevant, (vi) the clerical calendaring error

was completely irrelevant, and (v) non-source identifier use of a non-public, similar phrase, should be elevated to carry the day.

It appeared to Applicant as if the refusal to register was based on a change in Patent and Trademark Office guidelines and policy, rather than on application of relevant law. In fact, following receipt of the third office action, Applicant called the Examiner to see if he was missing an important element or could better understand the Examiner's thinking, but Applicant never received a return phone call.

On July 10, 2015 the Examiner sent a fourth and final office action refusing registration on the bases of genericness and descriptiveness, therein rejecting Applicant's arguments for acquired distinctiveness. It is from this final office action refusing registration that Applicant appealed on December 13, 2015.

### **III. STATEMENT OF THE ISSUES**

1. Is Applicant's Mark, THE CORPORATE LAW GROUP, generic? Applicant submits it is not.
2. Is Applicant's Mark, THE CORPORATE LAW GROUP, merely descriptive? Applicant submits it is not.
3. Has Applicant's Mark, THE CORPORATE LAW GROUP, achieved secondary meaning and acquired distinctiveness? Applicant submits that it has.

### **IV. STATEMENT OF FACTS**

Applicant is a lawyer who owns a law firm formed in the summer of 1991. Applicant works with companies within and without California. In the last 24 years Applicant, using the Mark, has advised on everything from an international arbitration conducted in Charleston, South Carolina, to a US company's acquisition of a UK company's assets, to a public Chinese company's compliance with US SEC reporting requirements.

When Applicant realized, to his horror, that he and his office had mis-calendared the proper dates for declarations of continued use of the Marks he filed an Application for Registration.

### **V. APPLICANT'S MARK IS NOT GENERIC**

Applicant's Mark is not generic and the Examiner did not raise a genericness refusal until the third

Office Action. The Mark was not generic when it was first registered in 2002 and Applicant's Mark has not become generic since 2012 when the prior registration lapsed. Applicant showed secondary meaning and acquired distinctiveness in 2002 regarding registration number 2561953. Applicant's Mark has not become less distinctive in the last several years, nor has it become more generic in the last several years.

None of the cases cited by the Examiner in refusing registration concerned a mark that had already been registered for 10 years, and had been declared incontestable. Granted, this is an unusual situation, but the fact that Applicant's Mark was registered and incontestable is not of no probative value in examining arguments of genericness. If Applicant's Mark is now claimed to be generic then either (i) it had to have been generic in 2002 when registered and the Patent and Trademark Office was in error, or (ii) it had to have become generic since 2002. Neither is the case.

A. The Test for Genericness.

As noted by the Examiner, there is a two part test to determine whether a designation is generic: (i) What is the genus of the goods and/or services at issue? and (ii) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services? *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Court of Appeals for the Federal Circuit held that, "critical issue in genericness cases is whether the members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *Id.* at 530. Applicant does not disagree with the Examiner that the proper genus of services for Applicant's Mark is "legal services". The relevant public for a genericness determination is "the purchasing or consuming public for the identified services." *Coach/Braunsdorf, Inc. v. 12 Interactive, LLC*, Cancellation No. 92051006, at pg. 9 (TTAB March 24, 2014); citing *Magic Wand, Inc. v. RDB Inc.*, 940F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

So the real question presented here is whether the public would think that THE CORPORATE LAW GROUP means the same thing as 'legal services'. But the two are not completely or even primarily interchangeable and no relevant purchaser would see them as equivalent. Persons seeking legal services related to divorce, criminal defense, estate planning and real estate would likely not approach Applicant to

obtain these services.

The converse is also true. Some areas of law practiced by Applicant may be included in the broad heading of ‘corporate law’<sup>1</sup> such as corporate formation or corporate governance. But many are not corporate law. These include employment law, securities law, intellectual property law, mergers and acquisition law, and others. In a Venn diagram ‘corporate law’ would be a small subset of, not a substitute for, ‘legal services.’

In fact, the phrase ‘corporate law’ in Applicant’s Mark is more a description of Applicant’s clients, than Applicant’s services. Applicant provides the kinds of diverse legal services that start-up corporations generally require. The phrase refers more to Applicant’s clients than Applicant’s services.

