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Subject: U.S. TRADEMARK APPLICATION NO. 86087067 - THE CORPORATE LAW GROUP - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86087067

MARK: THE CORPORATE LAW GROUP

CORRESPONDENT ADDRESS:
MEGAN JEANNE

THE CORPORATE LAW GGROUP

1342 ROLLINS RD

BURLINGAME, CA 94010-2410

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: Marotta, Paul David

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

PAUL DAVID MAROTTA (hereinafter, "Applicant"), has appealed the trademark examining attorney's final refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the grounds that the applied for mark is generic for, or in the alterative merely descriptive of, applicant's services.

STATEMENT OF THE CASE

On October 9, 2013, applicant filed the present application for the standard character mark "THE CORPORATE LAW GROUP" for "Legal services; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration; Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of business, securities, venture capital, corporate governance, and finance; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of employment and labor law for both employees and employers; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of international law; Legal services, namely, trademark maintenance services" in International Class 45. In the first Office Action, dated January 27, 2014, registration was refused under Trademark Act Section 2(e)(1) because the applied-for mark was merely descriptive of applicant's services. Additionally, applicant was required to claim ownership of the mark in U.S. Registration No. 2750351. In applicant's May 12, 2014 response, applicant claimed the mark had acquired distinctiveness based upon long term use. Additionally, applicant's prior registration had cancelled.

In the second Office Action, dated May 30, 2014, applicant's claim of acquired distinctiveness was denied and the refusal under Trademark Act Section 2(e)(1) was continued. Applicant then filed a Response to Office Action, dated November 25, 2014, applicant claimed acquired distinctiveness based on ownership of cancelled registrations, long term use, and declarations from clients as well as argued against the refusal. In the third Office Action, dated December 17, 2014, registration was refused under Trademark Act Section 2(e)(1) because the applied-for mark is generic of applicant's services and merely descriptive in the alternative. In addition, applicant's claim of acquired distinctiveness was denied. In

applicant's June 17, 2015 response, applicant argued that they mark was not generic and that it had acquired distinctiveness.

On July 10, 2015, a Final Office Action was issued making the refusal because the applied-for mark is generic of, or in the alternative merely descriptive of, applicant's services and applicant's claim of acquired distinctiveness is insufficient. Applicant did not file a Request for Reconsideration and filed their appeal on December 13, 2015.

ISSUES

Applicant's mark "THE CORPORATE LAW GROUP" is generic for applicant's services necessitating a refusal under 15 U.S.C. §1052(e)(1) and applicant's claim of acquired distinctiveness under 15 U.S.C. §1052(f) is insufficient.

ARGUMENT

I. The Applied for Mark is Generic for Applicant's Services

A generic term is a common name that the relevant public uses or understands primarily as referring to the category or genus of the services in question. *In re Nordic Naturals, Inc*., 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *see* TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of services and cannot be registered as trademarks or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). Registering generic terms "would grant the owner of [a]

mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

(1) What is the genus of services at issue?

(2) Does the relevant public understand the designation primarily to refer to that genus of services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, *Inc.*, 782 F.2d at 989-90, 228 USPQ at 530; *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1463 (TTAB 2015) (citing *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the services is often defined by an applicant's identification of services. *In re Meridian Rack & Pinion*, 114 USPQ2d at 1463 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In this case, the application identifies the services as corporate legal services, which adequately defines the genus at issue.

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified services. *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In this case, the relevant public comprises ordinary consumers who purchase applicant's services, because there are no

restrictions or limitations to the channels of trade or classes of consumers. The evidence in record clearly shows that the wording "CORPORATE LAW GROUP" in the applied-for mark means the part of a law practice that specializes in the needs of businesses and corporations and thus the relevant public would understand this designation to refer primarily to that genus of services because it is a commonly used basic term to describe this part of a legal practice.

- *See* the previously attached evidence from Walker Corporate Law Group, PLLC, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 4]
- *See* the previously attached evidence from Galler Corporate Law Group, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 7]
- *See* the previously attached evidence from Adler Pollock & Sheehan P.C., showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 8]
- *See* the previously attached evidence from Donovan Hatem LLP, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 9]
- *See* the previously attached evidence from Gardner Corporate & Entertainment Law Group, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 10]
- *See* the previously attached evidence from Greenberg Glusker, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 11]

