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CITABLE AS PRECEDENT OF
THE TTAB**

Mailed: June 3, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Executive Coaching Network, Inc.

Serial No. 76020606

Marnie Wright Barnhorst of The Trademark Group for
Executive Coaching Network, Inc.

Michael E. Bodson, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On April 6, 2000, Executive Coaching Network, Inc.
(hereafter "applicant") filed an application, based on an
asserted bona fide intention to use the mark in commerce,
for the mark STRATEGIC EXECUTIVE COACHING for services
which were subsequently identified as "educational
services, namely, conducting individual counseling
sessions, seminars and workshops which provide executives

with information about business management."¹ In the first Office action the Examining Attorney, *inter alia*, required a disclaimer of the merely descriptive words EXECUTIVE COACHING, and when applicant complied with this requirement the mark was published for opposition on October 16, 2001.²

On May 9, 2002, a letter of protest was forwarded to the Examining Attorney by the Administrator for Trademarks Classification and Practice, and jurisdiction over the application was restored to the Trademark Examining Attorney. Prior to that, however, a notice of allowance issued on January 8, 2002, and applicant filed a Statement of Use on April 9, 2002, in which it claimed first use dates of September 1999 for its identified services.

On May 13, 2002 the Examining Attorney issued an Office action in which he refused registration pursuant to Section 2(e)(1), 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services. Applicant filed a notice of appeal on November 12, 2002 and an appeal brief on January 16, 2003. Although the appeal was initially instituted by the Board, upon further review of the file it was determined that the appeal was

¹ Application Serial No. 76020606.

² The Examining Attorney also required a more definite identification of services, and applicant also complied with this requirement in its response.

premature. The Board order instituting the appeal was vacated, and the Examining Attorney was instructed to treat applicant's appeal brief as a response to the May 13, 2002 Office action. On February 13, 2003 the Examining Attorney made the refusal of registration pursuant to Section 2(e)(1) final, and on May 9, 2003 applicant filed the appeal which is now before us.

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

As a preliminary matter, we note that in its response to the first Office action raising the descriptiveness refusal, and again in its brief, applicant has asserted that the letter of protest, which was the basis for restoring jurisdiction over the application to the Examining Attorney, was untimely filed, and should never have been considered. In making these assertions, applicant apparently believed that the letter of protest was filed on April 9, 2002, which was six months after the application was published for opposition. However, in his appeal brief, the Examining Attorney explained that the letter of protest was actually submitted on October 31, 2001, within thirty days of the publication of the mark, and it was therefore timely. The Examining Attorney has

further explained that the letter of protest was accepted on May 9, 2002.

We must admit that we can find no indication in the file as to the date the letter of protest was submitted to the Office. This is not surprising, since when a letter of protest is submitted it does not form a part of the application file to which it pertains. Rather, if the Administrator for Trademark Classification and Practice grants the letter of protest, the Examining Attorney is informed that such a letter was filed, and any pertinent evidence that is submitted with the letter of protest is forwarded to the Examining Attorney. However, the Examining Attorney is not given the actual letter of protest, and therefore the date of receipt of the letter of protest does not appear in the file. In this case, the memorandum from the Administrator for Trademark Classification and Practice transmitting the letter to the Examining Attorney is dated May 9, 2002. The April 9, 2002 date to which applicant refers in its brief appears to be the date applicant filed its Statement of Use.

In any event, the timeliness of the filing of the letter of protest is not a question for the Board. If applicant wished to raise the issue of the propriety of the granting of the letter of protest, it should have done so

by way of petition to the Commissioner. This is not an issue for appeal. See TBMP §1201.05.

Another procedural matter concerns the Statement of Use filed by applicant on April 9, 2002. Applicant filed its Statement of Use three months after the mailing date of the Notice of Allowance, and one month prior to the grant of the letter of protest and the restoration of jurisdiction to the Examining Attorney. However, the Notice of Allowance was cancelled on May 13, 2002, at the point that the letter of protest was granted and jurisdiction was restored to the Examining Attorney. At that point the Statement of Use had not been examined. Thus, should applicant ultimately prevail in this proceeding, the file will be returned to the Examining Attorney to examine the Statement of Use.

This brings us to the substantive issue in this proceeding: whether or not applicant's mark STRATEGIC EXECUTIVE COACHING is merely descriptive of its identified services, "educational services, namely providing executives with information about business management."

