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REPLY BRIEF

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

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In The
United States Court of Appeals
For The Federal Circuit

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
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IN RE COLLEN IP INTELLECTUAL PROPERTY LAW, P.C.

APPEAL FROM THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
TRADEMARK TRIAL AND APPEAL BOARD.

REPLY BRIEF OF APPELLANT

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A. The Second Meaning of Appellant's Mark is Not Descriptive

Appellant's trademark A BRAND NAME LAW FIRM[1] is a creative turn of phrase which consumers immediately recognize as a play on words. The trademark both identifies some of the services offered by Appellant, and also suggests, in a very general tongue-in-cheek manner, some desirable attributes of Appellant's services. The Trademark Office initially refused the application because the Examining Attorney claimed not to recognize any play on words. The Trademark Trial and Appeal Board fully understood the double entendre. The Board has also refused registration but now with completely opposite findings. While the Examining Attorney could find no second meaning of Appellant's mark, the Board found the second meaning so readily apparent and direct that it was merely laudatory and descriptive.

The Board erred because the term BRAND NAME is not a direct, common-language description of the quality of the Appellant's services. *Rexel, Inc. v. Rexel Int'l. Trading, Corp.*, 540 F. Supp. 2d 1154, 1165 (C.D. Cal. 2008) (*citing*, 2

[1] This Appeal is of a single decision of the TTAB that jointly refused registration of the marks: (1) A BRAND NAME LAW FIRM; and (2) A BRAND NAME ADVISOR. Appellant filed two notices of appeal – one for each application. On February 22, 2012, this Court granted Appellant's uncontested motion to consolidate the appeals. Because Appellant maintains that the arguments and evidence supporting registration are the same for both marks, Appellant, for convenience purposes, will present arguments with regard to the mark A BRAND NAME LAW FIRM, and maintains that these arguments apply equally towards the mark A BRAND NAME ADVISOR.

McCarthy on Trademarks and Unfair Competition § 11:17 (4th ed. 2012)) ("laudatory marks involve a very direct, common language description of a product or service's purported quality"). While BRAND NAME suggests certain characteristics of a law firm's services, the Board erred in finding that BRAND NAME is a direct, common language term immediately recognized to describe a law firm's qualities.

The record contains no evidence that BRAND NAME is a direct, common-language term used to describe the characteristics of a law firm. Absent any evidence in the record, the Director now argues that Appellant has admitted that the second meaning of A BRAND NAME LAW FIRM *immediately* conveys a desirable characteristic of a law firm's services. Appellee's Br. at 16 (emphasis added). The Director misapprehends Appellant's argument. Appellant concedes that a consumer will immediately recognize that Appellant's mark is a double entendre. But when used in connection with the offering of legal services, BRAND NAME requires thought, imagination or perception to understand that the term is suggesting a firm that is widely known, highly regarded, or has some other characteristic (other than being a trademark firm).

Contrary to the Director's arguments, Appellant has never taken the position that the second meaning of A BRAND NAME LAW FIRM is descriptive. Appellant has consistently argued just the opposite:

> The term 'Brand Name' is not a direct, common-language description of the quality of the Appellant's legal services. . . . This is because 'brand name" may have an immediate meaning with regard to consumer products (e.g. "brand name jeans"), but requires some additional thought when used in a different context, such as in connection with the offering of legal services. Appellant's Br. at 5-6.

The record in this case has evidence that the term BRAND NAME has many different meanings, among them "widely known" and "highly regarded." Even these two meanings can have very different connotations, as a firm can be widely known and not highly regarded, or vice versa. The momentary pause a consumer must make before understanding how numerous different possible meanings may apply to a law firm, precludes a finding that the mark is merely descriptive. *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988).

The Director concedes that "[a] mark's descriptiveness is determined 'in relation to the particular [services] 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 [services] because of the manner of its use or intended use." Appellee's Br. at 10 (*quoting*, *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007). For this exact reason, the Board's reliance on a dictionary definition is insufficient, because although there is evidence that in some contexts (such as consumer goods) BRAND NAME could mean widely known or highly regarded, the Director has no evidence that BRAND NAME is laudatory and descriptive for a law firm and its services.

B. The Record Demonstrates that the Alternative Meanings of BRAND NAME are Suggestive for Legal Services

The burden is initially on the PTO to make a prima facie showing that the mark in question is descriptive from the vantage point of purchasers of Appellant's services. *In re Diamond Pac. Tool Corp.*, 1997 U.S. App. LEXIS 10722 (Fed. Cir. 1997). The Trademark Office's refusal of this mark was not supported by a single sheet of evidence regarding the "second" meaning of BRAND NAME for any services. Hence the Trademark Office could not possibly have met this burden.

