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OF THE TTAB**

Mailed:
May 11, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pre-Paid Legal Services, Inc.

Serial No. 86423483

Drew T. Palmer of Crowe & Dunlevy,
for Pre-Paid Legal Services, Inc.

Kathy Wang, Trademark Examining Attorney, Law Office 108
Andrew Lawrence, Managing Attorney.

Before Ritchie, Lykos, and Greenbaum, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Pre-Paid Legal Services, Inc. (“Applicant”) filed an application to register on the Principal Register the mark PPL, in standard character format, for services identified as “business administration of legal expense plan services, namely, arranging certain legal services covered by a membership contract for a member through a provider or referral third-party attorneys; arranging and conducting incentive or reward programs to promote the sale of pre-paid

legal expense plans,” in International Class 35.¹ The Trademark Examining Attorney refused registration on the ground that the applied-for mark is merely descriptive of the services pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, Applicant filed this appeal, which is fully briefed.

Preliminary Issue

We note that the statement from the Examining Attorney was filed nearly three weeks late, as it was due on March 5, 2017 and filed on March 23. The Examining Attorney acknowledges the tardiness of the brief and asks in the brief that the lateness be excused based on a “scheduling mistake.”² In particular, the Examining Attorney notes that Applicant had at the time three similar applications pending for the same mark, all of which were appealed at varying times.

We note that the Examining Attorney did not file a separate extension of time. *See* TBMP § 1203.02(d) (Jan. 2017). Nonetheless, as noted in that section, an extension of time may be granted by the Board “upon written request showing good cause for the requested extension.” Although the Examining Attorney’s brief was filed three weeks late, we find the excuse of docketing error to constitute good cause.

¹ Serial No. 86423496, filed on October 14, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s assertion of a bona fide intent to use the mark in commerce.

² 6 TTABVUE 3.

Although Applicant observes in its reply brief the lateness of the Examining Attorney's brief, Applicant does not appear to specifically object to our acceptance thereof, but rather cautions that "A late-filed brief by the Examining Attorney may be excluded in the absence of an adequate explanation for the late filing,"³ citing TBMP § 1203.02(b). Furthermore, Applicant asks on reply that to the extent the Examining Attorney's brief has "considered and relied on all evidence provided in Applicant's Brief" we thus "treat all evidence as of record."⁴ We agree and have considered all evidence in the record.

Finally, we note that even if we had not considered the Examining Attorney's brief, in accordance with our practice, we would proceed to consider the merits of the refusal. *See* TBMP § 1203.02(b). *In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984) (In finding Examining Attorney's statement to be untimely submitted without cause, the Board did not consider it, but proceeded to consider the merits of the case and to affirm the refusal). In this case, we would reach the same result. We thus affirm the refusal to register.

Mere Descriptiveness

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the

³ 7 TTABVUE 2 n.1.

⁴ 7 TTABVUE 2-3 n.3.

goods or services. See *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); see also *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). On the other hand, if a mark requires imagination, thought and perception to ascertain the nature of the goods or services, then the mark is suggestive. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*, 695 F.3d 1247, 103

USPQ2d 1753, 1755 (Fed. Cir. 2012) (citing *In re Abcor Dev. Corp.* 200 USPQ 215).

The Examining Attorney asserts that the term PPL is an acronym for “pre-paid legal” which describes a feature or characteristic of Applicant’s services, namely that Applicant arranges legal services and reward programs in the nature of “pre-paid legal expense plans.” We note that an acronym is considered merely descriptive under the following circumstances:

1. The applied-for mark is an abbreviation or acronym for specific wording;
2. The specific wording is merely descriptive of the applied-for goods or services; and
3. The relevant consumers will recognize the abbreviation or acronym as the merely descriptive wording it represents.

See *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715-16 (TTAB 2011).

A. Whether PPL is an abbreviation or acronym for “pre-paid legal”?

The Examining Attorney has submitted evidence from AcronymFinder, AllAcronyms, and TheFreeDictionary.com that PPL is an acronym for “Pre-Paid Legal.”⁵ The record also contains webpages that reference PPL as an acronym or abbreviation for “pre-paid legal,” including the following:

PPL Steve’s Blog: Listing of Pre-Paid Legal Provider Law Firms:
<https://pplsteve.wordpress.com>.⁶

EMMAcal: EmmaCal Prepaid Legal Plan: EMMACAL PPL is a prepaid legal plan specifically designed to protect the rights of

⁵ Attached to February 9, 2015 Office Action, at 2 (acronymfinder.com), 8 (allacronyms.com); March 24, 2016 Office Action at 2 (thefreedictionary.com).

