

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 21, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Simmons Browder Gianaris Angelides and Barnerd, LLC

v.

The Simmons Firm, ALC

—
Opposition No. 91199120
—

Joseph A. Saltiel of Jenner & Block LLP for Simmons Browder Gianaris Angelides and Barnerd, LLC.

Cindy A. Brand of Law Offices of Cindy A. Brand for The Simmons Firm, ALC.

—
Before Bucher, Cataldo and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

The Simmons Firm, ALC (“applicant”) filed an application to register on the Principal Register the mark below for “legal services” in Class 45:



¹ Serial No. 85136767, filed September 23, 2010, claiming December 1, 2003 as the date of first use of the mark anywhere, and January 5, 2004 as the date of first use of the mark in commerce. No claim is made to the exclusive right to use the terms “Firm” and “Law Corporation” apart from the mark as shown.

In the application, as originally filed, applicant claimed that the mark has acquired distinctiveness “through the applicant’s substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement,” under Section 2(f) of the Trademark Act. Applicant also owns registrations residing on the Supplemental Register for the same stylized mark sought to be registered herein (FIRM A LAW CORPORATION disclaimed) and the standard character mark THE SIMMONS FIRM (FIRM disclaimed) for “professional legal services” in Class 42.²

Registration has been opposed by Simmons Browder Gianaris Angelides and Barnerd, LLC (“opposer”). As grounds for opposition, opposer alleges use since 1999 of the designation SIMMONS FIRM for legal services, and asserts that (1) applicant’s mark is primarily merely a surname under Trademark Act § 2(e)(4), and the mark has failed to acquire distinctiveness, (2) applicant’s mark is likely to cause confusion with opposer’s prior used SIMMONS FIRM mark for legal services under Trademark Act § 2(d), and (3) applicant’s claim of acquired distinctiveness, based on substantially exclusive use for five years, is fraudulent. Opposer also asserted a claim of dilution, which opposer did not pursue at trial and we thus deem waived.³ *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB

² Registration Nos. 2956349 and 2956348, respectively, both registered May 24, 2005.

³ In any event, opposer improperly pleaded the claim by failing to allege that its mark became famous prior to the filing date of the involved application. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-73 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer is deemed to have waived the claim).

Applicant, in its answer, denied the salient allegations. Applicant also asserted certain affirmative defenses, but only pursued at trial the sixth affirmative defense, i.e., that the applied-for mark has acquired distinctiveness. As applicant did not pursue the other affirmative defenses by motion or at trial, they are deemed waived. *See Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187 (TTAB 2012) (affirmative defenses not pursued at trial deemed waived). Applicant further asserted as “affirmative defenses” matters that are more in the nature of amplifications of its denials and have been so construed.

The Record

By rule, the record includes the pleadings and the file history of the subject application. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). By stipulation as approved by the Board, the parties submitted all testimony by affidavit. During its testimony period, opposer provided under its first Notice of Reliance the testimony affidavits, with accompanying exhibits, of Greg Kirkland, opposer’s CEO, and John S. Simmons, a third-party attorney; the applications, Office actions and Examiner’s Amendments pertaining to applicant’s Supplemental Register registrations noted above; applicant’s responses to opposer’s interrogatories nos. 1-16; and applicant’s supplemental responses to opposer’s Interrogatory No. 3.

During its testimony period, applicant submitted under Notice of Reliance the testimony affidavits of applicant’s principal, Ross G. Simmons, his father

William K. Simmons, and his brother William R. Simmons, as well as seven other individuals who are present or former employees or clients of applicant, or are personal friends of Ross G. Simmons. Applicant also provided the testimony affidavit of Steven W. Winton, a member of the California Bar who practices in San Diego.⁴

As rebuttal testimony, opposer submitted the testimony affidavits (with accompanying exhibits) of John Simmons, opposer's Chairman and Founder, Mark Motley, opposer's Vice President of Communications, and Greg Kirkland.

Both parties attached exhibits to their pleadings. Only those exhibits that also were properly made of record during the respective party's testimony period have been considered. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009), 37 C.F.R. § 2.122(c), and TBMP § 704.05 (October 2012).

Opposer and applicant filed main briefs on the case, and opposer filed a rebuttal brief.

