

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

Mailed:  
January 15, 2008  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re EquityRG LLC

Serial Nos. 78674378 and 78674380

Anna W. Manville, Kimberley A. Isbell and Melissa Cross of  
Arnold & Porter LLP for EquityRG LLC.

Lourdes D. Ayala, Trademark Examining Attorney, Law Office  
106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Bucher and Holtzman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark **The Residence Company** (*in standard character format*)  
for services recited in the applications, as amended, as  
follows:

"financial services, namely management of  
capital and debt investment funds for  
investment in real estate; real estate  
agencies; real estate listing; real estate  
investment; real estate property management"  
in International Class 36;<sup>1</sup>

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<sup>1</sup> Application Serial No. 78674378 was filed on July 20, 2005  
based upon applicant's allegation of a *bona fide* intention to use  
the mark in commerce in connection with these recited financial  
and real estate services in International Class 36. No claim is  
made to the exclusive right to use the word "Company" apart from  
the mark as shown.

"construction services, namely, construction planning, general construction of residential and mixed-use real estate, general construction supervision, and construction project management services" in International Class 37; and

"design services, namely, architectural design and specification services, and interior design services" in International Class 42.<sup>2</sup>

These cases are now before the Board on appeal from the final refusals of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's recited services, i.e., that the term "The Residence Company" immediately informs potential purchasers about a characteristic or feature of applicant's services.

Applicant and the Trademark Examining Attorney fully briefed each appeal. The marks, the legal issues, the procedural histories and overall records are closely related in these two appeals. Accordingly, these cases were consolidated in order to issue a single opinion for these two applications to register, reversing the refusals to register as to all three classes of services.

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<sup>2</sup> Application Serial No. 78674380 was filed on July 20, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce in connection with these recited construction and design services in International Classes 37 and 42. No claim is made to the exclusive right to use the word "Company" apart from the mark as shown.

**Preliminary matters**

The Examining Attorney objects to applicant's reliance on certain applications and registrations, on the grounds that applicant did not submit printouts of the registrations. Ex. Atty. Appeal Brief p. 7. However, we agree with applicant that these registrations were properly made of record during prosecution. See TBMP § 1208.02. Alternatively, even if the applicant's attempts to place copies of Office records into these cases were insufficient, the Trademark Examining Attorney's failure to object to this evidence prior to the Trademark Examining Attorney's appeal brief results in the waiver of the objection. See *Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1153 n.3 (TTAB 2001).

Similarly, the Trademark Examining Attorney argues, in her brief, that applicant did not properly place dictionary definitions of the word "residence" into the record.<sup>3</sup> It is true that applicant simply argued in its response to the initial Office Action that the term "residence" has many meanings, and proceeded to list them in the text of its response:

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<sup>3</sup> Applicant submitted definitions of "residence" from *Webster's II New Riverside University Dictionary* (1994); Merriam-Webster Online, < [www.m-w.com](http://www.m-w.com) >; and *The American Heritage® Dictionary of the English Language* (4th ed. 2000).

The term "RESIDENCE" has many meanings. It can mean the place where one lives, or a commitment to work and live in a specific place - such as a "musician in residence" on a college campus, or it can refer to a period during which a physician receives specialized clinical training ...

However, this objection too is considered to have been waived since it was not interposed in response to applicant's reliance on such listings in its initial response. *Id.* In any case, we are free to take judicial notice of dictionary definitions, and do so herein.

