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This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Direct Response Corporation

Serial No. 76121702

William R Hansen of Lathrop & Gage L.C. for Direct Response Corporation.

Amos T. Matthews, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Hanak, Bucher and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Direct Response Corporation has applied to register TEACHERS' INSURANCE PLAN as a mark for services identified, after amendment, as "insurance services, namely underwriting insurance in the fields of property, casualty and automobile insurance; insurance claims administration and processing; insurance consultation and insurance brokerage services," in Class 36.

The application originally sought registration of the proposed mark on the Principal Register and was based on applicant's intention to use the mark in commerce. The examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the proposed mark, when used in connection with the services, would be merely descriptive.¹ Such refusal was later made final. Applicant then filed an amendment alleging use of the mark and, in view of the examining attorney's refusal to allow the mark on the Principal Register, an amendment to seek registration on the Supplemental Register. The amendment to allege use asserts that the proposed mark was first used, and first used in commerce, "at least as early as October 2000."

When the application was filed, it included a disclaimer of "'Insurance' and 'Plan' apart from the mark as shown." In its response to the first office action, applicant voluntarily, i.e., without a request from the examining attorney, amended the disclaimer statement to

¹ The initial office action also included a refusal of registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), but applicant responded by noting that it had obtained an assignment of the cited registration; and it subsequently recorded the assignment, thereby obviating this refusal.

disclaim "Insurance Plan" apart from the mark as shown.²

Applicant did not seek to withdraw its disclaimer of "Insurance Plan" when it amended its application to seek registration of TEACHERS' INSURANCE PLAN on the Supplemental Register.

The examining attorney refused registration of the proposed mark on the Supplemental Register under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that TEACHERS' INSURANCE PLAN "is incapable of identifying the applicant's services and distinguishing them from others." In response, applicant argued that its proposed mark is "not primarily descriptive of the services." Though applicant acknowledged, "the words may be commonly used in the insurance industry in separate contexts," it asserted that "the combination formed by the union of the terms renders the mark either suggestive or distinctive." Applicant also asserted that it did not think grant of a registration "would preclude others in the insurance industry from using the terms 'teachers' insurance plan' in

² In correspondence between the examining attorney and applicant, there are certain references to a disclaimer of "Teachers," but this has neither been requested by the examining attorney nor offered by the applicant, and the references appear to have seeped into correspondence related to this application from correspondence about applicant's separate application to register TEACHERS.COM.

an ordinary descriptive sense to convey a descriptive meaning."

In the final refusal of registration, the examining attorney again stated that the proposed mark was "incapable," referred to evidence purportedly showing use of the phrase "in a highly descriptive manner," and concluded that the phrase is generic because "TEACHER identifies the consumers of applicant's services and INSURANCE PLAN is the genus of the services," and the combination "would have no separate or distinct commercial impression."

During prosecution of the application after its amendment to seek registration on the Supplemental Register, applicant and the examining attorney continued to present arguments about whether the proposed mark is descriptive or only suggestive (applicant) or highly descriptive (the examining attorney). Notwithstanding these arguments, it is clear from applicant's request for reconsideration and the examining attorney's denial of that request, that both the examining attorney and the applicant consider the ultimate legal question presented by the final refusal to be whether TEACHERS' INSURANCE PLAN is generic or merely descriptive and capable.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Id.* Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, supra, 4 USPQ2d at 1143, and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

The examining attorney asserts in his brief that the "genus or category of services at issue herein consists of programs to indemnify purchasers against specified losses

in return for [a] premium paid" and this is more succinctly "referred to as [an] insurance plan." Applicant appears to consider the genus of services to be much broader, as it asserts in its brief that "the mark TEACHERS' INSURANCE PLAN covers a variety of services ... The range of services covers much more than just insurance for teachers as the Examining Attorney suggests is the case." In advancing its argument, applicant essentially analogizes the collection of services it offers to those offered by the "American Society for Reproductive Medicine," see In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), and it asserts in its reply brief that "[t]he educational community regularly relies on TEACHERS' INSURANCE PLAN ... similar to how members of the American Fertility Society would rely on their membership for information." In particular, applicant notes in its brief that it offers, "besides casualty insurance, an education newsletter, school calendar, referral program, scholarship program, and ... state approved defensive driving programs."

