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THE HONORABLE THOMAS S. ZILLY

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

THE CHRISTENSEN FIRM, a Washington
sole proprietorship,

Plaintiff,

v.

CHAMELEON DATA CORPORATION, a
Washington corporation; and DEREK S.
DOHN, an individual,

Defendants.

No. CV06-337 TSZ

**PLAINTIFF'S MOTION FOR
RECONSIDERATION RE
DISTINCTIVENESS OF MARKS**

Noted for Consideration:

February 14, 2008

I. INTRODUCTION AND RELIEF REQUESTED

Plaintiff The Christensen Firm moves this Court for an Order Granting Reconsideration of the Court's ruling that the terms "cc-law firm" and "the Christensen firm" are generic and descriptive marks, respectively. The Court has committed manifest error, and should reconsider it opinion and find that the marks are distinctive.

II. ARGUMENT

On January 31, 2008, this Court granted Defendants' motion for summary judgment on Plaintiff's Anti-Cybersquatting and Consumer Protection Act claims on the basis that the Plaintiff's marks were either generic (cc-lawfirm) or descriptive (The Christensen Firm). Local

1 Rule 7(h) requires a party to show “manifest error in the prior ruling” in order to prevail on a
2 motion for reconsideration. *See also* Fed. R. Civ. P. 59(e) (specifying the timeframe for a
3 motion for reconsideration). The Court has committed manifest error and should reconsider its
4 ruling.

5 **A. The Mark “cc-lawfirm” is Distinctive.**

6 The Court found “cc-lawfirm” to be a generic mark. This ruling is manifest error. First,
7 the Court appears to have separated the term “cc-lawfirm” into its component parts “cc” and
8 “lawfirm” to determine that the mark is generic. The Ninth Circuit specifically prohibits
9 determining the validity of a mark “by an examination of its parts,” but instead requires a court
10 to “view[] the trademark as a whole.” *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d
11 1451, 1455 (9th Cir. 1985) (citation omitted). Even if “lawfirm” is deemed to be generic,¹ its use
12 with the term “cc” would render the mark, at a minimum, descriptive. *See* Ninth Circuit’s Model
13 Civil Jury Instruction No. 15.9 (“Judy’s Juice” is an example of a descriptive term).

14 The Ninth Circuit and other courts, however, have found that the combination of initials
15 with descriptive or generic terms creates a distinctive mark. *See, e.g., Official Airline Guides,*
16 *Inc. v. Goss*, 856 F.2d 85, 87 (9th Cir. 1988) (mark “OAG Travel Planner” was distinctive
17 because “OAG” coupled with the more descriptive term “Travel Planner” constitutes an arbitrary
18 mark). In *Varian Assocs. v. IMAC Corp.*, 1968 U.S. Dist. LEXIS 8845 (N.D. Ill. Nov. 8, 1968),
19 the court found that the plaintiff’s mark, EIMAC, was distinctive because it “was a natural
20 contraction of the surnames of William W. Eitel and Jack McCullough who were the founders of
21 Eitel-McCullough, Inc.” *Id.* at *3. Like EIMAC, the word “cc” does not describe the goods or
22 services offered. *See also Anlin Indus., Inc. v. Burgess*, 2007 U.S. Dist. LEXIS 20516, at *19

23
24 ¹ In Dkts. #99 and 106, Plaintiff cited *Degidio v. West Group Corp.*, 191 F. Supp. 2d 904, 911-14
(N.D. Ohio 2002), where the court indicated that “Lawoffices.net” was a descriptive mark.

1 (E.D. Ca. Mar. 5, 2007) (the mark “Anlin” is a combination of letters from the names of the
2 owners, and, as such, is a distinctive mark); *Jaro Transp. Svcs. v. Grandy*, 2006 U.S. Dist.
3 LEXIS 62932, at *16-17 (N.D. Ohio Sept. 5, 2006) (“Dalko” is a distinctive mark comprised of
4 the first initials of the Grandy family).² So, too, did the “cc-lawfirm” mark originate from the
5 last names of Ms. Christensen and her former partner, Art Clafin.

6 As Defendants conceded, the term “cc” could stand for any number of things, thereby
7 admitting that the mark could never be generic, or even descriptive. *See HQ Network Sys. v.*
8 *Executive Headquarters*, 755 F. Supp. 1110, 1120 (D. Mass. 1991) (a generic term “simply states
9 what is offered” and is typified by such terms as “camera” for a type of goods, “computer
10 programming” for a type of service, and “bank” for a type of business.). The mark is inherently
11 distinctive. Accordingly, this Court manifestly erred in finding “cc-lawfirm” to be a generic
12 mark.