B. The Burden to Prove Genericness Rests on the Patent and Trademark Office.

Genericness is a fact-intensive determination. In determining whether a mark is generic, the United States Patent and Trademark Office has the burden of establishing by clear evidence and a substantial showing of evidence that a mark is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Any “doubt on the issue of genericness is resolved in favor of the applicant.” *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

C. Applicant’s Mark Should be Judged as a Whole Phrase.

An “inquiry into the public’s understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re Meridian Rack & Pinion DBA buyautoparts.com*, pg. 3 (TTAB Serial No. 85504151, April 21, 2015). As held by the TTAB in *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, “the fact that a term is derived from individual generic works or even a listing of generic words does not necessarily make the derived term generic.” *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, Cancellation No. 92051369, pg. 18 (TTAB

---

<sup>1</sup> Office Action dated 12/17/2014, page 2 (though the specific areas of practice argued to be included in ‘corporate law’ are not identified in the Office Action).

September 17, 2012).

Where the proposed mark is a phrase, as it is here with THE CORPORATE LAW GROUP, “the Board cannot simply cite definitions and generic uses of the constituent terms of a mark; it must conduct an inquiry into the meaning of the disputed phrase as a whole.” *In re Meridian Rack & Pinion DBA buyautoparts.com, supra*, at pgs. 3-4; citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836-37 (Fed. Cir. 1999).

The TTAB has previously found that the marks similar in format to Applicant’s Mark, e.g. THE VINTNER GROUP, COUNTY MUSIC ASSOCIATION, and TENNIS INDUSTRY ASSOCIATION, are phrases similar to AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE requiring inquiry into “the meaning of the disputed phrase as a whole”. See *In re Tennis Industry Association*, 102 USPQ2d 1671 (TTAB 2012); *In re The Country Vintner*, Serial No. 85567206 (TTAB, October 8, 2014); *In re County Music Association, Inc.*, 100 USPQ2d 1824 (TTAB 2011).

As such, THE CORPORATE LAW GROUP should be evaluated on its whole rather than by its individual words. A comparison with ‘corporate law group’ or ‘corporate law’ is improper. The use of the important word, “THE”, in Applicant’s Mark implies uniqueness and exclusiveness, both of which are important in identification of a single source.

In past instances, the TTAB has found that names which may, on one level, be deemed generic were not actually generic when used as part of a brand name and source identifier. The TTAB found in *In re Aloe Bioscience, LLC* that although the word “Bioscience” could be generic, the fact that it was being used by the applicant as part of a product and company brand name “to describe the nature of their business does not render ‘Bioscience’ generic for the goods at issue in this application.” *In re Aloe Bioscience, LLC*, Serial No. 85531266, at pages 18-19 (TTAB May 13, 2015). The TTAB went on to further state that “[t]aken in its entirety, the evidence establishes that ‘Bioscience’ is merely [a] descriptive term for a company involved with goods such as Applicant’s goods [i.e. dietary drinks and supplements,

dermatologicals, pharmaceuticals, mouth and teeth preparations, and cosmeceuticals, all containing aloe]; however, the record, does not show ‘Bioscience’ is a generic entity designator or otherwise a generic terms for Applicant’s goods.” *Id.* at 19. After considering all of the evidence and arguments presented, the TTAB held that the ALOE BIOSCIENCE mark is not generic for its dietary drinks and supplements, dermatologicals, pharmaceuticals, mouth and teeth preparations, and cosmeceuticals, all containing aloe because:

“The definitions of the individual words “aloe” and “bioscience” are insufficient to prove that Applicant’s composite mark ALOE BIOSCIENCE is not capable of distinguishing Applicant’s goods. While “aloe” may be a generic term for the goods which contain “aloe,” “bioscience” merely describes a feature or characteristic of the goods. The internet evidence also does not show the genericness of ALOE BIOSCIENCE or of “Bioscience.” Therefore, the use of “aloe” and “bioscience” together in the mark ALOE BIOSCIENCE does not result in a generic term. Even if we treat ALOE BIOSCIENCE as a phrase, rather than a compound term, the record supports the finding that ALOE BIOSCIENCE is not generic when used in connection with Applicant’s goods even in the absence of evidence that Applicant’s competitors use the term ALOE BIOSCIENCE. The evidence noted above establishes that ALOE BIOSCIENCE describes, but does not identify the type of goods Applicant is selling (i.e., dietary drinks and supplements, dermatologicals, pharmaceuticals, mouth and teeth preparations and cosmeceuticals, all containing aloe).” *Id.* at 20-21.

