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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Political Compliance Services, Inc.

Serial No. 76286430

Scott J. Major of Millen, White, Zelano & Branigan, PC for
Political Compliance Services, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Walters, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On July 16, 2001, Political Compliance Services, Inc.
(applicant) filed an application to register the mark
POLITICAL COMPLIANCE SERVICES, INC. on the Principal
Register for "election law compliance service, and related
consultation services" in International Class 42. The
application is based on applicant's claimed date of first
use and first use in commerce on May 18, 2001.

Registration was originally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that POLITICAL COMPLIANCE SERVICES, INC. is merely descriptive of applicant's services. In addition, in the first Office action, the examining attorney stated that applicant "may amend the application to seek registration on the Supplemental Register" which would also require a disclaimer of the wording "SERVICES, INC." Office Action p. 2 (November 21, 2001). Applicant initially responded that its mark is not merely descriptive and provided a disclaimer of the wording "SERVICES, INC." Upon receipt of the final Office action based on the Section 2(e)(1) refusal, applicant amended the application to seek registration on the Supplemental Register. Thereafter, the application was reassigned to a different examining attorney who issued a new refusal under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis that applicant's alleged mark is incapable of identifying applicant's services because it is the generic term for the recited services.

When the refusals were made final, applicant appealed to the Board and requested reconsideration. After the examining attorney denied the request for reconsideration,

the Board resumed the appeal. Briefs have been filed, but oral hearing was not requested.

As a preliminary matter, the examining attorney contends that applicant has not preserved its argument that the alleged mark is not merely descriptive. In view of applicant's statements in its request to amend to the Supplemental Register and its request for reconsideration, we find that the question of descriptiveness has been preserved for appeal. Accordingly, we must determine whether the mark is generic and, if not, whether it is merely descriptive.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See 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). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB

1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" Ginn, *supra*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

We find that the genus of services at issue in this case is adequately defined by applicant's recitation of services, namely, election law compliance service and related consultation services. Applicant's specimen of use and advertising provide further clarification that the services involve accounting services specializing in FEC (Federal Election Commission) regulations. In addition, applicant states that it provides advice "on matters relating to compliance with federal, state and local election laws." Applicant's Response p. 1 (May 21, 2002).

Turning to the second inquiry, the public's understanding of the term, the relevant public as shown in the specimen of use and by applicant's statements in its

May 21, 2002 response, includes non-connected PACs, party committees, candidate committees, political campaign managers and candidates.

In support of her position that the relevant public understands applicant's mark to primarily refer to election law compliance services, the examining attorney submitted excerpts of newspaper and trade journal articles retrieved from the Nexis database wherein the phrase "political compliance" is used in a variety of contexts. The following are the most relevant examples, "'We don't know how the blank pages were attached to it or why they were attached to it,' said Marjo Keller, interim political compliance manager in the city clerk's office..." The San Francisco Chronicle p. A17 (February 17, 2001); "O'Conner will be responsible for all political compliance with state, local and federal election laws associated..." The Hollywood Reporter (May 13, 1993); and "FSA to pay fine in campaign case: assessed almost \$5 million for illegal political donations. ...The unfortunate incident does not affect FSA operations, Vance adds 'A political compliance program will be put in place to make sure the rules of the game are very clear, and there are referees in place to deal with any questions.'" The Voice of Foodservices

Distribution p. 21 (May, 1998).¹ In addition, the examining attorney submitted excerpts from third-party websites where the phrase "political compliance" appeared. See, e.g., "Finally, in an era in which issues of 'political compliance' - that is - compliance [sic] the myriad laws and regulations that control lobbying and political activities - provide daily headlines, clients derive significant security and value by having a law firm handle matters and policy." www.akingump.com p. 2; "Lawyers in the group also regularly counsel firm clients on a wide array of political law issues, including federal and state election law and campaign finance, lobbying disclosure and corporate and political compliance." www.sonnenschein.com. P. 2; and iowa.sierraclub.org p. 1 wherein one of the listed committee chairs is the "Political Compliance Chair." Finally, the examining attorney submitted the following dictionary definitions:

¹ The majority of the excerpts are not relevant to the case before us because the phrase is used in contexts different from the relevant genus of services. See, e.g., "...this excruciating economic pain did not result in political compliance by Saddam Hussein." *America* p. 18 (November 25, 2000); and "...Washington's growing frustration with North Korea - whose abrupt and unprecedented [sic] withdrawal from the Treaty on the Non-Proliferation of Nuclear Weapons in March set off international shock waves - but also the increasing reliance on economic sanctions to push for political compliance." *The Oil Daily* p. 2 (December 21, 1993).