These services are, however, beyond the scope of the identification of services listed in applicant's application. While we find the examining attorney's description of the involved genus too narrow, insofar as it does not encompass all the services identified in the

application, and we find the applicant's references to non-insurance services to expand improperly the genus or class of services involved herein, we find the identification of services in the application an appropriate description of the class of services. See In re American Institute of Certified Public Accountants, 65 USPQ2d 1972, 1981-82 (TTAB 2003). This identification encompasses insurance products offered to customers in need of such widely available forms of insurance as property, casualty and auto policies; insurance claims administration and processing services that could be offered, for example, on a contract basis to other insurers, including self-insurers; and, finally, insurance consultation and brokerage services, that could be offered, for example, to customers as diverse as individuals seeking a package of different types of insurance or to companies or government agencies seeking insurance products to offer in benefits packages.

Given this description of the class or genus of services, we find that the relevant public is broader than either the examining attorney or applicant has acknowledged. The examining attorney has focused only on teachers as the class of purchasers of applicant's services, while applicant has focused on a broader description including not just teachers but also "various

non-teaching employees of schools, universities and school districts and their families, such as cafeteria workers and janitors." (Brief, p. 9) As discussed above, however, in our discussion of the involved genus or class of services, applicant offers, according to its identification, services that could be bought by, for example, companies, school districts, unions or associations of employees, government agencies as well as the various types of individuals described by applicant. Thus, we must review the evidence of record to determine what the likely perception would be of TEACHERS' INSURANCE PLAN by a relatively broad "relevant public."

We note that certain classes of customers within this broadly construed relevant public may be more likely than others to have been reached by applicant's advertising and promotion, or its collateral services offered to members of the educational community. Thus, it is unlikely that the record will reveal a singular perception of the proposed mark. See *Certified Public Accountants*, 65 USPQ2d at 1983-84.

The record includes dictionary definitions of each of the words "teacher," "insurance" and "plan"; excerpts of articles retrieved from the Nexis research database; reprints of web pages from applicant's Internet web site;

and the "search results" listings of searches of the Internet utilizing the Google search engine, one search each done by both the applicant and the examining attorney.

As for the "search results" listings, we note that the examining attorney conducted a search that effectively retrieved web pages that have on them "teacher" or "insurance" or "plan." Applicant in contrast, notes that it searched for web pages that have on them the composite "teachers' insurance plan," i.e., applicant's proposed mark. It is not surprising, therefore, that the examining attorney has argued that his search results support the refusal of registration, while applicant has argued that the results of its search show recognition of "teachers' insurance plan" as a mark. We find neither of the search results lists particularly probative, as the excerpts that appear in such lists are extremely truncated and we do not have the web pages themselves from which to examine the context within which the search terms are used. Moreover, the searches that were conducted are the equivalent of extremely leading questions or biased surveys, intended not to shed light on patterns of usage among the relevant public but to highlight particular types of usage that support, respectively, the examining attorney's and the applicant's arguments.

Turning to the reprints of web pages accessed by visiting applicant's Internet web site, we note that the examining attorney and applicant both have put into the record certain pages. The totality of these pages shows, not surprisingly, that applicant frequently uses "teachers" in generic fashion to signify a subset of the larger group that it refers to as the education community or education employees, that applicant uses the term "insurance plan" in a generic manner, as in the phrase "auto insurance plan," and that applicant uses its proposed mark TEACHERS' INSURANCE PLAN. Applicant's web pages do not contain any self-defeating uses of "teachers' insurance plan," i.e., use in a way that would be perceived as generic, but its use of the phrase as a mark is not determinative of the ultimate issue in this case. Any business could present a descriptive or generic term on its web pages in the same manner of presentation or display that it would employ for displaying a trademark, and such a self-serving use would not reveal the likely perception of the relevant public when the term was displayed in a normal fashion.

