

Hearing:
June 14, 2005

This Opinion is
Citable as Precedent
of the TTAB

Mailed:
December 16, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Reed Elsevier Properties Inc.

Serial No. 75530795

Katherine M. DuBray, Tara M. Vold, and J. Paul Williamson
of Fulbright & Jaworski L.L.P. for Reed Elsevier
Properties, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Grendel, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Reed Elsevier Properties Inc. [applicant] initially
applied to register LAWYERS.COM, in standard character
form, as a mark for services identified as "providing
access to an online interactive database featuring
information exchange in the fields of law, lawyers, legal
news and legal services," in Class 42. The application
sought registration on the Principal Register and was based

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on applicant's claim of use of the designation in commerce, with July 30, 1998 asserted as the date of first use and first use in commerce.

Examination History/Evidence

The examining attorney refused registration, asserting that the designation is merely descriptive for the identified services, because it signifies only that applicant provides information about lawyers via the Internet.¹ See Lanham Act Section 2(e)(1), § 15 U.S.C. 1052(e)(1). In addition, the examining attorney provided applicant with information about a prior-filed application which, the examining attorney reported, might present a bar to registration of LAWYERS.COM if the prior-filed application resulted in issuance of a registration. In a subsequent action, however, the examining attorney stated that no such refusal would be issued.

In response to the initial refusal under Section 2(e)(1), applicant refused to concede that either LAWYERS or .COM is descriptive of its services and further argued that the combination LAWYERS.COM, "considered as a whole ... does not immediately convey an idea of the ingredients,

¹ As an alternative basis for refusal under Section 2(e)(1), the examining attorney stated that the designation might be deceptively misdescriptive. That refusal, however, was subsequently withdrawn and is not a subject of this appeal.

qualities and characteristics of these identified services." Applicant explained that information "about lawyers is not necessarily the whole or even the primary emphasis of Applicant's service," and that the composite designation "is vague, at best, in terms of conveying any specific information."

Notwithstanding applicant's argument, the examining attorney made the refusal under Section 2(e)(1) final. Applicant then amended its application to seek registration on the Principal Register under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), but specifically stated that it was not waiving its right to argue the Section 2(e)(1) refusal on appeal. The examining attorney maintained the refusal under Section 2(e)(1) and rejected applicant's evidence of acquired distinctiveness as insufficient, but offered to consider any further evidence of distinctiveness applicant might later submit.²

Applicant then submitted a declaration from Carol Cooper, the Publisher and Senior Vice President of Martindale-Hubbell, a division of Reed Elsevier Inc., which is licensed to use LAWYERS.COM by applicant. This

² Applicant had submitted the declaration of its president and results of certain searches of the Internet by its counsel. The examining attorney suggested applicant submit information about the type of and expenditures for advertising, samples of

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declaration provides specific figures regarding advertising and sales, among other statements, and reports that "Nielsen has conducted an independent survey chronicling the consumer use of the mark." The declarant asserted that relevant portions of the survey were attached to the declaration, but they do not appear in the record.

Without mentioning the apparently missing survey evidence, the examining attorney issued another office action maintaining the refusal of registration under Section 2(e)(1). The examining attorney asserted that LAWYERS.COM is generic for the identified services and that applicant's evidence of acquired distinctiveness was therefore insufficient to overcome the refusal.

Applicant then amended the application to seek registration on the Supplemental Register. Applicant also amended the description of services to delete the word "lawyers," so that the resulting identification was "providing access to an online interactive database featuring information exchange in the fields of law, legal news, and legal services." (In a subsequent examiner's amendment, the words "access to" also were deleted from the identification.) Applicant explained that its amendment of

advertising, the level of sales of applicant's services, and consumer or other statements of recognition.

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the application to seek registration on the Supplemental Register was made "[w]ithout waiving its right to argue" on appeal against the examining attorney's refusal that LAWYERS.COM is descriptive.

The examining attorney refused registration on the Supplemental Register, referencing arguments and evidence from the previous office action. In addition, the examining attorney asserted that applicant's deletion of the word "lawyers" from its identification of services was a "transparent effort" to avoid Board precedent supporting the refusal and that it was clear from reference to applicant's specimens of use (reprints of numerous web pages accessible through the LAWYERS.COM web site) "that providing information about lawyers is one of the primary purposes of the website."

Applicant responded by arguing that while a term may be descriptive or generic for certain services, that does not preclude its registration for other goods or services. Also, applicant asserted that deletion of the term "lawyers" from its identification was not, as the examining attorney had contended, disingenuous, and applicant explained that it "never argued that its services didn't extend to providing information about lawyers, only that the services now covered by the application don't cover

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