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Subject: U.S. TRADEMARK APPLICATION NO. 77821445 - FOR THE INJURED -
2955U.000002 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77821445

MARK: FOR THE INJURED



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Gordon & Doner, P.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

2955U.000002

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's refusal to register the word mark FOR THE INJURED, the evidence submitted under Section 2(f) of the Trademark Act not establishing acquired distinctiveness of the term as a mark registrable on the Principal Register. 15 U.S.C. section 1052(f).

FACTS

On September 11, 2009 the applicant filed an application to register the term FOR THE INJURED in Standard word format, for legal services. Registration was refused under the provisions of Section 2(e)(1), on grounds that the term merely described the group to whom the services were directed—injured parties. The applicant responded on June 21, 2010, asserting a claim of distinctiveness based on length of use of the mark in commerce, under the provisions of 37 C.F.R. 2.41(b), and a declaration stating annual advertising expenditures by the applicant in promoting the term as a mark, under the

provisions of 37 C.F.R. section 2.41(a). The Examining Attorney rejected such a claim, based on the nature of the term. On February 4, 2011, the applicant made a further claim of acquired distinctiveness under Section 2(f), based on affidavits, stating that the term was recognized as a mark for the applicant. Again, the evidence was rejected, and a Final refusal was issued.

The Examining Attorney issued a subsequent Final refusal on March 12, 2011, introducing further evidence of common use of the term FOR THE INJURED by other parties in the legal profession.

On September 29, 2011, the applicant appealed the Final refusal, and filed a Request for Reconsideration, which was granted by the Trademark Trial and Appeal Board.

Jurisdiction was restored to the Examining Attorney. The Request for Reconsideration was denied, and the application was returned to the Trademark Trial and Appeal Board for resumption of the appeal.

ARGUMENTS

I. PROPOSED MARK IS HIGHLY DESCRIPTIVE FOR IDENTIFIED SERVICES

Registration of the term FOR THE INJURED is refused under the provisions of Section 2(e) (1) of the Trademark Act, on grounds that this term is commonly used descriptively in the legal profession.

Research shows that third parties in applicant's field use the same or substantially the same wording in a descriptive or informational manner, indicating that the mark is at

least highly descriptive. TMEP section 1212.01. Use of the term FOR THE INJURED in association with legal services is not unique to the applicant but rather, is frequently used by many third party legal practitioners to identify the type of clientele to whom the services are offered—injured parties, usually in accident or negligence cases. The Examining Attorney has produced over 10 Internet websites of legal firms around the United States, including the state of Florida, where the applicant is located, which use the term “ for the injured” in a descriptive or informational manner:

WELCOME TO ARNDT LAW—LEGAL SERVICES FOR THE INJURED
(Office Action of 4/12/11, p.2)

THE MULLIGAN LAW FIRM—NATIONALWIDE HELP FOR THE
INJURED AND
THEIR FAMILIES Office Action of 4/12/11, p.4)

ABOUT STEIGERWALT & ASSOCIATES We are here to Provide
Nationwide Legal
Assistance for the Injured and Their Families Throughout the Country (Office
Action of
4/12/11, p.8)

THE NATION LAW FIRM—Legal Help for the Injured (Office Action of
4/12/11,pp
10-11)

McCARDELL & ASSOCIATES Vancouver Personal Injury Law-Legal
Services for the
Injured (Office Action of 4/12/11, p.18)

WARREN McGRAW Fighting for the Injured & Disabled (Office Action of
4/12/11,
p.16)

JOSEPH SMITH, LTD. Attorneys for the Injured (Office Action of
4/12/11,p.17)

LEGAL CENTER FOR THE INJURED (Office Action of 4/12/11, p.19)

J. STANFORD MORSE, P.A. We Speak for the Injured. (Office Action of 4/12/11, p.22)

THE FRICKEY LAW FIRM Comprehensive Legal Services for the Injured (Office Action of 4/12/11, p.25)

ATTORNEYS FOR THE INJURED Seeking Justice for the Injured (Office Action Of 4/12/11, p.26)

While the applicant asserts that such third party use of the term FOR THE INJURED is informational in nature, unlike the applicant's use of the term in relation to its promotion of legal services, an examination of the applicant's specimen of record shows little, if any, distinction in display of the phrase FOR THE INJURED from that of the third party law firms listed above.

Finally, the applicant has made of record several third party registrations containing the term FOR THE INJURED as part of the mark:

ANSWERS FOR THE INJURED (Reg. No. 2,865,998)

JUSTICE FOR THE INJURED (Reg. No. 2,779,624)

TRAINED BY INSURANCE COMPANIES, FIGHTING FOR THE INJURED (Reg. No. 3,863,850)

While the applicant introduced this material to demonstrate that descriptive marks containing the term FOR THE INJURED are registrable, the Examining Attorney asserts that such documents, in which the term FOR THE INJURED appears in registered marks owned by different parties, clearly shows that such terminology is commonly used in the legal field, and has little, if any significant source origin impact in the field. All parties have registered different marks containing this term, FOR THE INJURED, with little

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