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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 76717807

MARK: SOCIAL SECURITY / ANNUITY



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: JOSHUA DAVID MELLBERG, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Joshua David Mellberg, LLC ("Applicant") has appealed the Trademark Examining Attorney's final refusal to register the applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** in standard characters for "Financial planning and retirement financial planning services" in International Class 36 on the ground that the mark is merely descriptive of the applicant's services under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). It is respectfully requested that the refusal be affirmed.

FACTS

Applicant filed this application on April 2, 2015, applying to register the mark **SOCIAL SECURITY / ANNUITY STRATEGIES** in standard characters for “Financial planning and retirement planning services” in International Class 36 on the Principal Register. The applicant included a statement disclaiming the exclusive right to use the wording “SOCIAL SECURITY” apart from the mark. In the first Office action dated July 14, 2015, registration was refused under Section 2(e)(1) of the Trademark Act on the ground that the mark was merely descriptive of a characteristic and feature of the applicant’s services.

On January 15, 2016, the applicant filed its response, amending its identification of goods to “Financial planning and retirement financial planning services” in International Class 36. On January 28, 2016, the refusal to register the mark under Section 2(e)(1) for being merely descriptive of the applied-for services was maintained and made final.

ISSUE

The sole issue on appeal is whether the mark **SOCIAL SECURITY / ANNUITY STRATEGIES** is merely descriptive of a characteristic, quality, function, feature, purpose, or use of the applicant’s services under Trademark Act Section 2(e)(1).

ARGUMENT

A) The Applied-For Mark is Merely Descriptive of the Identified Services

The applicant has applied to register the mark **SOCIAL SECURITY / ANNUITY STRATEGIES** for “financial planning and retirement financial planning services”. Registration is refused because the applied-for mark merely describes a characteristic or feature of the 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. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Trademark Act Section 2(e)(1) bars registration of an applied-for mark on the Principal Register that merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's services without sufficient proof the mark has acquired distinctiveness. *See* 15 U.S.C. §1052(e)(1). *See, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). A mark is merely descriptive if "it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant's] goods or services." *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b).

The determination of whether a mark is merely descriptive is made in relation to an applicant's services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In the present case, the wording "SOCIAL SECURITY", "ANNUITY", and "STRATEGIES" describe a feature and characteristic of the applicant's services. The Oxford University Press® defines the wording "SOCIAL SECURITY" as "a federal insurance program that provides benefits to retired people and those who are unemployed or disabled". Office Action dated January 18, 2016 ("Final Action") at p. 3. The term "ANNUITY" is defined as "[a] form of insurance or investment entitling the investor to a series of

annual sums”. *Id.* at p. 6. Further, the term “STRATEGY” is defined as “a plan of action or policy designed to achieve a major or overall aim”. *Id.* at 9.

With respect to the “/” symbol, the examining attorney asks the Trademark Trial and Appeal Board to take judicial notice of the following definition from the Oxford University Press®: “an oblique stroke (/) in print or writing, used between alternatives (e.g., and/or), in fractions (e.g., $\frac{3}{4}$), in ratios (e.g., miles/day), or between separate elements of a text.” See attached definition. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 n.18 (TTAB 2015) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); TMEP §710.01(c); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a). Thus, in its entirety, the applied-for mark describes financial planning services that feature plans and strategies regarding Social Security insurance benefits and/or financial products, such as annuities, to provide future income streams.

In the context of financial and retirement planning services, the federal government and commercial businesses, including the applicant’s competitors, use the wording in the applied-for mark to describe financial plans and identify current investment options and potential future income streams for a consumer’s financial future. For example:

- Encore Financial Consulting provides “[c]omprehensive financial planning” services, which includes advice on “maximizing your social security benefits” and potential investments and income streams, such as annuities. Office Action dated July 14, 2015 (“Office Action”) at pp. 7-8.
- Bankrate® provides a website featuring financial advice and information on various topics, including an article entitled “Retirement planning strategies: 50 and beyond”. This article discusses several investment options and idea for creating a financial plan, which include reviewing one’s savings and potential income streams during retirement, such as Social Security. *Id.* at pp. 35-36.

