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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Deutsche Telekom AG

Serial No. 79000707

Joan L. Long of Mayer, Brown, Rowe & Maw, LLP for Deutsche Telekom AG.

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

Before Quinn, Drost, and Walsh, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

The refusal in this Section 66(a) (15 U.S.C. § 1141f) application has now been appealed to this board to determine if applicant Deutsche Telekom AG's mark, *on-finance*, in standard character form is merely descriptive under Section 2(e)(1) of the Trademark Act (15 U.S.C. § 1052(e)(1)) for the following goods¹ and services:

¹ As explained further, we understand that the examining attorney's refusal is only directed to the highlighted words in Classes 9 and 16. The Class 36 services are discussed separately.

Computer software for **financial accounting**, for the provision of online information services in the field of news, sports, entertainment, culture, business and **finance**, weather and travel [and] audio and video recordings in the field of news, sports, entertainment, culture, business and **finance**, weather and travel in Class 9;²

Printed instructional and teaching materials, all in the fields of telecommunications, information technology, safety, news, sports, entertainment, culture, business and **finance**, weather and travel in Class 16;³ and

Insurance services, namely, insurance brokerage, insurance claims processing; financial services, namely, clearing of secure financial transactions through online services; financial analysis and consultation; financial information provided by electronic means; financial information processing; financial portfolio management; financial services, namely, securities consulting and safe keeping; financial sponsorship of sports, educational and entertainment programs and events; commercial lending services; monetary exchange; credit card services; electronic commerce services, namely, electronic debit and credit card transaction processing services, funds transfer and bill payment-processing services; discount brokerage services; security brokerage; brokerage in the field of insurance, stocks, commodities; custom brokerage for third parties in the field of insurance, stocks, commodities; brokerage of shares and venture capital funding services to start-up companies; brokerage of fund shares; brokerage of productive investment of funds; providing information and brokerage of insurances in the field of home insurance, accident insurance and health insurance; consulting services relating to bank services; providing information via telephone and the global

² To be more specific, the examining attorney described her refusal (Brief at 1) as being directed to "computer software for financial accounting, for the provision of online information services in the field of finance and audio and video recordings in the field of finance" in Class 9.

³ Again, to be specific, the examining attorney (Brief at 1) limited her Class 16 refusal to "printed instructional and teaching materials, all in the fields of finance."

communication networks in the field of finance in Class 36.

The examining attorney concluded her description of the refusal by stating that the "refusal applies to the goods and services listed only. The refusal is withdrawn for the remaining goods and services and it is respectfully requested that this refusal to register be affirmed."

Brief at 2.⁴

At this point, we believe further comment on the goods and services and the refusal are appropriate. Applicant originally applied for registration of its mark, *on-finance*, for a variety of goods and services in Classes 9, 16, 35, 36, 38, and 42. The examining attorney required clarification of the goods and services in these classes, and applicant responded by submitting an amendment that consisted of almost five single-spaced typed pages of goods and services, which the examining attorney generally accepted.⁵ Because we do not find it necessary to list all

⁴ Because the refusal is expressly limited to only certain goods and services, regardless of the outcome of the specified goods and services at issue in this appeal, applicant's mark may be published for opposition for at least the remaining goods and services in the application. 37 CFR § 2.65(a) ("If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services"). See also TMEP § 1904.03(d) (4th ed. April 2005).

