

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 18, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Nancy D. Greene*

—  
Serial No. 87830154

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Michael F. Sarney of Moritt Hock & Hamroff LLP,  
for Nancy D. Greene

Lyal Fox, Trademark Examining Attorney, Law Office 113,  
Myriah Habeeb, Managing Attorney.

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Before Shaw, Greenbaum and Adlin,  
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Nancy D. Greene (“Applicant”) seeks registration of the proposed mark LEGAL  
LANDMINES (in standard characters) on the Principal Register for services  
identified as:

Providing coaching services in the field of business;  
Educational services, namely, seminars, conferences, and  
workshops in the field of business; Business coaching  
services in the field of corporate culture, business  
consulting, employee and procedure policy review services,  
namely, business review of policies and procedures for legal  
compliance, and documentation of the internal processes

and retention of institutional knowledge, in International Class 41.<sup>1</sup>

Applicant disclaimed “LEGAL.”

The Trademark Examining Attorney has refused registration of Applicant’s proposed mark on the ground that it fails to function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1151-1053 and 1127.

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. After review by the Board, the application was remanded to the Trademark Examining Attorney to consider whether registration also should be refused, in the alternative, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Upon remand, the Examining Attorney and Applicant agreed to amend the application via Examiner’s Amendment to seek registration on the Supplemental register to obviate a Section 2(e)(1) refusal. The failure to function refusal has been maintained and the appeal has resumed again. The appeal is fully briefed. We affirm the refusal to register.<sup>2</sup>

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<sup>1</sup> Application Serial No. 87830154 was filed on March 12, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere of January 1, 2013 and a date of first use in commerce of March 1, 2018.

<sup>2</sup> All TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations reference the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

**I. Preliminary matters**

**A. Examining Attorney's non-conforming brief**

Applicant objects to the Examining Attorney's brief on the grounds that it violates Trademark Rule 2.126(a)(1), because the text is not in at least 11 point type. Applicant argues that the Board should disregard the brief because "[s]uch violation makes it very difficult and more time consuming to read and analyze the examining attorney's Brief."<sup>3</sup>

Trademark Rule 2.126(a)(1) states that "[t]ext in an electronic submission must be filed in at least 11-point type and double-spaced." The body of the Examining Attorney's brief appears to be in 10 point type which is not in accordance with the type size requirements. However, we have ascertained that this may be due to a technical problem that occurred during the uploading process, which converted the font from one that conformed to Trademark Rule 2.126(a)(1) to a font that appears smaller than required. The brief is double spaced, however, and it appears to fall within the applicable page limits. Given that the brief is available in electronic form and may be re-sized for viewing by using the "marquee zoom" tool, Applicant's objection is moot. *See In re Univ. of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017) (Board has discretion to consider nonconforming briefs).

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<sup>3</sup> Applicant's Reply Br., p. 1, 10 TTABVUE 2.

B. Evidence attached to Applicant's brief

The Examining Attorney objected to Applicant's submission, for the first time with her brief, of three third-party registrations, listed as Exhibit B.<sup>4</sup> Inasmuch as the Examining Attorney considered the third-party registrations pursuant to the Board's remand order, the objection is moot. The registrations will be considered as part of the record and will be given whatever probative value they deserve.

**II. Failure to function as a mark**

We begin our analysis with the Trademark Act's definition of a service mark, which is "any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127. "[A] proposed trademark [or service mark] is registrable only if it functions as an identifier of the source of the applicant's goods or services." *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, \*16 (TTAB 2019) (quoting *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019)). "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976).

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<sup>4</sup> 7 TTABVUE 11-19. Applicant also submitted (as "Exhibit A") a dictionary definition of "information" from merriam-webster.com. The Examining Attorney did not object to this definition and we have considered it. In any event, the Board may take judicial notice of dictionary definitions obtained from printed reference materials. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1208.04 (June 2020).

Whether the phrase LEGAL LANDMINES falls within the definition of a service mark and functions as a mark depends on whether the relevant public, i.e., purchasers or potential purchasers of Applicant's services, would perceive the phrase as identifying Applicant's services and their source or origin. *See e.g. In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, \*1-2 (TTAB 2019); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) ("To be a mark, the term must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods."); *In re Volvo Cars of North Am. Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998) ("A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public."); *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992). "To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace." *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (citations omitted).