- The Briarwood Community provides a website featuring financial advice with an article entitled “Create Your Own Social Security ‘Annuity’”. Therein, the article describes an annuity as “something you buy to generate a monthly income”, which can be achieved by deferring one’s Social Security benefits as that equates to “essentially ‘buying’ a higher payout by the mere act of waiting.” Final Action at pp. 34-35 (emphasis omitted).
- WealthManagement.com® provides a website featuring information in the fields of wealth and retirement planning. Its website features an article that advises consumers “‘buying’ Social Security’s annuity by delaying withdrawals and living on other assets best enhances overall retirement income.” *Id.* at 37. Furthermore, it compares “the annuity rates for commercial annuities and the return on the delayed Social Security filing (the “price” of the Social Security annuity is the savings drawn down to cover living expenses in the early years of retirement). An example: a 66-year-old woman could buy an inflation-protected income annuity carrying a 4.7 percent annuity rate. But by delaying her Social Security benefits by one year (from 65 to 66), she would earn a 7.1 percent rate of return on annual benefits.” *Id.* at p. 39.
- Kingsview Asset Management® provides investment management and financial planning services, in which it provides advice in the nature of “Investment Strategies”. Within its “Investment Strategies,” it discusses “Insurance & Annuity Strategies” to obtain tax deferral benefits, protection of principal investments, and sufficient return expectations for one’s risk tolerance. *Id.* at 56.

Thus, the evidence in the record establishes that, not only is the wording descriptive of features of the applicant’s services, but there is a competitive need for financial planning services to use the wording “SOCIAL SECURITY”, “ANNUITY”, and “STRATEGIES” in the marketplace.

Additionally, the applicant itself has conceded the descriptiveness of the wording in the applied-for mark. In the application, the applicant submitted a disclaimer of the wording “SOCIAL SECURITY”, thereby acknowledging that the wording describes a characteristic, quality, function, feature, purpose, or use of its services. Furthermore, the applicant admits that its “services include providing advice on insurance and investments intended to coordinate with guaranteed Social Security benefits”, which would encompass advice pertaining to annuity investments. Applicant’s Brief (“Brief”) at p. 5.

Based on the foregoing, the wording “SOCIAL SECURITY”, ANNUITY”, and “STRATEGIES” are descriptive of income streams and investment options commonly used and discussed by financial planning and retirement financial planning services and the financial plans developed by those services.

B) The Applied-For Mark Does Not Create a Unique, Non-Descriptive Meaning

The applicant argues that the combination of the wording in the applied-for mark does not immediately convey that the applicant is providing financial planning and retirement financial planning services. Brief at pp. 3-5. However, as stated earlier, the test is not whether consumers could guess the services being provided from the applied-for mark alone, but rather whether “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods or services.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); TMEP §1209.01(b). Here, the record establishes that financial and retirement financial planning services commonly use the wording “SOCIAL SECURITY”, “ANNUITY”, and “STRATEGIES” to identify income streams and investment options available to consumers and the financial plans themselves.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because “each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive”). Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise non-descriptive meaning in relation to the services is the combined mark registrable. *See 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 descriptive of applicant’s services and do not create a unique, incongruous, or non-descriptive meaning in relation to the services. Specifically, the individual components and composite result of the mark describe that the applicant is providing financial planning strategies that feature information on how to coordinate Social Security benefits with other investments, such as annuities. Moreover, the evidence in the record also

establishes that the wording “SOCIAL SECURITY ANNUITY” is also commonly used to describe a financial planning strategy whereby an individual defers the receipt of his or her Social Security benefits to increase the value of those payments. Final Action at pp. 34-35, 37, and 41. The applicant, meanwhile, has not submitted any evidence that demonstrates the wording “SOCIAL SECURITY”, “ANNUITY”, or “STRATEGIES” lose their descriptive meaning or convey a unique, non-descriptive impression when combined together.

Moreover, despite the applicant’s claim to the contrary, the applied-for mark is not similar to the suggestive mark at issue in *In re Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A. 1968). Brief at p. 3. There, the Court found that the mark “SUGAR & SPICE” was not descriptive of ingredients of bakery goods as the mark immediately stimulated the association with the well-known nursery rhyme, “sugar and spice and everything nice”. *In re Colonial Stores, Inc.*, 394 F.2d at 1053-1054. In this case, the applicant has submitted no evidence to support its claim that the combined wording “SOCIAL SECURITY ANNUITY” creates a similar association with a non-descriptive meaning.

Based on the foregoing, the individual components and composite result of the applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** merely describes financial planning services and the potential income streams and investment strategies commonly utilized by those services.