- *See* the previously attached evidence from Pearce & Durick, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 12]
- *See* the previously attached evidence from Peckar & Abramson, P.C., showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 13]
- *See* the previously attached evidence from Piliero Mazza, PLLC, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 14]
- *See* the previously attached evidence from Stark & Stark, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 1/27/14 at page 15]
- *See* the previously attached evidence from Bloomberg.com, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 12/17/14 at page 2]
- *See* the previously attached evidence from Long Island Business News, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 12/17/14 at page 7]
- *See* the previously attached evidence from South Carolina Lawyers Weekly, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 12/17/14 at page 9]
- *See* the previously attached evidence from The Daily Record of Rochester, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 12/17/14 at page 11]

- *See* the previously attached evidence from the Cleveland Plain Dealer, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Office Action dated 12/17/14 at page 14]
- *See* the previously attached evidence from Sullivan & Cromwell LLP, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 2]
- *See* the previously attached evidence from Maalouf Ashford & Talbot, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 3]
- *See* the previously attached evidence from Kirton McConkie, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 4]
- *See* the previously attached evidence from Asante Law Group, PC, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 5]
- *See* the previously attached evidence from Massillamany & Jeter LLP, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 6]
- *See* the previously attached evidence from Globalnewswire, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 7]
- *See* the previously attached evidence from Cincinnati.com, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 8]

- *See* the previously attached evidence from Palm Beach Daily News, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 9]
- *See* the previously attached evidence from LIBN, showing generic use of the term "CORPORATE LAW GROUP" used in connection with legal services. [Attachment to Final Office Action dated 7/10/15 at page 10]

Therefore, the wording "THE CORPORATE LAW GROUP" is generic wording for a specific type of legal service offered by applicant.

Applicant argues that the mark is not generic because they previously owned two cancelled registrations for the same or similar marks.

First, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). The facts and evidence in this matter clearly establishes that CORPORATE LAW GROUP is generic for legal services.

Additionally, a cancelled or expired registration is "only evidence that the registration issued and does not afford an applicant any legal presumptions under [Section] 7(b)," including the presumption that the registration is valid, owned by the registrant, and the registrant has the exclusive right to use the mark in commerce in connection with the goods and/or services specified in the

certificate. *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013) (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (C.C.P.A. 1973) (statutory benefits of registration disappear when the registration is cancelled); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB 2002)); *see* TBMP §704.03(b)(1)(A); TMEP §1207.01(d)(iv). Nor does a cancelled or expired registration provide constructive notice under Section 22, in which registration serves as constructive notice to the public of a registrant's ownership of a mark. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] canceled registration does not provide constructive notice of anything.").

Thus, applicant's prior registrations have little, if any, probative value with respect to the registrability of applicant's mark.

Finally, even if applicant's mark could have previously had a source identifying function, a mark may lose its distinguishing and origin-denoting characteristics through use in a generic sense over a period of time, and may come to be regarded by the purchasing public as nothing more than a generic designation. *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int'l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976).

Thus, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969).

Also, applicant argues that "legal services" are not the genus of applicant's services. First, applicant's identification of services includes the wording "Legal services." Secondly, a more specific genus for the remaining services is "corporate legal services." The evidence in the record clearly

establishes that the specific types of legal services listed in applicant's identification of services are all included under the genus of corporate legal services.

- *See* the previously attached evidence from The Princeton Review, showing corporate lawyers practice in the following fields: contract law, tax law, accounting, securities law, bankruptcy, intellectual property, licensing, zoning, business regulations, and others. [Attachment to Office Action dated 12/17/14 at page 17]
- *See* the previously attached evidence from Walker Corporate Law Group, showing corporate lawyers practice in the following fields: startup counseling, formation of business entities, intellectual property, employment law, securities law, commercial contracts, finance, licensing, and others. [Attachment to Office Action dated 12/17/14 at page 19]
- *See* the previously attached evidence from EnlightenMe, showing corporate lawyers practice in the following fields: business transactions, contracts, securities, tax law, regulations, intellectual property, bankruptcy, and others. [Attachment to Office Action dated 12/17/14 at page 22]
- *See* the previously attached evidence from JCPC LAW, showing corporate lawyers practice in the following fields: business contracts and transaction, business law, litigation, mergers and acquisitions, startups, business entity formation, intellectual property, real estate law, and others. [Attachment to Office Action dated 12/17/14 at page 25]

Also, the name of a key aspect, a central focus or feature, or a main characteristic of services may be generic for those goods and/or services. *See In re Hotels.com LP*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (affirming the Trademark Trial and Appeal Board's holding of HOTELS.COM as generic for travel agency services, namely, making reservations and bookings for temporary lodging, and providing information about temporary lodging); *In re Meridian Rack & Pinion*,

114 USPQ2d 1462, 1465-66 (TTAB 2015) (holding BUYAUTOPARTS.COM generic for on-line retail store services featuring auto parts); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); TMEP §§1209.01(c) *et seq.*; *see also In re Northland Aluminum Prods. Inc*., 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (holding RUSSIANART generic for art dealership services); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas). Thus, a term does not need to be the name of a specific service to be found generic.

