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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME

Mailed: January 29, 2016

Opposition No. 91210158

Larry Pitt & Associates, P.C.

v.

Lundy Law, LLP

Before Bergsman, Mermelstein, and Heasley,
Administrative Trademark Judges.

By the Board:

This case now comes up on Applicant's motion for summary judgment, filed March 4, 2015, and Opposer's combined response and cross-motion, filed September 25, 2015, for sanctions and for re-designation of a deposition transcript that Applicant has marked "Highly Confidential" and "Attorneys[] Eyes Only."

Background

Applicant seeks registration of the mark REMEMBER THIS NAME, in standard character format, for "legal services."¹ In its amended notice of opposition, Opposer alleges that Applicant's mark is not registrable because it does not function as a service mark for Applicant's legal services under Sections 1, 2, 3 and 45 of the

¹ Application Serial No. 85767757; filed October 31, 2012; based on a claim of first use and first use in commerce on May 16, 2011.

Trademark Act. In its answer to the amended notice of opposition, Applicant denies the salient allegations.

Motion for Sanctions

On March 11, 2015, in response to Applicant’s motion for summary judgment, Opposer filed a motion for discovery pursuant to Fed. R. Civ. P. 56(d) (the “56(d) Motion”). 35 TTABVUE. The Board issued an order on July 30, 2015 (the “Prior Order”), granting Opposer’s 56(d) Motion, in part, to the extent that Opposer was permitted to take the depositions of L. Leonard Lundy, who submitted a declaration in support of Opposer’s motion for summary judgment, and Tami Sortman, Applicant’s director of marketing and advertising. 40 TTABVUE 4-5. The Board denied Opposer’s 56(d) Motion to the extent Opposer sought to take the 30(b)(6) deposition of Applicant.

Opposer’s motion for sanctions relates to the deposition of Ms. Sortman (the “Sortman Deposition”). Opposer seeks sanctions in the form of “dismissal of [Applicant’s] summary judgment motion, or a grant of summary judgment in Opposer’s favor,”² on the ground that Applicant’s counsel made numerous objections instructing Ms. Sortman not to answer certain questions during her deposition. 41 TTABVUE 24-25. More specifically, Opposer argues that “Applicant expressly objected to questioning that goes to the heart of the case, and defense of the

² We do not construe this request for relief as a cross-motion for summary judgment as Opposer has not argued the absence of genuine disputes of material fact regarding whether REMEMBER THIS NAME functions as a service mark.

summary judgment motion. [Ms. Sortman's] failure to answer questions constitutes a nonappearance.”³ *Id.* at 24.

As the Board explained in the Prior Order, “56(d) discovery is not a substitute for full-blown pre-trial discovery. Under Rule 56(d), Opposer is limited to discovery it must have in order to respond to the motion for summary judgment.” 40 TTABVUE 3. Applicant seeks summary judgment on Opposer's claim that Applicant's mark is merely an instructional phrase that fails to function as a source indicator. The critical inquiry in determining whether Applicant's slogan functions as a mark is how the relevant public perceives the phrase, and the manner in which Applicant uses the wording REMEMBER THIS NAME is directly relevant to this inquiry. *See, e.g., In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998); *In re Remington Prods.*, 3 USPQ2d 1714, 1715 (TTAB 1987). Accordingly, in granting Opposer's motion to take the Sortman Deposition, the Board explained that the testimony of Ms. Sortman “would be directly relevant and necessary to the issues raised in Applicant's motion for summary judgment” because Ms. Sortman “in her capacity as Applicant's marketing director, would be a person with specific knowledge *regarding the manner in which Applicant uses the wording REMEMBER THIS NAME in association with its legal services.*” 40 TTABVUE 4 (emphasis added).

³ Opposer also asserts that Applicant's counsel “made lengthy speaking objections.” 41 TTABVUE 24. Based on our review of the Sortman Deposition transcript, we do not find that Applicant's counsel made lengthy speaking objections other than to object to the scope of the Sortman Deposition.

Many of the questions that Opposer posed during the Sortman Deposition concerned matters beyond use of the wording REMEMBER THIS NAME, *e.g.* questions regarding Applicant's advertising budget, Applicant's prior advertising campaigns, general advertising practices regarding mass torts, the names and responsibilities of advertising firms who have created advertisements for Applicant, and competitors' advertising practices not related to the slogan REMEMBER THIS NAME. Applicant objected that such areas of inquiry exceeded the scope of the Prior Order, and we agree. While information responsive to such inquiries might be generally discoverable, the intent of the Prior Order was to limit Ms. Sortman's deposition to use of the wording REMEMBER THIS NAME. Accordingly, Opposers' motion for sanctions is **DENIED**.

