

This Opinion is Not a
Precedent of the TTAB

Hearing: February 28, 2018

Mailing: March 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Larry Pitt & Associates, P.C.

v.

Lundy Law, LLP

—
Opposition No. 91210158
—

Jacqueline M. Lesser of Baker & Hostetler LLP,
for Larry Pitt & Associates, P.C.

Manny D. Pokotilow of Caesar Rivise, PC,
for Lundy Law, LLP.

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Before Bergsman, Goodman and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Lundy Law, LLP (“Applicant”) seeks registration on the Principal Register of the mark REMEMBER THIS NAME (in standard characters) for “legal services,” in Class 45.¹

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¹ Application Serial No. 85767757 was filed on October 31, 2012, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as May 16, 2011.

Larry Pitt & Associates, P.C. (“Opposer”) filed an Amended Notice of Opposition against the registration of Applicant’s mark on the ground that REMEMBER THIS NAME does not function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1053, and 1127.²

In its Answer to the Amended Notice of Opposition, Applicant admitted that (1) Opposer has used the phrase “REMEMBER THIS NUMBER” over its toll free number as one means of instructing potential clients to remember the telephone number of Opposer’s business, (2) it is a law firm operating in Pennsylvania and its advertising normally contains the name of the firm or its toll free number, (3) it filed subject application Serial No. 85767757, and (4) it filed suit against Opposer charging that Opposer’s use of REMEMBER THIS NUMBER is an infringement of Applicant’s REMEMBER THIS NAME; but Applicant dismissed the suit. Applicant denied the remaining salient allegations in the Amended Notice of Opposition.

² 24 TTABVUE.

Opposer initially filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the grounds that REMEMBER THIS NAME is merely descriptive or generic when used in connection with legal services. However, in the Board’s October 31, 2014 Order granting Applicant’s motion for summary judgment on the issues of whether its mark is generic or merely descriptive when used in connection with legal services, the Board allowed Opposer time to file an amended notice of opposition setting forth a claim that Applicant’s mark REMEMBER THIS NAME does not function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053 and 1127. 23 TTABVUE.

I. Evidentiary Issues

A. Applicant's motion to introduce testimony after the close of trial.

On January 19, 2018, well after the close of trial and briefing, Applicant filed a "Motion To Enter Further Evidence Into Notice of Reliance."³ In essence, Applicant filed a motion to reopen its testimony period to introduce newly discovered evidence. Applicant seeks to introduce the declaration of Lauren Cohen, Applicant's Director of Strategic Marketing, including a copy of Ms. Cohen's Facebook page announcing that she is leaving Applicant. One of the people responding to her announcement wrote "Remember The Name!!" Applicant argues that the evidence could not have been introduced earlier because it was not posted until January 19, 2018.

Opposer objects to the Cohen Declaration on the grounds that material submitted outside of a party's testimony period should be given no consideration and that Opposer has had no opportunity to cross examine either Lauren Cohen or the person responding to her Facebook post.⁴

The Trademark Rules provide for a trial order setting the time for each party to introduce testimony or other evidence.

The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the

³ 105 TTABVUE.

⁴ 107 TTABVUE 2.

parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a).

Trademark Board Manual of Procedure (TBMP) § 509.01(b)(2) (June 2017)

provides that:

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence. However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party. (footnotes omitted).

Trademark Rule 2.123(a)(1), 37 C.F.R. § 2.123(a)(1), provides that a party may introduce the testimony of a witness through an affidavit or declaration, filed during that party's testimony period, subject to the right of the adverse party to cross examine the witness. Considering the stage of this proceeding, allowing Applicant to introduce Ms. Cohen's declaration requires us to reopen Applicant's testimony period so that Opposer may cross examine the witness. Moreover, because the declarant whose statement is purportedly probative is not Ms. Cohen, we would have to permit Opposer to depose the declarant of the statement at issue. It is much too late in the proceeding to permit a reopening of Applicant's testimony period especially because the evidence at issue, consumer perception, is the type of evidence that Applicant should have introduced during its testimony period. *See Canadian Tire Corp. v. Cooper Tire & Rubber Co.*, 40 USPQ2d 1537, 1539 (Comm'r 1996) ("The nature and

purpose of the evidence sought to be added, the stage of the proceeding, the adverse party's right to a speedy and inexpensive determination of the proceeding and the need for closure once the trial period has been completed (barring some compelling reason to reopen), are all factors which must be considered by the Board in determining a motion to reopen such as this.”).