A "term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the United States*, 675 F.3d 1297, 1300 (Fed. Cir. 2012). Whether "a mark is descriptive cannot be determined in the abstract." *Id.* Descriptiveness "must be evaluated in relation to the particular [services] 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 [services] because of the manner of its use or intended use." *Id.*

Absent from the record is any evidence that the term BRAND NAME has ever been used to describe the qualities, characteristics or attributes of a law firm. In fact, other than submitting evidence that the words BRAND NAME, when used in connection with a law firm, means a firm that practices in trademark law, the Examining Attorney included no evidence of other meanings of BRAND NAME

for any services. Instead, the record on this point comprises solely of evidence submitted by Appellant. This evidence presents use of BRAND NAME in other contexts, such as in connection with actors, doctors and politicians. Applying these examples to the services at issue in this appeal, namely legal services, supports a finding that use of BRAND NAME is only suggestive for a law firm.

For example, Appellant identified certain uses of BRAND NAME in connection with certain actors. In the following two examples, BRAND NAME can be argued to suggest different meanings. One is that the actor is well-known. But another suggests many other possible characteristics of an actor, such as a highly paid, well-experienced, over-exposed, or well-trained. The fact that in the first example, "brand name" immediately follows the adjective "well known" signals that "brand name" is being used to say something other than just repeating "well known:"

- The article goes on to reference more of the TrekMovie report, saying that the studio is "looking for well known **brand name** actor (especially one who will help the film play in foreign markets). This fits with the report that there is interest in Russell Crowe for the part. A140.

- It takes nerve to come to Broadway with a two-part, six-hour epic about 200 years in the history of a piece of land. And the land's not even Manhattan, and your only **brand-name** actor is Stacy Keach, who couldn't keep his own show open a month on Broadway last year. A148.

In the following example, also in the context of an actor, the phrase brand-name is clearly being used for some purpose other than well-known or highly regarded. The article draws a distinction between actors Arnold Schwartzenegger and Meryl Streep – both well-known actors. Yet, in this example, "brand name" seems to refer to "ready-made associations" an actor may have to a particular role – something associated in the context with Schwatzenegger, but not Streep.

- [M]arketing strategies are still geared to **brand name-it is**, an alternative version of summertime's dread sequel disease. The reason this doesn't work for Ms. Streep is that she isn't, like Mr. Schwartzenegger, someone whose very being conjures up a whole set of ready-made associations. In other words, she's an actress, not a product. And the same can be said for Mr. DeNiro or Mr. Hoffman or Mr. Connery or any other of the screen's truly distinguished stars. They are performers who change from role to role, whose presence is shaped and altered by the contexts in which they appear and whose work is filled with those very surprises that many contemporary moviegoers work so hard to resist. . . . .The craziest way to sell any film, at a time when **brand-name** recognition so thoroughly dominates, is to take the familiar qualities of a famous movie star and actively throw them away. A118-119

The following example uses "brand name" to suggest an actor who is highly paid. While the price paid suggests the qualifications or notoriety of the actor, it still leaves some meaning to the imagination:

- So how do you produce a film that stars a six-story, tall-slashing monster for less than $50 million, while throwing in crumbling bridges, collapsing skyscrapers, and even some fierce man-eating insects the size of large dogs? Well, you start with the fact that there isn't a **brand-name** actor in the young, good-looking crew. By contrast, Will Smith got $20 million and a big piece of the profits for "I am Legend." A134.

Appellant also provided examples of how brand name is used in the context of politicians. In one example, the phrase brand name is used to suggest the politician is well-known:

- Aggressive Newcomer Hayden vs. **Brand-Name** Politician Toplikar [A] newly minted politician locked in a scrappy, yet low-profile campaign to unseat a veteran county commissioner with high name recognition. . . . Oven time Toplikar's political profile has remained constant. A96-97

However, in this second example the term "brand-name" suggests something more than simply a well-known politician. Here, the article states that Hillary Clinton is a brand name politician. But for some reason, not immediately conveyed, it says former Presidential candidate John McCain is not a brand name politician. Requiring even a little more thought, this leaves open the question of whether Barack Obama is a brand name politician. In this example, it should also not go unnoticed that reference to "brand name" is intended to carry a negative connotation.

- I support Obama because I am prepared to take a big risk that he can stand his ground that we can have a real President, not a **brand-name** politician acting as President. Hillary is **brand-name** to the nth. McCain is emphatically not **brand-name**, and my hope is Obama won't be either. A229.

