

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re David M. Chester

Serial No. 76636336

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

Sue Carruthers, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

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 MY CLAIM (in standard character form) on
the Principal Register for services ultimately identified
as "Direct response and on-line advertising in the fields
of attorney services, legal services and negotiating of out
of court settlements" in International Class 35 and "Legal
services and attorney services including litigating in-

court settlements and negotiating out of court settlements” in International Class 42.¹

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 as recited in both International Classes.

When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register in International Class 42.

As a preliminary matter, in her brief the examining attorney withdrew the Section 2(e)(1) refusal as to the recited services in International Class 35. In view thereof, we will make our determination only as to the recited services in International Class 42.

“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).

¹ Application Serial No. 76636336, filed April 18, 2005, alleging a bona fide intention to use the mark in commerce under Trademark

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.*, 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 Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney argues that the proposed mark SETTLE MY CLAIM "merely describes one of the services (negotiating out-of-court settlements of legal disputes) which applicant's law firm will provide." Br. unnumbered p. 4. Further, she argues that if "a consumer were to view the mark SETTLE MY CLAIM in conjunction with legal services, that consumer would immediately know that one of the law firm's functions is to negotiate settlements of legal disputes." Br. unnumbered p. 5. She concludes that "the meaning of the unitary phrase SETTLE MY CLAIM is clear - it is a client's request for his attorney to negotiate an out-of-court settlement of a legal dispute." Br. unnumbered p. 7.

In support of her arguments, the examining attorney submitted the following pertinent dictionary definition:

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).

Further, as requested by the examining attorney, we take judicial notice of the following pertinent dictionary definition:²

² 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) (Board may take judicial notice of dictionary definitions); In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (judicial notice taken of online

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).

The examining attorney also provided excerpts from numerous websites where the phrase SETTLE MY CLAIM is used, "referring to a request which a client may make of his attorney." Br. unnumbered p. 5. A few examples, with emphasis added, are reproduced below:

Garson & Associates Co., L.P.A. Attorneys at Law ... SHOULD I **SETTLE MY CLAIM**? ... There are many reasons why an injured worker might be interested in settling a worker's compensation claim. www.garson.com;

Zukowski, Rogers, Flood & Mcardle Attorneys at Law ... Frequently Asked Questions about Personal Injury ... 3. Am I better off attempting to **settle my claim** directly with the insurance company for the wrongdoer? www.zrfmlaw.com;

McLarens Young International Global Claims Services ... What's needed to **settle my claim**. www.mclarensyoung.com;

Lewis & Daggett Attorneys at Law, P.A. ... Guide to Property Damage Claims ... 2. How long does it take to **settle my claim** for damages? ... 3. What if it takes longer than two weeks to **settle my claim**? www.lewisdaggett.com; and

Edgar Snyder & Associates A Law Firm Representing Injured People ... Common questions about our law firm ... How long will it take to **settle my claim**? www.edgarsnyder.com.

dictionary definition where resource was also available in book form).

When we consider the dictionary definitions of the words CLAIM and SETTLE and use of the phrase SETTLE MY CLAIM in the various excerpts retrieved from the Internet, we find that the phrase SETTLE MY CLAIM is at least descriptive of a significant feature or characteristic of the services, 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 MY 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 MY 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 MY 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 MY CLAIM as it pertains to applicant's services.

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Decision: The refusal to register under Section 2(e)(1) of the Trademark Act as to the recited services in International Class 42 is affirmed. The application will be published in due course for the recited services in International Class 35.