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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Life Cycle Engineering, Inc.

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Serial No. 85692710

B. Craig Killough of Barnwell Whaley Patterson & Helms, LLC for Life Cycle Engineering, Inc.

April K. Roach, Trademark Examining Attorney, Law Office 115 (John T. Lincoski, Managing Attorney).

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Before Quinn, Taylor, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Life Cycle Engineering, Inc. (“Applicant”) filed an application¹ for registration of the mark RBAM in standard characters for the following services:

Business management and consultation in the field of engineering; Business management and consultation in the field [*sic*]² maintenance of industrial, military and marine equipment, in International Class 35;

¹ Application Serial No. 85692710 was filed on August 1, 2012 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), stating the date of first use and first use in commerce as February 28, 2011 with respect to all classes of services.

² The word “of” appears to have been omitted. We recommend that Applicant take the necessary action to correct this omission prior to publication of the application.

Consulting services in the field of maintenance of industrial, military and marine equipment, in International Class 37;

Technical consultation in the field of engineering of industrial, military, and marine equipment, in International Class 42.

The Trademark Examining Attorney refused registration, with respect to all classes of services, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark merely describes the identified services. The Examining Attorney also refused registration on the ground that Applicant failed to submit an acceptable specimen of use of the mark in connection with the services in International Class 42. When the refusals were made final, Applicant filed a request for reconsideration, which was denied. This appeal ensued.³ Applicant and the Examining Attorney have filed briefs.

1. Specimen of use, Class 42.

We first address the Examining Attorney's refusal on the ground that Applicant has failed to submit a specimen showing use of Applicant's mark in connection with the services identified as "Technical consultation in the field of engineering of industrial, military, and marine equipment."

Section 45 of the Trademark Act provides, in relevant part, that a service mark is a mark that is used "to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services"; and that "a

³ Applicant states in its brief that the Examining Attorney never made clear whether the latest revisions to the recitation of services in Class 42 (as set forth above) were acceptable to the Office. We confirm that the sufficiency of the recitation in Class 42 is not a subsisting ground for refusal of registration and is not at issue in this appeal. Moreover, the recitation appears to be sufficiently definite to meet the standards of the Office.

mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.”⁴ In order to demonstrate use of a service mark by means of an advertisement, the advertisement must display the mark “in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source via a ‘direct association.’” *In re DSM Pharmaceuticals Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008). “The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989).

Addressing the original specimen of use and the substitute specimen submitted on July 30, 2013, the Examining Attorney contends:

While the specimen may explain the concept of “risk-based asset management,” the only services it shows Applicant provides are the prioritization of time, money and materials, infrastructure, and meeting corporate business objectives. These services include the business and maintenance consulting in International Classes 35 and 37, but not the technical consulting in International Class 42.⁵

⁴15 U.S.C. § 1127, definitions of “service mark” and “use in commerce.”

⁵ Examining Attorney’s brief, 13 TTABvue 11.

The original specimen of use is a single web page, and its text is abruptly truncated at the end of the page. The substitute specimen is highly similar, but it includes a second page of text. We will address the substitute specimen.⁶

There is no dispute that the mark is displayed on the specimen, inasmuch as the Examining Attorney has accepted the same specimen with respect to the other classes of services recited in the application. There is no question that the specimen shows that Applicant is offering to provide consulting services: “Life Cycle Engineering will partner with you to build a risk-based asset management system....” However, the Examining Attorney’s position is that it does not offer to provide “technical consulting” in the field of engineering. We disagree. “Technical” is defined as follows:

1 a : having special usu. practical knowledge esp. of a mechanical or scientific subject.... b : marked by or characteristic of specialization....

2348 WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (1993).⁷

“Engineering” means:

The science by which the properties of matter and the sources of energy in nature are made useful to man in structures, machines, and products – see CHEMICAL ENGINEERING, CIVIL ENGINEERING, ELECTRICAL ENGINEERING, HYDRAULIC ENGINEERING, INDUSTRIAL ENGINEERING, MECHANICAL ENGINEERING, MUNICIPAL ENGINEERING, SANITARY ENGINEERING.

Id. at 752.

⁶ Applicant’s request for reconsideration of July 30, 2013 at 24-25.

