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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76717807
Applicant	JOSHUA DAVID MELLBERG, LLC
Applied for Mark	SOCIAL SECURITY / ANNUITY STRATEGIES
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7 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
8 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

9 Applicant: JOSHUA DAVID MELLBERG,
10 LLC

11 Mark: SOCIAL SECURITY/
12 ANNUITY STRATEGIES

13 Serial No.: 76/717807

14 Filing Date: APRIL 14, 2015
15

APPLICANT'S MAIN BRIEF ON APPEAL

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17 **I.**

18 **Procedural History**

19 Applicant Joshua David Mellberg, LLC ("JDM") has applied for the mark "SOCIAL
20 SECURITY / ANNUITY STRATEGIES" for "Financial Planning and Financial Retirement Planning
21 Services." On January 29, 2016, the Examining attorney issued an Office Action in which he issued his
22 final refusal to register Applicant's mark under Trademark Act Section 2(e), 15 U.S.C. § 1052(e)(1).
23 The sole basis of the Examiner's Final Refusal was his contention that Applicant's mark was
24 descriptive. Applicant is appealing that final refusal.
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II.

Argument:

The Examining Attorney Erred When He Concluded that Applicant's "SOCIAL SECURITY / ANNUITY STRATEGIES" Mark is Merely Descriptive.

The Examining Attorney erred when he denied registration of Applicant's mark based on his legal conclusion that the SOCIAL SECURITY / ANNUITY STRATEGIES mark is merely descriptive of the services for which registration of the mark is sought, namely a unique financial and retirement planning product or service that combines the benefits of a guaranteed annuity with Social Security benefits. Instead, the SOCIAL SECURITY / ANNUITY STRATEGIES mark is at best suggestive as applied to that service or product because thought and imagination are needed to conjure up the nature of that product or service.

"The determination of whether a mark is merely descriptive is a question of fact." *DuoPross Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012). The burden is on the party challenging the registration's validity to prove "that the mark is merely descriptive by a preponderance of the evidence." *Id.* A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it *immediately* conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. *See In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987) (emphasis added). "Whether a particular mark is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace." *See DuoProSS Meditech Corp.*, 695 F.3d 1247 (Fed. Cir. 2012). "[T]he suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment [and any] doubts are to be resolved in favor of applicants." *In Re Shutts*, 217 U.S.P.Q. (BNA) ¶ 363 (P.T.O. Feb. 25, 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool).

1 The Examining attorney cites to *Phoseon Tech.* for the proposition that if individual components
2 maintain their descriptive nature as a composite, then the mark is merely descriptive. However, in
3 *Phoseon*, the TTAB also noted that “[w]hen two or more merely descriptive terms are combined, the
4 determination of whether the composite also has a merely descriptive significance turns on the question
5 of whether the combination of terms evokes a new and unique commercial impression.” *In Re Phoseon*
6 *Tech. Inc.*, 103 U.S.P.Q.2d 1822 (P.T.O. Aug. 23, 2012). “Common words may be descriptive when
7 standing alone, but when used together in a composite mark, they may become a valid trademark.”
8 *Id.* In *Phoseon*, the TTAB found that the words in the “mark SEMICONDUCTOR LIGHT
9 MATRIX retain their dictionary meanings when used by applicant; and the proposed mark in its
10 entirety is merely descriptive, because as the words are combined they do not create a meaning
11 different from the individual elements.” *Id.* The TTAB also found that Applicant’s argument that
12 “any attempts to make sense of Applicant’s mark requires a complex, multistage mental process . . .
13 fail[ed] because the record is clear that the Applicant’s light curing system is a ‘matrix’ of light
14 emitting elements [semiconductor light].” *Id.* Here, unlike in *Phoseon*, there is a multistage mental
15 process that a consumer must take from seeing the mark SOCIAL SECURITY / ANNUITY
16 STRATEGIES and arriving at the services that Applicant offers, namely financial planning and
17 financial retirement planning services.

