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# **APPELLEE'S BRIEF**

Appeal Nos. 2012-1114, -1115  
(Serial Nos. 77/513,717 and 77/513,748)

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**IN RE COLLEN IP INTELLECTUAL PROPERTY LAW, P.C.**

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Appeal from the United States Patent and Trademark Office,  
Trademark Trial and Appeal Board

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**BRIEF FOR APPELLEE - DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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## STATEMENT OF RELATED CASES

The Director is not aware of any other appeal from the Trademark Trial and Appeal Board (“TTAB”) for the United States Patent and Trademark Office (“USPTO”) in connection with these trademark applications that has previously been before this or any other court. The Director is also unaware of any related cases pending in this or any other court that will directly affect or be directly affected by this Court’s decision in the pending appeal.



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**I. STATEMENT OF THE ISSUE**

Appellant, Collen IP Intellectual Property Law, P.C. (“Collen”), seeks to register A BRAND NAME LAW FIRM for “legal services” (Application No. 77/513,717), and A BRAND NAME ADVISOR for “business consultation services, namely, product and marketing evaluation; advertising services, namely, creating corporate and product identity for others; creating trademarks for others” (Application No. 77/513,748). The TTAB found that A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR are merely descriptive of the respective services under 15 U.S.C. § 1052(e)(1) (“Section 2(e)(1)”), because although the marks may create a second meaning, both meanings of the respective marks are merely descriptive of a

characteristic or quality of the services, namely, that Appellant (1) is a law firm and advisor in the field of brand names, and (2) is a law firm and advisor that purports to be well-known or highly regarded. The sole issue on appeal is whether substantial evidence supports the TTAB's finding that the second meaning of the proposed marks is merely descriptive.

## II. STATEMENT OF THE CASE

On July 2, 2008, Collen filed two separate intent-to-use trademark applications. Application No. 77/513,717 sought to register the mark A BRAND NAME LAW FIRM in standard character form for "legal services." A313-19.<sup>1</sup> Application No. 77/513,748 sought to register the mark A BRAND NAME ADVISOR in standard character form for "business consultation services, namely, product and marketing evaluation; advertising services, namely, creating corporate and product identity for others; creating trademarks for others." A24-29. The Examining Attorney refused registration for both applications under Section 2(e)(1) on the ground that A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR are merely descriptive of the services. A39-44, A53-74, A200-15, A244-45, A328-31, A340-59, A485-500, A529-30. Collen appealed the Examining Attorney's refusals to the TTAB, which consolidated the appeals

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<sup>1</sup> Citations to the Joint Appendix are referred to as "A \_\_\_"; citations to the Appellant's Brief are referred to as "Br. at \_\_\_."

and affirmed the refusals in a single decision. A1-20. Collen filed separate notices of appeal for each application with this Court on November 4, 2011 (A291, A577). The Court granted Collen's unopposed motion to consolidate the appeals in an order dated February 22, 2012.

### **III. STATEMENT OF THE FACTS**

#### **A. The Examining Attorney's Refusal**

Registration to A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR was refused under Section 2(e)(1) because the proposed marks were determined to be merely descriptive of the services in the respective applications based on evidence including dictionary definitions of "brand-name" (A60-61, A347-48), "law firm" (A355, A357), "advisor" (A70-74) and "advise" (A43-44); printouts of entries from Wikipedia.org regarding "brand name" (A62-67, A349-54); a printout from [www.investmentmarketing.com](http://www.investmentmarketing.com) showing the wording "brand name advisor" used by a provider of marketing services (A57, A344); and printouts from Collen's own website, "[www.brandnameportal.com](http://www.brandnameportal.com)," showing that Collen provides legal and business services in the field of brand names, such as helping clients select, protect and manage brand names (A208-15, A493-500). In particular, the Examining Attorney found that the proposed mark A BRAND NAME LAW FIRM in Application No. 77/513,717 is merely

descriptive of a feature, characteristic, function or purpose of a law firm that offers legal services in the field of intellectual property, particularly trademark law. A328-31, A340-59, A485-500, A529-30. Likewise, the Examining Attorney found that the proposed mark A BRAND NAME ADVISOR in Application No. 77/513,748 is merely descriptive of a feature, characteristic, function or purpose of providing business advice in the field of brand identity. A39-44, A53-74, A200-15, A244-45.

