

**This Opinion is Not a
Precedent of the TTAB**

Mailed: April 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dunham
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Serial No. 86941745
—

Phillip Thomas Horton, Esq.,
for Rachel Dunham.

Lauren E. Burke, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Wellington, Masiello, and Larkin,
Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Rachel Dunham (“Applicant”) filed an application for registration on the Principal Register of the mark BRAND THERAPY in standard characters for “Consulting in the field of graphic design; Graphic design,” in International Class 42.¹ Applicant has disclaimed the exclusive right to use BRAND apart from the mark as shown.

¹ Application Serial No. 86941745 was filed on March 16, 2016 on the basis of Applicant’s asserted use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating December 2015 as the date of first use and first use in commerce.

The Trademark Examining Attorney refused registration under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that Applicant's mark is generic with respect to Applicant's services; and, alternatively, under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of the services. When the refusal was made final, Applicant appealed to this Board. Applicant and the Examining Attorney have filed briefs. We reverse the refusal on both grounds.

I. Evidentiary matter.

Both Applicant and the Examining Attorney attached evidence to their briefs.² To the extent that the evidence was not previously submitted, it is untimely and we have not considered it. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *see also* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.01 (June 2017). Should any of the materials attached to the briefs have already been in the record, we have not compared them to the record evidence, but have based our decision solely on the evidence that is properly of record. *See* TBMP § 1203.02(e) (evidence already of record should not, as a matter of course, be resubmitted as exhibits to the brief). The Examining Attorney states, regarding her newly submitted evidence, that “[t]he content of the links to these websites have changed since the evidence was originally collected.”³ The evidence is nonetheless untimely. The Examining Attorney could have requested that the application be remanded for the

² Applicant's brief, 4 TTABVUE 24-33; Examining Attorney's brief, 6 TTABVUE 15-25.

³ Examining Attorney's brief, 6 TTABVUE 13.

introduction of the new evidence, and that process would have allowed Applicant the opportunity to see and respond to it. *See* TBMP § 1207.02.

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

We turn first to the Examining Attorney's refusal on the ground that Applicant's mark merely describes the identified services. A mark is merely descriptive of services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the 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 mark 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, we evaluate whether someone who knows what the services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). 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). Further, a mark need not describe every one of the identified services in an application in order to be considered merely

descriptive. 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*, 102 USPQ2d at 1219; *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). It is the Examining Attorney's burden to show, *prima facie*, that the mark is merely descriptive of Applicant's services. *In re Gyulay*, 3 USPQ2d at 1010; *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016).⁴

The Examining Attorney's position is that Applicant's mark describes a function of the services, arguing that "BRAND THERAPY" is a general term used to refer to the process of creating or re-creating graphic designs for use as brand images including consultation related to the graphic designs."⁵ The Examining Attorney has made of record internet web pages of various consultants, primarily in the field of business strategy, that make use of the expression "brand therapy," of which the following are excerpts:⁶

Aria Creative is a design consultancy specializing in strategic brand therapy. People see us for a variety of

⁴ Both Applicant and the Examining Attorney have referred to the three-part test described in *No Nonsense Fashions, Inc. v. Consol. Foods Corp.*, 226 USPQ 502 (TTAB 1985). That test has been superseded in the Federal Circuit by the rule that we apply here, as enunciated by the authorities discussed above. *See In re Fat Boys*, 118 USPQ2d at 1514-15 ("Under the current standard, there is no requirement that the Examining Attorney prove that others have used the mark at issue or that they need to use it, although such proof would be highly relevant to an analysis under Section 2(e)(1). ... The 'degree of imagination' test is still relevant as it is part of the concept of suggestiveness.").

⁵ Examining Attorney's brief, 6 TTABVUE 9.

⁶ We have not considered the web page at <round.com.au>, Office Action of September 10, 2016 at 3-4, because it appears to originate in Australia and, in the absence of evidence of its exposure to American consumers, it does not illustrate how "brand therapy" is used or understood in the United States.

reasons. Some are plagued by dreams of dangerous sea changes, of being chased through their office halls by zombie-faced competitors, and, most frequently, of finding themselves onstage at Carnegie Hall delivering a speech to 2,804 of their past, current and future clients – in the nude. ... Still others see us for something akin to well visits ...

As part of our work in the therapist's chair, we spend a lot of time digging around inside other people's heads. We listen, gently probing to determine a brand's patterns of attraction and its audience's level of engagement. Group sessions provide an opportunity for everyone to discuss how the brand is perceived, both internally and externally. When appropriate, together we explore new coping mechanisms to encourage behavior change.

