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Paper No. 21
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Media/Professional Insurance Agency, Inc.

Serial No. 75/643,344

William B. Kircher of Shook, Hardy & Bacon L.L.P. for
Media/Professional Insurance Agency, Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Chapman, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Media/Professional Insurance Agency, Inc. has filed an
application to register the mark YOUR CYBERRISK CONNECTION
on the Principal Register for "liability insurance
underwriting services for businesses which are involved in
the dissemination of information or the performance of
services using on-line technology" in International Class
36.¹

¹ Application Serial No. 75/643,344, filed February 16, 1999,
wherein applicant alleges a bona fide intention to use the mark
in commerce.

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 failure to comply with a requirement to disclaim the term "CYBERRISK." Such term, according to the Examining Attorney, is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

It is the Examining Attorney's position that the term "CYBERRISK" merely describes a field or area of business operations in which insurers, including applicant, supply insurance services, or stated another way, "CYBERRISK" identifies risks which are encountered on an on-line or electronic basis and applicant provides risk insurance to the operators of "cyber" businesses. The Examining Attorney argues that when the mark YOUR CYBERRISK CONNECTION is viewed in its entirety, the term "CYBERRISK" is an unregistrable component of an otherwise registrable mark. As evidence in support of this position, the Examining Attorney submitted The Computer Desktop Encyclopedia (1996) definition of "cyber" as "(1) From

cybernetics, a prefix attached to everyday words to add an electronic or online connotation." The Board takes judicial notice of the Dictionary of Insurance Terms (Fourth Edition 2000) definition of "risk" as "uncertainty of financial loss; term used to designate an insured or a peril insured against."²

The Examining Attorney also submitted several excerpted stories retrieved from the Nexis database showing "cyber(-)risk(s)" used in the insurance underwriting industry to describe the risks involved in business operating in the cyber environment, that is, the term identifies an area of insurance coverage for businesses. Representative examples of these stories are set forth below (emphasis added):

HEADLINE: Mealey's Announces Technology Insurance Report
Potential insurance coverage fallout from **cyber risks** known and not known could be enormous, with liabilities arising from Internet security, data destruction and/or alteration, misuse of Web site information ... software errors, hardware failure, electronic theft, and, of course, Y2K coverage issues.
Already, insurance companies have started marketing **cyber risk** insurance designed to shield businesses that

² The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

conduct e-commerce. "Mealey's
Litigation Report," November 20, 1998;

HEADLINE: New **Cyber-Risk** Cover [sic-
Coverage?] Offered
INSUREtrust.com, a provider of e-risks
solutions based in Atlanta, has
announced the availability of
"EXPRESstrust" - policies to protect
businesses from **cyber-risks**, losses and
liabilities... "National Underwriter,
Property & Casualty/Risk & Benefits
Management Edition," October 23, 2000;

HEADLINE: Limiting Liability: Risk e-
business; Insurers Aim to Shield
Clients From Pitfalls of Operating
Online
...unveiled new insurance coverage and
services devoted to shielding companies
from emerging **cyber risks** from LoveBug
viruses to the denial-of-service
attacks that crippled Yahoo Inc.
earlier this year.
Covering intangible harm
It's hardly the sexiest part of
launching an e-business, but '**cyber-
risk**' clearly presents new
opportunities for insurers. At issue
is whether businesses can afford to
ignore the need for electronic risk
management. "Crain's Chicago Business,"
August 14, 2000;

HEADLINE: Concern Spreads About Virus
Risk
...Although most property/casualty
programs do not include so-called **cyber
risk** coverage, the denial of coverage
for such claims has not yet been tested
in court.... "Business Insurance,"
November 13, 2000;

HEADLINE: Defending Against Hackers;
Experts Say Vigilance Is Key To
Maintaining Computer Security

...It is because there are so many exposures associated with Internet risks that insurance coverage must be structured appropriately, said David M. Brenner, an attorney at Riddell Williams P.S. in Seattle. Mr. Brenner specializes in **cyber risks**. "Business Insurance," May 15, 2000; and

HEADLINE: Willis Report Predicts Some Market Shifts

...concerns about new risks, ranging from viruses, to hackers, to cookies, to chat rooms to privacy issues, according to the report. Several sectors of the insurance marketplace have responded to these concerns, the report explained. Media insurers have expanded their media liability policies to address some **cyber-risks**, while other insurers have offered specific **cyber-risk** policies... But because this market is newly emerging, it is difficult to assess capacity, the report finds. However, the report said that there is capacity available in many parts of the market. Since the Internet is an evolving area of law, the report said, 'it will be interesting to see how the existence of insurance, and the attendant coverage litigation, will affect pricing and underwriting of **cyber risks**.'" "National Underwriter, Property & Casualty/Risk & Benefits Management Edition," February 14, 2000.

