

THIS OPINION IS
NOT A PRECEDENT OF
THE TTAB

Mailed: July 22, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pro Bono Institute

Serial No. 78762830

Perry J. Viscounty and Julie L. Dalke of Latham & Watkins LLP for
Pro Bono Institute.

Linda Lavache, Trademark Examining Attorney, Law Office 106 (Mary
I. Sparrow, Managing Attorney).

Before Holtzman, Rogers and Zervas, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Pro Bono Institute to
register the mark CORPORATE PRO BONO in standard character form
for services ultimately identified as "developing, coordinating
and conducting volunteer projects for organizations providing
legal services at reduced costs; development of business
processes for the analysis and implementation of charitable legal

services strategy plans; business management consultancy services in the field of legal services," in Class 35.¹

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that the mark is generic for the services, or if not generic, that the mark is highly descriptive of the services and that applicant's evidence is insufficient to show that the mark has acquired distinctiveness under Section 2(f) of the Act.

When the refusal was made final, applicant appealed. Both applicant and the examining attorney have filed briefs.

Turning first to the question of genericness, the examining attorney argues that CORPORATE PRO BONO is generic for providing free or reduced cost legal services by corporations, and for the type of program through which such services are provided. The examining attorney has submitted definitions of the individual words in the mark, "corporate" and "pro bono," including the following:

¹ Serial No. 78762830, filed November 29, 2005, based on an allegation of first use and first use in commerce in September 2000. The application was amended to include a claim of ownership of Registration No. 3297327 for the mark LAW FIRM PRO BONO CHALLENGE on the Principal Register; Registration No. 3290424 for the mark PRO BONO INSTITUTE ("Institute" disclaimed) under Section 2(f) of the Trademark Act; and Registration No. 3210560 for the mark LAW FIRM PRO BONO PROJECT also under Section 2(f) of the Act; all for the same or essentially the same services as those herein. These registrations will be discussed later in this opinion. Applicant has also claimed ownership of Registration No. 3278152 for the mark PRO BONO WIRE on the Supplemental Register for "providing via email newsletters in the field of pro bono legal services" in Class 41.

"Pro bono"

FUNCTION: *adjective*

"being, involving, or doing legal work donated especially for the public good <*pro bono work*>

Merriam-Webster Online Dictionary (ask.com)

"Corporate"

ADJECTIVE:...2. Of or relating to a corporation: *corporate assets; corporate culture*.

The American Heritage Dictionary of the English Language (4th ed. 2000) (bartleby.com)

The examining attorney has also introduced a number of articles from the Lexis/Nexis database and printouts from numerous third-party websites containing references to "corporate pro bono." Representative examples of these articles and websites are set forth below (emphasis added).

- ... Freddie Mac's 70+ attorney Legal Division has run an award-winning pro bono program in conjunction with Legal Services of Northern Virginia, Inc. (LSNV) since 1991. This program fits neatly with the corporate mission and the emphasis on giving back to our community.

...

Considerations in establishing a **corporate pro bono** program.

Pro bono work does require a commitment of employee time and resources. For this reason, support from corporate management is crucial to a program's success. Once this support is in place, consider these matters for building an in-house pro bono program: ...

Andrea L. Bridgeman, *Corporate Pro Bono - The Ins and Outs of giving Back* (vsb.org)

- Legal Services of Northwest Jersey Volunteer Lawyer Program
LSNWJ encourages the participation of private attorneys in the delivery of legal services to low-income people through its Volunteer Attorney Program (VLP). ...

...

VLP opportunities are available for corporate counsel, as well. LSNWJ operates a VLP Program with Merck & Co., Inc.

through which clients receive *pro bono* services in tenancy, domestic violence, bankruptcy and divorce matters. LSNWJ is available to other corporate counsel departments to conduct training and establish similar **corporate pro bono** programs. (lsnj.org)

- Corporate Counsel Section Profile
By Section Chair-Elect Steven H. Mosenson
...
8. Pro Bono Program
...to develop ways in which in-house counsel can perform pro bono service. In addition to a special issue of INSIDE, the committee provides regular liaison between members and pro bono organizations, and is co-sponsoring a program on **corporate pro bono** this spring in Rochester.
New York State Bar Association
(nysba.org)
- The Metropolitan Corporate Counsel
Expanding Pro Bono Services
The Texas Access to Justice Commission created the Corporate Counsel Committee in 2004 to encourage participation in pro bono legal services by in-house counsel. The committee promotes funding for legal aid and pro bono contributions by corporate counsel.
...
The committee partners with the Association of Corporate Counsel (ACC) to develop **corporate pro bono** summits in cities across Texas. ...
...
Designed specifically for corporate legal departments, the Houston summit explained the need for pro bono involvement by in-house counsel, discussed ways to develop and support pro bono projects, and explored opportunities for corporate volunteers. ...
(Metrocorpcounsel.com)
- HEADLINE: Legal Aid's Partnership with Pfizer Inc.
Pfizer Inc. has played a leadership role with its outstanding commitment to the provision of civil legal assistance to low income New Yorkers, both in terms of pro bono representation and financial support.
... In addition, Pfizer has provided outstanding financial support to The Legal Aid Society. In 2004, The Legal Aid Society honored Pfizer Inc. for creating the prototype for **corporate pro bono**. Pfizer established and funded the Pro Bono Adoption Project, that brought together eight

distinguished law firms, MFY Legal Services, Inc. and The Legal Aid Society. The Project has been instrumental in finding permanent adoptive homes for numerous foster children.