⁷ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

It is clear that Applicant's offer to help clients to "build a risk-based asset management system" is an offer of specialized consultation in the engineering field. Among other things, Applicant offers analysis of "Equipment Criticality," "risk and failure analysis," and "mechanical integrity programs." In the context of the advertisement, these services would be readily understood to refer to advice with respect to the maintenance of a customer's equipment and other physical assets. In our view, this constitutes an offer of technical engineering consultation. Accordingly, we reverse the refusal of registration based upon the insufficiency of Applicant's specimen of use.

2. Refusal under Section 2(e)(1).

The Examining Attorney has refused registration under Section 2(e)(1) on the ground that the mark RBAM is an acronym for "risk-based asset management," an expression that is merely descriptive of Applicant's services.

Section 2(e)(1) of the Trademark Act provides for the refusal of registration of a mark "on account of its nature" if it "[c]onsists of a mark which, (1) when used on or in connection with the goods of the Applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(1). With respect to services, a term is merely descriptive 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 services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark is merely descriptive is determined

in relation to the services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A mark need not immediately convey an idea of each and every specific feature of the services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the services. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Moreover, the mark need not describe all of the identified services. Rather, a descriptiveness refusal is proper with respect to all of the identified services in an International Class if the mark is descriptive of any of the services in that class. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). The determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

An acronym is merely descriptive only if it has “become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.” *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 110 USPQ293, 295 (CCPA 1956). To support a finding that an acronym is merely descriptive, the Board requires that the Examining Attorney show that the acronym is an abbreviation of a term that is merely descriptive of the identified services; and that a relevant consumer viewing the acronym in connection with Applicant’s

services would recognize it as an abbreviation of that descriptive term. *In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1716 (TTAB 2011); *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1155 (TTAB 2008); *see also Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1230 (TTAB 2012).

The Examining Attorney has made of record dictionary definitions of the component words of the phrase “risk-based asset management.”⁸ These are common words of reasonably clear meaning. Applicant’s advertising uses these words repeatedly in the text of its advertising in such a way that they are clearly intended to have their commonly understood meanings:

If your *asset management* strategy is not *risk-based*, you may be spending money on symptoms of problems instead of the root cause of your losses. ...

An effective *risk-based management* system includes an enterprise *asset* management or resource solution ... [and] *risk* and failure analysis....⁹

Applicant refers to the ultimate product of its services as “a risk-based asset management strategy.”¹⁰ In the context of Applicant’s advertisements, it is clear that the expression “risk-based asset management” is intended to mean a process of making decisions regarding the maintenance of a business’s equipment and other property (“assets”) on the basis of an analysis of “how those assets impact the value stream,” combined with an analysis of the risk of failure of such equipment, so as to make rational judgments as to when or how to maintain or replace such assets:

⁸ Office action of August 17, 2012 at 11-20.

⁹ Substitute specimen of use, filed with request for reconsideration of July 30, 2013 at 24-25 (emphasis added).

¹⁰ *Id.* at 24.

Performing a criticality analysis on the equipment seems like a daunting task, but without it, how can prioritization occur? A good understanding of the value that the products create ... is an important first step. From there, you can evaluate the equipment on impact to the value stream by looking at how failures to that equipment will impact environment, health, safety, reputation and production. Then you ... calculate the overall criticality of the equipment. ...

Once the equipment criticality is complete, a failure mode and effects analysis (FMEA) can be conducted on the most critical equipment – the equipment that poses the greatest risk or creates the most value in the value stream.¹¹

The Examining Attorney has shown that third parties use the expression “risk-based asset management” to describe similar processes.

- Green Bay Metropolitan Sewerage District uses the term to describe “an integrated optimization process for managing infrastructure assets to minimize the total cost of owning and operating them, while continuously delivering the service levels customers’ [sic] desire, at acceptable levels of risk.”¹²
- Cambridge Systematics uses the term to describe software that “enables asset owners to simultaneously increase critical asset reliability and reduce overall inspection and life-cycle costs.”¹³
- Faithful + Gould uses the term to refer to a process resulting in “Improved quality of decision making, reducing risk of asset failure.”¹⁴
- Powertech offers services described as “Least-Cost Risk Based Asset Management Service for prioritization and implementation of optimal maintenance strategies. The service includes developing systematic approach in quantifying health of a utility component type across an entire

¹¹ Marketing material filed with Applicant’s response of February 15, 2013 at 16.

¹² Office action of August 17, 2012 at 21.

¹³ *Id.* at 22.