We turn, then, to the dictionary definitions and Nexis excerpts of record as more probative evidence of the understanding of the relevant public. We agree with the examining attorney that the words teacher (and its plural,

possessive form teachers'), insurance and plan, when combined as "teachers' insurance plan," would retain their ordinary dictionary meanings. There is nothing about their combination that results in any ambiguity, incongruity, double entendre, or other effect that would make the whole greater than its parts. When, however, words are combined in a phrase, although we still consider the dictionary definitions of the individual words as evidence of the likely perception of the whole phrase, the examining attorney must present additional evidence establishing generic use of the phrase. *American Fertility*, 51 USPQ2d at 1836-37.

In this case, the only source of such evidence is the collection of Nexis excerpts put into the record.³ We note

³ Apart from the Nexis evidence of use of "teachers' insurance plan," and variations thereof, the examining attorney has also put into the record various Nexis excerpts showing generic use of "insurance plan(s)," including the following:

...transplants performed last year, 97 percent were, in fact, covered by private insurance, HMOs, PPOs, or government insurance plans.
CNN DayBreak, July 17, 2002.

Aetna is offering a new health insurance plan for employers with as few as 51 employees in an expansion of its consumer-directed products.
The Atlanta Journal and Constitution, July 17, 2002

...However, she gets no health coverage, vacation pay or other job benefits. But Brent is covered by her husband's insurance plan.
The Dallas Morning News, July 17, 2002

that the examining attorney and applicant have conducted separate searches of the Nexis database, but neither has put in all the obtained results. Understandably, each has put in results asserted to favor its position. In addition, there is a good deal of duplication in the record, which we have attempted to ferret out. Finally, we note that applicant contends that the Nexis excerpts put into the record by the examining attorney but which do not show use of the exact phrase "teachers' insurance plan" should be considered "mis-hits" and not probative. In essence, applicant discounts use of such slight variations as "teacher insurance plan" or "teachers' insurance plans."

Also driving up costs are consumers who are abandoning their HMOs and turning toward more traditional insurance plans, Flores said.

The Pueblo Chieftain (Colorado), July 17, 2002

HEADLINE: Senator at center of drug industry debate
Holmer said the drug industry favored Medicare coverage of prescription drugs, "offered through competing private insurance plans that rely on marketplace competition to control costs."

Chicago Tribune, July 17, 2002

HEADLINE: UPS talks to resume on contract in Chicago
In addition, the company will be offering a long-term care insurance plan for full-time retirees.

Chicago Tribune, July 17, 2002

Though these, of course, are not evidence of generic use of "teachers' insurance plan," we have considered these excerpts, just as we have considered the dictionary definitions of record. In addition, we have considered the third party registrations which the examining attorney has made of record and which include either "insurance plan" or "insurance plans" in their identifications of services.

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We find the distinction inappropriate. Evidence of use of variations on the phrase which utilize the same basic three words, in the same order, and differ only in terms of the use of singular or plural forms of "teacher" or "plan," or in terms of the use of the possessive apostrophe, are highly probative of the likely perception of the relevant public of "teachers' insurance plan."

Nexis excerpts of record introduced by the examining attorney and which are most supportive of the refusal include the following:

...Consider better benefits; did you know that child immunizations aren't even covered by the Mat-Su teachers insurance plan?
Anchorage Daily News, August 13, 2002

Starting July 1, the teachers' insurance plan will switch to a Preferred Provider Organization (PPO) network with higher deductibles and higher out-of-pocket expenses...
Chronicle Tribune (Marion, IN), April 30, 2002

...said the Legislature should consider levying a tax above the basic \$1.40 level to fully fund a state-paid teacher insurance plan.
Fort Worth Star Telegram, April 7, 2002

HEADLINE: Retired teachers insurance plan is saved
Chicago Daily Herald, December 21, 2001

...set a priority list for spending the state money, starting with copier paper for every school, a wage boost for the system's lowest-paid employees and extra money for the teacher insurance plan.
The Tennessean, October 4, 2001

HEADLINE: Teachers raises offset by rising insurance costs State won't absorb premium increase

John Greet, executive directive of the State and Public School Life and Health Insurance Board, which oversees state employee and teacher insurance plans, blames the cost increases on prescription drugs.

