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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mark Holdings, LLC

Serial No. 85163500

Steven J. Wadyka, Jr. and Steven B. Powell of Greenberg Traurig LLP for Mark Holdings, LLC.

Evelyn Bradley, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Bucher, Bergsman and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Mark Holdings, LLC (“applicant”) seeks registration of **LENDING STORE**, in standard characters, alleging a *bona fide* intent to use the mark in commerce for “providing business marketing services for the financial products industry.” The examining attorney refused registration on the ground that applicant’s mark is merely descriptive of the identified services under Section 2(e)(1) of the Act. After the refusal became final, applicant appealed. Applicant and the examining attorney filed briefs. We affirm the refusal to register.

A mark 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. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark 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 the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). 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).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on

whether the combination of terms evokes a new and unique commercial impression. 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. *See e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents for tracking the status of the records by means of the Internet); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry).

Here, the evidence upon which the examining attorney relies is fairly sparse.

It includes the following (emphasis supplied):

- a Wikipedia entry for “Payday loan,” which states “Borrowers visit a payday **lending store** and secure a small cash loan, with payment due in full at the borrower’s next paycheck ...;” Office Action mailed Feb. 16, 2011;
- a July 7, 2010 press release from Wells Fargo & Company, which refers to the company’s “Banking **stores**,” “Financial **stores**,” “home mortgage **stores**,” and

“community banking **stores**,” Office Action mailed August 31, 2011;

- a printout of a news story published on the “whotv.com” website, which includes the following quote from the Wells Fargo press release: “Our network of U.S. based consumer finance **stores** have served customers well for more than 100 years, but the economics of a separate Wells Fargo Financial channel are no longer viable;” *id.*;
- a printout from “thefreedictionary.com” which defines “lending institution” as “a financial institution that makes loans;” *id.*; and
- a printout from “businessdictionary.com” which defines “lending institution” as an “Organization such as a bank, credit union, or finance company that makes loans. It may or may not also be a depository institution.” *Id.*¹

Based on this evidence, the examining attorney argues that applicant’s mark “merely identifies the target market of the specified services,” that “the individual terms ‘lending’ and ‘store’ are descriptive as used with applicant’s services” and that the composite mark LENDING STORE remains descriptive of applicant’s services. Examining Attorney’s Appeal Brief at 3, 5, 6.

Applicant’s evidence is comprised solely of printouts of third-party registrations, many of them composite marks including the term STORE which are registered on the Principal Register for financial and related services, and in which the composites include the word STORE without any disclaimer. Applicant argues that “it is unclear what ‘LENDING STORE’ in connection with Applicant’s services

¹ The examining attorney also introduced evidence from foreign websites. However, in the absence of evidence that consumers in the United States would encounter these websites, or that the designations used in these websites are also used or understood by consumers in the United States, the evidence is not probative and has therefore not been considered.

exactly means,” and that the mark is “subject to multiple interpretations.” Applicant’s Appeal Brief at p. 5. Applicant also argues that LENDING STORE is not commonly used in the financial industry, and registration of the mark “would not preclude other providers of marketing services from describing their own services.” *Id.* at 6-7. Finally, applicant claims that its mark is suggestive because “an additional step in reasoning” is required to ascertain that the mark refers to a business from which “financial products providers may seek business marketing services.” *Id.* at 10.

While the examining attorney’s evidence is quite limited, it establishes that LENDING STORE is merely descriptive in relation to “providing business marketing services for the financial products industry.” Indeed, the examining attorney’s evidence establishes that “lending” means making loans, and that a local outlet or office of a lending institution is sometimes referred to as a “store.” We also take judicial notice that the Oxford *Online Dictionary* defines “lend” as “to grant to (someone) the use of (something) on the understanding that it shall be returned.”² We note that the examining attorney defined the term “store” as “an establishment for the retail sale of goods and services” and take notice of an additional definition of “store” as a “retail establishment selling items to the public.”³ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v.*

² Oxford Dictionaries
http://oxforddictionaries.com/definition/american_english/lend

