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THE TTAB

Mailed: August 3, 2006
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IPIQ, LLC

Serial No. 78355503

Richard E. Nawracaj of Entwistle & Cappucci LLP for IPIQ,
LLC.

Richard F. White, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Hairston, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by IPIQ, LLC to register
the mark RETURN ON INTELLECTUAL PROPERTY for "financial
analysis and consultation, namely calculation of the
expected financial value from intellectual assets,
intellectual property, and investments in intellectual
property and intellectual assets."¹

¹ Application Serial No. 78355503, filed January 22, 2004, based
on a bona fide intention to use the mark in commerce.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if used on the identified services, would be merely descriptive of them. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

It is the examining attorney's position that the mark RETURN ON INTELLECTUAL PROPERTY is merely descriptive of the identified services because it "inform[s] potential consumers that [applicant] is engaged in calculating the expected or potential yield of the consumer's intellectual property assets." (Brief at p. 3).

In support of the refusal, the examining attorney submitted the following definitions taken from The American Heritage Dictionary of the English Language (Fourth edition 2000):

return: 6b. A profit or yield from labor or investments. Often used in plural.

intellectual property: A product of the intellect that has commercial value, including copyrighted property such as literary or artistic works, and ideational property, such as patents, appellations of origin, business methods, and industrial processes.

The examining attorney also submitted materials taken from three Internet websites which show use of "return on

intellectual property." Excerpts from these materials are set forth below:

IPM with SAP enables media companies to gradually replace costly stand-alone systems, improve revenue projection, and cast increase financial return on intellectual property by fully exploiting intellectual property right inventories....

"Efficient management of our intellectual property will be a key driver of profitability and future growth," said Andreas Scholten, information officer, EM.TV. "We chose SAP to optimize the way we manage our intellectual properties..."

(www.sap.com)

2005 Intellectual Property Seminar Series
Intellectual Property Strategizing to Maximize Portfolio Value

The theme of this year's seminar series is: IP Strategizing to Maximize Portfolio Value

April 26 - Perspectives on IP Valuation

Neal M. Cohen, Esq.

Partner, Cohen Sakaguchi & English LLP

Mr. Cohen will lead a panel of distinguished outside and in-house counsel in a discussion about maximizing investment and return on intellectual property including retaining outside counsel to do IP valuation.

(www.law.whittier.edu/centers)

Maximizing Corporate Return on Intellectual Property

It's time to put your intellectual property (IP) to work. This is the only seminar that reveals how to make your technological innovations and intellectual properties your most valuable assets. There are two prime objectives: (1) Generate significant revenues (in many cases, revenues greater than the net worth of your company), and (2) Protect and benefit your organization (and not your competition). The

knowledge offered in this course will help create a profit center for your organization and immediately reduce the company's IP cost and protect the corporation's technology investments. (www.launchspace.santasoft.com)

Applicant argues that the mark RETURN ON INTELLECTUAL PROPERTY is at most suggestive of its services; that the examining attorney has made the erroneous assumption that the only services to which the mark applies are calculating the returns on intellectual property; that applicant's services are not as narrow as the examining attorney assumes; and that applicant's services incorporate subjective measures and opinion, and more than simply calculating the returns on intellectual property. Further, applicant maintains that "by simply looking at the Mark, the depth and scope of the services provided in connection therewith are not described by the Mark or, for that matter, readily ascertainable in any manner from the Mark itself." (Brief at pp. 4-5).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588

F.2d 811, 200 USPQ 215 (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 to be merely descriptive, rather it is enough that the term describe one significant attribute, function or property of the goods or services. 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 the 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 (TTAB 1979).

Applying these principles in the present case, we find that the mark RETURN ON INTELLECTUAL PROPERTY is merely descriptive of the services identified in the application, "financial analysis and consultation, namely calculation of the expected financial value from intellectual assets, intellectual property, and investments in intellectual property and intellectual assets." Specifically, it

immediately and directly informs clients and prospective clients that a significant feature of applicant's services is the calculation of the return on intellectual property. That this is a significant feature of applicant's services is beyond dispute. We note the following statements in applicant's 6/19/2006 Response:

The services applicant provides in conjunction with the mark RETURN ON INTELLECTUAL PROPERTY are consulting services relating to the valuation of intellectual property and the comparison of this worth to the investment that had been required to procure such intellectual property. Therefore, such services necessarily involve three steps: (1) valuation of the intellectual property; (2) determination of the investment that was required to obtain such intellectual property; and (3) the comparison of the foregoing two values by way of arithmetic division.

The valuation of intellectual property, which is the first step in determining the return thereon, necessarily incorporates subjective measures and opinion.

...

Only after the value of the intellectual property and the investment required in order to procure such intellectual property are determined may the *return on intellectual property* be calculated by dividing (1) the value of the property, by the (2) investment that was required to obtain such intellectual property. (emphasis added)

In addition, the examining attorney has made of record Internet evidence which shows that the phrase "return on intellectual property" has been used in a descriptive manner in connection with the valuation of intellectual property. Based on this evidence and on the meanings of

the words as they would be understood in connection with "financial analysis and consultation, namely calculation of the expected financial value from intellectual assets, intellectual property, and investments in intellectual property and intellectual assets," we find that the mark RETURN ON INTELLECTUAL PROPERTY merely describes a significant feature of applicant's services.

It appears to be applicant's position that the mark RETURN ON INTELLECTUAL PROPERTY is not descriptive of applicant's financial analysis and consultation services because the mark does not describe all the steps and subjective measures and opinion involved in rendering such services. However, as noted previously, 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 to be merely descriptive, rather it is enough that the term describe one significant attribute, function or property of the goods or services.

Further, contrary to applicant's contention that the connotation of its mark is ambiguous when considered in the abstract, it is well 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).

In sum, when considered in connection with applicant’s services, “financial analysis and consultation, namely calculation of the expected financial value from intellectual assets, intellectual property, and investments in intellectual property and intellectual assets,” the term RETURN ON INTELLECTUAL PROPERTY immediately describes, without conjecture, or speculation, a significant feature of such services.

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