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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re The Rainmaker Agency, LLC

Application No. 85743797
Filed: October 2, 2012

Joseph S. Heino, Davis & Kuelthau SC, for applicant.

Edward Fennessy, Examining Attorney, K. Margaret Le, Managing Attorney, Law Office 114.

Before Bucher, Mermelstein, and Masiello, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Based on use of the mark in commerce,¹ applicant seeks registration on the Principal Register of the mark **THE RAINMAKER AGENCY** for

business management services, namely, sales management consulting services; Marketing services, namely, providing independent sales representation; Business development services

in International Class 35.

The examining attorney refused registration of applicant's mark, alleging: (1) that applicant's mark is merely descriptive of the identified services, Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1); and (2) that applicant failed to respond fully to a request for information pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b). We af-

¹ Applicant alleges first use of the mark on January 1, 2010, and first use in commerce on April 30, 2010.

firm both the requirement and the refusal to register.

I. Requirement for Information

A. Background

In his first Office action, the examining attorney required applicant to provide certain information, including an answer to the following two questions:

- 1) Does the applicant provide “rainmaking?”
- 2) Does the applicant provide clients with sales representatives who generate sales leads, new customers or clients, and/or new or increased revenue from new or existing accounts?

In response to this requirement, applicant submitted pages from its website, indicating that they “impart additional information as to the services provided by the Applicant under it’s [sic] THE RAINMAKER AGENCY mark.” *Resp. & Exh. C1–C2* (Jul. 31, 2013). Finding that “Applicant’s response did not provide answers to the ... questions,” the examining attorney repeated the requirement for information in his final Office action. *See Final Ofc. Action* (Aug. 26, 2013).

In a request for reconsideration, applicant provided further pages from its website and some argument without directly answering either of the two questions. *Req. for Recon.* at 6–7 (Feb. 26, 2014). This time, the examining attorney was satisfied with applicant’s response to the first question, but maintained that

[a]pplicant’s answers do not completely and clearly respond to the second question posed, which is necessary to enable a fair and informed examination of the application for registration. Therefore, this requirement is continued and maintained as to the second question.

Recon. Denied (Apr. 9, 2014).

Although the requirement for an answer to the examining attorney's second question was made twice and adhered to upon reconsideration,² applicant did not argue this issue in its opening brief,³ nor did it file a reply brief. By contrast, the examining attorney briefed this issue. *Ex. Att. Br.* at 16–17.

B. Discussion

“The Office may require the applicant to furnish such information ... as may be reasonably necessary to the proper examination of the application.” Trademark Rule 2.61(b). As we noted recently:

Failure to comply with a request for information is grounds for refusal of registration. *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP § 814. In view of applicant's equivocal responses (not to mention its complete silence on this point in its brief), we find that applicant has not complied with the requirement for more specific information.

In re AOP LLC, 107 USPQ2d 1644, 1651 (TTAB 2013).

Although applicant supplied information from its website and argued that it is not

² Curiously, this requirement was never stated to be “final.” Pursuant to Trademark Rule 2.141(a), an applicant may only appeal from a *final* refusal or requirement. Yet the same rule goes on to say that “[a] second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.” In this case, the requirement was repeated three times, so applicant was entitled to appeal notwithstanding that the requirement was never formally declared to be “final.”

³ Applicant attempts to “incorporate[] its prior arguments in [its] Brief by reference for purpose of brevity.” *App. Br.* at 8. While we appreciate the brevity of applicant's brief, we cannot accept the incorporation in it of unspecified arguments made during examination. Because arguments for and against registrability often shift or narrow during the course of examination, all issues on appeal must be raised and argued in an appellant's opening brief. *Cf. General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011) (issues not raised in a party's brief are deemed waived). We have carefully reviewed the application file and have considered all of the *evidence* in the record, but we will not sift through the file in an attempt to divine which additional issues or arguments applicant might have made on appeal, but did not bother to include in its brief.

a “rainmaker,” applicant provided no direct answer to the examining attorney’s outstanding second question. We find the question about applicant’s services clearly relevant to the examining attorney’s Trademark Act § 2(e)(1) refusal and “reasonably necessary” to examination of the application. At no point did applicant argue that the question was irrelevant or burdensome, and we do not think it was. This was a specific question requiring only a yes-or-no answer. (The argument and evidence applicant did submit in response to the examining attorney’s questions clearly required more effort than would have been necessary to simply answer the question.)