³ Oxford Dictionaries
http://oxforddictionaries.com/definition/american_english/store?q=store

J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The examining attorney placed into the record a copy of the following press release from Wells Fargo & Company:

News Release

Wells Fargo & Company to Consolidate Its Wells Fargo Financial Consumer Finance Division into the Company's Newly Expanded Coast to Coast Community Banking Network: 638 Independent Consumer Finance Offices to be Closed
Restructuring does not impact Wells Fargo's industry-leading network of 6,600 Wells Fargo and Wachovia Community Banking stores and 2,200 Wells Fargo Home Mortgage stores; Wells Fargo will recognize a \$0.02 per share restructuring charge in second quarter 2010

DES MOINES, Iowa — July 7, 2010

Wells Fargo & Company (NYSE: WFC) today announced the restructuring of its Wells Fargo Financial division, including closing its 638 Wells Fargo Financial stores across the U.S. and exiting the origination of non-prime portfolio mortgage loans. The remaining consumer and commercial loan products offered through Wells Fargo Financial will be realigned with those offered by other Wells Fargo business units and will be available through Wells Fargo's expanded network of community banking and home mortgage stores, now the nation's largest.

Because of its 2008 merger with Wachovia, Wells Fargo's customers now have access to the company's 6,600 Wells Fargo and Wachovia community bank stores and its 2,200 Wells Fargo Home Mortgage locations, eliminating the need for a separate network of Wells Fargo Financial local offices. Less than 2 percent of all Wells Fargo's real estate loans were originated in Wells Fargo Financial stores in the first quarter of 2010. The company expects the consolidation to result in increased operating efficiencies, streamlined processes and controls, and a more consistent experience for customers.

"Our network of U.S.-based consumer finance stores, which have historically operated as an independent sales channel from our bank operations, have served customers well for more than 100 years," said David Kvamme, president of Wells Fargo Financial, "but the economics of a separate Wells Fargo Financial channel are no longer viable, especially now that our customers have access to the largest banking and mortgage store network in the United States."

The restructuring of Wells Fargo Financial will not impact the number of community banking or home mortgage stores currently in operation.

Customers with existing Wells Fargo Financial consumer loans and clients of Wells Fargo Financial's commercial businesses will continue to be served without disruption, the company said. FHA home loans, auto loans and credit cards previously offered by Wells Fargo Financial will be consolidated with similar products across the company and will be offered through the company's network of community banking stores, mortgage stores, phone banks and wells Fargo.com. Wells Fargo Financial's commercial businesses will be realigned with business units within Wells Fargo over the next 12 months. However, Wells Fargo will no longer originate non-prime portfolio real estate loans.

...

About Wells Fargo

Wells Fargo & Company is a diversified financial services company with \$1.2 trillion in assets, providing banking, insurance, investments, mortgage, and consumer and commercial finance through more than 10,000 stores and 12,000 ATMs and the Internet (wells Fargo.com and wachovia.com) across North America and internationally.

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She also placed into the record screenprints from Wikipedia discussing the “Payday loan.” We have included relevant sections herein:

Payday loan

From Wikipedia, the free encyclopedia



This article **needs additional citations for verification.**

Please help [improve this article](#) by adding [reliable references](#).

Unsourced material may be [challenged](#) and [removed](#).^(November 2008)



This article is **in need of attention from an expert on the subject.** [WikiProject Finance](#) may be able to help recruit one. ^(March 2009)

A **payday loan** (also called a **paycheck advance** or **payday advance**) is a small, short-term [loan](#) that is intended to cover a borrower's expenses until his or her next payday. The loans are also sometimes referred to as **cash advances**, though that term can also refer to cash provided against a prearranged line of credit such as a [credit card](#) (see [cash advance](#)). [Legislation](#) regarding payday loans varies widely between different countries and, within the [USA](#), between different states.

