

World Trademark Review Daily

TTAB holds that financial company's annual report is not "good in trade" Examination/opposition United States - Arent Fox LLP National procedures

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The Trademark Trial and Appeal Board (TTAB) has recently issued a precedential decision that could have a lasting impact on companies that offer electronic or printed reports in connection with their business services. The decision, *In re Thomas White International Ltd* (Serial No 77080379, February 28 2013), upheld the examining attorney's refusal to register the mark EMPOWERING THE INVESTOR in Class 9 of the [Nice Classification](#) based on an insufficient specimen of use and because the mark was not used on "goods in trade".

Thomas White International Ltd, a mutual fund and institutional investment manager, applied to register the mark EMPOWERING THE INVESTOR for:

"electronic publications, namely, reports featuring investment management and investment research information, and financial research and equity research information recorded on computer media, in Class 9."

As a specimen of use, Thomas White submitted a 52-page electronic document titled "Thomas White Funds; Annual Report October 31 2009". The annual report contained investment and financial information regarding the Thomas White Funds, such as the overall outlook of the fund and the economy, the return on investment, statements of assets and liabilities, tax information and the like.

The examining attorney refused registration under Sections 1, 2, and 45 of the [Trademark Act](#), finding that the mark was not used in connection with "goods in trade" and that the specimen of use was insufficient.

In upholding the refusal to register, the TTAB held that the annual report did not constitute a "good in trade" and that the specimen was unacceptable for Class 9. The TTAB considered the annual report to be an "incidental item[] used to conduct daily business", similar to "letterhead, invoices, and business forms". The TTAB fell short, however, of establishing a bright-line rule that investment/business reports are never goods in trade. Instead, it held that whether reports qualify as goods is a factual determination to be made on a case-by-case basis. The non-exclusive factors to consider are:

1. whether the report is simply a conduit or necessary tool useful only to obtain the applicant's services;
2. whether the report is so inextricably tied to, and associated with, the applicant's services as to have no viable existence apart therefrom; and
3. whether the report is sold separately from or has any independent value apart from the applicant's services.

To reach its decision regarding the report in the present case, the TTAB reviewed a line of cases finding similar printed or electronic reports were not goods in trade. These cases held that, where reports were "part and parcel of", or the "essence or gist of", the applicants' business services, they were not separate goods in trade. For example, in *In re Shareholders Data*, the applicant applied for the mark PERSONALYST for "reports on the valuations of subscribers' securities portfolios". In refusing registration, the court found the reports were simply the conduit through which the applicant provided its financial services to individual subscribers. Thus, while the applicant could secure a registration for its financial services, it could not get a registration for the related business reports. Similarly, in *Compute-Her-Look*, the TTAB refused registration of the applicant's mark for "computer printouts reflecting beauty advice tailored to particular customers" because the reports were:

"merely the means by which [the] applicant transmits the results of its beauty analysis service, and they are so [inextricably] tied to and associated with this service that they have no viable existence or marketable value separate and apart therefrom."

It is clear from the TTAB's decision in the present case, and the line of cited cases, that where an applicant offers reports that are inextricably tied to its business services and are not sold separately from the services, the reports likely are not goods in trade. The TTAB left open the possibility that, if an applicant charges a fee for its reports separate and apart from the fee for its business services, such reports might be considered goods in trade (see *In re Thomas White International Ltd* ("[T]here is no evidence in the record that applicant charges for the report...The report is not sold separate from the service, and the report has no viable existence or independent value separate and apart from the services.")).

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Thus, when filing new trademark applications or renewing existing registrations, businesses should consider the TTAB's guidance in *In re Thomas White International Ltd* to determine whether their reports are publications eligible for trademark registration, or whether they might be viewed as advertisements that would qualify as specimens supporting an application for a service mark registration.

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