

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Legal Eagle, Inc.  
v.  
Mark Allen Davis

Opposition No. 91171681  
to application Serial No. 78684218  
filed on August 2, 2005

Natalma M. McKnew of Smith Moore Leatherwood, LLP for Legal Eagle, Inc.

Mark A. Davis of The Davis Law Office, LLC for Mark Allen Davis.

Before Bucher, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mark Allen Davis ("applicant") filed a use-based application for the mark "**When you need a legal eagle, call a bald eagle.**", in standard character form, for "legal services," in Class 42.

Legal Eagle, Inc. ("opposer") filed a notice of opposition against the registration of applicant's mark on the ground of priority of use and likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15

U.S.C. §1052(d). Specifically, opposer alleged that it is the owner of seven federally-registered "Legal Eagle" marks including LEGAL EAGLE, in typed drawing form, for, *inter alia*, paralegal services<sup>1</sup> and legal support services, namely photocopying and clerical services,<sup>2</sup> and that applicant's mark is likely to cause confusion with opposer's marks.

Applicant denied the salient allegations in the notice of opposition, and filed a counterclaim to cancel opposer's pleaded registration for the mark LEGAL EAGLE for paralegal services. As ground for cancellation, applicant claimed that the term LEGAL EAGLE is generic for paralegal services. Opposer denied the essential allegations in applicant's counterclaim to cancel opposer's registration.

#### The Record

By rule, the record includes applicant's application file, the file for the registration sought to be canceled, and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, opposer introduced the following testimony and evidence:

1. The testimony deposition of Richard C. Carnahan, Jr., the controlling shareholder of opposer, with attached exhibits; and,

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<sup>1</sup> Registration No. 2,366,023, issued July 11, 2000; affidavits under Sections 8 and 15 accepted and acknowledged.

<sup>2</sup> Registration No. 1978249, issued June 4, 1996; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

2. A notice of reliance on applicant's responses to opposer's interrogatory Nos. 1-17 and applicant's supplemental responses to opposer's interrogatory Nos. 11 and 17.

Opposer also filed a notice of reliance on copies of its pleaded registrations "together with status information through March 12, 2008." However, no documents were attached. Nevertheless, opposer's pleaded registrations have been made of record to the extent that they have been properly identified and introduced during Mr. Carnahan's testimony. See the discussion on standing below.

Applicant did not introduce any testimony or evidence during his testimony period. However, applicant attached three (3) exhibits to his brief. The exhibits were not timely filed, nor were they filed pursuant to a notice of reliance. Therefore, they were not filed in compliance with the Trademark Rules of Practice, and, with the exception of the dictionary definition of the term "legal eagle,"<sup>3</sup> they have not been given any consideration. Trademark Rule 2.123(1), 37 CFR §2.123(1) ("Evidence not obtained and filed in compliance with these sections will not be considered"). See also TBMP §704.05(b) (2<sup>nd</sup> ed. rev. 2004) ("Exhibits and

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<sup>3</sup> We may take judicial notice of dictionary definitions. See *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice).

other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony").

Counterclaim

A. Standing.

Applicant's position as the defendant in the opposition gives it a personal stake in the outcome of the proceeding, and therefore it has standing to file a counterclaim seeking to cancel opposer's pleaded registration. *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990); *Alberto-Culver Co., v F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1603 (TTAB 1990); *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840, 841 (TTAB 1979).

B. Whether LEGAL EAGLE is generic for paralegal services?

The registration of opposer's mark on the Principal Register is *prima facie* evidence of the validity of that registration and that the mark identified in the registration is not generic. Accordingly, applicant has the burden of proving that opposer's registration is invalid because its mark is generic. *Stocker v. General Conference Corp.*, 39 USPQ2d 1385, 1392 (TTAB 1996) ("the burden of proof rests squarely on petitioners who are asserting invalidity").

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term has with the relevant public. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs and other publications. *Stocker v. General Conference Corp.*, 39 USPQ2d at 1392.

Our primary reviewing court has stated that a party asserting genericness must prove its claim by a preponderance of the evidence. Therefore, applicant has the dual burden of overcoming the registration's validity and he must also prove by a preponderance of the evidence that the term LEGAL EAGLE is used or understood by the relevant class of consumers primarily to refer to the class of services with which the term is registered (*i.e.*, paralegal services). *Stocker v. General Conference Corp.*, 39 USPQ2d at 1392.

The only admissible evidence applicant introduced into the record was a dictionary definition for the term "legal

eagle." It is defined as a disparaging term to identify a lawyer.<sup>4</sup> Accordingly, applicant argues that "[a]s a matter of law, the term 'legal eagle' refers to an attorney just as the words 'lawyer' and 'barrister' refer to an attorney. Even our learned judges have used the term 'legal eagle' to refer to a lawyer."<sup>5</sup> Applicant specifically asserts that the term "'legal eagle' is a generic term for an attorney."<sup>6</sup> However, opposer's registration for LEGAL EAGLE is not for attorney or legal services; it is registered for paralegal services. Indeed, Mr. Carnahan testified that opposer is not rendering legal services; rather it is rendering paralegal services and other legal support services.<sup>7</sup> Opposer's one dictionary definition is clearly insufficient to establish the genus or class of opposer's services or that the public understands the mark LEGAL EAGLE to refer to paralegal services. Accordingly, opposer has not met its burden of proving that LEGAL EAGLE is generic for opposer's paralegal services.

In view of the foregoing, the counterclaim to cancel opposer's pleaded registration is dismissed.

