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Paper No. 15
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The Whole Child Learning Company, Inc.**

Serial No. 75/646,333

James C. Wray for The Whole Child Learning Company, Inc.

Brian Neville, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before **Cissel**, Seeherman and Quinn, Administrative
Trademark Judges.

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

On February 23, 1999, applicant filed the above-identified application to register the mark "THE WHOLE CHILD LEARNING COMPANY" on the Principal Register for "educational instructional services in day care preschool and primary schools, namely providing teachers, classes, materials and instruction and interaction in the fields of kinesthetics, athletics, arts, civics, mathematics, logic, critical thinking, problem solving, spatial relations, time concepts, measurements, linguistics, music, cooperation,

social and interpersonal skills and activities, motivation, phonics, reading, pre-reading readiness, shape and color recognition, sequencing, computer skills and use and care of computer equipment," in Class 41. The basis for filing the application was applicant's claim that it has used the mark in commerce in connection with these services since August 1, 1998.

The Examining Attorney¹ refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. 1052(e)(1), on the ground that the mark is merely descriptive of the services with which applicant uses it. She took the position that the term "'Whole Child' describes the focus of the services and 'Learning Company' describes what the service does." (Office Action No. 1, August 16, 1999). Submitted in support of the refusal to register were copies of excerpts from published articles wherein the terms "whole child" and "learning company" were used. Examples of the excerpts showing use of the first term include the following:

The charter school, named Whole Child at UPARC, is scheduled to open in August...
(The Tampa Tribune, July 3, 1999)

¹ This application was originally examined by another Examining Attorney, but was subsequently reassigned to the attorney whose name is shown above.

The task of education, say Almond Hill instructors, is to teach the "whole child," paying attention to the intellectual, physical, social, psychological and moral aspects.
(The Sacramento Bee, May 20, 1999)

They have always believed in educating the whole child, and felt that arts was part of the comprehensive education.
(Las Vegas Journal, May 1, 1999)

Education of the "whole" child (physical, emotional, educational, mental, spiritual) that would allow the individual to view life as a precious gift from the Creator is not part of the child's education.
(The Times Picayune, April 27, 1999)

If approved, the charter school would offer parents a choice between Whole Child and Paul B. Stephens Exceptional Education Center, which does not integrate children in its preschool.
(St. Petersburg Times, March 1, 1999)

Examples of the evidence of how the second term in applicant's mark is used include the following:

...and was actively involved in the sale and subsequent transition of the Broderbund business to The Learning Company.
(Business Wire, April 9, 1999)

...16 featured companies that act as corporate sponsors, including ...The Learning Company and the Junior Achievement organization.
(PR Newswire, August 19, 1999)

...The Learning Company, educational software firm that Mattel acquired earlier this year.
(AP Newswire, August 4, 1999)

...The Learning Company, the largest maker of children's educational software...
(San Jose Mercury News, August 4, 1996)

As part of Harcourt, Inc.'s mission to be one of the world's pre-eminent 'anytime, anywhere' learning companies, we recognize the growing importance of technology-based learning... (Business Wire, June 1, 1999)

In addition to refusing registration under Section 2(e)(1), the Examining Attorney also required applicant to amend the recitation of services to be more definite. She suggested that applicant adopt "early educational services, namely, providing instruction in the fields of kinesthetic [sic], athletics, arts, civics, mathematics, logic, critical thinking, problem solving, spatial relations, time concepts, measurements, linguistics, music, cooperation, social and interpersonal skills and activities, motivation, phonic[s], reading, pre-reading readiness, shape and color recognition, sequencing, computer skills and use and care of computer equipment."

Responsive to the first Office Action, applicant adopted the suggested recitation of services, offered to disclaim the term "WHOLE CHILD" apart from the mark as a whole, and argued that the mark, when considered in its entirety, is not merely descriptive of the services identified in the application, as amended. Applicant pointed out that in each of the examples of use of the term "LEARNING COMPANY" submitted by the Examining Attorney, the term was shown as "The Learning Company," i.e., as a proper

name, and that as such, this evidence does not show descriptive use of the term " THE LEARNING COMPANY," as it is used as the second component of applicant's mark.

The Examining Attorney accepted applicant's amended recitation-of-services clause, but declined to accept the proffered disclaimer, suggesting instead that applicant amend to seek registration on the Supplemental Register because the mark in its entirety is merely descriptive.

