

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 28, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re InfoSecurity Infrastructure, Inc.
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Serial No. 87897631
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Charles Cresson Wood, Esq.,
for InfoSecurity Infrastructure, Inc.

Edward Fennessy, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Wellington, Pologeorgis and Lebow,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

InfoSecurity Infrastructure, Inc. (“Applicant”) seeks registration on the Principal Register of the mark DUTIES AUDIT (in standard characters) for “business risk assessment services,” in International Class 35.¹

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant’s mark is

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¹ Application Serial No. 87897631 filed on April 27, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

merely descriptive of the services identified in the application. When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board.

We affirm the refusal to register.

I. Merely Descriptive -- Applicable Law

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive of them,” unless the mark has been shown to have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).²

A term is “merely descriptive” within the meaning of § 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). A term “need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

² The application is not based on use in commerce (see Note 1) and Applicant does not claim that if the proposed mark is found to be merely descriptive, it is registrable because it has acquired distinctiveness. Thus, Section 2(f) is not pertinent to our decision.

“Descriptiveness must be evaluated ‘in relation to the particular goods or services for which registration is sought, the context in which the mark is used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use,’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys Water Sports*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). “In other words, we evaluate whether someone who knows what the goods [or services] are will understand the mark to convey information about them.” *Id.* at 1515 (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)).

When two or more merely descriptive terms are combined, the determination of whether the combined mark is also merely descriptive turns on whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (citing *Estate of P.D. Beckwith, Inc. v. Commr.*, 252 U.S. 538, 543 (1920)); *see also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1318 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs).

II. Argument and Analysis

The Examining Attorney relies on the following dictionary definitions of DUTY and AUDIT and asserts that these words maintain their merely descriptive meanings when combined because Applicant's business risk services assess the legal obligations or duties of its customers:³

DUTY [plural, DUTIES]: 1. Required action or service.

AUDIT: 1. An examination of records or financial accounts to check their accuracy. ... 4. A thorough examination or evaluation.

"Specifically, the addition of the word 'duties' to the word 'audit' does not result in a unique, incongruous or nondescriptive meaning in relation to the applicant's type of services. In fact, the combination of these words further clarifies their significance in relation to risk assessment services by indicating the subject matter of the assessment or audit services."⁴

The Examining Attorney also relies on Internet evidence and contends that it "shows that audits are frequently performed for businesses that must comply with various legal obligations or duties."⁵ This evidence demonstrates that risk assessment audits of organizations are often conducted to ensure that they are in compliance with legal, security or regulatory requirements. A few examples include:

³ 6 TTABVue 6, 13; definitions attached to Office Action issued on August 17, 2018.

⁴ *Id.* at 13.

⁵ *Id.* at 6; evidence attached to Office Action issued on July 10, 2019.

Data Privacy Audits

During a privacy audit, the auditor needs to consider the organization's key risks and controls in the context of the specific legislative and regulatory requirements as well as best practices. The auditor will review policies and evaluate procedures for how data is collected, created, received, transmitted, maintained, disposed of and so on. The purpose of the audit is to verify compliance, or to identify risks and recommend mitigation strategies.

[from Infosec website (www.resources.infosecinstitute.com)];⁶

“Finally, consider the audit objectives. This is likely to include compliance to laws and regulations (e.g., the US Health Insurance Portability Act [HIPAA] ...)”

[from ISACA Journal website article “IS Audit Basics: Auditing Data Privacy” (www.isaca.org)];⁷ and

“What is an IT auditor? A vital Role for Risk Assessment. An IT auditor is responsible for analyzing and assessing an organization's technological infrastructure to find problems with efficiency, risk management and compliance.”

[from CIO Digital Magazine website (www.cio.com)].⁸

Additionally, the Examining Attorney points to statements made by Applicant, characterizing them as “concessions,” such as Applicant stating that “certainly the

⁶ Request for Reconsideration after Final Office Action Denied, issued on July 10, 2019, TSDR p. 8. Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval (“TSDR”) system and identify documents by title and date. Specific citations are to the page number in the .pdf version of the TSDR records. References to the briefs and other materials in the appeal record refer to the Board's TTABVUE docket system.

⁷ *Id.* at TSDR pp. 14-17.

