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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87882281
Applicant	James Kelleher
Applied for Mark	ASK JIM FIRST
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Submission	Supplemental Brief
Attachments	ASK JIM FIRST - Supplemental Ex Parte Appeal Brief Of Applicant James Kelleher.PDF(53452 bytes )
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: James Kelleher )  
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SERIAL NO.: 87/882,281 ) Law Office 115  
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CLASS: 35 )  
)  
FILING DATE: April 18, 2018 )

**SUPPLEMENTAL EX PARTE APPEAL BRIEF OF APPLICANT JAMES KELLEHER**

Applicant James Kelleher (“Applicant”) submits this supplemental brief in support of his *ex parte* appeal in connection with Application Serial No. 87/882,281 (the “Application”). As more fully discussed below, Applicant’s supplemental brief responds specifically to the issues raised in the November 27, 2019 final refusal to register (the “Subsequent Final Action”) the ASK JIM FIRST mark (“Applicant’s Mark”) shown in the Application on the basis of a purported likelihood of confusion with the ASK JIM mark shown in Registration No. 3,289,118 (the “Cited Registration”) owned by Small Business Network, Inc.

**PROCEDURAL BACKGROUND**

Applicant has previously described in detail the procedural background of this matter from the filing of the Application through the initiation of this appeal. *See* Applicant’s Opening Brief at 1-2. Since Applicant initiated that appeal and filed its Opening Brief, a new Examining Attorney replaced the one originally responsible for the Application. On November 7, 2019, the new Examining Attorney requested suspension of the appeal and for the Application to be remanded so that she could “submit additional evidence in the record relevant to the issue on appeal”, which was attached to her request. On November 23, 2019, the Board

granted the request for remand. In doing so, the Board instructed the new Examining Attorney that “inasmuch as new issues will be raised, the refusal cannot be made final until Applicant is given an opportunity to respond”. On November 27, 2019, the Examining Attorney issued the Subsequent Final Action including the authority she had submitted to the Board with her request for remand. In response, on January 27, 2020, Applicant submitted a Third Request for Reconsideration. Therein, Applicant amended the identification of services in the Application to read “Lawyer referral services provided to consumers who seek to retain an attorney to represent them in personal injury matters excluding business advice, inquiries and information services”. Applicant also submitted further evidence in response to the Examining Attorney’s evidentiary submission in the Subsequent Final Action. On February 4, 2020, proceedings in the appeal resumed and Applicant received sixty (60) days from that date in which to file a supplemental brief if he so desired.

### **ARGUMENT AND CITATION OF AUTHORITY**

Applicant’s opening brief set forth in great detail the prior Examining Attorney’s repeated mischaracterizations of evidence in both her Final Office Action and subsequent Denial in reaching her conclusion of confusing similarity. *See* Applicant’s Opening Brief at 7-16.

Among other things, Applicant established that the previous Examining Attorney repeatedly mischaracterized the evidence upon which she was relying in support of her argument that the services covered by the Application and by the Cited Registration were related. The crux of those misrepresentations is that all of the evidence upon which she relied shows, at most, the provision of legal information and advice in Class 41 and not general business information and advice in Class 35, the latter of which are the services covered by the Cited Registration.

When Applicant learned of the new Examining Attorney assuming responsibility for the Application, Applicant hoped she would correct or otherwise “walk back” the numerous mischaracterizations of the evidence in the record. Instead, it appears that she has “doubled down” and has adopted those mischaracterizations, which are outlined in detail below.

Applicant’s supplemental brief is limited to a discussion of the Subsequent Final Action and the evidence upon which the new Examining Attorney relies, as well as the evidence submitted with Applicant’s Third Request for Reconsideration and, specifically, as that evidence and argument relates to the alleged “relatedness of the compared services”. *See* Subsequent Final Action at 3.<sup>1</sup>

The new Examining Attorney essentially presents two arguments for why she believes the services covered by the Application and by the Cited Registration are related. First, she contends that “[i]n the present case, the registration’s business information services are broadly defined **and necessarily overlap** with Applicant’s lawyer referral services”. *Id.* at 4<sup>2</sup> (emphasis added). Applicant denies the services of the Cited Registration were “broadly defined” or that they “necessarily overlap[ped]” with the services covered by the Application even prior to amending the identification of services in his Third Request for Reconsideration for the reasons explained in detail in its Opening Brief. *See* Opening Brief at 7-15. However, with the amendment to the identification of services, which now reads “Lawyer referral services provided to consumers who seek to retain an attorney to represent them in personal injury

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<sup>1</sup> The new Examining Attorney has essentially repeated her predecessor’s arguments on the alleged similarity of the marks. *See* Subsequent Final Action at 3-4. As Applicant has already addressed this factor at length, he will not repeat his argument on that factor here. *See* Opening Brief at 16-18.

<sup>2</sup> *See also* Subsequent Final Action at 3 (“[A]pplicant’s lawyer referral services provided to consumers on personal injury matters and registrant’s business ... information services are related because Applicant **necessarily provides** business information about law firms and attorneys in connection with its lawyer referral services.”) (emphasis added).

matters **excluding business advice, inquiries and information services**” (emphasis added), no reasonable argument exists that the respective services overlap as the services of the Cited Registration are explicitly excluded from the identification of services in the Application.

Indeed, the new Examining Attorney’s “necessarily overlap” argument is ironic in that on the one hand she contends that “a likelihood of confusion is based on the description of the services stated in the Application and the registration at issue” and not “on its extrinsic evidence of actual use”. Subsequent Final Action at 3. Yet her purported evidence of overlap rests solely on extrinsic use made by parties other than Applicant. *Id.* If the new Examining Attorney adheres to the “no extrinsic evidence” rule she has articulated, she must now concede the respective services do *not* overlap in view of the most recent amendment to the Application’s services.

Next, like her predecessor, the new Examining Attorney , argues that the respective services are related because they are purportedly “of a kind that might emanate from a single source under the same mark”. *Id.* The vast majority of evidence relied upon by the new Examining Attorney was also relied upon by her predecessor at various stages of the prosecution of the Application, and all of it has been discussed at length and discredited by Applicant. *See* Opening Brief at 7-15. Incredibly, again like her predecessor, the new Examining Attorney contends that the U.S. Chamber of Commerce, the People’s Library of Maryland and the American Bar Association provide lawyer referral services. Subsequent Final Action at 5. However, Applicant previously demonstrated that none of these entities provides lawyer referral services. *See* Request for Reconsideration at 7 and Exhibits E-F thereto. **Applicant requests that in her response the new Examining Attorney specifically identify where in the record there is any evidence that these entities provide “lawyer referral services”, particularly in**

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