⁵ The list of goods in Classes 9 and 16 required approximately three typed pages.

the goods and services that are not in dispute, we have chosen to refer only to the goods and services that are at issue. It is clear that there is no longer a refusal pending regarding the services in Classes 35, 38, and 42.⁶

Regarding the goods in Classes 9 and 16, the examining attorney applied the refusal to "computer software for financial accounting, for the provision of online information services in the field of finance, and audio and video recordings in the field of finance in class 009 [and] printed instructional and teaching materials all in the fields of finance in class 016." Brief at 1. Applicant, in its Reply Brief at 2, points out that in "further correspondence with the Examiner, Applicant agreed to remove the direct reference to 'finance' in Classes 9 and 16. Thus, while the Examiner has maintained her objection to those goods in Classes 9 and 16 in her response, it is only Applicant's services in Class 36 that remain in

⁶ In her denial of the request for reconsideration (p.3), the examining attorney added that the "terminology 'telecommunications software for use in the telecommunications industry' is unacceptable in class 42 because 'software is in class 9 unless it is 'non-downloadable computer software.'" These specific services are not further discussed in the appeal briefs, but the examining attorney indicated (Brief at 2 n.1) that the "remaining classes 016, 035, 038, 042 were not amended." However, the examining attorney has not argued that there is any refusal pending regarding the requirement for an amendment to the identification of goods. Before this case proceeds to publication, this discrepancy should be addressed.

dispute." In her appeal brief (p.2, n.1), the examining attorney argues that:

A further review of the Request for Reconsideration dated April 11, 2005 does not offer an amendment to delete all financial services and in fact the amended identification of goods and services contained financially related goods and services, such as audio and visual recordings in the field of news, sports, entertainment, culture, business and finance, weather and travel and computer software for financial accounting for the provision of online information services in the field of news, sports, entertainment, culture, business and finance, weather and travel in class 009.

There does not appear to be any dispute that the examining attorney has limited her refusal to only the following goods in Classes 9 and 16: "computer software for financial accounting, for the provision of online information services in the field of finance, and audio and video recordings in the field of finance in class 009 [and] printed instructional and teaching materials all in the fields of finance in class 016." Furthermore, applicant has made it clear that it has agreed to delete the term "finance" from the identification of goods in Classes 9 and

16.⁷ With these deletions from the identification of goods in Class 16, we understand that there is no longer a dispute regarding the descriptiveness of the goods in that class. Similarly, with the class 9 goods, there no longer is a dispute regarding the computer software for the "provision of online information services in the field of finance, and audio and video recordings in the field of finance" because applicant has agreed to delete the term "finance" to which the examining attorney directed her refusal. Therefore, because "on finance" would describe audio and video services, printed instructional and teaching materials and computer software for the provision of online information services all "about or concerning finance," we affirm the refusal to register these goods on the ground that the mark as applied to these goods is merely descriptive in the event that applicant has not formally deleted these goods from the application.

⁷ In Classes 9 and 16, we assume that applicant has agreed to delete the word "finance" from the following language in bold in the identification of goods: "... provision of online information services in the field of news, sports, entertainment, culture, business and **finance**, weather and travel [and] audio and video recordings in the field of news, sports, entertainment, culture, business **and finance**, weather and travel;" and in class 16: "printed instructional and teaching materials, all in the fields of telecommunications, information technology, safety, news, sports, entertainment, culture, business **and finance**, weather and travel."

However, the deletion of the term "finance" does not resolve the question of whether the term "on finance" is merely descriptive when used on "software for financial accounting." While we assume that applicant has offered to delete the words "and finance," we are unsure what change, if any, applicant intended with the identification of goods for "computer software for financial accounting." Therefore, we will assume that this item has not been amended and that the examining attorney's refusal is still viable for these goods in Class 9.

We now look at the services in Class 36. Again, applicant has proposed to delete numerous services from the list of the Class 36 services. The examining attorney refused to register applicant's mark for the services listed below (Brief at 1-2) in Class 36 and applicant has made it clear that it "offered to amend its description by deleting the [highlighted] services from Class 36." Reply Brief at 2-3.

