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Subject: U.S. TRADEMARK APPLICATION NO. 86302887 - AMERICAN BARRISTER - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86302887

MARK: AMERICAN BARRISTER



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Olejar, Robert J.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

On June 6, 2014, the applicant applied to register AMERICAN BARRISTER for the following services in Class 45:

Alternative dispute resolution services; Arbitration services; Attorney services; Expert witness services in legal matters in the field of fraud, forensic accounting, money laundering, financial accounting, and legal damages; Legal consultation services; Legal document preparation services; Legal research; Legal services; Litigation consultancy; Litigation services; Litigation support services; Mediation; News reporting and expert legal commentary services in the field of legal news; On-site legal services; Online news reporting and expert legal commentary services in the field of legal news; Providing information relating to legal affairs; Providing information, news and commentary in the field of law; Providing on-line information and news in the field of law

The Trademark Examining Attorney refused registration in an Office action issued September 19, 2014 because the proposed mark is primarily geographically descriptive of the services under 15 U.S.C. Section 1052(e)(2) and merely descriptive of the provider of the services under 15 U.S.C. Section 1052(e)(1), and provided a caveat that the applicant would be required to disclaim the generic term BARRISTER upon amendment to the Supplemental Register or submission of a claim of acquired distinctiveness. The applicant responded to these refusals on March 19, 2015. After telephone and email communications with the applicant concerning the Supplemental Register and acquired distinctiveness, the Trademark Examining Attorney issued a final refusal on April 24, 2015 on the basis of descriptiveness and geographic descriptiveness.

On October 23, 2015, the applicant requested reconsideration of the final refusal. After careful consideration of all arguments and evidence, the Trademark Examining Attorney denied reconsideration on November 9, 2015 and this appeal ensued.

ARGUMENT

1. The Proposed Mark is Geographically Descriptive of the Services

AMERICAN BARRISTER is primarily geographically descriptive of the applicant's services because it denotes the United States as the origin of the applicant's legal services.

For services to originate in a geographic place, the record must show that they are rendered at least in part in the geographic place. *See In re Chalk's Int'l Airline Inc.*, 21 USPQ2d 1637 (TTAB 1991) (holding PARADISE ISLAND AIRLINES primarily geographically descriptive of air transportation services of passengers and/or goods that are performed at least in part on Paradise Island); *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California and outside the state as well); *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (holding THE NASHVILLE NETWORK primarily geographically descriptive of television production and distribution services provided in Nashville); TMEP §1210.03.

AMERICAN is the adjectival form of the word AMERICA, and is defined as: Of or relating to the United States of America or its people, language, or culture. *See* definitions attached to

the April 24, 2015 final refusal. It is well settled that when AMERICA or AMERICAN appears in a mark such that it primarily denotes the country of the United States as the origin of the goods and/or services, then the primary significance is as a geographic location. See *In re Monograms Am., Inc.*, 51 USPQ2d 1317 (TTAB 1999); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986); *Am. Diabetes Ass'n, Inc. v. Nat'l Diabetes Ass'n*, 533 F. Supp. 16, 214 USPQ 231 (E.D. Pa. 1981), *aff'd*, 681 F.2d 804 (3d Cir. 1982); TMEP §1210.02(b)(iv).

The applicant is an attorney licensed to practice in New Jersey, which is part of AMERICA under its definition. Brief at page 10. The applicant's place of business is in New Jersey, and his legal services are rendered in New Jersey, as shown by the application and specimen. The applicant acknowledged that he "is an American-based provider of legal services." March 19, 2015 response at page 3. Therefore, there is no question that the legal services are provided in America.

The applicant argues that AMERICAN is not geographically descriptive of its services because "it identifies no location," and "is simply too broad when used within the United States." Brief at page 1. This position is specifically refuted by established case law and the evidence of record.

The record contains ample evidence that AMERICAN is a geographic indicator in marks used in similar contexts. The evidence includes numerous sample registrations from the Office's database of registered marks wherein marks with the word AMERICAN followed by the subject matter or the providers of the associated goods/services contained disclaimers of AMERICAN, or were registered on

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