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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Financial Media Holdings Group, Inc.

Serial No. 78317876

Julia Spoor Gard of Barnes & Thornburg LLP for Financial
Media Holdings Group, Inc.

Alex S. Keam, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Sams, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark COMPLIANCE WEEK (in standard character form)
for goods identified in the application, as amended, as
"print publication, namely, magazines and newsletters
concerning regulations promulgated by federal and state

governments and by independent regulatory agencies.”¹

Applicant has disclaimed the exclusive right to use WEEK apart from the mark as shown.²

At issue in this appeal is the Trademark Examining Attorney’s final refusal to register the mark on the ground that it is merely descriptive of the identified goods.

Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The appeal is fully briefed, but no oral hearing was requested. We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section

¹ Serial No. 78317876, filed October 23, 2003. The application is based on intent-to-use, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² As part of its October 26, 2004 response to the mere descriptiveness refusal contained in the Trademark Examining Attorney’s first Office action, applicant submitted a voluntary disclaimer of WEEK (i.e., voluntary because the Trademark Examining Attorney had not required submission of a disclaimer). The disclaimer was entered into the application record. In the April 26, 2005 final Office action, the Trademark Examining Attorney noted as follows: “The applicant argues that the mark is not merely descriptive and has merely entered a disclaimer of WEEK. The disclaimer is not accepted and the merely [sic - mere] descriptiveness refusal is maintained.” Contrary to applicant’s contentions in its main appeal brief and its reply brief, we do not deem this statement by the Trademark Examining Attorney to be an effective rejection of the disclaimer per se; such a rejection of a voluntary disclaimer would be improper. See *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm’r Pats. 1991); TMEP §1213.01(c). Instead, we read the Trademark Examining Attorney’s statement, in context, as a refusal to accept the disclaimer as a sufficient basis for withdrawal of the mere descriptiveness refusal. We thus have given effect to applicant’s voluntary disclaimer of WEEK.

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. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *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 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. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that

"[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

Finally, it is settled that a term which merely describes the subject matter of a publication is merely descriptive of the publication, for purposes of Section 2(e)(1). See, e.g., *In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993)(MEDICINE merely descriptive of journal); *In re Women's Publishing Co., Inc.*, 23 USPQ2d 1876 (TTAB 1992)(DECORATING DIGEST merely descriptive of magazine).

We find that the word COMPLIANCE is merely descriptive of the subject matter of applicant's publications. The evidence of record (attached to the final Office action) establishes that COMPLIANCE is a term of art in the legal field and in many fields where laws and regulations govern conduct.

For example, the printout from applicant's own web site includes numerous examples of descriptive use of the word "compliance." The "Free Features" menu of topics includes "**Compliance** Firms" among the listed topics. (Emphasis added.)³ The heading of the page is "**Compliance** Solutions and Providers", followed by this text (emphasis added):

The companies listed below market solutions that facilitate **compliance** with the latest regulatory and legislative requirements. Inclusion in this list should not be construed to be an endorsement of these companies, products or services, nor does inclusion validate or ensure the companies' **compliance** claims. Research providers carefully, and work closely with your internal IT executives. As usual, subscribers can also call us at any time at (888) 519-9200 for assistance.

Among the "Solution Types" listed beneath this introduction are "**Compliant** Record- and Document-Management," and "Ethics, **Compliance** Training Services." The "Brief Descriptions" of various of the listed "Solution Types" include the following descriptions:

These companies facilitate **compliance** with records-retention requirements of Sarbanes-Oxley and Rule 17a-4, including storage of email, IM and other records.

³ In all of the evidentiary excerpts quoted below, the emphasis on the word "compliance" or variations thereof is added.

These companies facilitate **compliance** with the requirements of Reg. FD and new rules requiring Web access to company filings and related disclosures.

These companies facilitate **compliance** with exchange regulations on codes of conduct, as well as **compliance** program specs as defined by the U.S. Sentencing Commission.