Applicant offers no explanation or argument in its opening (and only) brief with respect to this requirement, or any argument at all on the issue. The rules require that “[a]ll requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.” Trademark Rule 2.142(c). Therefore, if an applicant fails to raise the issue of an outstanding requirement on appeal, the Board may affirm the refusal to register, notwithstanding the merits of the substantive issues which have been raised. *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (affirming refusal to register on the basis of an unsatisfied request for information under Trademark Rule 2.61(b)); *see In re Cord Crafts Inc.*, 11 USPQ2d 1157 n.2 (TTAB 1989).

Accordingly, we will affirm the examining attorney’s requirement for an answer to his second question (a) on the merits, and (b) regardless of the merits of this issue, due to applicant’s failure to either satisfy the requirement or raise it on appeal. Further, because applicant inexcusably failed to comply fully with the examining attorney’s

straightforward request for information, we will presume that the answer to the question would not have been favorable to applicant's position.⁴ *Cheezwhse.com*, 85 USPQ2d at 1919; *Babies Beat*, 13 USPQ2d at 1730–31 (“[D]espite repeated requests by the Examining Attorney that applicant furnish copies of these patent applications, applicant never did so. Hence, this Board is left to assume that one [of them] could constitute evidence as to the functional nature of applicant's design.”).

II. Mere Descriptiveness

Although the outstanding request for information is itself sufficient to affirm the refusal to register, we will consider the examining attorney's Trademark Act § 2(e)(1) refusal for the sake of completeness. Registration was refused based on the examining attorney's determination that applicant's mark, **THE RAINMAKER AGENCY**, is merely descriptive of

business management services, namely, sales management consulting services; Marketing services, namely, providing independent sales representation; Business development services.

A. Applicable Law

A term that is merely descriptive of the applicant's goods may not be registered on the Principal Register without a showing of acquired distinctiveness. Trademark Act §§ 2(e)(1), 2(f). “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219

⁴ We thus presume that applicant *does* provide clients with sales representatives who generate sales leads, new customers or clients, or new or increased revenue from new or existing accounts.

(Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009–10 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods 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 Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316–17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (TTAB 2010) (quoting *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978)), *vacated-in-part on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

B. Arguments and Evidence

The examining attorney considered the meaning of the words comprising applicant’s mark as well as the meaning of the mark as a whole.

First, the examining attorney contends that in the context of applicant’s services, “the word ‘RAINMAKER’ refers to a sales representative and a business development professional,” *Ex. Att. Br.* at 3 (unnumbered) (capitalization altered). A variety of evi-

dence was submitted in support of this definition, including the following:

Rainmaker

Definition: Someone who can make things happen. **Definition:** A valuable employee, manager or subcontracted person who brings new business to a company.

MONEYGLOSSARY.COM <http://www.moneyglossary.com/?w=Rainmaker> (Aug. 19, 2013),

Final Ofc. Action (Aug. 26, 2013).

rainmaker *noun* activity to develop business, bringgng [*sic*] in a case flow, bringing in cases, bringing in new busiess [*sic*], bringing in new clients, bringing in new files, bringing in new matters, bringing in work, client development, pro-oucing [*sic*] business, producing new clients, producing new work

Associated concepts: business development, client development, marketing

THE FREE DICTIONARY, <http://legal-dictionary.thefreedictionary.com/rainmaker> (Aug. 19, 2013), *Final Ofc. Action* (Aug. 26, 2013).

Rainmaker

A valuable employee, manager or subcontracted person who brings new business to a company.