### **Refusals under Section 2(e)(1) of the Act**

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers

immediately associate it with a quality or characteristic of the product or service."]. Hence, the ultimate question before us is whether the term **The Residence Company** conveys information about a significant characteristic or feature of applicant's services with immediacy and particularity.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods or services are after seeing applicant's mark alone. *In re Abcor*, *supra* at 218

["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313

(TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of



"real estate advertisement services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See *In re Omaha National Corp.*,

819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [the term



"first tier" describes a class of banks]; *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement

devices"]; *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

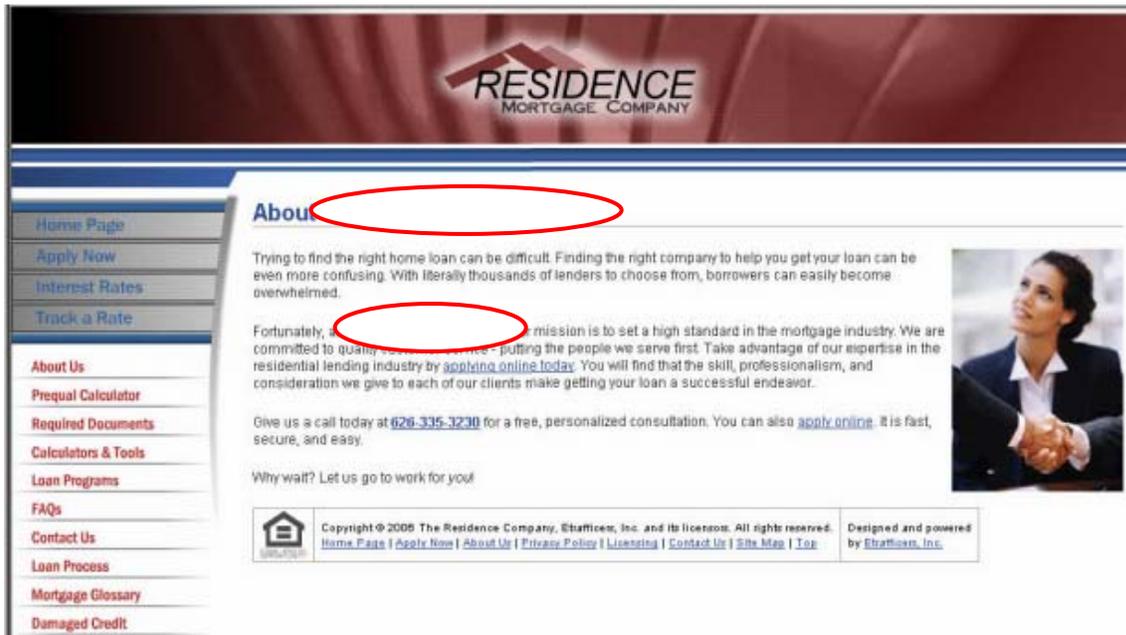
The Trademark Examining Attorney herein argues that applicant is a company that provides the services recited above "as it relates to residences or the places in which one lives or dwells." Hence, the Trademark Examining Attorney argues that when this mark is viewed in relation to the recited services, it is apparent that applicant features financial, design, construction and property management services for residences.

