

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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April 7, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Markel Corporation

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Serial No. 78952901

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Mary Dalton Baril of McGuire Woods, LLP for Markel Corporation.

John D. Dalier, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Grendel, Bergsman and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark Judge:

Markel Corporation, applicant herein, seeks registration on the Principal Register of the mark THE COUNSELOR in standard character form for services identified in the application as "insurance underwriting

services for all types of insurance" in International Class 36.<sup>1</sup>

The trademark examining attorney has issued a final refusal to register applicant's mark on the ground that the mark is merely descriptive of the identified services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

Applicant has appealed the final refusal. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

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 those goods or

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<sup>1</sup> Serial No. 78952901, filed on August 15, 2006. The application is a use-based application under Trademark Act Section 1(a), 15 U.S.C. §1051(a), with date of first use and date of first use in commerce listed as March 31, 2005.

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). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

Applicant submitted the following dictionary definition of "counselor": (1) an advisor; (2) lawyer, one that gives advice in law and manages cases for clients in court; (3) one who has supervisory duties at a summer camp."<sup>2</sup> (Appl's brief p.5). In support of the refusal to register the proposed mark under Section 2(e)(1), the examining attorney relied on the applicant's own submitted

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<sup>2</sup> Webster's Ninth New Collegiate Dictionary, 296 (1988).

specimen. The specimen, which consists of 4 pages, appears to be a brochure directed toward camp operators. The first page reads: **"To Run a Camp, You Need THE COUNSELOR."** At the bottom of the page, the applicant's company name is listed above the mark **THE COUNSELOR**, and in small writing, the phrase **"protection that's always there."**

The following three pages of the specimen go on to discuss various types of insurance that applicant offers to camps. Many of applicant's services offered under THE COUNSELOR mark are clearly intended to cover, as the examining attorney pointed out, "at least the actions of counselors" (such as liability insurance). Several of the offered services would cover the counselors themselves (such as health insurance).

The applicant argues that its proposed mark is merely suggestive. However, a suggestive mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). While we note that applicant is entitled to the benefit of the doubt in a 2(e)(1) analysis, the record here clearly indicates, without any leap of logic, that counselors represent a feature of applicant's services, *i.e.*, that the insurance covers counselors.

It is not dispositive that applicant's insurance services might cover or pertain to camp operations unrelated to counselors or even to other uses unrelated to camps. In order for a mark to be characterized as "merely descriptive" under Section 2(e)(1), it is not necessary that the mark immediately convey an idea of each and every specific feature of the applicant's goods or services. It is sufficient that one significant attribute, function or property be described. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

In cases with analogous facts, the Board has found the mark to be merely descriptive. See *In re MBAssociates*, 180 USPQ at 339 (the Board found applicant's proposed mark STUN-GUN to be merely descriptive, even though the applicant argued that the goods were primarily intended as blunt weapons similar to night sticks, and that the actual stun gun use was secondary); *In re Patent & Trademark Services, Inc.*, 49 USPQ2d at 1539 (TTAB 1998) (the Board found applicant's proposed mark, PATENT & TRADEMARK SERVICES, INC. to be merely descriptive, even though applicant argued that it was additionally offering other legal services not mentioned in the mark itself); *In re Pencils Inc.*, 9 USPQ2d 1410 (TTAB 1988) (The Board held

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PENCILS to be merely descriptive of office supply store services even though other goods were also sold). We are presented with the same situation here, and we arrive at the same result.

Accordingly, we affirm the refusal to register.