

This Opinion is not a
Precedent of the TTAB

Mailed: September 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Proboknow, LLC.

Serial No. 86790769

Gene Bolmarcich of Law Offices of Gene Bolmarcich for Proboknow, LLC.

David I. Dubin, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).¹

Before Cataldo, Ritchie and Goodman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Proboknow, LLC, seeks registration on the Principal Register of the standard character mark PROBOKNOW for “Operating an online marketplace for providers and consumers of free and affordable legal services” in International Class 35.²

¹ The involved application was originally examined by a different Trademark Examining Attorney, but was subsequently reassigned to this Examining Attorney after the appeal was filed.

² Application Serial No. 86790769 was filed on October 16, 2015, based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

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Applicant appeals from the final refusal of registration on the ground that the applied-for mark is merely descriptive of the identified services. Trademark Act Section 2(e)(1); 15 U.S.C. § 1052(e)(1). Applicant and the Trademark Examining Attorney filed briefs on the issue under appeal.

We affirm.

I. Applicable Law

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services with which it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d

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1778, 1780 (Fed. Cir. 2003); *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983).

It has long been acknowledged that there is a thin line between terms that are merely descriptive and those that are suggestive. *See In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

II. Discussion

We begin our determination by considering the applied-for mark and the recited services. Applicant's applied-for mark is PROBOKNOW, identifying "Operating an online marketplace for providers and consumers of free and affordable legal services." In support of the refusal of registration, the Examining Attorney made of record the following dictionary definitions of pro bono:

law: involving or doing legal work for free; being, involving, or doing professional and especially legal work donated especially for the public good, *pro bono* work.³

Pro bono publico (often shortened to pro bono) is a Latin phrase meaning "for the good of the people."

In [the legal profession](#), the term "pro bono" refers to legal services performed free of charge for the public good. Unlike traditional volunteerism, pro bono services leverage the skills of legal professionals to help those who are unable to afford a lawyer.

Pro bono services help marginalized communities and underserved populations – such as children and the elderly - that are often denied access to justice.

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The Examining Attorney further made of record the following screenshots from third-party Internet websites. The following examples are illustrative:

³ February 9, 2016 Office action at 5-6. Merriam-webster.com.

⁴ *Id.* at 7-13. legalcareers.about.com.

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[Lawyers.com](#) > [Understand Your Legal Issue](#) > [Legal Dictionary](#) > Pro bono

Pro bono

Definition - *adv Or Adj*

[Latin *pro bono publico* for the public good]

: being, involving, or doing legal work donated esp. for the public good <*pro bono* counsel>

Pronunciation"prO-'bO-nO

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GEORGETOWN LAW

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PRO BONO AND COMMUNITY SERVICE

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- Service-Oriented Student Organizations
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- New York Bar Pro Bono Admission Requirement

What is Pro Bono?

The term "pro bono," which is short for *pro bono publico*, is a Latin term that means "for the public good." Although the term is used in different contexts to mean "the offering of free services," it has a very specific meaning to those in the legal profession. Georgetown Law strongly encourages law students to develop a practice of engaging in pro bono work while in law school, and to carry this habit forward as they transition into practice.

Rule 6.1 of the American Bar Association's Model Rules of Professional Conduct, lays out the obligation of attorneys to engage in pro bono.

Every lawyer has a professional responsibility to provide legal services to those unable to pay. A lawyer should aspire to render at least (50) hours of pro bono publico legal services per year. In fulfilling this responsibility, the lawyer should:

- a. Provide a substantial majority of the (50) hours of legal services without fee or expectation of fee to:
 1. Persons of limited means or
 2. Charitable, religious, civic, community, governmental and educational organizations in matters that are designed primarily to address the needs of persons of limited means; and
- b. Provide any additional services through:

⁵ March 29, 2016 final Office action at 5.

