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Subject: U.S. Trademark Application Serial No. 98150610 - 1-800-NY-LEGAL
Sent: October 08, 2024 03:02:42 PM EDT
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Attachments

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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. 98150610

Mark: 1-800-NY-LEGAL

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Reference/Docket No. N/A

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REQUEST FOR RECONSIDERATION AFTER FINAL ACTION DENIED

Issue date: October 8, 2024

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or

shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated August 7, 2024 are **maintained and continued**:

- Section 2(d) Refusal - Likelihood of Confusion

See TMEP §§715.03(a)(ii)(B), 715.04(a).

RESPONSE TO APPLICANT'S ARGUMENTS

Applicant's arguments presented in the request for reconsideration have been evaluated and are found unpersuasive.

Applicant has applied for the mark "1-800-NY-LEGAL" for "Attorney services; Legal services; Litigation services" in International Class 45.

Registrant owns the mark "1-800-NY-ABOGADO" for "Business marketing consultation services; marketing and promotional services, namely, preparing and placing advertisements for others, banner advertising, display advertising; link exchanges, namely, promoting the services of others by providing hypertext links to the websites of others; and legal referral services" in International Class 35.

First, applicant argues the marks are dissimilar. However, as discussed in the Office actions, the marks "1-800-NY-LEGAL" and "1-800-NY-ABOGADO" share the identical lettering "1-800-NY-" and the terms “LEGAL” and “ABOGADO” have similar meanings. The attached evidence from the Federal Communications Commission website shows “1-800” refers to a toll-free telephone number. See attached. The attached evidence from Encylopedia Britannica shows “NY” is the state abbreviation for New York. See attached. As discussed in the previous Office actions, the registration includes a translation statement that "ABOGADO" translates to "LAWYER", and the examining attorney has provided Spanish Dictionary evidence supporting the translation of “ABOGADO” meaning “LAWYER”. The terms "LEGAL" and "LAWYER" are nearly identical in meaning and commercial impression because, as established in the Final Office action, the terms “LEGAL” and “LAWYER” both refer to the practice of law, with lawyers providing legal services. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see In re M. Serman & Co.*, 223 USPQ 52, 53 (TTAB 1984) (holding CITY WOMAN for ladies’ blouses likely to be confused with CITY GIRL for a variety of female clothing); *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 USPQ 257, 260-61 (TTAB 1979) (holding BLUE NUN for wines likely to be confused with BLUE CHAPEL for the same goods); *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125, 128 (TTAB 1978) (holding TUNA O’ THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105, 109 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b).

The marks “1-800-NY-LEGAL" and "1-800-NY-ABOGADO" are therefore nearly identical in meaning, and overall commercial impression because they both refer to a toll-free phone number for New York legal services. Applicant asserts that “a consumer would not see two telephone numbers

with completely different terms in different languages and believe them to be the same." However, since both marks are for legal-related services, and share the identical prefix of "1-800-NY-", it is likely that consumers would understand "1-800-NY-ABOGADO" to be for Spanish-speaking customers, while "1-800-NY-LEGAL" is for English-speaking customers, with the services therein provided by the same New York-based company, brand, or business. 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 *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (TTAB 2020) (citing *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018); TMEP §1207.01(b); *see In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). The attached article from Legal Conversion Center discusses the importance of providing accommodations for Spanish-speaking clients, stating "it is essential for law firms to offer Spanish support as part of their intake process." See attached. The attached evidence from the Legal Services of New Jersey website shows a list of community resources specifically for Spanish-speakers, including legal assistance resources. See attached. The Rodriguez Law Firm website advertises bilingual services for English and Spanish-speaking clients, and has alternate versions of its website depending on the preferred language of the client. See attached. This evidence establishes that, in the United States, Spanish-speaking customers seeking legal services are accustomed to seeing services advertised in their native Spanish language.

Next, applicant provides a list of third-party registrations for legal services including various combinations of the terms "1-800", "LAWYER", "LAW", and/or "ATTORNEY", as well as its registered marks for "1-800-FL-LEGAL", "1-800-MA-LEGAL", and "1-800-BOS-LEGAL", However, the cited registered mark "1-800-NY-ABOGADO" and applied-for mark "1-800-NY-LEGAL" are the only marks combining "1-800" and "NY" with a law-related term. Marks may be confusingly similar in appearance where similar terms or similar parts of terms appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Com.*, 228 USPQ 689, 690-91 (TTAB 1986) (holding COMMCASH and COMMUNICASH confusingly similar), *aff'd sub nom. Canadian Imperial Bank of Com. v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1492, 1495, 1 USPQ2d 1813, 1814-15, 1817 (Fed. Cir. 1987); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (holding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (holding MILTRON and MILLTRONICS confusingly similar); *Sun Elec. Corp. v. Sun Oil Co.*, 196 USPQ 450, 452 (TTAB 1977) (holding SUNELECT and SUN ELECTRIC confusingly similar); *In re BASF Aktiengesellschaft*, 189 USPQ 424, 424 (TTAB 1976) (holding LUTEX and LUTEXAL confusingly similar); TMEP §1207.01(b)(ii)-(iii). The identical "1-800-NY-" in the marks indicates the services therein are provided in New York, to New York clients, which differentiates the meaning and commercial impression from the applicant's registrations for Florida, Massachusetts, and Boston legal services. The registrations applicant provides showing "1-800" and "HURT" or "INJURED used in various combinations does not obviate the overall similarity between "1-800-NY-LEGAL" and "1-800-NY-ABOGADO". Prior decisions and actions of other trademark examining attorneys in applications for other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed.

Cir. 2016) (citing *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability of the applied-for mark. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973)).

Finally, the applicant argues that the registrant's legal referral services are unrelated to its legal services. However, the fact that the goods and/or services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods and/or services, but likelihood of confusion as to the source or sponsorship of those goods and/or services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Here, while the applicant's own website promotes its legal services, it also features a page providing information about "Attorney Referrals." See attached. This "Attorney Referrals" page of applicant's website solicits legal referrals for the applicant's legal services, stating "by **referring** [emphasis added] cases to Rubenstein Law our reputation can lead [*sic*] better fees for you without the outlay of time and resources." See attached. The applicant's website advertises that applicant has "paid out over $6 million in **referral** [emphasis added] fees in the last five years," and emphasizes their "track record of successfully collaborating with law firms around the country through **referrals** [emphasis added], joint ventures, and co-counsel." See attached. Applicant's website features a referral submission form for joining its referral network, and provides referral fees for their "Rubenstein Law **referral** [emphasis added] partner[s]." See attached. This evidence from applicant's website shows a direct correlation between legal services and legal referral services as being mutually beneficial, establishing that the relevant services are provided through the same trade channels and are similar or complementary in terms of purpose or function. Thus, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). An examining attorney need not establish that every good or service listed in the application is related to the goods and/or services in the cited registration(s). In a likelihood of confusion analysis, it is sufficient to establish relatedness for one good or service in the refused class(es). *MLB Players Ass'n v. Chisena*, 2023 USPQ2d 444, at *18 (TTAB 2023) (quoting *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *11 (TTAB 2020)); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *2 (TTAB 2020) (citing *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 938-39 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981)).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Therefore, the likelihood of confusion refusal is maintained and the applicant's request for reconsideration is denied.

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the response period for the final Office action, applicant has the remainder of that time to (1) file another request for reconsideration that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B).

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