13 **B. The Mark “The Christensen Firm” is Suggestive, not Descriptive**

14 The Court found “The Christensen Firm” to be a descriptive mark. This, too, is manifest
15 error. Plaintiff presented *prima facie* evidence that “The Christensen Firm” is distinctive
16 because the PTO has already determined that the word “Christensen” is distinctive. *See*
17 *Dkt. #70, Exhs. 5 and 6* (PTO’s service mark registration for “Christensen Farms,” and PTO’s
18 trademark and service mark registration for “Christensen,” both issued without proof of
19 secondary meaning). *See also Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112,

20 _____
21 ² There are also a number of cases in which a mark composed of the initials of a company’s full
22 name was found to be distinctive. *See, e.g., CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 684-85 (7th
23 Cir. 2001) (CAE mark was distinctive because it was an unpronounceable set of letters that appeared
24 without reference to the words from which it was derived: Canadian Aviation Electronics); *Elec.*
Communications, Inc. v. Elec. Components for Indus. Co., 308 F. Supp. 267 (E.D. Mo. 1969) (“As a
contraction or abbreviation, the mark ‘ECI’ is completely arbitrary and fanciful and is not descriptive or
suggestive of any of the goods, which may generally be termed electronic equipment, in connection with
which the mark is used.”).

1 119-20(1st Cir. 2006) (holding that the PTO's registration of other marks incorporating the same
2 term supports the inherent distinctiveness of the mark at issue); *Lahoti*, 2007 U.S. Dist. LEXIS
3 91997 at *23 (evidence that another company obtained trademark registrations from the PTO for
4 marks incorporating the term VERICHECK was evidence of distinctiveness). When Plaintiff
5 presented evidence that the PTO registered "Christensen," Defendants failed even to argue why
6 the addition of the word "Firm" to the distinctive mark "Christensen" would render the mark *less*
7 distinctive. Likewise, Defendants failed to provide any evidence that the replacement of the
8 word "Firm" for "Farms" would weaken what the PTO has already determined to be a distinctive
9 mark. *See* Dkt. #70, Exh. 5 (registration for "Christensen Farms"). Indeed, the use of the word
10 "Firm" makes the mark more suggestive than "Christensen Farms" because "Firm" does not
11 indicate whether the services provided are legal, architectural, etc. *See, e.g., Playtex Prods., Inc.*
12 *v. Georgia-Pacific Corp.*, 390 F.3d 158, 164 (2d Cir. 2004) (finding the term "Wet Ones," like
13 "Wite-Out," to be suggestive because it "could plausibly describe a wide variety of products").

14 In arguing against secondary meaning, Defendants repeatedly referred to Christensen
15 O'Connor Johnson Kindness. The relevance of the mark "Christensen O'Connor Johnson
16 Kindness" to the present dispute is that the PTO registered the mark. *See* Dkt. #75 at 5-6
17 (Defendants admitted federal trademark registration). Defendants failed to provide evidence
18 showing that "The Christensen Firm" is merely descriptive, when the PTO deemed "Christensen
19 O'Connor Johnson Kindness" to be distinctive.³

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23 ³ In fact, under Defendants' logic, the marks of all owner-named service firms would be merely
24 descriptive and, as a result, all such firms would have to show secondary meaning to the PTO before
registering their marks. This would leave all such firms in peril of cybersquatting.

1 **C. Plaintiff's Marks Acquired Secondary Meaning.**


2 Even if the marks are merely descriptive, Plaintiff presented a *prima facie* case of
3 secondary meaning. *See* Dkt. #106 at 6-8; Dkt. #110 at ¶¶ 2-7. "Proof of continuous and
4 exclusive use of a mark for five or more years establishes prima facie evidence of secondary
5 meaning for purposes of registering the mark. *See* 15 U.S.C. § 1052(f)." *Bishops Bay Founders*
6 *Group, Inc. v. Bishops Bay Apartments, LLC*, 301 F. Supp. 2d 901, 909 (W.D. Wis. 2003)
7 (applying rule to common law mark). *See also California Cooler*, 774 F.2d at 1454. At the very
8 least, Plaintiff's continuous and exclusive use of the marks creates a genuine issue of fact
9 regarding secondary meaning. Accordingly, summary judgment should have been denied.

10 **III. CONCLUSION**

11 For the foregoing reasons, Plaintiff respectfully requests that this Court grant Plaintiff's
12 Motion for Reconsideration re Distinctiveness of Marks.

13 RESPECTFULLY SUBMITTED this 14th day of February, 2008.

14 CORR CRONIN MICHELSON
15 BAUMGARDNER & PREECE LLP

16 
17 _____
18 William F. Cronin WSBA No. 8667
19 Attorneys for Plaintiff The Christensen Firm

1 **CERTIFICATE OF SERVICE**

2 The undersigned declares as follows:

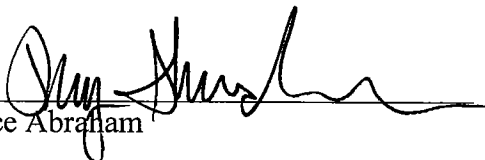
3 I am employed at Corr Cronin Michelson Baumgardner & Preece LLP, attorneys of
4 record for plaintiff The Christensen Firm herein.

5 I hereby certify that on February 14, 2008, I electronically filed the foregoing
6 document with the Clerk of the Court using the CM/ECF system, which will send notification
7 of such filing to the following person:

8 John David Du Wors
9 Newman & Newman
10 505 5th Ave. S., Ste. 610
11 Seattle, WA 98104-3846
12 Email: duwors@newmanlaw.com

13 I declare under penalty of perjury under the laws of the State of Washington that the
14 foregoing is true and correct.

15 DATED this 14th day of February, 2008, at Seattle, Washington.

16 
17 Joyce Abraham