Insurance services, namely, insurance brokerage, insurance claims processing; financial services, namely, clearing of secure financial transactions through online services; **financial analysis and consultation; financial information provided by electronic means; financial information processing; financial portfolio management;** financial services, namely, securities consulting and safe keeping; **financial sponsorship of sports, educational and entertainment programs and events;** commercial lending services; monetary exchange; credit card services;

electronic commerce services, namely, electronic debit and credit card transaction processing services, funds transfer and bill payment-processing services; discount brokerage services; security brokerage; brokerage in the field of insurance, stocks, commodities; custom brokerage for third parties in the field of insurance, stocks, commodities; brokerage of shares and venture capital funding services to start-up companies; brokerage of fund shares; brokerage of productive investment of funds; **providing information and brokerage of insurances in the filed of home insurance, accident insurance and health insurance; consulting services relating to bank services; providing information via telephone and the global communication networks in the field of finance.**

We assume that this amendment is acceptable and the following Class 36 services remain at issue:

Insurance services, namely, insurance brokerage, insurance claims processing; financial services, namely, clearing of secure financial transactions through online services; financial services, namely, securities consulting and safe keeping; commercial lending services; monetary exchange; credit card services; electronic commerce services, namely, electronic debit and credit card transaction processing services, funds transfer and bill payment-processing services; discount brokerage services; security brokerage; brokerage in the field of insurance, stocks, commodities; custom brokerage for third parties in the field of insurance, stocks, commodities; brokerage of shares and venture capital funding services to start-up companies; brokerage of fund shares; brokerage of productive investment of funds.

Additionally, we point out that in its response (p.6) to a requirement in the first Office action, applicant submitted a disclaimer of the term "finance."

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Next, we note that the application, Serial No. 79000707, has been filed under the provision of Section 66, 15 U.S.C. § 1141f, of the Trademark Act, which provides:

(a) *Requirement for Request for Extension of Protection.* – A request for extension of protection of an international registration to the United States that the International Bureau [IB] transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.

The United States application was filed on 07 November 2003. Because the application (request for extension of protection) was filed under the provision of Section 66(a), it is entitled to an earlier priority date. Section 66, 15 U.S.C. § 1141f, provides the following:

(b) *Effect of Proper Filing.* – Unless extension of protection is refused under section 68, the proper filing of the request for extension of protection under subsection (a) shall constitute constructive use of the mark, conferring the same rights as those specified in section 7(c), as of the earliest of the following:

(1) The international registration date, if the request for extension of protection was filed in the international application.

(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.

(3) The date of priority claimed pursuant to section 67.

Section 67 of the Trademark Act sets out how an applicant can obtain priority in the United States under these circumstances:

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if –

(1) the request for extension of protection contains a claim of priority; and

(2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

Applicant's International Registration No. 0817799 issued 07 November 2003. The International Registration is based on an underlying German application (No. 303 23 195.5/38) filed 08 May 2003, which issued on 27 May 2003, as German Registration No. 303 23 195.5/38. As a result, applicant is entitled to a priority date of 08 May 2003.

Because this application was filed under Section 66(a), TMEP 1904.03(d) (4th ed. April 2005) provides that refusals that do not encompass all the goods and services must specify the goods and services covered by the refusal.

If a notification of refusal in a §66(a) application does not pertain to all the goods/services, the mark

is protected for the remaining goods/services, even if the holder does not respond to the notification of refusal. Sections 68(c) and 69(a) of the Trademark Act, 15 U.S.C. §§1141h(c) and 1141i(a), provide that an application under §66(a) of the Trademark Act is automatically protected with respect to any goods or services for which the USPTO has not timely notified the IB of a refusal.

However, when the Section 66(a) application is examined, "a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register." TMEP § 1904.02(a) (4th ed. April 2005).

In cases involving descriptiveness refusals applied to a class of goods or services containing numerous items, the board has held that:

While some of the products enumerated in applicant's recitation of goods may not include devices in this category or class, at least some of the goods, such as analog to digital and digital to analog converters, analog computational circuits and analog multipliers/dividers would, in our view, fall within the category of analog devices. In this regard, it is a well settled legal principle that where a mark may be merely descriptive of one or more items of goods in an application but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the subject matter for registration is descriptive of any of the goods for which registration is sought.