The Arkansas Democrat-Gazette, July 30, 2001

Creating a statewide teachers insurance plan is one of the session's top issues. Texas' teacher shortage is blamed in part on the lack of affordable health insurance.

San Antonio Express-News, May 9, 2001

Teachers' insurance plan modified

The Senate Education Committee unanimously approved their school employee health insurance plan Wednesday night...

Austin-American Statesman, May 3, 2001⁴

On Tuesday, Sadler said a tax increase would keep the teacher insurance plan from having the same problems as the state's insurance program for retired school employees.

Austin-American Statesman, March 21, 2001

...Insurance: An effort to let DeSoto and other school districts opt out of the state's public employee and teacher insurance plan and use the state dollars to buy their own insurance was viewed as a threat to the solvency of the plan.
The Commercial Appeal (Memphis, TN), January 31, 2001

HEADLINE: Teacher health plan gaining momentum ...
[sub-head:] Area teachers' insurance plans vs. state employees' plans
Teacher groups are pushing for a statewide insurance plan...

⁴ There is a similar excerpt of the same date, and apparently discussing the same piece of legislation, from the Fort Worth Star Telegram. In addition, there are two excerpts from May 2, 2001 in the Star Telegram that discuss early steps in the legislative process. Two of these three excerpts use "teacher insurance plan," while the third uses "teachers' insurance plan."

Austin-American Statesman, January 29, 2001

...only \$300 million will be available for new programs this session, far less than the \$1.4 billion needed for the teacher insurance plan.
San Antonio Express-News, January 26, 2001

HEADLINE: By waiving health benefit, teachers qualify for payout

...who forfeited their insurance likely were receiving health benefits from another source, such as a spouse's employer. By going without the teachers' insurance plan, they saved the school district thousands of dollars in premiums over the years.

The State Journal-Register (Springfield, Illinois), October 30, 2000

HEADLINE: Teachers' insurance rates soar...

...Pete Laney formed an interim committee on teacher health insurance in December to study options for teacher insurance plans.

Corpus Christi Caller-Times, January 19, 2000

...said that simply funding priorities important to teachers - a pay hike, increased retirement benefits and creation of a statewide teacher insurance plan - would cost more than \$5 billion.
The Fort Worth Star-Telegram, April 20, 1999

HEADLINE: Report: Texas teachers' insurance plan to fail in 2000

The Houston Chronicle, December 4, 1998

Swanson is expected to address the issues of the retired teachers' insurance plan and an ad hoc increase in retirement benefits for currently retired teachers.

Chicago Daily Herald, August 20, 1998

HEADLINE: Arbitrators Rule on Teachers Insurance
The changes made by the second arbitration panel focus on the teachers' insurance plan, Erdmann said Thursday.

The Hartford Courant, March 6, 1998

Bromm said he introduced the bill to elicit information about the teachers' insurance plan. "Perhaps bringing the teachers into the state plan is not the most efficient means of providing insurance to teachers, but I..."
Omaha World Herald, January 24, 1997

The Senate also preserved Allen's teacher insurance plan, which the governor says is needed to help teachers instill classroom discipline.
Daily Press (Newport News, VA), February 23, 1996⁵

HEADLINE: Health crisis for retired teachers; Insurance fund may need a state bailout
Officials hope to persuade the legislature to kick in state funding for the retired teachers' insurance plan, on grounds that the teachers should have the same security as other public employees.
The State Journal-Register (Springfield, Illinois), December 6, 1994

It also adds \$75,000 for a teachers' insurance plan over three years.
Chicago Tribune, November 19, 1986

Nexis excerpts of record that identify applicant and associate it with insurance products of the type listed in its application include the following:

HEADLINE: Drivers, trick-or-treaters ...can be overly excited and stray from the careful safety practices they already know, said Ray Palermo, director of Public Relations with Teachers' Insurance Plan, an insurance company which provides safe driving tips.
The Marshfield News (Marshfield, WI), October 30, 2003⁶

⁵ A similar excerpt, from the same publication, is dated February 19, 1996.

