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NOT A PRECEDENT OF
THE TTAB

Hearing: May 15, 2008

Mailed: August 11, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Premier Trust, Inc.

Serial No. 76644705

Edward A. Pennington of Bingham McCutchen LLP for Premier Trust, Inc.

Alyssa L. Paladino, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Hohein, Holtzman and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Premier Trust, Inc. (applicant) has filed an application to register on the Principal Register the mark reproduced below

PREMIER TRUST

for services ultimately identified as "financial planning and investment services, namely, providing management of personal trusts, self-directed IRA's, insurance trusts, asset protection trusts, mortgage escrow accounts, for individuals, and for

Serial No. 76644705

corporations, providing qualified retirement plans, namely, profit sharing, pensions, 401(k)'s, and maintaining escrow accounts for investments," in Class 36.¹

The trademark examining attorney has refused registration on the ground that the mark is merely descriptive of the services under Section 2(e)(1) of the Trademark Act.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was held.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive must be determined 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 term is used, and the possible significance that the term is likely to have to the average purchaser as he encounters the goods or services in the marketplace. See In re Engineering Systems Corp., 2 USPQ2d 1075, 1076 (TTAB 1986).

¹ Application Serial No. 76644705, filed August 11, 2005, based on an allegation of first use on July 13, 2001 and first use in commerce on September 2, 2004.

Furthermore, as the Federal Circuit has observed: "Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are also regarded as being descriptive.... Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services]." In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:17 (4th ed. 1996)).

We find that the term PREMIER TRUST is a laudatory term describing the superior quality or character of applicant's financial services which include the management of trusts.

The examining attorney has submitted an entry from *The American Heritage Dictionary of the English Language* (4th ed. 2000) (bartleby.com), defining "trust" as follows:

7 a. legal title to property held by one party for the benefit of another. b. The confidence reposed in a trustee when giving the trustee legal title to property to administer for another, together with the trustee's obligation regarding that property and the beneficiary. C. The property so held.

It is clear from the definition that the word "trust" refers to the property itself, as well as the management of the property. Applicant's services, as identified, include the management of trusts. Thus, the term TRUST in applicant's mark

Serial No. 76644705

is a descriptive, if not generic, name for applicant's trust management services.

As additional evidence of the descriptive meaning of TRUST, the examining attorney has submitted a number of third-party registrations for financial services involving trusts where the word "TRUST" has been disclaimed. For example, Registration No. 3234573 for the mark ENCORE TRUST (TRUST disclaimed) lists "trust services, namely, investment and trust company services; financial trust operations including trust administration for personal trusts, employee benefit trusts, corporate trusts"; and Registration No. 3182967 for the mark SOMERSET TRUST (TRUST disclaimed) lists "trust services, namely, financial trust operations, trust management accounts, investment and trust company services, estate trust management." Third-party registrations, while not conclusive, "are probative evidence of mere descriptiveness at least to the extent that they may suggest that [a term] has been deemed and/or acknowledged to be not inherently distinctive by the Office and/or by the prior registrants." *In re Alpha Analytics Investment Group LLC*, 62 USPQ2d 1852, 1856 (TTAB 2002).

To demonstrate the laudatory and descriptive meaning of PREMIER, the examining attorney has submitted a listing from *The American Heritage Dictionary*, supra, defining "premier" as "First in status or importance; principal or chief *an architect of*

premier rank." We take judicial notice of an additional dictionary, *Encarta® World English Dictionary* (North American Ed. 2007), with the following definition: "**best or most important:** first in importance, size, or quality." ² (Emphasis in original.)

There are also eight third-party registrations of record showing that the term PREMIER is disclaimed when the mark is used to identify financial services. The registrations include Registration No. 2931752 for the mark NEUBERGER BERMAN PREMIER PORTFOLIO (PREMIER PORTFOLIO disclaimed) for "investment advisory and management services, trust and estate planning services, and financial planning services; and Registration No. 2880094 for the mark ALM FIRST EXPERT ADVICE. PREMIER SERVICE. (and design) (ALM and EXPERT ADVICE PREMIER SERVICE disclaimed) for services including "investment advice, investment management, financial consulting and financial advisory services for others."

