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Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Financial Engines, Inc.

Serial No. 75/461,553

Lori M. Stockton of Blakely, Sokoloff, Taylor & Zafman for
Financial Engines, Inc.

Christine M. Baker, Trademark Examining Attorney, Law
Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 2, 1998, Financial Engines, Inc. (applicant)
filed Trademark Application Serial No. 75/461,553 seeking
registration of the mark FORECAST ENGINE (typed drawing)
for goods ultimately identified as "computer software for
financial planning, investment analysis, portfolio
allocation and eliciting recommendations for selecting
specific financial instruments" in International Class 9.

The application is based on applicant's assertion of a bona fide intent to use the mark in commerce.

The Examining Attorney refused to register the mark on the ground that the mark when applied to the services is merely descriptive. 15 U.S.C. § 1052(e)(1). After the refusal was made final, this appeal followed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney argues that "the proposed mark immediately identifies the nature of applicant's goods, namely, computer software (i.e., an engine) that has forecasting capabilities, specifically, the ability to calculate and estimate financial data and figures on a repetitive basis." To support her refusal, the Examining Attorney provides definitions for the words "forecast" and "engines."¹

First, the term "forecast" is defined as "the extrapolation of the past into the future. Usually an objective computation involving data, as opposed to a prediction, which is a subjective estimate incorporating

¹ We take judicial notice of both the Examining Attorney's and applicant's dictionary definitions submitted with their briefs as well as our own added definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the manager's anticipation of changes and new influencing factors." *Webster's New World of Computer Terms* (4th ed.), 166. The Examining Attorney also included a definition of "forecast" as "to estimate or calculate in advance." *Webster's II New College Dictionary* (1995).

Similarly, the Examining Attorney made of record two definitions of the term "engine." The first defined "engine" as "[t]he portion of a program that determines how the program manages and manipulates data." *Webster's New World of Computer Terms* (4th ed.), 144. The other defines the term as "software that performs a primary and highly repetitive function such as a database engine, graphics engine or dictionary engine." Freedman, *The Computer Glossary*, (8th Ed. 1998), 140.

Based on these definitions, the Examining Attorney concludes that the mark FORECAST ENGINE for computer software for financial planning, investment analysis, portfolio allocation and eliciting recommendations for selecting specific financial instruments is merely descriptive of the goods.²

² At this point, while the marks are identical and the goods and services similar, we note that the record in this case is very different from the related case (Serial No. 75/451,194) that we also decide today. The related case involved a mark that was in use in commerce with specimens of use and evidence that included applicant's press release and LEXIS/NEXIS articles. We note that the Examining Attorney in the instant case attempted to put in

In its brief, applicant argues that the term FORECAST ENGINE is not merely descriptive of its product and that the term "FORECAST ENGINE is a coined term, a fanciful combination that evokes a distinctive impression." Brief at 3. Applicant also argues that the Examining Attorney "makes a mental leap from the individual definitions to an alleged 'clear' meaning to the average purchaser." Br. at 4. Its reply brief, applicant argues that the term is incongruous and that:

Applicant's use of "FORECAST ENGINE" may be viewed as suggesting the power of Applicant's software in helping users to plan and take charge of their financial future. The common dictionary definition of 'engine' supports this view:

* * *

- b. A mechanical appliance, instrument, or tool:
engines of war
2. A locomotive.

Reply Br. at 3.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or if it conveys information regarding a function, purpose, or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA

similar evidence after the notice of appeal was filed but her request for a remand was denied in an order of the Board dated September 19, 2000.

1978). A term may be descriptive even if it only describes one of the qualities or properties of the goods. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

Here, we must decide if potential customers when they encounter the term FORECAST ENGINE for software for financial planning, investment analysis and portfolio allocation will immediately understand that the term describes a quality or characteristic of the software, and/or that it conveys information regarding a function, purpose, or use of the software.

We start by rejecting two of the arguments that applicant makes in support of its position that the Examining Attorney erred in refusing to register applicant's mark. First, we reject applicant's argument that the definition of "engine" as a locomotive or mechanical appliance suggests the power of applicant's software and somehow demonstrates that the term is not merely descriptive. We have no reason to believe that "engine" would not be given its accepted computer meaning when the term is used in connection with computer software.