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<sup>4</sup> *Dictionary.com Unabridged* (v 1.01) derived from the Random House Unabridged Dictionary (2006).

<sup>5</sup> Applicant's Brief, p. 3.

<sup>6</sup> Applicant's Brief, p. 4.

<sup>7</sup> Carnahan Dep., pp. 6-7.

Likelihood of Confusion

A. Opposer's Standing and Priority

Mr. Carnahan testified that since December 1994, opposer has been using the mark LEGAL EAGLE to identify paralegal services and technical support services for attorneys such as duplication services, imaging and indexing services, and document numbering.<sup>8</sup> This testimony is sufficient to establish opposer's personal interest in the outcome of the proceeding and opposer's priority of use. *See National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

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<sup>8</sup> Carnahan Dep., pp. 6-7.

Moreover, Mr. Carnahan identified copies of opposer's pleaded registrations and testified that the registrations were subsisting and owned by opposer.<sup>9</sup> Because opposer properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In addition, because opposer's pleaded registration are of record, Section 2(d) priority is not an issue in this case as to the marks and the services covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

B. Likelihood of confusion analysis.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

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<sup>9</sup> Carnahan Dep., pp. 13-18 and Exhibits 4-10.

1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

1. The similarity or dissimilarity and nature of the services at issue.

Opposer has registered LEGAL EAGLE, in typed drawing form, for paralegal services and for legal support services, namely photocopying and clerical services. Applicant is seeking to register his mark for legal services. Opposer argues that applicant's legal services encompass opposer's paralegal and legal support services.<sup>10</sup> On the other hand, applicant argues that opposer does not provide legal services to the public; rather it markets its legal support services to attorneys.<sup>11</sup>

There is no evidence in this record regarding the relationship between legal services, on the one hand, and paralegal services and legal support services, on the other. However, it is well settled that applicant's services and registrant's services do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they

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<sup>10</sup> Opposer's Brief, p. 8; Opposer's Reply, p. 2.

<sup>11</sup> Applicant's Brief, pp. 2 and 7.

would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source.

*In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

"In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties." *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975). Mr. Carnahan testified that opposer renders its paralegal and legal support services to attorneys and corporate legal departments.<sup>12</sup> Moreover, it is common knowledge that attorneys and paralegals work together in rendering legal services, and that they also render their services to other attorneys and corporate legal departments. Accordingly, the services of the parties appeal to the same market. In view of the foregoing, we find that the services of the parties are related.

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<sup>12</sup> Carnahan Dep., pp. 10, 36-37, 57, 63 and Exhibit 18.

2. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

As indicated above, opposer renders its paralegal and legal support services to attorneys and corporate legal departments.<sup>13</sup> Applicant argues that “[l]egal services include personal injury, criminal defense, and business incorporation, among others.”<sup>14</sup> As indicated above, both parties could render their services to attorneys and corporate legal departments. Moreover, because the description of services in neither opposer’s registrations, nor applicant’s application, contain any restrictions or limitations as to channels of trade or classes of consumers, we must presume that the services move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In view of the foregoing, we find that the parties render their services in the same channels of trade and to the same classes of consumers.

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<sup>13</sup> Carnahan Dep., pp. 10, 36-37, 57, 63 and Exhibit 18.

<sup>14</sup> Opposer’s Brief, p. 7.

3. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In addition, in comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston*,

*Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The marks of the parties are similar to the extent that applicant's mark incorporates the entirety of opposer's LEGAL EAGLE mark. On the other hand, they are different because applicant's mark is a slogan incorporating opposer's mark. The term "Legal Eagle" as used by both parties means substantially the same thing and engenders a similar commercial impression. In applicant's case, it connotes a legal mind with an attention to details, and in opposer's case it connotes a good attorney or legal mind.<sup>15</sup> As such the term "Legal Eagle" is suggestive when used in connection with legal services, paralegal services or legal support services. In reaching this conclusion, we note that with the exception of the one dictionary definition, applicant failed to introduce any testimony or evidence regarding the meaning or use of the term "Legal Eagle" as a recognized term or colloquialism for legal services. We have very little basis on this record to find that applicant's use of the term "Legal Eagle" as part of its slogan **"When you need a legal eagle, call a bald eagle."** creates a readily distinguishable connotation or commercial impression. Thus,

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<sup>15</sup> We readily admit that we do not understand why applicant's dictionary definition indicates that the term "legal eagle" is often used as a disparaging term for attorneys. Moreover, if it is, in fact, a disparaging term, why are opposer and applicant being fighting over it?

in comparing the marks, the term "Legal Eagle" is sufficiently distinctive to create a memorable commercial impression which is likely to create an associative reaction in the minds of consumers familiar with opposer's mark upon encountering applicant's slogan incorporating opposer's mark. Accordingly, we find that the similarity of the marks outweigh their differences, and that the marks are similar in terms of their appearance, sound, meaning and commercial impression.

F. Balancing the factors.

Because of the similarity of the marks, the similarity of the services, and the presumption that the services move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's mark **"When you need a legal eagle, call a bald eagle."** for legal services is likely to cause confusion with opposer's LEGAL EAGLE mark for paralegal service and legal support services. To the extent that we have any doubts regarding the likelihood of confusion, we resolve them, as we must, in opposer's favor. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Carlisle Chemical Works v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 111, 112 (CCPA 1970).

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Decision: The counterclaim to cancel opposer's pleaded registration is dismissed.

The opposition is sustained and registration to applicant is refused.