

To: Russell, Richard M.(capecodlaw@aol.com)
Subject: U.S. Trademark Application Serial No. 90432695 - WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!
Sent: May 05, 2023 03:57:03 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[screencapture-vanderpoollaw-net-practice-areas-16825370476901](#)
[screencapture-flrlegal-com-practice-areas-16825370842091](#)
[screencapture-www-ruggedlaw-com-business-law-16825371161941](#)
[screencapture-www-ashmorelaw-com-reports-16825371526331](#)
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United States Patent and Trademark Office (USPTO) Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 90432695

Mark: WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!

Correspondence Address:

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Reference/Docket No. N/A

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SUBSEQUENT FINAL OFFICE ACTION

Issue date: May 5, 2023

INTRODUCTION

This Office action is in response to applicant's communication filed on April 18, 2023.

In a previous Office action(s) dated October 19, 2022, the trademark examining attorney refused registration of the applied-for mark based on the following:

- REFUSAL - APPLIED-FOR WORDING FAILS TO FUNCTION AS A MARK
- REFUSAL IN THE ALTERNATIVE - APPLIED-FOR MARK IS MERELY DESCRIPTIVE

- REFUSAL - SECTION 2(d) - LIKELIHOOD OF CONFUSION

Further, the trademark examining attorney maintains and now makes **FINAL** the refusal(s) and/or requirement(s) in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

SUMMARY OF ISSUES MADE **FINAL** that applicant must address:

- REFUSAL - APPLIED-FOR WORDING FAILS TO FUNCTION AS A MARK
- REFUSAL IN THE ALTERNATIVE - APPLIED-FOR MARK IS MERELY DESCRIPTIVE
- REFUSAL - SECTION 2(d) - LIKELIHOOD OF CONFUSION

REFUSAL - APPLIED-FOR WORDING FAILS TO FUNCTION AS A MARK

For the reasons set forth below, the refusal is now made **FINAL** under Trademark Act Sections 1, 2, and 45 for failure to function as a trademark. *See* 15 U.S.C. §§1051, 1052, 1127; 37 C.F.R. §2.63(b). Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and/or 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 this case, the applied-for mark is a commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment. *See In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1160 (TTAB 2019) (holding INVESTING IN AMERICAN JOBS not registrable for retail store services or promoting public awareness of goods made or assembled by American workers because the mark would be perceived merely as a commonly-used informational message); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (holding DRIVE SAFELY not registrable for automobiles and automobile parts because the mark would be perceived merely as an "everyday, commonplace safety admonition").

Terms and expressions that merely convey an informational message are not registrable. *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)). Determining whether the term or expression functions as a trademark or service mark depends on how it would be perceived by the relevant public. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351, 2022 USPQ2d 115, at *2 (Fed. Cir. 2022) (citing *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *3 (TTAB 2020)); TMEP §1202.04. When there are no limitations on the goods or services in the application, the relevant public comprises all potential purchasers of the goods or services. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *3 (TTAB 2020) (citing *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *5 (TTAB 2019)); *see* TMEP §1202.04. "The more commonly a term or expression 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 Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *3 (TTAB 2019) (citing *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013)); TMEP §1202.04(b).

The previously attached evidence from BakerBurtonLundy.com, Facebook.com, SerenaLaw.com, PattonAndPittman.com, and FZRLaw.com and the newly attached evidence from VanderPoolLaw.net, FLRLegal.com, RuggedLaw.com, AshmoreLaw.com, SchultzLawOffices.com, and CornerstoneLaw.us shows that this term or expression is commonly used to refer to a marketing message implying that the source of the message is available to assist and conveys a common evocation of the concept that a lawyer is there to help with legal needs. Because consumers are accustomed to seeing this term or expression commonly used in everyday speech by many different sources, they

would not perceive it as a mark identifying the source of applicant's goods and/or services but rather as only conveying an informational message.

An applicant may not overcome this refusal by amending the application to seek registration on the Supplemental Register or asserting a claim of acquired distinctiveness under Section 2(f). *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *8; TMEP §1202.04(d); *see In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *4 (TTAB 2019). Nor will submitting a substitute specimen overcome this refusal. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6 (TTAB 2020) (quoting *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016)); TMEP §1202.04(d).

In the Applicant's April 18, 2023 Response, the applicant argues that the use of wording "WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!" is not punctuated exactly as it appears in the evidence. However, as shown by the newly attached evidence, the same sentiment is generally expressed, being that the commercial impression itself fails to function, not merely the exact manner with which that commercial impression is expressed.

