

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: May 25, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Joyce Media, Inc.

Serial No. 76455256

Robert J. Schaap of Law Offices of Robert J. Schaap for
Joyce Media, Inc.

Amos T. Matthews, Trademark Examining Attorney, Law Office
117 (Loretta Beck, Managing Attorney).

Before Rogers, Kuhlke and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Joyce Media, Inc., has applied to register
on the Principal Register the mark LEGAL DESK in typed or
standard character form for the following services, as
amended:¹ "providing advisory notices to others of
governmentally required legal notices taken in newspapers,

¹ Applicant's subsequent amendment to the recitation of services,
filed after oral hearing, is discussed *infra*.

magazines, other printed publications and via the global computer network," in International Class 35.²

The examining attorney has required a disclaimer of the term "LEGAL," contending that it is merely descriptive of the recited services. When the requirement was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Applicant's request for an oral hearing was granted; and an oral hearing was held as scheduled on February 15, 2007.

Before determining the issue under appeal, some preliminary matters require our attention.

Amendment to Recitation of Services

In view of the discussion at oral hearing regarding the accuracy of the recitation of services in the involved application, applicant and the examining attorney agreed to further amend the recitation as follows: "providing assistance to others in achieving governmentally required legal notices through newspapers and the global computer network," in International Class 35. Inasmuch as the proffered amendment clarifies the services as previously recited, it is approved and will be entered in due course.

² Application Serial No. 76455256 was filed on September 25, 2002, based upon applicant's assertion of April 1992 as the date of first use of the mark anywhere and in commerce.

See Trademark Rule 2.71(a), 37 C.F.R. §2.71(a). See also TMEP§ 1402.06 (4th ed., April 2005).

Evidentiary Matters

During the prosecution of this application, applicant submitted the declaration of Ms. Crystal Flores, a clerk in the office of applicant's attorney. In her declaration, Ms. Flores asserted that she was requested by applicant's counsel to conduct "a very brief telephone survey, by calling several well-known newspapers and ask for the 'legal desk'" (December 20, 2005 declaration of Crystal Flores, p. 1-2). Ms. Flores then related the responses of five national newspapers to her inquiries. In his subsequent Office action the examining attorney objected to the survey on various grounds. However, in his brief on appeal the examining attorney indicated that he "has considered the survey presented by the applicant but does not find it persuasive" (brief, unnumbered p. 8). In view thereof, applicant's request in its brief that its survey "be entered" is moot, and we have considered the survey along with the other evidence of record for its probative value in determining the issue before us.

Disclaimer

We turn then to the issue on appeal; namely, whether applicant must disclaim LEGAL apart from the mark as shown in order to obtain registration.

The examining attorney may require applicant to disclaim an unregistrable component of a mark otherwise registrable. See Section 6 of the Trademark Act, 15 U.S.C. §1056. Merely descriptive terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore may be subject to disclaimer apart from a mark otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services

in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). On the other hand, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services, the mark is suggestive and registrable. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); and *In re Gyulay, supra*.

It has long been acknowledged that there is a thin line between terms that are merely descriptive and those that are suggestive. See *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

The burden is initially on the United States Patent and Trademark Office to make a prima facie showing that the term or word in question would be considered descriptive by purchasers of applicant's goods or services and, where doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the applicant. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

In support of the refusal, the examining attorney has made of record the following definition of "legal:"

Of, relating to, or concerned with law: *legal papers*.
Authorized by or based on law: *a legal right*.
Established by law; statutory: *the legal owner*.
In conformity with or permitted by law: *legal business operations*.³

The examining attorney further has made of record the following definition of "legal notice:"

Such notice as is adequate in point of law; notice as the law requires to be given for the specific purpose or in the particular case. Such legal notice is typically required to be published a specific number of times in a legal and/or general circulation newspaper.⁴

In addition, the examining attorney made of record excerpts of articles from the Lexis/Nexis computer database.

³ The examining attorney relies upon www.answers.com for this definition.

⁴ The examining attorney relies upon Black's Law Dictionary, 6th Edition (1990) for this definition.

Samples from these articles are reproduced below (emphasis added):

On Oct. 22, a **legal notice** appeared in the News Journal announcing the Department of Environmental Protection is proposing to issue an air construction permit allowing...
...both DEP and International Paper were hoping to "sneak" this through, as there was no public hearing. Well, it didn't work. We saw the **legal notice** and are requesting an administrative hearing on this permit as it definitely will impact not only Perdido Bay but...
[Pensacola News Journal (Florida) November 15, 2005]

LEGAL NOTICES

Liquor License Renewals
2005/2006

Notice is hereby given by the Town Council of the Town of North Providence, being the Licensing...