Moreover, the evidence sought to be introduced, one response to a Facebook posting, does not have significant probative value to justify reopening trial. That is, the new evidence is not likely to cause a different result or affect the outcome of this case.

Any further delay will prejudice Opposer. This case has been pending since April 2013, there has been a motion for summary judgment, and the parties have had more than four years to take discovery and present trial evidence. It is time to move this case forward for a final determination on the merits. *See Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998).

Applicant's motion to reopen its testimony period to introduce the declaration of Lauren Cohen and accompanying exhibit is denied.

- B. Applicant's motions to strike portions of the Ross Fishman testimony deposition and expert report.

Opposer has introduced the testimony deposition and Amended Expert Report of Ross Fishman.⁵ Mr. Fishman is a marketing consultant specializing in the development of strategies and creative marketing for law firms.⁶

Fundamentally we do three things: We are sort of a strategy and branding firm, mostly representing law firms, but other professional services, and other kinds of companies as well. We do the strategy, branding, and then developing the collateral materials in support of those brands, um, which include these days, um, websites, um, as well as print ads, brochures, the full range of marketing collateral materials. And also do a lot of marketing training, firm in trades (phonetic), and keynote speeches.⁷

Despite the Board's finding that Mr. Fishman is qualified as a marketing expert in the field of law firm advertising, not as an expert in trademark law,⁸ Opposer engaged Mr. Fishman to render his opinion regarding the following topics:

1. The use of the phrase REMEMBER THIS NAME;
2. Whether REMEMBER THIS NAME may be considered a trademark;
3. Whether the specimen of use filed with Applicant's application showing use of REMEMBER THIS NAME functions as a trademark; and
4. Whether REMEMBER THIS NAME is capable of functioning as a trademark.⁹

⁵ 71 TTABVUE.

⁶ Fishman Dep. Exhibit 2 (Amended Expert Report of Ross Fishman) (71 TTABVUE 130).

⁷ Fishman Dep., p. 8 (71 TTABVUE 9).

⁸ 23 TTABVUE 4-5.

⁹ Fishman Dep. Exhibit 2 (Amended Expert Report of Ross Fishman) (71 TTABVUE 130).

Applicant filed a series of motions to strike portions of the Fishman testimony deposition and Amended Expert Report,¹⁰ as well arguing in its brief that Mr. Fishman's testimony and Amended Expert Report should be given little weight because they exceed the subject matter about which he is qualified to testify.¹¹

The Board is responsible for determining whether the subject of this opposition, the phrase REMEMBER THIS NAME, is capable of functioning as a service mark, and whether the specimen filed with Applicant's application shows use of REMEMBER THIS NAME as a service mark. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010); *Fisons Ltd. v. UAD Laboratories, Inc.*, 219 USPQ 661, 663 (TTAB 1983).

[A]bsent a competently designed and executed survey of a cross-section of customers and prospective customers of the products or services involved, the deciding tribunal must make its own subjective evaluation of what the average consumer will perceive the mark to be as he encounters them in the actual or hypothetical ... marketing arena.

Edwards Lifesciences Corp. v. VigiLanz Corp., 94 USPQ2d at 1402 (quoting *The Mennen Co. v. Yamanouchi Pharm. Co., Ltd.*, 203 USPQ 302, 305 (TTAB 1979)); see also *Anheuser-Busch Inc. v. Holt*, 92 USPQ2d 1101, 1106 (TTAB 2009); *Ferro Corp. v. Nicofibers, Inc.*, 196 USPQ 41, 45 (TTAB 1977) ("understanding of the marks must be determined in light of the relevant purchasing sector and not that of linguistic experts or those familiar with the meaning or derivation of words").

¹⁰ 62 TTABVUE, 67 TTABVUE, and 85 TTABVUE.

¹¹ Applicant's Brief, p. 28 (96 TTABVUE 33).

In a similar situation, a witness was qualified as an expert in the field of travel writing and journalism based on her professional experience as a travel writer and editor and, therefore, was “qualified as an expert as to how to convey travel information to readers and potential tourists, and how travel writers believe such information will be perceived and understood.” However, the witness was not qualified to render an opinion regarding consumer perception. The Board expressly stated that the opinion of the purported expert witness may not “serve as a substitute for the Board’s judgment on the legal claim before us.” *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013), *aff’d mem.*, 565 F.App’x 900 (Fed. Cir. 2014).