These companies facilitate adherence to GAAP and/or **compliance** with new financial reporting requirements, including accelerated filing deadlines for periodic reports.

These companies provide fraud examinations, corporate **compliance** monitoring, forensic auditing, security audits, vulnerability analyses and other security evaluations.

These companies analyze **compliance** with regulations and standards (e.g. disclosure practices, executive pay, shareholder rights, etc.) to rank governance practices.

These companies help manage **compliance** and litigation risks through proactive discovery, assessment, notification and response systems.

These companies facilitate **compliance** with SOX "whistleblower" provisions requiring companies to provide confidential systems for employees to report fraud.

In the excerpt from applicant's publication, submitted by applicant with its response to the first Office action, an article entitled "Where Boards of Directors Go Wrong: Steinberg's Top 10" includes the following descriptive usage of "compliance":

But attention must be paid to fundamental board responsibilities - making sure the company has the right strategy and implementation plan; relevant and aligned performance metrics; strategically and economically sound M&A partners; effective ethics, control and **compliance** programs; sound financial reporting; sensible and effectively motivational compensation programs; and the like.

...

Boards certainly shouldn't allow institutional investors to dictate what needs to be done, but allowing major shareowners to raise issues and offer input and suggestions - and ensuring any information provided **complies** with Reg. FD and other rules - enables those investors to participate in the governance process without voting with their feet.

...

A tremendous amount of attention is being given to the new requirements of Sarbanes-Oxley, the exchanges and the SEC. Yes, ensuring **compliance** with these requirements is essential.

The record includes a printout of the web page of a publication entitled "**Insurance Compliance Week.**" Listed on this web page are "Our Other Publications," the descriptions of which include the following usage of "compliance":

The investment adviser industry looks to IA Week for independent coverage of both cutting edge and tried-and-true **compliance** practices, products, and services.

BD Week keeps **compliance** and continuing education professionals informed about all the federal and state regulatory and enforcement activity affecting their organizations and operations.

Regulatory Risk Monitor offers bank **compliance** officers practical guidance and expert advice on meeting regulatory challenges.

The record includes a printout of the web page of Eli Research Inc., advertising a publication named "**Medicare Compliance Week**," a publication published in "45 Weekly Issues." In describing this publication, the following language is used:

The fraud minefields are everywhere in Medicare and Medicaid, and your organization depends on being able to avoid them all.

Now for the good news: you can have an experienced team of **compliance** experts brief you every week in a comprehensive new report from Eli Research, **Medicare Compliance Week**. Every week, you'll receive a hard-hitting **compliance** update that will put you two steps ahead of the feds.

The record includes a printout of the web page of AIS Health.com, which includes the following text under the heading "HIPAA & Medicare **Compliance** Resources."

Articles on **Compliance** Strategies

Ways to Keep **Compliance** Fresh: Designate Week, Change Posters, Rotate Screensavers

*Reprinted from the Jan. 24, 2005, issue of REPORT ON MEDICARE **COMPLIANCE**, the nation's leading source of news and strategic information on false claims, overpayments, compliance programs, billing errors and other Medicare **compliance** issues.*

Congress may soon declare a "national **compliance** week" to highlight the value and mission of the health care **compliance** movement - a powerful way to keep ethics and **compliance** fresh now that it's a routine part of life. The Health Care **Compliance** Assn. Is working with some members on sponsoring the week-long dedication, says HCCA President Roy Snell. "We are very optimistic. It's just a matter of time."

But **compliance** officers striving to keep **compliance** alive in employees' minds don't have to wait for lawmakers to act. "People can just set aside **compliance** week" in their organizations, Snell says. ... One message to convey to employees: **Compliance** is a problem-solving resource, not an enforcement agency, he says.