¹⁴ *Id.* at 25-26.

system, assessing associated risk, and developing appropriate risk mitigation approaches.”¹⁵

- rbalm.com states that “Risk Based Asset Management” addresses questions such as “how to maximize my asset integrity, availability, continuity, safety and sustainability?” and “how to manage all business risks associated with owning and operating an asset base...?”¹⁶

The record contains a number of other equally relevant references to “risk-based asset management” used by third parties in a descriptive manner consistent with the significance that these words are given by Applicant.¹⁷

Applicant has submitted the declaration of Mike Poland, Applicant’s Director of Asset Management Services.¹⁸ Mr. Poland states, “I developed the concept of Risk-based Asset Management as a solution for [Applicant’s] clients in industry market segments including oil and gas, pharmaceuticals, power generation and mining.” He also states that he wrote an influential paper relating to principles of Risk-based Asset Management, and has made presentations regarding such principles at four industry conferences.¹⁹ However, the fact that an Applicant may be the first user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983). In this case, the component words of the phrase “risk-based asset management” are common words, each of which has relevant significance in the context of Applicant’s services.

¹⁵ *Id.* at 30-31.

¹⁶ *Id.* at 37.

¹⁷ Office action of February 23, 2013 at 13-25.

¹⁸ Request for reconsideration of July 30, 2013 at 17-18.

¹⁹ *Id.* ¶ 2.

Applicant's own marketing materials demonstrate how those words may be used individually in describing Applicant's services. The combination of the component words of this phrase does not result in any nondescriptive significance, and Applicant has not proposed that the phrase has any such nondescriptive significance. Moreover, the record shows that a substantial number of third parties have used the phrase "risk-based asset management" in a descriptive manner. *See In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (no need to analyze individual component words of a phrase where there is evidence of descriptive use of the phrase as a whole). We find the evidence of record sufficient to show that the expression "risk-based asset management" immediately conveys information regarding a feature of Applicant's business management, engineering consultation, and equipment maintenance consultation services and is accordingly merely descriptive, within the meaning of Section 2(e)(1), with respect to all three classes of services recited in the application.

We next must consider whether the designation RBAM, when viewed by relevant customers in the context of Applicant's services, would be generally understood to represent the words "risk-based asset management" and would be "accepted as substantially synonymous therewith." *Modern Optics*, 110 USPQ at 295. The Examining Attorney, in support of her position, has made of record the following evidence:

- A. Results of a search for RBAM on AF Acronym Finder, showing "Risk-Based Asset Management" among four other meanings.²⁰

²⁰ Office action of August 17, 2012 at 38-39.

- B. Web page at <psams.ca>, showing “RBAM Policy” as an item on the “Asset Management” menu, and policy statement with heading “Risk-Based Asset Management (RBAM) Policy.”²¹
- C. Abstract of paper entitled “Optimizing Maintenance and Inspection for New Offshore Installations, referring several times to “Risk Based Asset Management (RBAM)” and “RBAM process.”²²
- D. Website of Process Worldwide, referring to “Risk Based Asset Management (RBAM),” “RBAM process,” “RBAM... planning tool,” and “If you want to introduce RBAM....”²³
- E. Website of ATKearney, stating, “The migration toward risk-based asset management (RBAM) can reduce the required spend for asset maintenance and replacements.”²⁴
- F. Slide presentation of Lloyd’s Register Capstone entitled “Integrating People, Processes and Technology to Achieve Risk-based Asset Management,” including a slide with seven references to “RBAM,” e.g., “What is the scope of RBAM implementation on site...?”; “Who... will be responsible for RBAM and its associated work processes?”; “How are the RBAM work processes and procedures to be integrated...?”; and “How will RBAM affect maintenance and inspection workload...?”²⁵

With respect to the significance of RBAM, we note the declaration of Mike Poland, which states, in pertinent part:

4. I created the term RBAM to identify services offered and sold by [Applicant] that employ principles of Risk-based Asset Management.

5. ... I am familiar with the markets in which [Applicant] promotes and sells its ... services, and with the consumers of those services.... I am not aware of any other person or entity who uses the term RBAM to

²¹ *Id.* at 40-41.

²² *Id.* at 42-43.

²³ *Id.* at 44-47.

²⁴ Office action of February 23, 2013 at 30.