Because Mr. Fishman is qualified as an expert in legal marketing, he is qualified to testify as to how to convey legal marketing information to consumers and how practitioners in the field of legal marketing believe such information will be perceived. Mr. Fishman, however, is not qualified to testify regarding consumer perception. Accordingly, we have treated his testimony as an expert as explained above and have accorded his testimony the appropriate probative value.

Likewise, we limit the testimony of Harlan Schillinger, Applicant’s expert witness on legal marketing, to how to convey legal marketing information to consumers and how legal marketing practitioners believe such information will be perceived.¹²

¹² 79 TTABVUE.

C. Evidence improperly submitted through notices of reliance.

The types of evidence admissible by notice of reliance are identified in Trademark Rules 2.122(d)(2) (registration owned by a party to a proceeding), 2.122(e)(1) (printed publications and official records), 2.122(e)(2) (Internet materials) and 2.120(k) (discovery depositions, initial disclosures, and answers to interrogatories and requests for admission). *See* Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g).

We may not consider the document entitled “Case Study: Lundy Law” by Expert Technology Associates (63 TTABVUE 60) analyzing Applicant’s advertising. There is no evidence or testimony that the case study appears in books or periodicals available to the general public in libraries or in general circulation among the relevant public as required by Trademark Rule 2.122(e)(1). Accordingly, it is not the type of document that may be introduced through a notice of reliance.

We may not consider the video and audio excerpts from *Health Alert* advertising introduced by Opposer purporting to feature video and audio of third-party use of REMEMBER THIS NAME (63 TTABVUE 88) nor may we consider the recording introduced by Applicant purporting to feature the use of REMEMBER THIS NAME (74 TTABVUE 699), as neither is the type of evidence that may be filed through a notice of reliance. There is no provision in the rules for the introduction of audio and video tapes through a notice of reliance.

Finally, we may not consider the email communications from Tami Sortman, Applicant’s Creative Director, regarding advertising for REMEMBER THIS NAME

because email communications are not evidence that may be introduced through a notice of reliance.¹³

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.¹⁴ The record also includes the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Notice of reliance on the following items:
 - a. Applicant's responses to Opposer's first set of interrogatories;¹⁵
 - b. Applicant's responses to Opposer's first set of requests for admission;¹⁶
 - c. Applicant's responses to Opposer's request for production of documents;¹⁷

¹³ 64 TTABVUE 3-4 (designated confidential).

¹⁴ Accordingly, it was not necessary for Opposer to file a copy of the application in its first notice of reliance.

Also, it was not necessary for Opposer to introduce its rebuttal notice of reliance (89 TTABVUE) because Opposer previously introduced those discovery responses in its first notice of reliance discussed below (63 TTABVUE). "When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose by the Federal Rules of Evidence." Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). *See, e.g., Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) ("Once evidence is properly of record, it may be relied on by any party for any purpose.").

¹⁵ 63 TTABVUE 9-25.

¹⁶ 63 TTABVUE 26-40.

¹⁷ 63 TTABVUE 41-54. Opposer did not include any documents.

Responses to document production requests are admissible solely for the purpose of showing that that a party has stated that there are no responsive documents. *See City Nat'l Bank v. OPGI Mgt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1688, 1674 n.10 (TTAB 2013).

- d. Applicant's supplemental responses to Opposer's request for production of documents;¹⁸
 - e. Online articles purporting to advise businesses to choose memorable names;¹⁹
 - f. Excerpt from third-party websites purportedly showing use of REMEMBER THIS NAME;²⁰
 - g. Discovery deposition of Tami Sortman, Applicant's Creative Director;²¹ and
 - h. Discovery deposition of L. Leonard Lundy, Applicant's Managing Partner;²² and
2. Testimony deposition of Ross Fishman, Opposer's expert witness in the field of legal marketing;²³ and

¹⁸ 63 TTABVUE 55-59.

¹⁹ 63 TTABVUE 62-87.

²⁰ 63 TTABVUE 92-115.

²¹ 64 TTABVUE 4-72 (Confidential). Opposer filed a redacted version of the Tami Sortman discovery deposition posted at 110 TTABVUE 3-203.