Compliance programs are no longer the new kid on the block, and that means **compliance** officers have to take extra measures to keep people thinking about it and committed to it. Here are some approaches:

(1) Jim Passey, **compliance** and privacy officer at Desert Regional Medical Center in Palm Springs, Calif., suggests an emphasis on the lighter side of **compliance** to rekindle awareness. "Use humor to take some of the doom and gloom out of **compliance**," he says. You can send funny messages while still being serious. People turn off to worst-case scenarios," such as who went to jail for **compliance** violations.

...

For example, Passey puts **compliance** articles in the regular employee newsletter to constantly

keep **compliance** in employees' faces - with levity if possible. "I always try to use engaging stories peppered with some humor." The newsletter also always contains an "ad" for the **compliance** hotline.

...

Also, he says, organizations can keep **compliance** lively by implementing mandatory **compliance** education in different ways. ... The 200 managers were assigned responsibility for picking **compliance** modules relevant for their respective department. There are 150 **compliance** education modules to choose from...

Another way that Saint Joseph's keeps **compliance** alive: The **compliance** officer appears in person to celebrate with a department that has resolved a **compliance** problem satisfactorily. ... Token rewards - mugs, pens or polo shirts - "can help create the **compliance** culture we are looking for.

In terms of infusing the board with **compliance** awareness, Wade trained all incoming board members - about 15 a year at the health system's five hospitals - on **compliance**. He met privately with them, and presumably they brought their new-found **compliance** awareness to board meetings.

The record includes a printout of the web page of RSM McGladrey, which includes the following text under the heading "Regulatory **Compliance** Assessment."

Let Us Handle Your Regulatory **Compliance**.
Regulatory **compliance** issues continue to be at the forefront of the financial institution industry. The constantly changing laws and regulations may have a negative impact on your bottom line. In many institutions, officers and staff spend valuable time reviewing

regulatory requirements, ensuring ongoing **compliance**, and implementing new regulations. We can help you manage your **compliance** function and monitor **compliance** with consumer regulations.

Our team of regulatory **compliance** consultants has extensive experience in developing, designing, and assessing regulatory **compliance** programs in institutions of any size. Each consultant has significant work experience with regulatory agencies, financial institutions, and trade groups.

Our Approach

When we assess your regulatory **compliance**, we will:

- Create an overview of your regulatory risk profile.
- ...
- Review your current policies, processes, and procedures related to **compliance**.
- Assess your current **compliance** training.
- Assess by line functions and internal audit your current level of **compliance** monitoring.

We will provide you with:

- ...
- A new **compliance** structure, including a **compliance** charter and **compliance** committee.
- ...
- A **compliance** review program to assess your performance by functional area.
- ...
- Quarterly **compliance** results.
- A **compliance** hotline to provide up-to-date **compliance** information and answers to your **compliance** questions.

How You Will Benefit

- ...
- Our **compliance** professionals work with your personnel to find solutions to **compliance** problems.
- Your employees can focus on serving the needs

of your customers/members while we take care of your **compliance**.

Also of record is a printout from the web site of Insurance Networking News, under the heading "Regulatory **Compliance** Portal":

*The Sarbanes-Oxley Act of 2002 and other regulatory **compliance** news and information*

The insurance industry is still relying on manual processes and ad-hoc measures in response to fast-changing regulatory and corporate governance demands, experts say. Although **compliance** officers are being asked to manage the impact of regulatory demands, experts believe that the industry is failing to fully embrace the high business value of information technology when addressing regulatory requirements such as HIPAA and corporate governance demands driven by mandates such as the Sarbanes-Oxley Act.

For example, HIPAA **compliance** should not be seen as a costly regulatory burden, but as a way to appropriately manage ongoing security risks in a way that reduces overall business risk, reduce[s] costs, and improves quality, experts say. And, because financial reporting touches upon so many areas of corporate activity, IT is expected to play a critical role in Sarbanes-Oxley **compliance**.

Regulatory **Compliance** News Briefs

...

New Solution Aims to Reduce SOX **Compliance** Costs

...

Regulatory **Compliance** Articles

...

