

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: June 27, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wells Fargo Home Mortgage,
a division of Wells Fargo Bank

Serial No. 76624811

Brian J. Laurenzo of Dorsey & Whitney for Wells Fargo Home Mortgage, a division of Wells Fargo Bank.

Fred Mandir, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Walters and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Wells Fargo Home Mortgage, a division of Wells Fargo Bank, has filed an application to register on the Principal Register in standard character form the mark THE RELOCATION MORTGAGE PROGRAM for "mortgage lending services," in International Class 36.¹ The application, as filed,

¹ Serial No. 76624811, filed December 15, 2004, based on use of the mark in commerce, alleging first use and use in commerce as of October 3, 1983.

includes a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f).

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), and asserted that applicant's showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), is insufficient.²

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Basis of Refusal

Regarding the basis for refusal, we note that in the final refusal the examining attorney stated that the evidence he submitted shows that "THE RELOCATION MORTGAGE PROGRAM is highly descriptive or generic for applicant's services." In his brief, the examining attorney makes the following statements (pp. 2 and 6 respectively):

The crux of applicant's argument is that the [PTO] has not proven that the proposed mark is generic as applied to the services, and therefore registration of the proposed mark must be allowed on the Principal Register. ... However, the proposed mark was not refused under Trademark Act Section 23. The sole refusal of record is under Section 2(e)(1) and applicant's claim for registration under Section 2(f) was deemed insufficient to overcome the refusal under Section

² In the initial Office action, the examining attorney required a disclaimer of MORTGAGE PROGRAM apart from the mark as a whole. Applicant argued against this requirement and the examining attorney did not repeat the requirement. Thus, we conclude that the disclaimer requirement was removed and the issue is not before us in this appeal.

2(e)(1). Under Section 2(f) it is the applicant, not the [PTO], who has the burden of proving the acquired distinctiveness.

. . .
The evidence of record ... shows that consumers would understand that a relocation mortgage program is merely a specific type of mortgage lending service and that the designation "the relocation mortgage program" is generic for applicant's services.

We agree with applicant that the examining attorney has used both the terms "highly descriptive" and "generic," creating some confusion. However, in response to applicant's statements about whether the mark is generic, the examining attorney clearly stated that the basis for the refusal is that the mark is merely descriptive, under Section 2(e)(1) of the Trademark Act, and that the evidence applicant submitted under Section 2(f) of the Trademark Act does not establish that the proposed mark has acquired distinctiveness. We find this to be a clear statement of the ground for refusal. Therefore, the issue of whether THE RELOCATION MORTGAGE PROGRAM is a generic term for the identified services is not before us in this appeal.

Descriptiveness

Applicant has conceded the mere descriptiveness of the term sought to be registered by seeking registration pursuant to Section 2(f) in the original application. In essence, applicant's Section 2(f) claim of acquired distinctiveness is a concession that the mark is not inherently distinctive and that it therefore is not

registrable on the Principal Register absent a sufficient showing of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact."] (emphasis in original); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). Thus, the issue of mere descriptiveness is deemed to be conceded in this appeal.

Moreover, after reviewing the evidence submitted by the examining attorney in support of his position that the proposed mark is merely descriptive and that acquired distinctiveness is not established, and by applicant in rebuttal, we agree that the THE RELOCATION MORTGAGE PROGRAM is merely descriptive in connection with "mortgage lending services" for the reasons indicated below. In other words, when applied to applicant's services, the term THE RELOCATION MORTGAGE PROGRAM immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, that applicant has a program of providing mortgage lending services, including to relocating employees and their employers. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers

of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term THE RELOCATION MORTGAGE PROGRAM as it pertains to applicant's services. See *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Acquired Distinctiveness

Applicant has the burden of proving that its mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant").

"[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha International Corp., supra* at 1008.

