

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

Mailed:
March 23, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Joshua David Mellberg, LLC

Serial No. 76717806

David G. Bray of Dickinson Wright PLLC,
for Joshua David Mellberg, LLC.

Thomas Young, Trademark Examining Attorney, Law Office 120
David Miller, Managing Attorney.

Before Quinn, Ritchie, and Kuczma, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Joshua David Mellberg, LLC (“Applicant”) filed an application to register on the Principal Register the mark SOCIAL SECURITY ANNUITY, in standard character format, for services ultimately identified as “financial planning and retirement financial planning services,” in International Class

36.¹ The application disclaims the exclusive right to use the term “SOCIAL SECURITY” apart from the mark as shown.

The Trademark Examining Attorney refused registration on the ground that the applied-for mark is merely descriptive of the services pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, Applicant filed this appeal, which is fully briefed. For the reasons discussed below, we affirm the refusal to register.

Mere Descriptiveness

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 In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); *see also In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). 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

¹ Serial No. 76717806, filed on April 2, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), based on Applicant’s assertion of a bona fide intent to use the mark in commerce.

different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). On the other hand, if a mark requires imagination, thought and perception to ascertain the nature of the goods or services, then the mark is suggestive. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (citing *In re Abcor Dev. Corp.* 200 USPQ 215).

A composite of descriptive terms is registrable only if it has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products). The Examining Attorney argues that the applied-for mark SOCIAL SECURITY ANNUITY is descriptive because it:

merely describes a characteristic or feature of applicant’s services namely, that applicant’s financial planning and retirement financial planning services feature information and advice on Social Security benefits and annuities, including how

to optimize the value of one's fixed payments received from Social Security.²

Applicant argues, by contrast, that it would take a “mental leap” for consumers to determine that SOCIAL SECURITY ANNUITY “represents the combination of both social security benefits and annuity strategies.”³ In particular, Applicant argues that it provides “insurance and investments intended to coordinate with guaranteed Social Security Benefits that retirement income needs are met.”⁴ Applicant further elaborates that it “provides a service intended to seamlessly combine social security benefits and annuity strategies, two concepts that are not naturally associated together.”⁵ The Examining Attorney submitted the following definitions of “annuity,” in relevant part:

annuity: 2. A contract or agreement by which one receives fixed payments on an investment for a lifetime or for a specified number of years.⁶

annuity: 1.1 A form of insurance or investment entitling the investor to a series of annual sums.⁷

The Examining Attorney submitted two third-party web pages that refer to the concept of Social Security as being an “annuity” program (emphasis added):

² 6 TTABVUE 3-4.

³ 4 TTABVUE 8.

⁴ 4 TTABVUE 6.

⁵ 11 TTABVUE 2.

⁶ Ahdictionary.com. Attached to July 14, 2015 Office Action at 9.

⁷ Oxforddictionaries.com/us. Attached to January 28, 2016 Office Action, at 6.

The Wall Street Journal: An **Annuity** Plan Called **Social Security**: Deferring Benefits Can Yield a Significant Advantage: By Carolyn T. Geer; September 29, 2013; Know how to get a great deal on an annuity today? Tap your 401(k) or IRA for living expenses in your first few years of retirement so you can postpone taking Social Security. . . .But for every year you defer past that, up to age 70, your Social Security benefits will rise by 6% to 8%. Those are real, inflation-adjusted rates of return, guaranteed by the U.S. government. Where else can you get a return like that these day with real interest rates close to zero?

“Right now the government is offering the best deal in town on an inflation-adjusted annuity,” says Chris Jones, chief investment officer at Financial Engines, an advisory firm that helps people manage their 401(k) and IRA assets. *Wsj.com*.⁸

Center for Retirement Research at Boston College: Should you Buy an **Annuity** from **Social Security**?: By Steven A. Sass; May 2012; Households now retiring need to transform their 401(k) and IRA savings into retirement income. One way is to delay claiming Social Security to increase their monthly benefit, using savings to pay current expenses while they wait. In effect, they are buying an **annuity** from **Social Security**. The savings used is the “price” and the increase in their monthly benefit the annuity income it “buys.” [sic] Buying an **annuity** from **Social Security** is generally the best deal in town, especially in today’s low interest-rate environment. <http://crr.bc.edu>.⁹

The Examining Attorney submitted seven other third-party web pages that refer to this concept specifically using the exact term “SOCIAL SECURITY ANNUITY” (emphasis added):

GF The GailFosler Group LLC: **Social Security Annuity**: A Great Investment Deal: Although Social Security taxes are inadequate to pay for all promised benefits, substantial benefits will still be possible no matter what type of reform is undertaken. . . One answer lies partly in a set of little understood provisions deeply imbedded in the current program, which together offer one of the best investment options anywhere. This great deal allows individuals to add to **Social**

⁸ July 14, 2015 Office Action, at 11-12.

⁹ July 14, 2015 Office Action, at 15-16.

