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Hearing: December 1, 2004

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Bank Mutual Corporation**

Serial No. 78155909

Robert L. Titley of Quarles & Brady LLP for Bank Mutual Corporation.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Chapman, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Bank Mutual Corporation to register the mark BANKMUTUAL for "banking services; brokerage services in the fields of annuities, insurance and mutual funds" in International Class 36.¹

The trademark examining attorney refused registration on the ground that the mark is merely descriptive of the services under Section 2(e)(1) of the Trademark Act.

¹ Application Serial No. 78155909, filed August 20, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.² An oral hearing was held.³

The examining attorney contends that each word in BANKMUTUAL is descriptive of applicant's services and that the combination does not change the descriptive meaning of the mark as a whole. The examining attorney reasons that applicant is a bank that provides mutual funds, and that "the elimination of the term 'fund' from applicant's mark is insignificant" because applicant's customers would "read into the applicant's mark the word 'fund' and understand that applicant's mark is the descriptive term "bank mutual fund." In support of her position, the examining attorney submitted excerpts of articles obtained from the Nexis database containing references to "mutual banks" and "bank mutual funds." The examining attorney also made of record a definition of "bank" that includes "mutual bank,"⁴ and

² Because applicant filed its appeal brief prior to consideration of its request for reconsideration by the examining attorney, following the examining attorney's denial of the request for reconsideration, the Board allowed applicant time to file a supplemental brief, and applicant did so.

³ The application was assigned to a different examining attorney, Michael Baird, to argue this case at the hearing.

⁴ This definition was obtained from an online dictionary located at <http://dictionary.law.com>.

included with her appeal brief a definition of "mutual" as "mutual fund."⁵

Applicant does not dispute the descriptive meaning of the terms "bank" or "mutual fund" or even "bank mutual fund" in relation to mutual fund services offered by a bank. Applicant contends, however, that "mutual" alone is not the equivalent of, or synonymous with, "mutual fund" and that the word "fund" should not be implied in its mark. Applicant points out that its mark is not "bankmutualfunds" and contends that it would not be perceived that way. Applicant has attached to its reply brief relevant pages from *Webster's Third New International Dictionary* and *The Random House Dictionary of the English Language* to show that unlike the reference supplied by the examining attorney, the term "mutual" is defined in these dictionaries without reference to "mutual fund" and that instead, "mutual fund" is defined only as a separate entry.⁶

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the

⁵ *The American Heritage Dictionary of the English Language* (4th ed. 2000) from www.bartleby.com. The Board may properly take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁶ Applicant has not provided a copyright or publication date for these dictionaries. We nonetheless consider them of record.

goods or services with which it is used or intended to be used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Moreover, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought. See In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

Applicant's services are identified as banking services and brokerage services in the field of, inter alia, mutual funds, which would include bank mutual funds. We find that BANKMUTUAL describes a significant aspect of those services. The term immediately, and without conjecture, informs banking customers that applicant's bank features mutual fund products, including bank mutual funds.

Applicant acknowledges (Reply Brief, p. 2), and the Nexis excerpts submitted by the examining attorney show, that the term "bank mutual fund" has a readily understood meaning in relation to banking services. Some examples of these excerpts are reproduced below (emphasis added):

The latest and certainly not the last study about **bank mutual funds** has shown that most bank customers know that the Federal Deposit Insurance Corp. doesn't stand behind mutual funds sold through banks. *The Banking Attorney* (December 19, 1994).

The community bank, which has made a strong move into Monroe County in the last eight years helped introduce the upstate area to concepts such as the ATM, buying insurance from the

bank, check imaging and in-house **bank mutual funds**. They all were part of President George Hamlin IV's desire to be his customers' "primary care physician for financial affairs." *Rochester Democrat and Chronicle* (December 7, 2003).

Bank mutual fund operations, one of the industry's most promising new businesses, are suddenly caught in a regulatory drumfire. ... The big worry is that the **bank mutual fund** boom could go bust if stock and bond markets drop, hurting both consumers and banks. *The American Banker* (June 25, 1993).

In a dismal time for equity markets, **bank mutual funds** performed roughly in line with the rest of the fund industry last year - they were clobbered about as badly. *The American Banker* (January 8, 2003).

Last year, **bank mutual fund** sales fell to \$32 billion, their lowest level since 1995 and 31% below the high water mark of \$46.3 billion posted in 1998. *National Underwriter* (December 16, 2002).