A mark is merely descriptive, and therefore prohibited from registration by the provisions of Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with

which it is used, while it is suggestive, and registrable, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. The question is not decided in a vacuum but in relation to the goods on which, or the services in connection with which, it is used. See *In re Venture Lending Associates*, 226 USPQ 285, 286 (TTAB 1985). See also *In re Abcor Development Corporation*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Applicant has acknowledged the descriptiveness of EXECUTIVE COACHING by disclaiming exclusive rights to this term. Moreover, applicant's own specimens, submitted with its Statement of Use, amply demonstrate the descriptiveness of this phrase:

EXCN's accomplished executive coaches
focus vast corporate experience on
improving business performance....

STRATEGIC EXECUTIVE COACHING
Provides one-on-one coaching to
executives in areas they have
identified as vital to their
effectiveness....

Additional materials which were provided through the letter of protest, and made of record by the Examining Attorney, indicate the highly descriptive, if not generic nature of this term. For example, the biographies that are shown in the website for Assess Plus Affiliate Consultants, www.assessmentplus.com, frequently describe the personnel as having an expertise in executive coaching:

Arline N. Berman has over 18 years experience in organizational development, strategic planning, performance management, outplacement, and executive and business coaching.

Robert David Lapidus...has implemented interventions including executive coaching....

Dr. Joy McCarthy...has designed and implemented programs in executive coaching....

William R. Tiffan...blends consulting, training, executive coaching and facilitation services....

The materials from Cambria Consulting use "executive coaching" in a generic manner, e.g., "Executive coaching grew substantially..." and "The number of organizations engaged in executive coaching...."

Even two articles which applicant states were written by its own officers use "executive coaching" generically, e.g.:

The rapid growth of executive coaching reflects its bottom-line benefits...
Freas, Alyssa M. and Mankin, Don,
"Strategic Coaching has Bottom-Line Benefits," www.aesc.org

To be effective, executive coaching must be both strategic and individualized....

Id.

To engage and motivate individuals, executive coaching must be tailored....

Id.

To the casual observer, the practice of executive coaching...

Lyons, Laurence S., "Coaching at the Heart of Strategy,"
www.coachingnetwork.org.uk, p. 2

The second insight to be gained takes us beyond executive coaching.

Id.

Yet, an organization that regards executive coaching as a service provided entirely by external suppliers can never attain a true climate of leadership.

Id.

The Examining Attorney has also submitted evidence to show that applicant's mark as a whole, STRATEGIC EXECUTIVE COACHING, is merely descriptive. This evidence includes the material which was included with the letter of protest. Applicant has argued that these excerpts do not show descriptive use, and has discussed each of these excerpts in some detail. We will do the same.

The first excerpt is from www.springboardcoaching.com, which is apparently the website of SpringBoard Coaching Group LLC. Under the general heading "Executive Coaching Programs" is the phrase, "Discover your success formula with a coaching program designed for you," which is in turn followed by the listing:

Strategic Executive Coaching
Jump Start Development
High Potential Leader Development

There is a subheading for the "Strategic Executive Coaching Program," and then a description of the program, which states that it is "Designed to provide the executive with ongoing support of strategic and tactical professional and personal goals," and goes on to say, "This traditional coaching program focuses on your professional and personal goals...."

Applicant claims that "Strategic Executive Coaching Program" is not a descriptive use, but a common law trademark use that may be infringing on applicant's rights. We do not agree. Rather, it appears to be a descriptive name for a particular coaching program, which is used in the same way as the phrase "Jump Start Development Coaching Program" is used for a program for "Individuals who want to jump-start skill development" and the phrase "High-Potential Leader Development Program" is used for a program

"designed to accelerate the progress of high-potential managers and executives" which "coaching program is designed to develop key leadership competencies necessary to move the senior manager or executive to the next position."

The material from www.assessmentplus.com lists what appear to be the biographies of "Affiliate Consultants" for Assessment Plus. The biography of Jill Davis, who is described as "an experienced strategic planner" "who has transitioned to executive coaching" states that she is a "Senior Associate of the Strategic Executive Coaching Alliance and partners with that experienced team of corporate coaches on larger scale engagements." Again, applicant asserts that Strategic Executive Coaching Alliance is a "probably infringing" common law trademark use. Even if Strategic Executive Coaching Alliance is the name of a group or organization, this does not necessarily mean that the phrase "Strategic Executive Coaching" is not merely descriptive. The biographies are replete with the use of descriptive terms within or as the names of organizations. For example, the biography of Kathryn Hayman says that she is a member of the Society of Human

Resource Management,³ and the biography of Dr. Ken Jackson says that he is a member of the Southeastern Psychological Association, the Society for Industrial and Organizational Psychology and the Atlanta Society of Applied Psychology.

The third excerpt is from www.mayogenuine.com, and contains, under the title "Executive Coaching," the following sentence:

Your headquarters for executive coaching materials, executive coaching tips, executive coaching experts, on-site executive coaching, speakers for executive coaching, tactical executive coaching, strategic executive coaching, basic executive coaching and executive coaching for veterans.

