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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Needles & Powers, Inc.

Serial No. 75/519,155

William T. McGrath and Kevin A. Thompson of Davis Mannix & McGrath for Needles & Powers, Inc.

Tracy Cross, Trademark Examining Attorney, Law Office 103,
(Michael A. Szoke, Managing Attorney).

Before Cissel, Bucher and McLeod, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant filed the above-referenced application to register the words "FINANCIAL CONSEQUENCES MODEL" on the Principal Register for "computer multimedia software used as teaching materials demonstrating a visual model for understanding financial statements," in International Class 9.¹

Registration was refused under Section 2(e)(1) of the Trademark Act on the ground that the words sought to be registered are merely descriptive of applicant's product.

¹ Serial No. 75/519,155, filed on July 15, 1998, was based upon applicant's claim of first use of the mark on May 29, 1998, and first use of the mark in interstate commerce on the same day.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We affirm the refusal to register.

The Examining Attorney took the position that the designation sought to be registered is merely descriptive of a significant feature or function of applicant's software product. In particular, the Examining Attorney noted that:

In this case, the goods are described as "Computer multimedia software used as teaching materials demonstrating a visual model for understanding financial statements" [Emphasis added]. One can readily conclude from a plain language reading of the identification that the goods generate visual financial models. Upon closer inspection of the specimens of record, one can conclude that these models depict the financial consequences of selections made by the user. [Trademark Examining Attorney's appeal brief, p. 2]

Attached to the Office Actions were copies of excerpts from stories retrieved from the LEXIS/NEXIS® database of published articles. The stories illustrate the fact that computerized models often predict the likely future financial consequences of current decisions:

Agnew said special computer software can be used to project the *financial consequences* of alternative divorce settlements five, 10 or 15 years into the future... The Des Moines Register, "Softening divorce's fiscal blow," March 12, 1998, p. 12.

Risk modeling is a decision-making aid to CPAs and their clients. Models may be used in analyzing risks while *financial models* can evaluate the *financial consequences* arising from accidents or other adverse developments... The CPA Journal, "Risk analysis and management software and the CPA," December 1997, p. 65.

The software approaches [home] buying from three angles. The analysis mode helps you determine *financial consequences* ... The New York Times, "Peripherals: A Resume Road Map," May 16, 1995, p. C-6.

... [Featured companies] identified major national trends in information technology and linked them to building needs. They then devised a rating system that guides companies planning expansion, renovation or reorganization. With it, a *computerized model* helps determine the *financial consequences* of any move... Engineering News-Record, "Charting a course: Big firms back new method to plan smart buildings," October 24, 1985, p. 13.

The newer E&O [errors and omissions insurance] professional liability forms respond in cases of lack of performance and the *financial consequences* of faulty software... Computerworld, "Insuring against data processing losses," December 5, 1983, p. ID-19.

These and other excerpted articles submitted by the Trademark Examining Attorney show that there are indeed a variety of computerized "models" designed to determine the "financial consequences" of various scenarios or decisions.

Responsive to the refusal to register, applicant submitted argument and additional evidence. The argument is basically that the Trademark Examining Attorney misunderstands the nature of the software and has mischaracterized the goods:

The primary purpose of the software is to act as a teaching tool in conjunction with the printed materials for the course. It does not provide modeling of all possible financial situations. Rather the software works only in the context of fictional corporations and companies that are described in the printed material.

The software is not a general purpose financial calculator or spreadsheet, but rather is a multimedia tool used in conjunction with the [university-level accounting] course. The mark cannot be "merely descriptive" of a multimedia teaching tool. Instead, the mark brings to mind the financial nature of the teaching tool but does not simply describe the goods or even its principal feature as the Examiner believes. [Applicant's reply brief, pp. 1-2.]

The evidence submitted with the response consisted of an excerpt of a computer screen print from the program, graphically demonstrating the effects of an infusion of cash on the asset, liability and owner's equity portions of the balance sheet of a hypothetical firm, Café Caliente.

Applicant also points out that in examining a companion application, another Trademark Examining Attorney permitted publication of "FINANCIAL CONSEQUENCES" for integrally related goods -- applicant's printed course materials in International Class 16.² Applicant argues that this fact too is probative of the conclusion that this matter, at most, is suggestive of this multimedia computer software.

A term is merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §

² Reg. No. 2,228,961 issued on March 2, 1999.

