

THIS OPINION IS A NOT
PRECEDENT OF THE TTAB

Mailed: February 6, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Athmaram Vasudevan

Serial No. 77849253

Peter S. Sloane of Leason Ellis LLP for Athmaram Vasudevan

Matthew C. Kline, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney)

Before Bucher, Kuhlke and Lykos, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Athmaram Vasudevan, filed an application to register on the Principal Register the mark ASSISTANT GC in standard characters for services ultimately identified as “outsourcing in the field of law” in International Class 35.¹

Registration has been refused on the ground that ASSISTANT GC is merely descriptive of applicant’s services or, in the alternative, that it is deceptively

¹ Application Serial No. 77849253, filed on October 15, 2009, based on an allegation of a bona fide intention to use the proposed mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

misdescriptive of its services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).²

“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.” In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. In re Chamber of Commerce of the U.S., 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, 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,

² The examining attorney initially issued a final refusal based only on the ground that the proposed mark is merely descriptive. Applicant appealed that refusal. On May 13, 2011, the Board granted the examining attorney’s request for remand. Thereafter, the examining attorney refused registration on the additional ground of deceptive misdescriptiveness. Applicant was then allowed time in which to file a supplemental brief addressing the new refusal.

purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. In re Oppedahl & Larson LLP, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. See In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968); In re Shutts, 217 USPQ 363 (TTAB 1983); and TMEP § 1209.03(d). Finally, it is well-established that the determination of mere descriptiveness must be made 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 impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

It is the examining attorney's position that ASSISTANT GC is merely descriptive of "outsourcing in the field of law," because the identification encompasses "providing personnel who are Assistant General Counsels or act in such capacity." E.A. Br. p. 4. In support of his position, the examining attorney

submitted definitions from various reference sources for the terms “assistant” and “gc.” Based on these sources we find that ASSISTANT is defined as “one that assists”³ and GC is a common acronym or abbreviation for “General Counsel.”⁴ Further, the examining attorney submitted printouts from various third-party websites displaying the term ASSISTANT GENERAL COUNSEL used in connection with the provision of Assistant General Counsel positions. The examining attorney concludes that ASSISTANT GC “merely describes the purpose or intended audience of the applied for outsourcing in the field of law services.” E.A. Br. p. 6.

Applicant does not dispute that GC means “general counsel” or that “Assistant General Counsel” is the title of a position. However, applicant describes its intended services as “assist[ing] ... general counsels in their tasks.” App. Br. p. 2. Applicant argues that “[a]s a mark that designates services in assisting general counsels with their duties through outsourcing, the mark ASSISTANT GC is a catchy double entendre.” Further, applicant argues that the term “may also suggest that it will ‘assist’ General Counsels in performing their duties [and] [s]uch a mark would lend itself, for example, to Applicant promoting itself in a tongue and cheek manner as an assistant allowing general counsels to get their work done.” Reply Br. p. 2. More specifically, applicant contends that “the term ‘Assistant General Counsel’ is usually understood to mean a particular position for an individual. ... As

³ Office Action (January 25, 2010) (The American Heritage Dictionary of the English Language (4th ed. 2000) retrieved from www.thefreedictionary.com).

⁴ Office Action (January 25, 2010) (www.acronymfinder.com).

such, it is most unusual for a company like Applicant to be providing services under a mark like ASSISTANT GC, which is uniformly used to designate a title rather than a service. Such incongruity play[sic] into the suggestiveness of the mark.” Reply Br. p. 2-3. Applicant concludes that its mark ASSISTANT GC “which is ambiguous in meaning is suggestive, not descriptive.” App. Br. p. 3.

Terms that identify the function or purpose of a service are merely descriptive. Applicant states that its services are to “assist general counsels in performing their duties” which would include providing Assistant General Counsel type services. Thus, we find that ASSISTANT GC in the context of applicant’s “outsourcing in the field of law” immediately informs the consumer about a significant feature of the services, i.e., that applicant provides the type of legal services an Assistant General Counsel would provide.

Applicant argues that ASSISTANT GC is a double entendre because he does not provide an actual Assistant General Counsel. Applicant’s further description of his actual services, “assisting general counsels,” would include delivering the services an Assistant General Counsel would provide without the client having to take on a new hire. Applicant concedes that “the term ‘Assistant General Counsel’ is usually understood to mean a particular position for an individual.” App. Reply Br. p. 2. Applicant points to the evidence of record showing job listings for Assistant General Counsel positions, averring that they are for individuals, not companies or services. Applicant concludes that it is “unusual for a company like Applicant to be providing services under a mark like ASSISTANT GC, which is uniformly used to

designate a title rather than a service. Such incongruity plays into the suggestiveness of the mark.” Reply Br. pp. 2-3.

