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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Legal Eagle, Inc.
v.
Mark Allen Davis

Opposition No. 91171681
to application Serial No. 78684218
filed on August 2, 2005

Natalma M. McKnew of Smith Moore Leatherwood, LLP for Legal Eagle, Inc.

Mark A. Davis of The Davis Law Office, LLC for Mark Allen Davis.

Before Bucher, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mark Allen Davis ("applicant") filed a use-based application for the mark "**When you need a legal eagle, call a bald eagle.**", in standard character form, for "legal services," in Class 42.

Legal Eagle, Inc. ("opposer") filed a notice of opposition against the registration of applicant's mark on the ground of priority of use and likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15

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U.S.C. §1052(d). Specifically, opposer alleged that it is the owner of seven federally-registered "Legal Eagle" marks including LEGAL EAGLE, in typed drawing form, for, *inter alia*, paralegal services¹ and legal support services, namely photocopying and clerical services,² and that applicant's mark is likely to cause confusion with opposer's marks.

Applicant denied the salient allegations in the notice of opposition, and filed a counterclaim to cancel opposer's pleaded registration for the mark LEGAL EAGLE for paralegal services. As ground for cancellation, applicant claimed that the term LEGAL EAGLE is generic for paralegal services. Opposer denied the essential allegations in applicant's counterclaim to cancel opposer's registration.

The Record

By rule, the record includes applicant's application file, the file for the registration sought to be canceled, and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, opposer introduced the following testimony and evidence:

1. The testimony deposition of Richard C. Carnahan, Jr., the controlling shareholder of opposer, with attached exhibits; and,

¹ Registration No. 2,366,023, issued July 11, 2000; affidavits under Sections 8 and 15 accepted and acknowledged.

² Registration No. 1978249, issued June 4, 1996; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

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2. A notice of reliance on applicant's responses to opposer's interrogatory Nos. 1-17 and applicant's supplemental responses to opposer's interrogatory Nos. 11 and 17.

Opposer also filed a notice of reliance on copies of its pleaded registrations "together with status information through March 12, 2008." However, no documents were attached. Nevertheless, opposer's pleaded registrations have been made of record to the extent that they have been properly identified and introduced during Mr. Carnahan's testimony. See the discussion on standing below.

Applicant did not introduce any testimony or evidence during his testimony period. However, applicant attached three (3) exhibits to his brief. The exhibits were not timely filed, nor were they filed pursuant to a notice of reliance. Therefore, they were not filed in compliance with the Trademark Rules of Practice, and, with the exception of the dictionary definition of the term "legal eagle,"³ they have not been given any consideration. Trademark Rule 2.123(1), 37 CFR §2.123(1) ("Evidence not obtained and filed in compliance with these sections will not be considered"). See also TBMP §704.05(b) (2nd ed. rev. 2004) ("Exhibits and

³ We may take judicial notice of dictionary definitions. See *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice).

other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony").

Counterclaim

A. Standing.

Applicant's position as the defendant in the opposition gives it a personal stake in the outcome of the proceeding, and therefore it has standing to file a counterclaim seeking to cancel opposer's pleaded registration. *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990); *Alberto-Culver Co., v F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1603 (TTAB 1990); *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840, 841 (TTAB 1979).

B. Whether LEGAL EAGLE is generic for paralegal services?

The registration of opposer's mark on the Principal Register is *prima facie* evidence of the validity of that registration and that the mark identified in the registration is not generic. Accordingly, applicant has the burden of proving that opposer's registration is invalid because its mark is generic. *Stocker v. General Conference Corp.*, 39 USPQ2d 1385, 1392 (TTAB 1996) ("the burden of proof rests squarely on petitioners who are asserting invalidity").

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term has with the relevant public. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs and other publications. *Stocker v. General Conference Corp.*, 39 USPQ2d at 1392.

Our primary reviewing court has stated that a party asserting genericness must prove its claim by a preponderance of the evidence. Therefore, applicant has the dual burden of overcoming the registration's validity and he must also prove by a preponderance of the evidence that the term LEGAL EAGLE is used or understood by the relevant class of consumers primarily to refer to the class of services with which the term is registered (*i.e.*, paralegal services). *Stocker v. General Conference Corp.*, 39 USPQ2d at 1392.

The only admissible evidence applicant introduced into the record was a dictionary definition for the term "legal

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