...

Rainmaker

Informal: a facilitator of a deal. The term especially applies to an employee whose sole duty is to bring in new business from wealthy clients. That is, the rainmaker meets with potential clients and convinces them to come to [*sic*] business with the rainmaker's company. See also: Finder's Fee.

...

rainmaker

A brokerage firm employee who brings a wealthy client base

to the business.

THE FREE DICTIONARY, <http://financial-dictionary.thefreedictionary.com/Rainmaker>

(Aug. 26, 2013), *Final Ofc. Action* (Aug. 26, 2013).

rainmaker

...

noun

1 a person who attempts to cause rain to fall, either by rituals or by a scientific technique such as seeding clouds with crystals.

2 *North American Informal* a person who generates income for a business or organization by brokering deals or attracting clients or funds.

OXFORD DICTIONARIES, <http://www.oxforddictionaries.com/definition/english/rainmaker>

?view-uk (Aug. 19, 2013), *Final Ofc. Action* (Aug. 26, 2013).

1. rainmaker

An employee who creates a significant amount of new business to [*sic*] a company. This term is often used in the context of a financial services company, such as a brokerage.

We need to hire a rainmaker to bring our business up from a slump of no sales.

URBAN DICTIONARY, <http://www.urbandictionary.com/define.php?term-rainmaker> (Aug.

26, 2013, *Final Ofc. Action* (Aug. 26, 2013)).

rainmaker

...

1. (among American Indians) a medicine man who by various rituals and incantations seeks to cause rain.

2. a person who induces rainfall by using various scientific techniques, as the seeding of clouds with silver iodide crystals from an airplane.

3. *Slang*. an executive or lawyer with exceptional ability to attract clients, use political connections, increase profits, etc.: *The president has several rainmakers among his advisors.*

DICTIONARY.COM unabridged (Random House Dictionary (2013)), <http://dictionary.reference.com/browse/rainmaker?r=66> (Aug. 26, 2013), *Final Ofc. Action* (Aug. 26, 2013).

In business, a rainmaker is a person who brings in new business and wins new accounts almost by magic, since it is often not readily apparent how this new business activity is caused. It means generating substantial new business or additional cash flow from sources sometimes outside established business channels, sometimes by connecting with people in non-traditional or hidden markets, and sometimes by prompting current clients to spend more money. A rainmaker is usually a key figure in the business or organization, not merely a salesperson, but a principal or executive who is usually highly regarded within the enterprise.

Wikipedia, *Rainmaker (business)*, [http://en.wikipedia.org/wiki/Rainmaker_\(business\)](http://en.wikipedia.org/wiki/Rainmaker_(business)) (April 8, 2014), *Recon. Denied* (Apr. 9, 2014).

We've found that the top performing salespeople, rainmakers if you will, share 10 common beliefs, actions, attitudes, and rituals that define their sales motivation and set them apart from the pack. We call them the 10 Rainmaker Principles. . . .

Mike Schultz, *10 Rainmaker Principles and Keys to Sales Motivation*, Rain Selling Blog, <http://www.rainsalestraining.com/blog/sales-motivation-keys-and-10-rainmaker-principles/> (Apr. 8, 2014), *Recon. Denied* (Apr. 9, 2014).

[T]his hard-hitting collection of sales advice shows readers how to woo, pursue, and finally win any customer. ... A terrific resource for CEOs, as well as anyone looking to distinguish themselves in sales — be it books, cars, or real estate — *How to Become a Rainmaker* offers the opportunity to rise above the competition in any company, in any field.

Review (unsigned), Amazon.com (reviewing Jeffrey J. Fox, *How to Become a Rainmaker: The Rules for Getting and Keeping Customers and Clients*), <http://www.amazon.com/How-Become-Rainmaker-Getting-Customers/dp/0786865954> (Apr. 8, 2014), *Recon. Denied* (Apr. 9, 2014).