In responding to the refusals, Collen did not dispute that one of the meanings of the marks is descriptive, namely that Collen is a law firm and advisor specializing in brand names (*i.e.*, trademarks), but instead argued that the proposed marks are registrable because they have a second meaning that creates a “double entendre.” A45-46, A332-33, A75-80, A360-65, A216, A501. To support its position, Collen submitted dictionary definitions of “brand name” showing it also means “well-known” or “highly regarded” (A186-95, A449-58), third-party website printouts showing usage of the wording “brand name” to refer to famous or well-known individuals including surgeons, politicians, and actors, (A96-161, A220-36, A381-446, A505-21), and several third-party owned trademark registrations which include the wording “brand name” in the marks (A162-80, A459-77). The Examining Attorney considered Collen’s arguments against the refusals of

registration, but found them unpersuasive. A53-56, A340-43, A200, A485, A244, A529.

**B. The TTAB Affirmed the Refusal to Register**

The TTAB affirmed the descriptiveness refusals for both marks. A1-20. The TTAB determined that one meaning of each proposed mark merely describes the applied-for services. A7-8, A16-17. In addition to the dictionary and website evidence in the record, the TTAB noted the following admissions in Collen's brief and Office action responses:

- it "is a firm that practices the law of Brand Names (Trademarks)" (A7, quoting A333; *see also* A46);
- "it is a Trademark Law Firm, or a Brand Name Law Firm" (A8, quoting A333, A544);
- "it is a Trademark Law Advisor, or a Brand Name advisor" (A17, quoting A259);
- "it gives advice, among other things, in the field of brand identity" (A17, quoting A75; *see also* A360);
- that "brand name is a synonym for 'trademark'" (A17, quoting A46, A259, A333; *see also* A544);
- its "services include advising on issues of trademark adoption and use" (A17, quoting A251).

Thus, the TTAB found that "[t]here really is no issue that A BRAND NAME LAW FIRM describes legal services, in that it directly tells consumers that a major characteristic of the legal services rendered by [Collen] involves the protection of brand names or trademarks." A7.

Likewise, the TTAB found that “there is no real dispute that one meaning of A BRAND NAME ADVISOR is descriptive of the services,” which include creating trademarks and product identity for others, in that it directly tells consumers that a major characteristic of Collen’s services involve “advising on trademarks or brand names.” A17.

The TTAB next considered and rejected Collen’s claim that the proposed marks have a second, non-descriptive meaning. A20. In making its determination, the TTAB considered dictionary definitions of “brand name” which showed it has an alternate meaning of “one having a well-known and usually highly regarded or marketable name,” as well as Collen’s evidence of online news articles showing the term “brand name” used to refer to famous or well-known individuals. A8-10.

The TTAB noted that, even if a mark conveys two meanings, the second meaning conveyed by the mark must be non-descriptive for the mark to avoid the prohibition of Section 2(e)(1). A11. The TTAB found that any second meaning created by A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR fails that requirement because the meaning is laudatorily descriptive—it touts Collen’s legal and advisory services as being well-known or highly regarded. A12, A16, A19. Therefore, the TTAB found

that regardless of which meaning one ascribes to the proposed marks, each is merely descriptive of the identified services. A12, A19.

As the TTAB reasoned:

A BRAND NAME LAW FIRM, when used in connection with legal services, has not only the meaning of a law firm that specializes in brand name or trademark law, but a law firm that is known or has a good reputation. In fact, applicant's evidence shows that the term "brand name" is used in this manner in connection with doctors and pharmacists and companies, and the term would be immediately understood as having the same meaning when applied to a law firm, i.e., that the law firm itself has a notable reputation, or is highly regarded or well known. Thus, although applicant's mark has a second meaning, it is a laudatory descriptive one, and whichever meaning that one would ascribe to the mark, it is merely descriptive of the identified legal services.

A12; *see also* A19 (making similar findings regarding A BRAND NAME ADVISOR).