From Obstacle to Opportunity

September 1, 2004 - with the right approach, more insurers are viewing regulatory **compliance** not as a burden, but as an opportunity to enhance business activities.

...

Governance, Risk and **Compliance** Software
Vendors Form **Compliance** Consortium

...

The record includes a printout from the web site of Oklahoma State University, "Environmental Health & Safety" page, which includes the following text:

Compliance with Regulations

Oklahoma State University has established a system of faculty-administered boards and committees to ensure protection of the rights and well-being of human subjects, ethical treatment of animal subjects, and **compliance** with federal regulations governing both. The University Research and **Compliance** function is under the auspices of the Office of the Vice-President for Research. Oversight is provided by the Director of Research Development & **Compliance**, 405.744.6501.

In an effort to support research at OSU, the Environmental Health and Safety Dept. offers this web site to help students, faculty and research personnel meet **compliance** regulations and follow safety rules.

There is a printout from the web site of SSH Communications Security, which includes the following text under the heading "**Compliance** and Regulations":

Sarbanes-Oxley Act (SOX)
The SSH Tectia solution can help public companies implement technical security controls as a part of the SOX Section 404 **compliance** plan.

There is a printout of the web page of ChemAlliance Regulatory Column, which includes an article entitled "Developing An EPA Refrigerant Regulations **Compliance** Program" containing the following text:

...

EPA is responsible for federal regulations concerning the protection of stratospheric ozone and has issued numerous regulations and requirements to insure **compliance**.

...

Developing and implementing an EPA Refrigerant Regulations **Compliance** Program is vital to every affected organization to insure successful **compliance**. The ideal **compliance** plan minimizes capital expenditures and operating costs while achieving full **compliance** with applicable laws and requirements.

...

The first step in developing an EPA Refrigerant Regulations **Compliance** Plan is to appoint an individual or team the responsibility and authority to create a plan and to oversee its successful implementation. Title VI of the Clean Air Act provides information on the responsibilities and characteristics of the "Responsible Official" concerning **compliance** issues. ... The corporate refrigerant **compliance** manager will become the focal point for program activities. ...

...

Before a refrigerant **compliance** program is formulated, a comprehensive refrigerant systems assessment should be performed. ... This will help you to evaluate and benchmark the current situation and help to develop a refrigerant **compliance** management plan or improve an existing one.

...

The corporate refrigerant **compliance** manager will need to understand, evaluate, and institute required administrative controls, policies, and procedures to verify compliance. ... All current processes and procedures should be examined for gaps and potential **compliance** failure points.

...

A "Roll Out" implementation training process should be conducted to insure everyone affected receives a copy of the **compliance** program.. In order to insure ongoing **compliance**, regularly scheduled **compliance** update training should be conducted. ...

Finally, the record includes a printout from the web page of CIO Magazine, of an article from the January 15, 2005 issue entitled "Message Therapy," subtitled "Federal Regulations require an entirely new approach to storing and searching e-mails. Noncompliance is not an option."

Excerpts include:

Federal regulators understand the role e-mail plays in corporate life today. Consequently, almost every new regulation mandates that companies save those messages for years. For example, the Sarbanes-Oxley Act requires every

public company to save every record that informs its audit process, e-mails included, for seven years. Different regulations target specific industries. Securities and Exchange Commission Rule 17a-4, which covers brokerages, is the most publicized example. The Health Insurance Portability and Accountability Act and Medicare both require health-care companies to save e-mails. Pharmaceutical companies, telecommunications companies and government contractors have to comply with other e-mail laws and rules.

...

...One of the benefits of reviewing e-mails is that inbound and outbound messages that test positive for certain illegal terms or context can be flagged and routed to a **compliance** officer for review.

...

...The new policy tool searched for certain words, terms or meanings in e-mails that would trigger an alert, and then routed the e-mail to a **compliance** officer who needed to give approval before the e-mail would be sent.

...

...With the new e-mail system, the company's **compliance** officer is able to confront the offender before it becomes a criminal matter.

...

