

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
6/14/06

Mailed: 9/21/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arbitration Forums, Inc.

Serial No. 76583624

Stefan V. Stein of Holland & Knight for Arbitration Forums,
Inc.

Brendan Regan, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Quinn, Hairston and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Arbitration Forums, Inc.
to register the mark E-SUBRO HUB for goods and services
ultimately identified as "communication hubs, namely
electronic data exchange system to facilitate sending and
receiving electronic subrogation demands between insurance
and or self-insured companies" (in International Class 9);
"facilitating the exchange of needed information for
financial compensation via the Internet, namely electronic

Ser No. 76583624

data exchange system to facilitate sending and receiving electronic subrogation demands between insurance and or self-insured companies" (in International Class 35); and "electronic exchange of data stored in databases accessible via telecommunication networks, namely electronic subrogation demands between insurance and or self-insured companies" (in International Class 38).¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(e)(1), on the ground that applicant's mark, when used in connection with applicant's goods and services, would be merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was held at which applicant's counsel and the examining attorney appeared.

Applicant concedes that "[t]he prefix 'e' is recognized as a prefix for 'electronic' and is [sic] denotes electronic commerce or 'e-commerce' conducted through websites." In addition, applicant states that "[i]n the insurance industries, the word 'subrogation' is

¹ Application Serial No. 76583624, filed March 29, 2004, based on an allegation of a bona fide intention to use the mark in commerce.

often shortened to simply 'subro.'" (Appeal Brief, p. 5). Applicant goes on to state, however, that websites for conducting e-commerce are not known as "hubs." Applicant further states:

[T]he mark E-SUBRO HUB may suggest or hint at the nature of Applicant's goods or services, and may suggest that they somehow employ a communication hub, but it does not in any clear or precise way, serve to describe them.

A consumer encountering the mark might, at most, guess by virtue of the component "E-SUBRO" of the mark that Applicant offers goods or provides some services associated with subrogation and that they would be done in connection with e-commerce. The addition of the word "HUB" to the mark makes the composite mark significantly more suggestive since the consumer would merely be guessing "hub" could potentially be referring to. (Appeal Brief, p. 14).

Applicant also points to the inconsistency between the examining attorney's position herein and the one taken by a different examining attorney handling applicant's other two applications to register E-SUBRO HUB logo marks.² In those applications, there was no finding that the E-SUBRO HUB portion of the logo marks is merely descriptive requiring a disclaimer. In support of its arguments, applicant submitted excerpts of pages from its website.

² Application Serial Nos. 76633981 and 76633987.

The examining attorney maintains that the mark as a whole is merely descriptive of "a hub that concerns electronic subrogation; that is an electronic subrogation hub." (Appeal Brief, unnumbered p. 8). The examining attorney points to the use of the term "hub" in the Class 9 identification of goods, and that the recitations of services in Classes 35 and 38 employ the definition of "hub" (i.e., "an electronic data exchange system") used by applicant in its Class 9 identification. In support of the refusal, the examining attorney relied upon a dictionary definition of the word "hub," portions of applicant's website, a list of "hits" for "subro" using Google's search engine, and truncated excerpts of articles in printed publications wherein the term "subro" is used as a shortened form of "subrogate" or "subrogation."

A term is 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

Ser No. 76583624

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 different contexts is not controlling. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....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.

Ser No. 76583624

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

Applicant, on its website, described its goods and services as follows:

E-Subro Hub has been developed to help insurance carriers increase recovery, lower file handling and settlement expenses, reduce loss costs, shorten cycle times and improve customer service.

With E-Subro Hub, carriers can electronically send and receive subrogation demands, attach supporting documents, route demands to file handlers, negotiate and much more.

In a press release on the website, applicant described its services in the following manner:

The web-based subrogation technology will enable users to send and receive subrogation demands electronically, attach supporting documents (estimates, bills, photos, police reports, etc.) automatically route demands to file handlers, negotiate online and view and download online reports. The system will provide a flexible electronic link regardless of the platform operated by the user.