Applicant argues that the burden of proof to show that the mark is on the Office, and that the Office has not met that burden. The trademark examining attorney has established by "clear evidence" that the applied-for mark is generic; thus the USPTO's evidentiary burden has been met. *See In re Hotels.com LP*, 573 F.3d 1300, 1302, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); TMEP §1209.01(c)(i). The evidence in the record is a non-exhaustive collection of twenty-four examples of third parties using the applied-for mark in a generic manner. This includes two firms using the applied-for mark in a generic manner in their firm name, thirteen firms using the applied-for mark in a generic manner to describe a division within their practice, and nine news sources using the applied-for mark in a generic manner to describe types of legal practices. The evidentiary burden is clearly met to show applicant's mark is generic.

Applicant argues that the mark must be judged as a whole phrase and not broken into individual aspects. This is correct as every piece of evidence attached by the undersigned in the record shows the wording "CORPORATE LAW GROUP" used in a generic manner as a whole. None of the evidence breaks

down any of this wording into its component parts. In assessing the genericness of a phrase, the evidence of record must show that the composite mark, when viewed as a whole, would be perceived by the relevant purchasing public as generic when used in connection with the relevant services. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345-46, 57 USPQ2d 1807, 1810-11 (Fed. Cir. 2001) (quoting *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1348-49, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760 (TTAB 2013); TMEP §1209.01(c)(i). In this case, all of the evidence in the record considers the wording "CORPORATE LAW GROUP" as a whole and shows it used in a generic manner.

Applicant also argues that the addition of the word "THE" makes the mark not generic. Adding the term "the" to a generic term generally does not add any source-indicating significance or otherwise affect the term's genericness. *See In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive of restaurant and bar services; "the definite article THE . . . add[s] no source-indicating significance to the mark as a whole"); *Conde Nast Publ'ns Inc. v. Redbook Publ'g Co.*, 217 USPQ 356, 357, 360 (TTAB 1983) (holding THE MAGAZINE FOR YOUNG WOMEN a "common descriptive or 'generic' name of a class or type of magazine" and incapable of indicating source; "[t]he fact that the slogan also includes the article 'The' is insignificant. This word cannot serve as an indication of origin, even if applicant's magazine were the only magazine for young women."); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive of, and the common descriptive name for, computer-related services); *see also In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff'd*, 360 F.2d 1966, 149 USPQ 619 (C.C.P.A. 1966) (holding "THE PILL" a common descriptive name for pharmaceutical preparations in tablet form, and thus does not serve as an indicator of source or origin in applicant).

Applicant argues that their applied-for mark is not generic because the board found the wording BIOSCIENCE to not be generic for specific goods in International Class 5. *See In re Aloe Bioscience, LLC*,

Serial No. 85531266 (May 12, 2015) [not precedential]. In that case the wording ALOE BIOSCIENCE was held to not be generic of applicant's services because none of the evidence in the record showed the wording ALOE BIOSCIENCE was generic and the evidence that was in the record only showed that this wording was merely descriptive of applicant's goods. However, in this case, all of the evidence in the record demonstrates generic usage of the phrase "CORPORATE LAW GROUP" when used in connection with legal services.

Applicant claims that there are only nine pieces of evidence in the record showing generic use of the mark and only six actually use the wording "CORPORATE LAW GROUP". However, as described in detail above, there are twenty four separate pieces of evidence in the record, all of which contain the wording "CORPORATE LAW GROUP" used in a generic manner. Applicant is correct that none of the evidence show the use of "CORPORATE LAW GROUP" as a stand-alone phrase intended to be a source identifier. However, this is because this wording is generic and is not capable of being a source identifier. The fact that an applicant may be the first or only user of a generic designation is not dispositive on the issue of genericness where, as here, the evidence shows that the word or term is generic. *See In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); TMEP §1209.03(c).

Additionally, applicant has attacked the sources of four the news articles showing "CORPORATE LAW GROUP" generically because they have a "small circulation." But based on applicant's statistics, each of these sources have circulations in the thousands, and applicant has provided no evidence showing the Cleveland Plain Dealer is a small regional publication. The Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action. *See In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003); (citing *In re*

Loew's Theatres, Inc., 769 F2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Florists' Transworld Delivery, Inc.*, 106 USPQ2d 1784, 1786 (TTAB 2013); TBMP §1208.

Applicant argues that the use of capital letters makes their mark not generic. However, the applied-for mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii).

