

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

JULY 9, 1997

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Omega Research, Inc.**

Serial No. 74/546,080

Martin P. Michael of Rubin Baum Levin Constant & Friedman
for Omega Research, Inc.

Robert M. Feeley, Trademark Examining Attorney, Law Office
102 (Myra Kurzbard, Managing Attorney)

Before Seeherman, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Omega Research, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register WALL
STREET ANALYST as a trademark for "computer software to
assist in making investment decisions."¹ 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.

¹ Application Serial No. 74/546,080, filed June 30, 1994, based
on an asserted bona fide intention to use the mark in commerce.

The case has been fully briefed; an oral hearing was not requested.

It is the Examining Attorney's position that WALL STREET ANALYST is merely descriptive because it identifies the primary audience for applicant's software. In support of his position, he has made of record excerpts of articles from the NEXIS database,² some of which we quote below:

² Several of these excerpts were inadvertently omitted from the Examining Attorney's final Office action. Applicant stated that prior to filing its brief on appeal an attorney for applicant contacted the Examining Attorney, and advised him that no evidence had been attached to the final Office action. Subsequently, the Examining Attorney was able to locate this material, and when the file was forwarded to the Examining Attorney for his appeal brief, the Examining Attorney requested remand for the purpose of making this material of record. The Board granted the request for remand on May 24, 1996, and allowed applicant an opportunity, which applicant took, to address the additional evidence in a supplemental appeal brief.

In its supplemental appeal brief, and again in its reply brief, applicant has objected to the consideration of this evidence. This objection is not well taken. Although applicant is correct that Trademark Rule 2.142(d) states that the record should be complete prior to the filing of an appeal, the rule also provides that the applicant or Examining Attorney may request remand in order to submit additional evidence. We further reiterate the finding in the May 24, 1996 Board decision that the Examining Attorney has shown good cause for the request for remand. Attempting to make of record evidence which was inadvertently omitted from the Office action is not an attempt to make of record evidence which should have been obtained by the Examining Attorney during examination. This evidence was, in fact, obtained earlier, and was not made of record simply because of a clerical error. Thus, this is not a situation where an Examining Attorney is seeking through remand to remedy a lack of diligence during the examination of the application. Moreover, we note that applicant failed to apprise the Examining Attorney that the evidence had not been received until after the appeal was filed. As we stated in our May 24, 1996, action, the better practice would have been for applicant, upon receipt of the August 16, 1995 Office action, to contact the Examining Attorney about the missing materials, so that the oversight could have been corrected in a timely manner.

Wall Street analysts spent the rest of the day questioning whether the offer was real or simply an elaborate game of "greenmail"....

"The Washington Post," April 13, 1995

However, the experience at Spartanburg as well as other problems looming for Standard have shaken the confidence of some Wall Street analysts and investors.

"The Plain Dealer," April 4, 1995

For the next few years, Bethlehem's earning could be red hot. One Wall Street analyst says, "The stock is a compelling buy."

"The Baltimore Sun," March 30, 1995

Since early February, News Corp.'s stock price has risen 25% as several Wall Street analysts have upgraded the stock to a "buy," citing improving prospects for Star TV in Asia....

"Daily Variety," March 20, 1995

Most Wall Street analysts feel banks cannot begin a solid rally until rates have clearly peaked.

"The American Banker," March 6, 1995

...Quantum Health Resources fell 6 3/4 to 22 after reporting earning that disappointed Wall Street analysts.

"Los Angeles Times," March 1, 1995

In a presentation to Wall St. analysts of the company's third-quarter performance....

"Platt's Oilgram News," Nov. 3, 1994

Moreover, Wall St. analysts looked closely at the decline of gross profit margins during the last quarter.

"The New York Times," Oct. 18, 1994

...merger between Alta Energy Corp. and Devon Energy Corp. was completed May 18, a move that one Wall St. analyst called "a very logical fit."

"Platt's Oilgram News," May 20, 1994

Wall St. analysts have long considered
CBS, with its billion-dollar-plus
surplus from sale of its record and
publishing arms, prime takeover
target....

"Communications Daily," July 1, 1994

The Examining Attorney also quoted, in his first Office action, dictionary definitions for "Wall Street" ("the main financial center of the United States," and "analyst" ("a person who analyzes").³

A mark is merely descriptive if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service.