C) The Applied-For Mark Describes a Significant Feature of the Applicant’s Services

The applicant argues that the applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** is not descriptive because it “does not describe all of the applicant’s services.” Brief at p. 7. However, “[a] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); TMEP §1209.01(b). Instead, it is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1298-1300, 102

USPQ2d 1217, 1218-1219 (Fed. Cir. 2012) (finding the mark NATIONAL CHAMBER to be merely descriptive where it described only one of the applied-for services, namely, “[p]roviding online directory information services featuring information regarding local and states Chambers of Commerce.”); TMEP §1209.01(b). Here, the applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** describes a significant feature of the applicant’s financial planning and retirement financial planning services, namely, that the applicant develops financial plans and advice for consumers on how to coordinate one’s Social Security benefits with personal investments, such as annuities, to optimize income streams for one’s retirement.

Thus, based on the foregoing, the applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** remains merely descriptive as it immediately describes a significant feature of the applicant’s financial planning and retirement financial planning services.

CONCLUSION

The applied-for mark **SOCIAL SECURITY / ANNUITY STRATEGIES** merely describes a characteristic or feature of the applicant’s services, namely, that the financial and retirement financial planning services feature financial plans and strategies on the use of Social Security benefits and/or annuities as income streams in retirement. While doubt as to a mark’s descriptiveness should be resolved on applicant’s behalf, the evidence of record leaves no doubt that the mark is merely descriptive. *See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987). Therefore, because the applied-for mark is merely descriptive and the applicant has submitted no evidence of acquired distinctiveness, registration of the applied-for mark on the Principal Register must be refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), be affirmed.

Respectfully submitted,

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WORD OF THE DAY
punitive
ADJECTIVE

Home > North American English > slash

Main definitions of slash in English: slash¹ slash²

slash¹



VERB

(WITH OBJECT)

1 Cut (something) with a violent sweeping movement, typically using a knife or sword.

'a fire was slashed on my car'

'they cut and slashed their way to the river'

([no object]) 'the man slashed at him with a sword'

+ More example sentences

+ Synonyms

1.1 *informal* Reduce (a price, quantity, etc.) greatly.

'the workforce has been slashed by 2,000'

+ More example sentences

+ Synonyms

1.2 *archaic* Lash, whip, or thrash severely.

+ Example sentences

1.3 *archaic* Crack (a whip)



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12 synonyms for fool



zulily

+ Example sentences

1.4 **archaic** Criticize (someone or something) severely.

+ Example sentences

+ Synonyms

NOUN

1 A cut made with a wide, sweeping stroke.

'the man took a mighty slash at his head with a large sword'

+ More example sentences

1.1 A wound or gash made by a cut with a wide, sweeping stroke.

'he staggered over with a crimson slash across his temple'

+ More example sentences

+ Synonyms

1.2 A bright patch or flash of color or light.

'yellow and gold foliage, with the odd slash of red'

+ More example sentences

2 An oblique stroke (/) in print or writing, used between alternatives (e.g., and/or), in fractions (e.g., 3/4), in ratios (e.g., miles/day), or between separate elements of a text.

+ Example sentences

+ Synonyms

2.1 *(usually as modifier)* A genre of fiction, published chiefly in fanzines or online, in which characters who appear together in movies, television, or other popular media are portrayed as having a sexual (especially homosexual) relationship.

+ Example sentences

3 *North American* Debris resulting from the felling or destruction of trees.

+ Example sentences

CONJUNCTION

informal

Used to link alternatives or words describing or denoting a dual (or multiple) function or nature.

'a fashionable movie theater-slash-bar-slash-restaurant'

'a model slash actress'

'the most insane-slash-brilliant maneuver in the show's history'



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Which Roald Dahl character are you?



What do they call French toast in France? (And other similar questions)

Monkeys and Apes

Which of the following is a type of monkey or ape?

gorilla

bushbaby

NEXT

0/10

TRENDING WORDS

USE THIS SLASH-SLASH-UNION IN THE SLASH HISTORY

+ More example sentences

Origin

Late Middle English, perhaps imitative, or from Old French esclachior break in pieces. The noun dates from the late 16th century.

Pronunciation: ⓘ

slash /slaSH/

Main definitions of **slash** in English: slash¹ slash²

slash²



NOUN

US

A tract of swampy ground, especially in a coastal region.

+ Example sentences

Origin

Mid 17th century, of uncertain origin.

Pronunciation: ⓘ

slash /slaSH/

TRENDING WORDS

Most popular in the world

1. aiyo
2. Brexit
3. India
4. braggadocious
5. racism

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