The TTAB considered Collen's evidence of third-party registrations for marks including the term "brand name," but found they were inapposite to registrability of Collen's proposed marks in several ways and failed to establish that A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR are not descriptive. A14-15.

Having found both meanings of the proposed marks to be descriptive, the TTAB affirmed the refusals to register the marks under section 2(e)(1). A20.

#### IV. SUMMARY OF THE ARGUMENT

There is no dispute that A BRAND NAME LAW FIRM<sup>2</sup> conveys two meanings in connection with Collen's legal services and that one of those meanings is merely descriptive because it directly tells consumers that Collen provides legal services regarding brand names or trademarks. With respect to the second meaning conveyed by A BRAND NAME LAW FIRM—a highly regarded or well-known law firm—the TTAB properly found that meaning is laudatorily descriptive of the services rather than suggestive. In addition to relying on Collen's assertions that its mark connotes this laudatory meaning, the TTAB relied on substantial evidence in the record, much of which was submitted by Collen, including a dictionary definition of "brand name" meaning "one having a well-known and usually highly regarded or marketable name," as well as website evidence showing "brand name" used in a laudatory manner to describe professionals or

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<sup>2</sup> In its brief, Collen presents arguments only as to A BRAND NAME LAW FIRM for convenience purposes because "the arguments and evidence supporting registration are the same for both marks," but maintains the arguments apply equally to A BRAND NAME ADVISOR. Br. at 2, n. 1. The Director agrees and does the same.



companies. Collen does not challenge this substantial evidence supporting the TTAB's descriptiveness finding. Instead Collen merely argues that the TTAB should have found the second meaning of A BRAND NAME LAW FIRM to be suggestive of the services. Because Collen has failed to show the TTAB's finding of mere descriptiveness was unreasonable based on the evidence in the record, the TTAB's decision refusing registration under Section 2(e)(1) should be affirmed.

## V. ARGUMENT

### A. Standard of Review

Whether a proposed mark is merely descriptive is a question of fact which this Court reviews for substantial evidence. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001). Evidence is substantial if a "reasonable person might find that the evidentiary record supports the agency's conclusion." *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1085 (Fed. Cir. 2000). Just because there is a possibility of drawing two inconsistent conclusions from the evidence does not prevent the TTAB's finding from being supported by substantial evidence. *Id.* at 1086. Rather, where contradictory conclusions may reasonably be drawn from the evidence, the TTAB's decision to favor one conclusion over the other is the

type of finding that must be sustained as supported by substantial evidence.

*In re Bayer Aktiengesellschaft*, 488 F.3d 960, 970 (Fed. Cir. 2007).

**B. Substantial Evidence Supports the TTAB's Finding that A BRAND NAME LAW FIRM is Merely Descriptive of Collen's Legal Services, Whether Directly Describing Their Subject Matter or Laudatorily Describing Their Quality**

A term or phrase is merely descriptive and cannot be registered pursuant to Section 2(e)(1) if it immediately conveys information concerning a quality, feature, function, or characteristic of the applied-for goods or services. *Id.* at 963. A mark's descriptiveness is determined "in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use." *Id.* On the spectrum of distinctiveness, the dividing line between merely descriptive and suggestive is a fine one that turns on whether imagination, thought, or perception is required to reach a conclusion on the nature of the services. *See In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987) (internal citations omitted). If no exercise of imagination is required, the proposed mark falls on the descriptive side of the spectrum of distinctiveness. *Id.*

Laudatory words or phrases, that is, words or phrases which attribute merit or superiority to the goods or services, are regarded as merely

descriptive because “they simply describe the characteristics or quality of the goods in a condensed form.” *Nett Designs*, 236 F.3d at 1341 (THE ULTIMATE BIKE RACK found merely descriptive in a laudatory sense as touting the superiority of the applicant’s bike racks despite the term “ultimate” possessing some suggestive qualities); *In re Boston Beer Co.*, 198 F.3d 1370, 1373 (Fed. Cir. 1999) (finding BEST BEER IN AMERICA laudatory); *see also Palm Bay Imps. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1372-73 (Fed. Cir. 2005) (finding ROYALE to be laudatory and therefore non-source identifying); *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1360 (Fed. Cir. 2001) (finding NUMBER ONE IN FLOORCARE to be a generally laudatory phrase that is not inherently distinctive); *In re Duvernoy & Sons, Inc.*, 212 F.2d 202, 204 (CCPA 1954) (finding CONSISTENTLY SUPERIOR to be a laudatory statement used to indicate that applicant’s goods are always superior in quality); *and Burmel Handkerchief Corp. v. Cluett, Peabody & Co.*, 127 F.2d 318, 320 (CCPA 1942) (finding HANDKERCHIEFS OF THE YEAR to be a laudatory descriptive phrase).