Applicant argues that the compound word "CYBERRISK" is two distinct words represented as one word; that it should be considered unitary and thus not susceptible to disclaimer under USPTO disclaimer policy; and that the mark as a whole YOUR CYBERRISK CONNECTION is a unitary phrase or

slogan which is more than the sum of its parts and the term "CYBERRISK" should not be dissected out for disclaimer.

Applicant also contends that it owns a registration for the mark CYBERLIABILITY PLUS for essentially identical services, without the requirement for a disclaimer of "cyberliability"; and that any doubt on the issue of descriptiveness should be resolved in applicant's favor.

It is well settled that a term or phrase is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning a significant ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, whether a term or phrase is merely descriptive is determined in relation to the goods or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The Examining Attorney has clearly established that the term "cyber risk" is a descriptive term which relates to an emerging field of the insurance underwriting

business, specifically consisting of insurance for businesses involved in online technology. This term is unregistrable by itself for these services. The fact that applicant deleted the space between the words "cyber" and "risk" is not persuasive of different result because the relevant purchasers will readily understand "cyberrisk" to be "cyber risk" in the context of applicant's services. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

As our primary reviewing court stated in *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991):

The Lanham Act's disclaimer requirement strikes a statutory balance between two competing trademark principles. On the one hand, it provides the benefits of the Lanham Act to applicants for composite marks with unregistrable components. On the other hand, the Act prevents an applicant from claiming exclusive rights to disclaimed portions apart from composite marks. The applicant's competitors in the same trade must remain free to use descriptive terms without legal harassment. *DeWalt, Inc. v. Magma Power Tool*, 289 F.2d 656, 662, 129 USPQ 275, 281 (CCPA 1961). By encouraging definition of the rights claimed in a composite mark, the Act discourages unnecessary litigation.

Applicant's argument that its three-word mark is a unitary phrase or slogan is simply not persuasive. These three words are not inseparable and do not combine to show that the mark has a distinct meaning of its own independent of the constituent elements or words forming the mark. See *Dena Corp v. Belvedere*, supra, at 1052.

The Examining Attorney has established that "cyberrisk" is a merely descriptive term in the relevant field of applicant's insurance services for businesses engaged in online technology. See *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (Court affirmed the Board's decision on a requirement for a disclaimer of the merely descriptive term "FirstTier" for banking services); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (requirement for a disclaimer of the merely descriptive term "lean" for a variety of low calorie foods affirmed); *In re IBP, Inc.*, 228 USPQ 304 (TTAB 1985) (requirement for a disclaimer of the merely descriptive terms "select trim" for pork affirmed); and *In re Truckwriters Inc.*, 219 USPQ 1227 (TTAB 1983), aff'd unpubl'd Appeal No. 84-689 (Fed. Cir., November 1, 1984) (requirement for a disclaimer of the merely descriptive term "writers" for insurance agency services affirmed).

Applicant's argument that it has obtained a registration for the mark CYBERLIABILITY PLUS without a disclaimer of the term "cyberliability," is also not persuasive. As the Examining Attorney points out not only is "cyberliability" a different term than "cyberrisk," but also the record of that registration file is not of record. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of other registration files (including those claimed by the applicant), and moreover, the determination of registrability of those particular marks by other Trademark Examining Attorneys cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.") See also, *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1862 (TTAB 1998).

Decision: The requirement under Section 6 for a disclaimer of the term "cyberrisk" is proper. In the absence of a disclaimer of "cyberrisk" registration is refused. If a disclaimer is entered within thirty days from the mailing date hereof, this decision will be set

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aside and the mark will then be published for opposition.

See Trademark Rule 2.142(g).