⁸ *Id.* at TSDR p. 24.

word DUTIES does have a meaning in the context of the new products and services to which the proposed mark would apply, and that meaning relates to the legal duties of corporate directors and officers.”⁹ In its response to an Office Action, Applicant further states that “[r]egarding the applicant’s soon-to-be-offered services, the use of the word ‘duties’ pertains to the question: ‘Have the customer organization’s directors and officers fulfilled their legal duties regarding compliance with all information security and privacy related laws and regulations?’”¹⁰

Based on the record before us, we find DUTIES AUDIT is merely descriptive of Applicant’s business risk assessment services. The Internet evidence shows that entities, like Applicant, may render risk assessment services for organizations by conducting audits to ensure that the organization is performing its duties in compliance with various regulatory and legal requirements. Applicant, itself, acknowledges that it intends to use the mark DUTIES AUDIT in connection with making sure a customer organization and its employees are complying their the legal duties in connection with information security and privacy. Thus, in the context of these services, these consumers will immediately understand DUTIES AUDIT as conveying the very purpose or nature of Applicant’s business risk assessment services.

We have taken into consideration the various arguments Applicant set forth in its request for reconsideration and brief, including its contention that its mark “cannot

⁹ *Id.* at 15-16, referencing language in Applicant’s brief at 4 TTABVUE 8.

¹⁰ Response to Office Action filed March 28, 2019, TSDR p. 9.

be merely descriptive” because Applicant “has no existing goods or services in the marketplace to reference.”¹¹ Applicant argues that the fact that “[t]he proposed mark is to be used for forthcoming goods and services, that will be offered by the Applicant,” distinguishes this appeal from decisions wherein marks were found merely descriptive or generic.¹²

We are not persuaded by Applicant’s reliance on the putative assertion that it “has no existing goods or services in the marketplace to reference,” because this is irrelevant. Again, the involved application is based on Applicant’s asserted bona fide intent to use the mark in commerce and we must look to how the relevant consumer will perceive Applicant’s mark when it is used in connection with the services described in the application. Moreover, the fact that Applicant may be the first and only user of the merely descriptive term DUTIES AUDIT does not justify registration. *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833, 1838 (2004) (holding that trademark protection does not provide for “a complete monopoly on use of a descriptive term simply by grabbing it first.” (citation omitted)); *see also In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1209.03(c) (Oct. 2018).

¹¹ 4 TTABVue 3.

¹² *Id.* Applicant uses this argument to distinguish the circumstances of this proceeding from those in *In re Steelbuilding.com*, 415 F.3d 1293 (Fed. Cir. 2005).

Applicant also argues that the “meaning of the proposed mark goes substantially beyond the dictionary meanings, so as to convey a scripted compliance audit process that is applicable to corporate directors and officers.”¹³ Applicant acknowledges the relevant meanings of the two composite terms in its mark and “makes no claims to either of the two words . . . when they are used in other contexts as individual and separate words,” but asserts that “[t]here is no way that the consuming public could get this new meaning from the two words alone (DUTIES AUDIT) when those two words are standing without explanation, clarification, example, demonstration, or further information.”¹⁴

We disagree with Applicant that the combination of the terms DUTIES and AUDIT is incongruous, or that the merely descriptive meanings of those words will be lost on the relevant consumer. The combination does not “evoke[] a non-descriptive commercial impression,” and each component retains its merely descriptive significance in relation to the services. *In re Oppedahl & Larson LLP*, 71 USPQ2d 1372. That is, as the evidence demonstrates and Applicant acknowledges in its responses, prospective consumers for Applicant’s business risk assessment services will be organizations that must comply with legal and regulatory requirements. The evidence further shows that these entities will immediately understand that Applicant’s mark, when viewed in this context, conveys important information about Applicant’s services – namely, that Applicant will “audit” or assess the organization

¹³ 4 TTABVUE 4.

¹⁴ *Id.*

to ensure that it is performing its “duties” or requirements in order to be in compliance with certain laws and regulations.

III. Conclusion

We have carefully considered all arguments and evidence of record. We conclude that DUTIES AUDIT is merely descriptive of Applicant’s identified services since the mark merely describe a primary purpose or nature of the services, namely, rendering risk assessment services for organizations by conducting audits to ensure that the organization is performing its duties in compliance with various regulatory and legal requirements. We further find that the combination of the descriptive term “duties” with the descriptive term “audit” does not create a non-descriptive or incongruous meaning. Instead, we find that each component retains its merely descriptive significance in relation to Applicant’s identified services, the combination of which results in a composite mark that is itself merely descriptive.

Decision: The refusal to register Applicant’s DUTIES AUDIT mark under Section 2(e)(1) of the Trademark Act is affirmed.