



## UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT HOLDS LAWYERS.COM GENERIC: MUCH ADO ABOUT NOTHING?

On April 12, 2007, the United States Court of Appeals for the Federal Circuit rendered a decision in *In re Reed Elsevier Properties Inc.*, affirming the Trademark Trial and Appeal Board's ("Board") finding that the mark LAWYERS.COM is generic as applied to the services of "providing access to an online interactive database featuring information exchange in the fields of law, legal news, and legal services." *In re Reed Elsevier Properties Inc.*, 2007 U.S. App. LEXIS 8376 (Fed. Cir. 2007). The Federal Circuit's decision marks the latest step in the rather lengthy prosecution of Reed Elsevier Properties' ("Reed Elsevier") attempt to secure a federal trademark registration for LAWYERS.COM.

Reed Elsevier filed its application to register the mark LAWYERS.COM with the U.S. Patent and Trademark Office in 1998. At the time, Reed Elsevier's services were identified as "providing access to an online interactive database featuring information exchange in the fields of law, lawyers, legal news, and legal services." The examining attorney initially refused registration of the mark as merely descriptive under Section 2(e)(1) of the Lanham Act. After the examining attorney made this refusal "final," Reed Elsevier alleged that its mark had acquired distinctiveness and, accordingly, amended the application to seek registration under Section 2(f) of the Lanham Act. At that point, the examining attorney refused registration of LAWYERS.COM as generic for Reed Elsevier's services.

Reed Elsevier responded to the genericness refusal by amending its application to seek registration on the Supplemental Register and deleting the term "lawyers" from its

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recitation of services. The examining attorney refused registration of LAWYERS.COM on the Supplemental Register based on genericness, and this refusal was eventually made final. After the Board, in a citable decision, upheld the examining attorney's refusal of registration, Reed Elsevier appealed the case to the Federal Circuit.

In deciding that the Board did not err in finding LAWYERS.COM generic as applied to Reed Elsevier's services, the Federal Circuit employed the two-part genericness test set forth in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986). Under this test, the fact finder must determine the genus of goods or services at issue, and then must determine whether the relevant public understands the term sought to be registered as primarily referring to that genus of goods or services. The Federal Circuit stated that when this test is applied to the LAWYERS.COM mark, it is "abundantly clear" that the mark is generic for Reed Elsevier's services.

The Federal Circuit was not persuaded by Reed Elsevier's arguments that the Board, in defining the genus of services, had improperly considered all of the services offered on the LAWYERS.COM website rather than focusing on those listed in Reed's amended recitation of services. It agreed with the Board that information about the law, legal news and legal services is an "inextricably intertwined element" of information from and about lawyers. Thus, the Federal Circuit found that the element of the two-part test for proving genericness had been satisfied. The Federal Circuit also found that the Board properly considered eight websites containing the wording "lawyer.com" or "lawyers.com" to determine what services the relevant public would understand Reed Elsevier was providing via its LAWYERS.COM

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website, and that these websites provided “substantial evidence” in support of the Board’s decision.

The Federal Circuit’s decision in *Reed Elsevier* is hardly groundbreaking, and the intrinsic conflict between the desire of business owners to utilize business names that readily identify the nature of their businesses and federal trademark law regarding descriptive and generic terms is nothing new. Although the proliferation of domain names as trademarks added another element to this dichotomy in the form of top-level domains (“TLDs”) such as .COM, .ORG and .BIZ, as the Board noted in its LAWYERS.COM opinion, in most cases, these TLDs do not save an otherwise unregistrable mark. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (the term PATENTS is not rendered distinctive by the addition of the TLD .COM). The Federal Circuit’s affirmation of the Board’s decision regarding LAWYERS.COM confirms the validity of following tips:

- Don’t pick common descriptive or generic terms as marks; pick more suggestive, arbitrary or fanciful expressions when branding. These make the strongest and easiest marks to register and enforce.
- Trademark owners seeking federal registration of merely descriptive or generic terms are better off adding a registrable design element or other distinctive component to their marks. Although such owners will likely still be required to disclaim the descriptive or generic wording, and may not have the degree of protection accorded to more distinctive marks, they will at least be able to obtain a federal registration for the overall composite mark.

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- When applying for federal registration, trademark owners and practitioners should avoid using the mark, or any portion thereof, in the identification of their goods and services. Reed Elsevier's position was likely not helped by the fact that their original recitation of services stated that the mark LAWYERS.COM was, in fact, being used in connection with information in the field of lawyers.

The Federal Circuit's decision in the *Reed Elsevier* case should not come as a surprise. Yet, even though Reed Elsevier was unable to obtain federal trademark registration for LAWYERS.COM, they still own exclusive rights to the LAWYERS.COM domain name. In the meantime, business owners seeking to register these types of domain names as trademarks should consult with their trademark attorneys, and those attorneys should counsel their clients on the special challenges of attempting to gain exclusive rights to use generic terms as trademarks.

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