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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 12  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Robert Weinke

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Serial No. 75/390,298

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Lynn A. Sullivan of Leydig, Voit & Mayer, Ltd. for Robert Weinke.

Angela M. Micheli, Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

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Before Cissel, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On November 14, 1997, applicant, a citizen the United States, applied to register the mark "BANK GLOBAL" on the Principal Register for "financial services, including, but not limited to, banking and related transactions offered electronically and through traditional methods," in Class 36. The basis for filing the application was applicant's assertion that he possessed a bona fide intent to use the mark in commerce in connection with these services.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark sought to be registered is merely descriptive of the services specified in the application. She also raised a number of informalities, including requesting applicant under Trademark Rule 2.61(b) to submit samples of advertisements or promotional materials.

Applicant responded to the first office action by amending the recitation of services to read: "financial services, namely, banking services offered electronically and through traditional methods," and amending the application to include a disclaimer of the exclusive right to use the word "BANK" apart from the mark as shown. In addition, applicant provided argument that the mark "BANK GLOBAL" is not merely descriptive of the services with which applicant intends to use it.

The refusal to register under Section 2(e)(1) of the Act was made final in the second office action. In support of the refusal, the Examining Attorney attached copies of the excerpts of articles retrieved from the Nexis® database of publications and materials from the Internet which show the term "global" used in reference to banking services. Examples include the following:

"... manage your bank balances around the world with Scotiabank's global banking services."

"monitor your global bank balances easily..."

"global banking services are for organizations that have... balance and transaction information requirements for their global operations."

"Korn/Ferry International's global banking practice consists of partner teams in the United States, Europe, Latin America and Asia."

"... gives you instant 24-hour access to global banking services from your personal computer."

"... premiere Latin American corporates have gained access to the mainstream global bank market, sources say."

"... was promoted from Executive Vice President in charge of global banking to Vice Chairman of the business bank."

"... dismisses as either unrealistic or politically infeasible the obvious options, including the creation of a new global bank..."

"He will retain his role as a senior member of the firm's global banking practice."

"'I have an advantage because I'm a big global bank with a large corporate customer base,' Mr.Sponholtz said."

"'the question for Fleet will be how to take advantage of BankBoston's strong Latin presence,' said a banker at a U.S. global bank."

"Harrison, 55, is vice chairman of Chase's global bank."

"He's already running the global bank, which represents two-thirds of (Chase's) bottom-line."

and

"analysts credit the Connecticut resident with keeping Chase above water last year, when Russia's default led to trading losses at several other global banks."

The Examining Attorney also made final the requirement for applicant to submit advertising or promotional materials under Rule 2.61(b).

Applicant submitted a Notice of Appeal and requested reconsideration of the final refusal to register. Submitted in support of applicant's argument that "BANK GLOBAL" is not merely descriptive of the banking services set forth in the application was a list 122 United States trademark registrations of marks which assertedly include the word "GLOBAL" and are registered in connection with services in Class 36. Copies of a number of the listed registrations were also provided. Applicant argued that the term "GLOBAL" does not relate to the place of origin of the services or the bounds within which applicant operates, contending that it is too broad a term to describe with any specificity a feature or characteristic of applicant's services.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's request for reconsideration. She was not persuaded by applicant's

arguments or evidence, however, and the refusal to register under Section 2(e)(1) of the Act was maintained.

The application file was returned to the Board, which resumed action on the appeal. Applicant filed his appeal brief, the Examining Attorney filed her brief on appeal, and applicant filed a reply thereto. Applicant did not request an oral hearing before the Board.

Until his reply brief, applicant had never even responded to the requirement to provide advertising or promotional materials, although the Examining Attorney had made the requirement in her first office action and repeated it and made it final in her second office action. When applicant still had not addressed this issue in his brief, the Examining Attorney, in her brief, brought it up again. Applicant's reply brief finally addressed the issue by stating that because the application was filed based on applicant's assertion that he intends to use the mark in commerce in connection with the stated services, rather than on actual use of the mark, applicant is not withholding the requested materials; rather, he does not have any advertising or promotional materials yet.