1052(e)(1), if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505 (CCPA 1980), citing In re Abcor Development Corp., 588 F.2d 811, 813-14, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute of them. In re Gyulay, 820 F.2d 1216, 1218, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Furthermore, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought. Abcor Development, 588 F.2d at 814, 200 USPQ at 218; In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

After careful review of the entire record, we agree with the Trademark Examining Attorney that the term "FINANCIAL CONSEQUENCES MODEL," when used in connection with the identified goods, immediately describes a significant feature or function of applicant's product - namely, that this computerized model demonstrates visually the financial

consequences of business decisions. As seen various places on the specimens of record:

The *Financial Consequences Model*[™] provides users with a practical, intuitive approach for recording transactions. It demonstrates how business decisions affect a firm's financial position and how the three financial statements interrelate. The model is included on the disc and can be launched as an Excel[™] spreadsheet for customized use by selecting "Financial Consequences Model" from the menu bar...

p. 2 of software documentation.

... Select "Financial Consequences Model" from the menu bar at the top of the screen. Doing so will launch a spreadsheet version of the Financial Consequences Model linked to the three financial statements. Use the spreadsheet model to look at alternatives to the transactions you just completed. For example, increase inventory purchases and create a large credit sale but delay collection of the accounts receivable. Determine when Café Caliente will run out of cash. Enjoy the learning experience!

p. 6 of software documentation.

Applicant argues that the instant software does not explain all "financial consequences" of financial decisions. However, for this alleged mark to be found merely descriptive under Section 2(e)(1) of the Trademark Act, it is not necessary that the software must be able to demonstrate every conceivable impact of any imaginable business decision.

In addition to the LEXIS/NEXIS® entries cited above, the Trademark Examining Attorney has also introduced entries

from two different financial dictionaries showing that in the general area of "corporate planning models," the subset of "financial models" (or "financial modeling") is a readily understood designation " ... for mathematical models showing the financial interrelationships among financial variables of the firm."³ Usually these complex models are used by executives in an actual organization. When decisions have significant financial impacts, advanced financial models enable the decision-makers easily to evaluate multiple scenarios. The executive will instantly see the effects, numerically and with charts and graphs, and can reach optimal decisions quickly. The executive might use financial models to develop a business plan, to do feasibility studies, to complete a merger and acquisition analysis, or other advanced uses. Similarly, in the case of applicant's goods, the model is used by students who can learn by quickly evaluating a number of different "what if" scenarios, with the advantage of observing instantly the effects of changing multiple factors.

Furthermore, the LEXIS/NEXIS® entries show that the term "financial consequences" is repeatedly used in the traditional print media in the context of complex

³ "Dictionary of Accounting Terms," Second Edition, by Joel G. Siegel and Jae K. Shim, 1995.

computerized models. The examples cited above show this terminology used in the context of a wide variety of computerized modeling: for individuals evaluating divorce settlements or making home-buying decisions; for executives planning major changes in their corporate plants; by accountants in projecting the cost of accidents or other adverse developments; or by insurance underwriters in assessing the potential liability of manufacturers who market complex electronic components.

Hence, logic tells us that a "financial consequences model" is a further subset of generic "financial models." To the college student studying financial accounting, this term immediately conveys an understanding of the features or functionalities of this software. The record shows a screen print of this "Introduction to Financial Accounting" software. Judging from the menu bar, a student of financial accounting using this product has the option of clicking on the button labeled "Financial consequences model and financial statements." The same menu bar offers other choices like "profitability and liquidity" and "valuation." At that early juncture in using this program, it is readily apparent to the student/consumer that what lies beyond this particular menu tab is exactly the type of software listed in the instant identification of goods.

Finally, as to the fact that another Trademark Examining Attorney approved for publication the mark "FINANCIAL CONSEQUENCES" for applicant's printed course materials, we do not find that registration controlling herein. First, prior determinations by other Trademark Examining Attorneys have no precedential effect. Even if we assume (and we do not) that publication of the mark in this companion case was contrary to the proscriptions of the Lanham Act and/or the examination policies of the United States Patent & Trademark Office, that fact is not determinative in the present case. While uniform treatment under the Trademark Act is desirable, our task on this appeal is to determine whether applicant's mark is registrable based upon the factual record before us. The record of this companion file, wherein the mark has been published and registered, is not before us. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991). Rather, each case that comes before this Board must be resolved on its own merits. See In re Citibank, N.A., 225 USPQ 612, 616 (TTAB 1985); In re Hunter Publishing Co., 204 USPQ 957, 961 (TTAB 1979); and In re Half Price Books, Records, Magazines, Inc., 225 USPQ 219, 221 (TTAB 1984). In any event, we should note that the marks are somewhat different, and the identifications of goods covered by the two marks are also different.

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Moreover, as the Examining Attorney correctly notes, a merely descriptive mark is not registrable simply because another similar (or arguably so) mark appears on the federal register or in the Trademark Official Gazette. See In re Consolidated Foods Corp., 200 USPQ 477, 481 (TTAB 1977) and In re Scholastic Testing Service, Inc., 196 USPQ 517 (TTAB 1977).

Decision: The refusal to register is affirmed.

R. F. Cissel

D. E. Bucher

L. K. McLeod

Administrative Trademark
Judges, Trademark Trial and
Appeal Board