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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/636336

APPLICANT: Chester, David M.

CORRESPONDENT ADDRESS:
JOHN D. GUGLIOTTA
PATENT, COPYRIGHT & TRADEMARK LAW GROUP
137 S MAIN ST, STE 202
AKRON, OH 44308

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: SETTLE MY CLAIM

CORRESPONDENT'S REFERENCE/DOCKET NO: 1591A

CORRESPONDENT EMAIL ADDRESS:

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3. Examining Attorney's name and Law Office number.
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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant has appealed the examining attorney's final refusal to register "SETTLE MY CLAIM" for services in Classes 35 and 42, on the ground that it is merely descriptive of the services within the meaning of Trademark Act §2(e)(1).

Upon further review, the refusal to register on the ground of mere descriptiveness with respect to the Class 35 services only is withdrawn. This brief pertains to the Class 42 services only.

FACTS

Applicant initially applied to register "SETTLE MY CLAIM" for "attorney services, legal services, negotiation of out-of-court settlements, and direct-response and on-line advertising in the fields of attorney services, legal services and negotiation of out-of-court settlements."

In the first office action, the examining attorney refused registration on the Principal Register under Trademark Act §2(e)(1), on the ground that the proposed mark merely describes the services applicant will provide to his clients. As evidence thereof, she attached pages from several websites which advertise attorney services, all of which include the wording "settle my claim" to identify one of the services the attorney offers to his or her clients.

She advised applicant that the identification of services included services in both Class 35 (direct-response and on-line advertising) and Class 42 (attorney services, legal services and negotiation of out-of-court settlements). She also informed applicant that direct-response and on-line advertising may not be registrable as a service if applicant will merely advertise his own services rather than advertise on behalf of others.

In response, applicant paid an additional filing fee and amended the identification to read: "direct response and on-line advertising in the fields of attorney services, legal services,

and negotiating out-of-court settlements" in Class 35, and "legal services and attorney services, including litigating in-court settlements and negotiating out-of-court settlements" in Class 42. He did not comment on the examining attorney's advisory regarding the registrability of advertising services. His primary argument against the mere descriptiveness refusal was that the proposed mark could have numerous meanings.

In her final refusal, the examining attorney attached pages from four additional websites obtained through the Google search engine, all of which advertised law firms and prominently featured the phrase "settle my claim." She reiterated her finding that the proposed mark identifies a service provided by the applicant.

ARGUMENT

THE PHRASE "SETTLE MY CLAIM" IS MERELY DESCRIPTIVE, UNDER TRADEMARK ACT §2(e)(1), OF LEGAL SERVICES.

A mark is merely descriptive under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

"SETTLE MY CLAIM" merely describes one of the services (negotiating out-of-court settlements of legal disputes[1]) which applicant's law firm will provide.

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that "Doc" in "DOC-CONTROL" would be understood to refer to the "documents" managed by applicant's software, not "doctor," as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) ("CONCURRENT PC-DOS" found merely descriptive of "computer programs recorded on disk"; it is unnecessary that programs actually run "concurrently," as long as relevant trade clearly uses the denomination "concurrent" as a descriptor of this particular type of operating system); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) ("Whether consumers could guess what the product is from consideration of the mark alone is not the test"); TMEP §1209.01(b).

Applicant suggests that a descriptiveness refusal would be proper only if the proposed mark were "LEGAL SERVICES" or "ATTORNEY" or "PERSONAL INJURY ATTORNEY." However, it is not necessary for the mark to tell what the goods or services are. In *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977), the Board held "Burger" descriptive of an electric cooking utensil, because the word

[1] The examining attorney asks that the Board accept and take judicial notice of the attached definition of the word "settle" for purposes of this appeal. TBMP §1208.04.

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