In companies that use salespeople to sell directly to customers, rainmakers are the people who bring in the business. Rainmakers bring in big revenues, big money. Rainmakers bring in new revenues, new customers. Rainmakers sell new applications, new products, and price increases. Rainmakers make the cash register ring. ...

Jeffrey J. Fox, *Secrets of the Great Rainmakers*, <http://www.nightingale.com/articles/secrets-of-the-great-rainmakers/> (Apr. 8, 2014), *Recon. Denied* (Apr. 9, 2014).

Like many business owners and sales managers right now, there's a strong initiative to recruit new talent that can drive sales during these more challenging times. Companies are scrambling to find more rainmakers rather than order-takers to build out their sales team — and the line of disparity continues to widen between the two, as many salespeople are struggling to keep up and make the necessary and rapid changes needed in their sales process and strategy, as well as in how they think in order to adapt to and thrive in this new marketplace.

Keith Rosen, *Need a Rainmaker? Hiring The Right Salesperson Means Recruiting at a Deeper Level*, allBusiness, <http://www.allbusiness.com/labor-employment/human-resources-personnel-management/11480334-1.html> (Apr. 8, 2014), *Recon. Denied* (Apr. 9, 2014).

The examining attorney also submitted five registrations of marks on the Principal Register, each including the term “rainmaker,” and in which that term was either disclaimed or registered under the provisions of Trademark Act § 2(f); and three Supplemental registrations in which “rainmaker” also forms part of the mark. *Final Ofc. Ac-*

tion (Aug. 26, 2013). Third-party registrations in which a term is disclaimed, registered pursuant to Trademark Act § 2(f), or on the Supplemental Register, tend to suggest that the term in question is not inherently distinctive. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry”).

Second, the examining attorney contends that “the word ‘AGENCY’ refers generally to a business or other organization that provides a service or services.” *Ex. Atty. Br.* at 8. In support of this point, the examining attorney submitted nine use-based registrations⁵ on the Principal Register in which the word “AGENCY” is disclaimed, *Recon. Denied* (Apr. 9, 2014), as well as the following dictionary definition:

***agency* . . .**

1. a business or other organization providing a specific service ⇒ *an employment agency*
2. the place where an agent conducts business
3. the business, duties, or functions of an agent

⁵ The examining attorney actually submitted twelve registrations for this purpose, but three of them were based on applications under Trademark Act § 66 (*i.e.*, pursuant to the Madrid Protocol), which need not show use of the mark in United States commerce prior to registration, Trademark Act § 68(a)(3), and none of the registrants has yet filed an affidavit under Trademark Act § 71, attesting to such use. In other contexts, we have declined to give non-use-based registrations weight in making inferences about the United States marketplace or the perception of United States consumers. *E.g.*, *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (registrations based on §§ 44 or 66 “have no probative value in showing the relatedness of the services” identified in them). While we have not previously considered whether registrations issued under Trademark Act §§ 44 or 66 should be considered for the purpose here advanced by the examining attorney — *i.e.*, as evidence of the descriptiveness of a term — we need not answer the question because the nine remaining registrations (and other evidence) are sufficient evidence of the meaning of “agency.”

4. action, power, or operation \Rightarrow *the agency of fate*
5. intercession or mediation
6. one of the administrative organizations of a government

COLLINS DICTIONARIES, English, <http://www.collinsdictionary.com/dictionary/english/agency> (Aug. 26, 2013), *First Ofc. Action* (Jan. 31, 2013).

Third, the examining attorney asserts that when added to a descriptive or generic term, the word “the” “does not add any source-indicating significance or otherwise affect the ... descriptiveness or genericness” of the mark. *Ex. Att. Br.* at 9.

Finally, the examining attorney argues that applicant’s composite mark is descriptive in its entirety, and that the nondistinctive elements of applicant’s mark do not by reason of their combination result in a distinctive mark. *Ex. Att. Br.* at 10.

