

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Assurant, Inc.

Serial No. 85494137

Marsha Stolt of Moss & Barnett, P.A. for Assurant, Inc.

Courtney McCormick Alvarez, Trademark Examining Attorney,
Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Assurant, Inc. has applied to register PREAUTHORIZED DEBIT PROTECTION in standard characters as a mark for services ultimately identified as "underwriting and administration of payment protection insurance, namely, insuring payment of preauthorized payments."¹ Applicant has disclaimed exclusive rights to PROTECTION apart from the

¹ Serial No. 85494137, filed December 13, 2011, based on Section 1(b) of the Trademark Act (intent-to-use).

mark as shown. Request for reconsideration, filed January 10, 2013.

The examining attorney issued a final refusal of registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified services.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(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 Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term 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); In re MBAssociates, 180 USPQ 338 (TTAB 1973). 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 the 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 different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

In support of her position that the mark is descriptive, the examining attorney has submitted definitions of the following terms:

Preauthorized payment: arrangement (such as direct debit payment or standing order) under which a bank is authorized by a customer to debit his or her account for a regular bill's amount or for loan installments
BusinessDictionary.com

Debit: the recording or an entry of debt in an account
Dictionary.com

Protection: *Insurance*. Coverage (Dictionary.com, based on Random House Dictionary © 2012); coverage for loss provided by insurance (Merriam-Webster's Dictionary of Law © 1996).

In addition, the examining attorney has submitted a number of articles in which "preauthorized debit" is used as a term of art:²

"Preauthorized Debit Definition" (title)
Description: A preauthorized debit is an arrangement to withdraw funds directly from a bank account at predetermined intervals, such as monthly.

² We have given no weight to articles from other countries or by entities located in other countries, as they do not necessarily show the meaning of the term "preauthorized debit" in the United States.

www.ehow.com

Stopping a Pre-authorized Debit From Being Paid
(title)

At the time we are retained, clients frequently tell us that they have authorized monthly debits from their checking account by debt collectors...
Gillman & Gillman, LLC
<http://gillmanandgillman.com>

How can I stop a pre-authorized debit from being paid from my share draft account? (title)
MyCreditUnion.gov, Consumer Assistance Center
<http://ncua.parature.com>

Answers about Automatic Withdrawals (title)
How can I stop a pre-authorized debit from being paid from my checking account?
Comptroller of the Currency, Administrator of National Banks, U.S. Department of the Treasury
www.helpwithmybank.gov

Direct debit (title of article)
A direct debit or direct withdrawal is a financial transaction in which one person withdraws funds from another person's bank account. ... It is also called pre-authorized debit (PAD) or pre-authorized payment (PAP).
Wikipedia
<http://en.wikipedia.org>

Applicant has agreed that the examining attorney's submissions "show descriptive uses of the term "preauthorized debit" in connection with banking services." Response filed July 3, 2012. We would go further: the evidence shows that "preauthorized debit" is a term of art in the credit field.³ Further, the evidence shows that

³ We note that some of the articles use a hyphen in the term, i.e., "pre-authorized." The lack of a hyphen in applicant's mark does not affect the meaning of the word. Not only are there articles that use "preauthorized" without a hyphen, but the

"protection" means "coverage" when used in the context of insurance services, and applicant has admitted the descriptiveness of this word in connection with its services by its disclaimer in response to the examining attorney's requirement.

Applicant's services are identified in its application as "underwriting and administration of payment protection insurance, namely, insuring payment of preauthorized payments." When these terms are combined in the phrase PREAUTHORIZED DEBIT PROTECTION, consumers viewing the mark in connection with the identified services will immediately understand that a significant characteristic of the services is to insure payment of preauthorized debits. As a result, the mark PREAUTHORIZED DEBIT PROTECTION is merely descriptive of the insurance services.

Applicant argues that PREAUTHORIZED DEBIT PROTECTION "could suggest that consumers protect themselves from unforeseen circumstances by preauthorizing debits from an account, or that consumers protect the payments of debits from an account that have already been authorized, or that a financial institution protect itself in connection with

presence or absence of a hyphen would not affect a customer's understanding of the word. Applicant does not argue to the contrary.

payments that have been authorized by customers," and that "[a] potential customer would not know what services are being offered under the Applicant's mark until it investigates further." Brief, p. 7. However, as noted above, 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. When viewed in the context of applicant's identified services, the mark immediately tells consumers of this characteristic of the insurance services, i.e., that they provide protection to the consumer by covering preauthorized debits.

Applicant also contends that its mark is not merely descriptive because no one else uses the term "preauthorized debit protection." However, as the examining attorney has pointed out, the fact that a party is the first or only user of a term does not mean that the term is not merely descriptive. See *In re Phoeseon Tech., Inc.*, 103 USPQ2d 1822 (TTAB 2012). That is especially pertinent in the present situation, as applicant has stated that its service is "a unique new product offering in the insurance industry." Brief, p. 10. When third parties do start to provide such an insurance service, they should not be precluded from using a term that describes it simply because applicant began offering the service first.

Finally, applicant points to other marks that have been registered on the Principal Register, claiming that its mark is comparable. The particular mark that applicant identifies in its brief is Registration No. 3464259 for COMMERCE CREDIT PROTECTION for "financial services, namely, debt protection programs featuring debt cancellation, where all or part of the debt will be canceled." This registration does not support applicant's position, in that it includes a disclaimer of CREDIT PROTECTION, thereby indicating that this phrase is merely descriptive. Unlike applicant's mark, the registered mark includes the suggestive term COMMERCE, and the inclusion of this term is presumably the reason this mark was found to be registrable. However, applicant's mark PREAUTHORIZED DEBIT PROTECTION, as previously discussed, includes the descriptive term of art "preauthorized debit," and combining this term with the descriptive term PROTECTION results in a mark that as a whole is merely descriptive.

Decision: The refusal of registration is affirmed.