Opposer unnecessarily introduced the entire discovery deposition of Tami Sortman. For example, the speaking objections at pages 41, 114, 123 and 127 (64 TTABVUE 14, 33-36) do not add anything to our understanding of the facts. The Board rules of practice and procedure provide that a party may introduce any part of a discovery deposition through a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). Yet, we would be remiss if we did not add that although Opposer believed that we should suffer through the entire deposition, Opposer did not include the exhibits about which the witness was asked to testify.

²² 64 TTABVUE 73-135 (Confidential). A copy of the Lundy deposition with the confidential designation removed was posted at 110 TTABVUE 205-267.

²³ 71 TTABVUE. Applicant filed motions to strike, *inter alia*, Fishman Testimony Deposition Exhibit 3 (62 and 67 TTABVUE). Because we do not rely on those exhibits, we need not decide Applicant's motions.

3. Rebuttal testimony declaration of Ross Fishman.²⁴

B. Applicant's testimony and evidence.

1. Notice of reliance on the following items:

a. Copies of third-party registration prosecution history files showing the registration of marks that purportedly have characteristics similar to REMEMBER THIS NAME;²⁵ and

b. Printout from *Avvo.com* purportedly profiling Ross Fishman, Opposer's expert witness in the field of legal marketing;²⁶

2. Testimony deposition of L. Leonard Lundy, Applicant's Managing Partner;²⁷

3. Testimony deposition of Tami Sortman, Applicant's Creative Director;²⁸ and

4. Testimony deposition of Harlan Schillinger, Applicant's expert witness in the field of legal marketing.²⁹

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270,

²⁴ 88 TTABVUE.

²⁵ 74 TTABVUE 8-692.

²⁶ 74 TTABVUE 693-698.

²⁷ 76 TTABVUE. The portions of the Lundy deposition designated confidential are posted on 77 TTABVUE.

²⁸ 78 TTABVUE.

²⁹ 79 TTABVUE.

111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing ... are part of [a plaintiff’s] case and must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its petition.”). To prove its standing to oppose the registration of a phrase that allegedly does not function as a mark, an opposer may show it is engaged in the manufacture or sale of the same or related goods or services as those listed in the applicant’s application; that is, that the opposer has the right to use the wording in marketing its services. *See Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (“Opposer has standing to oppose registration of Applicant’s claimed mark because it competes directly with Applicant in the general utility engine business, and thus has a reasonable basis for a belief that it would be damaged if Applicant’s claimed mark were registered.”); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1712 (TTAB 2016) (because the parties are competitors, opposer has standing to pursue a claim that the subject matter sought to be registered does not function as a mark); *Univ. Book Store v. Univ. of Wisc. Bd. of Regents*, 33 USPQ2d 1385 (TTAB 1994) (operators of stores which sell merchandise imprinted with the mark sought to be registered have standing to oppose); *cf. Apollo Med. Extrusion Techs., Inc. v. Med. ExtrusionTechs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017); *Anheuser-Busch Inv. v. Holt*, 92 USPQ2d 1101, 1103 (TTAB 2009); *Plyboo Am., Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999); *Nature’s Way v. Nature’s*

Herbs, 9 USPQ2d 2077, 2080 (TTAB 1989); *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

Opposer, in its brief, did not address standing as an element of its case.³⁰ Our review of the record yields the following evidence relevant to Opposer's standing:

- Applicant, in its Answer, admitted that (1) "Opposer has used the phrase 'REMEMBER THIS NAME' over its toll free number as one means of instructing potential clients to remember the telephone number of Opposer's business," and (2) Applicant filed suit against Opposer, charged that the use of the mark REMEMBER THIS NUMBER was an infringement of REMEMBER THIS NAME, but dismissed the suit.³¹
- Applicant's response to Opposer's Interrogatory No. 19.

State with specificity where, when and how Applicant first became aware of Opposer's use of the phrase REMEMBER THIS NAME in Opposer's advertising.

Response

... Applicant states that on January 24, 2013 an employee reported to Applicant that she saw someone else using the mark REMEMBER THIS NAME. The employee did not remember who. Applicant requested that she return to the place where she saw the advertisement and find the nature of the law firm using the mark. The employee took a picture of the advertisement located on the inside of SEPTA bus with her cell phone. The advertisement was that of Opposer. The advertisement did not use Applicant's mark

³⁰ Applicant, in its brief, did not address whether Opposer has standing. At the oral hearing, Applicant initially contested Opposer's standing but subsequently conceded that it did not contest Opposer's standing.

