

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed:
August 9, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John M. Floyd & Associates, Inc.

Serial No. 78259782

Daniel N. Lundeen of Lundeen & Dickinson, LLP for John M. Floyd & Associates, Inc.

John S. Yard, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

John M. Floyd & Associates, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register PRIVILEGE MANAGER MRM as a trademark for "computer software for use in providing management reports, custom reports and account holder communications for financial institutions in connection with the supervision of

overdrawn accounts and customer relations.”¹ Applicant states that MRM has been disclaimed. We note that Office records do not indicate such a disclaimer, although in its request for reconsideration, dated July 26, 2005, applicant states that MRM “has been disclaimed,” and in its reply brief, at p. 8, applicant has reiterated that MRM has been disclaimed. Accordingly, we have treated the application as including a disclaimer of MRM, and have arranged to enter such disclaimer in USPTO records.

Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant’s mark is merely descriptive of its identified goods.

The appeal has been fully briefed. Applicant did not request an oral hearing.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the

¹ Application Serial No. 78259782, filed June 9, 2003, based on Section 1(b) of the Trademark Act (intent-to-use). It is noted that applicant amended its identification of goods to that indicated above in its response filed on September 21, 2004, and that the Examining Attorney accepted this amendment in the office action mailed May 19, 2005, stating that this amended identification had been entered into the record. However, Office records still list the originally filed identification, and the Examining Attorney referred to this identification in his brief. Because the amendment to the identification was clearly accepted during the prosecution of the application, we have treated the amended identification as the operative one; Office records will be corrected to reflect this.

Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is enough that the term describe one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAAssociates, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). On the other hand, a mark is suggestive, and therefore registrable on the Principal Register without resort to the provisions of Section 2(f), if imagination, thought or perception is required to reach a conclusion on the nature of the goods

or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The Examining Attorney's position as to why applicant's mark is merely descriptive has evolved during the course of examination. Initially, the Examining Attorney asserted that PRIVILEGE MANAGER denotes a computer application which allows a user to compute, track and share information while maintaining owner access and control of the data, and that MRM is an acronym which denotes Member Relationship Management or Marketing Relationship Management. According to the Examining Attorney, applicant's goods are computer programs which allow users to compute, track and share information for purposes of member relationship management and/or marketing relationship management, and therefore PRIVILEGE MANAGER MRM is descriptive of applicant's goods. First Office action, mailed December 10, 2003. In support of this position, the Examining Attorney made of record excerpts from Internet sites which explained "privilege manager" as follows:

Privilege Manager technology allows state and local criminal justice agencies to share information with complete confidence and control.

Privilege Manager is a platform-independent access control system that

enables agencies to share information while maintaining control of their data. Applications incorporating Privilege Manager allow agencies to control their data based on role definitions and individual user attributes found in digital certificates. By utilizing policy-defined rule-sets, agencies transcend the traditional username, login access control paradigm.
www.templarcorp.com

Privilege Manager for UNIX
Description: Privilege manager for UNIX controls access to account privileges with the first out-of-the-box solution. It allows delegation of any UNIX user's authority, so that you can implement reasonable security controls, without impacting the ability of users to perform their daily work. With Privilege Manager for UNIX, responsibility for adding accounts, fixing printer queues, and other routine job functions can be safely assigned to the appropriate users—without disclosing the root password and compromising your company's valuable information.
www.itsecurity.com

In response to this Office action, applicant submitted "background" information about the nature of its goods:

...Applicant's software product and consulting services are marketed to credit unions and other financial institutions for them to monitor overdrawn accounts to which the credit union has granted overdraft benefits. Instead of returning the check or other NSF item, the credit union pays it and charges the credit union's customer a fee. The software can determine whether to pay the overdrawn item or to

return it NSF according to the credit union's guidelines; it generates or schedules telephone calls, emails, letters or other communications to the overdrawn account holder informing them of the overdraft until the overdraft is covered by a deposit; it keeps a historical record of the account status and communications; if necessary, it closes the account and turns it over for collections; and it provides reports to the credit union personnel about the status of the accounts and the overdraft program as a whole. Response filed September 21, 2004.²

After receiving this explanation the Examining Attorney revised the reason that he considered the mark to be merely descriptive. While not withdrawing the reasoning he gave in the first Office action, in the final Office action, mailed May 19, 2005, the Examining Attorney asserted that "the wording PRIVILEGE MANAGER applies to and is descriptive of the supervision of overdrawn accounts and the wording MRM applies to and is descriptive of customer relations," and that the mark as a whole is merely descriptive of the identified goods. The Examining

² In its brief applicant modified this description somewhat, indicating that the consumers are "banks and other financial institutions" rather than just credit unions. Further, applicant explained that it is the financial institutions themselves that have overdraft benefit software, and applicant's software does not implement the program, but merely works with the bank's existing program to oversee communications with the bank's overdrawn account holders. The slight difference in the explanation of the software has no effect on our determination of the issue of mere descriptiveness.