Not surprisingly, applicant disagrees. The principal contentions in applicant’s brief are that the applied-for mark must be considered in its entirety, that the mark does not merely describe applicant’s services, and that other registrations exist in which the applicant has not disclaimed “RAINMAKER.”

First, applicant asserts that **THE RAINMAKER AGENCY** is a unitary mark, and that the elements comprising it should not be separately considered. *App. Br.* at 3. The examining attorney disagrees, noting that a unitary mark is one in which the parts are inextricably merged, either physically or conceptually. *Ex. Att. Br.* at 12–13. “[T]here is nothing in the record to suggest that consumers of the relevant services would view the wording in the mark as inseparable or capable of creating any commercial impression that is different from the significance of the individual wording in the mark.” *Id.* at 13.

Similarly, applicant contends that its mark may only be considered as a whole, and

that the examining attorney’s inquiry into the meaning of the separate words comprising applicant’s mark was inappropriate. *App. Br.* at 3 (“marks should be considered in their entirety and not improperly dissected”).

Finally, applicant argues that the USPTO has registered “many” RAINMAKER marks, “most without disclaimers of just the word RAINMAKER.” (arguing that the third-party registrations show that the term “is not descriptive but suggestive, and that the PTO has acted accordingly”); *App. Br.* at 5. Applicant submitted 20 registrations,⁶ all including the term **RAINMAKER** in support of its argument. *Response to Ofc. Action* Exh. A–B (July 31, 2013).

C. Discussion

To begin with, we agree with the examining attorney that **THE RAINMAKER AGENCY** is not unitary. A unitary mark (or part of a mark) is one in which the constituent elements would be perceived by the relevant purchaser as having “a distinct meaning of its own independent of the meaning of its constituent elements.” *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). There is nothing about the words in applicant’s mark which links them inextricably. The words are not physically joined; nor is there any contention that the meaning or commercial impression of any of the words in applicant’s mark would be different if it

⁶ Three of the registrations submitted by applicant (Nos. 3196547, 3297004, and 2754950) have been cancelled and therefore will not be considered. It is well-established that a cancelled or expired registration is evidence of nothing but the fact that it once issued. *See Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). In particular, such a registration is not entitled to the presumptions under Trademark Act § 7(b), including the presumption that the registration was valid. *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973).

were removed from the mark, or that the meaning of any of the terms depends on its being used with any of the other terms. The impression of the applied-for mark is no more (or less) than the sum of its parts.

Nonetheless, this issue is a red herring. Even if **THE RAINMAKER AGENCY** were considered unitary it would not be insulated from a descriptiveness refusal, because a unitary mark which is descriptive or generic *as a whole* is no more registrable than a non-unitary mark which is descriptive or generic as a whole. *E.g., In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (holding **SCREENWIPE** generic; “Whether compounded as ... two words ... [or] one ... either is ordinary grammatical construction.... Nothing is left for speculation or conjecture in the alleged trademark.”); *In re Tower Tech Inc.*, 64 USPQ2d at 1315, 1318 (holding **SMARTTOWER** descriptive; considering dictionary definitions of “smart” and “tower”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (holding **AGENTBEANS** descriptive; the fact that the unitary term “does not appear in a dictionary is not determinative”); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (holding **BATTLECAM** descriptive notwithstanding its absence from dictionaries).

In a related argument, applicant contends that the examining attorney’s evidence and analysis of the individual words in applicant’s mark should not be considered because its mark must be considered in its entirety. We disagree. While a final determination of descriptiveness must be based on the impression of the entire mark, the cases just cited make clear that when consumers would perceive separate elements in a

mark, it is appropriate to consider the meaning or impression formed by those elements. Here, it is obvious that applicant's mark comprises three words, "THE," "RAINMAKER," and "AGENCY," and that the purchasers of applicant's services would readily recognize those words. Applicant does not contend that there is some special meaning of **THE RAINMAKER AGENCY** as a phrase other than the ordinary meaning of its three words, and we see no such meaning. It was therefore appropriate for the examining attorney to consider the meaning of those separate words, so long as the final determination of descriptiveness was based on the mark as a whole — *i.e.*, on the combination of those terms in the applied-for mark. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) ("In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components. ... However, if those ... portions individually are merely descriptive of an aspect of appellant's goods, the PTO must also determine whether the mark as a whole, *i.e.*, the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts." (citation omitted)). Applicant's mark, **THE RAINMAKER AGENCY** comprises three readily recognizable English words, and applicant's customers would undoubtedly see it as such rather than as an arbitrary arrangement of words or letters having no meaning in the context of applicant's services.