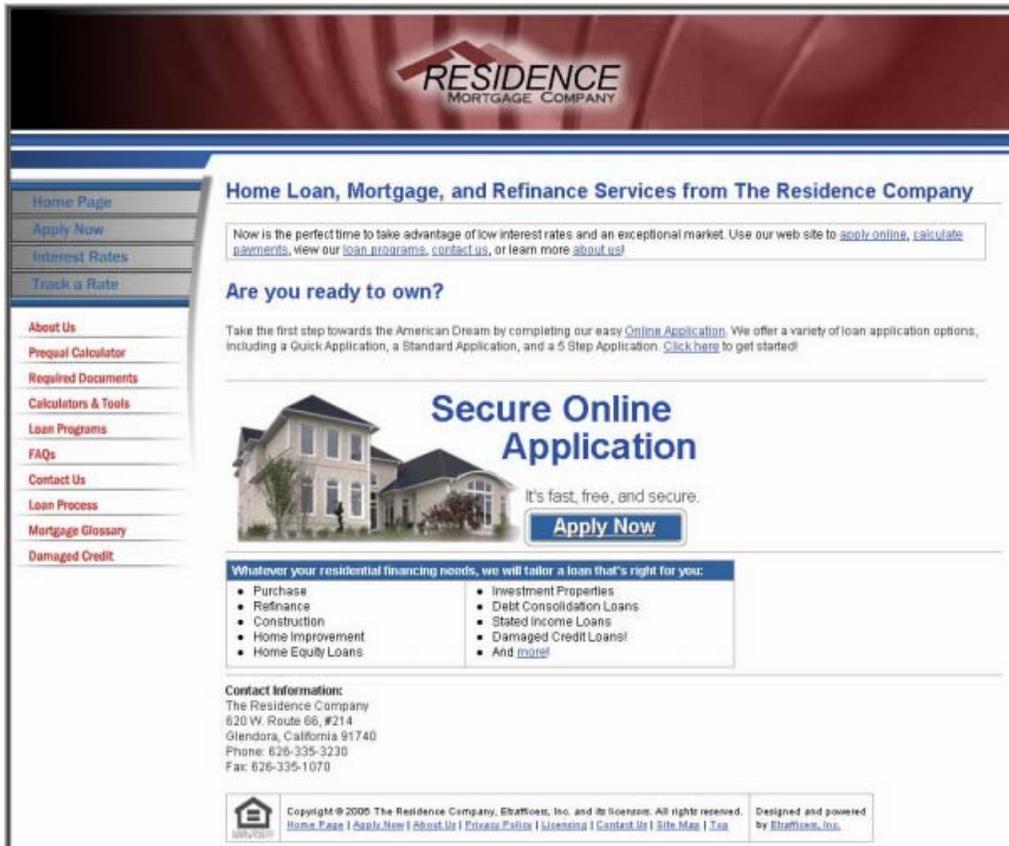
By contrast, applicant argues that the Trademark Examining Attorney has submitted no evidence that applicant's services are in any way related to "residences," as opposed to other type of real estate such as commercial real estate, citing to *In re Remade*, 66 USPQ2d 1222, 1224 (TTAB 2002). In this decision, the Board noted that "[t]here is little evidence in this record *that is clearly relevant to applicant's identified goods and services*, and the Examining Attorney did not request additional

information about the nature of the goods and services, the intended purchasers or the intended channels of trade.” [emphasis supplied]. Furthermore, applicant argues that inasmuch as the word “residence” has many potential meanings, a consumer, upon encountering applicant’s mark, would be required to undertake a multistage reasoning process in order to divine the nature of applicant’s services.

We turn then to look at the evidence the Trademark Examining Attorney has placed into the record.

Attached to the second Office Action was a printout from a website that the Examining Attorney claims demonstrates the descriptiveness of applicant’s mark:





As pointed out by applicant, this is not a printout of applicant's website. To the contrary, applicant argues that this evidence shows a third party's potentially infringing use of the applicant's mark in its ad copy. The mortgage lending services offered on this website are different from the services covered by the current applications, and apparently would be directed to a different set of customers. Moreover, this third-party usage has the look and feel of trade name usage, not merely descriptive usage. Accordingly, we find that these printouts do not support the position of the Trademark Examining Attorney.

As to the dueling dictionary definitions placed into the record, we do not find convincing applicant's argument that we should reverse the position of the Trademark Examining Attorney merely because the term "residence" has meanings such as "a commitment to work and live in a specific place" or "a period during which a physician receives specialized clinical training." That the word has these other meanings in some other contexts is irrelevant to our determination herein.

Nonetheless, we do find that applicant has adopted a word combination that is not readily recognizable as describing a particular characteristic or feature of applicant's services with any degree of specificity. There is nothing in the record to suggest there is any such thing as a "residence company." Thus, the mark "The Residence Company" does not convey any immediate and unambiguous meaning. As used in connection with applicant's financial, design, construction and property management services, we agree with applicant that the Trademark Examining Attorney has failed to demonstrate that the term "The Residence Company" is merely descriptive.

