

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Mailed:  
April 27, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re David M. Chester

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Serial No. 76636335

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John D. Gugliotta of Patent, Copyright & Trademark Law  
Group for David M. Chester.

Christopher L. Buongiorno, Trademark Examining Attorney,  
Law Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Quinn, Holtzman and Kuhlke, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

David M. Chester (applicant) has filed an application  
to register SETTLE YOUR CLAIM (in standard character form)  
on the Principal Register for services ultimately  
identified as "Legal services; and attorney services  
including litigating in-court settlements and negotiating  
out of court settlements" in International Class 42.<sup>1</sup>

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<sup>1</sup> Application Serial No. 76636335, filed April 18, 2005, alleging  
a bona fide intention to use the mark in commerce under Trademark  
Act Section 1(b). 15 U.S.C. §1051(b). The original application  
included the following services: "Direct mail advertising and

The examining attorney has refused registration under 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 its services.

When the refusal was made final, applicant appealed and briefs have been filed. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd.,

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on-line advertising in the fields of attorney services, legal services and negotiating of out of court settlements" in International Class 35. Applicant's request to divide the application and place the class 35 services in a separate application was granted on March 7, 2006.

204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney argues that the proposed mark SETTLE YOUR CLAIM "describes a purpose or feature of applicant's services—settle the prospective client's claim." Br. unnumbered p. 2. He further argues that the combination of terms in the mark does not "evoke a new and unique commercial impression apart from the descriptive meaning." Br. unnumbered p. 4. In support of the refusal, the examining attorney submitted web pages from two law firms where the phrase "settle your claim" is used descriptively, as shown below with emphasis added:

After the elimination of no-fault benefits, it may become more difficult to **settle your claim** without the help of a lawyer...The Following Information May be Helpful If You Choose To **Settle Your Claim** On Your Own:...One of the first questions to consider is when is the correct time to **settle your claim**...When you are ready to **settle your claim**, you should provide this information to the insurance adjuster through a written settlement letter. [www.kenjaray.com](http://www.kenjaray.com);

How long will it take to settle my claim...The length of time to **settle your claim** is usually determined by you and your doctor. [www.hardwickpendergast.com](http://www.hardwickpendergast.com).

We take judicial notice of the following dictionary definitions:<sup>2</sup>

CLAIM: 4. a. A demand for payment in accordance with an insurance policy or other formal arrangement.

The American Heritage Dictionary of the English Language (3d ed. 1992).

SETTLE: 1. to conclude a lawsuit by entering into an agreement, <the plaintiff chose to ~ out of court.>

Merriam-Webster's Dictionary of Law (2001).

When we consider the dictionary definitions of the words CLAIM and SETTLE and use of the phrase SETTLE YOUR CLAIM in the excerpts retrieved from the Internet, we find that the phrase SETTLE YOUR CLAIM is at least descriptive of a significant feature or characteristic of the services,

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<sup>2</sup> University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

namely, that applicant offers litigation of in-court settlements and negotiation of out-of-court settlements.

Applicant argues that absent the context of legal services the "words SETTLE YOUR CLAIM can have numerous, contradictory or ambiguous meaning [sic]." Br. p. 3. It is not necessary that the proposed mark contain the wording "legal services" in order to be considered merely descriptive, it is enough that the proposed mark immediately inform the consumer about a feature of the services, in this case that would be the settlement services applicant provides. Similarly, applicant's unsupported argument that the phrase SETTLE YOUR CLAIM presents a unique commercial impression is unpersuasive. As shown by the evidence of record, this exact phrase is commonly used by applicant's competitors to assist in describing the offered services. Finally, applicant's reference to third-party registrations is not convincing. First, the Board does not take judicial notice of registrations and the mere submission of a list of registrations does not make these registrations part of the record. In re Delbar Products, Inc., 217 USPQ 859 (TTAB 1981); In re Duofold Inc., 184 USPQ 638 (TTAB 1974). We further note that the list does not include the services for which these marks are registered or an indication if

they are registered on the Supplemental Register or on the Principal Register based on a showing of acquired distinctiveness. Finally, as has often been stated, each case must be considered on its own merits based on evidence of record at the time registration is sought. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

In this case, we are persuaded that the unitary phrase SETTLE YOUR CLAIM when used in connection with the recited services would immediately inform the potential users of a significant aspect of those services, i.e., the provision of claim settlement services. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective users of applicant's services to perceive readily the merely descriptive significance of the phrase SETTLE YOUR CLAIM as it pertains to applicant's services.

**Decision:** The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.