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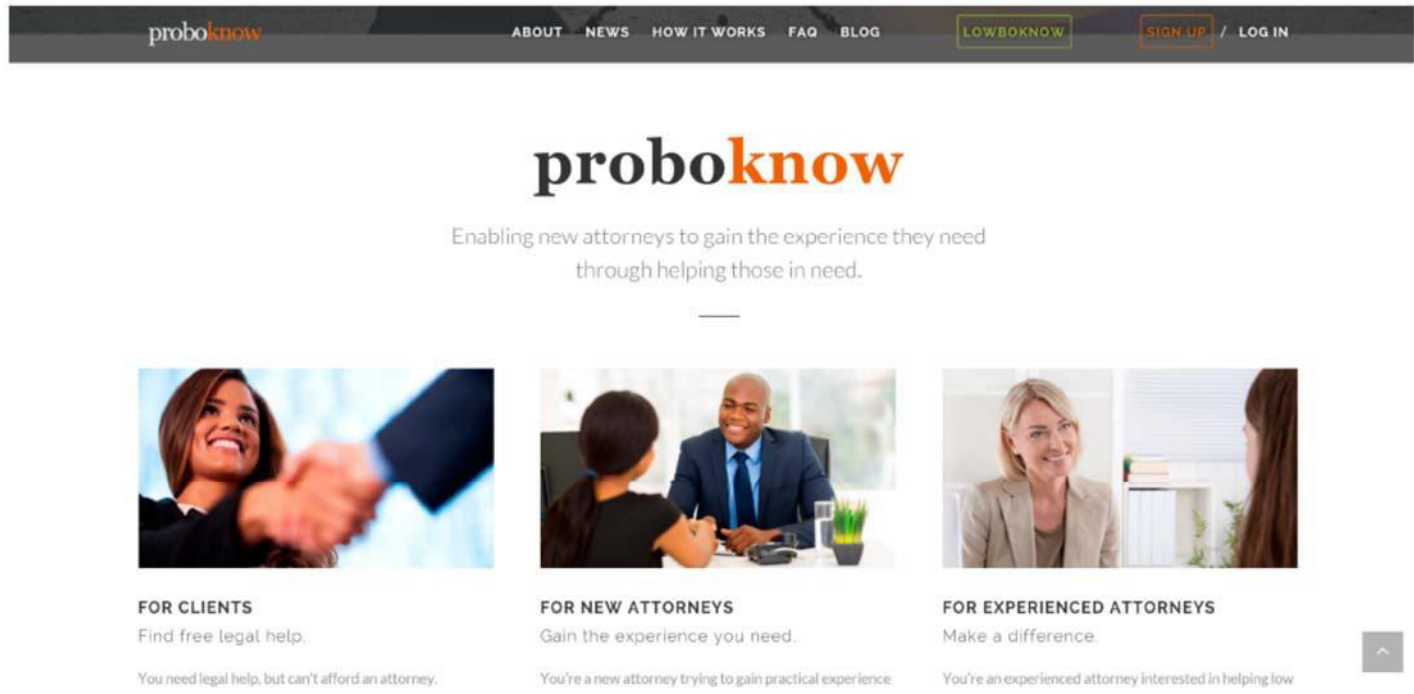
payment of standard legal fees would significantly deplete the organization's economic resources or would be otherwise inappropriate;

- 2. Delivery of legal services at substantially reduced fee to persons of limited means; or
- 3. Participation in activities for improving the law, the legal system or the legal profession.

In addition, a lawyer should voluntarily contribute financial support to organizations that provide legal services to persons of limited means.

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Applicant, for its part, made of record screenshots from its Internet website. These include the following:

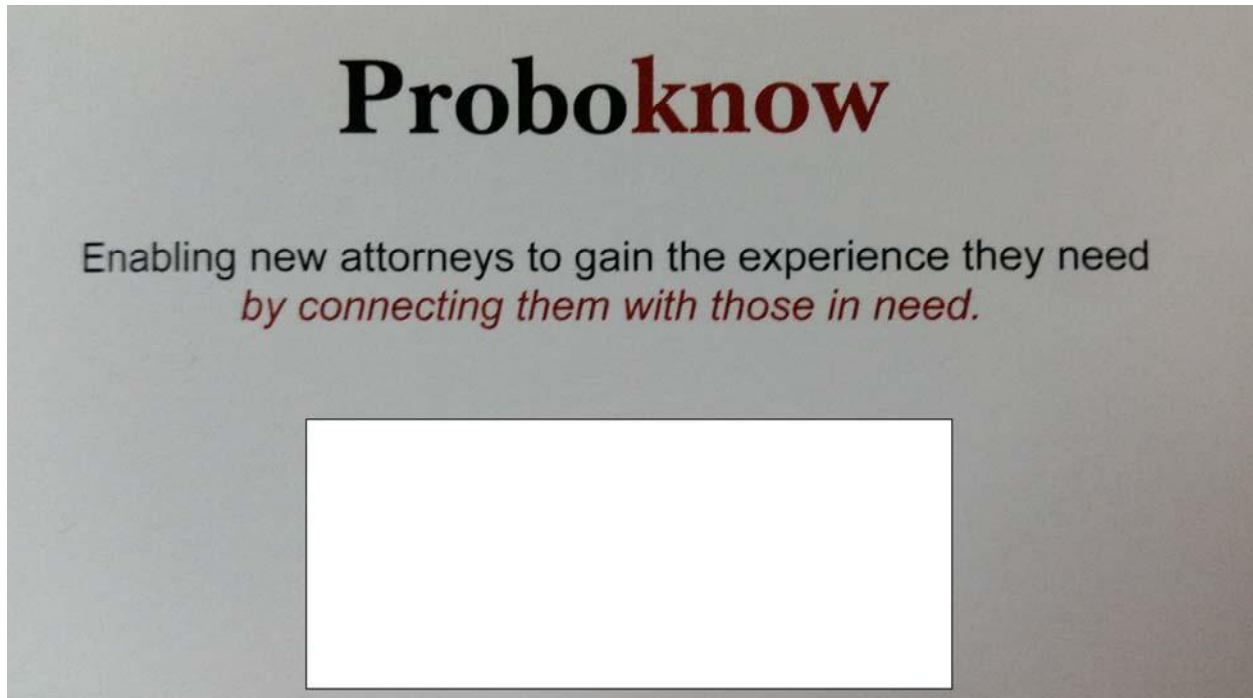


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⁶ *Id.* at 7-8.

⁷ Applicant's March 8, 2016 communication at 7.

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We turn then to the question of whether PROBOKNOW is descriptive of applicant's recited "Operating an online marketplace for providers and consumers of free and affordable legal services." We observe initially that, on this record, PROBOKNOW is a novel spelling of the phonetically equivalent "pro bono." The novel spelling of a mark that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *See In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (CCPA 1953) (holding "FASTIE," phonetic spelling of "fast tie," merely descriptive of tube sealing machines); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (holding "URBANHOUSING" phonetic spelling of "urban" and "housing," merely

⁸ *Id.* at 8.

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descriptive of real estate services); *In re State Chem. Mfg. Co.*, 225 USPQ 687 (TTAB 1985) (holding “FOM,” phonetic spelling of “foam,” merely descriptive of foam rug shampoo).

As noted above, the Examining Attorney has made of record dictionary definitions of the term comprising phonetic equivalents of applied-for mark. Based upon these dictionary definitions, it is clear that the term “pro bono” merely describes legal services provided to clients who are unable to pay. It is settled that “evidence [that a term is merely descriptive] may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *See In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, (Fed. Cir. 2005); and *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986). In addition, the Examining Attorney’s Internet evidence indicates that “pro bono” is a well-recognized term in the field of law describing legal work performed for the public good to clients who are unable to pay. Furthermore, Applicant’s evidence from its Internet website indicates that the services under its PROBOKNOW mark are provided for clients who “need legal help, but can’t afford an attorney,” to inexperienced lawyers “trying to gain practical experience,” and to experienced attorneys seeking to “make a difference.” Applicant’s website also indicates that its services under the PROBOKNOW mark enable “new attorneys to gain the experience they need by connecting them with those in need.” Based upon this evidence, we find that PROBOKNOW will be recognized as a novel spelling of the phonetic equivalent “pro bono,” and that PROBOKNOW merely describes, without conjecture or speculation, a feature or characteristic of Applicant’s

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services, namely, operating an online marketplace for providers and consumers of free and affordable, or pro bono, legal services. Prospective purchasers, upon confronting the term PROBOKNOW for Applicant's services, would immediately perceive that the services are intended for providers and consumers of free, or pro bono, legal services.