We concur with applicant that this three-word phrase creates some ambiguity. In consequence thereof, actual and prospective customers who encounter the mark in connection

with the applicant's services in the marketplace would have to engage in a multi-stage reasoning process, involving pausing, reflecting and then speculating on the significance of the combined designation, in order to understand that, as applied to applicant's services, the services offered under such term relate "to residences or the places in which one lives or dwells." As a result, the mark **THE RESIDENCE COMPANY** is simply suggestive of the financial, design, construction and property management services to be offered, rather than being merely descriptive of such services.

As to other trademark applications and registrations reviewed by the Office, the Trademark Examining Attorney is correct in noting that the Office is not bound by any prior actions taken in other cases. However, we do find most interesting the following registrations of third parties:

<b>CONSULTANTS IN RESIDENCE</b>	for "real estate consultation services" in International Class 36; <sup>4</sup>
<b>Residence for Residents</b>	for "real estate brokerage services" in International Class 36; <sup>5</sup>
<b>RESIDENCE</b>	for "advertising services, namely preparing advertisements for others in the field of real estate, direct mail advertising for others in the field of real estate,

<sup>4</sup> Registration No. 1532331 issued on the Principal Register on March 28, 1989.

<sup>5</sup> Registration No. 3050433 issued on the Principal Register on January 24, 2006.

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providing advertising space in a magazine relating to real estate, receiving real estate advertisements from others through a web site, and advertising real estate of others including those featured in magazines relating to real estate on a global computer network; and providing a web site featuring real estate advertising services" in International Class 35; and "providing a website which features information on real estate topics of interest to real estate buyers and sellers" in International Class 36;<sup>6</sup>

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**RESIDENCE  
INTERNATIONAL**

for "magazines related to real estate" in International Class 16;  
"advertising services, namely preparing advertisements for others in the field of real estate, direct mail advertising for others in the field of real estate, and providing advertising space in a magazine relating to real estate, and receiving real estate advertisements from others through a website" in International Class 35; and "providing a website which features information on real estate topics of interest to real estate buyers and sellers" in International Class 36.<sup>7</sup>

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Similarly, it is interesting to note that Notices of Allowance were recently issued for three of applicant's copending applications for retail store services for interior home furnishings - in addition to all the services involved in these appeals - for the mark shown below:

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<sup>6</sup> Registration No. 3135077 issued on the Principal Register on August 29, 2006.

<sup>7</sup> Registration No. 3205106 issued on the Principal Register on February 6, 2007. No claim is made to the word "International" apart from the mark as shown.

## EquityRG The Residence Company

In each of these copending Intent-to-Use applications, the wording "The Residence Company" apparently was not found to be merely descriptive of the services identified therein.<sup>8</sup>

While not necessarily outcome determinative, because we do retain some doubt as to the descriptiveness of the term "residence" for the recited services based on these records, we find the handling of these third-party registrations and three of applicant's copending applications to be consistent with reversals of the refusals to register herein.

We acknowledge that the distinction between merely descriptive and suggestive is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985). Accordingly, to the extent that there may be any doubt as to whether applicant's mark is merely descriptive or suggestive, such doubt is resolved, in accordance with the Board's policy, in favor of the applicant by allowing publication of the mark for

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<sup>8</sup> The services in Application Serial No. 78674369 are identical to the International Class 36 services herein, the services in Application Serial No. 78674511 are identical to the recited services in International Classes 37 and 42 herein, while the retail store services in Application Serial No. 78674372 actually highlight the marketing of interior home furnishings - services where arguably the term "residence" would more readily be perceived as merely descriptive.

opposition. Then upon publication of applicant's mark, any one who believes that it would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. Such an entity may well be in a stronger position to make the case for competitive need for use of this term than is the Office in this *ex parte* context. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

*Decision:* The refusals to register under Section 2(e)(1) of the Lanham Act are hereby reversed.