

Oral Hearing:
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THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mortgage Bankers Association of America

Serial No. 75/112,344

Raymond N. Baker and Andrew J. Aldag of Shanley & Baker for
Mortgage Bankers Association of America.

Jodi D. Lauterbach, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Seeherman, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Mortgage Bankers Association of America has filed an
application to register the mark "MBA REAL ESTATE FINANCE PRESS"
and design, as reproduced below,

for "printed matter, namely, educational brochures and reference manuals relating to guidelines and steps for applying for, obtaining and maintaining mortgages for prospective home buyers".¹

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the words "REAL ESTATE FINANCE PRESS," which the Examining Attorney maintains are merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).²

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the disclaimer requirement.

Applicant, while notably ignoring the fact that the Examining Attorney, among other things, has made of record numerous third-party registrations which show that the word "PRESS" is invariably disclaimed when used as a component of marks for various types of publications,³ argues that the

¹ Ser. No. 75/112,344, filed on May 31, 1996, which alleges dates of first use of 1993.

² Although the Examining Attorney also made final a requirement that applicant indicate the subject matter of its printed publications, such requirement has been withdrawn in view of applicant's subsequent amendment of the identification of its goods to read as set forth above.

³ In her final refusal, the Examining Attorney indicated that:

The Office has been consistent with respect to the requirement of the disclaimer of PRESS in relation to International Class 16 printed matter. The register is replete with such disclaimers. There are three-hundred and ten registrations with the disclaimer of PRESS for International Class 16 goods. The Examining Attorney

Examining Attorney has failed to consider its mark in its entirety. Specifically, applicant asserts that "[t]he Examining Attorney has dissected the mark by separating the MBA logo from the wording portions 'REAL ESTATE FINANCE' and 'PRESS' in order to separately analyze each wording portion and make a conclusion that each wording portion is descriptive." Applicant insists, however, that "the 'REAL ESTATE FINANCE PRESS' portion of the mark is a unitary mark" and that, consequently, "no disclaimer of a dissected part, whether descriptive or otherwise, should be required." Furthermore, applicant urges that the phrase "REAL ESTATE FINANCE PRESS," as used in its mark, "forms a unique commercial impression regardless of whether 'REAL ESTATE', 'REAL ESTATE FINANCE' or 'PRESS' taken individually could be construed as 'merely descriptive'."

The Examining Attorney, on the other hand, correctly observes that "terms which describe the subject matter of publications are merely descriptive under Section 2(e)(1)." See, e.g., In re Gracious Lady Service, Inc., 175 USPQ 380, 382 (TTAB 1972) ["CREDIT CARD MARKETING" merely descriptive of periodic pamphlet devoted to subjects of interest to those engaged in credit card merchandising field]; In re Nippon Kokan Kabushiki Kaisha, 171 USPQ 63, 64 (TTAB 1971) ["JAPAN STEEL NOTES" merely descriptive of magazine containing articles relating to the Japanese steel industry]; and In re Medical Digest, Inc., 148

encloses a sample of these third[-]party registrations as evidence of the descriptiveness of the term.

Applicant, however, has offered nothing in response to such proof.

USPQ 570 (TTAB 1965) ["OB/GYN DIGEST" merely descriptive of periodical magazine in the field of obstetrics and gynecology]. In view thereof, the Examining Attorney maintains that the words "REAL ESTATE FINANCE PRESS" are merely descriptive of applicant's publications since, as shown by the evidence of record, the phrase "REAL ESTATE FINANCE is a unitary term commonly used in the industry to describe a category of business/finance" and that the word "PRESS is descriptive of the goods in that it is a generic term used to identify 'printed matter as a whole.'"

Specifically, in support of her position, the Examining Attorney relies upon, as mentioned earlier, various third-party registrations, in which the term "PRESS" has been disclaimed when it appears as part of marks for publications, as clear evidence that "the Office has consistently held the term PRESS to be descriptive ... for all types of publications." In addition, the Examining Attorney has furnished numerous excerpts from her searches of the "NEXIS" database which "attest to the fact that the wording REAL ESTATE FINANCE is a term of art used in the industry to refer to the area of business/finance that is the subject matter of the Applicant's ... [educational] brochures and reference materials." A representative sample of such excerpts is set forth below (**emphasis added**):

"Mr. Schragger's financing for the purchase of the Henry Hudson Hotel will be provided by NorthStar Partners, the new **real estate finance** group backed by UBS Securities Inc." -- Crain's New York Business, September 15, 1997;

"'It stabilizes neighborhoods because there's pride of [home] ownership,' said Pam

Rodrigues, a city of Fresno **real estate finance** specialist." -- Fresno Bee, August 31, 1997;

"Expanding beyond construction loans - its historical **real estate finance** tool - the group is now offering bridge acquisition loans and permanent loans." -- American Banker, August 29, 1997;

"The new branch ... provides commercial mortgages and other **real estate finance** services." -- Miami Daily Business Review, August 25, 1997;

"He has taught state-approved **real estate finance** courses and published a subscription newsletter for Puget Sound area real estate investors." -- News Tribune, March 9, 1997;

"In addition to national conferences, MBA offers an array of educational programs. From week-long Commercial **Real Estate Finance** courses ... and the School of Mortgage Banking to seminars and roundtable discussions, MBA is nationally recognized as providing professional education" -- National Real Estate Investor, November 1994; and

"[T]he Greater Boston Real Estate Board on April 23 will begin courses for its certificate in **real estate finance**." -- Boston Globe, April 7, 1990.

