

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 11/23/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nucleus Research Incorporated

Serial No. 76428914

Robert P. Smith of Kirkpatrick & Lockhart for applicant.

Steven Foster, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Nucleus Research
Incorporated to register the mark THE ROI EXPERTS for
"consumer research of goods and services; and providing
product and service reviews relating to computers, computer
software, online services, high technology communications,
information technology and information services."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground

¹ Application Serial No. 76428914, filed July 8, 2002, alleging
first use anywhere and first use in commerce on August 30, 2000.

that applicant's mark, when applied to applicant's goods, is merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney maintains that "ROI" is an acronym for "return on investment," and that the mark is laudatorily descriptive of applicant's self-proclaimed expert services pertaining to return-on-investment information, analysis or advice. In support of the refusal, the examining attorney introduced dictionary definitions of "expert," "ROI" and "return on investment," as well as excerpts from applicant's web page. The examining attorney also relied upon applicant's specimens.

Applicant claims that the mark does not directly provide any information about applicant's services that are not return-on-investment studies, but rather are product and service reviews that help companies evaluate technology investment. Applicant contends that the term "return-on-investment" analysis describes a technology investment analysis that differs from applicant's product and service reviews. According to applicant, although "ROI" may be descriptive of an activity that follows the rendering of

the identified research and review services, "ROI" is not descriptive of the identified services.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in

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different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). As the Board has explained:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *See, e.g., In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; *In re*

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Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

The abbreviation "ROI" stands for "return on investment" which in turn is defined as follows:

A calculation that considers the projected economic benefits of an investment as a percentage of the investment cost; for example, if a company invests \$10,000 in a new computer system and can document \$20,000 in future savings due to the installation of the system, the return on investment is 100 percent.

Webster's New World Dictionary of Computer Terms (8th ed. 2000). The term "expert" means "a person with a high degree of skill in or knowledge of a certain subject." *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

Applicant's promotional information contains repeated references to "ROI" as a feature or purpose of applicant's services. A review of applicant's substitute specimen shows that applicant describes itself as an "industry research firm providing ROI-focused research and advisory services to help companies quantify and maximize the value

of their technology investment." A review of applicant's web site shows that it touts that "5 of the top 10 technology vendors refer their customers to [applicant] for unbiased ROI advice," and that applicant provides "expertise" and "ROI analysis you can trust" by "help[ing] CFOs, CIOs, and technology decision makers make the right decisions by accurately measuring the benefits and cost of planned and ongoing IT investments." The web page also states: "We deliver 100% impartial return-on-investment (ROI) information to organizations worldwide," and that applicant provides "CFOs and CIOs with the financial and technology information they need to accurately assess ROI and manage their technology investments to maximize value." Applicant claims on its web site that "our analysts have conducted thousands of ROI studies for clients."

Based on the record before us, we find that the mark sought to be registered is laudatorily descriptive. It is clear that applicant's consumer research services and product and service reviews are rendered with an eye toward return-on-investment analysis and advice. Although applicant's specific services identified in the application may not involve ROI calculations, applicant's services are an integral part of applicant's ROI analysis; the fact that a return-on-investment analysis follows applicant's

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research and product review services is of no consequence in our determination of the mere descriptiveness of applicant's mark. Without first rendering consumer research and product review services, applicant would be unable to engage in a valid ROI analysis.

Lastly, it hardly need be stated that the addition of the term "THE" does not change the merely descriptive nature of the mark inasmuch as the term has no trademark significance here. *Conde Nast Publications v. The Redbook Publishing Co.*, 217 USPQ 356 (TTAB 1983).

We conclude that, when used in connection with applicant's consumer research and product review services, the mark THE ROI EXPERTS is laudatorily descriptive, that is, that applicant has expertise in return-on-investment (or ROI) analysis and advisory services, of which consumer research and product and service reviews are an integral part.

Decision: The refusal to register is affirmed.