

Paper No. 16  
Bottorff

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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Taylor & Francis [Publishers], Inc.

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Serial No. 75/229,157

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Comisky & McCauley, LLP for Taylor & Francis [Publishers],  
Inc.

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Before Cissel, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration of the mark depicted  
below

for goods identified in the application as "series of non-fiction books in the field of psychology."<sup>1</sup>

The Trademark Examining Attorney, citing Trademark Act Section 6(a), 15 U.S.C. §1056(a), required applicant to disclaim the words PSYCHOLOGY PRESS apart from the mark as shown, and refused registration of the mark absent compliance with the disclaimer requirement. When the disclaimer requirement was made final, applicant filed this appeal.

Applicant and the Trademark Examining Attorney have filed main briefs, and applicant has filed a reply brief. No oral hearing was held.<sup>2</sup> For the reasons discussed below,

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<sup>1</sup> Serial No. 75/229,157, filed January 22, 1997. The application is based on use in commerce under Trademark Act Section 1(a), and September 28, 1995 is alleged as the date of first use of the mark anywhere and first use of the mark in commerce. A "description of the mark" statement in the application states as follows: "The mark consists of the words PSYCHOLOGY PRESS ALERE FLAMMAM and a design of a burning lamp with a human hand nearby within a circle." The application also contains a translation statement which reads as follows: The term ALERE FLAMMAM roughly translates from Latin meaning: 'to feed, or nourish, the flame.'"

<sup>2</sup> Applicant in fact timely requested an oral hearing in this case on January 7, 1999. The Board, in an order dated April 8, 1999, notified applicant's counsel and the Trademark Examining Attorney that an oral hearing was set for May 11, 1999 at 2:00 p.m. At approximately 11:00 a.m. on May 11, 1999, applicant's counsel notified the Board, in a telephone call to the Secretary for the Chief Administrative Trademark Judge, that she was unable to attend the hearing, and that she would be forwarding to the Board, by fax, a request to reschedule the hearing. The Board received this request at 11:45 a.m. on May 11, 1999. In requesting that the oral hearing be rescheduled, applicant's counsel gave the following reason: "Due to a sudden conflict of

we affirm the Trademark Examining Attorney's requirement for a disclaimer under Trademark Act Section 6(a).

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time, Applicant's attorney regrettably will not be able to attend the hearing at its originally scheduled date."

On May 13, 1999, the Board issued an interlocutory order denying applicant's counsel's request to reschedule the oral hearing. The Board explained that its practice in these situations is to reschedule an oral hearing, at the request of the applicant or the Trademark Examining Attorney, if there is a reasonable basis for the request, but that, absent compelling circumstances, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date, unless both the applicant and the Trademark Examining Attorney agree to the change. The Board noted that, in this case, applicant's request to reschedule the hearing was received a mere three hours before the scheduled oral hearing; that the reason given for the request, i.e., "due to a sudden conflict of time," was wholly inadequate and devoid of any compelling factual circumstances warranting a rescheduling (*cf. HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998)); and that the Trademark Examining Attorney, upon being contacted by the Board, declined to agree to the requested rescheduling of the hearing. In these circumstances, the Board concluded, the requested rescheduling of the hearing was not proper, and accordingly denied the request.

Applicant timely petitioned the Commissioner to reverse the Board's May 13, 1999 interlocutory order denying the request to reschedule the hearing. In an order dated November 23, 1999 (Petition Docket No. 99-484), the Commissioner denied applicant's petition. The Commissioner noted that, under 37 C.F.R. §2.142(e)(1), an oral hearing "may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or his attorney or other authorized representative." See also Trademark Trial and Appeal Board Manual of Procedure ("TBMP") Section 1216. The Commissioner also noted that the Board has wide discretion in scheduling the disposition of the cases on its docket, and that inherent in the power to schedule its own docket is the power to schedule oral hearings. The Commissioner found that, under the facts of this case, the rescheduling of the oral hearing requested by applicant may not have been convenient or proper within the meaning of Trademark Rule 2.142(e)(1). The Commissioner thus concluded that the Board's May 13, 1999 order denying applicant's request contained no clear error or abuse of discretion, and denied applicant's petition for reversal of that order.

Trademark Act Section 6(a) provides, in relevant part, as follows: "The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." If the applicant fails to comply with the disclaimer requirement, registration of the entire mark may be refused. See TMEP §1213.01(b), and cases cited therein.

The Trademark Examining Attorney contends that PSYCHOLOGY PRESS is an "unregistrable component" of the mark applicant seeks to register, inasmuch as it is merely descriptive under Trademark Act Section 2(e)(1). Applicant, in turn, contends that PSYCHOLOGY PRESS is not merely descriptive of its goods, and that, in any event, the disclaimer requirement is improper because applicant's mark is a unitary mark and PSYCHOLOGY PRESS is an inseparable component thereof.<sup>3</sup> We have carefully considered applicant's arguments, but we are not persuaded.