Because the examining attorney alleges that the proposed mark is "highly descriptive" and that the evidence of acquired distinctiveness is insufficient to establish acquired distinctiveness, we review the evidence of descriptiveness submitted by the examining attorney and, in rebuttal, by applicant. The examining attorney has submitted the following evidence³:

³ Applicant argues that the evidence is minimal in view of the amount of information available on the Internet. We disagree and note that the amount of evidence of descriptiveness of the individual terms, various combinations of those terms and the mark as a whole, considered in the context of the particular evidence submitted, leads us to conclude that

- excerpts of web page section titles from two third-party Internet websites referring to "RELOCATION MORTGAGE PROGRAMS FOR COMPANIES" [Wachovia] and "RELOCATION MORTGAGE SERVICES" [Weichert Financial Services]
- dictionary definitions of the individual terms comprising the mark, including, under the definition of "mortgage," an extensive list of types of mortgages that does not include a "relocation mortgage"
- excerpts from nine third-party Internet websites, wherein the following phrases are used to describe a particular service or product:
 1. "mortgage program" [one site],
 2. "preferred mortgage programs" [one site],
 3. "reverse mortgage program" [one site],
 4. "relocation mortgages" [three sites],
 5. "relocation mortgage services" [one site],
 6. "The Corporate Relocation Mortgage Program" [one site],
 7. "Home Services Relocation Services - Special Relocation Mortgage Program" [one site]
- excerpts from five third-party Internet websites, all of which use the phrase **relocation mortgage program(s)**, but none referring to applicant (*emphasis added*):
 1. "The \$168 million in mortgages were originated by Prudential Home Mortgage, under its **relocation mortgage program**, for companies that transfer employees." [online *New York Times Archive*]
 2. "Miles are not awarded for loans obtained through E-LOAN's **relocation mortgage program** or any other special programs, promotions or discounts." [airmileoffers.com]

the record is sufficient to establish that the mark is highly descriptive.

3. "Mr. Cunliffe also developed **relocation mortgage programs** for Banco Mortgage (now Norwest Mortgage) and converted the company to a relocation mortgage operation and a pure direct-to-consumer marketing organization." [realestate.com]
4. "Mortgage Assistance - Mayflower can assist the transferee with the financing of their new home while helping them control their costs. Special features such as pre-approvals, buy-downs, and closing specials may be available to your employees through specific **relocation mortgage programs.**" [imsrelo.com]
5. "Mark D. Carlson, VP, Technology, at Nexstar Financial Corporation, a provider of mortgage outsourcing solutions for many of the nations top lenders, as well as a leader in providing corporate and **relocation mortgage programs**, added ..." [adventnet.com]

In rebuttal, applicant submitted a substantial amount of evidence, including the following⁴:

- The summary results of a Google search for THE RELOCATION MORTGAGE PROGRAM, with copies of pages from the Internet websites identified therein. Each appears to use the phrase as a specific reference to applicant's services. It appears that many of the websites are owned by brokers or businesses affiliated with applicant that offer applicant's products.

⁴ Applicant also submitted several items that are of limited or no probative value:

(1) Copies of pleadings in several trademark infringement actions that applicant has brought against third parties. The pleadings refer only to applicant's marks "WELLS FARGO" and "WELLS FARGO MORTGAGE" and are not relevant to the mark herein.

(2) Copies of numerous third-party registrations for mortgage services for marks that do not contain applicant's proposed mark, perhaps to show that third parties do not use, or need to use, this term. While we acknowledge that it is difficult to prove a negative, this evidence does not establish this point, nor is it otherwise of probative value herein.

(3) Copies of third-party registrations that applicant contends are highly descriptive but were registered under Section 2(f). We remind applicant that each case must be decided on its own factual record and, therefore, these registrations are of no probative value. See *In re Nett Designs Inc.*, 236 F.3rd 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) and cases cited therein.

- Excerpts from applicant's website, including results of a Spring 2005 Web survey of 151 relocation managers, taken by Trippel Survey and Research, an independent firm in the relocation industry, that gave "Wells Fargo Mortgage" the top score for services satisfaction in the category of national mortgages providers.⁵
- Excerpts from applicant's website showing use of its proposed mark THE RELOCATION MORTGAGE PROGRAM, noting that the service and its products launched in 1981 and describing the nature of the services under the mark, including the statement "our relocation mortgage package is designed with features"

Additionally, we note the specimens submitted with the application. They consist of advertisements in two issues of the *Magazine of the Employee Relocation Council* and other advertising copy. The magazine advertisements are directed to employers and include the following statements:

- "When you offer employees the resources of the home lending leader, there's just no limit to the possibilities ... [f]rom assessing needs to customizing programs, we'll provide home financing solutions that work better ..."
- "We revolutionized our industry with **The Relocation Mortgage Program™**, the nation's first,"

The other specimen includes the following statements:

- "**The Relocation Mortgage Program™**"

⁵ We note that the relocation managers survey information reported on applicant's website refers to applicant as "Wells Fargo Mortgage" and does not refer to any other specific trademark of applicant, such as THE RELOCATION MORTGAGE PROGRAM. As applicant notes, the examining attorney did not submit the parameters of his Internet search, or state that the submission is "a representative sample" of his findings. However, in view of the dictionary definitions of the individual terms, the substance and amount of the additional evidence of use is sufficient for us to conclude that the term is highly descriptive in connection with the identified services.