Even if applicant amended the drawing to a stylized format showing the first letter of each word capitalized, the mark would still be generic. The degree of stylization in this case would not be sufficiently striking, unique, or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark. *See In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1490 (TTAB 2012); *In re Guilford Mills, Inc.*, 33 USPQ2d 1042, 1044 (TTAB 1994).

Applicant also argues that their mark functions as a source identifier because they are the top hits on a Bing® search results page. A search results summary from an Internet search engine has limited probative value because such a list does not show the context in which the term or phrase is used on the listed web pages and may not include sufficient surrounding text to show the context within which the term or phrase is used. TBMP §1208.03; *see In re Bayer AG*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006); TMEP §710.01(b).

Finally, applicant argues that the applied-for mark is not generic because similar marks have been allowed to register. The fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*,

196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive or generic does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive or generic is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566. In this case the evidence in the record clearly indicates that the applied-for mark is generic for applicant's services.

Therefore, the applied for mark is generic for applicant's services.

II. In the Alterative, the Applied-For Mark is Merely Descriptive of Applicant's Services and the Claim of Acquired Distinctiveness is Insufficient

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's services. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297,

1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The previously discussed evidence in the record clearly established that the wording "CORPORATE LAW GROUP" is commonly used in connection with applicant's type of services to mean a law practice that specializes in the needs of businesses. Therefore, the wording merely describes a characteristic of applicant's services.

Applicant argues that the mark is not descriptive of the services applicant's firm provides only descriptive of whom those services are provided. This statement is incorrect, as applicant's mark is clearly descriptive of a characteristic of applicant's services. Even if the mark were to merely describe the intended consumer of applicant's services, the mark would still be merely descriptive. A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); *see* TMEP §1209.03(i).

Applicant argues that while the mark could be deemed descriptive of some of their services it would not be descriptive of all of their services because they include assisting clients with "technology

transfer, joint ventures and strategic partnerships, periodic reporting under the Securities Act of 1934, venture capital transactions, and international law…Applicant's firm even assists clients with litigation from time to time, including in wrongful termination and discrimination claims."

First, "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Second, the previously discussed evidence of the record clearly establishes that technology transfer, business entity law, securities law, venture capital transactional law, international law, and litigation are all included under the umbrella of corporate law. Thus, the applied for mark would be descriptive of all of applicant's services.

Applicant argues that there could be no impairment of competition by allowing the mark to register. Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). The evidence in the record demonstrates widespread use of the wording "CORPORATE LAW GROUP" to describe either their entire firm or a portion of their firm. Allowing applicant to have exclusive rights to

this wording would inhibit competitors from using this wording which is already widely used among applicant's competitors.

In addition, applicant's claim of acquired distinctiveness in the response is a concession that the mark sought to be registered is merely descriptive of applicant's services. *In re Leatherman Tool Grp., Inc.*, 32 USPQ2d 1443, 1444 (TTAB 1994); *see Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

With respect to applicant's claim of acquired distinctiveness, the following evidence was provided in support of such claim: long term use, declarations of clients, and cease and desist letters. *See* 37 C.F.R. §2.41.

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the Section 2(f) evidence is insufficient to show acquired distinctiveness because the mark consists of highly descriptive wording that is commonly used in the marketplace to describe an area of a law firm that specializes in corporate law.

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Bd. of Trs. of Univ. of Ala. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970)); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); *see* TMEP §1212.05(a). The more descriptive a term is, the greater applicant's evidentiary burden to establish acquired distinctiveness becomes. *See, e.g.*, *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4 (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d at 1581, 6 USPQ2d at 1008); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013).

Applicant also argues that their previous registration was incontestable. A claim of acquired distinctiveness under Trademark Act Section 2(f) cannot be based on a registration that is cancelled or expired. *In re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1186 (TTAB 2014); TMEP §1212.04(d); *see In re BankAmerica Corp.*, 229 USPQ 852, 853 (TTAB 1986). Also, as stated above, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. Additionally, a cancelled or expired registration is "only evidence that the registration issued and does not afford an applicant any legal presumptions under [Section] 7(b)," including the presumption that the registration is valid, owned by the registrant, and the registrant has the exclusive right to use the mark in commerce in connection with the goods and/or services specified in the certificate.

CONCLUSION

In total, the applicant's mark is clearly generic when considered in the relation to the applied-for services or in the alternative is merely descriptive and applicant has not shown the mark has acquired distinctiveness. Therefore, for the foregoing reasons, the final refusal under 15 U.S.C. §1052(e)(1) should be affirmed.

Respectfully submitted,

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