²⁵ *Id.* at 38, 49.

identify those services, other than [Applicant]. Relevant consumers would not readily understand the term RBAM to be substantially synonymous with management, consulting, maintenance and engineering services or with the term Risk-based Asset Management. ...²⁶

Applicant criticizes the reliability of the entry from AF Acronym Finder (item A above), saying that anyone may submit an acronym for inclusion and that the terms of use for the site disclaim responsibility for the accuracy of the information provided.²⁷ However, Applicant has not submitted a copy of the site's terms of use, nor any other evidence relating to the website. Applicant also points out that the AF Acronym Finder lists four alternative meanings for the acronym RBAM, indicating that it could be interpreted to have these other meanings, which are not descriptive of Applicant's services.²⁸ Although the possible interpretation of the acronym to have alternative meanings is a relevant point, it does not follow that the acronym cannot be found merely descriptive. 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 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 re Champion Int'l Corp.*, 183 USPQ 318, 320 (TTAB 1974). As we have noted above, the record shows that the expression

²⁶ Poland Declaration ¶¶ 4, 5; see Applicant's request for reconsideration of July 30, 2013 at 17-18.

²⁷ Applicant's brief, 11 TTABvue 12.

²⁸ *Id.* at 11-12.

“risk-based asset management” is in common use in fields relevant to Applicant’s services. It is self-evident that the letters RBAM are the initial letters of the words of this phrase. The entry from the AF Acronym Finder confirms that this correspondence has been noted by one or more compilers of or contributors to the database, but does not indicate that there is widespread exposure to or a general understanding of the correlation between the term “risk-based asset management” and the letters RBAM by relevant consumers .

Applicant points out that the website located at <psams.ca> (item B above) relates to a business that is apparently located in Canada and that it is therefore not indicative of usage of RBAM in the United States.²⁹ The examining Attorney ripostes that “as long as the evidence is written in English, information originating on foreign websites that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark.”³⁰ We agree with Applicant that this evidence should not be considered in this case. When English speakers in foreign countries use ordinary English words in the context of standard grammatical structures, such use may reveal something about the meanings of the words used. However, RBAM is not an ordinary English word; it is more in the nature of an abstract symbol. We find that its use by a Canadian company does not indicate that businesses in the United States have adopted the use of this symbol to mean “risk-based asset management” or that relevant consumers would understand it as such.

²⁹ *Id.* at 13.

³⁰ Examining Attorney’s brief, 13 TTABvue 7.

Applicant appears to criticize items C and D on the ground that they do not show “commercial use” of the designation RBAM. Similarly, Applicant argues that item F shows use of the designation only in the form of an educational webinar used internally within a company, and not disseminated to the public. While it is true that evidence showing that the public has been repeatedly exposed to use of the acronym RBAM would be highly relevant to our inquiry, items C, D and F are nonetheless probative of the meaning that persons in certain industries have assigned to the designation RBAM.

Finally, we note Applicant’s objection to item E, on the ground that the authors of the piece, who are personnel of ATKearney, “are all from Germany.” Nonetheless, the website shows that ATKearney has locations in eight United States cities, suggesting that the marketing piece is intended for dissemination to the United States.

After careful review of all of the evidence of record, we find that it does not support a finding that the designation RBAM is “so generally understood” by relevant customers to mean *risk-based asset management* “as to be accepted as substantially synonymous therewith.” *Modern Optics*, 110 USPQ at 295. In reaching this determination, we note that, with only one exception, the examples of use that are of record never show the expression RBAM *alone* unless it has earlier appeared in the form “risk-based asset management (RBAM).” This form of usage may suggest that the writer would not expect readers to understand the acronym without explanation. The one exception is the slide presentation described as item

F above; but that presentation has the wording “Risk Based Asset Management” in bold lettering at the bottom of every slide. We also note that the number of examples of use of the acronym in the record is objectively small. Finally, the record includes Mr. Poland’s declaration wherein he states unequivocally that he is unaware of any third-party uses of RBAM in connection with similar services.

Although we are not without doubt as to whether RBAM may have descriptive meaning in the relevant field, we resolve that doubt in favor of Applicant. *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).³¹ Accordingly, we reverse the Examining Attorney’s refusal under Trademark Act § 2(e)(1).

Decision: The refusal to register is reversed.

³¹ We observe nonetheless that on a different record, such as might be adduced by a competitor in the field in an opposition proceeding, we might reach a different conclusion.