

To: Jason Webb(dokippearson@gmail.com)
Subject: U.S. Trademark Application Serial No. 97120891 - UTAH'S ORIGINAL PERSONAL INJURY LAW FIRM - J0594e4STM
Sent: August 22, 2022 07:09:10 AM EDT
Sent As: tmng.notices@uspto.gov

Attachments

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97120891

Mark: UTAH'S ORIGINAL PERSONAL INJURY LAW FIRM

Correspondence Address:

JASON WEBB
1802 W. SOUTH JORDAN PARKWAY, SUITE 200
SOUTH JORDAN UT 84095 UNITED STATES

Applicant: Robert J. DeBry & Associates PC

Reference/Docket No. J0594e4STM

Correspondence Email Address: dokippearson@gmail.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 22, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

SUMMARY OF ISSUES:

- Section 2(e)(1) Refusal - Merely Descriptive
- Supplemental Register
- Disclaimer Advisory

SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE

Registration is refused because the applied-for mark is a laudatory phrase that describes the geographic scope or location and type of legal services will provide. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but "whether someone who knows what the goods and/or services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Mueller Sports. Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018).

Websites and webpages and dictionary definitions, applicant's identification, and specimens of record including any explanatory text or items such as tags or labels contained within are generally a competent source for determining how the public perceives the mark in connection with applicant's goods and/or services. *See In re N.C. Lottery*, 866 F.3d 1363, 1367-68, 123 USPQ2d 1707, 1709-10 (Fed. Cir. 2017); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986)); TMEP §1209.01(b).

Here, applicant seeks registration of: UTAH'S ORIGINAL PERSONAL INJURY LAW FIRM in relation to legal services.

As exhibited by applicant's address applicant is located in Salt Lake City, Utah. Thus, it is reasonable to

assume that applicant will provide its legal services to residents of Utah, likely Salt Lake City. Thus, UTAH is descriptive of the geographic scope of the services or the place in which they will be rendered.

“Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive” because “[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services].” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1256, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); TMEP §1209.03(k). The Trademark Trial and Appeal Board has held that the word “ORIGINAL” used alone or paired with descriptive wording is merely laudatory and descriptive of goods or services being the first of their kind. *See In re Ervin*, 1 USPQ2d 1665, 1666 (TTAB 1986) (holding THE “ORIGINAL” merely laudatory and descriptive of applicant’s scorer for playing euchre as the first of its kind); *Gen. Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 994 (TTAB 1984) (holding ORIGINAL BLEND merely laudatory and descriptive of applicant’s cat food comprising a first-of-its-kind combination of ingredients).

"PERSONAL INJURY" describes the type of legal services that applicant will render as exhibited by applicant's specimen of record. Finally, a "LAW FIRM" is merely a business that renders legal services and is thus descriptive of the provider of the services at issue.

Taken together, applicant's mark, UTAH'S ORIGINAL PERSONAL INJURY LAW FIRM is a laudatory phrase that describes the geographic scope or location and type of legal services will provide, namely, personal injury legal services rendered by a first/one-of-its-kind law firm in or around the Utah area.

Accordingly, registration is refused pursuant to Section 2(e)(1) of the Trademark Act. Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, applicant is advised of the following:

SUPPLEMENTAL REGISTER ADVISORY

A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d), 2.75(b); TMEP §§815.02, 1102.03. When a Section 1(b) application is successfully amended to the Supplemental Register, the application effective filing date will be the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for the amendment to allege use. TMEP §§816.02, 1102.03; *see* 37 C.F.R. §2.75(b).

DISCLAIMER ADVISORY

Applicant is advised that, if the application is amended to seek registration on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, applicant will be required to disclaim “PERSONAL INJURY LAW FIRM” because such wording appears to be generic in the context of applicant’s goods and/or services. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986); TMEP §1213.03(b).

Applicant may submit a disclaimer in the following format:

No claim is made to the exclusive right to use “PERSONAL INJURY LAW FIRM” apart from the mark as shown.

TMEP §1213.08(a)(i).

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

How to respond. [Click to file a response to this nonfinal Office action](#).

/Siddharth Jagannathan/
Siddharth Jagannathan
(571) 272-6563
siddharth.jagannathan@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- [Responses signed by an unauthorized party](#) are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 22, 2022 for
U.S. Trademark Application Serial No. 97120891

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

User: Siddharth Jagannathan

Statistics for Case 97120891						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	*utah*	826	0	0	0	0:02
2	*original*[bi,ti] not dead[ld]	4907	0	0	0	0:01
3	*personal*[bi,ti] not dead[ld]	2384	0	0	0	0:01
4	*n{"gj"}ur{"iye"}*[bi,ti] not dead[ld]	562	0	0	0	0:02
5	*law*[bi,ti] not dead[ld]	9249	0	0	0	0:01
6	*{"fh"}{"iy"}rm*[bi,ti] not dead[ld]	1878	0	0	0	0:01
7	1 and 2 and 3 and 4 and 5 and 6	1	0	1	1	0:01
8	(1 and (2 3 4 5 6)) not (7)	6	0	6	6	0:01
9	(2 and (3 4 5 6)) not (7 8)	21	0	21	21	0:02
10	(3 and (4 5 6)) not (7 8 9)	76	0	76	76	0:04
11	(4 and (5 6)) not (7 8 9 10)	127	0	127	127	0:07
12	5 and 6	526	0	147	147	0:00
13	12 and "045"[cc]	519	0	0	0	0:01

Session started 08/22/2022 3:48 am

Session ended 08/22/2022 3:57 am

Total search duration 24.00

Session duration 8 minutes 49 seconds

Adjacency Level 1

Near Level 1