Attorney relied on dictionary and other evidence referring to "overdraft privileges" as "a term of art in the industry for discretionary benefit offered by financial institutions to customers as protection against overdrafts."

In his appeal brief, it appears that the Examining Attorney has taken the position that PRIVILEGE MANAGER MRM is merely descriptive for two reasons. As a unitary term, "PRIVILEGE MANAGER denotes a computer application which allows a user to compute, track and/or share information while maintaining owner access and control of the data." Brief, p. 4. Thus, according to the Examining Attorney, "applicant's software functions in a manner consistent with other Privilege Manager computer programs as referenced [by the evidence of record] herein, namely, it monitors and supervises overdraft account privileges while restricting access thereto and securing the data therein." Brief, p. 5. The Examining Attorney also asserts that "the individual terms PRIVILEGE and MANAGER are descriptive and together create the descriptive term PRIVILEGE MANAGER, notwithstanding and/or in addition to any term of art in the computer software field." Id. "Applicant's goods consist of manager software for managing bank overdraft privileges. ... That the privileges managed are overdraft privileges is implicit in the nature of the software."

Brief, p. 6. "In other words, applicant's software works with an existing financial institution's existing software to literally manage overdraft privileges." Brief, p. 7.

As pointed out by both applicant and the Examining Attorney in their briefs, applicant had another application, Serial No. 78245750, for a similar mark, PRIVILEGE MANAGER CRM, for identical goods that had been refused registration on the ground of mere descriptiveness. Applicant filed an appeal of that refusal and, subsequent to briefing in the instant appeal, the Board rendered a decision in the appeal of Application Serial No. 78245750 on July 24, 2006, reversing the refusal of registration. Because a different Examining Attorney examined that application, some of the evidence and the arguments were different from those in this case. However, many of the comments we made in rendering that decision are applicable herein.

In the prior appeal, the Examining Attorney asserted only the "unitary term" argument that has been put forth by the Examining Attorney here, namely, that applicant's software functions in a manner consistent with other Privilege Manager computer programs to monitor and supervise overdraft account privileges while restricting access thereto and securing the data therein. We found

that this position was not persuasive, agreeing with applicant that the relevant class of consumers would not regard the word "privilege," used in connection with the identified software, as referring to database access. We found, instead, that consumers would view "privilege" as referring to the overdraft privilege programs with which the software is used. We continue to hold that position based on the evidence in the current record.

As noted above, the present Examining Attorney also argues that, aside from the computer software meaning of PRIVILEGE MANAGER, the individual words combine to form a phrase that immediately informs consumers that applicant's software works with an existing financial institution's existing software to literally manage overdraft privileges. While we agree that consumers will view the word "privilege" in applicant's mark as referring to the overdraft privilege programs with which the software is used, rather than to the computer software meaning of accessing data, we do not agree that the mark as a whole, PRIVILEGE MANAGER MRM, immediately and directly conveys the requisite knowledge of a feature or characteristic of the software. Applicant's identification of goods shows that its software is used to provide management reports in connection with overdraft privilege programs. While the

words PRIVILEGE MANAGER thus have some relationship to applicant's software, there is no evidence that PRIVILEGE per se is readily recognized as meaning "overdraft privilege," or that when "privilege" is combined with "manager" consumers will immediately understand the resulting term, PRIVILEGE MANAGER, as describing software for management reports on overdraft privilege programs. Thus, the term does not directly impart information about the goods with the requisite degree of specificity. The words PRIVILEGE MANAGER are inadequate to convey direct knowledge of the goods; more words are needed for a consumer to ascertain what the software is designed to do. See *In re Southern National Bank of North Carolina*, 219 USPQ 1231 (TTAB 1983) (MONEY 24 suggestive of automatic teller machine services). Because imagination, thought, or perception is required to reach a conclusion on the nature of the goods, the mark PRIVILEGE MANAGER MRM is suggestive and therefore registrable.

Finally, to the extent that there is any doubt on the question of whether applicant's mark is merely descriptive, it is well established that such doubt must be resolved in applicant's favor. See *In re Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972).

Ser No. 78259782

Decision: The refusal of registration is reversed. As indicated above, applicant's disclaimer of MRM and its amended identification of goods will be entered in the record, and the application will then be forwarded to the Examining Attorney to arrange for publication.