Even applicant acknowledges that "strategic executive coaching" is used in this website in a descriptive manner. However, applicant states that "this phrase is no longer used on the www.mayogenuine.com website." Brief, p. 6. Applicant did not provide a copy of what it contends is currently on the website in support of its assertion. Moreover, this Board was able to access the website during the course of drafting this opinion, and it has the same content and appearance as the excerpt which is in the record. Thus, we give full weight to the fact that

³ The biography of Kevin E. Cruse states that that he "has over 16 years of human resource management experience" and has "a MS in Human Resource Management...."

"strategic executive coaching" is used on this website as a descriptive term.

The fourth excerpt is a printout of a computer screen, showing the address www.valerieandcompany.com. Under the title "Executive Coaching" are the following paragraphs:

Coaching is a concept with considerable merit, particularly in a corporate world that has difficulty coming up with mentors for talented executives....

Valerie & Company launched the Executive Coaching division by filling a need requested by clients....

Since 1993, Valerie & Company's Strategic Executive Coaching has been used internationally by organizations including....

Applicant claims that because "Strategic Executive Coaching" is used with initial capitals, this is another common law trademark use of the term. We disagree. Obviously not all capitalized terms are trademarks; descriptive and generic terms can be depicted with capital letters merely to make them stand out. That is the impression that is conveyed by this company's use of "Strategic Executive Coaching."

Further, the phrase "Strategic Executive Coaching" appears to be used by this company as a generic term, and there is no generic term used with the phrase. It is also

noted that "Executive Coaching," which is a descriptive or generic term, is also depicted with initial capital letters.

The fifth excerpt is an article entitled "Strategic Coaching Has Bottom-Line Benefits" which appears on the website of The Association of Executive Search Consultants, www.aesc.org. The party submitting the letter of protest apparently highlighted the phrase "our Strategic Executive Coaching (SEC) program produces more effective leaders." Applicant has explained that this is a reference to its own program, and that the article was written by one of its officers, and asserts that this shows proper trademark use. We find that the article as a whole shows that "strategic" is merely descriptive of applicant's services, and that when used in combination with "executive coaching," the term STRATEGIC EXECUTIVE COACHING is also merely descriptive. For example, the article contains the following statements:

To be effective, executive coaching must be both strategic and individualized.

Executive coaching that is strategic, that focuses on business needs as well as individual needs, is the key to achieving business results.

Where executive coaching becomes strategic is in the preparation that

precedes the actual coaching process. Before the process begins, the coaches meet with the client's executive leadership to define the strategic context.

Once the strategic context has been mapped out, the actual executive coaching process can begin.

A strategic coaching approach offers a supporting work-context

Given this turbulent world and the challenges and opportunities it presents, the "strategic" in strategic executive coaching will become even more important than it is today.

The next excerpt, taken from the website www.coachingnetwork.org.uk, is an article consisting of 17 pages which are described as the first chapter of the book "Coaching for Leadership." Applicant has stated that this book was written by an officer of applicant and, while applicant acknowledges that the article depicts two of the three words of its mark in lower case, it ascribes this to the author's inattention or a printer's error.

The reference, shown in the context of the entire paragraph, appears below:

For the coach, strategy need not reside in quarterly profit targets alone. Those committed to strategic coaching will expand the meaning of strategy to at once embrace individual, team, and corporate actors. Strategic executive coaching is an inclusive practical approach, incorporating the idea of a

dashboard or balanced scorecard, and is well-adapted to a complex world in which even the ground rules are in a state of change.

One reading the words "strategic executive coaching" in this article will not view it as a trademark. There are no other trademark uses of STRATEGIC EXECUTIVE COACHING in the article, nor are there any references to applicant and its services, such that this usage would be seen as a printer's error or the author's inattention. In fact, the capitalization of the single word "Strategic" in the phrase will be seen as only the normal capitalization of any word that begins a sentence. Moreover, in the context of the overall article, the word "strategic" describes a characteristic of executive coaching services:

When the whole organization is engaged, coaching becomes strategic.

However, whenever coaching succeeds in aligning the needs of the business with the development needs of its people, it cannot help but be strategic in nature.

...a drive to expand into global markets are also examples of situations demanding a strategic coaching response.

For the person being coached, the experience is invariably strategic.

To the extent that coaching sensitizes people to reflect and act in a more purposeful way, it is again strategic in nature....

...coaching is strategy in motion.