Although the mark BANKMUTUAL does not include the word "fund," in the context of the mark as a whole, and when the mark is viewed in connection with brokerage services in the field of mutual funds, including bank mutual funds, the word "fund" would be understood. The definition of "mutual" as "mutual fund" obtained by the examining attorney from a 2004 edition of a standard dictionary is evidence that the word "mutual" itself (i.e., without the word "fund"), would be perceived in the context of this brokerage service as referring to a "mutual fund."⁷ No imagination would be required by a banking customer

⁷ As for the dictionaries relied on by applicant that do not include a definition of "mutual" as "mutual fund," without any copyright or

to understand the significance of "mutual" in relation to the mutual fund product offered by applicant's bank or to make the transition from "bank mutual" to "bank mutual fund." See, e.g., *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215 (Fed. Cir. 1978) (GASBADGE is merely descriptive of a badge which detects gaseous pollutants even though the common compound word would be "gas monitoring badge").

In addition, the term BANKMUTUAL is also merely descriptive of a type of bank known as a "mutual bank."⁸

The definition of "bank" submitted by the examining attorney includes a description of a "mutual bank" as follows: "...Most banks are so-called 'commercial' banks with broad powers. In the east and midwest there are some 'savings' banks which are basically mutual banks owned by the depositors, concentrate on savings accounts, and place their funds in such safe investments as government bonds." The following Nexis excerpts similarly demonstrate the meaning of "mutual bank" as a recognized type of bank (emphasis added):

publication date for those dictionaries, we cannot presume that they reflect the public's current perception of the term.

⁸ Applicant notes that the examining attorney did not specifically rely on this rationale as a basis for refusing registration under Section 2(e)(1). While the Board's determination is limited to the stated statutory ground for refusal, the Board need not limit its determination to the reasons for the refusal set forth by the examining attorney. See *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985).

Throughout the transition from credit union to **mutual bank** to commercial bank, Moltzan and his growing staff worked diligently to get their name out. *The Daily Record* (Baltimore, MD) (March 15, 2003).

But Hancock County Savings President and Chief Executive Officer Harry A. Comm is quick to point out that Hancock County Savings, as a **mutual bank**, is as much a product of its community as its community is a product of it. *The State Journal* (February 28, 2003).

The retreat was organized to discuss what had to be done to keep the bank healthy and the staff's morale high. Many of the ideas we discussed would be applicable to other community **banks**, whether **mutual**-or stockholder-owned. *The American Banker* (October 30, 2002).

BFC began negotiations to make the acquisition in early 1986, contemplating a voluntary supervisory conversion in which Southeast would convert from a **mutual bank** to a stock federal savings bank and become a BFC subsidiary. *Mergers & Acquisitions Litigation Reporter* (February 2003).

"The image-what he wanted to make the bank become-is that people will be banking with us because it's the right thing to do. ... We're creating this image and this presence: we're a **mutual bank**; we can't be bought out; we're locally controlled." *Vermont Business Magazine* (January 1, 2003).

Applicant admits that a "mutual bank" refers to a type of bank (brief, p. 4) and acknowledges that "had applicant's mark been MUTUALBANK" applicant would concede that its mark is descriptive. (Id.) It is applicant's position, however, that the reversal of the terms from their normal order creates an incongruity or arbitrariness that makes the mark as a whole registrable. In this regard, applicant points to *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 119 USPQ 61 (2d Cir. 1958), wherein the court upheld the USPTO's

finding that SEASON-ALL, the reverse of the descriptive term "all season," created a quality of arbitrariness as used on storm doors and windows sufficient to justify registration.

The mere transposition of words does not automatically turn a common descriptive term or designation into a registrable mark. See *In re Dairimetics, Ltd.*, 169 USPQ 572 (TTAB 1971) and *In re Vasco Metals Corp.*, 154 USPQ 191 (TTAB 1967). The resulting term may be registrable if it creates a different meaning or commercial impression. However, unlike the transposition of "all season" to "season-all," reversing the order of the words in "mutual bank" does not result in a new term with a different meaning as used in connection with banking services. Although not the typical or conventional way of referring to a mutual bank, the transposed term "BANKMUTUAL" for banking services still signifies a mutual bank.

Applicant argues that registration of BANKMUTUAL "will not render it difficult for others to describe their bank as a 'mutual bank' nor deprive banks and others from promoting mutual funds." (Brief, p. 5.) While a competitive need to use a term is strong evidence that the mark is merely descriptive, it is not a prerequisite for finding that a term is merely descriptive. The fact that applicant may be the only entity using the term "BANKMUTUAL" does not justify registration where, as here, the term unquestionably conveys a merely descriptive meaning and

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would be perceived as such by the relevant public. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.