Here THE CORPORATE LAW GROUP has been distinguishing and identifying Applicant’s services since 1991. As with ALOE BIOSCIENCE, THE CORPORATE LAW GROUP describes, but does not identify the type of services Applicant provides (such as, in this case, litigation, mergers, licensing, employment, venture capital, securities, and the like, as well as corporate law).

Applicant’s Mark THE CORPORATE LAW GROUP is meant to be read together as a phrase and, therefore, an inquiry into its meaning as a whole is necessary to determine whether it is generic for “legal services”. “Evidence of this relevant public’s understanding of the term at issue may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications.” *In re The Country Vintner, supra*, pg. 12; citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

In this case, the genus “legal services” covers a broad range of legal practices, many of which Applicant does not provide, including services related to patent law, medical and health care law, real estate

law, entertainment law, criminal defense, sports law, immigration law, bankruptcy law, domestic violence law, education law, government law, environmental law, tax law, and prisoners' rights law. How can THE CORPORATE LAW GROUP be generic for an entire industry of law if it only practices (and implies it only practices) a small subset of that industry, and even then primarily only to corporations? See *H. Marvin Ginn Corporation, supra*, 782 F.2d at 991 [The "term 'Fire Chief,' is neither the name of the fire-fighting industry nor about the fire-fighting industry. We therefore conclude that the board clearly erred in finding Ginn's mark FIRE CHIEF, for a magazine directed to the field of fire fighting, to be generic."]

D. The Proffered Evidence Falls Short of the USPTO's Burden.

The evidence proffered to show that THE CORPORATE LAW GROUP is so commonly generic as to be unregistrable falls far short of the clear showing necessary to meet the Patent and Trademark Office's burden. As in *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, Cancellation No. 92050879 against Registration No. 3048114, pg. 36 (TTAB July 2, 2013), the evidence proffered by the Examiner, when considered as a whole, shows a mixed record of use of the phrase "corporate law group" both generically and as part of trademarks or tradenames. See *Baroness Small Estates, Inc., supra* ["A mixture of usages is not sufficient to show, by clear evidence, that the purchasers of wine view CMS as a generic term for wine."]; *In re Merrill Lynch, Pierce, Fenner, and Smith Inc., supra*, at 1143; *In re America Online Inc., 77 USPQ2d 1618, 1623* (TTAB 2006).

The TTAB further held in *In re America Online* that "the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by third parties." *Id.* at 1623. Courts have been loath to simply assume, without further evaluation of the substantive value of the specimen or the obscurity of the out-of-context result, results returned from an Internet search. As noted by Judge Rich in connection with a LEXISNEXIS search, "It is indeed remarkable to see the thoroughness with which NEXIS can regurgitate a placename casually mentioned in the news." *In re Societe Generale des Eaux Minerales de Vittel S.A., 824 F. 2d 957, 3 USPQ2d 1450, 1451* (Fed. Cir. 1987). The Court in *Baroness Small Estates, Inc., supra*, agreed that the same was true for words which could be returned by an Internet search. Ambiguous evidence fails to meet

the burden placed on the Patent and Trademark Office necessary to uphold a refusal of registration of Applicant's Mark.

Of the nine specimen proffered by the Examiner to show the alleged genericness of the Mark, only six use the actual words "corporate law group". Applicant has been aware of one of those six specimen, Walker Corporate Law Group, for several months and has been vigilant in looking for evidence of confusion or passing off, but is aware of neither. And Applicant has already threatened action against a firm using an identical mark on a website and that website was taken down by its promoters.

The Examiner cited use of [no caps] 'corporate law group' by large law firms. Large law firms internally referring to a practice group within that firm as their 'corporate law group' (i) do not use this term as a source identifier, (ii) do not promote its use outside the firm (and legal/business press), and (ii) frequently marry the phrase with, "of [law firm name]." <sup>2</sup> None of these uses are of the mark as a standalone phrase or as a source identifier.

Additionally most of the evidence proffered by the Examiner showing genericness are in the context of legal press concerning law firms or the business of law. People seeking start-up corporation services, the purchasing public relevant to Applicant's work or services, do not read or interact with such legal press.

Four of the six specimen off-handedly mention "corporate law group" buried within articles without any context of the potential circulation of these articles. Tellingly, by searching for "corporate law group" in LexisNexis, the search apparently returned only 79 articles with that combination of words and the Examiner only highlighted four of those results (approximately 5% of the returned results).

