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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gallup, Inc.

Serial No. 76188426

Serial No. 76188427

Jay H. Begler and Janel Calliham of Buchanan Ingersoll for
Gallup, Inc.

Hellen M. Bryan-Johnson, Trademark Examining Attorney, Law
Office 114 (Margaret Le, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The two applications involved herein were filed on
January 2, 2001 by Gallup, Inc. (a Nebraska corporation) to
register on the Principal Register the marks EMPATHY
(application Serial No. 76188426) and DISCIPLINE
(application Serial No. 76188427), both for "providing a

personal analysis of an individual's inherent strengths over an interactive website on a global computer network" in International Class 42. Applicant asserts a bona fide intention to use the mark in commerce in both applications.

The Examining Attorney has refused registration in each application under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark (EMPATHY or DISCIPLINE), when used in connection with applicant's services, is merely descriptive thereof.

When the refusal to register was made final, applicant appealed in each application. Both applicant and the Examining Attorney have filed briefs. In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of the oral hearing and this final decision. An oral hearing was held before the Board on October 15, 2003.

With regard to the issue of mere descriptiveness, it is the Examining Attorney's position that the terms EMPATHY and DISCIPLINE are each "merely descriptive of an online service which analyzes an individual's personal strengths, because it describes one of the individual strengths that the service could identify a prospective client possesses" (brief, p. 1); that the words EMPATHY or DISCIPLINE each

describe one of the "inherent strengths" which applicant's service is designed to identify in prospective customers; that other meanings for these words are not relevant in the context of applicant's services; and that consumers need not go through a multi-step process to understand the descriptive nature of these words in relation to applicant's services.

In support of the descriptiveness refusals, the Examining Attorney has made of record in these cases the following definitions from The American Heritage Dictionary (Third Edition 1992):

- (1) empathy noun 1. Identification with and understanding of another's situation, feelings, and motives...;
- (2) discipline noun 1. Training expected to produce a specific character or pattern of behavior, especially training that produces moral or mental improvement...;
- (3) trait noun 1. A distinguishing feature, as of a person's character...; and
- (4) characteristic noun 1. A feature that helps to identify, tell apart, or describe recognizably; a distinguishing mark or trait..., adjective Being a feature that helps to distinguish a person or thing; distinctive...

In addition, the Examining Attorney submitted the following dictionary definition from Merriam-Webster's Collegiate Dictionary (Tenth Edition):

strength n. ... 4 b. a strong
attribute or inherent asset.

The Examining Attorney also submitted photocopies of several excerpted stories retrieved from the Nexis database to show that consumers understand the words EMPATHY or DISCIPLINE refer to recognized characteristics, traits or strengths. Examples of these excerpted stories are reproduced below (emphasis added):

Headline: Miami's Coker, Morris, Clark
Lead By Example
..."The best trait a coach can have is **empathy**. You have to understand that there are going to be differences between you and your players, but you have to respect those differences."
"The Miami Herald," January 30, 2002;

Headline: Ponder, Enjoy 'Qualities of Life'
...Today in the IN Life Section, you can see his project "Qualities of Life."
Shin found and photographed people who exemplify characteristics such as generosity, honor and **empathy**... . "The Spokesman-Review (Spokane, WA)," December 25, 2001;

Headline: Ephrata Welcomes Regal Visitor; Miss America Angela Perez Baraquo Urging Character Education
...Starting with 59 traits suggested by the group, the list was winnowed down to the 12 deemed most important. The traits selected were respect,

integrity, responsibility, self-discipline, positive attitude, self-control, compassion, cooperation, accountability, perseverance, altruism and **empathy**. ... "Intelligencer Journal (Lancaster, PA)," February 12, 2001;

Headline: Stanley and Dorothy Frank Named Philanthropists of the Year ...established the Dorothy and Stanley Frank Family Fellows Program at Guilford, which identifies and supports young people who aspire to a career in business or industry, who have an interest and commitment to traditional American values and the economic system, and who have the personal characteristics of **discipline**, integrity, creativity and initiative... . "News & Record (Greensboro, NC)," November 23, 1997;

Headline: SAT Not a Predictor of Success ...Many educators are convinced that standardized-test scores cannot by themselves reflect the wide range of abilities or accomplishments of any applicant. Nor can these measures forecast a person's promise or success excluding a host of other personal characteristics such as drive, **discipline** and self-confidence... . "San Antonio Express News," October 4, 1997; and

Headline: Latino Young Adults Hold the Future ...According to a poll of these young marchers conducted by Hispanic Link News Service, they overwhelmingly believe they will succeed in life through personal characteristics like self-confidence, compassion, **discipline**, ambition, open-mindedness, civic mindedness and perseverance.