... Additionally, training programs for nonprofit organizations, developed and sponsored by Pfizer, have been an invaluable support to the Society's staff.

The Metropolitan Corporate Counsel (April 2006 Northeast Edition)

- Pro Bono Initiative

A Joint project of The Chicago Bar Foundation and Public Interest Law Initiative

The Pro Bono Initiative is your pro bono resource for establishing or enhancing a law firm or **corporate pro bono** program in Illinois
(probonoinitiative.org)

- San Francisco Business Times

Pro bono on the clock

...

Intel's lawyers are at the forefront of a growing movement among in-house attorneys. Growing numbers of companies -- including Hewlett-Packard Co., Symantec Corp. and Fireman's Fund Insurance Co. -- are setting up so-called **corporate pro bono** programs.

Just like at law firms, some of which are known for their pro bono work, these **corporate pro bono** programs match seasoned lawyers with people or organizations that often can't pay for their expertise.

One major difference.

Corporate pro bono programs diverge from law firms' programs in one significant way: In-house lawyers shy away from controversial cases. A law firm might jump at the chance to argue for gay marriage; take on the federal government over Guantanamo Bay prisoners or help a religious group. But what is a feather in the cap for private lawyers would be a thorn in the side for a company that doesn't want publicity for taking on an issue that might irritate customers.

Company executives in increasing numbers are giving the go-ahead to **corporate pro bono** programs, despite the fact they pull in-house lawyers away from their corporate work. ...

(Sanfrancisco.bizjournals.com)

- The Missouri Bar
Missouri's New Corporate Pro bono Program -- An Opportunity to Show the Nation
...
In April, The Missouri Bar launched a new, statewide **corporate pro bono** program, the first of its kind for any state bar in the nation. ...
...
How Does the Program Work?
A special website...has been developed by Wayne Greer of The Missouri Bar staff, where not-for-profit organizations, corporate counsel and private law firms can register to participate in the program. The web page includes descriptions of pro bono opportunities that are uniquely tailored to corporate counsel...
Mobar.org
- HEADLINE: Duty Bound: You don't have to work for a large legal department to further the public good
...
But what does it really mean to do pro bono? The term is derived from the Latin phrase pro bono publico, meaning "for the public good." What "public good" means is certainly open to debate. For example, is **corporate pro bono** less valuable if it also benefits the company? Think of a drug company trying to target the elderly with a new drug and therefore doing a lot of pro bono at nursing homes,
Inside Counsel (November 2007)

Applicant, for its part, argues that it is not a law firm, nor does it render pro bono legal services. Applicant states that it is a non-profit organization supporting law firms in their endeavors to provide charitable legal services. Applicant also states that all of its services are centered around assisting law firms and "other entities" providing charitable legal services. (Resp. to Office Action dated April 9, 2007.)

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (quoting *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

The Office has the burden of proving the genericness of a term by "clear evidence" of the public's understanding thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

1. *The genus of applicant's services and the relevant public for the services*

There is no dispute that the genus of services is the wording used in the recitation, "developing, coordinating and conducting volunteer projects for organizations providing legal services at reduced costs; development of business processes for the analysis and implementation of charitable legal services strategy plans; business management consultancy services in the field of legal services." In fact, applicant states in its brief (p. 3) that its goal is "to substantially increase the amount of

pro bono work performed by in-house counsel and to enhance the pro bono culture of in-house legal departments."

The relevant public for applicant's services includes corporate counsel and/or the legal departments of corporations that are interested in setting up pro bono programs or engaging in pro bono legal services.

2. The meaning of CORPORATE PRO BONO to the relevant public

Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. See *Reed Elsevier Properties Inc.*, supra at 1380; and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

The evidence clearly demonstrates that CORPORATE PRO BONO is generic for applicant's services. It is clear from the Nexis articles and third-party websites that the phrase "corporate pro bono" is commonly used by others to denote free or reduced cost legal assistance provided by corporate counsel or corporate legal departments. See *In re Reed Elsevier Properties Inc.*, supra at 1381 (Fed. Cir. 2007) (third-party websites are competent sources to show what the relevant public would understand a term to mean, and "they provide substantial evidence to support the Board's findings.")