One specimen highlighted by the Examiner refers to an attorney who "pioneered" in-house corporate law groups, smaller groups of lawyers within a larger firm. Three of the nine specimen

---

<sup>2</sup> See, for example the following Attachments to the December 17, 2014 Office Action, 2 "A partner in the Mineola-based law firm's corporate law group," 3 "chair of the firm's corporate law group," 4 "the corporate law group of Meltzer, Lippe, Goldstein, & Breitstone," 5 "a member of the business and corporate law group [of Brenna Manna & Diamond]," etc.

highlighted by the Examiner do not even use the phrase “corporate law group” but, rather, refer to corporate lawyers and a “business and corporate law firm”. The Long Island Business News, a business newspaper in the hamlet of Ronkonkoma, New York and one of the sources to which the Examiner points as evidence of generic use of the phrase “corporate law group”, appears to have a relatively small circulation of about 6,200 as of August 2011<sup>3</sup>. The South Carolina Lawyers Weekly, another source identified by the Examiner, appears to have an even smaller circulation of 1,700 persons<sup>4</sup> and is targeted specifically towards lawyers in South Carolina.

The Daily Record of Rochester, another source used by the Examiner, again appears to be directed towards lawyers and other legal professionals in the Rochester, New York area, not purchasers of legal services. Similarly, the Daily Record appears to have a small circulation of approximately 4,000 persons<sup>5</sup> and is limited to a small geographical region. The Cleveland Plain Dealer is also another regional publication serving Northeast Ohio.

The most recently published article from the batch of regional publications proffered by the Examiner is September 28, 2011, with the other three being published in October and November 2010 and December 2008. It is unclear from the results returned by the Examiner’s LEXISNEXIS search whether any of these articles were accessed by persons or entities looking for the start-up corporation legal help, nor how recently such articles were accessed at all. At best, these results show that lawyers and the legal community sometimes identify internal law firm groups by a shorthand. But the relevant purchasing public does not make decisions based on an examination of the internal structural designations used by large law firms for their personnel. In other words, even if there is a ‘corporate law group’ at law firm Smith, Smith & Jones the public would see itself as receiving services from Smith, Smith & Jones.

Similar to the evidence proffered by the Examiner in *In re Country Music Association, supra*, none of the entities specifically identified by the Examiner use the words “The Corporate Law Group” in

---

<sup>3</sup> <http://news.b2bcfo.com/wp-content/uploads/2012/02/longislandbusiness.pdf>

<sup>4</sup> <http://www.elarbeemedia.com/media/south-carolina-lawyers-weekly>. As of June 2015.

<sup>5</sup> [http://www.adhub.com/companies/the\\_daily\\_record.html](http://www.adhub.com/companies/the_daily_record.html). As of June 2015.

capitalized form as a trade or brand name or as a source identifier. As noted by the TTAB in *Country Music Association*, when used in initial capitalization form, and in conjunction with other descriptive, geographic, or other terms to designate the name of their respective organizations, the phrase “Country Music Association” was indicative of a trade or brand name. *In re Country Music Association, supra*.

The Mark THE CORPORATE LAW GROUP is not generic but is rather an apt name for a law firm that provides legal services to corporations. See *In re County Music Association, supra*; see also *In re American Fertility Society*, 51 USPQ2d at 1836 (“AMERICAN BAR ASSOCIATION is certainly an apt name for a national association of lawyers.”).

E. Applicants Mark is no more Generic than Other, Similar, Registered Marks.

Several similar third party marks have been granted registration by the Patent and Trademark Office. If a trademark including the terms “law group” and a practice-type specific word is so descriptive of the legal services genus, why are there currently 463<sup>6</sup> records of such trademark applications and registrations in the USPTO’s database?

Applicant’s Mark is similar to several registered marks using similar language, including THE EMPLOYMENT LAW GROUP (Reg. No. 3436135), SOCIAL SECURITY LAW GROUP (Reg. No. 2519230), INNOVATION LAW GROUP (Reg. No. 3105968), WORKERS’ INJURY LAW & ADVOCACY GROUP (Reg. No. 3925182), R&S INTERNATIONAL LAW GROUP (Reg. No. 4640530), and 866SUE2WIN.COM PERSONAL INJURY LAW GROUP (Reg. No. 3562397). All of these marks are registered on the Principal Register, all are related to the field of legal services, and all are fairly apparent from the face of the mark as to what subset of legal services each applies. Applicant agrees that these marks should be registered on the Principal Register and agrees that these Marks operate as a source identifier for their owners. Similarly, Applicant’s Mark was already found non-generic, registered twice, made incontestable, and found to have secondary meaning and acquired distinctiveness, all of which were proper when done. Therefore, registration should be granted Applicant’s Mark.