⁶ Attached to September 1, 2015 Office Action, at 2.

medical marijuana patients in the State of California and protect their legal use of MMJ as recommended by a physician.
<http://emmacal.org>.⁷

The LEAF online: I want my PPL (pre-paid legal):
<http://theleafonline.com>.⁸

Brooklyn College: Tax Information:
Box 14 – Other: Amounts to be reported: PPL – Prepaid Legal Expense.

Pre-paid legal service: A pre-paid legal service is an individual or group low-cost insurance provider for specific, limited legal services (usually basic, but sometimes specialized) from participating law firms and attorneys at costs considerably less than independently hiring these providers. PPL services may be provided on an ‘open’ basis, with a subscriber selecting specialists relatively freely from a pool of participating providers, . . .

Brooklyn.cuny.edu.⁹

We thus find that PPL is a recognized acronym for “pre-paid legal.”

B. Whether “pre-paid legal” is merely descriptive of Applicant’s services?

Applicant argues that “pre-paid legal” will not be understood as identifying its services. However, the identification of services specifies the provision of business administration and reward services specifying “pre-paid legal services.” The Examining Attorney has also submitted a third-party webpage that advertises the administration of PPL or “Prepaid Legal”:

Corporate Services: Employee Benefits Services: Prepaid Legal (PPL/PPLS): Protect yourself, your business and your employees against unforeseen litigious action at a fraction of the potential cost. Pickering can consult with you to help you decide whether you need minimal, general or specialized coverage, and find the right partner.

⁷ Attached to September 1, 2015 Office Action, at 5.

⁸ Attached to September 1, 2015 Office Action, at 8.

⁹ Attached to March 24, 2016 Office Action, at 15-16.

*http://pickeringinsurance.com.*¹⁰

We thus find that “pre-paid legal” is merely descriptive of Applicant’s services because it immediately conveys to prospective consumers a significant feature of its business administration and reward services.

C. Whether relevant consumers viewing PPL in connection with the services would recognize it as an abbreviation of the term “pre-paid legal”?

Applicant argues that the relevant consumers will not view PPL as referring to “pre-paid legal” since there are other possible definitions of the abbreviation or acronym. In particular, Applicant notes that there are 71 other meanings given for PPL on acronymfinder.com and 360 other meanings given for PPL on allacronyms.com.¹¹ In particular, Applicant refers to evidence it submitted showing that “pre-paid legal” is not a common or popular definition of PPL on either of those sites, referencing 0 out of 5 stars on acronymfinder.com and “a 15 ‘thumbs up/thumbs down’ ranking” on allacronyms.com.¹²

Applicant analogizes this to the case of *Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, 104 USPQ2d 1224, 1230 (TTAB 2012 (CMS not merely descriptive of wine). In that case, however, the Board found that in addition to the fact that a number of other possible meanings were given for

¹⁰ Attached to March 24, 2016 Office Action, at 11-14.

¹¹ Attached to March 1, 2016 Response to Office Action, at 3, 10.

¹² 4 TTABVUE 9-10. See also March 1, 2016 Response to Office Action, at 5, 10.

the acronym CMS, the letters did “not directly and immediately convey the meaning of the three varietals” cabernet, merlot, and syrah. Rather, “the process of recognizing that derivation requires some thought, and that is the very essence of a suggestive mark.”

It is axiomatic that we must consider the applied-for mark in relation to the services, and not in a vacuum. *See In re Bright-Crest, Ltd.*, 204 USPQ at 593. In addition to the evidence noted above, the Examining Attorney submitted the following:

Fry’s Equine Insurance: Prepaid Legal Services (PPL) is a service you purchase for a low monthly cost (less than \$15 a month in most states) that affords you an attorney when you need one.

frysequineinsurance.com.¹³

Considering the evidence as a whole, we find that the term PPL, when considered in relation to the applied-for services, “business administration of legal expense plan services, namely, arranging certain legal services covered by a membership contract for a member through a provider or referral third-party attorneys; arranging and conducting incentive or reward programs to promote the sale of pre-paid legal expense plans,” includes services featuring PPL or pre-paid legal services. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1755. Therefore, we find that the proposed mark is merely descriptive of the identified services, and we affirm the refusal to register under Section 2(e)(1).

¹³ Attached to October 12, 2016 Final Office Action, at 2.

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Decision: The Board affirms the refusal to register.