Although applicant itself is not providing the legal services, the term "corporate pro bono" identifies the central focus or subject matter of its services, that is, establishing or helping corporate counsel or corporate legal departments establish and manage programs to provide corporate pro bono. A term that names the central focus or subject matter of the services is generic for the services themselves. See *Id.* at 1380 (LAWYERS.COM generic for online information exchange in the fields of law, legal news, and legal services. Although applicant argued that it was not seeking to register its mark for offering services of lawyers, the Court agreed with the Board that "a central and inextricably intertwined element of [the claimed] genus is information about lawyers and information from lawyers."). See also *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for a type of building and also for architectural design services directed to that type of building and for retail outlets featuring kits for construction of that type of building); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for publication and communication via the World Wide Web, and also for consulting services directed to assisting customers in setting up their own Web sites for such

publication and communication); and In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law).

Indeed, "corporate pro bono" is not only used by these third parties to refer to the provision of legal services. The evidence shows that the term is also used by organizations, bar associations, special committees, and coordinators of other pro bono programs in connection with providing corporations with the resources and assistance needed to develop and establish corporate pro bono programs. In other words, the evidence shows that the term is used by others to refer generically to the same type of services that applicant provides.

In addition to the evidence of third-party use noted above, applicant's own promotional materials (from its website corporateprobono.org) show use of "corporate pro bono" in a generic manner:

Corporate Pro Bono
Quick Links
Read About Corporate Best Practices
Summaries of **corporate pro bono** models selected for their innovation, endurance, and accomplishment

Applicant argues that "many of the third-parties" in the examples cited by the examining attorney "are a sponsor, supporter, or leader of Applicant's organization" and that many

of the articles are referring to applicant's services. (Brief, p. 4.) Applicant states, for example, that Andrea L. Bridgeman (see vsb.org) is a real estate/contracts attorney at Freddie Mac in McLean Virginia and that Freddie Mac "is a supporter" of applicant's program, as are Pfizer (see *The Metropolitan Corporate Counsel*) and Merck (see lsnj.org), and that these companies are listed under the "Supporters" link on applicant's website, as shown on the printout from corporateprobono.org. Applicant maintains that the articles and web pages "provide conclusive evidence of the wide spread use of CORPORATE PRO BONO associated with one organization - the Applicant." These arguments are not persuasive.

First, merely because these companies or organizations are familiar with or contribute to applicant's "corporate pro bono" program and services does not necessarily indicate recognition of "CORPORATE PRO BONO" as a trademark. The phrase "corporate pro bono" is used by these third parties in a generic manner, not in a source-indicating manner. See *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972, 1983 (TTAB 2003) ("We acknowledge that these two constituent groups from the relevant public-state boards and competitors of applicant in the field of offering exam preparation materials and practice examinations—appear to recognize that the UNIFORM CPA EXAMINATION is a product of the AICPA. Nonetheless, that recognition has not

stopped many entities within these groups from utilizing 'CPA exam' and 'CPA examination' on their web pages and in their materials in a manner that would be perceived as generic..."). If anything, the evidence shows that even those organizations which are familiar with applicant's services plainly do not recognize "corporate pro bono" as a mark or as a term uniquely associated with applicant. In fact there are no references in the cited Nexis or website materials to applicant or its services. We also note that applicant's web page identifies applicant's company, "Pro Bono Institute" (e.g., "Please send checks made payable to the Pro Bono Institute") and it also contains frequent references to applicant's "corporate pro bono" program by the abbreviation "CPBO" (e.g., "For more information, ...contact the CPBO staff..."; "ABOUT CPBO"; listings of "CPBO'S Leaders" and "CPBO's Supporters"; "If you would like to list your organization on the CPBO web site...just complete the organization form."). It may well be that applicant's clients and supporters view the designations "Pro Bono Institute" and "CPBO," rather than CORPORATE PRO BONO, as applicant's source-identifying marks.

Moreover, the fact that "corporate pro bono" is often (although not always) used in its adjectival form to refer to a type of program or project does not detract from its generic meaning. See *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628,

1630 (TTAB 1998) (adjectival use of "mass flow" in connection with the meters that measure mass flow [namely, mass flowmeters] does not remove the term from being generic; "'Mass flow' is the name of a meter in the same way as 'gas' and 'water' name types of meters."). See also *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627, 634 (CCPA 1962) ("SUDSY", as an adjective, is "half of a common descriptive name" [for "sudsy ammonia"] and "as such it is clearly, and in common parlance, a type designation"); and *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1198 (TTAB 1998) (ATTIC generic for attic sprinklers; "[t]he fact that applicant has chosen to not include the term 'sprinkler' in the mark sought to be registered should not lead to the registrability of ATTIC standing alone).