LEGAL NOTICES

MORTGAGEE'S SALE

21 Bergin Street,
Providence, RI 02908

Will be sold at public auction on November...
[The Providence Journal (Rhode Island) November 15, 2005]

"We have been working on this project for the last two years. **Legal notices** and informational letters were mailed to all of you."

Some residents acknowledged they signed the original petition for water but now are backing...
[Buffalo News (New York) November 11, 2005]

It is settled that excerpts from articles taken from the Nexis database are competent evidence of how a term may be perceived. See *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998).

As shown by the examining attorney's evidence, the term "LEGAL" may be defined as relating to or in conformity with law. In addition, "legal notice" is defined as such notice as is adequate or required by law, typically achieved through publication in a newspaper. Applicant's services provide assistance to those seeking to file governmentally required legal notices through newspapers and the Internet. Further, applicant indicates in its brief (p. 10) that "consumers will encounter the mark while seeking a service that provides the opportunity to post legal notices." Thus, the term LEGAL merely describes a characteristic, function or feature of applicant's services; namely, that such services provide assistance in posting governmentally required legal notices. As such, we find that the examining attorney has made a prima facie showing that LEGAL is descriptive of applicant's services.

We are not persuaded by applicant's assertion in its brief (p. 3) that we must determine "[w]hether the term 'Legal Desk' in the combination is descriptive to thereby require disclaimer of the term 'Legal' in order to secure registration." The issue of whether LEGAL DESK is descriptive is not before us. Indeed, in his brief (unnumbered p. 11) the examining attorney "agrees that the entire mark, when used in connection with the identified

services, is not merely descriptive of such services.” Thus, we need not and do not come to a determination herein with regard to whether the mark LEGAL DESK is merely descriptive of the recited services under Section 2(e)(1) of the Trademark Act.

For this reason, we find that applicant’s survey of whether several major newspapers are familiar with the term LEGAL DESK is of very limited probative value. Applicant asserts that its survey demonstrates that LEGAL DESK has no meaning to consumers and thus is incongruous. In that regard, the survey appears to demonstrate that employees of these five newspapers are unfamiliar with the term LEGAL DESK. However, even accepting that applicant’s survey shows LEGAL DESK has no meaning to consumers, such a showing fails to rebut the examining attorney’s prima facie showing that LEGAL merely describes applicant’s services. Applicant provides no evidence, for example, that LEGAL DESK is a unitary term with its own connotation, such that LEGAL would lose its descriptive significance.⁵ Thus, on this record it is not clear that applicant’s mark connotes a piece of furniture, a newspaper department, or has any

⁵ Applicant refers in its brief (p. 15) to the results of a search of LEGAL DESK on the Google Internet search engine. However, no such search results were timely made of record in this proceeding, and applicant’s mere mention thereof does not provide evidentiary support for its position.

other meaning. Again, applicant's arguments regarding the meaning, or lack of meaning, of LEGAL DESK fail to rebut the examining attorney's prima facie showing that LEGAL merely describes its services.

Furthermore, applicant provides no authority for its contention that the examining attorney must demonstrate that LEGAL DESK merely describes the recited services in order to support his requirement that applicant submit a disclaimer of LEGAL alone. To the contrary, in order to support the instant refusal to register in the absence of a disclaimer under Section 6 of the Trademark Act, the examining attorney must demonstrate only that LEGAL merely describes a function, feature or characteristic of applicant's services. On the record of this case, the examining attorney has met that burden.

In short, the term LEGAL in applicant's mark LEGAL DESK, when used in association with applicant's services of providing assistance to those seeking to post legal notices, has a descriptive meaning, and applicant has submitted no evidence that such meaning is lost when used in combination with the word DESK. In view thereof, we find that LEGAL is descriptive of applicant's services and that the required disclaimer is appropriate.

Decision: The refusal to register based on applicant's failure to disclaim LEGAL is affirmed. However, if applicant submits the required disclaimer of LEGAL to the Board within thirty days, this decision will be set aside, as to the affirmance of the disclaimer requirement, the application shall be amended to enter the disclaimer, and the application then shall proceed to publication.⁶ See Trademark Rule 2.142(g), 37 C.F.R. §2.142(g).

⁶ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use LEGAL is claimed apart from the mark as shown." See TMEP §1213.08(a) (4th ed. April 2005).