Admissibility of Evidence

Opposer filed a motion to strike all of the evidence, including the 11 testimonial affidavits, introduced by applicant. The Board deferred consideration of

⁴ The Board notes with approval the parties' stipulation to testimony by affidavit and applicant's stipulation to the record as set forth in opposer's brief. While this case was not tried in accordance with the Board's Accelerated Case Resolution procedure (ACR), the parties nonetheless availed themselves of these ACR-type efficiencies.

Additional information regarding ACR is available in TBMP §§ 528.05(a)(2), 702.04 and 705 (October 2012), and on the Trademark Trial and Appeal Board web page of the United States Patent and Trademark Office (USPTO) website at www.uspto.gov.

the motion until final decision. Opposer did not renew the motion or objections in its main brief, but in its reply brief, opposer summarizes the arguments made in the motion.

The Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in cases litigated before us, including any inherent limitations, and this precludes the need to strike the testimony and evidence. As none of the evidence is outcome determinative, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by applicant. In doing so, we have kept in mind opposer's various objections, and we have accorded whatever probative value the subject testimony and exhibits merit.

We also note Ross G. Simmons' characterization of certain portions of Mr. Kirkland's testimony as "misstatements of fact" that are "fabricated", and containing matters "the law of perjury is supposed to be for."⁵ While a party should inform the Board when it believes there are problems with its adversary's evidence, it was not necessary for Mr. Simmons to level a charge of perjury against Mr. Kirkland. In any event, opposer adequately addressed the underlying concerns by way of the rebuttal affidavits of Mr. Kirkland and Mr. Motley, and there is no need to further discuss the matter.

⁵ Ross G. Simmons Aff., ¶¶ 16, 23(a)-(d), and 24.

Standing

Opposer asserts that it has used the name the SIMMONS FIRM since at least 1999 in connection with legal services, primarily focusing on mesothelioma and asbestos litigation. While opposer acknowledges that it changed its official name to SimmonsCooper, LLC in 2004, and to Simmons Browder Gianaris Angelides and Barnerd, LLC in 2009, opposer's CEO testified that opposer and others use the name the SIMMONS FIRM to refer to opposer. In addition, the testimony affidavit of opposer's principal evidences that he is the "Simmons" in the SIMMONS FIRM, and others refer to opposer as the SIMMONS FIRM or the SIMMONS LAW FIRM. Moreover, applicant, in its answer, admits that opposer began its "current usage" of the name SIMMONS FIRM in July 2009. Ans., ¶ 12.

To establish standing, opposer must show that it is not an intermeddler, but has a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); 15 U.S.C. § 1064. In this case, opposer has established that it has a commercial interest in using SIMMONS FIRM and derivations thereof to identify services that are essentially identical to those recited in the involved application. Further, opposer's commercial interest demonstrates competitive need to use the name SIMMONS FIRM for those services. We find that because opposer has demonstrated its usage and competitive need of the wording comprising the SIMMONS FIRM mark, opposer has established its standing to oppose applicant's mark. *See, e.g., Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) ("It is clear that use of a term in a

descriptive sense is sufficient to impart standing to oppose federal registration of a descriptive “word, name, symbol, or device” as a trademark ...”); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979) (damage sufficient to establish standing to oppose a registration “presumed or inferred when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business”); *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1357 (TTAB 2003) (“plaintiff has alleged the interest necessary to bring these proceedings by asserting its competitive uses of stripes and bands in various colors including the colors yellow and blue on abrasive wheels and disks.”).

Surname Claim

Our primary reviewing court instructs that “[t]he test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public.” *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988) (footnote omitted). “The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis.” *In re Établissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

In making this determination, we typically consider four factors: (1) whether the surname is rare; (2) whether anyone connected with applicant has the involved term as a surname; (3) whether the term has any other recognized meaning; and (4) whether the term has the “look and feel” of a surname. See *In re Binion*, 93

USPQ2d 1531, 1537 (TTAB 2009); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000), citing *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995). In its brief, applicant concedes that the name SIMMONS, standing alone, is primarily merely a surname. App. Br., p. 8. The record confirms this concession.

