

This Opinion is Not a
Precedent of the TTAB

Mailed: September 30, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mayer Brown LLP

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Serial No. 90044407

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Michael D. Adams and William R. Siegel of Mayer Brown LLP,
for Mayer Brown LLP.

Edward Germick, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

—
Before Bergsman, Shaw and Lebow,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Mayer Brown LLP (“Applicant”) seeks registration of the proposed mark 10HUNDRED, in standard characters, on the Principal Register for services identified as “legal services; legal advisory and consultancy services,” in International Class 45.¹

¹ Application Serial No. 90044407 was filed on July 9, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a declared intention to use the mark in commerce.

I. Prosecution History

Applicant filed its application based on an intention to use the mark in commerce under Section 1(b) of the Trademark Act. After publication of the mark and issuance of a notice of allowance, Applicant filed its statement of use. The Trademark Examining Attorney refused registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant's specimens submitted with the statement of use fail to show the mark in use in commerce in connection with the identified services.

In response to the refusal to register, Applicant submitted substitute specimens of use. In a final Office Action, the Examining Attorney continued the refusal to register on the ground that Applicant's substitute specimens also fail to show the mark in use in commerce. When the refusal was made final, Applicant appealed and requested reconsideration, and submitted additional substitute specimens. The request for reconsideration was denied and the appeal resumed. The case is fully briefed.²

We reverse the refusal to register.

II. Evidentiary objections

Before discussing the merits of the refusal, we briefly address an evidentiary objection asserted by the Examining Attorney in his brief. The Examining Attorney objects to evidence attached to Applicant's brief, specifically "a definition of the term

² All TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations reference the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

‘consultancy services’ from The Cambridge Dictionary (Exhibit A) and a screenshot from applicant’s website that was not previously made part of the record (Exhibit C).”³ The dictionary definition from The Cambridge Dictionary is for the verb “consult” which it defines as “to get information or advice from a person, book, etc. with special knowledge on a particular subject[.]”⁴

Regarding the dictionary definition, the Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018). Inasmuch as the meaning of “consult,” as used in “consultancy services,” is highly relevant to the refusal of registration, we exercise our discretion and take judicial notice of the definition. Regarding Exhibit C, the screenshot from Applicant’s website, we note that the exhibit was introduced previously as Exhibit E to Applicant’s January 26, 2022 Request for Reconsideration.⁵ Accordingly, we overrule the objection to both exhibits.

III. Analysis

A. Applicable Law

Although Section 1(b) of the Trademark Act permits an applicant to begin the registration process having only a “bona fide intention” to use a mark in commerce, 15 U.S.C. § 1051(b), the Act ultimately requires it “to show that the mark is being

³ Examining Attorney’s Br., 9 TTABVUE 2.

⁴ Exhibit A to Applicant’s Br., 7 TTABVUE 19-22; <https://dictionary.cambridge.org/us/dictionary/english/consult>, accessed April 29, 2022.

⁵ Applicant’s Request for Reconsideration of January 26, 2022, Ex. E, TSDR 33-40.

used in commerce before obtaining a registration on the mark.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). *See also In re MN Apparel LLC*, 2021 USPQ2d 535, *8 (TTAB 2021) (“The Trademark Act ‘provides for registration of a mark based on use of the mark in commerce.’”). To this end, an applicant seeking a service mark registration must, on filing a statement of use under Section 1(d), include one or more specimens showing the applied-for mark as actually used in connection with the services identified in the application. 15 U.S.C. § 1051(d); Trademark Rules 2.56, 2.88, 37 C.F.R. § 2.56, 2.88. *See also In re Fallon*, 2020 USPQ2d 11249, *2 (TTAB 2020); TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 904.07(a) (July 2022). “Generally, if ... more than one service, is specified in one class in an application, the applicant normally need not provide a specimen for each good or service.” TMEP § 904.01(a).

