

This Opinion is not a
Precedent of the TTAB

Mailed: October 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Michael Moureau Wilson
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Serial No. 87240575
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Joshua Gerben and Eric J. Perrott of Gerben Law Firm PLLC,
for Michael Moureau Wilson.

Meghan Reinhart, Trademark Examining Attorney, Law Office 108,
Steven Berk, Managing Attorney.

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Before Ritchie, Kuczma and Adlin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Michael Moureau Wilson (“Applicant”) seeks registration on the Principal Register of OUR LAWYERS ARE DOCTORS (in standard characters) for:

“Legal services,” in International Class 45.¹

The Trademark Examining Attorney refused registration of Applicant’s applied-for mark on the following grounds: (1) it is a slogan or term that does not function as

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¹ Application Serial No. 87240575 was filed on November 17, 2016, based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as January 1, 2001.

a service mark to indicate the source of Applicant's services, Trademark Act Sections 1-3 and 45, 15 U.S.C. §§ 1051-1053, 1127; (2) it merely describes a feature or characteristic of Applicant's services, Trademark Act Section 2(e)(1), 15 U.S.C. § 1052 (e)(1); and (3) Applicant's allegation of five years' use of the applied-for mark is insufficient to show acquired distinctiveness because the applied-for mark is highly descriptive.

After the Examining Attorney made the refusals final, Applicant appealed to this Board. We affirm the refusals to register.

A. Does the Applied-For Mark Function as a Mark?

We begin by considering whether Applicant's applied-for mark functions as a service mark to indicate the source of Applicant's services. Trademark Act Sections 1-3 and 45, 15 U.S.C. §§ 1051-1053, 1127. To be registrable as a service mark, the applied-for mark must identify the source of the services recited in the application and distinguish them from the services of others. "Implicit in this definition is a requirement that there be a direct association between the mark sought to be registered and the [services] specified in the application, that is, that the mark be used in such a manner that it would be readily perceived as identifying the specified [services] and distinguishing a single source or origin for the [services]." *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992); *see also In re Roberts*, 87 USPQ2d 1474, 1478 (TTAB 2008). Not every word or symbol which appears in connection with an entity's services functions as a service mark. *In re Safariland Hunting*, 24 USPQ2d at 1381; *In re Remington Prods. Inc.*, 3 USPQ2d

1714, 1715 (TTAB 1987). Whether the slogan functions as a service mark depends on how it would be perceived by the relevant public. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006). “The more commonly a [slogan or term] is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark [or service mark].” *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (quoting *In re Eagle Crest*, 96 USPQ2d at 1229).

According to the Examining Attorney, the applied-for mark OUR LAWYERS ARE DOCTORS consists of terms that are commonly used by those in Applicant’s trade to merely convey information about their services.²

The Examining Attorney’s position is supported by the following evidence showing that firms offering legal services provided by lawyers who are also doctors commonly use the terms “lawyers” and “doctors” together, sometimes using the identical language to that in Applicant’s proposed mark:

- Kline & Specter webpage sub-headline stating “The Doctor/Lawyer Team” with the text beginning “Kline & Specter, PC, has five lawyers who are also doctors . . .” (March 2, 2017 Office Action, TSDR 4)³
- LAWMD.COM webpage stating in the first paragraph “many of our lawyers are doctors as well as skilled trial lawyers” (March 2, 2017 Office Action, TSDR 5)
- Sacks, Leichter & Roskin webpage stating in a sub-headline near the top of the page “One of the Few Law Firms Where The Lawyers Are All Board Certified Physicians or Doctors,” also mentioning “Our medical

² Examining Attorney’s Appeal Brief (6 TTABVUE 6).

³ References to the TSDR database are to the downloadable .pdf version.

malpractice lawyers are all board certified physicians or doctors . . . ” and “one of the only medical malpractice law firms in the United States where the lawyers are all board certified physicians or doctors” (March 2, 2017 Office Action, TSDR 6)

- CHH Cirignani Heller Harman webpage stating in a sub-headline “A Firm With Attorneys Who Are Also Board-Certified Physicians” and also mentioning that “two of our lawyers are also doctors” (March 2, 2017 Office Action, TSDR 7)
- Cullan & Cullan M.D., J.D. webpage stating in sub-heading “Nursing Home Lawyers who are also Doctors” and in the text “Our lawyers are also doctors . . . ” and “Our AV rated lawyers are also doctors . . . ”; a box near the bottom of the page is entitled “Working with Nursing Home Lawyers who are also Doctors” (March 2, 2017 Office Action, TSDR 8)
- Gershon Willoughby & Getz webpage from <www.medical malpracticedoctors.com> has section beginning “**Our lawyers are doctors**” (May 26, 2017 Office Action, TSDR 8)
- Mahoney Law Firm webpage has the heading “A Lawyer Who is Also a Doctor” above the entry for “Attorney Dennis Mahoney” who “is also a licensed medical doctor.” (See February 28, 2018 Office Action, TSDR 8)
- Nudelman & Associates webpage with the headline “Sometimes you need a lawyer who is also a doctor.” and then follows that with information that firm’s attorney, Mitchell S. Nudelman is a lawyer and a doctor (February 28, 2018 Office Action, TSDR 10)
- Ramji Law Group webpage with heading “Lawyer & Doctor” “The Lawyer who is also a Doctor.” (February 28, 2018 Office Action, TSDR 12)
- Schwalben Law Firm webpage contains sub-heading “Legal Assistance From A Lawyer Who Is A Doctor” (February 28, 2018 Office Action, TSDR 14)

- Ted A. Greve & Associates website contains sub-heading “Talk to the Lawyer Who is Also a Doctor” and also notes later in another page that firm has “A lawyer who is also a doctor” (February 28, 2018 Office Action, TSDR 18, 20)
- Law Offices of John C. Dorn webpage contains the wording “Who better than a lawyer who is also a doctor to have on your side.” (February 28, 2018 Office Action, TSDR 22)
- The Rich Firm PC website stating “Several of our lawyers are also doctors . . .” (February 28, 2018 Office Action, TSDR 24)
- Florida Trial MD webpage states “. . . who better to have on your side that a lawyer who is also a medical doctor?” and that its trial team consists of both “a lawyer/medical doctor and a Board Certified Civil Trial Lawyer” (February 28, 2018 Office Action, TSDR 27)
- Jack Tolliver, M.D. webpage contains the sub-heading “Our Unique Doctor-Lawyer Medical Malpractice Experience,” describes the lawyer at the firm as “a doctor and personal injury lawyer” and has a link entitled “The Lawyer-Doctor edge” (February 28, 2018 Office Action, TSDR 28)
- RossFellerCasey law firm webpage contains the sub-heading “Our Team of Ivy League Educated Doctors” and describes its team as “consist[ing] of two of the nation’s leading physicians – one of whom is also a lawyer” (February 28, 2018 Office Action, TSDR 31)

Since it is common for lawyers to promote their legal services by advertising that they are also doctors, the Examining Attorney argues that the applied-for mark OUR LAWYERS ARE DOCTORS merely conveys an informational message about Applicant’s business, and does not distinguish Applicant’s services from those of others.

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