



**GALBUT BEABEAU**  
A PROFESSIONAL CORPORATION  
LAWYERS & COUNSELORS

November 21, 2019

**Via TEAS**

Tracy Cross  
Trademark Examining Attorney  
Law Office 109  
Alexandria, Virginia 223144-5793

**Re:** Response to Office Action  
**Serial No.:** 88313218  
**Applicant:** Advocate, L.L.C.  
**Design Mark:** ADVOCATE (“Applicant’s Mark”)  
**Date of Application:** February 23, 2019  
**International Class:** 037  
**Filing Basis:** 1(a)

On behalf of Applicant Advocate, L.L.C., please find the following response to your office action correspondence dated May 4, 2019 (the “Office Action”) which parallels the November 4, 2019 office action response submitted by Applicant in support of Serial No. 88304165.

**A. Trademark Section 2(e)(1) refusal.**

Applicant respectfully submits Applicant’s Mark is not descriptive, but suggestive, of its services. “Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning.” TMEP § 1209.01(a).

“A merely descriptive term is one which, when seen on the goods, immediately informs one of a characteristic, ingredient, quality, or attribute of the goods. One which is only suggestive requires some imagination, thought or perception to determine its meaning in relation to the goods. It has long been acknowledged that there is a very narrow line between terms which are merely descriptive and those which are only suggestive.” *In re Atavia Inc.*, 25 U.S.P.Q.2d 1361 (TTAB 1992).

The term “advocate” does immediately inform one of construction advisory services. The term – which is both a verb and a noun – is used in a variety of contexts. The public is not able to discern from ADVOCATE that Applicant offers a wide swath of services including pre-construction services, bidding services, lending services, and construction management services. “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). None of these services are synonymous with the term “advocate” and none are described/incorporated

as part of Applicant’s Mark. *See In re Southern National Bank of North Carolina*, 219 U.S.P.Q. 1231 (TTAB 1983) (holding MONEY 24 suggestive, not descriptive, of banking services available twenty-four hours a day); *In re National Overall Dry Cleaning Co.*, 123 U.S.P.Q. 556 (TTAB 1959) (holding the word element JOB FITTED was suggestive, and not descriptive, of services for rental, cleaning, and repair of working uniforms and industrial garments.). That Applicant’s services can be determined by reading the service descriptions on its website is inapposite because Applicant’s Mark does not incorporate these descriptions. It consists only of a word element that, in and of itself, is not descriptive of any particular service.

Rather than describe Applicant’s services, the ADVOCATE mark calls upon the viewer’s imagination, thought, and perception to reach a conclusion as to the nature of Applicant’s services. *See* TMEP § 1209.01(a). There is a multistage reasoning process needed to determine the attributes of Applicant’s services after encountering Applicant’s Mark -- it is not self-evident. This is a key distinguishing attribute of a registrable suggestive mark.

There is also incongruity in Applicant’s use of the term “advocate” that favors registrability. The term “advocate” is associated with legal services and defined as “*specifically*: one who pleaded the cause of another before a tribunal or judicial court.” *See* Merriam-Webster definition attached to Office Action. The incongruity between the traditional use of the term for legal services and Applicant’s use for its construction-related business “is a strong indication that a mark is suggestive rather than merely descriptive.” TMEP § 1209.01(a) *citing In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978).

The suggestive nature of “advocate” and the incongruity in its use for non-legal services is evidently the reason the USPTO has registered several servicemarks incorporating the term on the Principal Register for a variety of services. Applicant submits the Trademark Office should apply the same rationale here in approving registration of Applicant’s Mark. The table below identifies fifteen servicemark registrations that incorporate the term “advocate.”

Mark	Reg. No.	Class	Goods/Services
THE TENANT’S ADVOCATE	3066834	036	Real Estate Agency and brokerage services.
ADVOCATE, EDUCATE AND CONNECT	3372228	035	Business information services, namely, providing information concerning increasing the number of women serving on corporate boards and recognizing accomplished women and further expanding their influence within their respective business communities by helping to increase awareness for the need to increase the number of women serving on corporate boards.



