

THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: January 19, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Prudential Insurance Company of America

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Serial No. 78373988

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Sue J. Nam for The Prudential Insurance Company of America.

Amos T. Matthews, Trademark Examining Attorney, Law Office  
108 (Andrew Lawrence, Managing Attorney).

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Before Hairston, Grendel and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark EXPERIENCE RESEARCH DISCIPLINE (in standard  
character form) for services recited in the application as  
"mutual fund investment, brokerage and distribution  
services; investment management services; investment  
advisory services; portfolio management services; purchase  
and sale of assets and securities for others; fiduciary  
representative services; financial valuation of assets and

securities for others; financial research services; providing financial account and investment information by means of a global computer network" in International Class 36.<sup>1</sup>

In the application, applicant, in response to the first Office action, disclaimed the exclusive right to use the word RESEARCH apart from the mark as shown. The examining attorney also required applicant to disclaim the word DISCIPLINE, on the ground that it is merely descriptive of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Pursuant to Trademark Act Section 6, the Trademark Examining Attorney has issued a final refusal of registration pending applicant's submission of such disclaimer. 15 U.S.C. §1056.

Applicant has appealed and briefs have been filed. Applicant did not request an oral hearing. After carefully reviewing the evidence of record and the arguments made by applicant and the examining attorney, we reverse.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6. Merely descriptive terms are unregistrable, Trademark Act Section 2(e)(1), and

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<sup>1</sup> Application Serial No. 78373988, filed under Section 1(a) of the Trademark Act, claiming a date of first use and first use in

therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of 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. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). On the other hand, if imagination, thought or perception is required to reach

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commerce on June 1, 2003. 15 U.S.C. §1051(a).

a conclusion on the nature of the goods or services, the mark is suggestive and registrable. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It has long been acknowledged that there is a thin line between terms that are merely descriptive and those that are suggestive. See *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

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).

The burden is initially on the PTO to make a prima facie showing that the mark or word in question is descriptive from the vantage point of purchasers of applicant's services and where doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the application. *In re Merrill Lynch, Pierce, Fenner,*

and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

In support of the refusal, the examining attorney made of record the following dictionary definition of the word "discipline":

2. Controlled behavior resulting from disciplinary training; self-control.
3. a. Control obtained by enforcing compliance or order. b. A systematic method to obtain obedience: a military discipline. c. A state of order based on submission to rules and authority.

The American Heritage Dictionary of the English Language  
(3d ed. 1992).

In addition, the examining attorney submitted excerpts of articles from the LEXIS/NEXIS database based on searches for the phrases "investment discipline" and "financial discipline," and the words "investment discipline" and "experience research discipline" appearing in the same articles. The examining attorney argues that the evidence shows that "others use DISCIPLINE in the financial and investment industries to indicate that it is necessary to proceed with a systematic plan or method in order to achieve the objectives. In view of this record, the term DISCIPLINE tells prospective customers that applicant will provide a systematic approach for its investment and financial services." Brief p. 5. Below is a

representative sample of the excerpts highlighted in the examining attorney's brief:

...From that, we undertake in-depth research into [sic] wide range of areas, including manager experience and tenure, the level of expenses, the discipline of the investment process, and the availability to retail investors.

Business Week Online, March 28, 2005;

...We created working groups to focus on governance, assessing communications effectiveness, improving financial discipline and transparency.

Mergers & Acquisitions, January 14, 2005;

...Saving money is not about how much you earn, but is the result of financial discipline, attitude and patience.

The Lebanon Daily News (Pennsylvania), January 9, 2005;

...We pursue opportunities with integrity and with rigorous investment discipline, and our financial capabilities are unmatched.

Business Wire, January 11, 2005;

...Money managers are generally judged by how closely they adhere to a consistent investment discipline and are carefully monitored to "style drift."

Journal of Accountancy, January 1, 2005.

The examining attorney also points to applicant's specimens of use to show "how purchasers are likely to view the term in relation with the services." Brief p. 6.

Applicant's specimen of use includes the following excerpt:

"Our diversified fixed income team offers a disciplined investment and risk management process, in-depth sector expertise, and one of the most sophisticated research organizations in the industry." The examining attorney argues that from the specimen of use it is shown that "applicant provides a system that 'develops and coordinates investment strategy within the framework of the firm's market outlook and the mutual fund's investment objective, restrictions, policies, and benchmark' to achieve satisfactory results of its services. Applicant develops a systematic plan or method for its customers to achieve the financial objectives." Brief p. 7. The examining attorney concludes that the term DISCIPLINE is "descriptive because it conveys a feature of applicant's services, which is to provide a system or process of order for successfully [sic] financial and investment services." Brief p. 7.

Finally, the examining attorney argues that applicant's evidence of third-party registrations that do not contain a disclaimer for the word DISCIPLINE for similar services is not "conclusive on the question of descriptiveness," noting that each case must be considered on its own merits. Brief p. 7.

In response, applicant argues that the word DISCIPLINE "is a highly abstract word with numerous meanings in the

financial or investment arena" and "[i]n the context of applicant's mark EXPERIENCE RESEARCH DISCIPLINE, the term DISCIPLINE does not describe with reasonable specificity a quality or characteristic of applications services." In the context of applicant's services the word "discipline could suggest that applicant purchases and sells assets and securities in strict accordance with the client's directives, or it could suggest that applicant follows its own principles irrespective of the client's wishes" or "that applicant provides conservative investment advice or that applicant acts in a thorough, researched manner or that applicant is particularly careful about controlling its fees or that applicant adheres closely to legal rules and regulations." Brief p. 5. In support of its position, applicant submitted printouts of third-party applications and registrations from the USPTO Trademark Electronic Search System (TESS) and excerpts of articles retrieved from the LEXIS/NEXIS database based on searches of the phrases "sound investment," "financial experience" and "investment experience."

As noted above, a term is suggestive if, when applied to the goods or services, it requires imagination, thought and perception to reach a conclusion as to the nature of the goods or services. In the present case, we find that

the examining attorney has not established that DISCIPLINE is merely descriptive of applicant's services. We agree with applicant that the word DISCIPLINE alone and as it appears in the mark is more of an abstract term and is suggestive. In re Nett Designs, Inc., supra (a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term). The evidence of record fails to show that it describes a feature, characteristic, etc. of the services with any degree of particularity, and, in fact, supports applicant's position that the term has a multitude of meanings in applicant's field. See e.g., The Lebanon Daily News (Pennsylvania), January 9, 2005 ("Saving money is not about how much you earn, but is the result of financial discipline, attitude and patience" implying reigning in of costs or to save); Mergers & Acquisitions, January 14, 2005 ("...We created working groups to focus on governance, assessing communications effectiveness, improving financial discipline and transparency" implying compliance with financial regulations); Business Week Online, March 28, 2005 ("From that, we undertake in-depth research into [sic] wide range of areas, including manager experience and tenure, the level of expenses, the discipline of the

investment process, and the availability to retail investors" implying a conservative or focused investment approach); and Journal of Accountancy, January 1, 2005 ("...Money managers are generally judged by how closely they adhere to a consistent investment discipline and are carefully monitored to "style drift" implying a specific type of strategy.)

In view of our finding that the term DISCIPLINE is not merely descriptive of applicant's services, a disclaimer pursuant to Trademark Act Section 6 is not required.

Decision: The refusal to register based on applicant's failure to disclaim DISCIPLINE is reversed.