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Subject: U.S. TRADEMARK APPLICATION NO. 76664409 - ORPHAN'S FUND  
FOUNDATION - N/A

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76664409

**MARK:** ORPHAN'S FUND FOUNDATION



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**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**  
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** DEMERS, DUANE RAINVILLE

**CORRESPONDENT'S REFERENCE/DOCKET NO:**  
N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark "ORPHAN'S FUND FOUNDATION" on the grounds that it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1).

**I. FACTS**

Applicant applied for registration on the Principal Register of the proposed mark "ORPHAN'S FUND FOUNDATION" for "WILDFLOWERS-- AN EDUCATIONAL FUND FOR HIGHER EDUCATION." On January 12, 2007, registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), because the

proposed mark was merely descriptive of the services. In addition, the examining attorney found that the recitation of services was unacceptable as indefinite because it failed to identify all of the services specifically enough for the Office to classify them and because it also included the unnecessary and indefinite wording “wildflowers.”

Applicant failed to respond to the initial action and therefore, the application abandoned. Following the abandonment of the application, applicant submitted its correspondence dated November 6, 2007. The correspondence was resubmitted on November 16, 2007. In its response, applicant requested to revive the abandoned application, presented arguments against the merely descriptiveness refusal and explained the nature of its services.

On November 30, 2009, the petition to revive the abandoned application was granted. On December 3, 2009, the examining attorney issued a final action as to the descriptiveness refusal and the requirement for a definite recitation of services. On January 13, 2010, applicant further argued against the refusal under Section 2(e)(1) in a Request for Reconsideration.

This appeal, filed May 10, 2010, follows the examining attorney’s denial of the Request for Reconsideration regarding the Section 2(e)(1) refusal and the requirement to amend the recitation of services.

## II. OBJECTION

Applicant attempts to claim acquired distinctiveness of the proposed mark under Section 2(f) for the first time in its brief. The examining attorney respectfully requests that the Board not consider applicant's Section 2(f) claim as the claim is untimely. 37 C.F.R. Section 2.142(d).

### III. ARGUMENTS

#### A. DESCRIPTIVENESS

THE PROPOSED MARK, "ORPHAN'S FUND FOUNDATION" FOR WILDFLOWERS- AN EDUCATIONAL FUND FOR HIGHER EDUCATION" IS MERELY DECSRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(e)(1).

The proposed mark "ORPHAN'S FUND FOUNDATION" is descriptive of applicant's services for "AN EDUCATIONAL FUND FOR HIGHER EDUCATION" because the mark immediately describes a characteristic or purpose of applicant's services.

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified services. *See In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005). The determination of whether

a mark is merely descriptive is considered in relation to the identified services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b).

Here, the term “orphan” means “a child without parents.” The term “fund” refers to “reserve of money.” The term “foundation” means “fund supporting institution.” See dictionary definitions attached with Office actions dated January 12, 2007 and December 3, 2009. All together it means an institution providing funds for children without parents.

As applicant states in its correspondence of November 6, 2007, “its mission is to support indigenous orphans who lack support, and enroll them in school obtain higher education.” As such, the proposed term “orphan’s” in the mark merely describes the intended recipients or beneficiaries of applicant’s services. As evidenced by the recitation of services, applicant provides an educational fund. Thus, the wording “fund” as used in the mark is merely descriptive of the monetary resources that applicant provides for the purposes of paying for educational services on behalf of children without parents. The term “foundation” by definition refers to an institution providing funds and therefore, the wording when used in connection with applicant’s educational fund services merely describes the fact that applicant is a foundation or an institution providing funds. As demonstrated, the individual components in the proposed mark are merely descriptive of the key characteristic of applicant’s services.

Moreover, a mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services). Such a mark is registrable only if the composite creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the services. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968).

In this case, both the individual components and the composite result are merely descriptive of applicant's services and do not create a unique, incongruous or nondescriptive meaning in relation to the services. Specifically, the combined wording "ORPHAN'S FUND FOUNDATION" immediately conveys that applicant is a foundation that provides funds for orphans, and it does not create a unique, incongruous or nondescriptive meaning in connection with applicant's education fund services. Accordingly, consumers when encountered with applicant's mark will immediately know that applicant is a foundation that provides funds for orphans.