Considering the words in the mark, the examining attorney maintains that the term "RAINMAKER" "refer[s] to someone who creates additional business or revenue, typically by soliciting potential clients or customers as new accounts []or closing signif-

ificant sales deals.” *Ex. Att. Br.* at 3–4. This definition is well-supported by the evidence of record, which indicates, for example, that a “RAINMAKER” is “[a] valuable employee, manager or subcontracted person who brings new business to a company,” MONEYGLOSSARY.COM, *supra*, one who develops business or brings in cases, clients, and new business, THE FREE DICTIONARY, *supra*, or “a person who generates income for a business or organization by brokering deals or attracting clients or funds, OXFORD DICTIONARIES, *supra*. Although these definitions (and the other evidence of record) differ slightly in the way they define the term, they are consistent in indicating that a rainmaker is one who attracts new clients or otherwise brings significant business to a firm.

It is clear that such services are encompassed by applicant’s identified “sales management consulting services,” sales representation,” and “business development services.” Indeed, applicant’s website indicates that it “provides leading-edge sales management consulting to small and medium sized businesses ... that are serious about advancing, [*sic*] their sales pipeline, sales results and sales revenue to the next level,” Applicant’s website (no URL or date given), *Response to Ofc. Action* Exh. C1 (July 31, 2013). In other words, applicant shows its clients how to be “rainmakers.” Likewise, applicant provides “independent sales representation, ... providing highly effective business development and account management services....” *Id.* This marketing service encompasses the provision of sales representation which brings in new business and revenue. In other words, applicant performs the functions of a rainmaker for its clients or provides personnel who perform the function of rainmakers.

Although applicant acknowledges that “RAINMAKER’ may be a term of art within the area of business,”⁷ *Ex. Att. Br.* at 10 (quoting *Req. for Recon.* at 6); *see; App. Br.* at 2, it nonetheless maintains that

the position taken by the Examining Attorney is one that is hopelessly entrenched in the notion that the name or label that can be given to a person or individual who succeeds in promoting himself or herself as one being very good at what he or she does, is synonymous with the services that are provided by the Applicant under its Mark. As a preliminary matter, Applicant, as a business entity, cannot perform the services of “rainmaking” on its own. Further, and even if Applicant was capable of providing such services (which it cannot), the Applicant’s services are, [*sic*] not so limited.

App. Br. at 4.

Applicant’s first contention — that applicant cannot possibly be a rainmaker or perform the services of such a person because the evidence shows that rainmakers are individuals and applicant is a business entity⁸ — approaches the issue from the wrong perspective. In considering whether a mark is descriptive, we refer to the goods or services set out in the application, regardless of whether applicant is a natural or juridical person. It is well-established that a term is merely descriptive if it immediately identifies a feature, function, or characteristic of the recited services. *E.g., Chamber of Com-*

⁷ Notwithstanding its acknowledgement, applicant notes that a “rainmaker” can be “someone who manipulates the weather to produce rain,” although it admits this definition is “somewhat archaic.” *App. Br.* at 6 n.2. The fact that a term may have more than one meaning or sense is irrelevant. The descriptiveness of a mark is not considered in the abstract, but in the context of the services in connection with which it is used. *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). Aside from being “archaic,” the definition of a “rainmaker” as one who literally makes it rain is irrelevant, because rain-making has nothing at all to do with applicant’s services. Other meanings of the term in other contexts are not relevant. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