Another example derived from politics, describes former Vice Presidential candidate, Sarah Palin as a brand name politician. While the article's use of brand

name suggests positive attributes about Ms. Palin, some imagination and thought is needed to identify those attributes:

- GOP Base Still Wild About Palin

  Despite a torrent of criticism from the media, Democrats and even some in her own party, Sarah Palin remains the hottest **brand name** in politics. . . . [S]he remains extremely popular with the GOP grass roots, and most Republican Party leaders would jump at the chance to have her headline on of their events. . . . Republicans at the grass-roots level and their leaders still hold a very favorable impression of the former Alaska governor. Westerners have a particular affinity for Palin, with many noting she embodied the values of freedom and self-reliance. . . . People saw her as one of them – someone who could relate to any everyday person. She's not one of the political class. . . . The people I talk to that like her say she relates to them because they don't really look at her as a politician in Washington. A233-234.

Other examples made of record by Appellant include use of "brand name" in the context of other professionals, including surgeons. Here too the phrase "brand name" suggests some attributes of the surgeon, but the precise meaning requires some thought, imagination and perception to understand what is being said. For example, for a surgeon, brand name may suggest well-known or highly regarded. But it also may suggest expensive, over-priced, unavailable, highly-trained, experienced, or well-entrenched in the industry:

- I had no fault with 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. I was even able to schedule a surgery within 2 weeks of my first office visit. A147.

- How much does it cost? This is highly variable according to local norms, rates, and surgeon's reputation (name recognition and **brand name**). A138.

Another example involves an author and a pharmacist. This usage suggests many things about the pharmacist, including, among others, that he is highly-regarded, and well known, but also that he is a leader, mentor and advisor.

- He's A **Brand Name**: Mike Winter
  Pharmacists around the world know him as author of the very popular textbook *Basic Clinical Pharmacokinetics*, soon to be in its fifth edition and published in English, Spanish and Japanese. At the UCSF School of Pharmacy students know him not only as author, but also as top-notch teacher. His colleagues know him as leader, mentor, advisor and citizen. Patients and physicians at the UCSF Medical Center know him as an exceptional clinician. A230.

Finally, Appellant submitted an article regarding the company called Berkshire Hathaway, controlled by famous investor Warren Buffet. This article perhaps offers the best example of how "brand name" is only suggestive. Appellant concedes that "brand name" is being used in this article to suggest some positive attribute about the Berkshire Hathaway company. But without thought, imagination and perception, it is not possible to figure out from its heading "Berkshire Is Still a Brand Name" what that message is. The headline suggests that the company still carries some caché and is still a desirable company with which to be affiliated – but there is certainly no direct and immediate descriptive and laudatory meaning to "brand name" in this context:

- Berkshire Is Still a **Brand Name**
  Although Mr. Buffett's chosen successors' identities remain undisclosed, it's a safe bet they know what they are doing. But they aren't Mr. Buffet. Moreover, the leadership of Berkshire and the management of its investments will be separated, requiring some adaptation. The culture that brings 30,000-odd shareholders to Omaha every year will unavoidably change, too. Another important Buffett decision of late has been to expose Berkshire to big derivatives bets - $67 billion worth in terms of the worst-case exposure at the end of 2008. Despite having once called such instruments "financial weapons of destruction," he appears to think they are safe enough in his hands. A104

As reflected above, the term BRAND NAME is used in many contexts, suggesting several different meanings, and demanding thought, imagination and perception to understand how these definitions may apply to a particular situation. In different contexts, it may have different meanings. The record is devoid of uses in this context for a law firm, leading only to pure speculation. It is well established that vague terms that have several meanings, more than one of which could relate to the identified goods and services require a mental pause and thought that renders the terms suggestive rather than merely descriptive. *See*, *In re IdaTech, LLC*, 224 TTAB LEXIS 259 (T.T.A.B. 2004)(non-precedential)(*citing*, *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988). Likewise, when a mark connotes "a vague desirable characteristic or quality allegedly connected with the [service]" it is not merely descriptive of the services. *In re Ralson Purina Co.*, 1976 WL 20897, 191 U.S.P.Q. 237 (T.T.A.B. 1976) (finding SUPER suggestive for slush drinks); *In re Kellogg N. Am. Co.*, 2008 TTAB LEXIS 324, 23-24

(T.T.A.B. 2008) (non-precedential) (finding CRAZY GOOD suggestive for toaster pastries, recognizing it is "in essence hyperbole or similar aggrandizement" rather than "a merely descriptive term"). If terms such as SUPER and CRAZY GOOD, have been found not descriptive or laudatory in connection with beverages and breakfast pastries, it would be erroneous, under this record to conclude that BRAND NAME is laudatory for a law firm.