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<sup>3</sup> Additionally, applicant, citing a 1924 (pre-Lanham Act and pre-disclaimer practice) decision, has argued that because its mark as a whole is not merely descriptive, the Trademark Examining Attorney's "Section 2(e)" refusal is improper. Applicant also argues, without citing any authority in support thereof, that the proper basis for refusing to register an applicant's entire mark due to a failure to comply with a disclaimer requirement is Trademark Act Sections 1, 2 and 45, not Trademark Act Section 2(e). Applicant's arguments are without merit. The Trademark Examining Attorney's requirement and refusal in this case are not based on Section 2(e); rather, they are properly made pursuant to Trademark Act Section 6(a). See, e.g., *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975).

First, we find that PSYCHOLOGY PRESS is merely descriptive of applicant's goods, which are identified in the application as "series of non-fiction books in the field of psychology." 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 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 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. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applicant's identification of goods expressly states that the series of non-fiction books upon which applicant uses its mark are "in the field of psychology." The word PSYCHOLOGY therefore is merely descriptive of the subject matter of applicant's books, as identified in the application, and thus is unregistrable. Applicant's arguments to the contrary are entirely unpersuasive.<sup>4</sup>

We take judicial notice that "press" is defined, *inter alia*, as "a printing or publishing establishment."

Webster's Ninth New Collegiate Dictionary (1990) at 931.

See also the NEXIS® evidence submitted by the Trademark Examining Attorney, which includes, in an excerpt about a bookstore opening, a reference to "small, independent publishers and university presses." Thus, the word PRESS, when used by or in connection with "publishing establishments," is in the nature of a generic entity designation which is incapable of serving a source-

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<sup>4</sup> Even assuming, charitably, that the additional topics identified by applicant as being the possible or actual subject matter of its books, i.e., "language and cognitive processes," are not subsumed within the general subject of psychology, the fact remains that applicant's goods, as identified in the application, include books "in the field of psychology." The word PSYCHOLOGY thus is merely descriptive of the identified goods.

indicating function, and which may not be appropriated to applicant's exclusive use or to the exclusive use of any single publishing establishment. Indeed, the NEXIS® evidence submitted by the Trademark Examining Attorney includes references to several different publishing establishments that all use the term PRESS in their names, suggesting that the industry does not regard PRESS as a term that is capable of exclusive appropriation by any single entity. See, e.g., the references to publishing companies trading under the names "Novell Press"; "Bayou Press Ltd."; "Oriental Press Gp"; "Oxford Psychologists Press"; "Consulting Psychologists Press Inc."; and "Free Press."

It is apparent from applicant's trade name as set forth in the application, "Taylor & Francis [Publishers], Inc.," that applicant is a "publishing establishment" of the type covered by the above-quoted dictionary definition of "press." Applicant has not shown that the word PRESS, as it is used by applicant, would have any other meaning or significance to the relevant purchasing public. If applicant were seeking to register its mark as a service mark for its publishing services, we would not hesitate to find PRESS to be unregistrable for such services.

Applicant is not seeking a service mark registration for its publishing services, however. Rather, applicant is seeking a trademark registration for its goods, i.e., a series of non-fiction books in the field of psychology. Nonetheless, we find that the word PRESS is as unregistrable for applicant's books as it would be for applicant's publishing services. The word is merely descriptive of applicant's books because it directly and immediately conveys to purchasers that the books originate from a "press," that is, "a printing or publishing establishment." We have repeatedly held that "a mark which names the type of commercial establishment from which particular goods come is merely descriptive of those goods." *In re The Phone Company, Inc.*, 218 USPQ 1027, 1028 (TTAB 1983)(THE PHONE COMPANY is no more registrable for goods [telephones and telephone accessories] than it is for retail store services featuring such goods). *See also In re The Paint Products Co.* 8 USPQ2d 1863, 1866 (TTAB 1988)(PAINT PRODUCTS CO. is "no more registrable for goods [interior and exterior paints and coatings] emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company"); and *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364, 367-68 (TTAB 1984)(PASTRY SHOPPE merely

descriptive of both goods and services emanating from a bakery and pastry shop; disclaimer requirement affirmed), *aff'd on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

For the reasons discussed above, we find that the words PSYCHOLOGY and PRESS are each merely descriptive of applicant's identified goods, i.e., "series of non-fiction books in the field of psychology." Moreover, the two words in combination are likewise merely descriptive of applicant's goods. PSYCHOLOGY PRESS directly and immediately informs purchasers that the books bearing those words pertain to psychology, and that they emanate from a publishing establishment (a "press") which publishes books in the field of psychology. The term would equally describe books in the field of psychology published by applicant's competitors. Accordingly, PSYCHOLOGY PRESS would not be viewed as a trademark; rather, it is a merely descriptive designation as applied to the goods identified in the application. We are not persuaded by applicant's arguments to the contrary.