First, the record establishes that Simmons is the 103rd most common surname in the United States, with 201,650 occurrences in the 2000 U.S. Census, that there are approximately 60 practicing attorneys with the surname Simmons in California, and approximately 20 in Illinois,⁶ and three other law firms in the United States, including opposer, use SIMMONS to identify themselves. Opposer also submitted the affidavit of John S. Simmons and attached website printouts for the Simmons Law Firm (one of the three other law firms mentioned above), showing that John S. Simmons uses his surname in connection with legal services. Second, Simmons is the surname of Ross G. Simmons, applicant's founder, principal and sole shareholder. Third, there is no evidence in the record indicating that Simmons is recognized as anything other than a surname.

As to the fourth, subjective, factor, we find that Simmons has the "structure and pronunciation" or "the look and sound" of a surname. *Benthin*, 37 USPQ2d at 1333; *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994); *In re Industrie Pirelli*, 9 USPQ2d 1564, 1566 (TTAB 1988). As the 103rd most common surname, consumers are conditioned to see SIMMONS as a surname. Moreover,

⁶ We note, however, that because applicant seeks registration of the mark at issue without geographic restriction, our analysis is based upon evidence of the surname significance of SIMMONS in the United States as a whole, regardless of either party's area of use of its respective mark(s).

SIMMONS “would not be perceived as an initialism or acronym . . . and does not have the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix.” *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004).

Applicant’s argument turns on the fifth factor, namely, whether the stylization is sufficiently distinctive to cause the applied-for mark not to be perceived as primarily merely a surname. *Benthin*, 37 USPQ2d at 1334 (TTAB 1995). We find that this “decidedly subjective” factor favors opposer. *Id.*

The stylization of the logo -- where THE SIMMONS FIRM appears in script lettering, the additional wording A LAW CORPORATION appears in capitalized block letters below, and a horizontal line separates the script and block letters, breaking around the letter “F” in FIRM -- does little to create a separate commercial impression to purchasers of legal services other than that a person named Simmons provides such services. *See In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (“The style of lettering is also insignificant, in that it is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers of appellant’s services.”). The stylization is minimal, and does not result in a mark separate and apart from the literal elements. *Id.*

Moreover, as noted above, applicant initially registered the applied-for mark on the Supplemental Register. As Section 23 of the Lanham Act prohibits registration of inherently distinctive marks on the Supplemental Register, applicant’s prior registration of the applied-for mark on the Supplemental Register

is an admission by applicant that the mark was not distinctive, at least at the time of registration. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972).⁷

In view of the foregoing, the applied-for mark as a whole would be perceived by those who require or are involved in legal services primarily merely as a surname—a surname that the principals of both parties share. *See Hutchinson Tech.*, 7 USPQ2d at 1492 (when assessing whether the public will view a mark primarily as a surname, the “mark sought to be registered must be considered in its entirety”); *In re Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870, 152 USPQ 563, 566 (CCPA 1967) (“A mark must be considered in its entirety.”). The degree of stylization is simply insufficient for us to reach any other conclusion.

Accordingly, we find that applicant’s proposed mark is primarily merely a surname under Section 2(e)(4).

Acquired Distinctiveness

Section 2(e)(4) of the Trademark Act precludes registration on the Principal Register of a mark which is “primarily merely a surname” without a showing that the applicant has acquired distinctiveness in the surname by virtue of “substantially exclusive and continuous use” under Section 2(f) of the Act, 15 U.S.C. § 1052(f). “[E]vidence of long and exclusive use” can change the “significance to the public from a surname of an individual to a mark for particular goods or services.”

⁷ In addition, the disclaimed wording “FIRM” and “LAW CORPORATION” in the registration on the Supplemental Register and in the instant application have no trademark significance with respect to applicant’s legal services, and do not diminish the surname significance of the term SIMMONS. Applicant does not contend otherwise.

Établissements Darty et Fils, 225 USPQ at 653. Such evidence is necessary because multiple individuals share surnames, and each individual may have an interest in using his/her surname in connection with his/her profession. See *Mitchell Miller, a Professional Corp. dba Miller Law Group, P.C. v. Michele Ballard Miller*, ___ USPQ2d ___ (TTAB 2013) (Opposition No. 91184841). This is particularly true in the legal profession, because lawyers and law firms typically are identified by surnames. Thus, registration of a surname for legal services “could hinder the creation of new law firms . . . and the ability of individuals to practice law in their chosen field without changing their names” – a result that would not be in the public interest. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 13:2 (4th ed. 2012). Accordingly, applicant bears a heavy burden in establishing that it has acquired distinctiveness in the surname SIMMONS for legal services.