Applicant's amendment to the Supplemental Register does not overcome the failure to function refusal. *See id.* Matter that does not operate to indicate the source or origin of the identified goods or services and distinguish them from those of others does not meet the statutory definition of a trademark and may not be registered, regardless of the register on which registration is sought or claims of acquired distinctiveness. *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710 (TTAB 2016) (granting petition to cancel a registration on the Supplemental Register because the mark failed to function as a trademark); *In re Ocean Tech., Inc.*, 2019 USPQ2d

450686, \*8 (TTAB 2019) (ALL NATURAL GOURMET CRABMEAT PASTEURIZED 100% REAL CALLINECTES CRAB and crab design fails to function as a trademark for crabmeat because it merely conveys information about the goods).

The Examining Attorney argues that LEGAL LANDMINES is “a commonplace term, message, or expression widely used by a variety of sources in the applicant’s field that merely conveys an ordinary, familiar, well-recognized concept or sentiment, namely, that the provided coaching and educational services are for assisting businesses in avoiding concealed yet incipient crises relating to the law.”<sup>5</sup> In support of the refusal, the Examining Attorney submitted a number of exhibits from third-party sources to establish that the phrase “legal landmines” is commonly used in the business and legal fields to convey the danger to businesses of risks associated with such “concealed yet incipient crises relating to the law.”<sup>6</sup> The following evidence is the most pertinent:

1. An excerpt from acfe.com, the website of the Association of Certified Fraud Examiners, featuring fraud training entitled “Legal Landmines to Avoid in Fraud Examinations.” The description of the training session states it “highlights four potential legal landmines fraud examiners can avoid when conducting fraud examinations.” Office Action dated June 25, 2018, TSDR 24.

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<sup>5</sup> Examining Attorney’s Br., 9 TTABVUE 5.

<sup>6</sup> *Id.* The Examining Attorney’s evidence includes several search engine “hit lists.” These generally have little probative value, because such lists do not show sufficient context in which the term is used on the listed web pages. See *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007).

2. An Entrepreneur magazine article entitled “When Interviewing, Avoid Legal Landmines and Find Out What You Want to Know.” *Id.* at 25.
3. An Inman.com article entitled “5 tips for avoiding legal landmines this year.” *Id.* at 26.
4. An Insperity.com e-book entitled “Six Legal Landmines to Avoid When Screening Job Applicants. “Key Takeaways” involving hiring practices and compliance explain “why some common practices could create a liability for your company,” “what not to do when researching a candidate,” “why cutting corners on background checks can hurt your company,” and “how to protect yourself from liability and potential lawsuits.” *Id.* at 27.
5. A LegalTech News article entitled “Virtual and Augmented Reality’s Legal Landmine: User-Generated Data.” *Id.* at 28.
6. A Helpside article entitled “The Overlooked Steps: Avoiding Legal Landmines.” *Id.* at 29.
7. A PMS Plus Media Solutions press release advertising a webinar entitled “Hiring Hazards – How to Avoid the 7 Most Common Legal Landmines.” The webinar offers information on compliance with employment laws, payroll processing, and tax laws. Final Office Action dated April 4, 2019, TSDR 3.
8. A Right Vision Media press release advertising a webinar entitled “FMLA:- How to Avoid Legal Landmines.” The webinar offers management training on various Human Resources issues. *Id.* at 4.

9. A Mondaq business briefing discussing a presentation provided at the Employer Healthcare & Benefit Congress entitled “Wellness Incentive Programs: Navigating Legal Landmines and Designing Effective Employee Communication Strategies.” The webinar discusses compliance with the Health Insurance Portability and Accountability Act (HIPAA), the Affordable Care Act (ACA), the Americans with Disability Act (ADA) and other government programs. *Id.* at 5.
10. A Muzeview Research newsletter advertising a class for startup businesses which is described as a “get smart session on legal landmines,” and states that “[t]his class will give you the basic knowledge you will need to help avoid these costly legal landmines.” *Id.* at 6.
11. A Newstex LLC blog post advertising a webinar entitled “Avoiding Legal Landmines when Using Facebook, LinkedIn, and Other Social Media Websites for Screening Candidates,” which also states “[w]e show employers how to avoid these legal landmines,” and advises that webinar participants will learn “what the privacy and discrimination concerns are when using social media information, the potential legal landmines involved, and what steps their organizations can take to minimize these risks.” *Id.* at 7.
12. A ProQuest Information and Learning Company article advertising and reviewing a book entitled “The Four Mistakes – Avoiding the Legal Landmines that lead to Business Disaster.” *Id.* at 8.