"Albuquerque Journal," October 19,
1996.

Applicant urges reversal arguing that the marks EMPATHY and DISCIPLINE are suggestive as it requires some degree of imagination to connect the words with applicant's services; that the Examining Attorney has not submitted any dictionary definition of either the word "EMPATHY" or the word "DISCIPLINE" which specifies the services applicant offers; that the dictionary definitions of each word include other meanings; that consumers must engage in a multi-step reasoning process to understand that "EMPATHY" or "DISCIPLINE" refers to an inherent strength as part of applicant's analysis; that there is no evidence of any competitor's use of the words for similar services; that competitors would remain free to use the words in a "non-trademark manner" (brief, p. 8); and that doubt is to be resolved in applicant's favor.

The test for determining whether a mark is merely descriptive is whether the word or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978);

In re Eden Foods Inc. 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark does not have to describe every quality, characteristic, function, ingredient, attribute or feature of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the mark describes a single significant quality, feature, function, etc. thereof.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the word or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether 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). Rather, the question is whether someone who knows what the goods or services are will understand the word or phrase to convey information

about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

We agree with the Examining Attorney that the asserted marks, EMPATHY and DISCIPLINE, each immediately describes a significant characteristic or feature of the services on which applicant intends to use its marks. The dictionary listings for the words "empathy" and "discipline" establish their meanings in the English language. The Nexis evidence shows that these words are often used to describe positive characteristics or traits (or inherent strengths) of individuals. Consumers would understand these two words in their normally understood meanings relating to characteristics or traits or strengths in the context of applicant's providing a personal analysis of an individual's strengths through an interactive website. See *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505 (CCPA 1980); *In re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985); and *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982).

Each word (EMPATHY or DISCIPLINE) is commonly used to describe those strengths in individuals. Thus, the plain meaning of these words, when used in relation to applicant's services, "providing a personal analysis of an

individual's inherent strengths over an interactive website on a global computer network," immediately conveys that EMPATHY or DISCIPLINE are each characteristics which applicant's service could identify as an individual's strengths. Simply put, the stated function of applicant's services, as identified, is to identify a person's inherent strengths and these two words identify two such strengths. The fact that the words may have other meanings in other contexts does not negate the descriptive meaning of the words in relation to applicant's online personal analysis services.

Moreover, when the Examining Attorney required information regarding applicant's services and how the marks may be used in a service mark manner, applicant stated in each application that the "mark is not in use as a trademark [sic-service mark], however, the word is used in a program, Gallup Strengths Finder, which evaluates certain inherent strengths" (Supplemental response, filed August 12, 2002); and applicant enclosed materials therewith. Applicant's materials clearly show that the trademark/service mark thereon is "Strengths Finder The Gallup Organization"; and the three-page document lists numerous "themes," each named by a single word such as

"Achiever," "Analytical," "Arranger," "Command,"
"Discipline," "Empathy," "Focus," "Learner," and "Relator."

Applicant's own use of the words "Empathy" and "Discipline" in these materials adds credence to our finding that purchasers and prospective purchasers of applicant's online personal analysis of individual strengths, upon consideration of the words "empathy" or "discipline" used in connection therewith, will immediately know a significant feature of its service, i.e., that empathy and discipline are possible individual inherent strengths. Such purchasers or prospective purchasers will not need to engage in even the slightest degree of cogitation or reasoning to understand the significance of these words when used in conjunction with the service. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, supra; *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Inasmuch as the record establishes that each of these words, EMPATHY and DISCIPLINE, unquestionably projects a merely descriptive connotation with regard to applicant's online personal analysis service, we believe that competitors have a competitive need to use these terms.

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See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994);
and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair
Competition, §11:18 (4th ed. 2001).

Decision: The refusal to register under Section
2(e)(1) is affirmed in both applications.¹

¹ It is clear from the materials submitted by applicant (and as acknowledged by applicant) that the two words involved herein are not currently being used as a service mark to indicate the source of applicant's services. If applicant ultimately prevails on the merely descriptive issue on appeal on the records in these applications, and if applicant eventually files a Statement of Use in either application, the Examining Attorney would be free to consider the issues of whether or not the word(s) are used as service marks, and whether or not the word(s) are merely descriptive based on applicant's use of the word(s) on any specimen(s).