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PRECEDENT OF THE TTAB

Mailed: October 26, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Jeffrey Feulner, P.A.

v.

Cordell Practice Management Group, LLC

Cancellation No. 92056202

Terry M. Sanks, Amber N. Davis and Kevin W. Wimberly of Beusse Wolter Sanks & Maire, PLLC for Jeffrey Feulner, P.A.

Benjamin Haltenhof of Sandberg Phoenix Von Gontard PC for Cordell Practice Management Group, LLC.

Before Wolfson, Adlin and Hightower, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Cordell Practice Management Group, LLC (“Respondent”) owns a Supplemental Register registration for the mark MEN’S DIVORCE, in standard characters, for “legal services” (the “Registration”).¹ In its amended petition for cancellation, Jeffrey Feulner, P.A. (“Petitioner”) alleges prior use of MEN’S DIVORCE LAW

¹ Supplemental Register Registration No. 4159345, issued June 12, 2012.

FIRM as a mark, and prior use and ownership of a pending application to register the mark shown below (with MEN'S DIVORCE LAW FIRM disclaimed)



both for “legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of divorce and family law.”² Petitioner also alleges that its application “has been initially rejected based on” Respondent’s involved Registration. As grounds for cancellation, Petitioner alleges that continued use of Respondent’s mark is likely to cause confusion with Petitioner’s marks.³ In its amended answer, Respondent admits that the parties’ marks “may be confusingly similar,” but otherwise denies the salient allegations in the amended petition for cancellation.

Procedural History and Stipulations

On August 19, 2014, the Board issued an order denying Petitioner’s motion for summary judgment on its likelihood of confusion claim. 24 TTABVue.⁴ Therein, the

² Application Serial No. 85456862, filed October 26, 2011 based on first use dates of January 1, 2009. The application includes this description of the mark: “The mark consists of the terms MEN'S DIVORCE which is underlined and beneath the underline the terms LAW FIRM, to the left of the terms is a square, and inside the square there is a design of a triangle on the upper left-hand corner, and an ‘S’ design connected to a triangle on the bottom right-hand corner.”

³ Petitioner also alleged as a separate ground for cancellation that Respondent’s mark is merely descriptive, but as explained herein, that claim is not viable and has not been considered.

⁴ Citations to the record reference TTABVue, the Board’s online docketing system. Specifically, the number preceding “TTABVue” corresponds to the docket entry number, and any number(s) following “TTABVue” refer to the page number(s) of the docket entry where the cited materials appear.

Board informed the parties with respect to Petitioner's claim that Respondent's mark is merely descriptive that such claims are "unavailable against a registration on the Supplemental Register. ... Therefore this proceeding will go forward on the pleaded Section 2(d) claim only." *Id.* at 2-3.

On December 8, 2014, the parties filed a stipulation "that all documents exchanged by the parties under Rule 34 of the Federal Rules of Civil Procedure are authentic and may be made of record by either party through a Notice of Reliance alone." 30 TTABVue 2. On January 8, 2015, the parties filed a stipulation that audio files which Respondent produced during discovery would be submitted in the form of a "textual transcript," in compliance with their December 8, 2014 stipulation. 31 TTABVue 2.

The Record and Evidentiary Objections

The record consists of the pleadings, by operation of Trademark Rule 2.122(b) the file of the involved Registration, and the following:

Petitioner's testimonial deposition of Jeffrey Feulner, its president and managing attorney ("Feulner Tr."), and Exhibit A thereto. 32 TTABVue. Exhibit A to the deposition is Mr. Feulner's affidavit submitted in support of Petitioner's motion for summary judgment. Although Respondent did not object to Petitioner's submission of the affidavit at trial, Mr. Feulner reaffirmed his testimony therein and the affidavit is consistent with Mr. Feulner's testimony, we rely herein on Mr. Feulner's testimonial deposition, rather than his prior affidavit.

Petitioner's notice of reliance ("Petitioner's NOR") on: Respondent's discovery responses, including documents produced during discovery and covered by the parties' stipulations; Petitioner's discovery responses, including documents it produced during discovery, which are

covered by the parties' stipulation; information about Petitioner's pleaded application printed from the Office's TESS database; and the Feulner Affidavit which was also included with Mr. Feulner's testimonial deposition. 33 TTABVue.

Respondent did not introduce any testimony or other evidence, or object to any of the evidence Petitioner introduced.