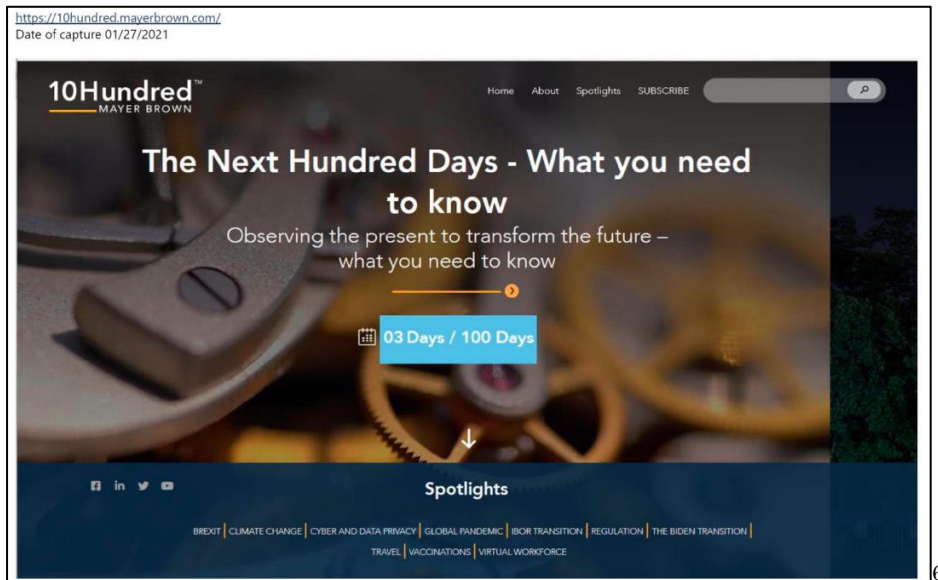
Under Section 45 of the Trademark Act, “a mark shall be deemed to be in use in commerce— ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce....” 15 U.S.C. § 1127. *See Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1027 (Fed. Cir. 2017) (“[T]o meet the use requirement for a service mark, an applicant must use the mark in advertising or sale of a service, and show that the service was actually rendered in interstate commerce or in more than one state, or in this and a foreign country, by a person engaged in commerce”). Accordingly, “[a] service mark specimen must show the mark as used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services. The

specimen must show a direct association between the mark and the services.”
37 C.F.R. § 2.56(b)(2).

Because a service mark can be used in a wide variety of ways, the types of specimens that may be submitted as evidence of use are varied. *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992). The varieties include advertising specimens, which show the mark displayed in advertising, marketing, and promoting the services, and rendering specimens, which show the mark used in the sale or performance of the services. *See On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476-77 (Fed. Cir. 2000). *See generally* TMEP § 1301.04(f)(ii).

B. Applicant’s specimens

In support of registration Applicant submitted three sets of specimens, mostly comprised of web page excerpts from its web site mayberbrown.com. The following examples are representative of the specimens submitted:



⁶ Applicant’s January 27, 2021 Statement of Use, TSDR 2.

<https://www.mayerbrown.com/en/news/2020/11/10hundred-series-portal-offers-legal-and-global-guidance-on-pivotal-issues-for-businesses>
April 16, 2021

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November 17, 2020 → **10Hundred Series portal offers legal and global guidance on pivotal issues for businesses**

Mayer Brown announced the launch of its [10Hundred Series portal](#), which provides global legal and business guidance on the top 10 key issues and pivotal developments that could affect businesses during a rolling 100-day period. The portal will feature thought leadership, legal updates, videos, podcasts, webcasts and live newsfeeds on global legal and business issues.

The portal will showcase a series of 'Spotlights,' which will highlight key issues, historic moments or pivotal change events which clients should be aware of in the next 100-day period. Two immediate Spotlights are already in progress: the [US post-election analysis](#) and [Brexit developments](#).

Click [here](#) to access the portal.

