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

Proceeding	91171681
Party	Defendant Mark Allen Davis
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Submission	Brief on Merits for Defendant
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Application Serial No. 78/684,218

Filed: August 2, 2005

For the Mark: “**WHEN YOU NEED A LEGAL EAGLE, CALL A BALD EAGLE**”

Published in the *Official Gazette* on May 9, 2006

Legal Eagle, Inc.

Opposition No. 91171681

Opposer,

vs.

Mark Allen Davis

Applicant

APPLICANT’S BRIEF

I. Introduction

In this case, Legal Eagle, Inc. opposes the registration of “When you need a legal eagle, call a bald eagle” (which plays on the fact that Applicant is bald). Opposer requests that Applicant’s Mark be denied because it alleges confusion with its own Mark of “Legal Eagle.” Applicant counterclaims by showing that Legal Eagle is a common, generic term for an attorney such that its registration should be cancelled.

II. Law and Argument

Confusion does not arise between the two Marks upon any of the factors set forth in *In Re DuPont DeNemours & Co.*, 476 F.2d 1357 as shown below. In fact, the term legal eagle does not commonly refer to an entity providing copying services as Opposer alleges. Instead, it is the

generic term for an attorney. As a generic term, it cannot be “owned” by Opposer. As such, it’s registrations are improper and should be cancelled.

A. Opposer is not an attorney, does not provide legal services, and instead provides copying services.

As admitted by Opposer, it is not an attorney. Instead, Opposer admits in its Brief that it uses the “legal eagle” term to describe its copying services provided by its company. To wit, on pages 4-5, Opposer owns “Legal Eagle” Marks related to photocopying services marketed to attorneys.

Mark	Registration No.	Goods/Services
Legal Eagle	1,982,384	legal support services, <u>namely photocopying</u> and clerical services
Legal Eagle	1,978,249	legal support services, <u>namely photocopying</u> And clerical services
Legal Eagle	2,015,446	legal support services, <u>namely photocopying</u> And clerical services
Legal Eagle	2,643,271	stationery
Legal Eagle	2,366,023	paralegal services, electrical <u>document imaging</u> services
Legal Eagle	2,601,613	computer software for document management, namely <u>imaging</u>
Legal Eagle, We Have an Eye for Perfection	3,027,178	<u>photocopying</u>

Other than photocopying, Opposer provides imaging services, which is another form of photocopying. Opposer does not provide any legal services to the public. Opposer, admittedly, is not a lawyer or a law firm. Instead, Opposer markets its services to attorneys.

B. Opposer’s Mark is a generic term that refers to an attorney.

As a matter of law, the term “legal eagle” refers to an attorney just as the words “lawyer” and “barrister” refer to an attorney. Even our learned judges have used the term “legal eagle” to refer to a lawyer.

For example, in *Henderson v. Georgia Pacific*, the United States District Court Judge Robert S. Gawthrop, III wrote in his opinion, “one could really understand that this gentleman ...might well have been taken aback by the sight of a long varnished table attended by 21 legal eagles all presumably armed with briefcases and accompanied by a court reporter.” 1990 US Dist. LEXIS 2769, *4 (1990 E.Dist. Penn). Obviously, the good judge used the term “legal eagle” to refer to attorneys, and not a photocopying service.

Similarly, in the case of *Modisett v. Jolly*, the term legal eagle referred to an attorney drawing up a contract. (“Until we see if the legal eagles can draw up a satisfactory contract.”). 286 N.E. 2nd 675, *11 (Indiana, 1972). Admittedly, Opposer does not draw up contracts.

In the movie, *Legal Eagles*,¹ Robert Redford does not play a copier salesman who helps lawyers manage documents. No, Robert Redford plays a lawyer, District Attorney Tom Logan. *See* Exhibit A.

Dictionary.com defines a legal eagle as a lawyer.¹ *See* Exhibit B. Other dictionaries, such as Merriam-Webster’s define the term “legal eagle” as a lawyer.

A google search for legal eagle provides 2, 220,000 hits.¹ *See* Exhibit C. Of these hits, *less than one one thousand of one percent* (.00001) relates to Opposer’s business. The majority

¹ Produced in discovery

of the hits relate to lawyers or references to lawyers.

As shown above, the term “legal eagle” is a generic term. As a generic term, it may not be trademarked. *Kellogg Co. v. National Biscuit Co.*, (1938) 305 U.S. 111, 116 (The plaintiff has no exclusive right to the use of the term "Shredded Wheat" as a trade name. For that is the generic term of the article, which describes it with a fair degree of accuracy; and is the term by which the biscuit in pillow-shaped form is generally known by the public. Since the term is generic, the original maker of the product acquired no exclusive right to use it).

The term “legal eagle” is analogous to that of the term “American.” While legal eagle is a generic term for an attorney, “American” is a generic term for someone from the Americas (i.e., Western Hemisphere, and more commonly, the United States). Simply using the generic term, American, to a title of a company or service, such as American Appraisals, does not give the right of American Appraisals to trademark the term, “American.”

Imagine, if for example, everytime the word “American” was used, a fee would have to be paid to whoever trademarked “American.” Similarly, “mother” may not be trademarked because of its universal meaning. *Nebraska Consol. Mills v Shawnee Milling Co.* (1951, WD Okla) 99 F Supp 70, 90 USPQ 303, affd (1952, CA10 Okla) 198 F2d 36, 94 USPQ 19 ("Mother" has become so universal in meaning and use that its exclusive use for any commercial purpose has been judicially prohibited.).

As with the words “American” and “mother”, “legal eagle” is a common daily term used by millions of people with a universal meaning of an attorney. Thus, Opposer may not claim the exclusive right to this generic term.

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