

Response to Office Action

MARK: RETIREMENT PLANNING UNIVERSITY

SERIAL NO.: 88628895

APPLICANT: Strategic Wealth Designers

FILING DATE: September 24, 2019

INTERNATIONAL CLASS: 036

TO: Julie Thomas
Examining Attorney
USPTO, Law Office 107

Applicant, Strategic Wealth Designers (“Applicant”) respectfully submits this Response to the Office Action issued on January 14, 2020 against Application Serial No. 88628895 for the RETIREMENT PLANNING UNIVERSITY mark (for *Financial advice and consultancy services* in Class 036) (“Applicant’s Mark”).

The Examining Attorney has refused registration on the ground that the Mark is merely descriptive of Applicant’s services, under 15 U.S.C. § 1052(e)(1). Applicant respectfully maintains that the Mark is not merely descriptive because it is suggestive, and therefore requests that the refusal be withdrawn.

The Mark is Not Merely Descriptive Because it is Suggestive

A trademark is not merely descriptive if it does not immediately tell an average potential purchaser what the goods or services are. *In re Energy Resources Corporation*, 173 USPQ 510 (TTAB 1972) (holding ENERGY RESOURCES not merely descriptive of the services of exploration for and production of oil and gas for others). If a trademark does not without interpretation and imagination describe the goods or services, then the trademark is not merely descriptive. *In re The Gracious Lady Service, Inc.*, 174 USPQ 340 (TTAB 1972). If the mental leap between the mark and the applicant’s goods and services is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. *See McCarthy On Trademarks* (4th ed.), § 11.67 at 118. Further, a trademark is not merely descriptive if it is not needed by others to describe the goods or services. *See McCarthy On Trademarks* (4th ed.), § 11.68.

Applicant’s mark is RETIREMENT PLANNING UNIVERSITY. The Office reasons that this is merely descriptive because “applicant operates an educational institution for instruction relating to retirement planning” and therefore “The proposed mark immediately describes this nature of the services.” Applicant respectfully submits that the mark is suggestive because it does not merely describe the intended user and a feature of the services, but creates an overall commercial impression that combines those the Mark’s individual components in a stylized manner that has greater significance than the sum of its parts.

Applicant respectfully contends that the mark could not possibly be descriptive, since by its definition a “university” is defined as “an institution of higher learning providing facilities for teaching and research and authorized to grant academic degrees.” Applicant’s services entailing *Financial advice and consultancy services* do not constitute an institution for higher learning because the courses are available to the general public regardless of their academic backgrounds. In fact, the courses have nothing to do with

the traditional educational curriculum; the courses are tailored to prepare individuals for retirement, and offer financial planning advice, in general. Although Applicant's educational services are administered in a classroom setting, the classroom is rented by Applicant for the sole purpose of administering its retirement planning course, whereby it provides generalized financial advice. The attendees are not matriculated students at the campus facility. Most importantly, Applicant's "university" is not authorized to grant academic degrees. Therefore, UNIVERSITY is not descriptive of Applicant's services.

Second, and relatedly, the syntax "RETIREMENT PLANNING UNIVERSITY" is highly unusual because RETIREMENT PLANNING is not a traditionally recognized or a conceivable university. In fact, the mark automatically conveys to the consumer a faux, non-accredited program. For example, no reasonable consumer would believe that they could receive higher education, a degree, or do research at UNIVERSITY OF BEER PONG (Reg. No. 5279256), as opposed to "HARVARD UNIVERSITY" or "NEW YORK UNIVERSITY." In Applicant's mark, "university" is reasonably understood, not by its traditional definition, but as a database of resources, or as more of a "crash course." Therefore, consumers are not likely to perceive the mark as merely descriptive.

Moreover, RETIREMENT PLANNING UNIVERSITY cannot be merely descriptive of the services in question because the Applicant's services do not solely consist of the course itself, but also of one-on-one meetings with financial advisers. Therefore, to arrive at a conclusion as to the nature of the services associated with Applicant's Mark, the consumer will have to undertake a process of abstract and multistage reasoning. Consequently, Applicant respectfully maintains that the mark is not merely descriptive because it is suggestive.

Doubts as to Registrability are Resolved in Favor of Applicant and Publication

Applicant respectfully notes that the Office bears the burden of demonstrating mere descriptiveness by a preponderance of evidence. At a minimum, Applicant has raised a doubt about the propriety of the classification of Applicant's Mark as merely descriptive. Any doubts concerning the descriptive significance of a mark are to be resolved in favor of Applicant and of passing the mark to publication. *See In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152, 2006 WL 337549 (T.T.A.B. 2006).

As the Federal Circuit stated in the case *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987), "It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent." *See also In re the Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380, 382, 1972 WL 17804 (T.T.A.B. 1972) ("It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes ...").

CONCLUSION

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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