Applicant submitted several types of evidence of its use of SIMMONS in the form of the applied-for mark in connection with legal services. Applicant also relies upon this evidence to demonstrate that the applied-for mark has acquired distinctiveness. This evidence includes signage; newspaper advertisements in 2004; business cards; fleece blankets; paperweights; shirts; banners; annual “sticky” calendars distributed by several affiants; and use on applicant’s Facebook page. The evidence also includes testimony affidavits from the individuals listed in the description of the record, above, attesting to their recognition of the applied-for mark as pointing to applicant’s legal services.

Applicant's evidence of acquired distinctiveness is minimal, and is, in fact, significantly less in quantity and probative value than the unsuccessful applicant provided in *Miller*. Unlike the applicant in *Miller*, applicant The Simmons Firm, ALC provided *no* evidence regarding, for instance, its gross revenues; its marketing expenditures or the results derived therefrom; advertisements in publications after the 2004 "grand opening"; radio or television advertisements; articles or publications on topics related to transactional law authored by Ross G. Simmons or any attorneys of The Simmons Firm, ALC; articles written about, featuring or referencing Ross G. Simmons or The Simmons Firm, ALC and its attorneys; speaking events, panel discussions or webinars featuring Ross G. Simmons or other attorneys of The Simmons Firm, ALC under the applied-for mark; or updates, alerts, newsletters or email blasts to clients, prospective clients or colleagues featuring legal updates within applicant's area of expertise.

In addition, as was the case in *Miller*, the record clearly establishes that opposer and others with the surname SIMMONS have an interest in using, and do in fact use, the SIMMONS surname in connection with their respective legal practices. Opposer's evidence of its use of the name "Simmons Firm" in connection with legal services includes the testimony affidavits of applicant's CEO and applicant's principal; signage; promotional materials; Articles of Organization as "Simmons Firm, L.L.C." in 1999; an application with, and approval from, the Illinois Secretary of State to adopt the business name "Simmons Firm" in 2009; and use of

the name in connection with opposer's charitable activities including the Simmons Employee Foundation and the Simmons Cancer Institute.⁸

Opposer has also provided the testimony affidavit of John S. Simmons, who attests to having continuously used the name "Simmons Law Firm" in connection with legal services since August 2003. Further, in response to opposer's Interrogatory No. 4, which asked applicant to identify other law firms that use the surname Simmons to promote their legal services, applicant identified the same John S. Simmons, and the Simmons and Simmons law firm of Greenville, MS. Based on the record, there are at least four users, including applicant and opposer, of the surname SIMMONS in connection with legal services in the United States. The record also shows that SIMMONS is the 103rd most common surname in the country as of Census 2000, and there are approximately 60 attorneys with the surname SIMMONS in California, and approximately 20 in Illinois. Thus, as in *Miller, supra*, it is reasonable to presume that there are additional legal practitioners who use SIMMONS in connection with legal services, and that the record only reflects a small sampling of those users.

Although applicant appears to have used the applied-for mark continuously in commerce since 2004, applicant has not established that its use of SIMMONS in connection with legal services is substantially exclusive as required by Section 2(f).

As our primary reviewing court stated:

⁸ Because of the ultimate disposition of this proceeding, we have no need to address opposer's Section 2(d) claim, or applicant's affirmative defenses or arguments in relation thereto. We therefore make no determination as to the whether such use continued during the 2004 to mid-2009 period, when opposer's official name was SimmonsCooper, LLC.

In respect of registration, there must be a trademark, *i.e.*, purchasers in the marketplace must be able to recognize that a term or device has or has acquired such distinctiveness that it may be relied on as indicating one source of quality control and thus one quality standard. When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984).

We conclude that applicant has not acquired distinctiveness of the surname SIMMONS, in connection with legal services.

Decision: Opposition No. 91199120 is sustained on the grounds that the applied-for mark is primarily merely a surname under Trademark Act Section 2(e)(4), and that it has not acquired distinctiveness under Trademark Act Section 2(f).⁹

⁹ In light of our finding on the surname claim and the question of acquired distinctiveness, we find it unnecessary to reach opposer's remaining claims.