⁶ A similar excerpt, from the Fort Wayne News Sentinel, is dated two days earlier.

HEADLINE: CAREER LADDER

Stephen T. Zerio was named Connecticut manager of the newly formed Teacher Agent Network, part of the Teachers' Insurance Plan, Meriden.

Hartford Courant (Connecticut), October 5, 2003

The Teachers' Insurance Plan aims to make sure drivers around the country, no matter their level of driving acumen, drive safely and sanely.

AutoWeek, June 2, 2003

...deer foraging near roadsides - it's a very dangerous combination," said Ray Palermo, the director of public education for Teachers' Insurance Plan.

Statesman Journal (Salem, OR), November 27, 2002

...deer foraging near roadsides - it's a very dangerous combination," said Ray Palermo, the director of Public Education for Teachers' Insurance Plan, an auto insurance program based in Connecticut.

The Virginian-Pilot (Norfolk, VA), October 24, 2002

... Response operates the Teachers' Insurance Plan, which offers auto and home insurance to educators so it researches auto and home-related issues for its customers.

Connecticut Post (Bridgeport, CT), May 23, 2002

HEADLINE: School Vouchers Get Low Grades

...

The telephone survey of 1,046 respondents was sponsored by Teachers' Insurance Plan, an insurance program tailored exclusively for educators and their families. Nearly two-thirds of those surveyed (65%) said...

New York Voice Inc./Harlem USA, April 17, 2002

... Teacher's [sic] Insurance Plan, which caters to the specific needs of educators and their families, is providing its fraud prevention "Accident Action Pack" to all of its policyholders.

Best's Review, December 1, 2001⁷

HEADLINE: Harrisburg, Pa.-Area Educators Get Car-Insurance Price Break

...a 9-year-old auto insurance company, which is about to market discounted coverage to Pennsylvania educators.

"Actuarially, teachers are better than average risks," said John Brooks, national program manager for Teachers' Insurance Plan, based in White Plains, N.Y. ...

Teachers' Insurance Plan first offered policies in New York in 1992. The company is also rolling out coverage in Florida and Connecticut.

The Patriot-News, November 2, 2001

HEADLINE: Insurers Market to Teachers; Brief Article

Two insurance companies are reaching out to the educators market because of the high marks they earn in risk evaluation.

Teachers' Insurance Plan is a direct auto insurance program designed specifically for teachers. ...

Farmers Insurance Group of Cos., the nation's third-largest home and auto insurer, launched a...

Best's Review, October 1, 2001

...growing number of states, including California, have begun to tackle class size, and a national poll last month by the Teachers' Insurance Plan found class-size reduction the top priority among parents.

The Arizona Republic, October 1, 2001

...another school year and elected officials debating the fate of "failing schools," a newly released national survey by Teachers' Insurance Plan reveals that public school parents have their own set of answers that runs counter to some of the solutions currently on the table.

New York Voice Inc./Harlem USA, September 19, 2001

⁷ Also of record are excerpts from what appear to be distinct publications titled Claims Magazine and Claims, each of which also reported in December 2001 of applicant's development of the "Accident Action Pack."

HEADLINE: Direct Response Acquires Teachers
[sic] Insurance Plan

Direct Response Corp., the holding company of a group of national automobile insurance companies, has purchased the assets of Teachers [sic] Insurance Plan, a direct program marketed to teachers in New York and New Jersey. The acquisition includes exclusive rights to the Teachers Insurance Plan name (except Teachers Insurance Plan of New Jersey), and does not include staff, licences, infrastructure or any of the company's New Jersey business.

Claims, June 1, 2000

... He paid \$1,828 for the prior year's coverage, through Lancer's Teachers' Insurance Plan, for a package that included \$500,000 worth of liability coverage.