Security annuities for which they already qualify at age 62. As classic employer-funded pension plans disappear, this option gets more valuable by the day. . . . Many don't realize that they don't need to start benefits at retirement. By living off other assets for a while, even if only a month or so, they can convert some of their riskier assets into a higher Social Security annuity asset. *Gailfosier.com*.¹⁰

Social Security Choices: How Valuable is Your Social Security?: If you are a married couple and you both have earned Social Security benefits, look at *Your Social Security Statements* you receive each year. Many retirement advisors recommend that you should spend no more than 4% of your retirement savings each year to protect yourself against future inflation. If we use this as a guideline, then a **Social Security annuity** that pays you and your spouse \$3500 a month or \$42,000 a year will actually pay you more than you should be spending out of savings of more than \$1 million. *Socialsecuritychoices.com*.¹¹

RAND Labor and Population: Project: Valuing the **Social Security Annuity**: Background: Currently, few Americans opt to annuitize their Social Security payments. A better understanding of individuals' preference for annuitization will inform the debate on Social Security reform. Overview: The Financial Literacy Center is evaluating to what extent individuals value having Social Security payouts in the form of annuities versus lump-sum amounts. *Rand.org*.¹²

The Briarwood Community: Create Your Own **Social Security "Annuity"**: Posted August 9, 2012; Many retirees hope to use their hard-earned money as a source of income. . . . When interest rates are low, this path is especially appealing because the 7% to 8% guaranteed Social Security income increase (calculated by waiting) surpasses the nominal rates currently realized on savings accounts. . . . What does any of this have to do with *annuities*? Well, in simple terms, an annuity is something you **buy** to generate a **monthly income**. By delaying Social Security, you're essentially "buying" a higher payout by the mere act of waiting. Naturally, this road is right for some people but not for others. *Briarwoodretirement.com*.¹³

¹⁰ July 14, 2015 Office Action at 22-24.

¹¹ July 14, 2015 Office Action at 27.

¹² July 14, 2015 Office Action at 29.

¹³ January 28, 2016 Final Office Action at 31-32.

WealthManagement.com: Who's Got the Best Annuity Deal in Town?: It may surprise you, but "buying" **Social Security's annuity** by delaying withdrawals and living on other assets best enhances overall retirement income. By Mark Miller; June 7, 2012 . . . The CRR brief was written by Steven Sass, program director of the center's Financial Security Project. He concluded that traditional retirement income strategies – preserving principal and living on the interest, or investing in stocks and bonds and drawing out a portion as income – both fell short when compared with a **Social Security annuity**.¹⁴

Lifelong Retirement Corp: The difference between the benefit amount you will receive at full retirement age and age 70 is significant. It is for this reason, combined with the fact that Social Security:

- is guaranteed
- receives special tax treatment
- includes COLAs (Cost of Living Adjustments)

that many choose to draw down on their retirement assets rather than claiming their benefits at full retirement age. This strategy, coined "buying a **social security annuity**" is becoming a popular strategy given the uncertainty of the markets and the increasingly difficult challenge of protecting purchasing power in retirement. *Lifelongretirementcorp.com*¹⁵

Pension Rights Center: Background: Social Security already offers a great annuity option to retirees. . . . A worker can almost double annual **Social Security annuity** benefits. *Pensionrights.org*.¹⁶

From this evidence, it is apparent that Social Security has indeed been

¹⁴ January 28, 2016 Final Office Action at 34-35.

¹⁵ January 28, 2016 Final Office Action at 38-39.

¹⁶ January 28, 2016 Final Office Action at 43.

interpreted as a type of “annuity” program to the extent that it constitutes, in accordance with the American Heritage Dictionary definition of “annuity,” fixed payments on a prior investment of funds. Furthermore, to the extent that consumers would interpret the term “SOCIAL SECURITY ANNUITY” as not a unitary mark, but as referring to financial planning and retirement financial planning services that include *both* “Social Security” *and* “annuity” discussions, the term is also merely descriptive. In this regard, we note that despite Applicant’s arguments on brief, we must consider the mark in relation to the services, and not in a vacuum. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). There is nothing incongruous about the combination of SOCIAL SECURITY SERVICES in relation to Applicant’s applied-for services.

Based on the plain meaning of the term as a whole as well as the third-party evidence and Applicant’s own statements, we find that Applicant’s composite term “SOCIAL SECURITY ANNUITY,” when viewed in relation to Applicant’s services, immediately conveys that Applicant’s financial planning and retirement financial planning services may include discussions of both Social Security and annuity programs, as well as, specifically, Social Security as a type of annuity program. While doubt is resolved for Applicant, we have no doubt that consumers require no imagination, thought or perception to arrive at this conclusion. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1755. Therefore, we find that the mark is

Ser. No. 76717806

merely descriptive of the identified services, and we affirm the refusal to register.

Decision: The Board affirms the refusal to register.