Applicant strenuously argues that PROBOKNOW will not be recognized as "pro bono." Rather, Applicant argues that "Far from being a merely descriptive term, PROBOKNOW is a portmanteau of the terms "pro bono" and "knowledge". As such it can only be considered a suggestive term."⁹ However, Applicant has provided no evidence that consumers of its services, that is, attorneys and clients or potential clients in need of low cost or free legal services, would recognize PROBOKNOW as a combination of "pro bono" and "knowledge." There is no evidence that "KNOW" will be perceived by consumers as a shortened version of "knowledge," either by itself or in connection with the term "PROBO" or "pro bono," nor is such a possible meaning evident from the recitation of services or the manner in which the mark appears to be used by Applicant in connection with its services. In any event, Applicant's own website uses the applied-for PROBOKNOW mark in a manner indicating its meaning as a novel spelling of "pro bono," and that a feature or function of Applicant's services is to provide knowledge of potential pro bono practitioners and clients. As a result, even if the applied-for mark conveys "pro bono knowledge," that meaning is no less

⁹ 4 TTABVUE 4.

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descriptive than the meaning of “pro bono” as intended to be used in connection with Applicant’s services.

Applicant further argues that the applied-for PROBOKNOW mark is suggestive.

For the sake of argument only, and in the alternative, Applicant submits that even if the Board concludes that PROBOKNOW is the equivalent of “pro bono”, it is nonetheless not merely descriptive of Applicant’s services. While “pro bono” would of course be merely descriptive of legal services per se, “legal services” are not the services for which Applicant has applied.¹⁰

We agree with Applicant that “pro bono” is merely descriptive, if not generic, used in connection with legal services, particularly provided to clients who are unable to pay. Moreover, according to Applicant’s own website, its “Operating an online marketplace for providers and consumers of free and affordable legal services” concerns “connecting” attorneys (providers) able to provide free legal services with clients (consumers) in need of free legal services. In other words, Applicant’s services under its applied-for mark connect providers of pro bono legal services with consumers in need thereof. As a result, PROBOKNOW immediately describes an essential function, feature or characteristic of the identified services.

Applicant also argues in the alternative that its applied-for PROBOKNOW mark is a double entendre. Applicant relies upon *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062 (TTAB 2008) (involving the mark “FARMACY”) and *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994) (involving the mark “MUFFUNS”) in support of its argument that

¹⁰ *Id.* at 5.

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The Board should feel confident in believing that the public would easily recognize two meanings in PROBOKNOW. The first being “pro bono” and the second being a telescoped word combining “pro bono” with the word “know(ledge)”. Whether the latter is an existing word is irrelevant as discussed above. All that matters is that consumers will clearly see this “meaning” of the mark because “KNOW” is at least as recognizable as “FUN” in MUFFUNS and “FARM” in FARMACY.

However, to the extent that consumers may view PROBOKNOW as a combination of “pro bono” and “knowledge,” the resulting meaning merely conveys a feature or function of Applicant’s services, which is that Applicant offers knowledge of pro bono services to providers and consumers. This does not constitute a double entendre.

Finally, in reaching our conclusion that Applicant’s applied-for mark is merely descriptive, we have considered Applicant’s argument that “the Examining Attorney did not use the TTAB’s standard three-pronged test”¹¹ to determine whether a mark is suggestive rather than descriptive: (1) the degree of imagination test, (2) the competitors’ need test, and (3) the competitors’ use test. Applicant bases this argument on *No Nonsense Fashions Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). However, these “tests” were set out in an inter partes case in a discussion of whether use of a term by third parties on their packaging detracted from the plaintiff’s trademark rights. Thus, to the extent that Applicant is suggesting that the Office must prove all three points, Applicant is incorrect. Since this decision issued in 1985, there have been numerous decisions from the Court of Appeals for the Federal Circuit and the Board making clear that the test for descriptiveness is whether a term “immediately conveys knowledge of a quality, feature, function, or

¹¹ *Id.* 6-7.

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characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the United States of America*, 102 USPQ2d 1217, 1219 (fed. Cir. 2012), citing *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831, citing *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well established that even if an applicant is the only user of a merely descriptive term, this does not justify registration of that term. *See In re BetaBattInc.*, 89 USPQ2d 1152, 1156 (TTAB 2008); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985). Applicant’s arguments with respect to the lack of evidence of third-party use of PROBOKNOW for its services goes to the particular spelling of PROBOKNOW. We have already discussed why the misspelling of the merely descriptive term “pro bono” does not make Applicant’s applied-for mark registrable.

III. Conclusion

We have carefully considered all of the evidence and argument of record, including any arguments and evidence not specifically discussed herein. We conclude that Applicant’s mark, PROBOKNOW is merely descriptive of its identified services. Trademark Act Section 2(e)(1).

Decision: The refusal to register under Section 2(e)(1) is AFFIRMED and registration to Applicant is refused.