18 SOCIAL SECURITY / ANNUITY STRATEGIES is more like the mark SUGAR & SPICE
19 registered for bakery goods, which was found suggestive, not descriptive. *In re Colonial Stores, Inc.*,
20 394 F.2d 549, 552, 157 USPQ 382, 384 (C.C.P.A. 1968). In *Colonial*, the court noted “the usual
21 practice of selling baked goods in stores which also sell sugar and spices as individual commodities.”
22 *Id.* The court also found that the “terms ‘sugar’ and ‘spice’ used individually are well known and well
23 understood by the purchasing public.” *Id.* “However, when combined and used on bakery goods, []
24 they may function as an indication of more than a mere description of the ingredients of the goods on
25 which the mark is used.” *Id.* Here, the SOCIAL SECURITY / ANNUITY STRATEGIES mark, like
26 SUGAR & SPICE, is more than a mere description of the services that Applicant provides. As in
27 *Colonial*, although SOCIAL SECURITY and ANNUITY are well known by consumers, when they are

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1 combined they do not immediately convey to consumers that financial planning and retirement financial
2 planning services are being provided by Applicant.

3 A mark is suggestive, and therefore registerable, if imagination, thought or perception is required
4 to reach a conclusion on the nature of the goods or services. “[I]f one must exercise mature thought or
5 follow a multi-stage reasoning process in order to determine what product or service characteristics the
6 term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*,
7 199 USPQ 496, 497 (TTAB 1978). “If the mental leap between the word and the product’s attribute is
8 not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” *Self-
9 Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995)
10 (citing 1 McCarthy § 11.21 at 11-108, 109). If a consumer must use imagination or any type of
11 multistage reasoning to understand the mark's significance, then the mark does not describe the product's
12 features, but suggests them. *Kendall-Jackson Winery v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n. 8
13 (9th Cir.1998); *see also Innovation Ventures, LLC v. N.V.E., Inc.*, 694 F.3d 723, 730 (6th Cir. 2012)
14 (holding that 5-hour Energy mark was suggestive because “[t]he connection between ‘5-hour’ and
15 ‘Energy’ is not so obvious that a consumer seeing [5-hour Energy] in isolation would know that the term
16 refers to an energy shot rather than, for example, a batter for electronics, an exercise program, a backup
17 generator, or a snack for endurance sports” (internal quotation omitted)).

18 If a mark, without more, does not imply the product or could relate to a number of products, then
19 it is suggestive. *See, e.g., BIC Corp. v. Far E. Source Corp.*, No. 99 CIV. 11385 HB, 2000 WL
20 1855116, at *3 (S.D.N.Y. Dec. 19, 2000), *aff'd*, 23 F. App'x 36 (2d Cir. 2001) (holding that WITE-
21 OUT, although logically related to its use as a corrective product, does not without more imply a
22 correction product); *Playtex Prod., Inc. v. Georgia-Pac. Corp.*, 390 F.3d 158, 164 (2d Cir. 2004),
23 *superseded by statute on other grounds as recognized in Starbucks Corp. v. Wolfe's Borough Coffee,*
24 *Inc.*, 588F.3d 97, 108 (2d Cir. 2004) (finding that the term “Wet Ones” was not merely descriptive
25 because it “without more, does not conjure up the image of a towelette . . . [and] could plausibly
26 describe a wide variety of products” (internal citation omitted)). Here, SOCIAL SECURITY /
27 ANNUITY STRATEGIES does not without more imply the service for with Applicant seeks
28 registration. The Examining attorney suggests that the wording “social security / annuity strategies”

1 is a phrase used by financial planners “in connection with an investment technique whereby retirees
2 can increase guaranteed income payments in retirement by delaying withdrawals.” In fact, SOCIAL
3 SECURITY / ANNUITY STRATEGIES, could imply a number of services or products and would
4 not automatically suggest to the consumer the unique use of social security benefits in a financial
5 planning service.

6 Again, suggestive marks are those that, when applied to the goods or services at issue, require
7 imagination, thought, or perception to reach a conclusion as to the nature of those goods or services.
8 Thus, a suggestive term differs from a descriptive term, which immediately tells something about the
9 goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for
10 frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a
11 desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In*
12 *re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant
13 deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the
14 purpose of an anti-perspirant and deodorant for the feet would be described).