Newsday (New York), January 12, 1997

HEADLINE: SCHOOL VOTERS GUIDE 96 / SEAFORD

... He is the vice president of the Teachers [sic] Insurance Plan, which is part of Lancer Insurance.

Newsday (New York), May 19, 1996

HEADLINE: NEW POSITIONS

...INSURANCE

... Teachers [sic] Insurance Plan, a provider of auto and homeowners insurance for education professionals based in Long Beach, has hired Bill Lentino of ...

Newsday (New York), April 11, 1994

HEADLINE: NEW POSITIONS

...INSURANCE

Teachers' Insurance Plan, a Long Beach-based auto insurer for educational professionals, has appointed John E. Brooks of Seaford as director of operations. Teachers' Insurance Plan is a division of Lancer Insurance Co.

Newsday (New York), December 6, 1993

HEADLINE: NEW POSITIONS

...INSURANCE

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Teachers' Insurance Plan, a Long Beach-based auto insurer for educational professionals, has hired Karen Danza of New Hyde Park as...
Newsday (New York), November 8, 1993

There are additional Nexis excerpts which include applicant's proposed mark, but which are only listings of the "Teachers' Insurance Plan" trade name and contact information in directories or are only attributions of survey reports or graphs to Teachers' Insurance Plan, e.g., "Survey sponsor: Teachers [sic] Insurance Plan."

We also note that there are numerous references to Teachers' Insurance Plan in Nexis excerpts from wire service-distributed reports or press releases. These wire services include BestWire, Business Wire, and PR Newswire. Typically, the wire service excerpts bear a legend indicating targeted distribution, e.g., "Distribution: Business Editors" or "Distribution: To Education, Political and Family Editors." Excerpts of wire service reports or releases, in appropriate circumstances, can be accorded some probative value. See In re Cell Therapeutics Inc., 67 USPQ2d 1795 (TTAB 2003). However, there is nothing in the record to indicate that these wire service reports have been distributed any wider than to particular groups of editors for possible reprinting in various publications, i.e., there is nothing to indicate that they

have been "picked up and 'broadcast' on the Internet," so as to reach more members of the relevant public. *Id.* Accordingly, we have given the wire excerpts of record decidedly less value than the excerpts appearing in newspapers and magazines.⁸

In *Merrill Lynch*, the Federal Circuit noted that there was "a mixture of usages unearthed by the NEXIS computerized retrieval service" and held that CASH MANAGEMENT ACCOUNT was not a generic or common descriptive term because, inter alia, there was "recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was the appellant." *Merrill Lynch*, 4 USPQ2d at 1143. While there is a mixture of usages in this case, too, we find it distinguishable from *Merrill Lynch*.

In *Merrill Lynch*, the Board decision that was appealed to, and ultimately reversed by, the Federal Circuit, acknowledged that the applicant was a pioneer in offering

⁸ Where reports or press releases put out on wire services have been reprinted in newspapers or magazines, they then are retrievable from the Nexis database as newspaper or magazine articles. In this case, for example, the results of a Teachers' Insurance Plan National Education Survey were released via the PR Newswire service on September 5, 2001 and were reprinted in substantial part in New York Voice Inc./Harlem USA on September 19, 2001. Thus, while we have accorded little weight to the PR Newswire release because of its targeted distribution, we have accorded normal weight to the subsequent reprinting of that release in a publication.

the type of account at issue and was the first user of the term CASH MANAGEMENT ACCOUNT to designate such an account. *Merrill Lynch*, 4 USPQ2d at 1142. The Board, however, concluded that the evidence of record showed that the term subsequently was adopted by a major segment of the financial industry as the name for the type of account at issue. *Id.* at 1143. In short, the Board essentially held that CASH MANAGEMENT ACCOUNT, though first used by the applicant, had subsequently been widely adopted as the name of a type of account and, therefore, had *become* generic. The Federal Circuit, however, as noted above, found the evidence mixed and therefore insufficient to constitute clear evidence of generic use.

