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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Growth Strategies, Inc.

Serial No. 76362314

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Mary Boagni, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Hairston, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Growth Strategies, Inc. has filed an application to register on the Principal Register the mark HUMAN CAPITAL CAPABILITY SCORECARD for "business management consultation services," in International Class 35.¹

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 76362314, filed January 24, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

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U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its proposed services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The examining attorney contends that the mark is merely descriptive because it "conveys that the applicant's business consultation services feature the use of and provide to customers a scorecard to assess the human capital capability of other businesses" (brief, pp. 2-3). The examining attorney stated that "a scorecard ... is a way in which something can be measured and is a term used in the business context" (brief, p. 3); that applicant's mark is simply a combination of merely descriptive words that, when considered in its entirety, is also merely descriptive and creates nothing incongruous or novel.

In support of her position, the examining attorney submitted excerpts from applicant's Internet web site and a third-party Internet web site that applicant clarified is its joint venture partner; excerpts from a third-party Internet web site; the results of an Internet search using the Google search engine; third-party registrations; dictionary definitions of "human," "capability" and

"capital"²; and excerpts of articles retrieved from the Lexis/Nexis database.

Applicant contends that its mark is not merely descriptive; that the phrase comprising the mark "could suggest services in a variety of fields," for example, a philanthropic organization or corporate educational services (brief, p. 3); that the examining attorney has dissected the mark, noting in particular that "scorecard" is an incongruous sports-related term in connection with both the term "human capital capability" and the identified services.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single,

² *The American Heritage Dictionary of the English Language* (3rd ed. 1992) defines, in pertinent part, "human" as "of, relating to, or characteristic of human beings"; "capital" as "an asset or advantage"; and "capability" as "a talent or ability that has potential for development or use .. the capacity to be used, treated, or developed for a specific purpose." Additionally, we take judicial notice of the relevant definition in *Merriam Webster's Collegiate Dictionary* (11th ed. 2003) of "scorecard" as "a report or indication of the status, condition or success of something or someone."

significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. *See In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In this regard, we now consider the evidence submitted in support of the refusal. First, we look at the excerpts from applicant's web site (www.growth-strategies.com), which includes the following statements:

Applicant describes itself as "a leader in the field of business, organization and personal development. The principals of [applicant] have been developing successful growth strategies for profit making organizations, nonprofit organizations and individuals for over forty years."

"We create measurement systems that enable our clients to identify and focus on their human capital capability and its link to outcomes ..."

"Human capital has become the key element in creating and sustaining value in business. ... For human resources to transform to a truly strategic role, HR professionals must be able to measure performance and to link HR's contribution to the mission of the organization. The HR Scorecard is a management system for filling the gap between what is usually measured in HR and what is actually essential to the firm."

"The ideal scorecard for an HR measurement system will include four themes ..."

"An HR Scorecard measurement system identifies in quantitative terms the gap between current and ideal HR architecture, and it provides data for either an operational or strategic cost-benefit analysis."

"Most organizations don't measure their human capital capability - the overall capacity of their people to affect the 'bottom line.'"

The following statements from the web site of applicant and/or its joint venture partner, are used in connection with promotion of the HUMAN CAPITAL CAPABILITY SCORECARD services:

"The most significant source of wealth creation inside businesses today is human capital - the collective skills and knowledge of employees."

"The application of our HCCS tools (including a streamlined series of interviews and surveys) allows us to develop - simultaneously - an accurate view of a client's overall human capital capability as well as a *detailed* view of capabilities for each specific factor area that directly affects human capital capability. (Italics in original.)"

"After all data gathering is complete, this information is presented to the client in the form of a customized HCCS report that includes a capability score for the three major tiers as well as specific factor areas, a comparison of these scores to benchmarked norms, identification of key linkages to intermediate and financial outcomes, and specific recommendations for improvement."

The examining attorney also submitted an excerpt from a University of Missouri Internet web site (www.outreach.missouri.edu/boone/B&I/businessprog).³ A section titled "Programs of the Missouri Small Business Development Center," includes the following entry:

³ The results of a Google search for "human capital capability scorecard," submitted by the examining attorney, refer primarily to applicant or its joint venture partner and, thus, this evidence does not support the examining attorney's position.

