

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re The Contentment Foundation
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Serial Nos. 87958925 and 87958967
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Eric S. Goldman of Eric S. Goldman LLC,
For The Contentment Foundation.

Tasneem Hussain, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

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Before Cataldo, Ritchie, and Coggins,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

The Contentment Foundation (“Applicant”) seeks registration on the Principal Register of the mark CONTENTMENT FOUNDATION (Application Serial No. 87958925, in standard characters) and the mark shown below



(Application Serial No. 87958967, a word-and-design composite mark), both for

Educational services, namely, conducting seminars, lectures, teleseminars, teleclasses and workshops in the field of contentment, education, positive psychology and human wellbeing and distribution of course and educational materials in connection therewith; Educational services, namely, developing curriculum for educators; Educational services, namely, developing curriculum for others in the field of contentment, education, positive psychology and human wellbeing; Educational services, namely, developing curriculum for teachers; Educational examination services; Educational testing services; Providing educational assessment services in International Class 41.¹

In Application Serial No. 87958925 (for the standard character mark), the Trademark Examining Attorney refused registration of Applicant's proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of Applicant's identified services; and, in Application Serial No. 87958967 (for the word-and-design composite mark), the Examining Attorney issued a final requirement under Section 6(a) of the Act, 15 U.S.C. § 1056(a), for Applicant to disclaim the exclusive right to use the wording THE CONTENTMENT FOUNDATION apart from the mark as shown. After the Examining Attorney made the refusal and requirement final, Applicant appealed to this Board. We affirm the

¹ Application Serial Nos. 87958925 and 87958967 both filed on June 12, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as August 2, 2017. Application Serial No. 87958967 includes the following statements: "The mark consists of a stylized shaded circle with four overlapping curved lines above the words 'THE CONTENTMENT FOUNDATION' with three dots on either side of the word 'FOUNDATION';" and "color is not claimed as a feature of the mark."

refusal to register and the requirement to disclaim the exclusive right to use the wording THE CONTENTMENT FOUNDATION.

I. Procedural Issue

These appeals involve common questions of law and fact and the records are substantially similar. Accordingly, we consolidate and decide each appeal in this single decision.² See *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1214 (2019).

II. Mere Descriptiveness

Merely descriptive terms are unregistrable under Section 2(e)(1) of the Trademark Act. A term is “merely descriptive” within the meaning of Section 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

² Unless otherwise specified, all TTABVUE and TSDR citations refer to the docket and electronic file database for Application Serial No. 87958925 (the standard character mark). Coming before the designation TTABVUE is the docket entry number, and coming after this designation is the page number. All citations to the TSDR database are to the downloadable .pdf version of the documents.

USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).³

Under Section 6(a), “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Since merely descriptive terms are unregistrable under Section 2(e)(1), they may be subject to a disclaimer requirement if the mark is otherwise registrable. *See In re Stereotaxis*, 77 USPQ2d at 1089. Failure to comply with a disclaimer requirement is a basis for refusing registration of the entire mark. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

Whether a term is merely descriptive is “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,’” *Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *Bayer*, 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

³ A “mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or] services for which registration is sought.’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1088 (Fed. Cir. 2005)).

DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd., 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)).⁴ Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries,” *Bayer*, 82 USPQ2d at 1831, “advertising material directed to the [services],” *Abcor Dev.*, 200 USPQ at 218, websites, publications, and an applicant’s own specimen of use and any explanatory text included therein. *N.C. Lottery*, 123 USPQ2d at 1710; *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

With terms such as CONTENTMENT FOUNDATION and THE CONTENTMENT FOUNDATION, we consider the meaning of the components, and then determine whether the mark as a whole is merely descriptive. *DuoProSS Meditech v. Inviro Med. Devices*, 103 USPQ2d at 1758. If the components CONTENTMENT and FOUNDATION are each individually merely descriptive of the services, we assess whether their combination in “Applicant’s mark ‘conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.’” *Fat Boys Water Sports*, 118 USPQ2d at 1515-16 (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2003)). If each component “retains its merely descriptive significance in relation to the [services], the combination results in a composite that is itself merely descriptive.”

⁴ A term is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the term. *See, e.g., Fat Boys Water Sports*, 118 USPQ2d at 1515.

Fat Boys Water Sports, 118 USPQ2d at 1516 (citing *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)).

With the initial Office Action, the Examining Attorney attached a dictionary definition showing that “contentment” means “the happiness you feel when you have everything you want and you enjoy your life;”⁵ a dictionary definition showing that “foundation” means “an organization that provides money for things such as medical research or for a charity;”⁶ excerpts from Applicant’s own website showing that Applicant describes itself to the public “[a]s a registered 501(c)(3) nonprofit foundation”⁷ which “offers child and adult-centered curricula, and studies the effects of contentment” and through its educational services “help[s] children and adults begin to cultivate a sense of internal and indestructible contentment that is not affected by the external world;”⁸ and third-party registrations for marks comprised of “foundation” coupled with descriptive subject matter wording for educational services, with “foundation” disclaimed.⁹

The Examining Attorney also points out that CONTENTMENT appears in Applicant’s identification of services; Applicant’s specimen of record uses CONTENTMENT in non-source identifying, descriptive text explaining Applicant’s

⁵ MacMillanDictionary.com, September 25, 2018 Office Action at TSDR 5.