Political: 2 "Relating to, involving or characteristic of politics, parties, or politicians"; and

Compliance: 1(a) "The act of complying with a wish, request, or demand, acquiescence."

The American Heritage Dictionary of the English Language (3d ed. 1992).

Significantly, there are no examples in the record of use of the phrase "POLITICAL COMPLIANCE SERVICES, INC." for which registration is sought.

As noted above, the evidentiary burden of establishing genericness of a term or a whole phrase rests with the Office and the showing must be based on clear evidence. Merrill Lynch, *supra*, 4 USPQ2d at 1143. Moreover, to prove that a mark is generic, the Office may not simply cite definitions and generic uses of the constituent terms of a mark, but must consider the meaning of the disputed phrase as a whole. In re Dial-A-Mattress Operating Corporation, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); In re the American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

The record before us does not contain a single example of use of "POLITICAL COMPLIANCE SERVICES, INC." (other than applicant's service mark use). In addition, even taking the constituent parts separately, both the number and

nature of the uses of "political compliance" in the record are not sufficient to establish by clear evidence that "political compliance" is currently generic for the identified services.

Therefore, we find that the examining attorney has not established a prima facie showing that the phrase "POLITICAL COMPLIANCE SERVICES, INC." is generic for applicant's recited services.

We next address whether the phrase "POLITICAL COMPLIANCE SERVICES, INC." is merely descriptive of applicant's recited services.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems

Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Although the evidence submitted by the examining attorney does not establish that the phrase "POLITICAL COMPLIANCE SERVICES, INC." is generic, it does establish that the phrase is merely descriptive of a significant feature of applicant's services, specifically that its services involve consultation regarding compliance with regulation in the political field, specifically election laws.

First, applicant concedes that the phrase "SERVICES, INC." is "non-distinctive." Request for Reconsideration p.

1. Second, there is sufficient evidence of the phrase "political compliance" used in connection with election law compliance programs and services to establish that the phrase is merely descriptive thereof. As shown above, some of the excerpts from newspaper articles and third-party websites show use of the term "political compliance" to describe services in the field of election law. See, e.g., "O'Conner will be responsible for all political compliance with state, local and federal election laws associated..." The Hollywood Reporter, *supra*; and "Lawyers in the group also regularly counsel firm clients on a wide array of political law issues, including federal and state election law and campaign finance, lobbying disclosure and corporate and political compliance." www.sonnenschein.com, *supra*. In addition, applicant's specimens of use corroborate the descriptive nature of the alleged mark. In its brochure, applicant states that it is "experienced in all facets of federal state and local compliance requirements [and it's] analysts are career experts in campaign and PAC accounting, finance, administration and compliance." These services are clearly in the political field. Finally, the combination of the descriptive phrase "POLITICAL COMPLIANCE" with the non-distinctive phrase "SERVICES, INC." does not create a new and unique commercial

impression. In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

Therefore, we are find that the phrase "POLITICAL COMPLIANCE SERVICES, INC.," when used in connection with applicant's election law compliance service, and related consultation services, would immediately inform the potential users of those services that the services involve, in applicant's words, "matters relating to compliance with federal, state and local election laws." Response p. 1 (May 21, 2002). Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective users of applicant's services to perceive readily the merely descriptive significance of the phrase "POLITICAL COMPLIANCE SERVICES, INC." as it pertains to applicant's services.

Decision: The refusal to register on the Principal Register based on mere descriptiveness under Section 2(e)(1) is affirmed. The refusal to register on the Supplemental Register based on genericness under Section 23 is reversed and registration will issue on the Supplemental Register in due course.