The Examining Attorney has also made of record definitions from both Webster's II New Riverside University Dictionary (1994), which defines "press" as a noun meaning, in relevant part, "[p]rinted matter as a whole, esp. newspapers and periodicals," and Webster's Ninth New Collegiate Dictionary (1990), which lists such term as a noun signifying, in pertinent part, "newspapers, periodicals" In addition, the Examining Attorney accurately observes that the specimens submitted with the application, which consist of the title page and table of

contents from its "FORECLOSURE Management" publication, contain a reference on the title page to "The National Association for Real Estate Finance". Such reference appears adjacent to applicant's mark and immediately below applicant's name and address. The Examining Attorney asserts that the reference "is further evidence that ... Applicant is a member or sponsor of this association" and that "it is logical to assume that these publications relate to 'real estate finance.'"

With respect to applicant's argument that she has improperly "dissected the mark in requiring the disclaimer of the wording REAL ESTATE FINANCE PRESS" apart from the MBA abbreviation and book design" of the mark, the Examining Attorney contends that:

[I]n order for a mark to be considered unitary, the elements must be so merged together that they cannot be divided to be regarded as separable elements. TMEP Section 1213.06(a). Here, the descriptive wording, i.e., REAL ESTATE FINANCE PRESS, is not combined with the nondescriptive elements of the mark, specifically, the letters MBA and the stylized book design, in such a way that the descriptive significance of the wording ... is lost and the combination functions as a unit. In fact, ... the portion of the mark REAL ESTATE FINANCE PRESS" is completely segregated from the wording MBA and stylized building design. The respective wording is clearly set apart on separate pages of the book design and it appears in different stylized fonts.

It is well settled that a phrase or term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning the nature thereof, including any significant 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). It is not necessary that a phrase or term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the phrase or term describes a significant attribute or aspect about them. Moreover, whether a phrase or 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 phrase or term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

In the present case, we agree with the Examining Attorney that, in light of the evidence of record, it is plain that the words "REAL ESTATE FINANCE PRESS" merely describe printed matter, including educational brochures and reference manuals, which is devoted to the subject of real estate finance, such as guidelines and steps for applying for, obtaining and maintaining mortgages for prospective home buyers. Such words, therefore, must be disclaimed inasmuch as they immediately

convey, without speculation or conjecture, that applicant's goods are printed publications dealing with matters of real estate finance. Here, the Examining Attorney has clearly shown, by dictionary definitions and the disclaimers in numerous third-party registrations, that the term "PRESS" is merely descriptive of printed matter, including not just newspapers and magazines but also publications of the type offered by applicant, and that those in the trade recognize that, by disclaiming such term, that no one is entitled to the exclusive appropriation thereof. Lest there be any doubt in this regard, we judicially notice⁴ that The Random House Dictionary of the English Language (2d ed. 1987) defines "press" in relevant part as "printed publications collectively, esp. newspapers and periodicals."⁵ Coupled with the fact that the reference in applicant's specimens and the "NEXIS" excerpts demonstrate that "REAL ESTATE FINANCE" is a commonly known and used term, it is plain that the phrase "REAL ESTATE FINANCE PRESS" conveys forthwith the nature and subject matter of applicant's educational brochures and reference manuals

⁴ Judicial notice may properly be taken of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁵ While applicant asserts that the dictionary definitions are limited in that they apply "to periodic publications and not instruction manuals, which are the types of educational printed matter associated with applicant's mark," we agree with the Examining Attorney that newspapers and periodicals are but "prime examples of 'press'" and that such term is broad enough to encompass other kinds of printed matter. Moreover, educational brochures and reference manuals are often periodic in nature in that they are updated and/or revised at various intervals to reflect the latest developments or other new information.

and is thus merely descriptive of such goods within the meaning of the statute.

Applicant, it seems, does not seriously take issue with this conclusion, relying instead upon its contention that the words "REAL ESTATE FINANCE PRESS" form a unitary expression and therefore need not be disclaimed. It is true, of course, that the Board has held that merely descriptive elements of a unitary mark need not be disclaimed. Compare In re Kraft, Inc., 218 USPQ 571, 573 (TTAB 1983) [disclaimer of merely descriptive word "LIGHT" in mark "LIGHT N' LIVELY" for reduced calorie mayonnaise "is not appropriate" since mark is unitary] with In re EBS Data Processing, Inc., 212 USPQ 964, 966 (TTAB 1981) [disclaimer of merely descriptive term "POCKET PROFILE" in mark "PHACTS POCKET PROFILE" for a personal medical history summary "is proper" inasmuch as the former "is a separable element" from the latter]. Whether a mark is unitary, however, depends upon whether its elements are inseparable and make a single and distinct commercial impression. Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Factors to be considered in determining whether matter forms part of a single or unitary mark are: whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology and how the meanings of the words relate to each other and the goods. TMEP §807.13(a).

We concur with the Examining Attorney that applicant's entire mark is not unitary and that, in particular, the merely

descriptive words "REAL ESTATE FINANCE PRESS" must be disclaimed. Plainly, such words are not so merged together or otherwise combined with the design elements of applicant's mark that they cannot be regarded as a separate element of such mark, nor is there anything which is striking or significant in the arrangement or meaning of such words. Rather, as the Examining Attorney has pointed out, the borders formed by the pages of the book design in applicant's mark serve to segregate the phrase "REAL ESTATE FINANCE PRESS" from the term "MBA" and its associated building silhouette. Inasmuch as applicant's mark, therefore, is not unitary, a disclaimer of the merely descriptive words "REAL ESTATE FINANCE PRESS" is proper.

Decision: The requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the words "REAL ESTATE FINANCE PRESS".⁶

E. J. Seeherman

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

⁶ See *In re Interco Inc.*, 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.09(a)(i) and 1213.09(b).