

To: Gordon & Doner, P.A. (ustrademarks@m spatents.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77821445 - FOR THE INJURED
- 2955U.000002
Sent: 12/14/11 9:00:00 AM
Sent As: ECOM117@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77821445

MARK: FOR THE INJURED

77821445

CORRESPONDENT ADDRESS:

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APPLICANT: Gordon & Doner, P.A.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

2955U.000002

CORRESPONDENT E-MAIL ADDRESS:

ustrademarks@m spatents.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

ISSUE/MAILING DATE: 12/14/2011

THIS IS A FINAL ACTION.

The referenced application is currently the subject of an appeal with the Trademark Trial and Appeal Board (Board). However, the Board has suspended action on the appeal and has remanded the application to the trademark examining attorney to consider specific facts or issues pertaining to the application. *See* 37 C.F.R. §2.142(d), (f); TMEP §1504.05. In this case, the Board has requested that the following issue(s) be considered: The applicant's filing of a Request for Reconsideration.

The trademark examining attorney issued a final Office action on April 12, 2011. On September 29, 2011, applicant responded by filing a notice of appeal to the Trademark Trial and Appeal Board (Board); on

October 12, 2011 applicant filed a request for reconsideration of the issues presented in the final Office action. The Board then suspended the appeal and remanded the application to the trademark examining attorney for consideration of the request.

After careful consideration of the material and arguments in the Request for Reconsideration, the request appears to present no new evidence or arguments regarding registrability of the applicant's mark, and the Request is refused, the finality of the prior Office action is maintained.

The arguments, supporting evidence and case law in prior Office actions are repeated and maintained in their entirety in this letter. The applicant seeks to register the phrase FOR THE INJURED, in Standard format, for legal services. Applicant's prior evidence introduced to support a claim of distinctiveness under Section 2(f) was not accepted in the last Final action issued by the Office.

The Request for Reconsideration has not introduced any new evidence in support of a 2(f) claim of distinctiveness. Rather, the applicant appears to argue that:

- 1). The term FOR THE INJURED is not merely descriptive, since it could identify a variety of legal and non-legal services;
- 2). A prior registration owned by the applicant, Reg. No. 3,195,410, containing the same phrase as part of the overall mark was registered and ;
- 3). Other registrations exist , containing the phrase FOR THE INJURED.

1). Applicant Applies Wrong Test to Determine Descriptiveness:

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Therefore, applicant's argument that the term FOR THE INJURED could identify a number of different activities other than legal services is an incorrect application of the test for mere descriptiveness.

- 2). Existence of Different Marks containing the term Applicant seeks to register does not mandate registration of the new term applicant seeks to register:

The fact that the applicant owns a prior registration, no. 3,195,410 , TRIAL LAWYERS FOR THE INJURED does not mandate that the portion of such a mark which the applicant now seeks to register, FOR THE INJURED, must be registered.

A term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and may come to be regarded by the purchasing public as nothing more than a descriptive 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).

The mark in the applicant's prior registration was registered four years ago. Moreover, it is maintained that the registered mark is not the "same mark" which the applicant seeks to register in this instance. See TMEP section 1212.04(b). It is maintained that any evidence produced to register the term TRIAL LAWYERS FOR THE INJURED is different and distinct from material which would be required to demonstrate that part of such a mark. "FOR THE INJURED" is capable of recognition by the public as a mark solely originating from the applicant, inherently distinctive on its face.

Finally, existence of this registration does not mandate that the Office register the current term. The fact that a mark may have been registered even though it may be in violation of governing statutory standards does not mean that the agency must forego applying that standard in all other cases. *Accord in re Boulevard Entertainment, Inc.* 334 F 3d 1336, 67 USPQ2d 1475-1480 (TTAB 2001).

3). Existence of other marks containing the term FOR THE INJURED supports the Office's position regarding the descriptiveness and/or common usage of such a term in the legal profession:

While the applicant contends that prior registrations of marks containing the term FOR THE INJURED, owned by different third parties supports the applicant's ability to register this phrase under the provisions of Section 2(f), it is the examining attorney's contention that such usage by third parties supports the argument that this term FOR THE INJURED is so commonly used in the legal profession to promote such services that a more substantial amount of evidence than that currently of record is required by the applicant to establish a claim of acquired distinctiveness for this term by the applicant.

In fact, such material supplied by the applicant buttresses the prior evidence made of record by the examining attorney demonstrating the frequent use of this term FOR THE INJURED by other third parties in the legal profession.

For these reasons, the applicant's Request for Reconsideration has not introduced any new arguments or evidence which would require removal of the finality of the prior Office action.

This application will be returned to the Trial and Appeal Board, for resumption of the Appeal process.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON **12/14/2011** FOR
SERIAL NO. 77821445

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from **12/14/2011** (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.