The TTAB applied these settled principles in analyzing A BRAND NAME LAW FIRM and correctly concluded, based on substantial evidence, that the proposed mark is merely descriptive under Section 2(e)(1).

**1. Collen Does Not Dispute that the First of the Two Meanings of A BRAND NAME LAW FIRM is Merely Descriptive Because it Directly Informs Consumers that Collen is a Law Firm Specializing in Brand Names or Trademark Law**

On appeal, Collen does not challenge the TTAB's finding that one meaning of A BRAND NAME LAW FIRM is merely descriptive. Br. at 7.

As Collen acknowledges:

[O]ne meaning of [Collen]'s mark is that the Appellant provides legal services and counseling regarding trademarks (*i.e.*, brands) (A329). Accordingly, this meaning of the mark can be said to be descriptive of the type of legal services performed by [Collen].

Br. at 7. Thus, the TTAB's finding on this point is not in dispute.

**2. Substantial Evidence Supports the Board's Finding that the Second Meaning of A BRAND NAME LAW FIRM is Descriptive Because it Immediately Conveys the Notion that the Services are Highly Regarded or Well Known**

The TTAB correctly found that "A BRAND NAME LAW FIRM, when used in connection with legal services, has not only the meaning of a law firm that specializes in brand name or trademark law, but a law firm that is known or has a good reputation." A12, *see also* A14. Because whichever meaning a consumer would ascribe to A BRAND NAME LAW FIRM is merely descriptive of the services, the proposed mark is unregistrable on the Principal Register without evidence of acquired distinctiveness.

The TTAB based its finding on substantial evidence<sup>3</sup> in the record, including dictionary evidence put into the record by Collen and the Examining Attorney defining “brand name” as also meaning:

- one having a well-known and usually highly regarded or marketable name. A8, citing A376, A457 (from *Merriam-Webster* online dictionary);
- a person who is notable or famous, esp. in a particular field: *The reception was replete with brand names from politics and the arts.* A8 n.5, citing A376, A455 (from dictionary.infoplease.com, based on *Random House Unabridged Dictionary* (1997)).
- [w]idely familiar; well-known: *Several brand-name personalities will be performing at the benefit.* A8 n. 5, citing A347-348, A455 (from Dictionary.com, based on *Random House Dictionary* (2009));

The TTAB also pointed to Collen’s evidence consisting of news articles and website printouts using “brand name” in the manner indicated by these dictionary definitions. A9-10. The TTAB highlighted several excerpts referring to various service providers, such as companies, actors, doctors, and politicians, as “brand name,” including:

- An article published in *The New York Times* about Berkshire Hathaway entitled “**Berkshire Is Still a Brand Name.**” A389 (emphasis added);

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<sup>3</sup> Evidence of descriptiveness may come from “any competent source,” including dictionaries, websites, newspapers, and other publications. *Bayer*, 488 F.3d at 964 (internal citations omitted).

- An article from *BusinessWeek* about the low-budget horror movie “Cloverfield” noting that “there isn’t a **brand-name actor** in the young, good-looking crew.” A419 (emphasis added);
- A theater review from the *Los Angeles Times* stating that “your only **brand-name actor** is Stacy Keach.” A433 (emphasis added);
- An entry on the website <http://help4hips.com> about “Seattle FAI arthroscopy surgeons” stating that “I found no fault in the other two Seattle surgeons, but after meeting Dr. Johnston I was quite confident that I didn’t need to spend \$7,500 for a **brand-name surgeon** to fix my hip.” A432 (emphasis added).
- An article from the Pharmacy Alumni Association Alumni Voice entitled “**He’s a Brand Name**: Mike Winter,” describing him as known “around the world” as author of a textbook, a “top-notch teacher,” and an “exceptional clinician.” A515 (emphasis added).
- An article from “Prime Buzz” on [KansasCity.com](http://KansasCity.com) entitled “Aggressive newcomer Hayden vs. **brand-name politician** Toplikar” describing “a newly minted politician locked in a scrappy, yet low-profile campaign to unseat a veteran county commissioner with high name recognition.” A381 (emphasis added).