Balanced Scorecards

Large corporations have used balanced scorecards for years to improve their performance and achieve their strategic goals. The MO SBDC's nine-step process helps smaller companies create a scorecard and enjoy the benefits of improving communication, aligning work throughout the company, executing their strategic plan and measuring performance with a balanced set of metrics.

The examining attorney's search of "business scorecard" in the Lexis/Nexis database includes the following relevant excerpts⁴:

"... the fact of the matter is Gaston scored higher on Associated Industries of Florida's business score card than Allan Bense and J.D. in 2000." [The Ledger (Lakeland FL), June 10, 2002.]

"SMALL-BUSINESS SCORECARD - 9 A.M. - Members of Congress host a news conference to release a report, 'Scorecard II: How Federal Agencies Continue to Fail America's Small Businesses.' Location: Capitol, House Triangle. [The Washington Times, September 6, 2001.]

"As for a business scorecard, on the failure side was right-to-work legislation, a small employer health insurance reform act, franchise tax relief and other tax incentives." [The Daily Oklahoman, June 1, 2000.]

Of the third-party registrations submitted by the examining attorney, seven registrations are for marks that include the term HUMAN CAPITAL in connection with business management services, and each registration is either on the Supplemental Register or contains a disclaimer of

⁴ While the examining attorney's search strategy showed that 109 items were retrieved, the ones printed and made of record are mostly from wire services and, thus, are of minimal probative value in determining the public's exposure to the use of the term at issue. The only remaining and relevant excerpts are shown herein.

HUMAN CAPITAL; four registrations are for marks that include the term SCORECARD for business-related goods and services, and each registration is either on the Supplemental Register or contains a disclaimer of SCORECARD; and one registration is for a mark that includes the phrase INNOVATIVE CAPABILITIES ENHANCEMENT for industrial management assistance services, and the phrase is disclaimed.

As applicant correctly states, when the mark involves more than a single term, we must consider whether the mark as a whole is merely descriptive and not just the individual elements. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004). As the Court stated in that case:

The PTO may properly consider the meaning of 'patents' and the meaning of '.com' with respect to the goods identified in the application. However, if those two portions individually are merely descriptive of an aspect of appellant's goods, the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.

When two or more descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the

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combination results in a composite that is itself descriptive. *See, e.g., In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

In the case before us, as quoted above, applicant itself defines the term "human capital" as "the collective skills and knowledge of employees"; and defines the term "human capital capability" as "the overall capacity of [applicant's clients'] people to affect the 'bottom line.'" As such, the terms "human," "capital" and "capability" are used for their ordinary meanings as defined herein and are merely descriptive in connection with the identified services. Further, and also in the context of applicant's identified services, both the terms "human capital" and "human capital capability," as applicant uses them, are merely descriptive.

Applicant further describes its services as "creat[ing] measurement systems that enable our clients to identify and focus on their human capital capability and its link to outcomes..." As the term "scorecard" is defined, its applicability is broader than mere applicability to sports. The use of "scorecard" to refer to the results of applicant's analysis of the "capability" of a client's "human capital" is merely descriptive of applicant's report regarding the condition of the client's organization. Our findings are reinforced by the evidence of business-related descriptive use of the term "scorecard" in the Lexis/Nexis excerpts and in the third-party registrations, as well as the apparently descriptive use of "human capital" in the third-party registrations.⁵

Moreover, we find the mark as a whole, HUMAN CAPITAL CAPABILITY SCORECARD, to be as descriptive of applicant's services as the individual words. Applicant does not suggest with any particularity that the combination of the individual terms evokes a new and unique commercial impression, nor do we find that it does. We find that the mark in its entirety is merely the sum of its merely descriptive components and is equally merely descriptive in connection with applicant's identified services.

⁵ It is immaterial that some of the uses of "scorecard" in the evidence show it as two words, i.e., "score card."

Contrary to applicant's contention that the connotation of its mark is ambiguous when considered in the abstract, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985); and *In re Recovery*, 196 USPQ 830 (TTAB 1977).

In conclusion, when considered in connection with applicant's services, the term HUMAN CAPITAL CAPABILITY SCORECARD immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely that a significant aspect of applicant's business management consultation services involves an analysis and report in the form of a "scorecard" of the "capability" of a client's "human capital." Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive

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significance of the term HUMAN CAPITAL CAPABILITY SCORECARD as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.