⁶ *Id.* at TSDR 8.

⁷ Contentment.org/donations, *id.* at TSDR 13.

⁸ Contentment.org/about, *id.* at TSDR 11-12.

⁹ For example, Registration Nos. 3290969 (IMMUNE DEFICIENCY FOUNDATION) and 4387028 (THE CULTURAL LANDSCAPE FOUNDATION) both registered under § 2(f) with FOUNDATION disclaimed. *See id.* at TSDR 19-20 and 23-25.

services; and Applicant has already disclaimed FOUNDATION, a concession that the word is descriptive.¹⁰ Citing *In re Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive of restaurant and bar services; “the definite article THE . . . add[s] no source-indicating significance to the mark as a whole”), the Examining Attorney observes for Application Serial No. 87958967 that adding the word THE to a descriptive or generic term generally does not add any source-indicating significance or otherwise affect the term’s descriptiveness or genericness.¹¹

We agree with the Examining Attorney’s conclusion that by disclaiming FOUNDATION Applicant conceded that word is descriptive. The disclaimer of a term pursuant to a requirement by the Examining Attorney is a concession that the term is at best merely descriptive. *See In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n.4 (TTAB 1988) (“By its disclaimer of the word LITE, applicant has conceded that the term is merely descriptive as used in connection with applicant’s goods.”) (citing *State Oil Ref. Corp. v. Quaker Oil Corp.*, 161 USPQ 547 (TTAB 1969), *aff’d*, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972)). Indeed, Applicant does not argue otherwise in its brief.

Applicant’s existential argument that it is impossible for CONTENTMENT to describe a feature of the services because educational services are inanimate and “cannot contain a state of mind,” *see* Brief, unnumbered p. 10 (5 TTABVUE 11), is not

¹⁰ *See* Examining Attorney’s Brief, unnumbered p. 2, 3 (7 TTABVUE 2, 3). *See also* Specimen; and November 28, 2018 Response to Office Action at TSDR 2 (disclaimer).

¹¹ Examining Attorney’s Brief, unnumbered pp. 2 (7 TTABVUE 2).

well-taken. Contentment is one of the specifically identified fields in which Applicant conducts seminars and develops curriculum for others.

When a mark combines two descriptive terms, such as CONTENTMENT and FOUNDATION, the descriptiveness analysis turns on whether the combination of terms evokes a new and unique commercial impression. We find no such new and unique commercial impression from the combination CONTENTMENT FOUNDATION in these cases. The terms retain their ordinary meanings, and when combined, refer to a foundation focused on contentment – exactly what Applicant’s specimens reveal Applicant to be and its services to provide. Where, as here, the combination retains the descriptive significance of the individual parts, the mark as a whole must be considered merely descriptive. *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1337 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *see also In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012) (holding SEMICONDUCTOR LIGHT MATRIX merely descriptive of light and UV curing systems composed primarily of light-emitting diodes for industrial and commercial applications).

Similarly, Applicant’s addition of the word “the” to CONTENTMENT FOUNDATION in Application Serial No. 87958967, does not evoke a new and unique commercial impression. In fact, the word “the” in Applicant’s mark is a definite article merely serving to specify or particularize the term it precedes. *See In re Place*, 76 USPQ2d at 1468; *In re Comput. Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (THE COMPUTER STORE is the common descriptive name for computer-related services);

Conde Nast Publ'ns Inc. v. Redbook Publ'g Co., 217 USPQ 356, 357 (TTAB 1983) (“the” cannot serve as an indication of origin even if applicant’s magazine was the only magazine for young women).

Based on the record as a whole, we find that CONTENTMENT FOUNDATION and THE CONTENTMENT FOUNDATION clearly and immediately convey information concerning a feature and characteristic of the educational services for which registration is sought. Someone who knows what the services are will understand CONTENTMENT FOUNDATION and THE CONTENTMENT FOUNDATION to convey information about them, namely that “contentment” is a feature or purpose of the services offered by Applicant’s foundation. Accordingly, we find that the Examining Attorney established prima facie that the terms CONTENTMENT FOUNDATION and THE CONTENTMENT FOUNDATION are merely descriptive of Applicant’s educational services. Applicant submitted no evidence, and its arguments in response to this showing do not rebut the prima facie descriptiveness of the terms.

III. Decision

As to Application Serial No. 87958925, the refusal to register Applicant’s proposed mark CONTENTMENT FOUNDATION is affirmed.

As to Application Serial No. 87958967, the refusal to register Applicant’s proposed


mark  in the absence of a disclaimer of the wording THE CONTENTMENT FOUNDATION is affirmed. However, this decision will be set aside as to Application

Serial No. 87958967 if Applicant submits to the Board a proper disclaimer of THE CONTENTMENT FOUNDATION in the next thirty days. *See* Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). The standardized disclaimer format is as follows: No claim is made to the exclusive right to use THE CONTENTMENT FOUNDATION apart from the mark as shown.