Conceding that the evidence submitted with the first Office Action did not show descriptive use of "LEARNING COMPANY," the new Examining Attorney included with the second Office Action copies of an advertisement for a book titled "The Learning Company Toolkit," which appears to use the term in question to describe a business which "learns" in order to be able to communicate, organize and adapt better to the changing business environment. Nothing in this three-page text appears to relate to any of the services set forth in the amended application.

Also included with the second Office Action, however, were additional excerpts from published articles. Included were the following:

The Portland-based multimedia creative learning company has developed a series of CD-ROMs, books, educational Web portals and interactive technologies...
(The Tribune, undated)

...the idea of becoming a publisher came to him seven years ago--when he supervised the turnaround of a learning company.
(News and Observer, May 1, 2000)

If you want to improve your skills, go to work for a learning company. But if you aspire to a career with an enterprise that's likely to endure, hire on at a teaching company.
(Austin American-Statesman, December 30, 1997)

Imagine a "learning" company with an innovative employee that refines a process so the company can cut its costs...
(Daily Press, February 17, 1998)

Additionally, attached to the second Office Action were a number of third-party trademark registrations wherein the term "LEARNING COMPANY" is disclaimed. The goods in these registrations are identified as computer programs, printed materials for computer programs, computer hardware, printed instructional materials for teaching children and educational games.

The refusal to register was continued, and applicant was advised that registration on the Supplemental Register would require a disclaimer of the term "LEARNING COMPANY."

Applicant did not amend to seek registration on the Supplemental Register, but did follow the instruction of the Examining Attorney to amend the application to disclaim "LEARNING COMPANY" apart from the mark as shown, and argued that the refusal based on Section 2(e)(1) should be withdrawn.

The Examining Attorney was not persuaded, and the refusal to register was made final with the third Office Action. Submitted with the final refusal were additional excerpts from articles. The Examining Attorney noted that one refers to "...giving teachers the specific skills they need to teach the whole child--emotionally, socially, physically, creatively, and cognitively." (The Whole Child: Developmental Education for the Early Years, Joanne Hendrick, 2001.) Another is titled "Special programs address the needs of the 'whole child,'" and concludes that "[w]e must look at the whole child." (The Signal, October 18, 1997).

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the record in this application, the arguments presented by applicant and the Examining Attorney, and the relevant legal precedents, we hold that the refusal to register must be affirmed.

The test for determining whether a mark is merely descriptive within the meaning of Section 2(e)(1) is well settled. A mark is merely descriptive of the goods or services with which it is used if it immediately and

forthwith imparts information, with some degree of specificity or particularity, about a significant ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The Examining Attorney bears the burden of establishing that the term sought to be registered is merely descriptive. Whether it is merely descriptive or only suggestive of the goods or services with which is used has been recognized as a question of a highly subjective nature, and any doubts in regard to this question must be resolved in favor of the applicant. In re Aid Laboratories, Inc., 221 USPQ 215 (TTAB 1983).

Simply put, the Examining Attorney has met his burden of supporting the refusal to register with evidence upon which we can without doubt conclude that "THE WHOLE CHILD LEARNING COMPANY" immediately and forthwith conveys information about the services with which applicant uses this mark.

The evidence submitted by the Examining Attorney with respect to the "LEARNING COMPANY" component of applicant's mark establishes the descriptiveness of this term in

connection with the services specified in this application. Moreover, the applicant has disclaimed this term, so we must consider that its descriptiveness has been conceded. The same is true with respect to the second component of the mark applicant seeks to register. Not only does the evidence of record establish the descriptiveness of "THE WHOLE CHILD" in connection with these services, but applicant has also offered to disclaim this term, thus conceding its descriptiveness.

The issue before us thus boils down to whether, when these two descriptive terms are combined, the mark in its entirety does more than describe the services.

Nothing in the record supports this conclusion. Applicant does not explain, much less support with evidence, the contention that the combination of these two descriptive terms is not itself merely descriptive of the services which are independently described by each term. "THE WHOLE CHILD LEARNING COMPANY" immediately conveys to prospective purchasers of applicant's services significant information with regard to characteristics of those services, namely that they are provided by a learning company and that they are directed to the "whole child," i.e., that the educational services are directed to aspects of child development that are outside the usual parameters

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of the educational services provided by traditional schools. Just as the two individual terms are descriptive of the services, no additional degree of thought or imagination is required to deduce this descriptive significance from consideration of this entire mark in connection with the services. We are left with no doubt as to the correctness of this conclusion.

DECISION: The refusal to register based on Section 2(e)(1) of the Lanham Act is affirmed.

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