13. A Crain's article entitled "Avoid the latest legal landmine." The article discusses policies businesses should adopt when interviewing job candidates. *Id.* at 9.
14. A ProQuest Information and Learning Company article entitled "Probing for worker misconduct plants legal landmines." The article discusses policies businesses should adopt when investigating employee wrongdoing. *Id.* at 10.
15. A Law360.com article on companies' policies relating to employee grooming and dress. The article states some corporate "appearance and grooming policies may contain hidden legal landmines." *Id.* at 14.
16. A Lexology.com article discussing a National Labor Relations Board ruling on unfair labor practices. The article states corporate policies relating to unionizing activities are "full of potential legal landmines." *Id.* at 15.
17. An excerpt from the Hoover, Hull, Turner law-firm website advertising a seminar entitled "Avoiding HR Legal Landmines." A portion of the website states the session: "will discuss Hiring, Firing, and Discipline Missteps, including job description errors, interview and background check compliance, avoiding pitfalls in discipline and discharge, and navigating use of waivers and releases." The seminar also includes topics on compliance and documentation. Denial of Request for Reconsideration dated October 2, 2019, TSDR 7.
18. A Workforce Solutions advertisement concerning "everyday HR issues" for a class entitled "Legal Landmines: Say This, Not That."

19. An Eventbrite webpage advertising a workshop entitled “Lunch & Learn: HR: Legal Landmines for 2019.” The website states: “In this live workshop offered in Columbus, you will learn actionable tips to proactively address the HR legal issues that are most likely to impact employers this year.” The workshop includes sections on wages, labor policies, and management training. *Id.* at 9.

The Examining Attorney also relies on Applicant’s specimen, webpage, and other submissions to support the refusal. The following evidence from Applicant is the most pertinent:

1. Applicant’s original specimen, filed with the application, includes the following description of her services:<sup>7</sup>

Navigating LEGAL LANDMINES™

I help clients in all areas of business and employment law. I give my full attention to every aspect of my client’s matters. I provide business owners and entrepreneurs with the tools they need to navigate the perilous waters, legal and practical, of doing business.

\* \* \*

WHAT YOU DON’T KNOW CAN HURT YOUR BUSINESS!

You’ve often heard that what you don’t know won’t hurt you? Unfortunately, when it comes to the law and your business that saying is dead wrong. Running a business and minimizing the Legal Landmines™ you hit in the process means leveraging knowledge from different specialties.

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<sup>7</sup> Application of March 12, 2018, TSDR 3.

2. Applicant's website describes her services, and states: "Our business consulting and diagnostic services are tailored to each client's requirements."<sup>8</sup> The offered services include "Landmine detection evaluation."<sup>9</sup>
3. In her response to the first Office action, Applicant included marketing materials further describing her services. The materials reference the services as follows: "LEGAL LANDMINES: THE TOP 5 MISTAKES YOU ARE MAKING IN YOUR BUSINESS."<sup>10</sup> The materials also include the following graphic images describing Applicant's services in more detail:<sup>11</sup>



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<sup>8</sup> [https://www.attorneynancygreene.com/practice areas](https://www.attorneynancygreene.com/practice%20areas), Office Action dated June 25, 2018, TSDR 30.

<sup>9</sup> *Id.* at TSDR 31.

<sup>10</sup> Response to Office action dated March 22, 2019, TSDR 34.

<sup>11</sup> *Id.* at TSDR 35.

If you are in business you are likely making at least one of 5 critical but avoidable mistakes that will send you careening into a **Legal Landmine**. Do you worry that one legal misstep will send your business tumbling into freefall? Overwhelmed by seemingly contradictory requirements? Don't worry. You are not alone.

You will leave knowing:

- The "must have" agreements to protect your business.
- How to arm yourself against the everyday threats that can destroy your business.
- How to get past the legal mumbo-jumbo and know what really matters.

4. An excerpt from Applicant's webpage describes her public speaking experience, and her book, NAVIGATING LEGAL LANDMINES™: A practical guide to business law for real people (emphasis added):<sup>12</sup>

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<sup>12</sup> Office Action of April 4, 2019, TSDR 16.

