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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Senior Consulting Group, L.L.C.

Serial No. 75/587,358

Ezra Sutton of Ezra Sutton, P.A. for Senior Consulting Group, L.L.C.

Florentina Blandu, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Hohein and Bottorff, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Senior Consulting Group, L.L.C. has filed an application to register on the Supplemental Register the mark "NSAC NATIONAL SENIOR ADVISORY COUNSEL" and design, as shown

below,

for "conducting seminars for senior persons relating to financial and estate matters."[1]

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the wording "NATIONAL SENIOR ADVISORY COUNSEL," which the Examining Attorney maintains is merely descriptive of applicant's services (within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1)) and therefore must be disclaimed apart from the mark as shown as a unitary expression.[2]

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[1] Ser. No. 75/587,358, filed on the Principal Register on November 12, 1998, based on an allegation of a bona fide intention to use the mark in commerce. The application was amended to the Supplemental Register on November 13, 2000 when applicant also filed an amendment to allege use of the mark, claiming a date of first use anywhere and in commerce of November 30, 1998. The words "NATIONAL," "SENIOR" and "ADVISORY" are disclaimed.

[2] The Examining Attorney, apparently in view of the term "NSAC" and the design elements in applicant's mark, also made final a refusal to register such mark on the Supplemental Register. As support for her position, she cited what is now TMEP §815.01 (3rd ed. 2002, rev. 2) (formerly Section 1114.01), which is entitled "Marks Eligible for Principal Register Not Registrable on Supplemental Register" and provides that:

> A mark that is clearly eligible for the Principal Register may not be registered on the Supplemental Register. An application requesting registration on the Supplemental Register must be amended to the Principal Register, or refused registration if the mark is registrable on the Principal Register. *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 115 USPQ 96 (Comm'r Pats. 1957).

However, in her brief, the Examining Attorney appears to have implicitly withdrawn the refusal to register applicant's mark on the

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the disclaimer requirement.

Applicant, in its brief, asserts that it is not a "national senior advisory counsel" inasmuch as it "is not an entity in the form of a counsel (or council)." Applicant maintains, instead, that it "dispatches individuals to provide seminars to senior citizens on a nationwide basis. In view thereof, applicant contends that while it "is willing to disclaim the individual words 'NATIONAL' and 'SENIOR' and 'ADVISORY[,]' it should not have to disclaim the remaining word, namely, 'COUNSEL,' and certainly it should not have to disclaim the entire composite four word combination in the unique sequence as used by applicant."

In particular, as to the evidence of record, which consists of copies of various third-party registrations for marks in which the words "NATIONAL," "SENIOR," "ADVISORY" or "COUNSEL" have been disclaimed with respect to (for the most part) a variety of personnel, educational, health, financial and/or advisory services, applicant argues in its brief that:

Supplemental Register, stating that '"[t]he sole issue on appeal is whether the wording 'NATIONAL SENIOR ADVISORY COUNSEL' is descriptive of the services and whether they should be disclaimed apart from the mark as shown as a unitary expression." Accordingly, the propriety of registration of applicant's mark on the Supplemental Register is not before us.

> [T]here is no evidence from the registrations that the combination of <u>all four (4)</u> of applicant's words [in its mark] needs to be disclaimed (for instance, none of the registrations show[s] that the phrase "advisory counsel" has ever been disclaimed or even used); nor is there any evidence in the record (such as NEXIS excerpts) to show that this four-word combination or any similar combination has ever been used in applicant's field of services.

Applicant consequently concludes that the Examining Attorney "has

not made a prima facie showing as to why all four (4) words in applicant's mark need to be disclaimed."

The Examining Attorney, on the other hand, insists in her brief that the words comprising the phrase "NATIONAL SENIOR ADVISORY COUNSEL" are merely descriptive of applicant's services of conducting seminars for seniors which relate to financial and estate matters "because they describe the exact nature of the entity that renders the services, namely, that the entity is a national advisory counsel that provides services to seniors." Specifically, as stated in her brief, she reasons that

> The applicant provides advice to seniors. The advice is rendered through the use of diverse counsel. The services are offered nationally. Therefore, the wording in question is descriptive and must be disclaimed accordingly.

Moreover, she asserts that because "the wording in question, 'NATIONAL SENIOR ADVISORY COUNSEL,' make[s] up a unitary expression, ... [it] must be disclaimed in its entirety.

As support for the latter proposition, the record shows, as the Examining Attorney points out in her brief, that "applicant agreed to and registered the same wording ..., NATIONAL SENIOR ADVISORY COUNSEL, without the design element and the acronym [NSAC], for the same type of services, on the

Supplemental Register."[3] With respect to the absence of any evidence demonstrating the use of the phrase "NATIONAL SENIOR ADVISORY COUNSEL" in a descriptive manner, the Examining Attorney "notes that had such evidence been found," she "would have argued that the ... expression is generic, and not descriptive," but asserts that "[t]he evidence of record is acceptable to support a finding that the wording in question is descriptive." Lastly, as to the propriety of disclaiming the word "COUNSEL," the Examining Attorney requests in her brief that the Board take judicial notice that The American Heritage Dictionary of the English Language (3rd ed. 1992) defines such term in relevant part as meaning "[a]dvice or guidance, especially as solicited from a knowledgeable person."[4] The advertising brochure submitted as applicant's specimen of use, the Examining Attorney accurately observes, "clearly indicate[s]

[3] Reg. No. 2,422,294, issued on the Supplemental Register on January 16, 2001, which sets forth a date of first use anywhere and in commerce of September 1998 for the services of "conducting seminars for senior persons relating to financial and estate matters." Only the word "NATIONAL" is disclaimed.