In re Analog Devices Inc., 6 USPQ2d 1808, 1810 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). See also In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 (TTAB 2002) ("[I]f applicant's mark

BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable”).

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be “merely descriptive,” a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

We must consider whether the mark in its entirety is merely descriptive. P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 545-46 (1920). However, “[i]t is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in

its entirety." In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986).

The examining attorney argues that in "this case, the mark 'on-finance' describes that the goods and services relate to finance or are about the science of the management of money and other assets and therefore, the mark must be held descriptive." Brief at 4. The examining attorney also argues (Brief at 5) that "the use of the preposition 'on' with the word 'finance' describes that the goods and services are about finance or financially related goods and services. The examining attorney has attached a definition of 'on' ... showing that one of the definitions of 'on' is 'concerning or about.'"⁸

Applicant maintains (Brief at 4) that a "degree of thought or imagination is required to mentally connect the broad term 'on-finance' with applicant's specialized services. Furthermore, Applicant's insurance services, while tangentially related to the field of finance, cannot be though[t] of as being *merely* described by the mark ON-FINANCE."

⁸ We grant the examining attorney's request to take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The examining attorney's evidence to support her argument that the mark, **on-finance**, is merely descriptive consists of numerous registrations in which the term "on finance" is used in the identification of goods and/or services. Some examples are set out below:

Registration No. 1,262,328 - "Reports **on finance** and industry" in Class 16

Registration No. 1,481,545 - "Newsletters, manuals and periodically published books **on finance** and investing" in Class 16

Registration No. 1,828,225 - "Books and pamphlets **on finance** and securities law" in Class 16

Registration No. 2,250,716 - "Pre-recorded compact disks and diskettes featuring information **on finance** and investing" in Class 9

Registration No. 2,134,207 - "Educational services, namely, offering on-site employee education **on finance** and financial planning" in Class 41

Registration No. 2,388,086 - "Providing information **on finance**, financial portfolio statements, securities..." in Class 36

Registration No. 2,847,706 - "Providing information **on finance**, stocks and investments by way of a global computer network" in Class 36

Registration No. 2,533,707 - "Provision information and advice **on finance**, investment and value via television, cable television, radio, print, broadband and the Internet" in Class 36

Registration No. 2,824,498 - "Providing information **on finance** and personal finance" in Class 36

The examining attorney, in her first Office action, also included a definition of "finance" as "the science of

the management of money and other assets." We also take judicial notice that "finance" can be defined as simply "the management of revenues" and "the conduct or transaction of money matters generally, esp. those affecting the public, as in the field of banking and investment." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).

In light of this evidence, we now focus our discussion on the services in Class 36 that have been refused registration on the ground that, when the mark is used with these services, the term is merely descriptive. Under the Analog Devices and CyberFinancial.Net cases, if the term "on-finance" is merely descriptive for any of the services in Class 36, the examining attorney's refusal will be sustained.

Based on the dictionary definitions, we find that the term "on finance" would generally mean "concerning or about the management of revenues." There are two points we must keep in mind. First, when the term is applied to the goods and services, it must immediately describe them. Second, as indicated in the first point, we look at the mark in relationship to the goods and services and not the words alone. Abcor Dev., 200 USPQ 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"). Therefore, we reject applicant's argument (Brief at 8) that a "consumer must know more than the fact that a company falls within the enormous rubric of finance to know what particular goods or services are provided." Instead, we must consider whether prospective purchasers view the mark in the context of the specific goods and services as describing a characteristic or feature of those goods or services. The prospective purchaser would understand what the goods or services are in making this determination.

We now consider whether the term "on finance" would describe applicant's services in Class 36. Clearing financial transactions, electronic commerce services, brokerage and security consulting services are concerned with or about managing revenue or other similar assets. Therefore, we find that the term "on finance" would merely describe these services inasmuch as they are "about" or "concerning" finances or managing revenues. We also find that monetary exchange services would similarly be services that are concerned with or about the conduct or transaction of money matters, which is what monetary exchange services

would involve. Therefore, the term "on finance" would describe these services.