Second, we find nothing incongruous about the use of the term FORECAST ENGINE on financial planning software. The key to determining whether a term is merely descriptive is to view the mark in relation to the goods and/or services, not in the abstract. An engine refers to a type of software and forecasting includes estimating or calculating in advance. An engine would be expected to be used in making forecasts or calculations about the future because it would involve the repetitive function of calculating different scenarios. Financial planning, by definition, involves making calculations or forecasts about the future, otherwise it would not be planning. Investing means "to utilize for future benefit or advantage." *Webster's II New Riverside University Dictionary* (1984), 641. It is not incongruous to use the terms "forecast" and "engine" in these circumstances. Thus, the only question is whether applicant's mark is suggestive of its goods or merely descriptive.

We admit that this is a much closer case than applicant's related case, which we decide contemporaneously today. We do not have the evidence of applicant's use and other evidence that was in that case, and we have not considered that evidence in reaching the result here. We must decide if a prospective purchaser of financial

planning software that makes recommendations for selecting financial instruments, upon seeing the term FORECAST ENGINE, would immediately understand that the term describes a feature, function or characteristic of the software.

From the dictionary definition of "engine," a potential purchaser would understand that, unless the word was used inaccurately, the software performs a primary or highly repetitive function such as a database engine, graphics engine or a dictionary engine. Applicant argues that: "Financial planning, investment analysis, portfolio allocation and eliciting recommendations for specific financial instruments . . . are, by their very nature, individually tailored, and are not 'primary and highly repetitive functions.'" Reply Br. at 2. While that is true of the ultimate recommendation, the underlying economic analysis to arrive at that recommendation would involve the highly repetitive number crunching analysis for which computers are famous. This function is the type of function that would be performed by a software engine.

A desirable feature of software, as described in applicant's identification of goods, would be the inclusion of a feature which forecasts investments based on economic variables that the individual or the individual's

investment advisor inputs into a computer program. Even the computer's ability to demonstrate potential investment scenarios based on forecasts of long-term economic conditions would be a highly desirable feature of the software. Indeed, if financial planning software did not contain a feature that made forecasts using a software engine, there would be a question of whether the term is deceptively misdescriptive of the goods.

We are cognizant of the prohibition against dissecting a mark and finding it descriptive based on its individual components. We must view the mark as a whole. At the same time, a mark is not merely descriptive simply because the Examining Attorney did not produce evidence showing use of the exact term. See In re American Society of Clinical Pathologists, Inc., 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1973). The question is whether the mark as a whole is merely descriptive because a combined term can have a non-descriptive meaning that the individual descriptive terms lack. See In re Colonial Stores, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (phrase SUGAR & SPICE from nursery rhyme not merely descriptive for bakery products). Here, we are unaware of any non-descriptive meaning that the term FORECAST ENGINE has, and its combined meaning is exactly what one would expect based on the words' individual

meanings.³ When the terms are combined and used on software for financial planning, investment analysis, portfolio allocation and eliciting recommendations for selecting specific financial instruments, we see no ambiguity. The term would tell prospective purchasers that the program contains an engine that calculates or forecasts financial projections to assist the purchaser in making investment decisions.

Decision: The refusal to register on the ground that the mark FORECAST ENGINE is merely descriptive of the involved goods is affirmed.

³ In its Reply Brief (p. 5), applicant refers to a registration and several applications it owns. It identifies the mark in the registration as FINANCIAL ENGINES, the mark in one pending application as FINANCIAL ENGINES INVESTMENT ADVISOR, and the marks in the other pending applications as FORECAST ENGINES. The printout to which applicant refers was not attached to its brief. However, applicant has asked the Board to take judicial notice of these facts. The Board does not take judicial notice of applications or registrations. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). This is particularly important in a case such as this where this information was submitted after the Examining Attorney's brief and, thus, after any opportunity for her to object. We note that the relevance of this evidence is questionable. See In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court").