Applicant argues that even if PSYCHOLOGY PRESS, in itself, is merely descriptive of applicant's goods, the Trademark Examining Attorney's disclaimer requirement is improper because applicant's mark is a unitary mark

consisting of the words PSYCHOLOGY PRESS ALERE FLAMMUM and Design, into which PSYCHOLOGY PRESS is so integrated that it does not create a separate commercial impression apart from the mark as a whole. We disagree, and find that PSYCHOLOGY PRESS is readily separable from the rest of the mark in terms of appearance and connotation, and that it creates its own independent and separate commercial impression.

The mark depicts the words PSYCHOLOGY PRESS in a type size which is many times larger and more prominent than the type size in which the words ALERE FLAMMUM appear. Likewise, the words PSYCHOLOGY PRESS are depicted as a circle, further separating them visually from the words ALERE FLAMMUM, which are not part of the circle. The words PSYCHOLOGY PRESS and the words ALERE FLAMMUM are in two different languages, further reducing the likelihood that purchasers viewing the mark would view the four words as a single unitary phrase.

Even if we were to assume that purchasers would readily be able to translate ALERE FLAMMUM into English as "to feed or nourish the flame," the four words PSYCHOLOGY PRESS ALERE FLAMMUM make no sense as a single or unitary phrase. Although PSYCHOLOGY PRESS has a definite meaning, as discussed above, and ALERE FLAMMUM apparently has a

definite meaning, according to applicant's translation thereof, those respective meanings are completely different from and unrelated to each other. Moreover, it is clear that the words ALERE FLAMMUM in the mark are related to, and illustrative of, the design feature in the mark, i.e., the drawing of the hand pouring oil into the lamp in order to keep the lamp aflame. PSYCHOLOGY PRESS has no connotative connection with either the words ALERE FLAMMUM or the drawing of the lamp; rather, it stands alone and creates its own separate commercial impression.

Finally, we reject applicant's arguments that purchasers would perceive PSYCHOLOGY PRESS ALERE FLAMMUM to be unitary because the two phrases, PSYCHOLOGY PRESS and ALERE FLAMMUM, share the same meter, and because the entire four-word phrase is "unitary through its use of anapestic pentameter." Even assuming, *arguendo*, that a mark's employment of such poetic devices might be legally sufficient, in itself, to support a finding that purchasers would perceive the mark as unitary, there is no factual basis for such a finding in this case. There is no evidence in the record as to what would be the proper pronunciation of the Latin words ALERE FLAMMUM, but it is clear that the two phrases PSYCHOLOGY PRESS and ALERE FLAMMUM do not share the same meter. Moreover, the four-

word designation PSYCHOLOGY PRESS ALERE FLAMMUM is not "anapestic pentameter," inasmuch as it is neither composed of anapestic metrical feet<sup>5</sup> nor does it comprise a pentameter.<sup>6</sup>

In short, we find that PSYCHOLOGY PRESS, as applied to applicant's identified goods, i.e., "series of non-fiction books in the field of psychology," is merely descriptive within the meaning of Trademark Act Section 2(e)(1) and thus unregistrable. We further find that applicant's mark is not a unitary mark into which PSYCHOLOGY PRESS is so integrated that a disclaimer thereof would be improper. Accordingly, we find that the Trademark Examining Attorney's requirement for such disclaimer under Trademark Act Section 6(a) was proper.

**Decision:** The requirement for a disclaimer of PSYCHOLOGY PRESS apart from the mark as shown, and the refusal to register in the absence of such disclaimer, are affirmed. However, this refusal will be set aside if, within thirty days of the date stamped on this order,

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<sup>5</sup> An "anapest" is "a metrical foot consisting of two short syllables followed by one long syllable or of two unstressed syllables followed by one stressed syllable (*as unabridged*)."  
Webster's Ninth New Collegiate Dictionary, supra, at 83.

<sup>6</sup> A "pentameter" is "a line of verse consisting of five metrical feet." Webster's Ninth New Collegiate Dictionary, supra, at 870.

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applicant files with the Board a disclaimer, in proper standardized form, of PSYCHOLOGY PRESS. See Trademark Rule 2.142(g).

R. F. Cissel

P. T. Hairston

C. M. Bottorff

Administrative Trademark Judges  
Trademark Trial and Appeal Board