The individual words PREMIER and TRUST in the mark are descriptive, and the combination of the two words does not convert those words into a nondescriptive mark. The words, when combined, retain their descriptive meanings. The examining attorney has made of record printouts from applicant's website, premiertrust.com, showing that applicant's own promotional

² The Board may take judicial notice of dictionaries, including online dictionaries which exist in printed format or have regular fixed editions. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

materials tout the high or superior quality of its "trust" services. The website states, for example, that applicant's trust administration "is managed by professionals experienced on executing their fiduciary responsibilities with the highest levels of professionalism and personal attention"; that "PREMIER TRUST OFFERS SEVERAL ADVANTAGES over other trust service providers"; and that "This dedication translates into a higher standard of efficiency and service in the handling of your financial affairs."

It is clear from the dictionary definitions and other evidence of record that the term PREMIER is a nondistinctive, laudatory term which when combined with the word TRUST does nothing more than tout the superior or high quality of applicant's trust management services. Applicant's arguments to the contrary are not persuasive.

Applicant contends that the examining attorney has improperly dissected the mark. Applicant argues that the two words together connote a different meaning than each word by itself, and also that each word has other nondescriptive meanings. To support this contention, applicant relies on an entry from *Merriam-Webster's Collegiate Dictionary* (1998), defining "premier" as "first in position, rank, or importance," and also as "prime minister." Applicant argues that PREMIER in its mark can also mean "prime minister." In addition, according

to applicant, while PREMIER may suggest the services may be of high quality or may be top rated, it does not mean the services are "'ranked first' by some unknown authority whose responsibility it is to rank financial services." Noting that its services are complex financial services involving complex legal structures such as trusts, applicant argues that "in the world of financial planning at this level, rankings on the order of 'highest' to 'lowest' have virtually no meaning." Applicant argues that when dealing with other people's money, the meaning of "trust" in the organization applies; and that "the double entendre of 'trust' is significant because it suggests that applicant is a 'trustworthy' handler of the customer's assets."

First, the examining attorney has not improperly dissected the marks. It is necessary to understand the meaning of each word in the mark, PREMIER TRUST, before understanding the meaning of the mark as a whole. Furthermore, the combination of the individual words PREMIER and TRUST does not result in a term which is unique or incongruous or any less descriptive than each word alone. Viewed either as individual words or a combined phrase, PREMIER TRUST directly and immediately conveys the same information to the relevant public about the high quality of applicant's trust management services.

In addition, as we have said, the question of whether the mark is merely descriptive must be determined, not in a vacuum,

but rather in the context of the mark and in relation to applicant's services. The word TRUST, when viewed in its proper context, would be immediately understood by applicant's customers as referring to trust management, not to the "trustworthiness" of the company. Clearly, the word PREMIER, in the context of trust management services, would not be understood as a reference to a "prime minister." Nor would PREMIER be thought of as some kind of official ranking of applicant's services. Indeed, the question of whether applicant's services are, or can be, officially ranked is simply irrelevant. In the context of applicant's mark and services, PREMIER refers to the way applicant promotes or "ranks" itself and its services, that is, as being the "best" or "first...in quality." See *Encarta* entry, *supra*. Applicant clearly touts its trust management services as being of the highest quality, or of a higher quality than the trust management services of others.

In further support of its position that the mark is not descriptive, applicant argues that while there are over 2,500 applications and registrations containing the term PREMIER, in "most of these" such term is "neither disclaimed nor disallowed." Applicant, in particular, has made of record three third-party registrations for the mark PREMIER which are registered on the Principal Register without a Section 2(f) claim, and applicant asks the Board to take judicial notice of the others.

The Board will not, as applicant requests, take judicial notice of applications and registrations that are not properly of record. It has been stated in numerous cases that the Board does not take judicial notice of registrations that reside in the Office. See *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). See also *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485, n.4 (TTAB 2007). Furthermore, applicant's representations about the applications and registrations which are not properly of record and its claims about what they show or do not show, cannot be considered.

Moreover, the three third-party registrations which have been properly made of record are not persuasive. None of the registrations is for services that are similar to those herein. Registration No. 3004498 for the mark PREMIER is for such goods as "pedicure implements" and "corn and callus" creams and removers; Registration No. 3095093 for the mark PREMIER is for "security guard services; security services, namely, providing security and threat assessment to businesses and residences"; and Registration No. 3144268 for the mark PREMIER (and design) is for "providing property and casualty insurance underwriting services, risk management services." In any event, it is well settled that each case must be decided on its own facts, based on the particular mark, the particular goods or services, and the

Serial No. 76644705

particular record in each application. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

When applicant's mark PREMIER TRUST is viewed in relation to applicant's identified trust management services, applicant's clients and customers will immediately understand, without any guesswork or the exercise of any imagination, the laudatory and descriptive meaning of the mark as applied to those services.

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