³¹ Applicant's Answer ¶¶ 7 and 18 (25 TTABVUE 3 and 5).

REMEMBER THIS NAME, rather, it used the mark, REMEMBER THIS NUMBER.³²

- Testimony deposition of Ross Fishman, Opposer's expert witness.

Q. Are you familiar with, um, either law firm in this particular case, Larry Pitt & Associates or Lundy Law?

A. I was not familiar with them before getting involved in this case.³³

- Ross Fishman's Amended Expert Report.

Larry Pitt & Associates, like other law firms[,] uses the phrase "Remember this number." This advertising always and only refers to the firms' number – 1-888-PITT LAW. Many personal injury firms have a phone number related to the firm's name.

* * *

Just as some law firms, besides Lundy Law, use the phrase "Remember this name," other firms use the phrase "Remember this number." See attachment B.³⁴

Attachment B includes a copy of Opposer's website advertising Opposer's worker's compensation, personal injury, social security disability, immigration and employment law legal services.³⁵

- Harlan Schillinger Rebuttal Expert Report:

Unlike the third party personal injury law firm advertisements cited by Mr. Fishman, the advertisement of Larry Pitt & Associates, the Opposer, uses the phrase "REMEMBER THIS NUMBER" which is analogous to the Lundy Law mark REMEMBER THIS NAME in that both

³² 63 TTABVUE 22.

³³ Fishman Testimony Dep., p. 26 (71 TTABVUE 27).

³⁴ Fishman Testimony Dep., Exhibit 2 (Amended Expert Report) (71 TTABVUE 135).

³⁵ 71 TTABVUE 163-166.

phrases are taglines which include words that do not suggest calling the firm.³⁶

This evidence is sufficient to establish that Opposer renders legal services in the field of personal injury law and is a competitor of Applicant and, therefore, has standing to pursue this opposition.

IV. Whether REMEMBER THIS NAME functions as a service mark?

Section 45 of the Trademark Act, 15 U.S.C. § 1127, defines a “Service mark” as “any word, name, symbol, or device, or any combination thereof—(1) used by a person ... 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.” It is well settled that not every designation that is placed or used on a product necessarily functions as a trademark for said product and not every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose. *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d at 1713; *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010). The critical inquiry in determining whether a designation functions as a mark is how the designation is perceived by the relevant public. *Id.*; *see also In re Phoseon Tech. Inc.*, 103 USPQ2d 1822, 1827 (TTAB 2012); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“the mark must be used in such a manner that it would be readily perceived as identifying the specified goods and distinguishing a single source or origin for the goods. ... The mere fact that a designation appears on the specimen of record does not make it a

³⁶ Schillinger Testimony Dep. Exhibit 51 (79 TTABVUE 44).

trademark. ... A critical element in determining whether matter sought to be registered as a trademark is the impression the matter makes on the relevant public.” (citations omitted).

Opposer argues that REMEMBER THIS NAME “is simply an instruction for the consumer to remember the name and number of” Applicant³⁷ and, as such, it is simply an ordinary slogan without any independent source identification, such as “Call Today,” “No fee unless we win,” or “Injured? We can help.”³⁸ In this regard, Opposer contends that even Applicant’s witnesses have testified that “REMEMBER THIS NAME’ only makes sense if it is used in connection and association with the 1-800-LUNDYLAW name and phone number.”³⁹

The specimen filed with the application displays REMEMBER THIS NAME on a photograph of a bus advertisement reproduced below:



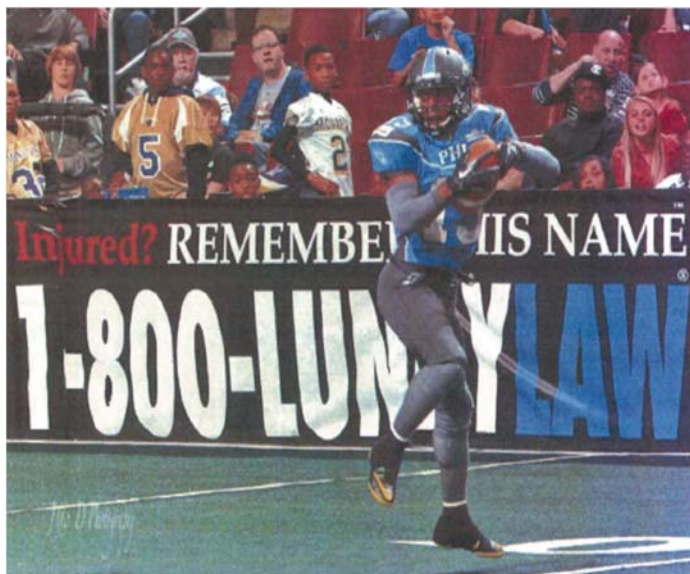
³⁷ Opposer’s Brief (92 TTABVUE 5).