## COMMITTED TO THE BUSINESS COMMUNITY

Nancy is a dynamic speaker who has presented at a number of conferences across the country. Tired of watching the heartbreak of business owners who'd lost everything over legal landmines that could have been avoided, she's committed to ensuring business owners have access to competent and cost-effective legal counsel and information.



In this DIY society there are very limited legal resources for small to mid-sized businesses. Nancy takes all that fancy legal mumbo-jumbo and demystifies it. She is committed to helping women leverage the law to help them grow their businesses in a sustainable and compliant manner, and equally importantly, create the systems that allow them to enjoy what they've built.

## BEST SELLING AUTHOR

Nancy is the bestselling author of *Succeeding Through Doubt, Fear & Crisis*, which rose to #1 status in five categories at Amazon.com, and *Navigating Legal Landmines™: A Practical Guide to Business Law for Real People*, which rose to #1 status in three categories on Amazon.com.



She has also published multiple short stories under her pen name "Nancy DiMauro." She's developed a series of YouTube Videos, and blog posts to assist business owners on how to avoid the Legal Landmines that can destroy their businesses.

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GET MY BOOK

<https://www.attorneynancygreene.com/meet-nancy/>

The American Heritage dictionary defines "legal" as "[o]f, relating to, or concerned with law."<sup>13</sup> "Land mine" is informally defined as "a concealed yet incipient crisis."<sup>14</sup>

<sup>13</sup> Americanheritagedictionary.com, Office Action of June 25, 2018, TSDR 13.

<sup>14</sup> *Id.* at TSDR 14.

Taken together, LEGAL LANDMINES is a figure of speech used to refer to a concealed yet incipient crisis relating to the law. The record before us establishes that the phrase LEGAL LANDMINES is widely used by attorneys, HR specialists, and business educators to identify common legal problems businesses should avoid. As demonstrated by the third party evidence, these legal problems commonly involve corporate labor policies, compliance with existing laws, management training, wage issues, hiring issues, and discrimination issues.

As stated in Applicant's attachment to her response to the first Office action, Applicant's business coaching and educational services focus on some of these same kinds of legal problems:<sup>15</sup>

- BUSINESS CONSULTING
- COMPLIANCE ASSESSMENTS
- MANAGEMENT TRAINING
- CORPORATE STRUCTURE ASSESSMENTS
- POLICY REVIEW
- WAGE/HOUR REVIEW
- CULTURE ASSESSMENT
- PROCESS CREATION
- EDUCATIONAL SEMINARS AND EVENTS

Similarly, as Applicant states on her website, she "provide[s] business owners and entrepreneurs with the tools they need to navigate the perilous waters, legal and practical, of doing business."<sup>16</sup> Thus, Applicant's use of LEGAL LANDMINES to identify her coaching and educational services in the field of business merely informs prospective consumers about the focus of Applicant's services, namely, avoiding

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<sup>15</sup> Response to Office Action dated March 22, 2019, TSDR 35.

<sup>16</sup> Application of March 12, 2018, TSDR 3.

common legal crises in business, or “legal landmines.” Indeed, in some instances Applicant uses the term LEGAL LANDMINES not to identify her services or their source, but to refer to unexpected crises to be avoided: “Running a business and minimizing the Legal Landmines™ you hit in the process means leveraging knowledge from different specialties.”<sup>17</sup>

The function of a trademark or service mark is to identify a single commercial source. Because consumers are accustomed to seeing LEGAL LANDMINES used by law firms, HR specialists, and business educators discussing ways to avoid legal crises, consumers would not view Applicant’s LEGAL LANDMINES as a service mark indicating Applicant is the sole source of business coaching and educational services. Instead, the record establishes that many third parties have a common and consistent understanding of the phrase LEGAL LANDMINES, which refers not to Applicant or her services, but instead to legal crises businesses seek to avoid. Applicant is not entitled to appropriate the phrase to herself and thereby attempt to prevent competitors from using it to promote the sale of their own products or services. *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1152 (TTAB 2019) (INVESTING IN AMERICAN JOBS does not function as a mark because it is “merely an informational statement that Applicant is selling certain goods that are made or assembled in America in areas of the store where the signage appears”); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (describing the phrase BRAND NAMES FOR LESS as “a highly descriptive and informative slogan [that] should remain available

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<sup>17</sup> *Id.*

for other persons or firms to use to describe the nature of their competitive services”); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (affirming refusal to register FOR A DAY, A WEEK, A MONTH OR MORE! because it “is simply an ordinary informational statement about the availability of rooms for various lengths of time”). It has been noted that “as a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights” in common phrases. 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:23 (5th ed. June 2020).