What's more, the e-mail management crisis offers a rare chance for the CIO to be the hero. Eaton-Vance's Cottone, for example, brought the issue to the attention of his **compliance** officer.

This evidence establishes that COMPLIANCE is a term of art in the legal and business fields. Companies have

"compliance programs" and "compliance plans" to aid them in meeting regulatory compliance requirements such as those imposed by Sarbanes-Oxley, the Health Insurance Portability and Accountability Act (HIPAA), and other regulatory regimes. Companies have officers known as "compliance officers," and they provide "compliance training" and "compliance education" to their employees. There appears to be an entire industry that has grown up around the issue of compliance, with "compliance experts," "compliance consultants" and "compliance professionals" offering their services to clients in need of such assistance; applicant itself identifies "Compliance Firms" and "Compliance Solutions and Providers" as resources available on or through its web site.

Based on this evidence, we find that COMPLIANCE is merely descriptive of the subject matter of applicant's publications, i.e., "print publication, namely, magazines and newsletters concerning regulations promulgated by federal and state governments and by independent regulatory agencies." A publication "concerning regulations" necessarily would include, or certainly could include, information regarding compliance with regulations. The term COMPLIANCE immediately and directly informs purchasers of this feature of applicant's publications.

We also find that WEEK is merely descriptive of applicant's publications, inasmuch as it immediately and directly describes the frequency with which the publication is or could be issued, i.e., once a week.⁴

Finally, we find that the mark as a whole, COMPLIANCE WEEK, is merely descriptive of applicant's publications, i.e., publications, issued once a week, on the subject of regulatory compliance. Unlike in the SNO-RAKE case cited by applicant (*In re Shutts*, 217 USPQ 363 (TTAB 1983)), there is nothing incongruous, unusual or otherwise distinctive about applicant's combining of these two merely descriptive terms into the composite COMPLIANCE WEEK; the words have the same merely descriptive significance whether considered separately or as a composite phrase. See, e.g., *In re Oppedahl & Larson LLP*, *supra* (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet); and *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996)(FOOD & BEVERAGE ONLINE merely

⁴ Applicant's voluntary disclaimer of WEEK, although not conclusive on the issue of mere descriptiveness and not necessary to our finding of mere descriptiveness, tends to corroborate our finding, based on the meaning of the word itself as applied to a weekly publication, that WEEK is merely descriptive.

descriptive of news and information service for the food processing industry).

For these reasons, and based on the evidence discussed above, we find that COMPLIANCE WEEK is merely descriptive of the goods identified in the application. Applicant's third-party registration evidence, showing a handful of registrations of marks not at issue herein, does not mandate or warrant a different conclusion. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Nor are we persuaded by applicant's argument that, because some courts in dicta have identified BUSINESSWEEK as an example of a suggestive (rather than merely descriptive) mark, we should find COMPLIANCE WEEK to be a suggestive mark in this case. Even assuming arguendo that the premise is correct, i.e., that BUSINESSWEEK is suggestive, applicant's mark COMPLIANCE WEEK is obviously different, and more specific and direct in its connotation, than BUSINESSWEEK.

Finally, we are aware that subsequent to the briefing of this appeal, applicant's copending application to register COMPLIANCE WEEK for Class 9 goods identified as "electronic publications, namely magazines and newsletters concerning regulations promulgated by federal and state governments and by independent regulatory agencies which is

downloadable or recorded on computer media," was approved for publication (by a Trademark Examining Attorney other than the one involved in this case), and a registration has issued (with applicant's disclaimer of WEEK).⁵ We have considered the fact of the issuance of that registration, but are not persuaded that it warrants registration of the mark in the case before us. Rather, we find that refusal of registration is proper in this case in view of the evidence of record which establishes, without doubt, the mere descriptiveness of COMPLIANCE WEEK as applied to applicant's identified goods.

Decision: The refusal to register is affirmed.

⁵ Registration No. 3072742, issued March 28, 2006.