ADVANCE, ADVOCATE AND INSPIRE	4239310	035	Association services, namely, promoting the interests of case management in the field of health services.
THE PLAN ADVOCATE	4477534	036	Financial retirement plan consulting services.
MYELDERADVOCATE	4623492	035, 036, 045	Assistance, advisory services and consultancy with regard to elder care crisis intervention, namely connecting elderly persons with qualified elder care service providers; assistance, advisory services and consultancy with regard to elder care, namely providing advice regarding long term care planning; mediation of disputes regarding elders, their families, caregivers and stakeholders; case management services, namely coordination of legal services, medical services, personal care services offered by nursing home facilities ... providing patient advocate services to hospital patients and patients in long term facilities ... hospital intervention on behalf of elderly patients, namely providing patient advocate services to hospital patients.
THE ETIQUETTE ADVOCATE	4655056	041	Business education and training services, namely, developing customized incompany leadership and executive development programs, providing executive coaching services, and providing public and in-company keynote presentations to business leaders.
ARMY OF ADVOCATES	4802722	035	Promoting public interest and awareness of issues impacting public education.
ADVOCATE	4887641	037	Consulting services in the field of maintenance and repair of telecommunications infrastructure, namely, network hardware, apparatus and instruments.
ADVOCATE4ME	5232845	045	Personal concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs; Providing case management services, namely, coordinating legal, physical, social and psychological services for individuals.
THE INVESTORS' ADVOCATE	5246572	035	... consulting services in the design and development of courses of instruction and



			training all in the field of conforming to legal, regulatory, and ethical standards and requirements and in the field of business and business management and in creating standards and practices facilitating conforming to legal, regulatory, and ethical standards and requirements and in the field of business and business management; regulatory compliance consulting in the field of conforming to legal and regulatory standards and requirements and creating standards and practices facilitating conforming to legal and regulatory standards and requirements, all of the aforementioned exclusive of providing a newsletter for investment advice.
ADVOCATE. VALIDATE. ANSWERS.	5280883	045	Grief counseling; Adoption counseling; Spiritual counseling; Parenting counseling; After abortion care and counseling for men and women; Providing emotional counseling and emotional support services for pregnant women and parents; Parenting and family services, namely, pregnancy counseling and family counseling; Providing information about adopting children; Adoption referral services; Birth parent counseling services to women in crisis pregnancies, namely, providing information about birth and adoption options, parenting information and support, and emotional and spiritual support, and referrals to other community resources; Providing a website featuring information about parenting and adoption.
ADVOCATES 4 PEACE & URBAN UNITY	5322905	035	Charitable services, namely, organizing and conducting volunteer programs and community service projects; Charitable services, namely, organizing youth groups to undertake projects to benefit the needy and the community to encourage leadership, character, compassion, and good citizenship.
ASSET ADVOCATES	5507409	036	Real estate consulting and financing services.
PROPERTY DAMAGE ADVOCATES PROTECTIVE YOUR BEST INTERESTS	5666714	036	Assessing insurance claims; claims adjustment in the field of insurance.



Tracy Cross  
Trademark Examining Attorney  
Ser. No. 88313218  
November 21, 2019  
Page 5 of 5

CONSUMERSADVOCATE.ORG	5862915	035	Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail websites of others, and discount information.
-----------------------	---------	-----	--

In view of the foregoing and the controlling authority providing that any doubt in discerning between a suggestive mark and a merely descriptive mark be “resolved in favor of the applicant,” Applicant requests approval of its mark for registration. *See In re Atavio, supra.*

**B. Identification/classification of services.**

Applicant agrees to adopt the proposed modification to the identification of its services for International Class 37; namely to “**Construction management, namely, serving as owner's representative for construction projects; Construction services consulting.**”

Please contact me by telephone at (602) 955-1455 or e-mail if I can address any questions or if you require additional accommodation from Applicant as a prerequisite to registration.

Sincerely,



Olivier A. Beabeau  
Attorney of record