Some [jurisdictions](#) impose strict [usury](#) limits, limiting the [nominal annual percentage rate](#) (APR) that any lender, including payday lenders, can charge; some outlaw payday lending entirely, and some have very few restrictions on payday lenders. Due to the extremely short-term nature of payday loans, the difference between APR and [effective annual rate](#) (EAR) can be substantial, because EAR takes [compounding](#) into account. For a \$15 charge on a \$100 2-week payday loan, the APR is $26 \times 13\% = 338\%$ but the EAR is $(1.15^{52} - 1) \times 100\% = 3,685\%$. Careful reporting of whether EAR or APR is quoted is necessary to make meaningful comparisons



Virginia

Retail lending

Borrowers visit a payday [lending store](#) and secure a small cash loan, with payment due in full at the borrower's next paycheck (usually a two week term). In the United States, finance charges on payday loans

are typically in the range of 15 to 30 percent of the amount for the two-week period, which translates to rates ranging from 390 percent to 780 percent when expressed as an annual percentage rate (APR).^[a] The borrower writes a [postdated check](#) to the lender in the full amount of the loan plus fees. On the [maturity date](#), the borrower is expected to return to the [store](#) to repay the loan in person. If the borrower doesn't repay the loan in person, the lender may process the check traditionally or through electronic withdrawal from the borrower's [checking account](#).

If the account is short on funds to cover the check, the borrower may now face a bounced check fee from their [bank](#) in addition to the costs of the loan, and the loan may incur additional fees and/or an increased interest rate as a result of the failure to pay. For customers who cannot pay back the loan when due, members of the national trade association are required to offer an extended payment plan at no additional cost. In states like [Washington](#), extended payment plans are required by state law.

Payday lenders require the borrower to bring one or more recent pay stubs to prove that they have a steady source of income. The borrower is also required to provide recent bank statements.^[citation needed] Individual companies and [franchises](#) have their own underwriting criteria.

...

Variations on payday lending

A minority of mainstream [banks](#) offer advances for customers whose paychecks or other funds are deposited electronically into their accounts. The terms are similar to those of a payday loan: a customer receives a predetermined cash credit available for immediate withdrawal. The amount is deducted, along with a fee, usually about 10 percent of the amount borrowed, when the next direct deposit is posted to the customer's account. After the programs attracted regulatory attention^[citation needed], Wells Fargo called its fee “voluntary” and offered to waive it for any reason. It later scaled back the program in several states.

Wells Fargo clearly uses the terms “banking stores,” “financial stores,” “home mortgage stores,” “community banking stores” and “consumer finance stores.” In fact, according to this press release, Wells Fargo has the largest network of community banking and home mortgage stores in the country, offering consumer and commercial finance through more than 10,000 “stores.” This evidence alone establishes that financial services are offered in a large number of “stores” throughout the United States. In the Wikipedia article on “payday loans,” the article refers to the prototypical “payday lending store,” and it is clear that Wells Fargo is a mainstream bank providing a variation of this type of loan through its “stores.”

Based on the evidence of record and the definitions of “lending” and “store,” it is clear that LENDING STORE does not evoke a new and unique commercial impression. Rather, the words LENDING and STORE each retain their merely descriptive significance in relation to the recited services. In this case, because there is no dispute that applicant’s marketing services are, according to applicant’s identification of services, “for the financial products industry,” which offers financial services, including “lending,” through “stores,” applicant’s mark is merely descriptive.

To the extent that applicant functions as an intermediary in the financial products industry, and provided its marketing services are indeed targeted to the ultimate borrower (as described by the examining attorney), the term LENDING STORE immediately conveys an idea of this service. Alternatively, to the extent that this alleged mark might be directed to a network of lenders, the examining attorney also points out that a term which identifies a group to whom the applicant directs its goods or services is merely descriptive. *See In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of risk management services in the field of pricing and purchasing natural gas); *Hunter Publ’g Co. v. Caulfield Publ’g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail-order services in the field of outdoor equipment and apparel).

