

Paper No. 9
RFC

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AUG 28, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Theodore E. Charles

Serial No. 74/710,039

George Kersey for Theodore E. Charles.
John Michos, Trademark Examining Attorney, Law Office 105
(Thomas Howell, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 2, 1995, applicant, a citizen of the United States, applied to register the mark "INVESTORS MARKETING" on the Principal Register for "financial services," in Class 36. The basis for the application was applicant's claim of use of the mark in commerce in connection with his services since March 15, 1989.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that, as used in connection with financial services, applicant's mark is merely descriptive. Further, he required applicant to amend the recitation of services to be more specific as to the nature of his financial services and the particular field of finance in which they are rendered. He suggested that applicant might want to adopt "investment brokerage services." Additionally, he requested that applicant submit copies of the specimens which had been submitted with the application. The ones originally submitted had apparently been misplaced by the Office.

Responsive to the Examining Attorney's Office Action, applicant amended the recitation of services in the application to read "investment brokerage services," and amended the method-of-use clause to indicate that the mark is used "on advertisements, sales and promotional materials for the services." Additional copies of the original specimens were also provided. The top line of the advertisement submitted, which appears to be a hand-out type of promotional flyer, shows that applicant does business as "Investors Marketing Services, Inc. 230 Broadway, East Linfield MA 09140." Applicant's response

also presented arguments on the issue of mere descriptiveness.

The Examining Attorney was not persuaded to withdraw the refusal to register, however. Attached to his second Office Action were several excerpts from published articles retrieved from the Nexis® database wherein the term "investor marketing" is used. Typical examples of these uses are as follows:

"It's a promising time to go back to Japan," said Gene Spencer, head of mortgage-backed investor marketing, who is leading the trip.

Stuart Novek will skipper Janus Funds' retail marketing efforts after doing time as OppenheimerFunds' director of investor marketing.

"The brokers like it," says investor marketing chief Ellen Batt.

... and it plans to concentrate private investor marketing through share shops.

Stafford Butt will assume the securitization responsibilities, while much of Slawek's investor marketing duties will shift back to the sales team, sources said.

... said Ms. Emma Conyers, an associate responsible for commodity investor marketing at JP Morgan.

The Examining Attorney made the refusal to register under Section 2(e)(1) final.

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

Based on the written record and arguments of applicant and the Examining Attorney, we affirm the refusal to register.

The well-settled rule is that a term which immediately and forthwith conveys information about an ingredient, quality, function, feature, purpose or use of the services set forth in an application for registration is merely descriptive of them, and hence is unregistrable under Section 2(e)(1) of the Act. In re Bright-Crest, Ltd., 204 USPQ 591(TTAB 1979). In the instant case, we agree with the Examining Attorney that "INVESTORS MARKETING" is merely descriptive of applicant's investment brokerage services because the term immediately conveys information about the nature or purpose of the services, i.e., that applicant's business is the marketing to investors of financial products. The specimens show that what applicant markets to investors are annuities. The nature of investment brokerage services and the ordinary meanings of the words which are combined to make up the mark lead inexorably to this conclusion.

Applicant acknowledges that it sells annuities to investors, but he contends that the plain meaning of "INVESTORS MARKETING" is "the marketing of investors," which applicant of course does not do. This argument is

blatantly wrong-headed. No one in his right mind would understand the mark to convey the idea that applicant sells people. Anyone who is active in the financial market knows that investment brokers market investments to investors, and these people would understand the mark "INVESTORS MARKETING" to indicate that applicant markets to investors.

Just as "MARKETING TO INVESTORS" would be merely descriptive of investment brokerage services, in the sense that this is the essence of the services, the juxtaposition of the words in "INVESTORS MARKETING" does not change the descriptive nature of the term. The only conceivable alternative meaning would be the nonsensical one urged by applicant. Moreover, if we had any doubt as to this fact, the excerpted articles made of record by the Examining Attorney would dispel it. These excerpts make it clear that in the field of financial services, "investor marketing" is a term, used by itself and as part of various job titles, to designate a particular market niche in the field of selling financial products. Even applicant's specimens support this conclusion. They show that applicant does business as "Investors Marketing Services, Inc." There would be no reason for applicant to use these words in its trade name if their combination is nonsensical.

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In summary, the words sought to be registered immediately convey the fact that applicant's investment brokerage services involve marketing to investors. Because this is a feature or characteristic of these services, the term is merely descriptive within the meaning of Section 2(e)(1) of the Act. Accordingly, the refusal to register is affirmed.

R. L. Simms

R. F. Cissel

E. J. Seeherman
Administrative Trademark Judges
Trademark Trial & Appeal Board

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