

# TTAB

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Ser. No. 76/636,336  
SETTLE MY CLAIM

## BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: David M. Chester )	Date: February 1, 2006
)	)
Serial No.: 76/636,336 )	Trademark Law Office: 108
)	)
Filed: 04/13/05 )	Examiner: Sue Carruthers
)	)
Title: SETTLE MY CLAIM )	)
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Commissioner for Trademarks  
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Dear Sir:

### APPELLANT'S APPEAL BRIEF UNDER 37 CFR 1.192

In an action dated January 19, 2006, the present application was finally refused registration



on the principal register under the Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), because the subject matter for which registration is being sought was determined to be merely descriptive of the identified services.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); In re MetPath Inc., 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The examiner relies upon the conclusion that the mark, SETTLE MY CLAIM, clearly indicates that the services pertain to legal cases. However, this is not the same as “merely descriptive”.

In the present case, a *proper* rejection for being merely descriptive would exist if the requested mark were LEGAL SERVICES or ATTORNEY or PERSONAL INJURY ATTORNEY; however, such are not the case.

The determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the market place. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Again, the present mark is being used for LEGAL SERVICES; absent the context that the applicant is providing, the words SETTLE MY CLAIM can have numerous, contradictory or ambiguous meaning.

Additionally, there currently exists third-party registrations that are arguably just as indicative as pertaining to legal cases as the present application. Currently registered are FASTSETTLE (Reg. No. 2404297, principal register), WHY SETTLE FOR LESS? (Reg. No. 2851024), SETTLEMENT ON LINE (Reg. No. 2523663). Although the existence of FASTSETTLE on the principal register is not conclusive on the question of descriptiveness, it is an indication that such is not the case in the present instance.

Further, combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive or evokes a unique commercial impression. See In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); In re TBG Inc., 229 USPQ 759 (TTAB 1986) (SHOWROOM

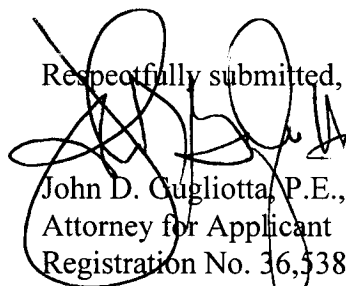
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ONLINE held not merely descriptive of computerized interior furnishings product information service); In re Shutts, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). Currently, commercial searchers on the world wide web will find the applicant's services unique if looking for www.settlemycase.net. The issue is whether the mark considered in its entirety possesses a merely descriptive significance as applied to the goods in question, i.e., whether it conveys a readily understood meaning to the average purchaser of such goods. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979)

The fact that a term may have meanings must be considered as evidence that in this particular application, the present term is not merely descriptive in relation to the goods or services for which registration is sought. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979), and cases cited therein.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,



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