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Paper No. 13
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American International Group, Inc.

Serial No. 75/737,853

Mark J. Liss and Tamara A. Miller of Leydig, Voit & Mayer for applicant.

Allison E. Hall, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by American International Group, Inc. to register the mark AIG EWRITER for "insurance services, namely, insurance administration and underwriting in the fields of management liability, directors and officers liability, corporate liability and employment practices liability; providing information in the field of insurance underwriting, namely, insurance rate calculations, insurance rate quotations, account

reservations, and issuing insurance policies via a global computer network."[1]

The Trademark Examining Attorney has made final the requirement to disclaim the term "EWRITER" apart from the mark because, according to the Examining Attorney, it is merely descriptive when used in connection with applicant's services.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.[2] An oral hearing was not requested.

The Examining Attorney maintains that the term "EWRITER" describes characteristics or features of applicant's services, namely, that applicant's services are offered electronically over the Internet and that the services involve insurance underwriting services. The Examining Attorney asserts that two descriptive terms, "e"

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[1] Application Serial No. 75/737,853, filed June 28, 1999, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth a date of first use anywhere and a date of first use in commerce of June 1999. Applicant claims ownership Of Registration No. 1,294,898 and others.

[2] Attached to the Examining Attorney's appeal brief are dictionary definitions, of which the Examining Attorney requests the Board to take judicial notice. Applicant has objected to the evidence as untimely. Although applicant is correct as to the untimeliness of the submission(see Trademark Rule 2.142(d)), this evidence is proper subject matter for judicial notice. Thus, we have considered this evidence in making our determination. We hasten to add, however, that even if these definitions were not considered, we would reach the same result in this case.

and “writer,” have been combined to form a composite term that remains equally descriptive of applicant’s services. In this connection, the Examining Attorney points to the manner in which the mark is actually used as shown by the specimens of record, “eWriter,” as evidence that consumers encountering the term would easily see it as comprising the descriptive elements “e” and “writer.” In support of the refusal, the Examining Attorney has submitted dictionary definitions, and excerpts retrieved from the NEXIS database.

Applicant, in urging that the refusal be reversed, argues that the mark sought to be registered is only suggestive because “it requires a consumer to exercise imagination, thought or perception to reach a conclusion as to the exact nature of the Applicant’s services.” (brief, p. 3) Applicant maintains that even if the individual words of a mark are descriptive, the combination of such elements as a composite mark may result in a composite which is not descriptive. Applicant goes on to state (brief, pp. 4-5):

> Applicant does not dispute that when an “E” is added to the beginning of a common word, consumers generally view that “E” as signifying “electronic.” The resulting term in some cases is merely descriptive of the services, such as “e-commerce” for

> electronic commerce, or "e-ticket" for tickets purchased electronically. But this in itself does not make "EWRITER" merely descriptive of Applicant's services.
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> While the term "write" may have some meaning in relation to insurance, in this case Applicant submits that consumers, upon viewing the term "EWRITER," will not immediately know the nature of the services offered under Applicant's composite mark "AIG EWRITER." Unlike the term "e-ticket," which has a very clear meaning to consumers, the word "EWRITER" does not. Because "EWRITER" appears as one word, rather than a hyphenated word (like e-ticket), consumers will be less likely to dissect it. Even if consumers view the "E" as signifying "electronic," the meaning of the term "EWRITER" will still not be clearly and immediately apparent to consumers. Consumers will have to stop and think about what the term "EWRITER" could mean. In other words, consumers will have to make a mental leap, and use "imagination, thought or perception to reach a conclusion as to the nature of the goods or services." [citations omitted]

Applicant maintains that with so many different definitions of the word "writer," consumers will have no way to know the nature of the services offered under the mark. To the extent that "writer" is a term of art in the insurance industry, ordinary consumers, according to applicant, are not familiar with this specialized meaning. Applicant also points to the absence of any evidence that the term