Applicant's argument that its mark is "incongruous" because it is a "juxtaposition of words which have slightly contradictory connotations" is belied by the evidence of record discussed above. Based upon a complete reading of the Wikipedia article and Wells Fargo press release made of record, in the context of the "financial products industry," including the payday loan industry, the term "store" is an apt designation for an outlet, branch office or other space suitable for housing a place of business offering loans, including payday loans.

Finally, as the examining attorney points out, applicant's third-party registration evidence is not persuasive because "[t]he Board must decide each case on its own merits" and "the PTO's allowance of such prior registrations does not bind the Board or this court." *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

In short, the evidence of record leaves no doubt in the minds of this panel's majority that LENDING STORE is merely descriptive of "providing business marketing services for the financial products industry."

Decision: The refusal to register is affirmed.

Opinion by Bergsman, Administrative Trademark Judge, dissenting:

I respectfully dissent. The mark LENDING STORE to identify marketing services in the financial products industry is incongruous because the term "Lending Store" does not immediately call to mind financial marketing services or the companies to whom the services will be rendered. For example, as indicated by

the evidence, lending institutions are commonly referred to as banks, credit unions, mortgage bankers, government agencies and private sellers.⁵ “Lending Store” is not the usual or normal way that consumers refer to a lender. With all the millions of websites, the examining attorney could only find one oblique reference to “Lending Store” in the “Payday loan” entry in *Wikipedia*. There is no *Wikipedia* entry for “Lending Store” in the record. This leads to the conclusion that the term “Lending Store” is not a natural or obvious way to describe lenders, let alone marketing services to lenders.

The evidence demonstrates that it is rare, close to non-existent, in contemporary usage for someone to borrow money from a “lending store.” In this regard, to support its decision, the majority had to rely on a Wells Fargo press release that does not even reference the term “Lending Store.” “The concept of mere descriptiveness ... must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’” *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983). With the mark LENDING STORE, applicant has applied an imaginative twist that

⁵ An entry from the *StreetDirectory.com* website identifying neighborhood banks, credit unions, mortgage bankers, government agencies and private sellers as the “Top Mortgage Lending Institutions.” A definition of the term “lending institution” from the *BusinessDictionary.com* website as an “[o]rganization such as a bank, credit union, or finance company that makes loans. It may or may not be a depository institution.” (August 31, 2011 Office action).

risers above the level of mere descriptiveness and does not remove a desired characterization from the lexicon.

The term “Lending Store,” thus, possesses enough incongruity to raise doubts as to whether it is merely descriptive because its meaning would not be grasped without some measure of imagination and “mental pause.” In this regard, the examining attorney explained that applicant’s mark identifies the users to whom applicant directs its marketing services because “applicant’s services are for financial institutions which could include lending institutions.”⁶

Applicant seeks to register the mark LENDING STORE for “providing business marketing services for the financial products industry.” Applicant provides business marketing services to lending institutions or financial stores. Some lending institutions are referred to as stores. ... A lending institution is a financial institution that makes loans. Financial institutions such as banks, credit unions or finance companies that make loans are known as lending institutions.⁷

This analysis does not demonstrate someone who comprehends the mark as readily and immediately evoking an impression and understanding of the services or the companies to whom the services are being rendered. *See The Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666, 216 USPQ 11, 18 (7th Cir. 1982) (THE MONEY STORE for money lending services is suggestive because the mark does not convey the essence of the business, money lending); *Decatur Federal Savings and Loan v. Association Peach State Federal Savings and Loan Association*, 203

⁶ August 31, 2011 Office action.

⁷ *Id.*

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USPQ 406, 411 (N.D. Ga. 1978) (SAVINGS SHOP suggestive of savings and loan association services rendered out of small booths in shopping malls because it is an uncommon term).

It is well settled that there is often a thin line separating merely descriptive from suggestive terms and that judgments in these cases are frequently subjective. However, where there is doubt in the matter, the doubt should be resolved in applicant's behalf. *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and authority cited therein.

In view of the foregoing, I find that the mark LENDING STORE is suggestive, not merely descriptive, of marketing services in the financial products industry. Therefore, I would reverse the refusal to register.