---

<sup>6</sup> As of February 9, 2016

F. Applicant's Mark is a Source Identifier.

Since the first day Applicant opened his firm Applicant's Mark has been a source identifier and a designation of origin. There is no other THE CORPORATE LAW GROUP. In the course of the registration process Applicant provided (i) over 20 client and business person declarations, and (ii) letters from nine attorneys, all acknowledging that THE CORPORATE LAW GROUP is a source identifier for Applicant.

Once past the promotional listings in a Bing search for "The Corporate Law Group" the top three results are for Applicant's (i) website, (ii) Facebook page, and (iii) LinkedIn page. Additionally, Applicant's Yelp page listing comes right after a Wikipedia listing and a news listing. Following that is a 'Corporate Law Group' in India<sup>7</sup> and, after that, Walker Corporate Law, on which Applicant has his eye. Similarly, the first six returns for a Google search of "the corporate law group" link to Applicant's website, Yelp page, LinkedIn page, and two yellow page listings.

Applicant promotes the Mark through a twitter feed at @tclg, and has placed the Mark on coffee mugs, magnets, water bottles, shirts, and other personal products. And Applicant has used the Mark on the firm's website since 1996.

Under the Mark Applicant has (i) worked with other business and legal professionals, (ii) presented at and met with college classes and teachers at Stanford University, the University of Southern California, and Chabot College, (iii) guest lectured in classes where entrepreneurs learn the basics and pitfalls incumbent on starting a business, (iv) served on judging panels for start-up elevator pitch competitions, and (v) provided sponsored prizes and services to contest winners.

THE CORPORATE LAW GROUP is used by only one law firm as an indicia of origin which has asserted its exclusive rights to such use against others using the identical mark and phrase. Applicant has spent well over a hundred thousand dollars on advertising, marketing and promoting the Mark. THE

---

<sup>7</sup> Obviously the Indian lawyers operate in a jurisdiction where Applicant does not and outside the jurisdiction of the USPTO. Nonetheless, Applicant is aware of the Indian firm and the Indian lawyers have 'liked' Applicant's Facebook page.

CORPORATE LAW GROUP was a sponsor of the big wave surf contest The Mavericks Surf Contest for several years. Applicant provided checks to winners of the Silicon Valley Marathon where Applicant also operated an aide station handing out water, oranges, and electrolyte drinks, assisting with medical issues, and providing similar kinds of aid to thousands of runners.

Applicant has maintained @TheCorporateLawGroup email addresses for two decades. Applicant (i) spent \$1,200 promoting an event at Z Space Studio <http://zspace.org/>, (ii) advertised THE CORPORATE LAW GROUP on KFOX radio in the San Francisco Bay Area, (iii) sponsored whitewater raft trips, soccer games and other sporting events, and (iv) was involved in charities ranging from building homes in Juarez to teaching school in Dessie, Ethiopia, all using the Mark.

Applicant (i) promoted the Mark THE CORPORATE LAW GROUP through publication of articles on various legal topics, and webinars directed to various legal and business topics, (ii) retained the services of marketing professionals and spent several thousand dollars promoting Applicant's THE CORPORATE LAW GROUP brand, (iii) sponsored the 2005, 2006, 2007, and 2008 Silicon Valley Marathons; (iv) hosted a 15<sup>th</sup> anniversary party, and (iv) participated in copious seminar, webinar, and professional legal and business-related panels.

Applicant has promoted the firm using the Mark on and through the firm's website for almost twenty years, and has promoted the firm under the Mark through Twitter, Facebook, LinkedIn, and through distribution of Applicant's digital newsletter "BizBuzz". Over the last ten years, Applicant has sent approximately 250 digital BizBuzz newsletters using the Mark THE CORPORATE LAW GROUP.

Widespread recognition of THE CORPORATE LAW GROUP as Applicant's brand is reflected in the Applicant's revenue produced under Applicant's Mark. Applicant has provided several millions of dollars of legal services using the Mark as Applicant's source identifier. The Mark is and has been for almost 25 years a source identifier linked only to Applicant and the services his firm provides to start-up corporations.