The prefix "E-" conveys the recognized meaning of "electronic." See In re Styleclick.com Inc., 57 USPQ2d 1445, 1448 (TTAB 2000). As noted earlier, applicant acknowledges that "[t]he prefix 'e' is recognized as a prefix for 'electronic' and is [sic] often denotes

electronic commerce or 'e-commerce' conducted through websites."

The record includes numerous examples from applicant's website, as well as excerpts from printed publications, showing that "subro" is a commonly used and recognized shortened form of the term "subrogation." Indeed, applicant acknowledges that "[i]n the insurance industries, the word 'subrogation' is often shortened to simply 'subro.'"

In view of the above, there is no doubt that "E-SUBRO" means "electronic subrogation," and that relevant purchasers in the insurance industry would understand it as such. Thus, the term "E-SUBRO" is merely descriptive for the type of goods and services produced by applicant.

Accordingly, the merits of this appeal rest, in large part, on the meaning of "HUB" in applicant's mark. The only evidence of record bearing on the meaning of "hub" is a dictionary definition submitted by the examining attorney. The term "hub" is defined as follows: "the central part of a car wheel (or fan or propeller etc.) through which the shaft or axle passes; a center of activity or interest or commerce or transportation; a focal point around which events revolve; "the playground is the hub of parental supervision"; "the airport is the economic

hub of the area." Webster's Revised Unabridged Dictionary (1998). We further take judicial notice of the meaning of "hub" as set forth in a computer dictionary: "a central connecting device in a network that joins communications lines together in a star configuration." The Computer Glossary (7th ed. 1995).

With respect to the goods listed in applicant's Class 9 identification, we note, of course, applicant's use of the terminology "communication hubs." Further, in response to the examining attorney's inquiry as to whether applicant's services included an "electronic hub," applicant answered "no." Applicant went on, however, to state the following: "Applicant's services include a communication hub to facilitate sending and receiving electronic subrogation demands between insurance and/or self-insured companies. The term 'hub' does not have any significance in applicant's industry or as applied to Applicant's goods or services." (Response, November 21, 2005).

Given the use of the specific term "hub" in the Class 9 identification of goods, we are hard pressed to not find the term merely descriptive for goods identified as "communication hubs." Based on the use of the term in the identification of goods, and the meaning of "hub" in the

context of computer hardware, we find that the term is merely descriptive of the "communication hubs" listed in the identification.

We have little sympathy for applicant's statement that the examining attorney suggested the identification of goods, and that the term "hub" would not otherwise have been used.³ The simple fact remains that applicant was not forced to accept the proposed terminology, but rather applicant could have declined the examining attorney's suggestion. After accepting the suggested terminology, applicant has little basis upon which to blame the examining attorney for its predicament.

Accordingly, we find that the applied-for mark, E-SUBRO HUB, is, in its entirety, merely descriptive for the goods identified in Class 9.

With respect to the services listed in Classes 35 and 38, we find that the term "hub" is only suggestive when used in connection with the identified services. The term suggests that applicant's services provide a center of

³ After our review of the excerpts of applicant's website, as well as hearing the responses of counsel to the Board's inquiries at the oral hearing, we have doubts about whether applicant's intended use of the mark will encompass sales of "communication hubs," as goods in trade, rather than merely use of such goods in rendering its services. In any event, the involved application is based on an intention to use, and no amendment to allege use was filed; thus, there are no specimens of use showing the mark as used on a product.

activity around which electronic subrogation revolves. In this sense, the term is not merely descriptive, but rather only suggestive. Thus, while "E-SUBRO" is merely descriptive for applicant's services, the term "HUB" is not. Accordingly, the mark as a whole is not merely descriptive; however, in order to be registrable, the term "E-SUBRO" must be disclaimed apart from the mark.

In reaching this result, we acknowledge that it is somewhat inconsistent with the USPTO's approach taken in applicant's co-pending applications. Although uniform treatment under the statute is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark sought to be registered is merely descriptive. Moreover, the Board is not bound by the prior actions of either of the examining attorneys examining applicant's applications.

Decision: The refusal to register in all classes is affirmed. However, with respect to Classes 35 and 38, this decision will be set aside if applicant, within thirty days of the date hereof, files a disclaimer of "E-SUBRO" apart from the mark.