In this case, the term BRAND NAME when used with a law firm is not merely descriptive. Some thought, imagination and perception is needed to appreciate the meaning.

C. The Examining Attorney's Own Failure to Recognize the Second Meaning, Evidences that the Mark is Suggestive

During examination of the application, Appellant argued that A BRAND NAME LAW FIRM is a double entendre. Because BRAND NAME is an unconventional and awkward way to refer to a law firm[2], consumers will recognize this mark as a tongue-in-cheek reference to a law firm that works with trademarks, and will also recognize it has a second intended meaning. Appellant argued that consumers will recognize the intended play on words to also suggest other, informal, connotations of BRAND NAME, such as, but not limited to, widely known, notable, a household name or well regarded. The Examining Attorney

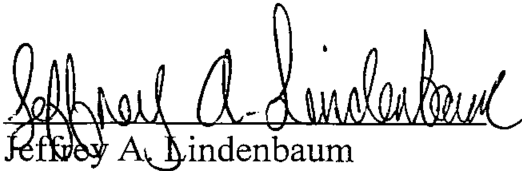
[2] Even for this first meaning, BRAND NAME is not used in the profession. Common terms in the field include: "a trademark firm" or an "intellectual property law firm."

rejected this argument, finding that consumers will only recognize A BRAND NAME LAW FIRM as referring to a trademark firm, and flatly rejected the notion that consumers could perceive A BRAND NAME LAW FIRM to mean a firm that is widely known or highly regarded.

In this appeal, the Trademark Office has reversed its position. The Trademark Office has quietly abandoned its earlier argument that consumers will not be able to even recognize that the term A BRAND NAME LAW FIRM, for legal services, could even suggest "a widely known or highly regarded firm. The Trademark Office now submits that not only will consumers draw this connection, but they will do so immediately, without any thought, imagination or perception. These very contrasting positions cannot be reconciled. If after carefully analyzing (with much thought, imagination and perception) the arguments and evidence of the second meaning of A BRAND NAME LAW FIRM, the Trademark Office failed to recognize this meaning, it cannot possibly justify its new position that this meaning will be directly and immediately recognized, even without any thought, imagination or perception.

Because the second meaning of the marks A BRAND NAME LAW FIRM and A BRAND NAME ADVISOR are suggestive and not merely descriptive, the Board erred in affirming the refusal of registration. The Board's decision should be REVERSED and the applications should be allowed to proceed to publication.

Respectfully submitted,



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CERTIFICATE OF FILING AND SERVICE

I hereby certify that on this 8th day of June, 2012, two bound copies of the Reply Brief of the Appellant were served via U.S. Mail, postage pre-paid, to the following:

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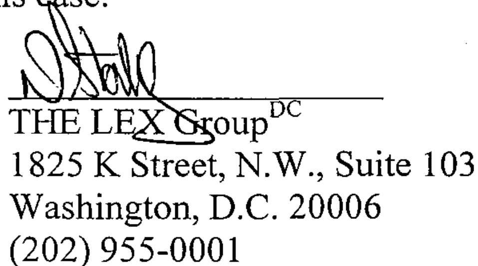
I further certify that on 8th day of June, 2012, the required number of copies of the Reply Brief of Appellant were hand filed at the Office of the Clerk, United States Court of Appeals for the Federal Circuit.

The necessary filing and service were performed in accordance with the instructions given me by counsel in this case.



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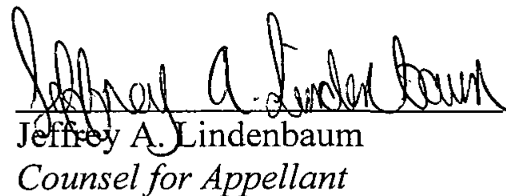

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DECLARATION OF AUTHORITY
PURSUANT TO FED. CIR. R. 47.3(d)

I, Danielle Staley, hereby declare under penalty of perjury that I am duly authorized to sign on behalf of Counsel for Appellant, Jeffrey A. Lindenbaum, as he is unavailable to do so himself.

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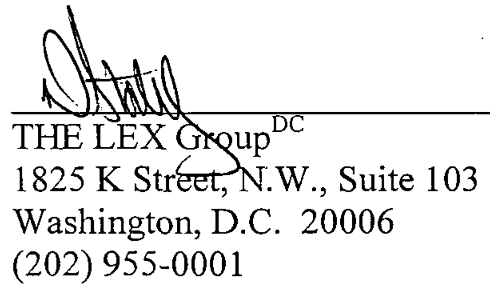

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