Because we have determined that CORPORATE PRO BONO is generic, applicant's claim that the designation is registrable on the Principal Register under Section 2(f) is unavailing. Nevertheless, for purposes of a complete record, we will now assume that CORPORATE PRO BONO is not generic and decide the questions: Is the mark merely descriptive, and if so, has applicant established its alternative claim that the mark has acquired distinctiveness?

If CORPORATE PRO BONO is not generic, then the term is certainly highly descriptive of applicant's services. The dictionary definitions, Nexis articles, website printouts and

applicant's own promotional materials show that CORPORATE PRO BONO is highly descriptive of a significant feature or function of applicant's services. There is no question that applicant's clients, sponsors and participants would immediately, and without the exercise of any imagination, understand that applicant's CORPORATE PRO BONO services will provide them with the assistance and resources needed to establish and manage programs to provide "corporate pro bono" services to the public.

We turn then to applicant's evidence of acquired distinctiveness. The burden is on applicant to show acquired distinctiveness, and the more descriptive the term, the heavier that burden. See *Yamaha International Corporation v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In considering all of the evidence, and the highly descriptive nature of CORPORATE PRO BONO for the identified services, we find that applicant has not met this burden.

In support of its claim of acquired distinctiveness, applicant has submitted a declaration attesting to applicant's five years of substantially exclusive and continuous use of the mark in commerce. The Board has consistently held that where, as here, the term sought to be registered is highly descriptive, a mere statement of five years of use is insufficient to establish acquired distinctiveness. See *In re Synergistics Research Corporation*, 218 USPQ 165, 167 (TTAB 1983) and cases cited

therein; and In re Mine Safety Appliances Co., 66 USPQ2d 1694, 1698 (TTAB 2002).

Furthermore, based on this record, there is at least a question as to whether applicant has made substantially exclusive use of the term "corporate pro bono." Without substantially exclusive use, the term at issue does not point to one unique source. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-941 (Fed. Cir. 1984) ("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").²

Applicant also argues that applicant's organization "has grown exponentially with over thirty-five corporate supporters, and thirty-five law firm sponsors"; that applicant recently provided a "Corporate Pro Bono Challenge" which had over fifty entities participating in the challenge, including a number of large corporations such as 3M Company and The Coca-Cola Company; and that, as shown on its website, there are many entities and

² The requirement for substantially exclusive use makes allowance for inconsequential or infringing use by others that will not invalidate applicant's claim that its mark has acquired distinctiveness. *L.D. Kichler Co. v. Davoil Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). There is nothing of record to indicate that these are infringing uses; and the number and nature of the third-party uses do not appear to show inconsequential use.

individuals that participate in applicant's "CORPORATE PRO BONO" program.

Applicant's statements are unverified, and moreover, as we indicated earlier, there is no evidence that participation by these organizations or their sponsorship of applicant's "corporate pro bono" program evidences recognition of CORPORATE PRO BONO as a mark associated uniquely with applicant.

We turn then to applicant's prior registrations. As noted earlier, applicant has claimed ownership of the following registrations on the Principal Register, all for services essentially the same as those recited herein: Registration No. 3290424 for the mark PRO BONO INSTITUTE ("Institute" disclaimed) under Section 2(f) of the Trademark Act; Registration No. 3297327 for the mark LAW FIRM PRO BONO CHALLENGE on the Principal Register; and Registration No. 3210560 for the mark LAW FIRM PRO BONO PROJECT under Section 2(f) of the Act.

Trademark Rule 2.41(b) provides in relevant part that "In appropriate cases, ownership of one or more prior registrations on the Principal Register...of the same mark may be accepted as prima facie evidence of distinctiveness." To the extent, if any, that applicant is relying on these registrations as evidence of acquired distinctiveness, the evidence is not persuasive. First, applicant has merely listed the registrations, and printouts of

the registrations were never made of record.³ Thus, applicant has not demonstrated that it owns any prior registrations. Nevertheless, even if the registrations were properly of record, none of the registrations is for the "same mark" as required by Trademark Rule 2.41(b). As set forth in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), a proposed mark is the "same mark" as a previously-registered mark for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such mark. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. The marks in these three registrations are not legal equivalents to the mark herein as they clearly do not convey the same meaning or commercial impression. Thus, applicant's ownership of registrations covering different marks is irrelevant to the question of whether the mark in this case has acquired distinctiveness. See *In re Parkway Machine Corp.*, 52 USPQ2d 1628 (TTAB 1999).

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act on the ground that the mark is generic is affirmed; and the refusal to register on the ground that the mark

³ The examining attorney mistakenly refers to these registrations as "third-party registrations" when in fact applicant claimed ownership of the registrations in its request for reconsideration dated November 8, 2007.

Serial No. 78762830

is merely descriptive and that the evidence is insufficient to show that the mark has acquired distinctiveness under Section 2(f) of the Act also is affirmed.