The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. In *re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). Further, to avoid mere descriptiveness the second meaning may not be merely descriptive in relation to the relevant services. We do not find ASSISTANT GC to present a double entendre such that “the merely descriptive significance of the term [ASSISTANT GC] is lost in the mark as a whole.” In *re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). See also In *re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE double entendre for bakery products); and In *re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT double entendre for fresh pre-cooked ham). Moreover, to the extent it does present two meanings, they are both merely descriptive of the services in that both asserted meanings refer to the customers’ needs being met by the provision of the appropriate services, i.e., assisting general counsels. See TMEP § 1213.05(c). Nor is the meaning ambiguous as was found in In *re T.M.S. Corp. of the Americas*, 200 USPQ 57 (TTAB 1997) (“THE MONEY SERVICE” suggestive for financial services wherein funds are transferred to and from a savings account from remote locations), a case relied upon by applicant. Here, the term ASSISTANT GC does not fall “short of describing applicant’s services in any one degree of particularity.” As discussed above, both meanings, providing the actual Assistant General Counsels or simply the type of legal services provided by Assistant General

Counsels, as applicant puts it “assisting general counsels in their tasks,” are merely descriptive of the services.

Moreover, even if ASSISTANT GC were not merely descriptive for applicant’s actual services, it is merely descriptive of services providing Assistant General Counsels, which is included in applicant’s broad identification of services “outsourcing in the field of law.” The fact that applicant does not intend to provide “Assist General Counsels,” does not impact our analysis inasmuch as we must base it on the services as identified -- whatever they may include. Chamber of Commerce, 102 USPQ2d at 1219. We are required to construe the application as broadly as it is written. Further, if the proposed mark is merely descriptive for any of the possible services falling within that identification we must hold it to be merely descriptive. *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

In addition, a term may be merely descriptive if the identified services fall within a subset of services indicated by the term. *In re Amer. Soc’y of Clinical Pathologists, Inc.*, 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1971). Certainly services that consist of assisting general counsels fall within the subset of Assistant General Counsel services. Just as “business and regulatory data analysis services are within the scope of traditional chambers of commerce activities” of “promoting the interests of businessmen and businesswomen,” so too are services providing assistance to general counsels within the scope of traditional Assistant General Counsel services. See Chamber of Commerce, 102 USPQ2d at 1220.

Based on this record, we find that the examining attorney has demonstrated that ASSISTANT GC is merely descriptive of a significant feature of applicant's services, namely, the provision of Assistant General Counsel type legal services, and, based on the broad identification, the provision of Assistant General Counsels.

For completeness we address the refusal in the alternative that applicant's proposed mark is deceptively misdescriptive.

The test for deceptive misdescriptiveness has two parts. First it must be determined if the matter sought to be registered misdescribes the goods or services. If so, then it must be ascertained if it is also deceptive, that is, if anyone is likely to believe the misrepresentation. In re Quady Winery Inc., 221 USPQ 1213, 1214 (TTAB 1984). See also In re Phillips-Van Heusen Corp., 63 USPQ2d 1047 (TTAB 2002).

The examining attorney argues that because the identification "outsourcing services in the field of law" includes, *inter alia*, "outsourcing assistant general counsel services" and applicant expressly states that it does not provide these specific services, the mark is misdescriptive of the services. Further, the examining attorney contends that potential consumers would likely believe the misrepresentation because Assistant General Counsel is a commonly used job title. Finally, the examining attorney states that "[t]he fact that applicant's clients are sophisticated plays no part in the determination of whether a mark is descriptive."

E. A. Br. p. 8.

Applicant responds that “[t]here is nothing in the identification of services, outsourcing in the field of law, which would make it unreasonable to conclude that Applicant intends to provide legal outsourcing services which helps general counsels with their tasks or that consumers would perceive things as such. ... [I]t is error for the Examining Attorney to take the position that the mark is either merely descriptive or misdescriptive. Rather, the mark ASSISTANT GC is a classic double entendre when used in connection with legal outsourcing services. The mark may suggest that Applicant intends to provide assistant general counsels or it may imply that Applicant will assist general counsel in performing their duties. It is well established that “a mark which connotes two meanings – one possibly descriptive and the other suggestive of some other associate – can be called suggestive, as the mark is not ‘merely’ descriptive.” App. Supp. Br. p. 2. Finally, applicant argues that the level of sophistication of the potential consumers is relevant to the determination if “the persons who encounter the mark as used on or in connection with the goods or services in question, are likely to believe the misrepresentation.” App. Supp. Br. p. 3, quoting TMEP § 1209.04.

In essence, applicant is arguing that because one of the possible interpretations of the identification of services is to simply “assist general counsels with their tasks,” the proposed mark is not misdescriptive. However, because the identification is broad enough to include also providing Assistant General Counsels, and applicant has stated it does not provide that service, it is misdescriptive. Cf. Chamber of Commerce, 102 USPQ2d 1217; Stereotaxis Inc. 77 USPQ2d 1087.

Further, the record shows that legal positions are outsourced, Assistant General Counsel is the title of a legal position and GC is the common acronym for General Counsel. Thus, this misdescription is plausible to the consumers.

We agree that the sophistication of the potential consumer is relevant to our analysis to the extent that we must consider the question in the context of the services, which necessarily limits the analysis to the potential consumers of that service, in this case general counsels or more generally lawyers. However, there is nothing in the record to support a conclusion that the sophistication of the consumer here would protect them from such misrepresentation. In fact, we could equally infer that lawyers understanding the meaning of ASSISTANT GC would in the context of “outsourcing in the field of law” understand that to mean the provision of an Assistant General Counsel.

Decision: The refusals to register under Section 2(e)(1) of the Trademark Act are affirmed.