Motion to Re-Designate the Sortman Deposition

Pursuant to the Board's standard protective order automatically applicable here, Applicant has designated the entirety of the Sortman Deposition "Highly Confidential" and "Attorneys[] Eyes Only."⁴ Opposer argues that "[p]lacing an entire deposition under seal is improper." 41 TTABVUE 25. In response, Applicant contends that "there are so few portions of the transcript that are not highly confidential that it would be less helpful to the [B]oard to redesignate a small portion interweaved throughout the entire deposition and cause there to be two

⁴ The standard protective order provides that parties and their attorneys shall have access to information designated as "highly confidential" while only outside counsel may access "trade secret/commercially sensitive" information. Because Applicant has marked the Sortman Deposition as "Attorneys[] Eyes Only" Applicant is effectively treating the Sortman Deposition transcript as "trade secret/commercially sensitive."

transcripts both of which are cut up and would have to be used together in order to make any sense of the transcript.” 47 TTABVUE 5-6.

“Board proceedings are designed to be transparent to the public and the contents of proceeding files publically available. The improper designation of materials as confidential thwarts that intention.” *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014). Accordingly, a party seeking to designate information as confidential, highly confidential or trade secret pursuant to the Board’s standard protective order has a duty to make a meaningful effort to designate only that information that warrants the designated level of protection. *Id.*; see also *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006).

During the Sortman Deposition, Applicant’s counsel acknowledged that portions of the deposition are not confidential, and we agree. For example, Ms. Sortman’s testimony regarding her employment history and job responsibilities, the areas of law that Lundy Law practices, the media through which Applicant advertises, the geographic areas in which Applicant advertises, the length of time that Applicant has been using the slogan REMEMBER THIS NAME, the names of the advertising and production firms that Applicant has worked with, and the manner in which Ms. Sortman defines marketing terms such as “focus group” and “slogan” are not confidential information, and therefore, should not be shielded from public view. Similarly, the extensive wrangling between the parties’ counsel regarding the scope of the Sortman Deposition is not confidential.

Accordingly, Opposer's motion to re-designate is **GRANTED** to the extent that within **TWENTY DAYS** of the mailing date of this order, Applicant is ordered to file a redacted copy of the Sortman Deposition in which all non-confidential testimony and exhibits⁵ are made available for the public to view, failing which the entire deposition will be designated as non-confidential and made available for public display. *See Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009). Applicant also must file a redacted copy of its brief in opposition to Opposer's combined motion for sanctions and re-designation, *i.e.* 47 TTABVUE, failing which the entire brief will be designated as non-confidential and made available for public display. *See id.* The Board expects that Applicant will carefully review the Sortman Deposition transcript and exhibits as well as its response brief and designate only those portions of the documents that are truly confidential, highly confidential and trade secret commercially/sensitive as those terms are defined in the standard protective order.

Motion for Summary Judgment

Summary judgment is appropriate only where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting*, 833 F.2d 1560, 4

⁵ The copy of the Sortman Deposition that Opposer filed with the Board does not include the referenced exhibits so the Board has been unable to review them.

USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

Applicant asserts that there is no genuine dispute of material fact that REMEMBER THIS NAME functions as a mark for legal services. To function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application. 15 U.S.C. § 1127; *see also In re Volvo*, 46 USPQ2d at 1459; *In re Remington*, 3 USPQ2d at 1715. Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. *See In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (C.C.P.A. 1960); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986); *In re Gilbert Eiseman, P.C.*, 220 USPQ 89, 90 (TTAB 1983) (finding IN ONE DAY

failed to function as a mark for plastic surgery services where it appeared “as part of a larger message” and “read[] as an integral and natural part of a larger thought”).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to Applicant’s motion in favor of Opposer as the non-moving party, we find that there are genuine disputes of material fact regarding how consumers will perceive Applicant’s mark, and this precludes granting summary judgment to Applicant.

The record does not include any evidence of consumer perception. Applicant, however, has submitted photographs and copies of advertisements demonstrating the way it uses REMEMBER THIS NAME. Examples include:



See 33 TTABVUE 58 and 72 (consisting of a specimen of use submitted in support of the involved application).