Related Capabilities

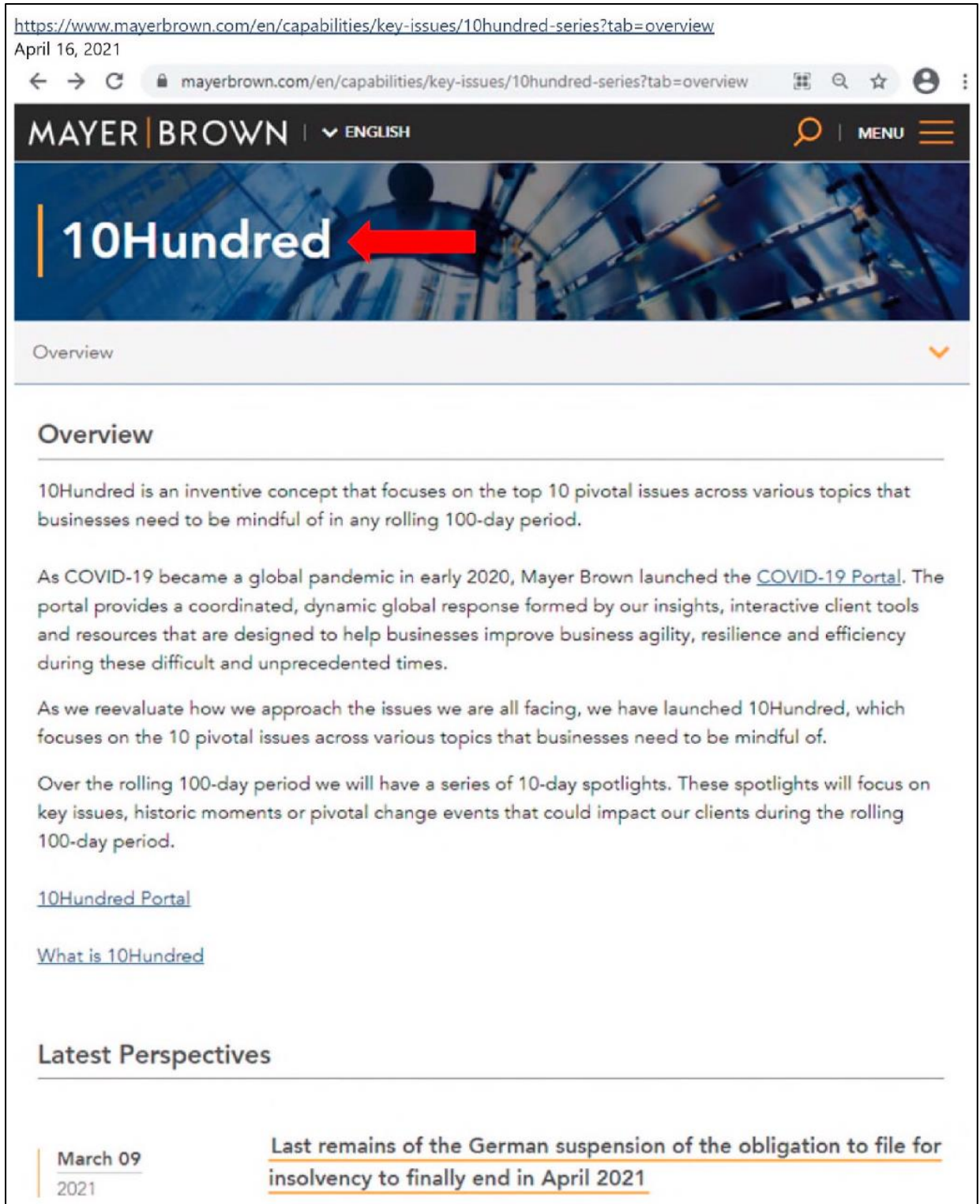
Key Issues – [10Hundred](#) ←

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⁷ Applicant's April 16, 2021 Response to Office Action, TSDR 2.



https://www.mayerbrown.com/en/capabilities/key-issues/10hundred-series?tab=overview
April 16, 2021

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10Hundred

Overview

Overview

10Hundred is an inventive concept that focuses on the top 10 pivotal issues across various topics that businesses need to be mindful of in any rolling 100-day period.

