

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: April 5, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Duane Rainville Demers

Serial No. 76664409

Duane Rainville Demers appearing *pro se*.

Jenny Park, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Bucher, Cataldo, and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Duane Rainville Demers ("applicant") filed an application to register the mark ORPHAN'S FUND FOUNDATION in standard character format for "wildflowers - an educational fund for higher education" in International Class 36.¹

The Trademark Examining Attorney refused registration of applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of applicant's identified services. Registration was also refused in light of applicant's failure to comply with

¹ Serial No. 76664409, filed August 9, 2006, pursuant to Section 1(b).

the examining attorney's requirement to amend the recitation of services.

Upon final refusal of registration, applicant filed a timely appeal and request for reconsideration. Both applicant and the examining attorney filed briefs.² For the reasons discussed herein, the Board affirms the refusal to register and requirement to amend the recitation of services.

I. *Examining Attorney's Objection - Applicant's Claim of Acquired Distinctiveness*

Before addressing the merits of the appeal, we will consider the examining attorney's objection raised in her brief. The examining attorney objects to applicant's assertion of a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f) in his brief for the first time. The objection is sustained. In addition to being untimely, such a claim is impermissible for an application based on an allegation of a *bona fide* intent to use the mark.

15 U.S.C. § 1052(f); Trademark Rule 2.142(d).

II. *Refusal to Register Under Section 2(e)(1)*

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function,

² As noted in the Board's October 26, 2011 order, in light of applicant's failure to appear at the oral hearing scheduled upon his request, applicant's right to an oral hearing is deemed waived.

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ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). 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 the 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 at 593.

We find that applicant's mark is a phrase which immediately conveys to prospective purchasers a significant feature of the identified services, namely that applicant's services consist of a foundation whose purpose is to provide funds for children without parents.

Multiple definitions of the terms "orphan," "fund," and "foundation" have been made of record:

orphan 1. a child without parents: a child whose parents are both dead or has been abandoned by his or her parents, especially a child not adopted by another family. *encarta.msn.com.*

orphan 1a. a child whose parents are dead. **1b.** a child who has been deprived of parental care and who has not been adopted. *www.bartleby.com.*

fund 2. a reserve of money: a sum of money saved or invested for a particular purpose. *encarta.msn.com.*

fund 2a. a sum of money or other resources set aside for a specific purpose. *www.bartleby.com.*

foundation 5. charitable or educational organization: an organization that has been formally set up with an endowment fund, e.g. a school, research establishment, charitable trust, or hospital. **6. fund supporting institution:** an endowment fund that supports an institution. *encarta.msn.com.*

foundation 3a. Funds for the perpetual support of an institution; an endowment. *www.bartleby.com.*

As shown by the above dictionary definitions, the possessive form of the word "orphan" in applicant's mark immediately conveys to prospective consumers the intended recipients or beneficiaries of applicant's services; the word "fund" as used in the mark refers to the monetary resources that applicant provides for the purposes of paying for educational services on behalf of children without parents; and the term "foundation" by definition refers to an institution providing endowment funds. When used together as a phrase, applicant's

mark immediately identifies a foundation designed to provide funding to finance the education of orphans.

In addition, the evidence obtained by the examining attorney from third-party websites shows that the term "orphan's fund" is used by others to identify charitable endowment funds established for orphans. See e.g., printout from www.orphansfund.org showing use of brand name ORPHAN'S FUND to identify charitable fundraising services for the benefit of orphans. Denial of Request for Reconsideration, February 15, 2010. Such evidence is consistent with a finding that applicant's mark is merely descriptive.³

To further support the descriptive nature of the term "foundation" as used in relation to applicant's identified services, the examining attorney made of record the following use-based third-party registrations with a disclaimer of the term FOUNDATION for the same or similar services:

Registration No. 3106067 for the mark THE ROGER EDENS FOUNDATION for "charitable fundraising and providing grants to individuals and organizations in the fields of stem cell research and the art of writing special material, namely songs and sketches specifically written for the purpose of charitable fundraising."