In the case before us, we find a different situation. We have considered the plain, dictionary meanings of the words that form the involved phrase; and the evidence of record showing generic use of "insurance plan" (the disclaimed portion of applicant's proposed mark); and the Nexis evidence that shows discussion of insurance plans for teachers by school boards, legislatures and others, and we find that "teachers' insurance plan," has been a name for insurance plans for teachers since well prior to applicant's first use of the proposed mark in October 2000, in conjunction with applicant's attempts to expand what was

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a business conducted in a limited area under a composite word and design mark that included a disclaimer of the words now proposed to be separately registered as a mark.⁹

The Nexis excerpts which support the examining attorney's refusal include at least ten instances of generic use of the proposed mark during the time period preceding applicant's first use of the phrase, apart from its use in the composite registration wherein the phrase was disclaimed. Such prior generic use has continued, as shown by the record. Unlike *Merrill Lynch*, this is not a case in which applicant has pioneered a product or service and only later has had to deal with generic uses of its proposed mark by others.

In In re American Institute of Certified Public Accountants, 65 USPQ2d 1972 (TTAB 2003), the Board also contemplated a record with mixed usages, but held "CPA Examination" generic and affirmed a refusal to register UNIFORM CPA EXAMINATION under Section 2(f) of the Trademark Act in the absence of a disclaimer of the generic part. In particular, the Board found that, notwithstanding recognition among the relevant public that the applicant

⁹ Registration No. 2331524 for the composite mark resulted from application serial no. 75574881, which claimed first use of the composite on March 1, 1992, but first use in commerce only as of December 1, 1996.

therein was the source of the UNIFORM CPA EXAMINATION, there was clear evidence of use by the relevant public of "CPA exam" and "CPA examination" in a generic manner. *Id.* at 1983-84.

In the case at hand, applicant's recent use of its proposed mark, its expansion into numerous states from its beginnings in New York, and its marketing to the educational community, may very well have resulted in some recognition of applicant as a source of the identified services. It is equally clear, however, that many members of the relevant public use "teachers' insurance plan," or the equivalents, in a generic manner to refer to various types of insurance plans for teachers. Even applicant expects that they will continue to use the phrase, as it has stated that it does not believe grant of a registration "would preclude others in the insurance industry from using the terms 'teachers' insurance plan' in an ordinary descriptive sense to convey a descriptive meaning."¹⁰ We do not see how others in the insurance industry could use

¹⁰ In regard to the subject of use by others in the insurance industry, we note the Nexis excerpt from the June 1, 2000 issue of Claims, which reports applicant's acquisition of the Teachers' Insurance Plan business and states: "The acquisition includes exclusive rights to the Teachers Insurance Plan name (except Teachers Insurance Plan of New Jersey), and does not include staff, licences, infrastructure or any of the company's New Jersey business." This indicates that a separate entity may be using Teachers' Insurance Plan in New Jersey.

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"teachers' insurance plan" in a manner that would be merely descriptive but not generic, or why applicant, if others can use the phrase, should be entitled to an exclusive registration, albeit on the Supplemental Register. When used by others, "teachers' insurance plan" could not be perceived as anything but the name of insurance plans for teachers. See Filipino Yellow Pages Inc. v. Asian Journal Publications Inc., 198 F.3d 1143, 53 USPQ2d 1001 (9th Cir. 1999) ("In light of the evidence presented by [defendant], it would seem that under the 'who-are-you/what-are-you' test, the term 'Filipino Yellow Pages' is generic. ... Giving [plaintiff] exclusive rights to the term 'Filipino Yellow Pages' might be inappropriate because it would effectively" grant a monopoly). See also, Blinded Veterans Association v. Blinded American Veterans Foundation, 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989) (Ginsburg, R.B., J.) (Court held "'blinded veterans' is generic when used to refer to once-sighted persons who served in the armed forces" and the BLINDED VETERANS ASSOCIATION name therefore was not entitled to trademark protection).

Decision: The examining attorney's refusal to approve registration of TEACHERS' INSURANCE PLAN on the Supplemental Register is affirmed.