<ariacreative.net>, Office Action of June 27, 2016 at 7.

Knowledge
BRAND THERAPY

The running joke around the Braizen offices is that we are one part designers, one part consultants, and two parts therapists. Over the years, we have noticed that a lot of our process involves drawing information out of our clients to help us to inform a new brand identity. The questions we ask of them go beyond "what's your favorite color?" or "what are you drawn to visually?" and are often more along the lines of "what do you hope to accomplish with your business?" and "what were you like as a child?" We sit our clients down on the metaphorical couch and let them talk, scribbling notes and pausing now and again for a "Mm hm" or a "that's interesting."

<braizen.com>, Office Action of June 27, 2016 at 8.

Grow your brand in 5 steps.

Step 1. Brand Check-Up

...

Step2. A Day Spa (for your brand)

Build your brand,
Find your niche.

Let's talk about your brand. Think of it as 'brand therapy', a space to explore your ideas and frustrations, and make sense of them.

<cordandberg.com>, Office Action of June 27, 2016 at 11.

Open contest

Therapist in desperate need of design/logo/brand therapy!
Ha ha!

<99designs.com>, Office Action of September 10, 2016 at 7.

Core Messaging

At the core of your business is your brand. ... Core Messaging gives you the opportunity to fully understand that brand so that you can leverage what makes you unique and excelling, capturing the attention of your target market.

Often referred to as brand therapy, you will work through the fundamentals of your business with goBRANDgo! As your guide. You will begin to see strengths that you never knew you possessed and weaknesses that you never knew you needed to tackle.

<gobrandgo.com>, Office Action of June 27, 2016 at 9.

Brand therapy

We interact constructively with the client to understand in-depth the brand vision and its positioning to define the strategic guidelines in order to build a distinctive service model & brand strategy, reinforcing and delivering innovative customer experience within the physical space.

<creainternational.com>, Office Action of June 27, 2016 at 13.

Brand Therapy

...

This process blends collaborative consultation with foundational messaging to build a practical tool kit.

<easgraphics.com>, Office Action of September 10, 2016 at 4.

IDENTITY & BRANDING

Think of us as the storytellers of your Brand. We listen to understand your core business objectives, ... then develop a set of comprehensive solutions to help you tell the right story ...

Built Environment

Devlop [*sic*] your brand from an architectural point of view across multiple dimensions ...

Brand Innovation

...

Brand Therapy

Provides a clearer picture of the real story being told, and how to refine and craft it for a better chance of favorably resonating with the intended audience.

<hubbsgroup.com>, Office Action of September 10, 2016 at 8.

We help communicate the beauty and power of your story.

But we believe the journey is just as important as the destination. Our process is designed to help you discover your “why”, connect deeply with your purpose, and then communicate that in an engaging way to your audience.

Ways we can serve you:

Identity Consulting: Exploring your “why” and discovering your brand personality and voice.

Brand Therapy: When your brand doesn't quite represent who you are...we will help get you back on track.

<chrysaliscreativenet>, Office Action of September 10, 2016 at 9.

Brand therapy is all about talking out your ideas, problems, hang-ups and goals for your business with a professional.

Brand therapy is a place where you can be free to brainstorm up new ideas or sort out questions about old ones. ... If you need a drink and a chat with a friend with marketing and design savvy, you could use a brand therapy session!

What Happens in Brand Therapy...

We'll explore what makes you unique, pinpoint a few goals, and brainstorm ways to move your brand in the direction you want it to go. Sometimes all you need is a person who knows marketing and design to talk things over with, a partner who can help you sort out ideas and formulate a plan, and get excited about your business again. ...

Brand therapy sessions are not about selling my design services, but often my design services can support the brand therapy sessions with action. ...

<rudipetry.com>, Office Action of June 27, 2016 at 4.

brand therapy

When you're walking in the woods it is nice to have a compass, right? ... In business we need a compass too, we need to know our own personal true North so we can make decisions and navigate obstacles and be confident that we're always going to get back on track.

...

Are you a business owner, artist, coach, consultant, or creative who feels driven by a sense of purpose? Do you feel that you are too often misunderstood? Do you keep

attracting the wrong types of clients? Do you keep saying yes to projects that don't excite you, that don't tap into your true talents or align with your values? **If you are nodding your head yes, then please read on.**

Brand therapy is a process to help you find and understand your compass, your values, the patterns and priorities that are core to how you approach business. The purpose is to get you spending more time doing what you're great at, work that gives you satisfaction and aligns with your values, and to be doing that work with and for people who in turn value you and what you do.