³⁸ Opposer’s Brief (92 TTABVUE 21-22).

³⁹ Opposer’s Brief (92 TTABVUE 26) (citing Sortman Testimony Dep., p. 58 (78 TTABVUE 59) (the telephone number is the most important thing to remember) and Schillinger Testimony Dep., p. 13 (79 TTABVUE 14) (REMEMBER THIS NAME is used to get somebody’s attention as a reference to Applicant)).

Applicant introduced examples of advertisements displaying REMEMBER THIS NAME through the Tami Sortman Testimony Deposition. Representative examples of those advertisements are reproduced below:

- An advertisement at the Philadelphia Soul Arena Football arena:⁴⁰



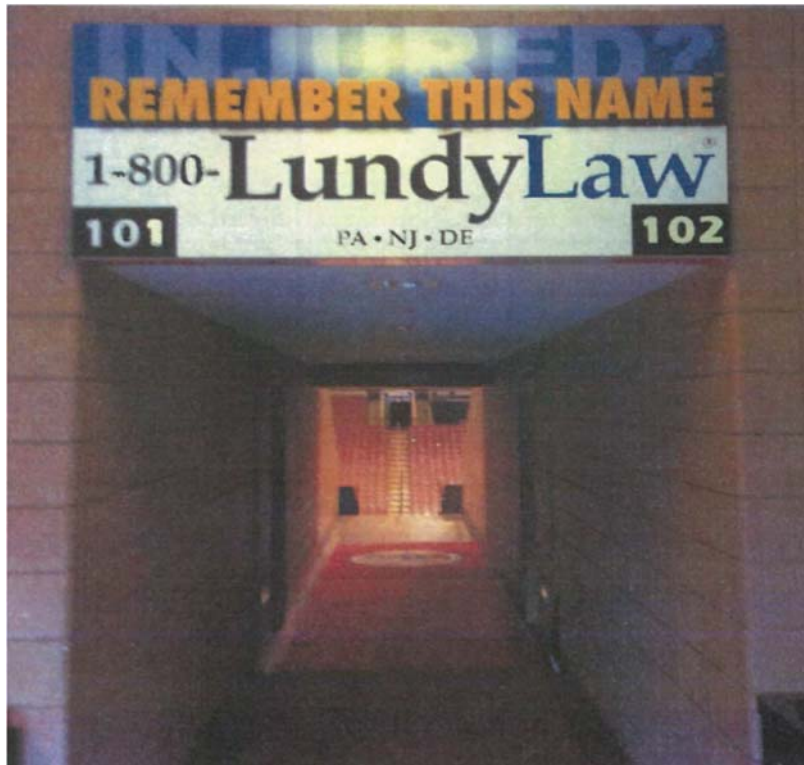
- A poster on a PATCO or SEPTA train:⁴¹



⁴⁰ Sortman Testimony Dep., p. 11 and Exhibit 16 (78 TTABVUE 12 and 94).

⁴¹ Sortman Testimony Dep., p. 14 and Exhibit 19 (78 TTABVUE 15 and 97).

- Sign over an entrance inside Wells Fargo Center arena:⁴²



Ross Fishman, Opposer’s legal marketing expert, made the following observation in his expert report:

“Remember this name” represents the *objective* of the advertisement, not the identity of the brand. The advertisement is designed to encourage people to know the brand – “Lundy Law.” The use of the phrase reflects that which Lundy Law wants to achieve, that viewers of its advertisements will remember Lundy Law.⁴³

* * *

The phrase “Remember this name” as used by Lundy Law is designed to drive potential clients to the Lundy Law name.”⁴⁴

⁴² Sortman Testimony Dep., p. 24 and Exhibit 28 (78 TTABVUE 25 and 106).

⁴³ Ross Fishman Testimony Exhibit 2 (71 TTABVUE 134).

⁴⁴ Ross Fishman Testimony Exhibit 2 (71 TTABVUE 135).

