

This Opinion is not a
Precedent of the TTAB

Mailed: August 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Marotta
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Serial No. 86087067
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Megan Jeanne of The Corporate Law Group for Paul D. Marotta.

Jonathan R. Falk, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

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Before Taylor, Shaw and Masiello,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Paul D. Marotta, an individual doing business as The Corporate Law Group (“Applicant”), seeks registration on the Principal Register of the mark THE CORPORATE LAW GROUP in standard characters for:

Legal services; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration; Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of business, securities, venture capital, corporate governance, and finance; Legal services, namely, providing customized information,

counseling, advice and litigation services in all areas of employment and labor law for both employees and employers; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of international law; Legal services, namely, trademark maintenance services, in International Class 45.¹

Registration has been refused on the grounds that the mark is generic under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).² In the event the mark is not generic, registration also has been refused on the ground that the mark is merely descriptive and Applicant has not demonstrated that it has acquired distinctiveness under Section 2(f). Applicant appealed and the case is fully briefed. We affirm the refusals to register.

I. Genericness Refusal

Whether a particular term is generic, and therefore cannot be a trademark or service mark, is a question of fact. *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009). When a proposed mark is refused registration as generic, the Examining Attorney has the burden of proving genericness by “clear evidence” thereof. *Id.*; *See also In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

¹ Application Serial No. 86087067, filed on October 9, 2013 under Section 1(a) of the Trademark Act, alleging a date of first use of the mark in commerce and anywhere of August 1, 1991.

² The Examining Attorney also issued a requirement for Applicant to claim ownership of Registration No. 2750351 for the mark THE CORPORATE LAW GROUP and design which registered under Section 2(f). The requirement became moot when the mark was cancelled on March 14, 2014 for failure to file a Section 8 affidavit.

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?” *Id.* Evidence of the public’s understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *See Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Additionally, “[a]n inquiry into the public’s understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005).

A. The Genus of Applicant’s Services.

We first determine the proper genus of the services at issue. We agree with Applicant that the genus is adequately defined by the wording “legal services.”³ *See Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)

³ Applicant’s Br., p. 8; 4 TTABVUE 9.

("[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration.").

The Examining Attorney argues that the genus should be defined more narrowly as "corporate legal services."⁴ This is an unnecessarily narrow genus. It is well settled that a mark may be refused registration if it is generic for any of the services encompassed within the genus. *In re Reed Elsevier Props., Inc.*, 77 USPQ2d 1649, 1654 (TTAB 2005) ("[T]he question of registrability must be determined by considering any goods or services falling within the literal scope of an identification."); *See In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010) (holding the genus "lighting fixtures" to encompass electric candles). Thus, the fact that Applicant has identified its services broadly as "legal services" will not permit registration if THE CORPORATE LAW GROUP is generic for any services encompassed by this broad terminology, including more-narrowly defined services such as "corporate legal services." *See In re Allen Elec. and Equip. Co.*, 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972) (holding SCANNER merely descriptive of goods broadly identified as "antennas" which encompassed narrower term, "scanning antennas").

B. Primary Significance to the Relevant Public

Next, we must determine whether the primary significance of Applicant's mark THE CORPORATE LAW GROUP is understood by the relevant public primarily to refer to "legal services." *Marvin Ginn*, 228 USPQ at 530. The "relevant public" for

⁴ Examining Attorney's Br. at 4; 6 TTABVUE 5.

services is limited to actual or potential purchasers of the services. *Magic Wand*, 19 USPQ2d at 1552-53. Here, the “relevant public” consists of all persons seeking legal services, including individuals, businesses, and even other lawyers.⁵

We now turn to the evidence of record to determine the relevant public’s understanding of THE CORPORATE LAW GROUP when used in connection with “legal services.” The Examining Attorney submitted the following excerpts from third-party law firm web sites showing their use of the phrase THE CORPORATE LAW GROUP or CORPORATE LAW GROUP to identify the provision of legal services in the field of business and corporate law:⁶

1. Walkercorporatelaw.com – The website of the “Walker **Corporate Law Group**, PLLC” which bills itself as “a boutique corporate law firm specializing in the representation of entrepreneurs and their companies.”
2. Gcorplaw.com – The website of the “Galler **Corporate Law Group**” which bills itself as “a boutique law firm based in the Washington, DC area. We deliver excellent transactional service and business-centric advice to business clients who value practical answers to their thorniest questions.”
3. Apslaw.com – The website of the law firm Adler Pollock & Sheehan. The firm’s website states that its “Business and **Corporate Law Group** offers a broad range of sophisticated business counseling and transactional services to a diverse clientele. . . .”
4. Donovanhatem.com – The website of the law firm Donovan Hatem, LLP. The website states that “Donovan Hatem LLP’s **Corporate Law Group** serves clients at all stages of the business lifecycle.” The website frequently uses the entire phrase “the corporate law group” while describing the firm’s activities:

In our representation of start-up companies, **the Corporate Law Group** frequently advises the founders of start-ups. . . . Also, during this start-up stage, **the Corporate Law Group** will often

⁵ See Applicant’s specimen submitted with the application and the declarations of nine attorney-clients submitted in support of registration with Applicant’s response of June 17, 2015, pp. 46-63.

⁶ Office Actions of January 27, 2014 and July 10, 2015. Emphasis added.

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