Furthermore, the applicant misinterprets the evidence, but rather seems to reinforce the point of the evidence, that the use of the wording is typically a non-source identifying usage. Generally, the sentiment expressed is to indicate to consumers that the provider of legal services is present in order to assist with their legal needs. The fact that the wording is often a buried afterthought is exactly the point being made, that it fails to function as source identifying because it is a rather common place slogan to use when advertising legal services.

As such, the refusal is continued, maintained and now made **FINAL**.

The applicant should also take note of the additional ground for refusal made **FINAL** below.

REFUSAL IN THE ALTERNATIVE - APPLIED-FOR MARK IS MERELY DESCRIPTIVE

Furthermore, in the alternative, if the applied-for wording is determined to be capable of functioning as mark, the following refusal applies. Additionally, the refusal under Trademark Act Section 2(e)(1) is now made **FINAL** for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.63(b).

Registration is refused because the applied-for mark merely describes a feature, ingredient, characteristic, purpose, function, intended audience of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Here, the mark is descriptive of a purpose of applicant's legal services. That is, the previously attached evidence from Legal Building block shows that legal services involve lawyers doing work for clients. Additional previously provided evidence from Thompson Reuters shows that meeting a client's legal needs is part of the work lawyers do. The evidence discussed above regarding the failure to function refusal also shows that consumers immediately understand the wording WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS to describe a purpose of applicant's services: that the source of the statement is available to assist with a client's law-related issues. Moreover, the previously attached evidence from BakerBurtonLundy.com, Facebook.com, SerenaLaw.com, PattonAndPittman.com, and FZRLaw.com and the newly attached evidence from VanderPoolLaw.net, FLRLegal.com, RuggedLaw.com, AshmoreLaw.com, SchultzLawOffices.com, and CornerstoneLaw.us shows that the wording, if not incapable of function, is at least used often descriptively to describe what the provider of such legal services does, which is help consumers with their legal needs. This is because consumers

would understand this wording as indicating to them that the applicant provides assistance with legal needs, much like if the applicant were asked the question "What do you do?" and the response would be "We're here to help with your legal needs!" It is a direct description of their services.

Accordingly, if the applied-for wording is determined to be capable of functioning as mark, registration is refused based on Trademark Act Section 2(d) because the applied-for mark is merely descriptive of applicant's services.

In the Applicant's April 18, 2023 Response, the applicant argues that not all lawyers seek to help clients with their legal needs. This is unpersuasive, in particular because the applicant does appear to be assisting clients with their legal needs, so the fact that some lawyers may not be assisting clients with their needs would not be relevant here.

As such, the refusal is continued, maintained and now made **FINAL**.

The applicant should also take note of the additional ground for refusal made **FINAL** below.

REFUSAL - SECTION 2(d) - LIKELIHOOD OF CONFUSION

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made **FINAL** with respect to U.S. Registration No. 4790098. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b). Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4790098. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The applied-for mark is:

- **U.S. Application Serial No. 90432695 – “WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!”** in standard characters for:
 - Class 045: Legal services

- *Applicant: Russell, Richard M.*

The registered mark is:

- **U.S. Registration No. 4790098** – “WE'RE HERE TO HELP” in standard characters for:
 - Class 045: Legal services
 - *Registrant: Parnall Law Firm, LLC*

1. Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

The registered mark “WE’RE HERE TO HELP” is the only registered mark in Class 045 with that wording. Furthermore, the registered mark “WE’RE HERE TO HELP” is the only registered mark for legal services in Class 045 with that wording, indicating the strength of that mark.

The marks share an overall similar commercial impression because they share the similar phrases “WE’RE HERE TO HELP”. The applied-for mark has additional wording “WITH YOUR LEGAL NEEDS!” in relation to legal services, so that wording is descriptive because helping with “LEGAL NEEDS” in relation to legal services describes that the services help consumers in the field of law.

The applied-for mark “WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!” entirely incorporates the registered mark “WE’RE HERE TO HELP”. These two marks are the only two marks in Class 045 with the exact wording “WE’RE HERE TO HELP” and also the services are identical, meaning that the degree of similarity between the marks required to support a finding that confusion is likely declines. Both marks begin with “WE’RE HERE TO HELP”. The additional wording in the applied for-mark, “WITH YOUR LEGAL NEEDS!”, is also descriptive because the applicant is offering legal services. So, the wording “WITH YOUR LEGAL NEEDS!” does not affect or change the commercial impression of “WE’RE HERE TO HELP” when compared to the registrant’s mark.

It is reasonable that a consumer who sees or hears the phrase “WE'RE HERE TO HELP WITH YOUR LEGAL NEEDS!” for legal services would likely be confused as to the source of the services when compared to seeing or hearing the phrase “WE’RE HERE TO HELP” for legal services. A consumer would believe that both phrases come from the same source, especially for when the services are identical.

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting

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