[4] The Examining Attorney's request is granted inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

that diverse experts will advise seniors on financial matters ...."[5]

Because applicant seeks registration of its mark on the Supplemental Register, and thus has necessarily acknowledged by its action that its entire mark, including all terms therein, is at least merely descriptive of its services, the requirement of a disclaimer of the phrase "NATIONAL SENIOR ADVISORY COUNSEL" is in essence a finding that such phrase is generic with respect to applicant's services of "conducting seminars for senior persons relating to financial and estate matters." While properly noting in her final refusal that it is the policy of the U.S. Patent and Trademark Office ("USPTO") that, if an applicant's mark were otherwise "capable of registering on the Supplemental [R]egister, then, at that point, only generic

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[5] Among other things, such literature states that:

> The NSAC is a national senior advocacy group dedicated to solving the problems facing today's seniors. We have focused our considerable resources on identifying, researching and finding solutions to the problems of seniors -- including the financial devastation which is often caused by enormous long term health care costs. ....
>
> To that end, we have been presenting our educational seminars around the country to thousands of seniors, covering such topics as long term health care, Medicare, Medicaid, insurance, tax planning, investment management, and estate planning. To address these issues, the NSAC has assembled a team of independent professionals from various disciplines, including insurance, mortgage banking, finance, tax and law. This diverse expertise allows the NSAC to integrate all of these disciplines into its analysis of your particular situation. ....

matter would have ... to be disclaimed," in her brief the Examining Attorney appears to have lost sight of such policy by failing to offer any argument demonstrating the genericness of the phrase "NATIONAL SENIOR ADVISORY COUNSEL." Thus, while a showing of mere descriptiveness of such phrase would be adequate if applicant were seeking registration of its mark on the Principal Register, clear evidence of the genericness thereof is necessary in order to uphold the disclaimer requirement where, as here, registration of applicant's mark is sought on the Supplemental Register.

Specifically, it is well established that in the case of a generic term or phrase, the burden is on the USPTO to show the genericness of such by "clear evidence" thereof. See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). As to the standard for evaluating genericness, the Board in In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), has stated for example that:

> The test for determining whether a designation is generic, as applied to the goods [or services] set forth in an application or registration, turns upon how the term is perceived by the relevant public. *See* Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991) and cases cited therein at 1553. Such perception is the primary consideration

> in a determination of genericness. *See* Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1532 (Fed. Cir. 1992). As Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3), makes clear, "[a] ... mark [or portion thereof] shall not be deemed to be the generic name of goods or services solely because such ... is also used as a name of or to identify a unique product or service"; instead, "[t]he primary significance of the ... mark [or portion thereof] to the relevant public rather than purchaser motivation shall be the test for determining whether the ... mark [or portion thereof is or] has become the generic name of the goods or services on or in connection with which it has been used." Consequently, if the designation sought to be registered is understood by the relevant public primarily to refer to the class or genus of goods [or services] at issue, the term is generic. *See* H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., [728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)] .... Evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. *See* In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

Furthermore, as reaffirmed by our principal reviewing court in In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999): "[T]he correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark [or portion thereof] refers primarily to 'that genus of goods or services.'"

The court, in particular, noted in this regard that "[a]ptness is insufficient to prove genericness" and also cautioned that it is insufficient to "simply cite definitions and generic uses of the constituent terms of a mark, or ... a phrase within the mark, in lieu of conducting an inquiry into the meaning of the disputed [terms or] phrase as a whole [in order] to hold a mark, or a phrase within in the mark, generic." Id.

We are constrained to agree with applicant that the evidence of record falls short of clearly establishing genericness. While, under *Marvin Ginn*, it is plain that the genus or class of services at issue is conducting seminars for senior persons relating to financial and estate matters, there is simply no evidence to show that the phrase "NATIONAL SENIOR ADVISORY COUNSEL" is understood by the general public to refer to or designate, as opposed to merely describing, such a category of services. Accordingly, notwithstanding the various third-party registrations for marks which contain disclaimers of the individual words "NATIONAL," "SENIOR," "ADVISORY" or "COUNSEL" and the dictionary definition of the word "counsel," the absence on this record of any "NEXIS" excerpts or other evidence of third-party use of the phrase "NATIONAL SENIOR ADVISORY COUNSEL," in connection with the services of conducting seminars for seniors which relate to financial and estate matters, compels a conclusion that such phrase is not generic in

relation to applicant's services. See, e.g., In re American Fertility Society, supra; and In re Ferrero S.p.A., 24 USPQ2d 1155, 1157 (TTAB 1992) ["if a term is generic for a type of a product [or service] that has been on the market for decades, evidence of its use by others in the marketplace should be available"]. A disclaimer thereof is therefore not required for registration of applicant's mark on the Supplemental Register.

Decision: The requirement for a disclaimer under Section 6(a) is reversed.