Regarding applicant's commercial lending services, we add that the term "finance" is also defined as "to raise money or capital needed for financial operations." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We again take judicial notice of this definition and the term "on finance," when applied to commercial lending services, would merely describe these services as concerning raising money or capital, in this case by lending money, for commercial entities.

We must also address the goods in Class 9 that remain in dispute, i.e., "computer software for financial accounting." We find that the definitions indicate that the term "on finance" would be defined as concerning or about the management of revenues. Financial accounting software would assist in the management of revenues by accounting for the revenues. Indeed, applicant has specified that its software is specifically for "financial accounting." Consumers encountering the term "on finance" for financial accounting software would immediately know that the software is concerned with the management of revenues. Applicant's financial accounting software would permit purchasers to manage their finances. Therefore, we

likewise find that the term "on finance" is merely descriptive of this computer software.

We now address a few final points. First, while we have relied on several definitions of "finance," this is entirely appropriate in this case in which applicant has applied for the registration of its term on numerous goods and services. It is not surprising that some goods or services are more accurately described by one particular definition than another. Second, the term "on finance" is not "too broad and varied to describe Applicant's goods and services" as it argues. Brief at 8. A term can be at least merely descriptive of the field in which applicant operates. See In re A La Vieille Russie Inc., 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for art dealership services); In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held unregistrable on the Supplemental Register). Inasmuch as applicant's goods and services that are relevant here are concerned with or about finance, the term is not too broad to merely describe these goods and services. Third, we also note that applicant has applied to register the term, on-finance, in standard character form with a hyphen. The presence of minor spelling idiosyncrasies or punctuation marks does not normally change merely descriptive terms into suggestive

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terms. In re S.D. Fabrics, Inc., 223 USPQ 54, 55 (TTAB 1984) ("Aside therefrom, we are not persuaded that the design features of applicant's mark, namely, the filling in of portions of some of the letters in the mark and the separation of the two words of the mark with a conventional punctuation mark, are so distinctive as to create a commercial impression separate and apart from the unregistrable components"). Fourth, applicant refers to several other registrations that involve the term, "on." We note that the marks in these registrations share virtually nothing in common with the mark here except that they include the preposition "on." The goods and services are frequently quite different. We are also unaware of a per se rule that requires marks beginning with the preposition "on" to be treated the same. Rather we must look at the specific mark for which applicant seeks registration and view it in relation to the identified goods and services. Therefore, these registrations have little, if any, relevance. We add that "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Decision: We affirm the refusal to register applicant's mark on the ground that it is merely descriptive for the following goods and services:

Computer software for financial accounting, for the provision of online information services in the field of finance, [and] and audio and video recordings in the field of finance in Class 9;

Printed instructional and teaching materials, all in the fields of finance in Class 16; and

Insurance services, namely, insurance brokerage, insurance claims processing; financial services, namely, clearing of secure financial transactions through online services; financial analysis and consultation; financial information provided by electronic means; financial information processing; financial portfolio management; financial services, namely, securities consulting and safe keeping; financial sponsorship of sports, educational and entertainment programs and events; commercial lending services; monetary exchange; credit card services; electronic commerce services, namely, electronic debit and credit card transaction processing services, funds transfer and bill payment-processing services; discount brokerage services; security brokerage; brokerage in the field of insurance, stocks, commodities; custom brokerage for third parties in the field of insurance, stocks, commodities; brokerage of shares and venture capital funding services to start-up companies; brokerage of fund shares; brokerage of productive investment of funds; providing information and brokerage of insurances in the field of home insurance, accident insurance and health insurance; consulting services relating to bank services; providing information via telephone and the global communication networks in the field of finance in Class 36.