Facts of Record

Petitioner provides family and specifically divorce law services under its trade name MEN'S DIVORCE LAW FIRM, which it uses in "all" of its advertisements and communications with clients and the public. 32 TTABVue 12-16. Petitioner first used the MEN'S DIVORCE LAW FIRM name in July 2004, and registered it as a fictitious name with the state of Florida on July 22, 2004. *Id.*; 33 TTABVue 100-01.

Petitioner's marketing efforts under the MEN'S DIVORCE LAW FIRM name have expanded every year since 2004. 32 TTABVue 16. Initially, Petitioner relied on business cards, Yellow Pages advertisements and "pay-per-click" campaigns, but later expanded to billboards, television and radio commercials and print, movie theater and Facebook advertising, all promoting the MEN'S DIVORCE LAW FIRM trade name. 32 TTABVue 17-21; 33 TTABVue 255-93. Petitioner's television ads appeared during the 2010 Winter Olympics. *Id.* at 37; 33 TTABVue 444-45. Petitioner's billboard advertisements were placed "throughout Central Florida," including Interstates 4 (which passes by Disney World, Busch Gardens, Sea World and Universal Studios) and 75 and the road leading to Orlando's international airport. Petitioner also placed wall ads in the Orlando Arena, which hosted NBA

basketball as well as professional lacrosse and arena football games. 32 TTABVue 21-23, 26. Petitioner always displays its MEN'S DIVORCE LAW FIRM name in all capital letters and uses it "as a brand." *Id.* at 30-31. Petitioner's annual advertising expenses have increased over time from approximately \$2,500 in 2004 to approximately \$140,000 in 2012, and Petitioner has spent a total of over \$1 million on advertising since 2004, virtually all of it including "some use or form of the 'MEN'S DIVORCE LAW FIRM'" name. *Id.* at 40-41; 33 TTABVue 624-31. The following are representative of Petitioner's promotional efforts:



MANAGING ATTORNEY
JEFFREY FEULNER

Mr. Feulner graduated from Rollins College with a Bachelors Degree in Organizational Behavior and received his Juris Doctorate Degree from the Florida State University College of Law.

Mr. Feulner is the sole shareholder of the Men's Divorce Law Firm. Prior to founding the Men's Divorce Law Firm he was associated for six years with an AV rated law firm, practicing in the areas of marital & family law and labor & employment law. During law school he served as a judicial intern at the First District Court of Appeal for the Honorable Judge Stephan Mickle, who is now a federal court judge, and Mr. Feulner clerked for the Tallahassee law firm of Marie Mattox, P.A.

Mr. Feulner handles all aspects of marital & family law and aggressively pursues cases involving the establishment of paternity and fathers' rights. Standing at 6'8", Attorney Feulner brings a commanding presence into the courtroom. He is a member of the Marital & Family Law Sections of the Florida Bar, the Orange County Bar Association, and the Seminole County Bar Association. Mr. Feulner is admitted to practice in the state courts of Florida, the United States District Courts for the Middle and Southern Districts of Florida and the Eleventh Circuit United States Court of Appeals.

Mr. Feulner has been a committee chair for the Young Lawyer's Division of the Orange County Bar Association and has also served on the Board of Directors of the Downtown Orlando YMCA and on the Transportation Advisory Board for the City of Maitland. A strong supporter of local athletic programs, Mr. Feulner has held the position of legal counsel for the Florida Region of the United States Volleyball Association.

Fathers, Families, Fairness.™

MEN'S DIVORCE
LAW FIRM

Attorney Feulner and His Son.

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33 TTABVue 93, 238.

Mr. Feulner has been interviewed on Fox News. 32 TTABVue 33; 33 TTABVue 192-93. The Orlando Sentinel named Petitioner one of the Top 100 Companies for Working Families in 2009, 2011 and 2013, listing it not as “Jeffrey Feulner, P.A.” but instead as “Men’s Divorce Law Firm,” and in 2013 Orlando Business Journal named Petitioner one of Orlando’s “Best Places to Work.” 33 TTABVue 153-57, 195-96, 208-39; 32 TTABVue 35-36. The following is a portion of an Orlando Sentinel article featuring Petitioner dated November 24, 2013:

Do divorce-law firms for men level playing field — or spur gender war?

BY JIM STRATTON | Staff Writer



Feulner: Focused law firm on men after a paternity dispute, divorce.

The name of Jeffrey Feulner's legal practice, displayed on billboards throughout Central Florida, leaves little room for doubt: "Men's Divorce Law Firm."

