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Mailed:
July 24, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John M. Floyd & Associates, Inc.

Serial No.78245750

Marcee G. Lundeen and Daniel N. Lundeen of Lundeen & Dickinson, LLP for John M. Floyd & Associates, Inc.

Toni Y. Hickey, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

John M. Floyd & Associates, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register PRIVILEGE MANAGER CRM as a trademark for "computer software for use in providing management reports, custom reports and account holder communications for financial institutions in connection with their overdraft privilege programs and the supervision of overdrawn accounts and the

customer relations.”¹ Applicant has disclaimed exclusive rights to use CRM apart from the mark as shown.²

Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant’s mark is merely descriptive of its identified services.

The appeal has been fully briefed. Applicant did not request an oral hearing.

Applicant has explained the nature of its software:

...appellant’s software product and consulting services are marketed to banks and other financial institutions for monitoring overdrawn accounts to which the bank has granted overdraft benefits. With overdraft benefits, instead of returning a customer’s check or other “non-sufficient funds” (NSF) item, the bank pays it and charges the customer a fee for the overdraft. Banks typically have overdraft benefit software which determines whether to pay the overdrawn item or to return it NSF, according to the bank’s guidelines. Appellant’s PRIVILEGE MANAGER CRM software is designed to work with a bank’s existing overdraft benefit program software. PRIVILEGE MANAGER CRM can generate or schedule

¹ Application Serial No. 78245750, filed May 5, 2003, based on Section 1(b) of the Trademark Act (intent-to-use). Applicant subsequently submitted an Amendment to Allege Use, asserting first use and first use in commerce on May 1, 2004.

² The Examining Attorney made of record a definition from Webopedia for CRM: “Short for customer relationship management. CRM entails all aspects of interaction a company has with its customer, whether it be sales or service related...”
www.pcwebopaedia.com.

telephone calls, emails, letters or other communications to the overdrawn account holder informing them of the overdraft until the overdraft is covered by a deposit, keep a historical record of the account status and communications, if necessary, close the account and turn it over for collections, and provide reports to bank personnel about the status of the accounts and the overdraft program as a whole."

It is the Examining Attorney's position that applicant's mark is merely descriptive of the identified goods. Through most of the examination of the application, the Examining Attorney pointed to examples of third-party uses of the term "privilege manager" and asserted that "applicant's software program functions in a manner consistent with other PRIVILEGE MANAGER programs, namely, it monitors and administers NSF account privileges." Office action mailed January 25, 2005. The evidence regarding third-party uses, however, indicates that "privilege" relates to allowing or controlling access to networks. See, for example, the following:

PASSGO

UNIX Privilege Manager-UPM

Key Features:

- Controls access to account privileges with the first out-of-the box solution
- Allows delegation of any UNIX user's authority, so that you can implement reasonable security controls, without impacting the ability of users to perform their daily work

- UNIX-Privilege Manager allows you to control access for any user on your UNIX network

www.passgo.com

Privilege Manager is used to Grant or Revoke privileges on an Object (like Admin, Nodes) for a User/Group.

www.elegant-software.com

Securing JAVA

How to Sign Java Code

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The Capabilities library provides a class called the Privilege Manager that handles requests from the program to turn on and off privileges. When the first request to enable a certain privilege is made, the Privilege Manager prompts the browser's user, showing the certificate used to sign the code requesting the privilege, and asking whether the privilege should be granted. See Figure C.1. If the user agrees to grant the privilege the privilege is granted for the lifetime of the applet.

www.securingjava.com

We agree with applicant that these references to "privilege manager" have no applicability to applicant's identified software or, more specifically, that the relevant class of consumers will not regard the word "privilege," used in connection with such software, as referring to database access. Rather, they will view "privilege" as referring to the overdraft privilege programs with which the software is used. The question of whether a term is descriptive is determined in relation to

the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services in the marketplace. See *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

Although in her brief the Examining Attorney still maintains that the third-party evidence is probative, claiming that "the differing fields of use only substantiate the fact that 'privilege manager' software programs operate and function in a consistent manner despite the field of use," she primarily relies on dictionary definitions for "privilege" and "manager" to demonstrate that PRIVILEGE MANAGER CRM is merely descriptive.³ "Together, the terms, 'privilege manager' describe the function of Applicant's goods, namely, software that controls or manages information related to the special advantages or privileges provided by Applicant for the benefit of the customer." Brief, p. 4.

Applicant's identification of goods shows that its software is used to provide management reports in

³ As noted above, applicant submitted a disclaimer of CRM in response to the descriptiveness refusal, thus acknowledging the descriptiveness of this term.

connection with overdraft privilege programs. While the words PRIVILEGE MANAGER thus have some relationship to applicant's software, we find that the term does not directly impart information about the goods with the requisite degree of specificity. A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). In this case, however, the words PRIVILEGE MANAGER are inadequate to convey such knowledge of the goods; more words are needed for a consumer to ascertain what the software is designed to do. Because imagination, thought, or perception is required to reach a conclusion on the nature of the goods, the mark PRIVILEGE MANAGER CRM is suggestive and therefore registrable.

Finally, to the extent that there is any doubt on the question of whether applicant's mark is merely descriptive, it is well established that such doubt must be resolved in applicant's favor. In re The Gracious Lady Service, Inc., 175 USPQ380 (TTAB 1972).

Decision: The refusal of registration is reversed.