

03/28/01

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

Paper No. 11
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hartford Life Insurance Company

Serial No. 75/467,064

John R. Garber of Cooper & Dunham for applicant.

Rodney Dickinson, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Hanak, Quinn and Drost, Administrative Trademark
Judges.

Opinion by **Quinn**, Administrative Trademark Judge:

An application was filed by Hartford Life Insurance
Company to register the mark STABLE PORTFOLIO for services
ultimately identified as "investment of funds for others
through annuity contracts by pension plan sponsors."¹

The Trademark Examining Attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground
that applicant's mark, when used in connection with

¹ Application Serial No. 75/467,064, filed April 13, 1998,
alleging dates of first use of January 1998.

applicant's services, is merely descriptive of them. The Examining Attorney also refused registration based on applicant's noncompliance with a requirement for new specimens. The Examining Attorney maintains that the specimens, which show use of the mark STABLE PORTFOLIO ONE, are unacceptable to support registration of the mark STABLE PORTFOLIO as shown in the drawing.

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

We first turn to the requirement for new specimens based on the Examining Attorney's view that the drawing (STABLE PORTFOLIO) is an incomplete representation or mutilation of the mark as actually used as shown by the specimens of record (STABLE PORTFOLIO ONE). When this requirement was made initially, applicant responded by contending that the specimens are sufficient to show use of the mark as it appears on the drawing. Applicant contended that "the suffix ONE is merely descriptive of an indication that it is the first of a series of STABLE PORTFOLIO contracts" and, as such, "it is not an integral element of the mark, which is STABLE PORTFOLIO." The Examining Attorney then issued a final refusal, clearly stating that "[t]he requirement for acceptable specimens showing the

mark as reflected in the drawing is maintained and made FINAL." Applicant's request for reconsideration solely addresses the mere descriptiveness refusal under Section 2(e)(1); no mention is made relative to the outstanding final requirement for new specimens. In denying the request for reconsideration, the Examining Attorney indicated that the "final refusal pursuant to Section 2(e)(1) of the Trademark Act and the final requirement for acceptable specimens showing use of the proposed mark in connection with the services are continued." Applicant's appeal brief is curious for what it omits. The "FACTS" section of the brief, which comprises a chronology of the prosecution history of the application, makes no mention of the requirement for new specimens. The "ISSUE" identified by applicant is solely mere descriptiveness. Further, applicant's five-page brief otherwise does not include a single reference to the specimen requirement. The Examining Attorney, in his brief, noted that "applicant has failed to offer any argument" against this portion of the final refusal. Applicant did not file a reply brief.

This review shows that applicant, after the Examining Attorney's issuance of a final refusal based on applicant's noncompliance with the requirement for new specimens, made absolutely no response to this requirement. Although

applicant filed an initial response to the requirement, we are compelled to find, in view of applicant's total lack of response to the requirement in either its request for reconsideration or its appeal brief (and no reply brief was filed), that applicant has waived its appeal with respect to the requirement for new specimens. On this basis alone, the refusal to register is affirmed.

We find that, in any event, the requirement for new specimens is well taken on the merits. As indicated above, the only response from applicant is that the term "one" denotes the first in a series of STABLE POTFOLIO contracts to be offered by applicant and that, therefore, the term is not an integral element of the mark.

Nothing in the record supports the statement that STABLE PORTFOLIO is used or is intended to be used in connection with a series of goods and/or services. Further, the specimens show the mark STABLE PORTFOLIO ONE appearing on one line in identical type. The specimens consistently refer to the mark as "SP1," identified by applicant as an abbreviation for STABLE PORTFOLIO ONE. The mark, as shown on the specimens, is the unitary mark STABLE PORTFOLIO ONE; thus, the specimens do not support registration of STABLE PORTFOLIO standing alone.

We next turn to the refusal based on mere descriptiveness to which the entirety of applicant's arguments in its request for reconsideration and appeal brief is addressed. Applicant contends that its mark is only suggestive and not merely descriptive. The main thrust of applicant's arguments relates to the prosecution history of another application, now abandoned, filed by applicant to register the mark STABLE PORTFOLIO ONE.² Applicant asserts that the same Examining Attorney in that case³ determined that the mark was registrable with a disclaimer of the word "Portfolio," and essentially argues that it should be able to rely on this prior determination when seeking registration herein.⁴

² Applicant has stated that the application "was abandoned for other reasons completely unrelated to the issues in this case."