Feulner and his three colleagues — all women — specialize in family-law cases and market themselves exclusively to men. In a rare instance they'll work for a woman, but the firm is built on the XY chromosome.

"That's our focus," said Feulner, who launched the practice in 2004.

The specialty remains uncommon. Orlando has at least two such firms, with more scattered throughout the state. Practitioners say they bring

Please turn to **MEN, A18**

33 TTABVue 148.

Like Petitioner, Respondent provides legal services, specifically related to family and domestic law, and more specifically focused on serving male clients in divorce-related matters. 33 TTABVue 43-78; 33 TTABVue 649 (Respondent's response to Petitioner's Request for Admission No. 9). In 2004, Respondent, operating under the trade name CORDELL & CORDELL, sponsored "The Complete Men's Divorce Workshop," addressing child custody and support, and financial concerns in divorce. 33 TTABVue 43-78. Respondent eventually began doing business in Tampa, and later opened a "satellite office" not only in Orlando, but in the "same neighborhood" as Petitioner. 32 TTABVue 42; *see also* Amended Answer ¶ 18 (admitting allegation that Respondent "opened an office in the exact same location (Baldwin Park) as petitioner").

Standing

Petitioner has used the trade name MEN'S DIVORCE LAW FIRM in connection with legal services since 2004. 32 TTABVue 12-23, 26, 30-31, 33, 40-41; TTABVue

100-01, 255-93, 444-45, 624-31. This establishes Petitioner's standing. *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor has standing to challenge registration); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011) (same); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).

Likelihood of Confusion

This case is essentially a dispute over priority. In fact, there is no doubt that the parties' marks are confusingly similar.

Respondent has repeatedly admitted as much. Amended Answer ¶¶ 15, 16 (admitting that the parties' services are "identical or nearly identical ... such that they would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of consumers" and that the marks "may be confusingly similar"); 33 TTABVue 648-49 (Respondent's responses to Petitioner's Request for Admission Nos. 1-9, admitting, *inter alia*, that "a likelihood of confusion exists between Registrant's mark and petitioner's mark"). We therefore turn to the question of priority.

Priority/Proprietary Rights

Respondent alleges that it used “men’s divorce” prior to Petitioner, based on offering “The Complete Men’s Divorce Workshop” in 2004. We disagree. Respondent’s use of the term “men’s divorce” in that context was obviously not to indicate the source of the workshop, which was the CORDELL & CORDELL, P.C. law firm, but instead to describe the workshop’s subject matter, men’s divorce. In fact, as stated in radio advertisements for the workshop:

If you’re a man facing divorce, attend “The Complete Men’s Divorce Workshop.” Hosting the workshop is attorney Joe Cordell, author of *Civil War: A Dad’s Guide to Custody* and founder of the domestic litigation law firm Cordell & Cordell ... Come see for yourself how Cordell & Cordell has earned its reputation for vigorously and successfully defending the rights of men. “The Complete Men’s Divorce Workshop” *sponsored by Cordell & Cordell*, a partner men can count on

33 TTABVue 78 (emphasis added). Similarly, the specimen Respondent submitted in support of registration, which appears to be a website printout, bears the heading “Men’s Divorce” at the top, but underneath that heading states “Providing divorce tips for men in the most trying period of their lives.” The site appears to be informational only, and contains no indication that legal services are provided by an entity named “Men’s Divorce.” In short, the record in this case contains no evidence that Respondent ever used “men’s divorce” to indicate source, and the evidence of Respondent’s use which Petitioner introduced reveals use of “men’s divorce” only in the context of describing a workshop’s and website’s subject matter.

As for Petitioner's use of the term, this case is somewhat unusual in that Petitioner seeks to cancel a term on the Supplemental Register, based on its alleged prior use of the registered term in its trade name and alleged service mark.⁵ The nature of the term at issue dictates the scope of our analysis.

Specifically, the term at issue is at best merely descriptive. Indeed, "a registrant owner of a Supplemental Register registration," in this case Respondent, "impliedly admits that the registered term was descriptive ... at least at the time of the registrant's first use of the term." *Perma Ceram Enterprises Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) ("registration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance"). Moreover, in this case, Respondent conceded during discovery and in its Trial Brief that the registered term "men's divorce" was not only descriptive at the time of registration, but that it remains at least descriptive, and may in fact be generic. 33 TTABVue 651 (Respondent's responses to Petitioner's Request for Admission Nos. 16 and 17, admitting that "men's divorce" describes "a feature, target consumer, subject matter, use, and/or nature of Registrant's legal goods and/or services for Men's divorces"); 39 TTABVue 7, 9 (Respondent's Trial Brief at 6 and 8, stating that "Registrant had not acquired distinctiveness in the admittedly generic descriptive mark 'Men's Divorce'" and "both Registrant's mark and Petitioner's proposed mark