The next exhibit is material from Cambria Consulting. It appears to be a piece of advertising material, but an additional page shows a website address of www.cambriaconsulting.com. The title is "Executive Coaching—A Strategic Approach. One paragraph includes the phrase "strategic executive coaching," as follows:

With our years of experience in building executive coaching programs, Cambria Consulting has launched a new practice area—**Strategic Executive Coaching**—to help our clients achieve the greatest return on their investment in this area.

Applicant characterizes this as trademark use, noting that the term appears in initial capital letters and bold face font.

We agree that the manner in which the term is depicted can be viewed as trademark use. It can also be viewed as simply a way to highlight the company's new practice area. Even if we do not treat this particular phrase as constituting descriptive usage, the rest of the copy in the exhibit, including the title, shows that "strategic" has a descriptive meaning when applied to executive coaching services, such that STRATEGIC EXECUTIVE COACHING must be

deemed a merely descriptive term. See, for example, the following statements:

Our strategic approach focuses on what a group of executives needs to do...to achieve organizational goals....

As part of the plan, we do the following:

Translate business strategy into executive development goals by working with our clients' top executives to set qualitative and quantitative targets....

We point out that there are two pieces of evidence that were submitted with the letter of protest which we do not consider to have probative value. One is what appears to be a flyer for Laszlo & Associates, Inc., and seems to have no relevance to the issue before us. Another is the material from the website www.kevingsaunders.com, which includes the statement, "the flagship service of KGS Technology is strategic executive coaching." Although we disagree with applicant's characterization of the use of the phrase "strategic executive coaching" as trademark use, we agree with applicant that this statement and, indeed, the entire web page, can no longer be found at the web address.

As can be seen from the statements we have quoted herein, and as is amply demonstrated by the evidence of record, strategic coaching is clearly one of the aspects of

executive coaching. Although there is evidence that the entire phrase which forms applicant's mark, STRATEGIC EXECUTIVE COACHING, is used by third parties in a descriptive manner, such evidence is not necessary to support a finding that the mark is merely descriptive. At the very least, the evidence shows that "executive coaching" is a type or aspect of educational services which provide executives with information about business management, and that "strategy" is touted as a feature of executive coaching, such that consumers of applicant's services would immediately understand STRATEGIC BUSINESS COACHING to refer to this characteristic of applicant's business coaching educational services.

We also note that, as used in applicant's specimens, "strategic executive coaching" would be perceived as a descriptive term. Although set apart as a subheading, and depicted in all capital letters, the phrase appears in the same manner as the descriptive phrases "Customer Client Feedback," "Assessment," "Workshops" and "Keynote Speakers."

Applicant has argued that because "strategic" has many definitions that are not descriptive of applicant's services, "consumers will not immediately perceive what the

words of the mark refer to." Brief, p. 9.⁴ Applicant also contends that "A consumer who knows nothing of Applicant's services will not know from the mark STRATEGIC EXECUTIVE COACHING that they are educational services, namely, conducting individual counseling sessions, seminars and workshops which provide executives with information about business management." Brief, p. 13. Both these statements fail to recognize the well-established principle, stated earlier in this opinion, that the question of descriptiveness is not to be determined in the abstract, but in relation to the identified goods or services. Thus, it is irrelevant whether a consumer can guess from the mark what the goods or services are. The question is whether a consumer who sees the mark in connection with the offering or rendering of the services will understand that strategic coaching is a feature of applicant's educational services for executives.

Applicant has also pointed to several third-party registrations for marks which include the word "strategic,"

⁴ The Examining Attorney has submitted a printout from The American Heritage Dictionary of the English Language, 3d ed. © 1992 which provides the following definitions: 1. Of or relating to strategy 2.a. Important or essential in relation to a plan of action: *a strategic withdrawal*. b. Essential to the effective conduct of war: *strategic materials*. C. Highly important to an intended objective: *The committee discussed strategic marketing factors*. 3. Intended to destroy the military potential of an enemy: *strategic bombing*.

and which were registered without a disclaimer of this term. Applicant argues that the Office should, in accordance with past practice, allow the registration of applicant's mark, which also consists of the word STRATEGIC followed by a descriptive term.

Although consistency in Office practice is certainly a goal, we do not believe that registration of other STRATEGIC marks demonstrates a policy that such marks should be registered. Each application must be considered on its own merits. As the Court of Appeals for the Federal Circuit stated in *In re Nett Designs Inc.*, 236 F.2d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001):

Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board.

Here, the record amply supports a finding that STRATEGIC EXECUTIVE COACHING is a merely descriptive mark.

Decision: The refusal of registration is affirmed.⁵

⁵ As previously noted, should applicant ultimately prevail in this appeal, the file will be transmitted to the Examining Attorney in order to examine the Statement of Use.