As Collen conceded to the TTAB, these news excerpts evidence “the common understanding of the term ‘BRAND NAME’” as meaning that “one is notable or famous in a particular field.” A538-539. The TTAB agreed, explaining it was finding A BRAND NAME LAW FIRM to have a second laudatory descriptive meaning “because of the evidence that ‘brand name’ is used in a laudatory manner to describe people or companies recognized in

their respective fields.” A14; *see also* A12 (noting that Collen’s evidence shows the term “would be immediately understood as having the same meaning when applied to a law firm, i.e., that the law firm itself has a notable reputation, or is highly regarded or well known”).

In addition, the TTAB noted Collen’s assertions in its responses to Office actions and its brief to the Board that A BRAND NAME LAW FIRM means “that a firm is well-known” (A9, citing A360), a “household name law firm” or “a first-rate law firm” (A12, citing A363, A544). These statements “reflect [Collen’s] recognition that this meaning of the mark is laudatory” and thus descriptive. A13.

Based on the evidence and Collen’s statements, the TTAB found that the second meaning conveyed by A BRAND NAME LAW FIRM is also descriptive because it immediately conveys “that the law firm is well known or highly regarded.” A14; *see also* A12. Like other laudatory phrases, A BRAND NAME LAW FIRM “simply describe[s] the characteristics or quality of the [services] in a condensed form,” and therefore is merely descriptive under Section 2(e)(1). *Nett Designs*, 236 F.3d at 1341.

**3. Collen Concedes that the Second Meaning of A BRAND NAME LAW FIRM Immediately Conveys a “Desirable Characteristic of the Quality or Renown of the Law Firm’s Services.”**

Collen does not mention any of the admissions and evidence relied on by the TTAB to support its finding that the second meaning of A BRAND NAME LAW FIRM describes the renown or reputation of the law firm. That is because Collen actually agrees not only that “brand name” generally connotes the quality or renown of goods, services, or their source, but also that the term *immediately* creates that connotation—even in the specific context of law firm services. It is useful to compare Collen’s concession with this Court’s standard for descriptiveness:

Descriptiveness Standard	Collen’s Concession
“immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used” ( <i>Chamber of Commerce</i> , 675 F.3d at 1300 (citation omitted)).	“conveys an immediate, yet vague desirable characteristic of the quality or renown of the law firm’s services” (Br. at 10.)

The only point of contention in this case is Collen’s insistence that it is unusual for a law firm to use this admittedly laudatory phrase, thus rendering the phrase suggestive. In Collen’s view, although “‘Brand Name’ creates an immediate impression, particularly in the context of consumer goods (*e.g.*, ‘brand name jeans’ or ‘brand name shoes’) this is not a phrase



that is associated with law firms” and instead “falls starkly outside [the] universe of common language adjectives used to describe the quality of law firm’s services.” Br. at 9-10; *see also id.* at 8 (“[c]alling a firm a ‘brand name law firm’ may ultimately conjure up the idea of being known, but it requires some imagination to reach that meaning”). In addition to lacking evidentiary support, Collen’s arguments fail to demonstrate any error in the TTAB’s fact finding that A BRAND NAME LAW FIRM is merely descriptive.

**4. That Collen May be the First Law Firm to Use this Admittedly Laudatory Phrase Does not Make the Phrase Vague or Suggestive.**

Collen’s argument that the desirable characteristic immediately conveyed by A BRAND NAME LAW FIRM is too “vague” is at odds with the simple, clear dictionary definition Collen submitted for “brand name”: “one having a well-known and usually highly regarded or marketable name.” A8. Moreover, even if “brand name” could be considered vague in the abstract, that is not the test for descriptiveness, and Collen has not applied to register BRAND NAME standing alone but rather A BRAND NAME LAW FIRM.