⁸ The application indicates that applicant is a Limited Liability Company organized under the laws of Wisconsin.

merce, 102 USPQ2d at 1219. The focus is on the relationship of the mark to the *services set out in the application*, and not the relationship of the mark to the applicant itself or the applicant’s actual services. Thus, a term which is merely descriptive of an identified service which is normally performed by a natural person is likewise merely descriptive when the applicant is a business entity that performs the same service or provides personnel who do so. Whether the mark is descriptive of an applicant’s *actual* services — or indeed, whether applicant is even able to perform those services — is not important in a descriptiveness analysis for purposes of registration. As a result, even if we were convinced that it is impossible for applicant to provide the services of a rainmaker because applicant is not a human being, we would nonetheless find “rainmaker” merely descriptive if applicant seeks registration for services which include those of a rainmaker.⁹

⁹ Adoption of applicant’s theory would raise serious policy concerns. Merely descriptive terms are barred from registration “(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) (citing *Armour & Co. v. Organon Inc.*, 245 F.2d 495, 114 USPQ 334, 337–38 (CCPA 1957)).

Suppose a corporation were allowed to register an otherwise merely descriptive term for its services because the term described the function or activity of a person, rather than a corporation. Cloaked with the mantle of presumptive validity, the corporate registrant would be in a position to claim that an individual competitor using the same term in promoting or providing the same services is likely to cause confusion, notwithstanding that the term — when used by the individual — is by applicant’s own reasoning descriptive of the individual’s services.

Consider also that our hypothetical corporate registrant would be able to license use of the registered mark or to assign it (along with the associated goodwill) to an individual for whom use of the mark *would* be descriptive, despite the fact that the individual would not have been able to register the mark in her own right. Because the USPTO has no post-registration authority to reexamine the registrability of a mark *ex parte*, even if the mark “becomes” merely descriptive by virtue of a post-registration license or assignment, the now-unregistrable mark would remain on the Principal Register, forcing competitors to give up their use of descriptive

(continued...)

Applicant's other argument — that its services are not limited to those related to rainmaking — is likewise incorrect. “The law is settled that registration should be refused if the mark is descriptive of *any* of the goods for which registration is sought.” *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975) (citing *In re Am. Soc’y Clinical Pathologists, Inc.*, 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1971)). So even if RAINMAKER is not descriptive of all of applicant’s services, registration must be refused if the term is descriptive of *any* of the services set out in the application.

We further agree with the examining attorney that the addition of “THE” and “AGENCY” to the descriptive term “RAINMAKER” does not result in a registrable mark. Admitting that AGENCY “conveys characteristics of the services,” applicant nonetheless maintains that “the word THE placed at the front of the mark and the inclusion of the word RAINMAKER ... makes the composite term distinctive as applied to the services, thus rendering the mark not descriptive, but suggestive.” *App. Br.* at 4. Yet applicant does not explain *how* adding the word THE to an otherwise descriptive term would result in a distinctive mark or why it does so in this case. Common articles like “the,” “an,” or “a,” are usually considered to have no trademark significance. Linguistically, they simply refer to another word or object in a phrase, but such terms neither distinguish the applicant’s services nor point to their source. *In re G.D. Searle & Co.*, 143 USPQ 220, 222–23 (TTAB 1964), *aff’d* 360 F.2d 650, 149 USPQ 619 (CCPA) (holding “**THE PILL**” generic for oral contraceptives; “the utilization of the article ‘the’

terms or risk costly disputes. In enacting Trademark Act § 2(e)(1), Congress sought to avoid placing such burdens on both competition and competitors.

and of quotation marks cannot convert a simple notation comprising ordinary words of the English language used in their ordinary sense into a registrable trademark”). We think it highly unlikely that customers would consider these common words to have any source-identifying capacity, and we see nothing in applicant’s mark that might point to a different conclusion.

