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RFC

THIS DISPOSITION IS NOT
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MAY 18 ,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Legal Staffing, Inc.**

Serial No. 74/**591,188**

Seth Nehrbass of Pravel, Hewitt, Kimball & Krieger for **Legal Staffing, Inc.**

Vivian Micznik First, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney)

Before **Sams**, Simms and Cissel, Administrative Trademark Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On December 27, 1994, applicant filed an application to register the mark "BRIGGS LEGAL STAFFING" on the Principal Register for "temporary and permanent placement services for legal secretaries." The basis for the application was applicant's claim of use in interstate commerce since September 7, 1992. The specimens submitted with the application are telephone index cards showing the mark and the addresses and phone numbers of seven of applicant's

locations. In addition to the mark "BRIGGS LEGAL STAFFING," these cards bear the notation "Personnel for the Legal Industry...Temporary & Full-Time."

On April 27, 1995, the Examining Attorney issued an Office Action in which she refused registration under Section 2(e)(4) of the Lanham Act on the ground that the mark is primarily merely a surname. In support of the refusal, she attached to the Office Action copies of printouts of a number of pages from the Phonedisc U.S.A.® database which show listings for people whose surname is "Briggs." Also submitted were copies of dictionary definitions of the word "legal" as meaning "of, pertaining to, or concerned with the law," and "applicable to or typical of lawyers or their profession," and of the word "staffing" as relating to "the personnel carrying out a specific enterprise < the nursing staff at a hospital." The Examining Attorney cited the cases of *In re Crazes*, 21 USPQ2d 1796 (TTAB 1991) and *In re Possis Medical, Inc.*, 230 USPQ 72 (TTAB 1986) for the proposition that a surname combined with incapable matter, such as a generic term, is still primarily merely a surname and therefore unregistrable under Section 2(e)(4) of the Act.

The Examining Attorney also required applicant to claim ownership of Registration No. 1,853,379, which was issued to applicant on the Supplemental Register on September 6, 1994.

The mark registered there is the same mark as in the instant application, "BRIGGS LEGAL STAFFING." The services listed there are "employment agency services in the field of legal support personnel, such as legal secretaries, paralegals, and receptionists." That registration contains a disclaimer of the words "LEGAL STAFFING."

In the instant application, the Examining Attorney required applicant to disclaim the words "LEGAL STAFFING" apart from the mark as shown.

The last requirement the Examining Attorney made in her first Office Action was that applicant clarify the recitation of services by amending it to state that the services are rendered by an employment agency.

Applicant responded by claiming ownership of its registration on the Supplemental Register, amending the recitation of services to "employment agency services," and arguing that the refusal to register under Section 2(e)(4) is improper. Applicant submitted copies of portions of its local Yellow Pages advertising directory to show that there are no headings labeled "legal staffing," and pages from the PTO manual for identifications of goods and services, which show no listings for either "staffing" or "legal staffing." These submissions were argued to support applicant's contention that "LEGAL STAFFING" is not generic for, or even descriptive of, applicant's services.

From this conclusion applicant argued that its mark is not primarily merely a surname under the test set forth in *In re Hutchinson Technology*, 7 USPQ2d 1490 (Fed. Cir. 1988), because the mark is not composed of a surname combined with generic or even descriptive terminology. In that case, the Court reversed the Board's holding that the mark "HUTCHINSON TECHNOLOGY" was unregistrable as a trademark for electronic and mechanical computer components because it was primarily merely a surname. The Court found that although "HUTCHINSON" was indeed a surname, the word "TECHNOLOGY" was so broad and indefinite that it did not convey an immediate idea of ingredients, qualities, or characteristics of applicant's goods, and thus was not merely descriptive of applicant's products.

Applicant characterized "LEGAL STAFFING" as only suggestive of applicant's services, and argued that because Section 1211.01(b) of the TMEP's guidelines states that if the "wording combined with a surname is capable of functioning as a mark (i.e., matter which is arbitrary, suggestive, or merely descriptive of the goods or services), the mark is not considered to be primarily a surname" under the Act.

On February 1, 1996, the Examining Attorney made final both the refusal to register and the requirements for a disclaimer and for an amendment to the recitation of

services. "Employment agency services, namely, temporary and permanent placement of legal secretaries" was suggested because the first amendment applicant had submitted included services which were not encompassed in the original recitation of services.

In support of her contention that "LEGAL STAFFING" is a generic term for applicant's services, the Examining Attorney attached to her second Office Action copies of excerpts from over a hundred stories retrieved from the Nexis® database wherein the term "legal staffing" appears. Typical examples include the following: "Taylor, whose firm, Of Counsel Inc., provides temporary legal staffing,..."; "AmeriClerk, Inc. Temporary Legal Staffing Specialists"; "Attorneys Per Diem, national provider of temporary legal staffing,..."; and "The company specializes in legal staffing and legal support services."

Applicant filed an amendment to the recitation of services, a notice of appeal and a request for reconsideration. Applicant adopted the recitation of services suggested by the Examining Attorney. Applicant argued that the term "LEGAL STAFFING" is only suggestive of applicant's services, and that the mark as a whole is therefore registrable without a disclaimer. The appeal was instituted, but action on it was suspended and the

application file was remanded to the Examining Attorney for reconsideration.

The Examining Attorney was still not persuaded on either point, and maintained both the requirement for a disclaimer and the refusal to register. Attached to the Examining Attorney's Office Action were still more excerpts from the Nexis® automated database. In each one, the term "legal staffing" is used in the manner of the previously submitted excerpts, that is, as the name of the activity of staffing businesses with employees trained in the field of legal work.

The application was then returned to the Board, which resumed action on the appeal and allowed applicant time in which to file its brief on appeal. Applicant timely did so, and the Examining Attorney filed her brief in response. Applicant did not request an oral hearing, so we have resolved this appeal based on the written record and arguments.

We hold that the requirement for a disclaimer of the term "LEGAL STAFFING" and the refusal to register are both proper.

Both of these findings center upon the fact that "LEGAL STAFFING" is a generic term for applicant's services, as they are identified in the amended application. The dictionary definitions of the component words, as well as

the many examples of use of the combined term in the record, establish that what applicant provides is called "legal staffing." That "legal staffing" is not a two-word term defined in the dictionary listings submitted by applicant and is not shown in the Office's manual for identifications of goods and services is not determinative of this issue in favor of applicant. These reference works hardly purport to include listings for all the services that can possibly be rendered.

Generic terminology is unregistrable under Section 2(e)(1) of the Act. As such, the term "LEGAL STAFFING" must be disclaimed under Section 6 of the Act, which requires a disclaimer of any unregistrable component of an otherwise registrable mark. Surely this was the reason applicant's prior registration on the Supplemental Register includes a disclaimer.

Further, in keeping with the principle that a surname combined with a generic term is still primarily merely a surname, the entire mark is unregistrable under Section 2(e)(4). The record clearly establishes that "BRIGGS" is primarily merely a surname, and the addition of the generic term "LEGAL STAFFING" to it does not alter its significance. Because the primary significance of applicant's mark in its entirety is that of a surname, the refusal to register under Section 2(e)(4) of the Act is proper.

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Accordingly, both the requirement and the refusal to register are affirmed.

J. D. Sams

R. L. Simms

R. F. Cissel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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