This Court’s decision in *Nett Designs*—where the Court affirmed the TTAB’s finding that the combination of the laudatory term “ULTIMATE”

with the generic name for the goods “BIKE RACK” rendered THE ULTIMATE BIKE RACK as a whole a laudatory descriptive phrase, 236 F.3d at 1340-41—is instructive. Dictionary definitions of the word “ultimate” supported the finding that THE ULTIMATE BIKE RACK as a whole was a laudatory phrase that touted the superiority of the bike racks. *Id.* Although the Court recognized that the word “ultimate” standing alone had some elements of suggestiveness, when properly viewed as a whole and in connection with the bicycle rack goods at issue in the case, THE ULTIMATE BIKE RACK immediately described the purported merit of the goods. *Id.* So too, here, when A BRAND NAME LAW FIRM is properly viewed as a whole in relation to legal services, and in view of the evidence that “brand name” is used to refer to highly regarded professionals and companies, it immediately conveys that the services are rendered by a law firm that purports to be well known or highly regarded. A14.

Similarly unavailing is Collen’s argument that A BRAND NAME LAW FIRM is suggestive because the record does not include evidence of other law firms using “brand name” in a laudatory descriptive manner. Even if Collen were the first to use “brand name” in connection with legal services, this would not lessen the descriptive character of the words. The law has been settled for decades that the first or only party to use a

descriptive phrase is not thereby given the reward of being able to remove it from the commercial lexicon. *See, e.g., In re Bailey Meter Co.*, 102 F.2d 843, 844 (CCPA 1939) (“The fact that appellant may have been the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive . . . .”); *In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476 (TTAB 2006) (“a word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods, does not imbue the term with source-identifying significance”); *In re Eden Foods Inc.*, 24 USPQ2d 1757, 1761 (TTAB 1992) (same principle applies to a laudatory descriptive phrase); *In re G.D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff’d*, 360 F.2d 650 (CCPA 1966); *cf. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (trademark law embodies the principle that it is undesirable to “allow[] anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first”) (citation omitted).

Collen’s argument also ignores the numerous examples it put in the record of “brand name” used in a laudatory manner to describe the quality or renown of a wide variety of service providers, such as companies, doctors, politicians, and entertainers. *See* A9-10, citing passages from A381-446.

The TTAB properly relied on this evidence as showing that consumers would immediately understand “brand name” to have “the same meaning when applied to a law firm, i.e., that the law firm itself has a notable reputation, or is highly regarded or well known.” A12; *see also* A14.

Collen’s argument that the term “brand name” takes on a different meaning in connection with legal services than its admitted laudatory descriptive meaning for consumer goods, simply because other more common adjectives exist to describe the quality of legal services, fails for similar reasons. The existence of “well-known” and other laudatory adjectives does not lessen the laudatory nature of the phrase “brand name” or preclude A BRAND NAME LAW FIRM from being found descriptive of the caliber or renown of Collen’s services. *See In re Sun Oil Co.*, 426 F.2d 401, 404 (CCPA 1970) (Rich, J. concurring); *In re Walker Mfg. Co.*, 359 F.2d 474, 476 (CCPA 1966).

**5. Third Party Registrations Containing the Term BRAND NAME[S] in Other Contexts Are Immaterial to the Specific Factual Context Presented in This Case**

Collen’s argument regarding third-party registrations containing the term “brand name” fares no better. A14-15, citing A162-183. The TTAB considered that evidence and found that it fails to demonstrate that A BRAND NAME LAW FIRM is not descriptive. A14-15. As the TTAB

explained, unlike A BRAND NAME LAW FIRM, which as a whole is merely descriptive, “the marks in the third-party registrations include non-descriptive material, so that the entire marks are not merely descriptive.”