Although we are at a loss as to why this explanation was not provided responsive to the first two times the request was made, we are nonetheless constrained to accept

it at this juncture. Accordingly, the requirement under Trademark Rule 2.61(b) is reversed.

We now turn to the central issue in this appeal, which is the refusal to register under Section 2(e)(1) of the Lanham Act. Based on careful consideration of the record before us in this appeal and the arguments of applicant and the Examining Attorney, we find that the refusal to register is well taken.

The test for determining whether a mark is merely descriptive within the meaning of the Lanham Act is well settled. A mark is merely descriptive under Section 2(e)(1) if it immediately and forthwith describes a significant quality, characteristic, function, feature, purpose or use of the relevant services. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The mark applicant seeks to register, when considered in connection with banking services offered electronically and through traditional means, is merely descriptive of those services because it describes a recognized type of banking services, namely global banking services, which are banking services provided worldwide.

The materials made of record by the Examining Attorney clearly demonstrate that the term "global bank" is used to identify a bank which renders services throughout the world. If applicant were to use "BANK GLOBAL" in connection with electronic and traditional banking services, the mark would immediately inform prospective customers of this significant characteristic or feature of applicant's services.

Applicant contends that the term sought to be registered cannot be considered to be merely descriptive of the services set forth in the application because it too vague and indefinite to describe the services with the necessary particularity, citing *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 168 USPQ 609 (5<sup>th</sup> Cir. 1971), and *International House of Pancakes, Inc. v. Elca Corp.*, 216 USPQ 521 (TTAB 1982). While terms like "WORLD" and "INTERNATIONAL," when used in connection with some services like carpet sales and restaurant services can create situations wherein the mark as a whole may not provide specific or definite information about the service with which it used, in the case at hand, the record establishes that prospective customers of electronic and traditional banking services know what a global bank is and know what global banking is.

Applicant argues that by reversing the order of the words in the descriptive term "GLOBAL BANK," applicant has created a registrable service mark for his banking services. He claims that by reversing the order of the descriptive words, he has "arranged them in a way that is distinguishable from the descriptive uses of the term..." and that this somehow creates "a mark that is not merely descriptive[,] but rather suggests to consumers the nature of the services." (brief p. 4)

A mark which combines descriptive words may be registered if the juxtaposition of the words results in an unexpected mark or one with an incongruous meaning or a unique commercial impression. In re Ampco Foods, Inc., 227 USPQ 331 (TTAB 1985). As the Examining Attorney points out, however, this is not what is happening in the instant case. Citing In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), she quotes the Court therein for the proposition that simply combining two highly descriptive words will not necessarily result in a registrable trademark.

The record before us in this appeal provides no basis upon which we could conclude that by reversing the order of the descriptive term "GLOBAL BANK," applicant has diminished the descriptive significance thereof. All

applicant does is state the conclusion it urges us to adopt, without providing any evidence or reasoning upon which we could reach such a conclusion.

Applicant also argues that his mark is registrable because other marks for financial services which include the word "GLOBAL" have been registered, but this argument is not persuasive either. Three of the registered marks relied upon by applicant are registered on the Supplemental Register, which is an admission that those marks are merely descriptive. Each of the other marks is distinguishable from the mark in the case before us. In any event, it is well settled that third-party registrations are not determinative on the issue of descriptiveness. Each case must be decided on its own merits. In re Scholastic Testing Service, Inc., 196 USPQ 517 (TTAB 1977). The Board is not bound by previous decisions of Examining Attorneys to register other marks which may or may not be descriptive of the goods or services with which they are used. In re Pennzoil Products, Co., 20 USPQ2d 1753 (TTAB 1991).

Applicant's argument that his mark cannot be held to be merely descriptive because there is no evidence in this record that it used descriptively by others is likewise not well taken. That applicant intends to be the first and only one to use this descriptive term does not justify

**Ser No.** 75/390,298

issuance of a registration to him. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

In summary, the mark applicant seeks to register is unregistrable under Section 2(e)(1) of the Lanham Act because if it were to be used in connection with the services identified in the application, it would immediately and forthwith inform prospective customers of applicant's banking services that applicant is a global bank, providing banking services on a worldwide basis.

Decision: The refusal to register is affirmed.

**Ser No.** 75/390,298