⁵ In its Trial Brief, Respondent "does not deny that Petitioner has used 'Men's Divorce Law Firm' as its trade name since July of 2004." 39 TTABVue 8.

are as descriptive as can exist”). For its part, Petitioner has also conceded that “men’s divorce” is at best merely descriptive, as its pending application includes a disclaimer of “men’s divorce law firm.” *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008). Petitioner’s assertion in its Trial Brief that its alleged word mark MEN’S DIVORCE LAW FIRM has acquired distinctiveness, 38 TTABVue 20-25, is also an admission that the alleged mark is merely descriptive. *Bass Pro Trademarks*, 89 USPQ2d at 1851.

In *Books on Tape*, our primary reviewing court considered the relatively rare circumstance presented here, i.e. the owner of a merely descriptive term seeks to cancel a Supplemental Register registration for the same term. In that case, the prior user of BOOKS ON TAPE for the sale of cassette tapes sought to cancel a Supplemental Register registration for the mark BOOKTAPES for prerecorded audio tapes for instructional purposes, alleging likelihood of confusion. The Federal Circuit first reversed the Board’s finding that the petitioner lacked standing because its alleged mark was held to be generic.⁶ It then limited the holding of *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981), that a plaintiff “must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion” to proceedings challenging registration on the Principal Register:

⁶ In this case, neither party has alleged that the other’s alleged mark is generic, and the issue was neither pled nor tried by implied consent. It is beyond the scope of this proceeding for us to consider whether “men’s divorce” is generic.

... the ruling on the merits in *Otto Roth*, in any event, is not controlling here. The *Otto Roth* opposer sought to prevent the applicant's registration of an arbitrary mark on the *Principal* Register on the basis of prior use of a *descriptive* phrase. One who had proprietary rights in a mark was being attacked by a party who had established no rights in a mark on the ground that the applicant's use would be attributable to opposer. In contrast, this case concerns a registration for a *descriptive* term on the *Supplemental* Register. The registrant here has as yet no proprietary rights in a mark The statute does not require the anomalous result that a junior user is entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a *prior* user cannot show secondary meaning in that term either.

Books on Tape, 5 USPQ2d at 1302.

Similarly, in this case it would be an "anomalous result" if Respondent was permitted to keep its Supplemental Register registration for an at best highly descriptive, if not generic term, in the face of Petitioner's prior use. As in *Books on Tape*, Petitioner in this case need not establish secondary meaning in the term "men's divorce."⁷ Accordingly, the petition to cancel is granted.

Even if *Books on Tape* were found inapplicable to this proceeding, and Petitioner was required to establish proprietary rights in its proposed word mark, we would reach the same ultimate result. To the extent that the term "men's divorce"

⁷ We recognize that *Books on Tape* has been distinguished, perhaps most notably in *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990), which referred to the passage quoted above as "dicta." However, *Books on Tape* was not and could not have been overruled by the *Towers* panel because *Towers* was not an *en banc* decision, the situation in this case is on all fours with that in *Books on Tape* (but not *Towers*, in which, as in *Otto Roth*, the plaintiff asserted use of a descriptive term against a registration on the Principal Register) and it is not just the "dicta" but the ultimate result in *Books on Tape* which compels a similar result here.

(including “men’s divorce law firm”) is capable of identifying source, it has acquired distinctiveness as a source-indicator for Petitioner at least in Central Florida based on Petitioner’s extensive, expanding use of the term for more than a decade, in newspapers, on television, radio, and prominent billboards and sports arenas, its unsolicited media attention and awards and its significant advertising expenditures. By contrast, there is no evidence that Respondent ever used “men’s divorce” to identify source, much less that the term has a secondary meaning as identifying Respondent anywhere. Moreover, Respondent now operates and uses its alleged mark in the exact same geographic area, in fact in the “same neighborhood” as Petitioner, where Petitioner has shown secondary meaning. Accordingly, even if *Otto Roth* rather than *Books on Tape* applies, and assuming Petitioner’s trade name and alleged service mark is not generic, Petitioner has established “priority of acquired distinctiveness.” *Perma Ceram*, 23 USPQ2d at 1138.

Decision: The petition to cancel is granted and the Registration will be cancelled in due course.