A15. In addition, the TTAB noted that the marks in the third-party registrations are slogans, which the USPTO’s Trademark Manual of Examining Procedure (“TMEP”) instructs should be considered as unitary, meaning that they should not be broken up for purposes of requiring a disclaimer of the term BRAND NAME(S). A15, citing TMEP § 1213.05(b). Moreover, each case must be decided on its own merits. Thus, even if the USPTO had allowed other marks with similar characteristics to be registered, such action would not bind the TTAB or this Court to register Collen’s proposed mark. *See, e.g., Nett Designs*, 236 F.3d at 1342.

**C. The TTAB Did not Express any Doubt in Finding A BRAND NAME LAW FIRM Merely Descriptive**

Collen closes its brief by noting that any doubt about whether A BRAND NAME LAW FIRM is merely descriptive should be resolved in its favor. Br. at 11. But the TTAB did not express any doubt in finding that A BRAND NAME LAW FIRM merely describes the applied-for services. As the Court has previously held, “[w]ithout any indication by the Board that it entertained any doubt, the rule of resolving doubt in favor of the applicant

does not apply.” *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1336 (Fed. Cir. 2003).

**D. A Descriptive Term Does not Become Distinctive Simply Because it has More than One Meaning**

In a footnote at the end of its brief, Collen invites the Court to make new law holding that anytime a mark has two meanings, it qualifies for registration, even if both meanings are merely descriptive of the applied-for goods or services. Br. at 12 n.3. The Court should decline this invitation.

The statute prohibits registration of a mark that is merely descriptive of applied-for goods or services unless the applicant proves that the mark has acquired distinctiveness. *See* 15 U. S. C. §§ 1052(e), (f). The statutory prohibition exists to ensure that terms which do not perform the function of distinguishing a particular provider’s goods or services from those of others remain in the public domain for competitors to use to describe the qualities or characteristics of their own goods or services. *See, e.g., Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543-44 (1920) (“[T]he function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with

equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public.”) (citations omitted).

Collen’s proposed new rule of law plainly contravenes the well-settled principle embodied in the statute. It also contravenes longstanding precedent of this Court and the TTAB interpreting Section 2(e)(1), as well as the examination guidance set forth since 1993 in the Trademark Manual of Examining Procedure based on this case law, all of which permit an exception to Section 2(e)(1)’s prohibition for double entendre marks only where one of the mark’s meanings is not merely descriptive. *See e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 553 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products, despite the fact that sugar and spice are descriptive of ingredients in the products, because the mark creates a non-descriptive association with the well-known nursery rhyme “sugar and spice and everything nice”); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1067-68 (TTAB 2008) (THE FARMACY not merely descriptive of retail store services featuring herbs and organic products because consumers are likely to perceive the mark as a play on the “farm-fresh characteristics” of the products and not simply as a misspelling of “the pharmacy”); *In re Del. Punch Co.*, 186 USPQ 63, 63-64 (TTAB 1975) (THE SOFT PUNCH not merely descriptive of noncarbonated soft drink because it projects a

double entendre of a soft impact or “pleasing hit,” as well as a non-alcoholic drink); *In re Nat’l Tea Co.*, 144 USPQ 286, 286-287 (TTAB 1965) (NO BONES ABOUT IT not merely descriptive of fresh pre-cooked ham because the phrase used in the mark connotes a double connotation of more than simply a boneless product); *see generally* TMEP § 1213.05(c) (“If all meanings of a ‘double entendre’ are merely descriptive in relation to the goods, then the mark comprising the ‘double entendre’ must be refused registration as merely descriptive.”).

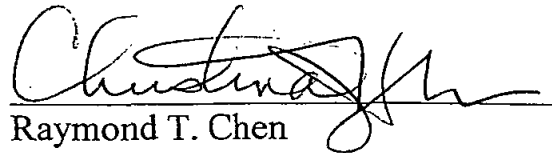
The record establishes that any meaning a consumer might ascribe to the proposed mark A BRAND NAME LAW FIRM is merely descriptive. Therefore, the refusal of registration under Section 2(e)(1) is proper and should be affirmed.



## VI. CONCLUSION

Given the substantial evidence supporting the descriptiveness refusal, the TTAB's decision should be affirmed.

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that on May 21, 2012, I caused two copies of the foregoing BRIEF FOR APPELLEE – DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be served via U.S. mail (first-class, postage prepaid) upon the following:

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