- "A comprehensive **mortgage program** designed especially for transferees"
- "Our **relocation mortgage** package is designed with features to specifically meet your unique needs as a transferee."

The evidence clearly establishes that there are a substantial number of services and products offered by third parties to those involved in the corporate employee relocation process; that numerous financial and real estate businesses offer, to employers or directly to transferred and relocating employees, mortgage products that are known as "relocation mortgages"; and that businesses offer employers and employees various "mortgage programs" to assist with the employee "relocation" process. In fact, five websites excerpted in this record refer to their services informationally as "relocation mortgage programs"; another five websites, plus applicant itself, use the phrase "mortgage program(s)" informationally; and five other websites appear to refer to a mortgage product identified as a "relocation mortgage."

It is clear from this record that, in the mortgage lending field, each of the individual words comprising applicant's proposed mark is used regularly in a descriptive manner, as are various combinations of those words, including the entire phrase RELOCATION MORTGAGE PROGRAM. The proposed mark does not create a unique impression

through the combination of the words; rather, the words retain their common dictionary meanings. Considering the uses of the mark and its component parts by third parties and applicant itself is part of the determination of the descriptive nature of the mark as a whole, not a dissection of the mark as argued by applicant. Finally, we note that the article THE in the proposed mark is of little, if any, trademark significance. Thus, we agree with the examining attorney that THE RELOCATION MORTGAGE PROGRAM is highly descriptive in connection with mortgage lending services. We are not persuaded otherwise by applicant's evidence of third parties using the phrase as a mark to refer to applicant's identified services. Clearly, these third parties are brokers or businesses otherwise affiliated with applicant that are authorized to offer applicant's mortgage lending services, not relevant consumers. Thus, this evidence does not rebut the showing that the mark is highly descriptive.

In this case the standard of acquired distinctiveness is extremely difficult to meet because we have found that not only is THE RELOCATION MORTGAGE PROGRAM merely descriptive in connection with the identified services, but it is highly descriptive in connection therewith.

In support of its Section 2(f) claim, applicant submitted the following:

- The declaration of its associate general counsel attesting to "substantially exclusive and continuous use in interstate commerce for more than the five years preceding the filing date of ... [the] application"; and sales and advertising figures including, for the five years from 1998 through 2003, total sales of \$522.3 million, annual sales growth from \$65.7 million in 2000 to \$107.8 million in 2003, and advertising expenditures in connection with the services under the mark of \$20,500 each year from 1998 through 2002, and \$20,400 for 2003.
- Three essentially identical letters (from individuals at BellSouth, Price Waterhouse Coopers and Target Corporation) attesting to the purchase of applicant's services under the mark, and stating that the writer "regard[s] this name as identifying the services of Wells Fargo Home Mortgage ... only, and not of any other company making these or similar products."

Certainly, in view of the highly descriptive nature of the mark, the statement of substantially exclusive and continuous use for a period of more than five years is not sufficient to establish acquired distinctiveness. Applicant states that it has used the proposed mark since at least 1983; however, the evidence and advertising figures pertain only to the most recent several years prior to this appeal. In fact, those figures show that sales declined from \$81.2 million in 1998 to \$65.7 million in 2000, before rising slowly to \$107.8 million in 2003. Advertising dollars remained steady during the period, declining by a negligible \$100 in 2003. Applicant has provided no context for these figures - there is no information as to what average annual sales and advertising figures are in the mortgage lending field. Similarly, a mere three form letters from corporate

Serial No. 76624811

customers, clearly authored for the signors by applicant or its attorneys, do not establish that the proposed mark has acquired distinctiveness among the relevant consumers, namely, corporate employers and employees. The substantial evidence of use by third parties of the proposed mark and significant portions thereof indicate otherwise. Therefore, we conclude that applicant's Section 2(f) showing is inadequate to establish that THE RELOCATION MORTGAGE PROGRAM has acquired distinctiveness as a mark in connection with the identified services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.