15 In this case, the product or service subject to the SOCIAL SECURITY / ANNUITY
16 STRATEGIES mark is financial planning and retirement financial planning services. Applicant’s
17 services include providing advice on insurance and investments intended to coordinate with guaranteed
18 Social Security Benefits so that retirement income needs are met. Those unique services are not
19 immediately conveyed by the mark SOCIAL SECURITY / ANNUITY STRATEGIES. As in
20 *Innovation Ventures* where the court found that 5-hour Energy was suggestive, here, a consumer seeing
21 the mark SOCIAL SECURITY / ANNUITY STRATEGIES would not know that it represents financial
22 planning and retirement financial planning services. Instead, the mark is suggestive because it “requires
23 a mental leap from the mark to the product.” *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*,
24 174 F.3d 1036, 1058 (9th Cir. 1999). The SOCIAL SECURITY / ANNUITY STRATEGIES mark
25 would not lead an average person to know immediately what type of product or service is being offered.
26 *As it is obviously not possible to annuitize government-provided social security retirement benefits*
27 *which provide a monthly income over the remaining lifetime of a retiree and not a lump sum, consumers*
28 *must make a mental leap as to the goods and services actually provided under this mark.* Although they

1 might *guess* that the service has something to do with financial and retirement planning, they certainly
2 would not be able to determine the unique services being offered. As such, although the term “SOCIAL
3 SECURITY / ANNUITY STRATEGIES” might be suggestive of its purpose—a retirement planning
4 program or product that combines the benefits of insurance and investment products with the benefits of
5 Social Security --it is not immediately apparent what product is at issue or to whom the product is
6 directed.

7 For that reason, SOCIAL SECURITY / ANNUITY STRATEGIES is unlike the mark
8 BREATHABLE MATTRESS which the court denied registration of as descriptive. *See In re King Koil*
9 *Licensing Co.*, 79 U.S.P.Q.2d 1048 (P.T.O. Mar. 2, 2006). In *King Koil*, the court found that the term
10 breathable mattress as a mark for beds and mattresses “is used by purveyors of mattresses or related
11 bedding products precisely because it is likely to be perceived by consumers as indicating that these
12 products are breathable and therefore desirable.” *Id.* The Examining Attorney argued that financial
13 planners use the strategy of “buying a social security annuity.” However, unlike in *King Koil*, here,
14 consumers would not be able to as readily determine that the SOCIAL SECURITY / ANNUITY
15 STRATEGIES mark relates to retirement planning services. Although the Examining attorney cites
16 to financial planners’ use of the term, it is not clear that as in *King Koil* the term is used to
17 immediately convey to consumers the purpose of financial planning services nor the desirableness of
18 the financial planning services.

19 The Examining attorney argues that a “[a] mark may be merely descriptive even if it does not
20 describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*,
21 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (denying registration of patents.com as
22 descriptive of patent tracking service provided by website). However, the cases that the Examining
23 attorney cites for this proposition are factually distinct and inapposite. For instance in *In re the*
24 *Chamber of Commerce of the U.S.*, the Chamber of Commerce of the United States of America
25 attempted to register the mark, NATIONAL CHAMBER, one of the services it was being registered for
26 was “[p]roviding online directory information services featuring information regarding local and state
27 Chambers of Commerce.” 675 F.3d 1297, 1298 (Fed. Cir. 2012). The court found that “this service
28 provides information to identify chambers of commerce nationwide” and, therefore, the mark was

1 descriptive of that service. *Id.* at 1301. As previously submitted, SOCIAL SECURITY / ANNUITY
2 STRATEGIES does not describe all of the applicant's services, but it also requires a mental leap,
3 unlike the NATIONAL CHAMBER mark in *In re the Chamber of Commerce of the U.S.* for the
4 consumer to determine that SOCIAL SECURITY / ANNUITY STRATEGIES represents the
5 combination of both social security benefits and annuity strategies.

6 Not only does the mark SOCIAL SECURITY / ANNUITY STRATEGIES without more not
7 imply Applicant's services of providing financial planning and retirement financial planning
8 services, it would require imagination for a consumer to determine what services and who the
9 services SOCIAL SECURITY / ANNUITY STRATEGIES represents. Therefore, the mark is
10 suggestive, not merely descriptive, of the services that Applicant offers.

11 **III.**

12 **Conclusion**

13 Because there is a mental leap between the concepts of social security benefits and annuity
14 strategies and the fact that this is a service intended to seamlessly combine the benefits of both, SOCIAL
15 SECURITY / ANNUITY STRATEGIES is a suggestive, not merely a descriptive, mark.

16 Applicant therefor requests that the TTAB reverse the Examining Attorney's decision refusing
17 registration and permit Applicant's mark to proceed to publication.

18 RESPECTFULLY SUBMITTED this 27th day of September, 2016.

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20
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