As COVID-19 became a global pandemic in early 2020, Mayer Brown launched the [COVID-19 Portal](#). The portal provides a coordinated, dynamic global response formed by our insights, interactive client tools and resources that are designed to help businesses improve business agility, resilience and efficiency during these difficult and unprecedented times.

As we reevaluate how we approach the issues we are all facing, we have launched 10Hundred, which focuses on the 10 pivotal issues across various topics that businesses need to be mindful of.

Over the rolling 100-day period we will have a series of 10-day spotlights. These spotlights will focus on key issues, historic moments or pivotal change events that could impact our clients during the rolling 100-day period.

[10Hundred Portal](#)

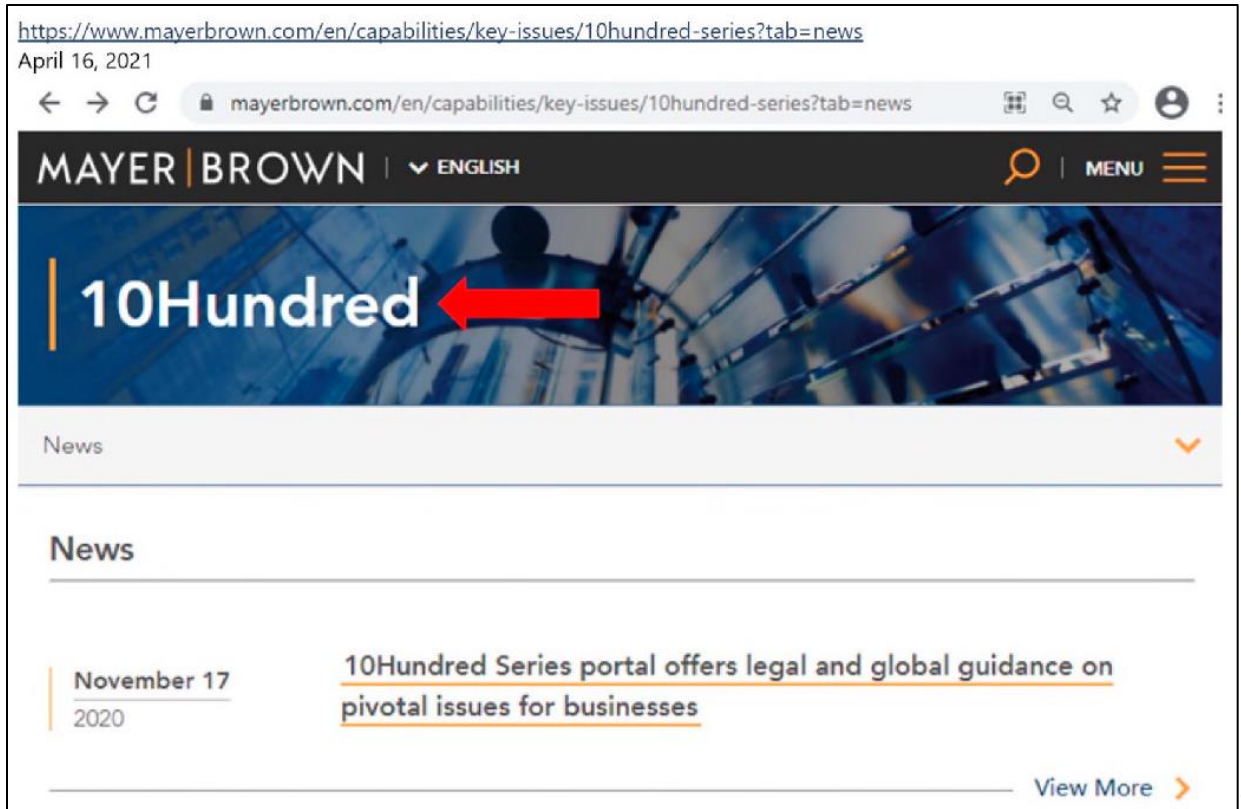
[What is 10Hundred](#)

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2021

[Last remains of the German suspension of the obligation to file for insolvency to finally end in April 2021](#)

⁸ *Id.* at 6.