In its brief, applicant writes extensively about the mission of and the inspiration behind "ORPHAN'S FUND FOUNDATION," seemingly to sway the Office that the mark should be acceptable because it is for such a worthy cause. While the cause is indeed noble, such discussion is relevant only for the purpose of determining whether the

proposed mark “ORPHAN’S FUND FOUNDATION,” when used in connection with applicant’s educational fund services, immediately conveys a characteristic or purpose of applicant’s services. In this case, the proposed mark clearly describes a characteristic or purpose of applicant’s services and this is overwhelmingly supported by the applicant’s discussion of its mission. .

Moreover, in support for registration of its mark, applicant cited 33 cases. All of the cases cited in the brief relate to trademark infringement, unfair competition, and/or secondary meaning based on acquired distinctiveness under Section 2(f) of the Trademark Act. These cases are not applicable in the present case as none of the cases support the registrability of this proposed mark under Section 2(e)(1) of the Trademark Act.

#### Evidence of Record

To support the finding that the proposed mark is merely descriptive, the examining attorney submitted evidence consisting of dictionary definitions, webpage excerpts showing descriptive use of the proposed wording “orphan’s fund,” and third party registrations in which the wording “foundation” is disclaimed in the context of charitable fund related services. The evidence of record clearly supports that upon encountering the proposed mark, consumers will immediately know the intended purpose of applicant’s services.

a. "Orphan's Fund"

The evidence of record consists of internet webpage excerpts showing descriptive use of the terms "orphan's fund" in connection with raising or establishing funds to support orphans.

1. A screenshot of a webpage for the Adams County Sheriff's Office states the purpose of the Sheriff's Office Employee's Orphan's Fund as providing assistance for descendants of those members who died while actively employed by the Sheriff's Office or were in a retired status from the Office. See page 2 of the Outgoing action dated February 15, 2010.

2. A screenshot of a blog for Hagen's Travel & Cruises discusses how it has teamed up with an organization to help raise money for the organization's orphan's fund. See pages 3-4 of the Outgoing action dated February 15, 2010.

3. A screenshot of a webpage discusses how the Universal Ethician Church has established the orphan's fund in order to bring hope and light into the lives of those children who do not have mothers or fathers. See pages 36-37 of the Outgoing action dated February 15, 2010.

4. A screenshot of a webpage for the Washington State Fire Fighters' Association discusses its spouse and orphan's fund as a private death benefit fund. See pages 38-39 of the Outgoing action dated February 15, 2010.

5. A web article by B Net dated February 7, 2002 discusses raising money to benefit the Twin Tower Orphan's fund. See pages 40-42 of the Outgoing action dated February 15, 2010.

6. A screenshot of a blog discusses how the NHLPA (NHL Players Association) is suing the NHL over the death benefit for players with NHL service and calling the death benefit fund as the widow's and orphan's fund. See pages 44-50 of the Outgoing action dated February 15, 2010.

These webpage excerpts of record show descriptive use of the term "orphan's fund" in connection with fundraising services or funds established for the benefits orphans. This evidence demonstrates that the wording "orphan's fund" is commonly used and recognized as a charitable fund that benefits orphans.

b. "Foundation"

The following is a list of third party registrations with the wording "foundation" disclaimed in the context of charitable fund related services. 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, 1564-65, 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).

The third party registrations of record are merely a sample of many other registrations in which the term “foundation” is disclaimed in the context of charitable fund related services. These registrations demonstrate that the wording “foundation” is considered descriptive by the Office when used in connection with charitable related services.

1. U.S. Registration No. 3106067: “The Roger Edens Foundation” with “Foundation” disclaimed 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.”

See pages 5-7 of the Outgoing action dated February 15, 2010.

2. U.S. Registration No. 3040912: “Central Valley Foundation” with “Foundation” disclaimed for “accepting and administering monetary charitable contributions.” See pages 8-10 of the Outgoing action dated February 15, 2010.

3. U.S. Registration No. 2995352: “United Health Foundation” with “Foundation” disclaimed 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 field of health and well-being.” See pages 11-13 of the Outgoing action dated February 15, 2010.

4. U.S. Registration No. 3035547: “The Jeld-Wen Foundation” with “Foundation” disclaimed 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.” See pages 14-16 of the Outgoing action dated February 15, 2010.

5. U.S. Registration No. 3085315: “Burger King/McLamore Foundation” with “Foundation” disclaimed for “providing charitable fundraising and scholarship services.” See pages 17-19 of the Outgoing action dated February 15, 2010.