## **VI. APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE**

In *G. Heilman Brewing Company, Inc., v. Anheuser-Busch, Inc.*, the court defined 'merely

descriptive’ as a term that, “specifically describes a characteristic or ingredient of an article. It can, by acquiring a secondary meaning, *i.e.*, becoming “distinctive of the applicant’s goods” (15 U.S.C. §1052(f)), become a valid trademark, [e.g., “bubbly champagne,” “Auto Page”]. *G. Heilman Brewing Company, Inc., v. Anheuser-Busch, Inc.*, 873 F.2d 985, 992 (1989).

THE CORPORATE LAW GROUP is also not merely descriptive. Although it consists primarily of a string of descriptive terms, it is an unusual name for a law firm. When the Mark was adopted in 1991 the Applicant was aware of only two law firm names as distinctive; almost every other law firm name consisted of a string of partner surnames. Two or more descriptive terms may be combined to form a valid arbitrary mark. *Q-Tips, Inc. v. Johnson & Johnson*, 98 U.S.P.Q. 86 (3<sup>rd</sup> Cir.), *cert. denied*, 346 U.S. 867 (1953).

Without belaboring the point, the Mark is not descriptive of the services Applicant’s firm provides; it is descriptive of for whom those services are provided. In addition to those practice areas mentioned earlier, Applicant’s law firm provides services in technology transfer, joint ventures and strategic partnerships, periodic reporting under the Securities Act of 1934, venture capital transactions, and international law. Even if the Mark is deemed descriptive of some of the services provided, it is certainly not descriptive of all. Applicant’s firm even assists clients with litigation from time to time, including in wrongful termination and discrimination claims.

Additionally, when reviewing the registrability of a trademark “[t]he law requires that a mark be ‘considered in its entirety.’” *In re Oppedahl & Larson LLP*, 373 F. 3d 1171, 1174 (Fed. Cir. 2004); citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 546 (1920). When considering the mark as a whole, the Examiner “may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *Id.*; citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed.Cir.1985). The Court of Appeals further explained that if the individual words “are merely descriptive of an aspect of appellant’s goods, the PTO must also determine whether the mark as a whole, *i.e.*, the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *Id.* at 1174-1175.

While individually the words “the”, “corporate”, “law”, and “group” may be descriptive of one thing or another, when used together as in the mark, the new combination serves to identify the specific law firm which provides many different services to start-up corporations. And when applicant began using the Mark, he was aware of only two other law firms, one national and one local, using a name not consisting of a string of surnames, “General Counsel Associates” and “Hyatt Legal Services.”

Here, there could be no impairment of competition by allowing this Mark. *See Devcon Corp. v. Woodhill Chem. Sales Corp.* 45 F.2d 830, 172 U.S.P.Q. 417, 173 U.S.P.Q. 257 (1<sup>st</sup> Cir.), *cert. denied*, 400 U.S. 916 (1970). Applicant is not attempting to prevent others from using “corporate”, “law”, or “group” as part of a trade or service mark. Therefore, the Mark was at its first use, and still is, unusual and unique in this industry and should be allowed. Additionally the Mark has already been federally registered once and but for a gross calendaring error would be both registered and incontestable today. No person has ever brought opposition or litigation against Applicant concerning the Mark. The Mark is associated publicly and professionally only with the Applicant. There are now apparently dozens of other “law groups” none of which are confused with the Applicant and, to Applicant’s knowledge, he was the first law firm in the United States to use the phrase ‘law group’ in its name.

## **VII. APPLICANT’S MARK HAS ACHIEVED ACQUIRED DISTINCTIVENESS**

Applicant’s Mark has achieved secondary meaning and acquired distinctiveness under 15 U.S.C. § 1052(f). Acquired distinctiveness was found by the PTO to exist for Applicant’s Mark 10 years ago and the Mark has become even more distinctive of the services Applicant provides through the Applicant’s substantially exclusive and continuous use in commerce for 24 years.

### **A. Test.**

An examiner may accept a claim of acquired distinctiveness if five years of use is established. The examiner must look to “whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public”. *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); 37 CFR 2.41 (a); TMEP 1212.06.

### **B. Proof.**

Applicant claims acquired distinctiveness in the Mark based on his almost 25 years of continuous use. In addition to the lengthy use of the Mark, Applicant has widely promoted the Mark as set forth herein and in Applicant's Declarations, and in the Declarations of several clients and lawyers submitted in response to the several office actions.