As can be seen from the foregoing specimens, Applicant uses the mark 10HUNDRED to identify a program presenting “**global legal and business guidance** on the top 10 key issues and pivotal developments that could affect businesses during a rolling 100-day period.”¹⁰ The material is offered in a variety of formats through the “10Hundred Series portal” which, according to Applicant, “will feature thought leadership, **legal updates**, videos, podcasts, webcasts and live newsfeeds on global **legal and business issues**.”¹¹ The presentations, called “spotlights,” appear to be available to the general public, but are directed to

⁹ *Id.* at TSDR 4.

¹⁰ Applicant’s April 16, 2021 Response to Office Action, TSDR 2. Emphasis added.

¹¹ *Id.* Emphasis added.

Applicant’s clients: “These spotlights will focus on key issues, historic moments or pivotal change events that could impact **our clients** during the rolling 100-day period.”¹²

C. Discussion

According to the Examining Attorney, “the paramount dispute is whether either of the services listed in the statement of use, ‘legal services’ and ‘legal advisory and consultancy services,’ encompass the service or activity of providing ‘legal information,’ which is shown in the specimens.”¹³ The Examining Attorney introduced a definition of the term “legal services” as: “the work performed by a lawyer for a client.”¹⁴ He also introduced an article from a website, LegalMatch, titled “*Legal Advice vs. Legal Information.*” The article purports to explain the difference between legal advice and legal information, and states:

Legal advice is any written or oral counsel regarding a legal matter that impacts the responsibilities and rights of the person who receives it. It often requires knowledge of and careful analysis of the law. Giving legal advice is an essential function of a lawyer and equivalent to practicing law. Legal advice requires legal education and knowledge and impacts the recipient’s legal rights. It also creates an attorney-client relationship.

* * *

Legal information, on the other hand, can be given by anyone who is knowledgeable on the law. It is simply a

¹² Applicant’s April 16, 2021 Response to Office Action, TSDR 6. Emphasis added.

¹³ Examining Attorney’s Br., 9 TTABVUE 3.

¹⁴ February 25, 2022 Denial of Request for Reconsideration, TSDR 6; <https://legal-dictionary.thefreedictionary.com/legal+services>, accessed February 25, 2022.

statement of what the law is, without any application to your particular situation, leaving up to you the decision of how to proceed. Given the costs associated with hiring a lawyer, it is good to know when you need legal advice, and when you simply need legal information.¹⁵

Relying on these definitions, the Examining Attorney explains the difference between providing “legal services” and “legal advice” and providing “legal information:”

[T]he terms “legal services” and “legal advice” both refer to services performed by an attorney for a client and both provide a detailed examination of the law as it pertains to a person’s unique circumstances. Because both refer to services performed by an attorney for a client, both services create an attorney-client relationship that gives rise to a duty of confidentiality, i.e., the attorney-client privilege. “Legal information,” on the other hand, may or may not be provided by an attorney, is simply a statement of what the law is without any application to someone’s particular situation. It is general in nature and is not confidential in nature because it does not involve an attorney-client relationship.¹⁶

Based on this distinction, the Examining Attorney concludes that Applicant does not use the 10HUNDRED mark in the provision of its legal services:

[A]ll of the specimens provided show a rendering of, or advertisement for, “legal information” that is provided to the general public. It is neither confidential nor specific to a particular client’s individual needs. Therefore, what is

¹⁵ *Id.* at TSDR 4, <https://www.legalmatch.com/law-library/article/legal-advice-vs-legal-information.html>, accessed February 25, 2022.