Harlan Schillinger, Applicant's legal marketing expert, observed that REMEMBER THIS NAME is a "call to action' to remember the name 'Lundy Law.'"⁴⁵

... Not only did [REMEMBER THIS NAME] create name recognition for the personal injury services of Lundy Law, it focused the potential client of the firm on who was providing the legal services.⁴⁶

Mr. Fishman stated in his expert report that REMEMBER THIS NAME is comparable to other terms used in advertisements both within and outside the legal industry to "drive the potential client to the brand name."⁴⁷ Mr. Fishman attached copies of news articles and advertisements listed below to corroborate his point:

- *Adweek (adweek.com)* (June 25, 2013) reporting on the use of "REMEMBER MY NAME" to advertise the final episodes of *Breaking Bad*;⁴⁸
- All In One Restoration website (URL illegible) using REMEMBER OUR NAME in a banner across the top of a webpage;⁴⁹
- Bryant Miller Olive law firm website (URL not included) using the tagline "Our Name Is Easy To Remember. Our Work Is Hard To Forget";⁵⁰
- The FaceBook page of PhysioWorld Ltd. using "Remember this name PhysioWorld Ltd.";⁵¹ and

⁴⁵ Harlan Schillinger Testimony Exhibit 51 (79 TTABVUE 43).

⁴⁶ Harlan Schillinger Testimony Exhibit 51 (79 TTABVUE 43).

⁴⁷ Fishman Amended Expert Report (71 TTABVUE 134).

⁴⁸ Fishman Amended Expert Report (71 TTABVUE 158-160).

⁴⁹ Fishman Amended Expert Report (71 TTABVUE 161).

⁵⁰ Fishman Amended Expert Report (71 TTABVUE 162).

⁵¹ Fishman Amended Expert Report (71 TTABVUE 232).

- *S/Magazine* excerpt (*stylemagazine.com*) entitled “Remember This Name: Achok Majak,” an article introducing a new model.⁵²

There is no question that REMEMBER THIS NAME may be considered a slogan, tagline, or a “call to action” used in Applicant’s advertising. The issue is whether REMEMBER THIS NAME as used by Applicant performs the function of a service mark by signifying to purchasers the source of the legal services being offered by Applicant. *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d at 1716; *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115 (TTAB 1982). REMEMBER THIS NAME is one feature of Applicant’s advertising comprising (i) INJURED? (ii) REMEMBER THIS NAME and (iii) 1-800-LUNDY LAW where 1-800-LUNDY LAW is the prominent element of the advertisements and REMEMBER THIS NAME is the least prominent element. “While a trademark or service mark need not be displayed in any particular size or degree of prominence, the important question is whether, when it is noticed, it will be understood as indicating the origin of the goods or services.” *In re Royal Viking Line A/S*, 216 USPQ 795, 797 (TTAB 2982) (citing *In re Singer Mfg. Co.*, 255 F.2d 939, 118 USPQ 310, 312 (CCPA 1958) (“The important question is not how readily the mark will be noticed, but whether, when it is noticed, it will be understood as indicating origin of the goods.”). As was noted by the Commissioner of Patents and Trademarks in *Ex parte National Geographic Society*, 83 USPQ 260 (Comm’r. Pat. 1949):

This [definition of trademark] contemplates use in such a manner as to fulfill that function and clearly does not

⁵² Fishman Amended Expert Report (71 TTABVUE 233).

contemplate that the public will be required or expected to browse through a group of words, or scan an entire page in order to decide that a particular word, separated from its context, may or may not be intended, or may or may not serve, to identify the product [or service] of the manufacturer or dealer.

Applicant did not introduce any direct testimony regarding how clients or potential clients perceive REMEMBER THIS NAME as used in Applicant's advertising.⁵³ Tami Sortman testified that after Applicant incorporated REMEMBER THIS NAME in its advertising, Applicant received more telephone calls.⁵⁴ However, Ms. Sortman could not explain why the advertising generated more telephone calls.⁵⁵