The term “AGENCY” fares no better. Applicant concedes that “an ‘agency,’ ... is a type of business,” *App. Br.* at 3, and that the term “conveys characteristics of the services,” *App. Br.* at 4. Similarly, the dictionary definition submitted by the examining attorney defines an “agency” as “a business or other organization providing a specific service.” COLLINS DICTIONARY, *supra*. Thus, “AGENCY” simply names the kind of business organization that might provide the services recited in the application. Such terms have long been held to have no trademark significance. *E.g.*, *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“The addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them.”); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (“We find the addition of the company designation in this case to have no significance. . . .”); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539–40 (TTAB 1998) (“the term ‘Inc.’ in applicant’s mark does not serve to identify the source of applicant’s services but rather merely indicates the type of entity which performs the services, and thus has no service mark significance.” (citing *In re Indus. Relations Counselors, Inc.*, 224 USPQ 309, 311 n.7 (TTAB 1984) (Board attaches no trademark significance to the corporate identifier “Inc.”))). Accordingly, we find

“AGENCY” descriptive of applicant’s services.

Although we find the individual words in applicant’s mark to be descriptive, we must still consider the mark as a whole to determine whether it would tell the potential purchaser relevant information about the identified services. The clear answer is that applicant’s mark — **THE RAINMAKER AGENCY** — immediately, and without further thought or conjecture, would inform applicant’s potential customers that applicant provides business consultation to its clients to help them become or develop their own rainmakers, that applicant provides sales representation with the object of bringing in new business or revenue, and that applicant’s business development services bring in new business for its clients. Applicant’s mark is merely descriptive of all of these services, and as such is unregistrable.

Finally, we agree with the examining attorney that the third-party registrations applicant submitted do not support its position. The 17 registrations under consideration each include the term “rainmaker”; all but one includes other wording. Nonetheless, ten of them were registered with disclaimers of “rainmaker,” under the provisions of Trademark Act § 2(f), or on the Supplemental Register, all of which suggest that the term was treated as descriptive by the registrants or the USPTO. At best, this evidence demonstrates that “rainmaker” is sometimes treated as a descriptive term and sometimes it is not (by our count the score is 10–7, with descriptiveness winning).

Looking more closely, however, we note that although all of the registrations include services in International Class 35, some do not include services which are the

same or closely related to those at issue in this case.¹⁰ Those registrations are not helpful in considering whether the applied-for mark is descriptive of applicant's identified services, because the descriptiveness of a mark must be considered in relation to the particular services for which it is to be registered. Of the nine registrations which do recite services closely related to applicants',¹¹ *all of them* were registered with disclaimers, on the Supplemental Register, or pursuant to Trademark Act § 2(f). Thus applicant's evidence actually supports a conclusion that "rainmaker" is descriptive of applicant's services. That said, we are not bound to follow the decisions of examining attorneys reached in other cases based on other records. The Board must make its own determination of registrability based on the facts and circumstances relevant to this application. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986). Accordingly, we have noted the third-party registration evidence, but we do not give it much weight.

III. Conclusion

We have carefully considered all of the evidence of record and the arguments on appeal, including those we have not specifically addressed. For the foregoing reasons, we conclude that the examining attorney's requirement that applicant provide certain information was appropriate, and that it has not been satisfied; and we further find that **THE RAINMAKER AGENCY** is merely descriptive of the identified services, and

¹⁰ We also note that at least one (Registration No. 3287004 for LAND THE RAINMAKER) might have been considered a unitary slogan for which a disclaimer of one element would be unnecessary. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.05(b)(i) (April 2014).

¹¹ Registration Nos. 3343978, 3020357, 3810151, 3444490, 4236887, 3960088, 3851827, 3720720, and 3416348.

thus unregistrable on the Principal Register. Either of these issues would independently require affirmance of the refusal to register.

Decision: The examining attorney's requirement for information pursuant to Trademark Act § 2.61(b) is AFFIRMED. The refusal to register pursuant to Trademark Act § 2(e)(1) is likewise AFFIRMED.