6. U.S. Registration No. 3679817: “William & Eva Fox Foundation” with “Foundation” disclaimed 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.” See pages 20-22 of the Outgoing action dated February 15, 2010.

7. U.S. Registration No. 3565932: “The John Ritter Foundation for Aortic Health” with “Foundation” disclaimed for “charitable fundraising; accepting and administering monetary charitable contributions; charitable fundraising services for aortic health research and education,” among other services. See pages 23-25 of the Outgoing action dated February 15, 2010.

8. U.S. Registration No. 3253329: “Pitt Memorial Hospital Foundation” with “Foundation” disclaimed for “charitable fund raising services, namely, for the support of medical care for hospital patients, hospital facilities and equipment.” See pages 26-27 of the Outgoing action dated February 15, 2010.

9. U.S. Registration No. 3703647: “Motherless Child Foundation” with “Foundation” disclaimed for “charitable fundraising for orphans and orphanages; charitable services, namely, providing financial assistance and tuition assistance, to orphans and orphanages.” See pages 28-30 of the Outgoing action dated February 15, 2010.

10. U.S. Registration No. 3324307: “Lance Armstrong Foundation” with “Foundation” disclaimed for “charitable fundraising services; providing research grants to organization in the fields of public health, cancer, cancer recovery and survival” among other services.. See pages 31-33 of the Outgoing action dated February 15, 2010.

11. U.S. Registration No. 3242130: “Make a Difference Foundation” with “Foundation” disclaimed for “charitable fund raising.” See pages 34-35 of the Outgoing action dated February 15, 2010.

As demonstrated by the evidence of record, the proposed mark “ORPHAN’S FUND FOUNDATION” immediately describes a foundation that supports or establishes a charitable fund for orphans. Because the proposed mark immediately conveys a characteristic or purpose of applicant’s services, and applicant failed to show any evidence supporting that the proposed mark creates a unique, non-descriptive meaning which is entitled to protection, the proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act.

In light of the evidence of record in this case, the examining attorney submits that consumers who encounter applicant’s mark in commerce in the context of the identified services would immediately perceive the wording to describe a characteristic or purpose of applicant’s services.

#### B. The Recitation of Services

THE RECITATION OF SERVICES IS UNACCEPTABLE AS INDEFINITE

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) (emphasis added), (b)(2) (emphasis added); *see* 15 U.S.C. §1053. Specifically, a complete application must include a “list of the **particular** goods or services on or in connection with which applicant uses or intends to use the mark.” 37 C.F.R. §2.32(a)(6) (emphasis added). 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); TMEP §§1402.01, 1402.01(c).

The Office requires a degree of particularity necessary to identify clearly services covered by a mark. *See In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007). Descriptions of goods and services in applications must be specific, explicit, clear and concise. TMEP §1402.01; *see In re Cardinal Labs., Inc.*, 149 USPQ 709, 711 (TTAB 1966).

In the present case, applicant seeks registration of its proposed mark for “wildflower—educational fund for higher education.” Applicant’s responses failed to address the requirement to amend the recitation of services. Moreover, applicant’s brief does not address the requirement to amend the recitation of services.

Applicant’s recitation of services is unacceptable because it fails to identify all of the services specifically enough for the Office to classify them. *See* TMEP §1402.01. Further, the wording “wildflowers” is unnecessary as it does not specify the particular services upon which applicant intends to use the mark. Additionally, the recitation of

services as written does not indicate what specific services are provided in connection with “educational fund.” The services involving “educational fund” could include “charitable fundraising,” or “granting funds to schools.” As such, the recitation of services as written is overly broad.

On appeal, applicant did not amend the recitation of services or present arguments that the recitation of services as written is definite. Because applicant’s recitation does not indicate the particular services specifically enough for the Office to classify them and it includes unnecessary wording, applicant’s services as written is unacceptable as indefinite. Accordingly, the examining attorney properly exercised her discretion in issuing a final requirement to amend the recitation of services.

#### IV. CONCLUSION

For the foregoing reasons, the examining attorney respectfully request that the refusal to registration under Section 2(e)(1) of the Trademark act, 15 U.S.C Section 1052(e)(1) and the requirement to amend the recitation of services be affirmed.

Respectfully submitted,

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