“EWRITER” is being used by others in the insurance industry. In this connection, applicant submitted the affidavit of one of its attorneys and the results of searches of the NEXIS and WESTLAW databases showing that the only uses (five) of “EWRITER” in insurance publications are in relation to applicant’s insurance services. The other uses revealed by the searches show the term used to describe authors who write letters, stories or books specifically for publication or transmission on the Internet.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, contrary to the gist of some of applicant’s remarks, whether a term is merely descriptive is determined not in the abstract but in

relation to the services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The prefix "e-" is defined as follows: "(Electronic-) The 'e-dash' prefix may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc." The Computer Glossary (9th ed. 1999). The NEXIS evidence of record makes it crystal clear that the prefix "e-" means electronic and refers to the publication or exchange of information in an electronic format as over the Internet. In point of fact, applicant's specimen indicates that applicant offers its services, under the mark AIG EWRITER, via a "new web-based system" to those who log on to access.aig.com.

The word "writer" has a variety of meanings, including "to underwrite, as an insurance policy." The American Heritage Dictionary of the English Language (3rd ed. 1992). The NEXIS evidence shows uses of the word in connection with insurance companies, of which the following are representative: "the nation's second-largest auto writer based on 1998 net premiums written"; "reinsurers and direct writers will need to reflect this in pricing"; "analysts have long been expecting Allstate to become a direct writer--through phone, Internet or other direct channels"; and "Sirius America is a direct insurance writer." The

evidence shows that, among both ordinary consumers and individuals in the insurance industry, the term “writer” is a commonly used and understood term relating to insurance products and services.

Applicant, as noted above, “does not dispute that the initial ‘e’ is commonly used and known as an acronym for ‘electronic’” and “that when the letter ‘e’ is added as a prefix to a generic or descriptive word, the resulting term is sometimes merely descriptive or generic for the goods or services it is used to identify.” Further, applicant concedes that “the term ‘write’ may have some meaning in relation to insurance.” We do not share applicant’s view, however, that the combination of the terms results in a composite mark that is only suggestive.

The evidence of record establishes that the term “EWRITER,” when used in connection with applicant’s insurance and insurance-related services, immediately describes, without conjecture or speculation, a significant feature of the services, namely, that the services involve the underwriting of insurance by electronic means over the Internet. Contrary to applicant’s arguments, nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for consumers and prospective purchasers to readily perceive

this merely descriptive significance of “EWRITER” as it pertains to applicant’s specific services.

Applicant repeatedly makes the point that the term “writer” has a variety of meanings and that consumers, upon encountering “EWRITER,” will not immediately know the nature of the services offered under the proposed mark. It should be remembered, however, that the other meanings of “writer” or even “e-writer” (referring to an author who writes for distribution on the Internet) are largely irrelevant as we must consider the mark in relation to the services recited in the application. See: In re The Officers’ Organization For Economic Benefits, Limited, 221 USPQ 184 (TTAB 1983); and In re Bright-Crest, Ltd., supra. The term “EWRITER” takes on a specific, merely descriptive meaning when used in connection with insurance writing services offered over the Internet. See: In re Styleclick.com Inc., 57 USPQ2d 1445 (TTAB 2000) [E FASHION is merely descriptive of, inter alia, electronic retailing services via a global computer network featuring apparel and fashions]. This is especially the case given that applicant actually uses the term in its specimen as “eWriter.”

The fact that applicant may be the first or only entity using “EWRITER” in the industry is not dispositive.

In re Helena Rubinstein, Inc., 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969); and In re Central Sprinkler Co., 49 USPQ2d 1194, 1199 (TTAB 1998).

Decision: The refusal to register is affirmed in the absence of a disclaimer of the descriptive term “EWRITER.” Applicant is allowed thirty days from the date of this decision to submit a disclaimer of “EWRITER” apart from the mark. If the disclaimer should be submitted, this decision will be set aside. Trademark Rule 2.142(g).