Applicant nevertheless argues that “LEGAL LANDMINES does not convey any message, and is not widely used by others to convey any information or message.”<sup>18</sup> We disagree. LEGAL LANDMINES conveys information about the subject of Applicant’s business coaching and educational services, i.e., the dangers of unexpected legal crises. The evidence of record also establishes that LEGAL LANDMINES is widely used by third parties to convey information about the dangers of unexpected legal crises that businesses may face. Based on the evidence of record showing use by third parties to discuss some of the same subjects covered by Applicant’s services, we do not find that Applicant’s specimens or other submissions establish that the proposed mark would be perceived by the relevant public as a source indicator for business coaching and educational services. Simply put, Applicant’s intent that LEGAL LANDMINES function as a service mark does not make it so. “Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term

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<sup>18</sup> Applicant’s Br., p. 4, 7 TTABVUE 5.



a trademark.” *In re Remington Prods. Inc.*, 3 USPQ2d at 1715; *see also Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1855 (TTAB 2017); *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) (“[M]ere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself.”); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) (“Wishing does not make a trademark or service mark be.”). If, as here, the evidence establishes that the public would not perceive the proposed mark as serving to indicate the source of the identified services, it does not function as a mark and may not be registered regardless of the manner of use depicted on the specimens.

Applicant also argues that since other phrases, such as “EARLY WARNING” for use in connection with computer programs and radar detectors, have registered, her proposed mark should be entitled to registration as well. “While we recognize that ‘consistency is highly desirable,’ consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.” *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) (quoting *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007)). We “must assess each mark on its own facts and record.” *Id.* The fact that the USPTO may have registered “EARLY WARNING” for use in connection with unrelated goods does not entitle Applicant to register LEGAL LANDMINES for business coaching and educational services.

Because it is merely informational in the context of Applicant's identified services, widely used by the others in the relevant markets, and would not be perceived as an indicator of source, LEGAL LANDMINES fails to function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act. 15 U.S.C. §§ 1051-1053 and 1127.

**Decision:** The refusal to register Applicant's proposed mark LEGAL LANDMINES on the ground that it fails to function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act is affirmed.

**Greenbaum, Administrative Trademark Judge, dissenting:**

Reasonable minds may differ, and I find myself in that situation here. I therefore respectfully dissent.

The evidence outlined by the majority shows some use of the term LEGAL LANDMINES in the industry and by Applicant to refer to common business problems. This evidence supports a finding that the term is merely descriptive of the subject matter under Section 2(e)(1) of the Trademark Act, a refusal that was made and then obviated by Applicant's amendment to the Supplemental Register.

But the record does not sufficiently demonstrate that LEGAL LANDMINES fails to function as a trademark because it is a common phrase or message that ordinarily would be used in advertising or in the relevant industry, or that consumers are accustomed to seeing used in everyday speech by various sources. The evidence pertains only to the specific services identified in the application, and does not show wide use of the term by a variety of sources from a variety of fields. *Cf., e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403 (TTAB 2018) (I LOVE YOU,

appearing on bracelets, would be viewed as a term of endearment rather than a source-identifying trademark).

Nor does the record demonstrate that LEGAL LANDMINES conveys general information about the identified services to the extent that would preclude the term from performing a source-identifying function. *Cf., e.g., In re AOP LLC*, 107 USPQ2d 1644, 1655 (TTAB 2013) (finding AOP merely informational and not source identifying for wine because it informs consumers of a certification process).

In some circumstances, a proposed mark may properly be refused registration under Section 2(e)(1) of the Trademark Act, and under Sections 1, 2, 3 and 45 of the Trademark Act. But I do not believe this duality applies to LEGAL LANDMINES. Accordingly, I would reverse the refusal under Sections 1, 2, 3 and 45 of the Trademark Act, and allow the proposed mark to reside on the Supplemental Register.