The existence of distinctiveness is a fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769 (Fed. Cir. 1985). Applicant has acquired distinctiveness in the Mark established by the facts submitted in the registration process and including, without limitation, the following:

a. Applicant has continuously used THE CORPORATE LAW GROUP in connection with his services since August 1, 1991 – almost 25 years;

b. Promotion of the Mark has reached millions of the relevant purchasing public through print, radio, and Internet advertising, and Applicant has provided several millions of dollars of legal work under the Mark; and

c. The Mark is recognized in the industry and purchasing public as a source identifier for Applicant.

C. Long-Term Usage by Applicant.

Section 2(f) provides that usage of a trademark for five or more years is *prima facie* evidence of distinctiveness. 15 U.S.C. § 1052(f); 37 C.F.R. § 2.41(b); TMEP 1212.05. Applicant has been using the Mark for almost 25 years, substantially longer than the five year, *prima facie* time period for distinctiveness.

D. The Mark Had Previously Been Granted Incontestability.

Applicant had previously been granted trademark registration for the same THE CORPORATE LAW GROUP Mark on April 16, 2002 (Reg. No. 2561953). Applicant filed a Section 8 and Section 15 Combined Declaration of Use and Incontestability on September 6, 2007. But for Applicant's failure to calendar the date by which its second Section 8 Declaration of Continued Use was to be filed, Applicant would have timely filed the necessary declaration and would have a validly registered and incontestable trademark today.

E. Applicant's Promotional Efforts Have Reached Millions of People.

The purchasing public has had wide exposure to Applicant's Mark. Applicant has advertised the

Mark almost 25 years, including in *Upside* and *Red Herring* magazines related to start-up businesses; sponsorship of the 2005, 2006, 2007, and 2008 Silicon Valley Marathons; sponsorships of concerts, white water raft trips, a 15<sup>th</sup> anniversary party, and many sporting events; through a semi-monthly digital newsletter called “BizBuzz”; and by participation in copious seminar, webinar, and professional legal and other business-related panels throughout the country.

F. Applicant’s Sales under the Mark are Not Insignificant.

Applicant’s widespread recognition by the purchasing public is reflected in the provision of several millions dollars in legal services under the Mark. Due to its widespread promotional efforts, Applicant has provided services to clients from across the United States including from Arizona, Washington, Texas, Massachusetts, New Hampshire, Florida, Wyoming, Idaho, Ohio, Nevada, and California. In addition to services provided to clients from across the United States, Applicant has also performed services for clients from Australia, Hong Kong, China, Great Britain, Japan, Dubai, India, Ethiopia, Canada, Germany, Romania, and Mexico.

G. The Mark is a Recognized Source Identifier in the Industry.

Most importantly, Applicant’s Mark has come to be recognized as a source identifier in the start-up corporation community. In response to an office action Applicant submitted letters from several attorneys, each of whom agreed that the Mark was associated with Applicant and Applicant’s work. Many clients and lawyers regularly refer business entities and startups to Applicant for corporation services. All of these activities, letters, and evidence, as well as the other evidence previously submitted or discussed herein, have contributed to the strong recognition of the Mark and its association with Applicant’s services within the industry and target market.

The Examiner cited *In re the American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002) for the proposition that the Mark is incapable of acting as a source identifier for Applicant’s services. However in *In re the American Academy of Facial Plastic and Reconstructive Surgery* the TTAB affirmed that the mark was “lacking in acquired distinctiveness,” not that it was incapable of acting as a source identifier. In fact “source identifier” is only mentioned in the dissent and

the majority only found that acquired distinctiveness was absent, not that it was impossible in that or any other case. The mark there had been in use about 5 years, and had not been previously registered, while Applicant has used his Mark for close to 25 years, and it was previously registered and incontestable. Applicant's clients would be surprised to learn that Applicant's Mark does not identify as its source, Applicant.

Additionally, in *In re the American Academy of Facial Plastic and Reconstructive Surgery* the mark consisted only of the words "FACIAL PLASTIC SURGERY." Here the words "THE" and "GROUP" add non-descriptive elements to Applicant's Mark, and CORPORATE LAW is not descriptive of most of Applicant's services.

