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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Donald S. Dowden

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Serial No. 75716024

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Donald S. Dowden of Cooper & Dunham LLP for Donald S. Dowden.

Stephanie M. Davis, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Seeherman, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Donald S. Dowden, a U.S. citizen, has appealed from the final refusal of the Trademark Examining Attorney to register FEDERAL LAW PUBLISHING as a mark for services ultimately identified as "publication of newsletters featuring information on intellectual property law."<sup>1</sup>

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<sup>1</sup> Application Serial No. 75716024, filed May 27, 1999, and asserting a bona fide intention to use the mark in commerce. The services were originally identified as "services related to promoting the distribution of newsletters discussing intellectual property law," then amended to "services related to promoting, through advertising, direct mail, the Internet and the leasing of

Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of his identified services.<sup>2</sup>

Applicant and the Examining Attorney filed briefs.<sup>3</sup> Applicant did not submit a reply brief, nor did it request an oral hearing. With his brief, applicant submitted a copy of a third-party registration for LAW AND ORDER. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed after the appeal is filed. Because the evidence submitted with

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customer data bases, the distribution of newsletters discussing intellectual property law," and then to "services related to promoting, through advertising, direct mail, the Internet, and the distribution of newsletters discussing intellectual property law." After applicant filed its appeal brief, the Examining Attorney requested and was granted a remand of the application in order to obtain an acceptable identification of services, and it was at this point that applicant amended the identification to that which we have indicated above.

<sup>2</sup> In the final Office action the Examining Attorney also maintained a refusal of registration on the ground of likelihood of confusion, citing Registration No. 682920 for FEDERAL PUBLICATIONS INC. and design for "periodical newsletter containing digests of government procurement information and a government contracts citator." However, in her appeal brief the Examining Attorney withdrew the refusal on this ground.

<sup>3</sup> As noted, the Examining Attorney requested remand of the application after applicant filed his appeal brief. When proceedings in the appeal were resumed, applicant was given an opportunity to file a supplemental appeal brief, but did not do so.

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applicant's brief is manifestly untimely, it has not been considered. The Examining Attorney has also submitted evidence with her brief, specifically, several definitions of "law." Although this evidence is also technically untimely, the Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We have considered the definition taken from an on-line version of a dictionary which is also in printed form, i.e., the Merriam-Webster Online Dictionary. However, those definitions which were taken from exclusively on-line dictionaries and encyclopedias have not been considered. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (when Examining Attorneys intend to rely on Internet evidence that otherwise would normally be subject to judicial notice (such as dictionary definitions), such evidence must be submitted prior to appeal).

We affirm the refusal of registration.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed.

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Cir. 1987). It does not have to describe every quality, characteristic, function, attribute or feature of a product or service; it is enough if it describes a single, significant quality, attribute, etc. In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985).

The Examining Attorney has pointed out that applicant, during the course of prosecution, offered a disclaimer of the words FEDERAL and PUBLISHING, and asserts that applicant has thereby acknowledged the descriptiveness of these words. (In offering the disclaimers, applicant stated, "It is respectfully submitted that these disclaimers avoid the refusal to register based on the allegedly merely descriptive nature of the mark as a whole." Response filed April 2, 2001.) Therefore, in her brief, the Examining Attorney has focused on the word LAW, asserting that this word is also descriptive, as it tells consumers the nature of the subject matter of applicant's newsletters, which are identified as featuring information on intellectual property law. The Examining Attorney also contends that these three descriptive words, when combined as the mark FEDERAL LAW PUBLISHING, do not result in a mark with a separate, nondescriptive meaning. Rather, they convey that applicant will publish information about a field of federal law.

In his brief, applicant's only argument as to why his mark should not be considered merely descriptive is a reference to a third-party registration for LAW AND ORDER for legal services, and the statement that if that mark is not merely descriptive, then applicant's mark should not be considered merely descriptive either. As noted earlier, this registration is not part of the record, but even if it were, the mark is distinguishable because it is unitary and a double entendre, LAW AND ORDER being a well-known phrase. Thus, the registration of LAW AND ORDER without a disclaimer of "law" does not show that the word "law" is not descriptive of such services; disclaimers of individual words are not required in such a situation.

We agree with the Examining Attorney that applicant's mark as a whole is merely descriptive of his identified services, "publication of newsletters featuring information on intellectual property law." The word PUBLISHING obviously describes publication services, while intellectual property law is a type of FEDERAL LAW. Thus, the combined term FEDERAL LAW PUBLISHING immediately conveys to consumers what applicant does, i.e., he publishes material on the topic of federal law. The fact that applicant's newsletters feature one aspect of federal law does not avoid a finding of mere descriptiveness.

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Simply because applicant has chosen to identify the subject matter of his newsletters more broadly does not mean that "federal law" does not describe newsletters featuring intellectual property law, any more than the designation "vegetable" would not describe peas. We also point out that, although the newsletters are identified as featuring information on intellectual property law, they are not limited to this subject matter.

Decision: The refusal of registration is affirmed.