

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JUNE 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re UMI Company

Serial No. 74/719,760

Richard A. Gaffin of Miller, Canfield, Paddock and Stone,
P.L.C. for UMI Company.

Martha Santomartino, Trademark Examining Attorney, Law
Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hanak, Hairston and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

UMI Company has filed an application to register the
mark BANKING INFORMATION SOURCE for "computer services,
namely, providing on-line information data bases for the
retrieval of information in the nature of articles from

business publications, including bibliographic citations and abstracts relating thereto."¹

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney maintains that the mark BANKING INFORMATION SOURCE is merely descriptive in that it immediately conveys to prospective purchasers information with respect to a characteristic or feature of applicant's services, namely, that applicant is providing information about the banking industry. Applicant contends that this is only one possible meaning for its mark; that the mark may equally be interpreted as a source of information about banking per se, such as the types of transactions offered by financial institutions, or even on-line access to bank account information. Applicant argues that because it would take imagination on the part of the user of applicant's database to determine from the mark BANKING INFORMATION SOURCE whether the database provides general information about the financial services industry or specific information with respect to the transactions

¹ Serial No. 74/719,760, filed August 24, 1995, based on a bona fide intention to use the mark in commerce. An amendment to

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offered by particular institutions, its mark is not merely descriptive.

A word or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, purpose, function or feature of the goods or services with which it is being used. Whether or not a particular term or phrase is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is being used, and the significance the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services bearing the mark. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Nibco Inc.*, 195 USPQ 180 (TTAB 1977) and the cases cited therein.

Applicant is using BANKING INFORMATION SOURCE in connection with services which it identifies as on-line information databases which provide information from articles from business publications. In the specimens of record, applicant's databases are described as follows:

Banking Information Source records provide complete bibliographic information, indexing, and abstracts for

allege use was filed October 7, 1996, setting forth first use dates of September 1, 1995.

articles published in more than 220 essential industry publications, banking newsletters, Bank Marketing Association's Golden Coin Awards competition entries, Stonier Theses, and School of Bank Marketing Papers - plus citations to banking related articles from The American Banker, The Wall Street Journal and The New York Times

as well as

The Banking Information Source combines two popular information resources from the American Bankers Association (ABA): the ABA's Banking Literature Index ... and FINIS (Financial Industry Information Service)...

This is the context within which the mark is being used and the manner in which the mark would be viewed by prospective purchasers or users of applicant's services.

Without getting caught up in the rather circuitous paths of reasoning followed by both applicant and the Examining Attorney in their arguments, we find the conclusion to be drawn very clear-cut. When BANKING INFORMATION SOURCE is considered in the manner in which it is being presented by applicant, there is only one plausible interpretation of the mark. In the first place, the average potential purchasers and users of applicant's services would be individuals seeking information about the banking industry, not consumers seeking information about a particular bank service. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) ["average purchaser" refers to class or classes of actual or

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prospective customers of the applicant's particular goods or services]. To these individuals, the words BANKING INFORMATION would immediately convey information with respect to the nature or subject matter of applicant's databases. The services per se would be recognized to be exactly as applicant has described them, namely, the provision of a SOURCE of information about the banking industry. See *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ON-LINE immediately conveys information about the subject matter of applicant's computer-accessed service to the relevant class of consumers]. There is no second meaning for BANKING INFORMATION SOURCE which would be applicable to applicant's particular services. Nor is there any double entendre involved, as would be the case if BANKING INFORMATION SOURCE had a second non-descriptive, but applicable, meaning, when used in connection with applicant's services. Cf. *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154 (TTAB 1987)[term CHIC, as applied to women's jeans, projects double entendre (both its descriptive significance as "stylish" and its non-descriptive meaning as the phonetic equivalent of "chick" or "young woman") and thus is not merely descriptive].

Although the Examining Attorney has submitted dictionary definitions of the individual components of applicant's mark, and LEXIS/NEXIS database evidence of the descriptive use of the terms "banking information" and "information source," we do not find consideration of this material necessary for our decision. The commonplace meaning of the phrase BANKING INFORMATION SOURCE is readily apparent to us. Furthermore, the NEXIS/LEXIS database excerpts showing use of the phrase "on-line banking information" are directed for the most part to the non-applicable meaning, the supplying of information with respect to bank accounts and the like, and thus are irrelevant. Similarly, we find the fact that applicant uses a TM symbol next to the listing in its specimens of certain of its databases and not next to others, including the one in question, to be immaterial.

Accordingly, we find the mark BANKING INFORMATION SOURCE merely descriptive when used in connection with applicant's on-line database services.

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

E. W. Hanak

P. T. Hairston

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H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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