In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985). In **In re Gentex Corp.**, 151 USPQ 435 (TTAB 1966), the Board stated that a mark which describes the intended users of a particular product is merely descriptive of such goods within the meaning of Section 2(e)(1). In **In re Camel Manufacturing Co., Inc.**, 222 USPQ 1031, 1032 (TTAB 1984), the Board again "embrace[d] the holding that a mark is

³ The Examining Attorney stated that these definitions were obtained from Webster's New World Dictionary of the American Language." Although the relevant excerpts were not in fact submitted, applicant did not object to consideration of them during prosecution, and we therefore deem the definitions to have been submitted by stipulation. In its brief, applicant points out that the Second College Edition of this dictionary also includes other definitions for these terms, and that the particular definition for Wall Street provided by the Examining Attorney reads, in its entirety, "a street in lower Manhattan, New York City: the main financial center of the U.S." We have considered the definition presented by applicant, but would point out that, even if the dictionary relied on by the

merely descriptive if it describes the type of individuals to whom an appreciable number or all of a party's goods or services are directed."

The Examining Attorney asserts, based on the NEXIS evidence, that WALL STREET ANALYST has a well-understood meaning in the world of finance, describing a professional investor. The Examining Attorney further asserts that applicant's identified computer software to assist in making investment decisions would be used by Wall Street analysts, and hence that the mark is merely descriptive.

Applicant, on the other hand, argues that the intended consumers for its software are not professional investors, but are non-professional individuals interested in investing in securities. It is applicant's position that, at most, WALL STREET ANALYST may be suggestive of a possible professional level of results for one using the goods.

The Examining Attorney does not disagree that WALL STREET ANALYST does not describe non-professional investors in securities. Examiner's brief, p. 7. However, he asserts that the software must be presumed to be used by professional investors as well as non-professionals, and that, with respect to the former group, the mark describes this audience for applicant's goods.

Examining Attorney did not contain the prefatory language, it would have no effect on our decision herein.

Both applicant and the Examining Attorney have cited a number of cases in which the particular mark involved appears to refer to the users of the goods or services. In those cases cited by the applicant, the term has been found to be not merely descriptive, while those cited by the Examining Attorney have reached the opposite result.

For example, in **In re Gentex Corp.**, supra, PARADER was found to be merely descriptive of protective helmets because the word was defined as "one who parades," and applicant's advertising material showed paraders wearing the hats, and referred to the headgear as being used in parades. The Board concluded, therefore, that the mark immediately indicates the primary or intended users of these hats and would be so recognized by the average purchaser of such goods.

Similarly, in **In re Camel Manufacturing Co., Inc.**, supra, MOUNTAIN CAMPER was found to be merely descriptive of retail and mail order services in the field of outdoor equipment and apparel because applicant's catalogs showed that an appreciable number of the products sold by applicant were directed toward mountain campers, and that the group described by the term MOUNTAIN CAMPER is a category of purchaser to whom applicant specifically directs its camping equipment.

Applicant has relied on **In re John Berg Mfg. Co.**, 164 USPQ 607 (TTAB 1970), in which MILLWRIGHT was found to be not merely descriptive of ladders, despite a dictionary definition of "millwright" as a "workman who erects the shafting...in a workshop, mill, or plant." The Board said that although MILLWRIGHT is suggestive of the fact that the ladder is one that could be used by a millwright, this did not make the term merely descriptive.

In **In re Chesebrough-Pond's Inc.**, 163 USPQ 244 (TTAB 1969, the word MANICURIST in the mark MANICURIST BY CUTEX was held not to be merely descriptive for nail polish, the Board stating that the average woman purchaser would not conclude that the mark signified a nail polish specifically for use by manicurists, while a professional would not assume that the product was intended only for her use. Thus, the Board concluded that the mark was merely suggestive that the product would give professional results.

It is not always easy to reconcile the results in these cases and to determine on which side of the line the present case falls. As the Board has previously recognized, the distinctions between the various cases are indeed subtle ones. See **In re Camel Manufacturing Co., Inc.**, supra. In the present situation, after considering all the evidence of record, the case law, and the arguments, we find that the Office has not made the necessary showing that WALL STREET

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ANALYST is merely descriptive of computer software to assist in making investment decisions. WALL STREET ANALYST, when applied to computer software to assist in making investment decisions, suggests that the software provides the user with the skills of professional investment analysts. It appears that this type of suggestiveness, i.e., a meaning separate from that of describing the purchasers of the goods, is one of the points that distinguishes those cases in which purchaser identifier marks were found merely descriptive from those which were not. Moreover, in this case the Examining Attorney has acknowledged that WALL STREET ANALYST is not descriptive of non-professional individuals seeking investment advice, and applicant has asserted that these individuals are the primary customers for its software, a point which the Examining Attorney has not disputed.

Finally, we have resort to the well-established principle that, when there is doubt as to whether a mark is merely descriptive, that doubt must be resolved in applicant's favor. See **In re The Gracious Lady Service, Inc.**, 175 USPQ 380 (TTAB 1972).

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Decision: The refusal of registration is reversed.

E. J. Seeherman

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board