See id. at pp. 22 and 37 (identified as “a photograph of a Lundy Law advertisement taken at the Wells Fargo Center”).



See id. at pp. 23 and 49 (identified as a “photograph of marketing materials”).

Applicant’s evidence also included “slides which comprise a television commercial which is being used by Lundy Law.” *Id.* at p. 23. The slides read as follows:

Injured in an auto accident?

1-800-LundyLaw

Injured in a Slip & Fall?

1-800-LundyLaw

Injured on the job?

1-800-LundyLaw

Remember This Name

Id. at pp. 23 and 51-57.

In addition, Opposer has submitted the report of its expert witness, Ross Fishman,⁶ which includes examples of similarly structured advertisements used by third-party law firms. Examples include:

- “Have You Been Injured in an Accident? Call Now to Speak to an Attorney” followed by the phone number and website address for the law firm;
- “Injured? Don’t Wait Long. Call.” followed by a telephone number;
- “Injured? Free Case Evaluation” followed by a telephone number and the name of the law firm;
- “Injured? One Call. That’s All.” followed by the name of the attorney and his telephone number;

⁶ The Board has previously determined that Mr. Fishman is qualified as a marketing expert in the field of law firm advertising. *See* Board’s order of October 31, 2014, p. 4. The Board, however, has not considered any legal conclusions made by Mr. Fishman with respect to whether REMEMBER THIS NAME serves as a source identifier. *See, e.g., Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984); *The Mennen Co. v. Yamanouchi Pharm. Co.*, 203 USPQ 302, 305 (TTAB 1979).

- “Injured? We Can Help.” Followed by the law firm name and telephone number.
- “Injured? I’ve Been There.” followed by the attorney’s website address and telephone number; and
- “Injured? Accident? Let Us Fight for You!” followed by the firm name and telephone number.

43 TTABVUE 8-11.

The way Applicant displays its mark, as shown above, the use of similar advertising formats by third-party law firms, and the lack of any evidence of consumer perception create a genuine dispute of material fact regarding whether consumers perceive or will perceive REMEMBER THIS NAME as a source identifier or merely as an instruction to take action, *i.e.* If you are injured, remember the name of Lundy Law and contact the firm for legal assistance. Accordingly, Applicant’s motion for summary judgment is **DENIED**.⁷

Proceedings Suspended

On February 26, 2015, six days before Applicant filed its motion for summary judgment, Opposer notified the Board of its timely disclosure to use expert testimony. Accordingly, proceedings are **SUSPENDED** pending Opposer’s

⁷ The fact that we have identified a genuine dispute of material fact as a sufficient basis for denying Applicant’s motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial. Further, the parties should note that the evidence submitted in connection with Applicant’s motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981).

compliance with Fed. R. Civ. P. 26(a)(2) and the exchange of discovery limited to planned expert testimony, including that of any rebuttal experts. *See* Trademark Rule 2.120(a)(2).

To the extent that the use of experts did not form part of the parties' discovery conference discussions, the parties shall promptly confer on the arrangements for the completion of disclosures relating to planned expert testimony, including any testimony by rebuttal experts, and for exchanging and responding to discovery requests, if any, related to the identified experts. Such discussions also should encompass stipulations regarding the introduction into evidence of the testimony of expert witnesses, for example: (1) whether in lieu of testimony, the parties may introduce the expert reports; (2) whether the expert testimony may be provided by affidavit or declaration;⁸ or (3) whether the witnesses will present testimony and discuss exhibits in testimony depositions.

Federal Rule 26(a)(2) provides that a party planning to use an expert solely to contradict or rebut an adverse party's expert must disclose such plans within thirty days of the adverse party's prior disclosure. However, Trademark Rule 2.120(a)(2) also provides that the Board may set a deadline for disclosing plans to use a rebuttal expert. Accordingly, if Applicant has not already complied with the requirements of Federal Rule 26(a)(2), it is allowed **until TWENTY DAYS from the mailing date of this order** to disclose any planned rebuttal expert testimony.

⁸ Parties stipulating that the testimony of a witness may be introduced by affidavit or declaration may reserve the right to conduct in-person cross-examination, if necessary.

Upon the completion of expert discovery and the service of information required by Federal Rule 26(a)(2), the parties must inform the Board so that proceedings may be resumed.