³ The two applications were originally assigned to the same Examining Attorney who since has left the Office. The current Examining Attorney assumed responsibility over the present application at the time of issuance of the final refusal.

⁴ During the prosecution of the application involved herein, applicant based its arguments primarily on the prosecution history of its earlier application. It was not until its appeal brief, however, that applicant furnished any underlying evidence relating to the earlier application. With its appeal brief, applicant submitted a copy of an Office action in the earlier application wherein the Examining Attorney, *inter alia*, requested a disclaimer of the term "Portfolio." The Examining Attorney has objected to this submission, correctly pointing out that it is untimely. Trademark Rule 2.142(d). Given the particular nature of this evidence, and the fact that a TRAM printout was earlier made of record by the Examining Attorney, however, we have elected to exercise our discretion and consider the untimely evidence.

The Examining Attorney maintains that the mark is merely descriptive because it immediately tells the relevant purchasing public that applicant's investment services provide a group of relatively safe and non-volatile funds. The Examining Attorney contends that the term "stable portfolio" is commonly used among institutional investors to refer to the fact that certain investments are non-volatile and relatively safe. In support of this contention, the Examining Attorney submitted excerpts retrieved from the NEXIS database showing descriptive uses of the term "stable portfolio" in the financial investment field. The Examining Attorney also submitted a dictionary definition of the word "portfolio,"⁵ and a TRAM printout relating to applicant's earlier application which shows it to be abandoned.

It is well settled that a term is considered to be merely descriptive of services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature,

⁵ The term is defined as "a group of investments." *The American Heritage Dictionary of the English Language* (3rd ed. 1992). We take judicial notice of the dictionary definition of the word "stable": "not subject to sudden change; subject to relatively limited fluctuation." *Webster's Third New International Dictionary* (unabridged ed. 1993).

function, purpose or use of the services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

A review of applicant's specimen of record is revealing. Applicant states that it "offers qualified retirement plan sponsors a simple, new way to increase the diversity of their stable value funds," by "buy[ing] units in some of America's best-run stable value pooled funds." Applicant claims that its services are designed for those who are "seeking greater diversity and stability" by virtue of its "diverse stable value assets." The specimen indicates that applicant's investments are allocated equally among eight "stable value pooled funds," one of which is the Norwest Stable Return Fund.

The NEXIS excerpts include the following examples of descriptive uses of the term "stable portfolio" in the financial investment field:

One of his largest holdings in a stable portfolio is Washington-based Fannie Mae...

The Washington Post, January 17, 1999

He said the AFP-RSBS made no investment in stable portfolios like Treasury bills and bonds, which should be the primary choice of pension fund managers.

BusinessWorld, August 21, 1998

This fund is ideal for investors seeking a stable portfolio and for those who are more concerned with "not losing their money versus making huge gains."

The Palm Beach Post, December 20, 1997

We find that, when used in connection with applicant's "investment of funds for others through annuity contracts by pension plan sponsors," the term STABLE PORTFOLIO immediately describes, without conjecture or speculation, a significant characteristic or feature of the services, namely, that applicant's investments in stable value pooled funds result in a "stable portfolio," that is, one that increases stability and reduces volatility. As applicant's specimen clearly states, one of the benefits of applicant's services is to create increased stability in a portfolio or group of investments. To consumers of applicant's investment services, there is nothing in the term STABLE PORTFOLIO which, in the context of applicant's specific

services, would be ambiguous, incongruous or susceptible to any other plausible meaning.

Although the term "stable portfolio" may be used to describe a variety of financial investments, the term is no less descriptive as used in connection with the specific services recited in the application. See: *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd without pub. op.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

Applicant's reliance on its earlier-filed application, now abandoned, is of little moment. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark sought to be registered here is merely descriptive. As often stated, each case must be decided on its own merits. Neither the current Examining Attorney nor the Board is bound by the prior action of the Examining Attorney in the now-abandoned application. See: *In re Nett Designs Inc.*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Decision: The refusal to register under Section 2(e)(1) is affirmed. The refusal to register based on applicant's noncompliance with the requirement for new specimens is affirmed.

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