¹⁶ Examining Attorney’s Br., 9 TTABVUE 6-7.

shown in the specimens is “legal information,” and not a type of “legal service” provided to clients.¹⁷

According to the Examining Attorney, the distinction between legal services and legal advice and legal information is so significant that the information provided by Applicant under its 10HUNDRED mark “cannot be ‘legal services’ or ‘legal advice’ because if it were, it would mean that applicant violated its duty of confidentiality by publicly disclosing confidential information provided to a client.”¹⁸

For its part, Applicant argues that the Examining Attorney erred in three ways: “(1) by creating a heightened standard for ‘legal services’ which creates a catch-22 for applicants[;] (2) failed to consider if the provided specimen show ‘consultancy services’; and (3) erred by dismissing the specimens as not being attorney advertising.”¹⁹

We find that the Examining Attorney’s limitation of the terms “legal services” and “legal advice” only to instances necessitating observance of an attorney-client privilege to be overly narrow and restrictive, elevating form over substance. The practice of law encompasses many different aspects of client counseling, and not all of them require attorney-client privilege. Put another way, while it is true that non-attorneys may not practice law, licensed attorneys may work on matters that do not, strictly speaking, comprise the practice of law. According to the Examining Attorney’s own definition, “legal services” are defined simply as “work performed by a lawyer for

¹⁷ *Id.* at 7.

¹⁸ *Id.* at 8.

¹⁹ Applicant’s Br., p. 4, 7 TTABVUE 7.

a client.” As Applicant notes, offering legal services and legal advice includes work not covered by the attorney-client relationship:

Work may encompass other things, for example, providing legal information, reading statutes for a client, reading a contract for a client, providing legal education, filing documents with a court, filing trademark applications, providing general information or best practices and a variety of other services. These are all types of work that a lawyer may provide for a client that does not constitute the providing of advice. Applicant’s specimens show various examples of such work.²⁰

Looking at the specimens of record, we find that Applicant offers its 10HUNDRED service in order to provide clients and prospective clients with useful legal information which they can use in their businesses. Providing clients with such information before problems arise is the hallmark of good counsel. Admittedly, the line between providing legal services or legal advice versus merely educating clients on legal issues is rarely clear. Indeed, as the Findlaw.com article introduced by the Examining Attorney states, “[t]he difference between ‘legal advice’ and ‘legal information’ is often blurry.”²¹

We find that the specimens of record demonstrate the mark has been used in commerce in a way that creates an association with Applicant’s identified legal services in the minds of consumers. Applicant’s services provided under the 10HUNDRED mark are directed to clients or prospective clients, and involve

²⁰ Applicant’s Reply Br., pp. 3, 10 TTABVue 5.

²¹ February 25, 2022 Denial of Request for Reconsideration, TSDR 5.

preparing and presenting information encompassing “global legal and business guidance” and “legal updates.” That is, existing clients, or prospective clients will be informed by the legal presentations, and may seek out further advice from Applicant, as needed. *See In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) (quoting *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006)) (“[T]he question is whether the evidence of JobDiva’s use of its marks ‘sufficiently creates in the minds of purchasers an association between the mark[s] and [JobDiva’s personnel placement and recruitment] services.’”). Further, the compilation and presentation of such presentations clearly fall within the meaning of legal services, i.e., “work performed by a lawyer for a client.”

Similarly, the definition of “consult” introduced by Applicant suggests that Applicant’s specimens demonstrate that its 10HUNDRED mark is used in connection with “legal advisory and consultancy services.” “Consult” is defined simply as “to get information or advice from a person, book, etc. with special knowledge on a particular subject[.]”²² “Advisory” is defined simply as “containing or giving advice.”²³ Applicant’s 10HUNDRED program, which provides information or “special knowledge” on subjects such as “global legal and business guidance” and “legal updates,” clearly use the mark in association with services that fall within the common meaning of “consultancy” and “advisory.”

²² Exhibit A to Applicant’s Br., 7 TTABVUE 19-22; <https://dictionary.cambridge.org/us/dictionary/english/consult>.

²³ <https://www.merriam-webster.com/dictionary/advisory>, accessed September 29, 2022. We take judicial notice of this definition as well.

Because we have found that the specimens are acceptable to show use of the mark “in the performance or rendering of the services,” we need not decide whether the specimens also are attorney advertising. 37 C.F.R. § 2.56(b)(2).

Decision: The refusal to register Applicant’s mark 10HUNDRED on the ground that Applicant’s specimens fail to show the mark in use in commerce in connection with the identified services is reversed.