Applying the two part test identified in *In re the American Academy of Facial Plastic and Reconstructive Surgery* (1) as illustrated above, the class of goods and services for the Mark includes several kinds of law, such as litigation, not generally associated with corporate law, and (2) the relevant public, unaware of the firm, would not understand the Mark to include litigation, intellectual property law, etc.

Finally, *In re the American Academy of Facial Plastic and Reconstructive Surgery* was decided in 2002, about the same time Applicant first registered his Mark and prior to registration of the second mark in 2003, and did not cause refusal then. Each of those Marks was registered for 10 years. The prior treatment of Applicant's Mark by the USPTO should have some bearing on its registrability today. Applicant does not argue simply that because the Mark was registered once it must be registered again; Applicant simply argues that the USPTO got it right the first time for all the reasons set forth herein.

H. The Prior Registrations Show Secondary Meaning.

An applicant may use three different types of evidence to establish a claim of acquired distinctiveness: (i) A claim of ownership of one or more prior registrations on the Principal Register of the *relevant portion of the mark* for goods or services that are the same as or related to those named in the pending application, (ii) A statement verified by the applicant that the *relevant portion of the mark* has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is

made, and (iii) Actual evidence of acquired distinctiveness of the *relevant portion of the mark*. TMEP 1212.02(f)(i).

Prior registrations of the same mark may be relied upon to “assist in resolving whether the mark in question has acquired distinctiveness”. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). A mark is considered to be the same mark if it is the “legal equivalent” of the mark in question. TMEP 1212.04(b). A mark “is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.” *In re Dial-A-Mattress Operating Corp.*, *supra*, 240 F.3d at 1347.

As previously stated, Applicant had, and inadvertently let lapse, two prior trademark registrations for similar marks, THE CORPORATE LAW GROUP (Registration Number 2561953) and a stylized mark for The Corporate Law Group (Registration Number 2750351). For close to 25 years Applicant has been providing services to clients under the Mark. The Mark Applicant seeks to register now is the same mark that was registered in 2002. Even though the previously registered trademarks lapsed due to calendaring errors, the Examiner can use the former registrations to see that Applicant has been using the same trademarks for over 24 years. As the Marks have previously been registered, the registrations show that the USPTO had deemed the marks non-descriptive in the past. *Id.*; TMEP 1212.02(c).

## VIII. SUMMARY

Applicant’s Mark is not generic because THE CORPORATE LAW GROUP, a law firm targeted to start-up corporations, both (i) does not provide all generic legal services, and (ii) provides much more than just corporate law legal services, (iii) Internet evidence alone is insufficient to show genericness, and (iv) doubt on the issue of genericness must be resolved in favor of the Applicant.

Additionally, (v) the Examiner’s few references to use of ‘corporate law group’ not as a source identifier is insufficient to show genericness, (x) the Mark should be evaluated as a complete phrase and, when so evaluated, is not generic, (y) the Mark is a brand name, and a source identifier, as well as an indicia of origin, and (z) Applicant has been vigilant regarding potential confusion and infringement.

Similarly, Applicant’s Mark is not merely descriptive because (a) it has been in open and exclusive

use for almost 25 years, (b) it has been the subject of significant advertising and promotion, (c) over 20 business persons have identified it with Applicant, (d) nine lawyers have identified it with Applicant, (e) it has been used with clients from many different states and countries, (f) the public understands THE CORPORATE LAW GROUP to primarily refer to the law firm started by Paul David Marotta in 1991, (g) persons seeking divorce, criminal defense, estate planning, or real estate legal services would not seek them from THE CORPORATE LAW GROUP, and (h) even if some people might understand that corporate governance and entity formation are included in the broader ‘corporate law’ that doesn’t make ‘corporate law’ synonymous with all ‘legal services.’

Finally, the fact that Applicant’s Mark was previously registered in two different forms, found not to be generic, found to have achieved secondary meaning and acquired distinctiveness, and declared incontestable, is not wholly without probative value in asking whether re-registration is appropriate. Anything other than giving some not inconsequential weight to these facts would be unfair

For all of these reasons, Applicant submits that the Mark should be allowed because (i) the Mark, although consisting of a string of descriptive words, is not merely descriptive, (ii) the Mark is unique in this industry and to start-up corporations, and (iii) there is no public policy reason for this Mark to be disallowed.

**DATED this 11<sup>th</sup> day of February, 2016.**

**The Corporate Law Group**

**/s/ Megan Jeanne**  
**Megan Jeanne for Applicant**