³ We hasten to add though that as part of its burden of proof, the Office is not required to show competitor need. See *In re BetaBattInc.*, 89 USPQ2d 1152, 1156 (TTAB 2008); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

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Registration No. 3040912 for the mark CENTRAL VALLEY FOUNDATION for "accepting and administering monetary charitable contributions."

Registration No. 2995352 for the mark UNITED HEALTH FOUNDATION for various services including, "charitable services, namely, providing grants, contributions and other funding, support and information to non-profit organizations, medical and clinical research facilities, physicians and other health professionals, community leaders, community organizations and individuals in the fields of health and well-being."

Registration No. 3035547 for the mark THE JELD-WEN FOUNDATION for "providing grants to organizations involved in social welfare activities, educational activities, healthcare activities, youth activities, arts and cultural activities, and/or free-market and free-enterprise oriented activities; providing college scholarships; administering monetary charitable contributions."

Registration No. 3085315 for the mark BURGER KING/McLAMORE FOUNDATION & design for "providing charitable fundraising and scholarship services."

Registration No. 3679817 for the mark WILLIAM & EVA FOX FOUNDATION & design for "providing grants to actors and not-for-profit charitable organizations to promote study, research, and training in the field of acting and to encourage participation by actors and potential audiences in non-commercial theater."

Registration No. 3565932 for the mark THE JOHN RITTER FOUNDATION FOR AORTIC HEALTH for various services, including "charitable fundraising; accepting and administering monetary charitable contributions; charitable fundraising services for aortic health research and education."

Registration No. 3253329 for the mark PITT MEMORIAL HOSPITAL FOUNDATION & design for "charitable fund raising services, namely, for the support of medical care for hospital patients, hospital facilities and equipment."

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Registration No. 3703647 for the mark MOTHERLESS CHILD FOUNDATION for "charitable fundraising for orphans and orphanages; charitable services, namely, providing financial assistance and tuition assistance, to orphans and orphanages."

Registration No. 3324307 for the mark LANCE ARMSTRONG FOUNDATION for various services, including "charitable fundraising services; providing research grants to organization in the fields of public health, cancer, cancer recovery and survival."

Registration No. 3242130 for the mark MAKE A DIFFERENCE FOUNDATION for "charitable fund raising."

Third-party registrations featuring the same or similar services as applicant's services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. See *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

As accurately noted by the examining attorney, applicant devotes much of his brief explaining the inspiration and purpose of his proposed mark. Such a discussion is relevant only to the extent it pertains to whether applicant's mark is merely descriptive. In addition, we agree with the examining attorney

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that the cases cited by applicant in his brief are inapposite and fail to support his position.

In sum, we find that the examining attorney has met her burden of proof that applicant's mark is merely descriptive of the recited services.

III. *Amendment to Recitation of services*

The Trademark Act requires that a trademark or service mark application must include a "specification of ... the goods [or services]" in connection with which the mark is being used or will be used. 15 U.S.C. § 1051(a)(2); 15 U.S.C. § 1051(b)(2); Trademark Rule 2.32(a)(6). This requirement for a specification of the particular goods and/or services applies to applications filed under all statutory bases. See 15 U.S.C. §§ 1051(a)(2), 1051(b)(2), 1053, 1126(d)-(e), 1141f; 37 C.F.R. § 2.32(a)(6). The identification of goods and/or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (CCPA 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966). The Office has discretion to require a degree of particularity necessary to

identify clearly services covered by a mark. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007).

In the present case, applicant seeks registration of his proposed mark for "wildflower – educational fund for higher education." As argued by the examining attorney,⁴ the recitation is deficient for several reasons: because of the overly broad wording, it fails to identify all the services with sufficient particularity in order to determine the correct classification; the term "wildflowers" is ambiguous within the context of the recitation as currently stated and appears to be "unnecessary"; and the recitation does not indicate what specific services are provided in connection with "educational fund" and as such is overly broad.

We find for the reasons stated above by the examining attorney that she properly exercised her discretion in issuing a final requirement to amend the recitation of services.

Decision: The refusal to register under Section 2(e)(1) and the requirement to amend the recitation of services are affirmed.

⁴ Applicant did not address this issue in his appeal brief.