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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87240575

MARK: OUR LAWYERS ARE DOCTORS



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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: Wilson, Michael Moureau

CORRESPONDENT'S REFERENCE/DOCKET NO:

06128-0001

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the undersigned examining attorney's final refusal to register the mark "OUR LAWYERS ARE DOCTORS" on the grounds that it is a slogan/terms that does not function as a

service mark to indicate the source of applicant's legal services and to identify and distinguish them from others. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127.

In addition, applicant has appealed the final refusal to register the mark on the grounds that it is (1) merely descriptive of a feature or characteristic of applicant's legal services, and (2) has not acquired distinctiveness in connection therewith. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), (f); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

FACTS

Applicant filed its application on November 17, 2016, seeking registration of the mark "OUR LAWYERS ARE DOCTORS" in connection with "legal services".

On March 2, 2017, the examining attorney issued an Office Action in which registration of applicant's mark was refused on the grounds that the mark is a slogan/terms that does not function as a service mark to indicate the source of applicant's services and to identify and distinguish them from others.

Applicant responded to that Office Action on May 3, 2017, by submitting arguments relating to the failure to function refusal.

On May 26, 2017, after consideration of applicant's arguments and further review of the file, the examining attorney continued the failure to function refusal and also issued a new refusal, namely, a Section 2(e)(1) Merely Descriptive refusal on the grounds that "OUR LAWYERS ARE DOCTORS" merely described a feature and/or characteristic of applicant's legal services.

Applicant responded on July 27, 2016, by submitting a Section 2(f) Claim of Acquired Distinctiveness and asserting that the mark had become distinctive of the legal services through the applicant's substantially exclusive and continuous use of the mark in commerce for at least the five years immediately prior to date of submitting the claim.

On August 21, 2017, the examining attorney issued an Office Action that rejected the claim of acquired distinctiveness because the allegation of five years use was insufficient to demonstrate that the relevant public would understand the primary significance of the mark as identifying the source of applicant's legal services rather than just identifying/describing the services themselves. In addition, the Section 2(e)(1) Merely Descriptive refusal and the failure to function refusal were continued and maintained.

Applicant responded on February 6, 2018, by submitting arguments relating to the failure to function refusal and the rejection of the Section 2(f) Claim of Acquired Distinctiveness.¹ Applicant did not present arguments as to the Section 2(e)(1) Merely Descriptive refusal.

On February 28, 2018, the examining attorney issued a Final Office Action wherein the failure to function refusal, the Section 2(e)(1) Merely Descriptive refusal and the rejection of the Section 2(f) Claim of Acquired Distinctiveness were all continued and made final.

On May 17, 2017, applicant filed its *ex parte* appeal and appeal brief with the Trademark Trial and Appeal Board and, on that same date, the file was then forwarded to the examining attorney for the preparation of this Reply Brief.

ISSUE

The following three issues are presented in this appeal:

- (1) Does the mark “OUR LAWYERS ARE DOCTORS” function as a service mark, under Sections 1, 2, 3 and 45 of the Trademark Act, to indicate the source of applicant’s legal services and to identify and distinguish them from others?
- (2) Has the mark “OUR LAWYERS ARE DOCTORS” acquired distinctiveness under Section 2(f) of the Trademark Act?
- (3) Is the mark “OUR LAWYERS ARE DOCTORS” merely descriptive, under Section 2(e)(1) of the Trademark Act, when used in connection with legal services?

¹ Although applicant stated that its attached arguments were for both the failure to function refusal and the rejection of the Section 2(f) claim, only the failure to function refusal was specifically addressed in those arguments.

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