

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: October 4, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PayClerk, Inc.

Serial No. 76594440

Jay S. Horowitz of Jay S. Horowitz, P.C. for PayClerk, Inc.

Julie A. Watson, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Quinn, Hairston and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

PayClerk, Inc. filed an application to register on the
Principal Register the mark PAYCLERK in standard character
form for the following services¹:

payroll preparation and payroll tax preparation
services for others,

in International Class 35.

¹ Serial No. 76594440 was filed on May 27, 2004, based on an
allegation of June 1, 2003 as a date of first use of the mark
anywhere and August 15, 2003 as a date of first use of the mark
in commerce.

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). After applicant amended its application to seek registration on the Supplemental Register, the examining attorney refused registration, under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is incapable of identifying applicant's services and distinguishing them from those of others. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. *See* Section 14(3) of the Act. *See also In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991);

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and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In the case of *In re American Fertility Society*, *supra*, our primary reviewing court stated that if the PTO can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

In the case of *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home

retail services in the field of mattresses," the court further clarified the test as follows (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole."

In this case, we find that PAYCLERK is more analogous to the compound word considered in *Gould* than it is to the phrase considered by the court in *American Fertility*.

Thus, we look first to the dictionary definitions of the

terms comprising PAYCLERK to determine whether they support the refusal to register the proposed mark. The examining attorney submitted with her December 29, 2004 Office action the following definition of "clerk":² "A person who works in an office performing such tasks as keeping records, attending to correspondence, or filing." The examining attorney further submitted with her brief the following definition of "pay":³ "ADJECTIVE: Of, relating to, giving, or receiving payments. NOUN: The act of paying or state of being paid." We will exercise our discretion to take judicial notice of this definition. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982); *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Thus, PAYCLERK may be defined as a person who works in an office keeping records, correspondence and filing relating to giving or receiving payments.

In addition, the examining attorney submitted with her July 25, 2005 Office action articles from the Lexis/Nexis electronic database as well as advertisements and articles

² The American Heritage® Dictionary of the English Language: 4th ed. 2000.

³ *Id.*

retrieved from Internet web pages. Certain excerpts from these articles and web pages follow (emphasis added):

Payroll Clerks

Payroll Clerks collect, verify and process payroll information and determine pay and benefit entitlements for employees within a department, company or other establishment. They are employed by payroll administration companies and by establishments throughout the private and public sectors.

Examples of titles classified in this group

Benefits officer

Pay Clerk

Pay Advisor

Payroll Clerk

Pay and Benefits Administrator

Payroll Officer

Pay and Benefits Clerk

Salary Administrative Officer

Main duties

Payroll Clerks perform some or all of the following duties:

Maintain records of employee attendance, leave and overtime to calculate pay and benefit entitlements, using manual or computerized systems

Prepare and verify statements of earnings for employees, indicating gross and net salaries and deductions such as taxes, union dues and insurance and pension plans

(<http://happyface.com/jobdesc/dllil.html>)

With TimeCardControl, your payroll clerk will not need to manually track and count daily hours and overtime hours. This can translate into substantial cost saving as she could be assigned to other tasks...Within a five-year period a **pay-clerk's** time on processing punch cards could cost

the company \$5,236x5=\$26,180. Her time could be better utilized through using TimeCardControl with or without the Payroll option at a much lower investment.
(www.dbcsoft.com/timecard.php)

Maydean Swoboda lives in Topeka. She began working at the Supply Depot in Topeka in 1944. She worked as a military **pay clerk** in Indiana and in accounting at Forbes Air Force Base, Topeka. (Topeka Capital-Journal (Kansas), May 9, 2004)

...Officers in the war zone often had to educate **pay clerks** at bases in the United States about proper pay procedures.
(The Denver Post, November 14, 2003)

Based upon the recitation of services in the involved application, we find that that "payroll services" is the name of a genus of services. Next, we must determine based upon the evidence of record whether the designation PAYCLERK is understood by the relevant purchasing public primarily to refer to that genus of services.

On this record, we are constrained to find that the examining attorney has failed to show that the designation PAYCLERK has acquired no additional meaning to consumers of payroll services than the terms "PAY" and "CLERK" have individually. That is to say, although the terms "PAY" and "CLERK" may be generic for, respectively, giving and receiving payments and a person who works in an office keeping records, correspondence and filing, the record

falls short of establishing that the compound word PAYCLERK, comprised of those individual terms, is generic. This is not a case where the Office has clearly proven that the designation as a whole is no less generic than its constituents. While PAYCLERK may be an apt name for a person who works in an office performing various recordkeeping, filing and correspondence tasks that may include payroll services, the evidence does not show that it is used as a generic name for such services.

We find, based on the limited evidence of record, that the Office has not met its burden of establishing by clear evidence that the designation PAYCLERK, as a whole, is generic for the identified services. *See In re Merrill Lynch, supra*. Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we have concerns here about the genericness of applicant's designation, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or our own subjective opinions. Any doubts raised by the lack of evidence must be resolved in applicant's favor. *Id.* Further, on a different and more complete record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at

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a different result on the issue of genericness.

Decision: The refusal of registration on the Supplemental Register, under Section 23 of the Trademark Act, is reversed.