⁵³ Tami Sortman's and L. Leonard Lundy testified that the people they come in contact with associate REMEMBER THIS NAME with Applicant because when Tami Sortman tells people where she works and Leonard Lundy identifies himself, people say REMEMBER THIS NAME. Sortman Testimony Dep., pp. 45-47 (78 TTABVUE 46-48) and Lundy Testimony Dep., pp. 10-12 (76 TTABVUE 12-13). For example, Tami Sortman's testimony is, in essence, when she tells people that she works for Lundy Law, they say you advertise REMEMBER THIS NAME. Likewise, Mr. Lundy testified that people repeat the slogan to him. Opposer, in its brief, referred to this testimony as anecdotal, hearsay statements. Opposer's Brief, p. 22 (92 TTABVUE 26). Applicant contends that the statements of the third parties fall within the state of mind exception to the hearsay rule (Fed. R. Evid. 803(3)). Applicant's Brief, pp. 25-26 (96 TTABVUE 30-31). The statements by the third parties are not hearsay because Ms. Sortman and Mr. Lundy testified about what they experienced (*i.e.*, people said REMEMBER THIS NAME when Ms. Sortman told people where she worked and when Mr. Lundy identified himself). The testimony is admissible to prove what people say to Ms. Sortman and Mr. Lundy, not that REMEMBER THIS NAME is recognized as a service mark. *See Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1273 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010).

The testimony that an unidentified number of anonymous people recognize the phrase REMEMBER THIS NAME does not establish that clients and potential clients perceive REMEMBER THIS NAME as a service mark. *Cf. Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1402-03 (TTAB 2016) ("Daniel Ayoub's testimony that Applicant's proposed mark has become distinctive of Applicant's services also is entitled to little probative weight. This statement is merely a conclusory opinion about source recognition among relevant consumers without any probative and corroborating evidence from the consumers themselves.").

⁵⁴ Sortman Discovery Dep., pp. 55-56 (64 TTABVUE 18).

⁵⁵ Sortman Discovery Dep., p. 132-33 (64 TTABVUE 37).

Q. Do you have any metrics that would suggest that any consumer or any potential client called the call center based on any portion of your advertising copy?

* * *

A. We don't base it on that.

Q. Okay. Is your phone number on all your advertising copy?

A. Yes.⁵⁶

The impression created by Applicant's use of REMEMBER THIS NAME is an advertising message, informational slogan or a "call to action" rather than an expression to identify and distinguish Applicant's legal services. *See In re Gilbert Eiseman, P.C.*, 220 USPQ 89, 90 (TTAB 1983) ("It is established that when a designation or slogan imparts an impression of conveying advertising or promotional information rather than of distinguishing or identifying the source of goods or services, it cannot be the basis for registration."). While there is nothing inherent in an advertising message, informational slogan or a "call to action" that prevents it from being a service mark, it must be used in a manner so that it is perceived as indicating the source of the services being advertised.⁵⁷ In this case, however,

⁵⁶ *Id.*

⁵⁷ *See* 74 TTABVUE 8-692 (Applicant offered by notice of reliance third-party registration prosecution history files showing the registration of marks that purportedly have characteristics similar to REMEMBER THIS NAME such as AFTER 911, CALL 411; KEEP CALM, CALL US; HURT BY A BUS? CALL US, *etc.*). These registrations do not conclusively rebut Opposer's claim that REMEMBER THIS NAME does not function as a service mark. The Board must decide each case on its own merits. In this case, the crucial fact is how Applicant uses REMEMBER THIS NAME. Even if some of the prior registrations had characteristics similar to Applicant's use of REMEMBER THIS NAME, the USPTO's

Applicant's use of REMEMBER THIS NAME does not rise to the level of a service mark because there is nothing in the record demonstrating that the phrase REMEMBER THIS NAME creates a commercial impression separate and apart from the other material with which it appears in Applicant's advertising.

Applicant argues that Opposer has failed to meet its burden of proof because Opposer did not introduce any evidence of consumer protection.⁵⁸ However, Opposer may rely on Applicant's specimen of use, which we find fails to show REMEMBER THIS NAME used as a service mark, to establish a *prima facie* case that REMEMBER THIS NAME does not function as a service mark.⁵⁹ Because Applicant failed to introduce any evidence showing service mark use or any evidence that consumers perceive REMEMBER THIS NAME functioning as a service mark, the opposition is sustained.

Decision: The opposition is sustained and registration to Applicant is refused.

allowance of these registrations does not bind the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

⁵⁸ Applicant's Brief, pp. 27-33 (96 TTABVUE 32-38).

⁵⁹ At the oral hearing, Applicant did not contest that Opposer could rely on the specimen of record to make a *prima facie case* as to whether REMEMBER THIS NAME functions as a service mark.