Not everyone needs this help. ... **To build the brand you want you first have to understand the relationship between you and the brand you currently have.**

<equationarts.com>, Office Action of June 27, 2016 at 5.

OUR SERVICES

Content Therapy

...

Digital Therapy

...

Brand Therapy

Your brand has a story to tell but you're not sure how to tell it, or who and when to tell it to. You need a strategy. With brand therapy you will receive a complete brand strategy roadmap to get you on the right path to digital nirvana and brand revitalization. Your roadmap will be complete with a plan of action ...

<jennymiranda.com>, Office Action of June 27, 2016 at 6.

Applicant argues that her mark is not merely descriptive because, in the context of Section 2(e)(1), "merely" means "only,"⁷ citing *In re Quik-Print Copy Shop*,

⁷ Applicant's brief at 13, 4 TTABVue 14.

Inc., 616 F.2d 523, 205 USPQ 505, 507, n7. Applicant contends that her mark is suggestive. “A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS*, 103 USPQ2d at 1755 (internal quotation marks omitted)). Applicant argues that “the ‘mental link’ between the trademark BRAND THERAPY and the Applicant’s services ... is neither immediate nor instantaneous”;⁸ and that the mark “creates an incongruity in the mind of a consumer by juxtaposing discordant elements or ideas by suggesting a brand can go to therapy [T]he incongruity is also an illustration of the degree to which imagination and a multi-step reasoning process is necessary for a viewer to arrive at a tolerably accurate understanding of the ... services.”⁹

Applicant’s contention is supported by the first four usage examples given above, in which BRAND THERAPY is used in a metaphorical or even facetious way in order to suggest that the offered service is similar to psychoanalysis or psychotherapy:

As part of our work in the therapist’s chair, we spend a lot of time digging around inside other people’s heads.”¹⁰

⁸ *Id.* at 17-18, 4 TTABVUE 18-19.

⁹ *Id.* at 20-21, 4 TTABVUE 21-22.

¹⁰ Office Action of June 27, 2016 at 7.

We sit our clients down on the metaphorical couch and let them talk ...¹¹

Brand Check-Up ... A Day Spa (for your brand) ...¹²

Therapist in desperate need of design/logo/brand therapy!
Ha ha!¹³

The Examining Attorney appears to argue that, despite the mark's suggestion of psychoanalysis or psychotherapy, it has been adopted as industry jargon and has become merely descriptive terminology. We have considered all of the Examining Attorney's usage examples carefully. Among the various users there does not appear to be agreement as to the meaning (if any) of BRAND THERAPY. No user employs the term to refer to graphic design, and different users apply it variously in the contexts of consultation regarding business development, communications, and public relations. It is also apparent that, in these examples, BRAND THERAPY is used to refer to a number of different things. For one user it refers to developing a business model; for others it refers to improving the "messaging" of a business; analysis of the strengths and weaknesses of a business or its principal; analysis of a businessperson's goals, vision, or values; and a "place" for brainstorming. No single, clear meaning of BRAND THERAPY arises from these usage examples. Moreover, the context of these uses of BRAND THERAPY strongly suggests that the users are attempting to express themselves in a novel, clever, or interesting way rather than simply employing the terminology or jargon of their fields.

¹¹ *Id.* at 8.

¹² *Id.* at 11.

¹³ Office Action of September 10, 2016 at 7.

Although there is no dictionary definition of the word “therapy” of record, the patterns of usage shown in the evidence indicate that “therapy” is a type of treatment, such as psychotherapy or physical therapy, applicable to a person or other physical being, rather than to an abstraction like a brand or a graphic design. There is a degree of incongruity in the concept of subjecting a brand to therapy. Thought or imagination is required to leap past the incongruity in order to discern a descriptive quality of the mark. On this record, we find that a non-descriptive, suggestive meaning arises from the combination of the words BRAND and THERAPY in Applicant’s mark, and that the mark therefore does not merely describe Applicant’s services. Accordingly, we reverse the refusal under Section 2(e)(1).

Inasmuch as we have found Applicant’s mark to be not merely descriptive under Section 2(e)(1), it is, *a fortiori*, not generic as applied to the services. A generic term is “the ultimate in descriptiveness.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 413 (C.C.P.A. 1961).

Decision: The refusal on the ground that the mark merely describes Applicant’s services is REVERSED. The refusal on the ground that the mark is generic is REVERSED.