

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Richard M. Russell

Serial No. 90432695

Richard M. Russell, Esq., pro se.

Justine Levy, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

Before Kuhlke, Lykos and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:¹

¹ Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system. Citations to the record and briefs include references to TTABVue, the Board's online docketing system.

I. Background

Richard M. Russell (“Applicant”) seeks to register on the Principal Register the proposed mark WE’RE HERE TO HELP WITH YOUR LEGAL NEEDS! in standard characters for “legal services”² in International Class 45.³

Applicant described the specimen of use, shown below, as “mark used on Internet marketing”:



The Examining Attorney has finally refused registration on the grounds that the proposed mark: fails to function as a service mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053, 1127; is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); and is likely to cause confusion with Registration No. 4790098, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

For the reasons set forth below, we affirm the refusal to register under Sections 1, 2, 3 and 45, and do not reach the other grounds for refusal. *See, e.g., In re DTI P'ship*

² The application included the following miscellaneous statement: “Any use of a similar mark is necessarily geographic and geographically far from applicant’s use.” December 30, 2020 Application at TSDR 1. Any attempt to seek a concurrent use registration must comply with Trademark Rule 2.42, 37 C.F.R. § 2.42, which Applicant’s statement does not. *See also* 37 C.F.R. § 2.99 (regarding concurrent use proceedings).

³ Application Serial No. 90432695 was filed December 30, 2020, based on an alleged use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

LLP, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for information was sufficient basis to refuse registration; Board did not reach merits of refusal under Section 2(e)(1)).

II. Failure to Function

A. Legal Background

The [Trademark] Act conditions the registrability of any mark on its ability to distinguish an applicant's goods and services from those of others. See 15 U.S.C. §§ 1052, 1053. In other words, it is a threshold requirement of registrability that the mark "identify and distinguish" the goods and services of the applicant from those of others, as well as "indicate the source" of those goods and services. [15 U.S.C.] § 1127; *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 146, 143 S. Ct. 1578, 216 L. Ed. 2d 161 (2023) ("[A] trademark is not a trademark unless it identifies a product's source (this is a Nike) and distinguishes that source from others (not any other sneaker brand)."); *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, 600 U.S. 412, 429, 143 S. Ct. 2522, 216 L. Ed. 2d 1013 (2023) (Jackson, J., concurring) ("It is clear beyond cavil that what makes a trademark a trademark under the Lanham Act is its source-identifying function.").

In re Go & Assocs., LLC, 90 F.4th 1354, 2023 USPQ2d 1337, at *2 (Fed. Cir. 2024).

We must assess whether Applicant's proposed mark, WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!, functions as a mark based on whether the relevant public, i.e. purchasers or potential purchasers of the recited legal services, would perceive WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS! as identifying the source or origin of such services. *See e.g., id.* (the relevant inquiry "typically focuses on how the mark is used in the marketplace and how it is perceived by consumers");

In re Texas With Love, LLC, 2020 USPQ2d 11290, at *2 (TTAB 2020) ("Whether the

term ... falls within this definition and functions as a mark depends on whether the relevant public, i.e., purchasers or potential purchasers of Applicant's goods [or services], would perceive the term as identifying the source or origin of Applicant's goods [or services]."). In this case, because there are no limitations to the channels of trade or classes of consumers, the relevant consuming public comprises all potential purchasers of the identified legal services, and therefore includes members of the general public. *See In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *5 (TTAB 2019); *cf. CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983) (applying this principle in the likelihood of confusion context).

Describing "helpful" guidance from the Board, the Federal Circuit noted the Board's holding that "matter that 'merely convey[s] general information about the goods or services or an informational message'" fails to function as a source identifier. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at *3 (Fed. Cir. 2022). "Where the evidence suggests that the ordinary consumer would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the goods and services from similar goods and services of others, then the words fail to function as a mark." *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *3 (TTAB 2019).

B. Evidence and Analysis

The Examining Attorney argues that the proposed mark "fails to function as a trademark because the wording is merely informational and constitutes a

commonplace slogan.”⁴ As support, the Examining Attorney relies on a Thomson Reuters’ Legal online article referring to “clients’ legal needs”⁵ in connection with legal services, along with the following third-party law firms’ uses of the wording in the proposed mark, or nearly identical wording:

The Baker Burton & Lundy website states: “WE’RE HERE TO HELP WITH YOUR LEGAL NEEDS,” noting, “[w]hether dealing with new opportunities or facing an unexpected problem, seeking legal advice can be intimidating. That’s why we’re here. At Baker, Burton & Lundy, we do our best to solve your problem and take the stress out of navigating the legal system.”⁶

The Terry Jessop & Bitner Facebook page states, “[s]ometimes, our problems require the help of others. We salute and honor those who step up to help. We’re here to help with your legal needs.”⁷

The Carroll Law Firm, LLC website states, “We’re Here to Help With Your Legal Needs. Whether you’re starting a business, handling family affairs, or struggling with the home damage recovery process, we’re here to help you.” The webpage then lists three types of legal services – property damage, family law, and small business legal.⁸

An article titled “Keep Your Divorce Off Social Media: Here’s Why” on the Patton & Pittman Attorneys at Law website concludes with, “Need more advice about using social media during your divorce? Call (931)361-4477 to speak with our Clarksville divorce lawyers. We’re here to help with your legal needs.”⁹

⁴ 14 TTABVUE 2 (Examining Attorney’s Brief).

⁵ October 19, 2022 Office Action at TSDR 8.

⁶ *Id.* at 2 (bakerburtonlundy.com) (capitalization in original).

⁷ *Id.* at 3 (facebook.com/TerryJessopBitner/).

⁸ *Id.* at 4 (serenalaw.com).

⁹ *Id.* at 5 (pattonandpittman.com).

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