

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: The Right Brain Trust, LLC
Serial No: 75/757,251
Filed: July 21, 1999
Mark: THE SENIOR CHANNEL
Classes: 38 & 41
Our Ref: RTBR-01/04759



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REPLY BRIEF

Box TTAB
NO FEE
Trademark Trial and Appeal Board
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Arlington, Virginia 22202-3513

This is in response to the Examining Attorney's appeal brief which was mailed on March 13, 2002.

The Examining Attorney has based his refusal to register on several grounds, each of which will be addressed in turn below:

1) First, the Examining Attorney states that when prospective consumers encounter the applicant's mark, they will find it descriptive in relation to "applicant's particular goods or services," particularly because consumers will not view Applicant's mark in a vacuum. See Brief p. 6. Applicant fully agrees that consumers will not encounter the mark in a vacuum. Indeed,

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<u>Diane B. Melnick</u> (Printed name of person mailing paper or fee)	<u><i>Diane B. Melnick</i></u> (Signature)

when viewed in the context of the actual television programming services which will be rendered by Applicant, the mark is even more suggestive – and less descriptive - than it would be otherwise. The applicant’s services will consist of services which can be categorized as “lifestyle programming.” This includes sports, education, hobbies, and other leisure pursuits which would be of interest to a broad range of consumers. Therefore, in the context of the services themselves, the term SENIOR is suggestive of a lifestyle, but is not directly descriptive of either the subject matter or the intended consumer of the programming. The Examining Attorney contends that “the applicant’s brief makes clear that its media broadcasts and programming will concern and will be of primary interest to *senior citizens*” (emphasis in original). In fact, Applicant’s Brief clarified the nature and subject matter of the programming services and it is clear that as recited in the identification, they cover a diverse group of subjects which would appeal to a broad range of viewers.

2) The Examining Attorney also cites the TTAB decision *In re Weather Channel, Inc.*, 229USPQ 854, 856 (TTAB 1986) in support of his refusal to register. This case is offered to support the contention that the applicant’s mark is descriptive, yet the mark in that case “THE WEATHER CHANNEL” is significantly different in terms of its level of descriptiveness. In that instance, there is no mental leap required because the term “weather” immediately and instantly conveys the exact subject matter of the programming. The term SENIOR does not.

3) As for the prior registrations which are attached to the Examining Attorney’s brief, each application must stand on its own merits. The Examining Attorney has indicated that third party registrations are not conclusive on the issue of descriptiveness. To the extent that this statement is true, it certainly can be said that each application presents its own particular

combination of facts which must be evaluated independently in order to arrive at an assessment of the distinctiveness of each mark. Section 1209.03(a) of *the Trademark Manual of Examining Procedure*, (3rd Ed. March 2002) states as follows:

Each case must stand on its own merit. The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. (citations omitted).

It is clear, from the portion of the TMEP cited above, that the applicant's own registration may not be used against it to preclude registration in this instance. In those prior marks, the Applicant offered disclaimers of the terms SENIOR CHANNEL (in serial No. 75/827529 and 75/827530) and amended to the Supplemental Register (in U.S. Reg. No. 2,528,681) not because it believed the term was descriptive, but to keep those cases moving forward procedurally. In this application, Applicant has pursued an Appeal and it should be allowed to submit its arguments, without being prejudiced by its previous procedural concessions. That is, the prior disclaimers and amendments are not conclusive on the substantive issues raised here. They were only a procedural measure to move the cases forward.

In addition, Section 1213.11 of the TMEP specifically provides that rights can be acquired in a disclaimed matter. That section cites to § 6 of the Trademark Act which provides as follows: "no disclaimer...shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter shall be or have become distinctive of his goods or services."

This provision states that the disclaimer does not prejudice the Applicant's rights "...then existing" in "the disclaimed matter." It also states that the disclaimer does not prejudice the Applicant's "...right of registration on another application if the disclaimed matter shall be -

...distinctive." This can only mean that a previous disclaimer is not a conclusive determination of the inherent distinctiveness of the mark. The Applicant is always entitled to registration on the Principal Register, if the mark is distinctive (either inherently so, as it is here, or as a result of the development of secondary meaning), notwithstanding previous disclaimers.

That section of the TMEP provides further clarification as follows:

It is now clear that, aside from generic matter disclaimed matter is not forever barred from registration, and can subsequently be considered for registration on either the Principal Register or the Supplemental Register. When an application is filed seeking registration of matter previously disclaimed, it should be examined in the same manner as other applications.

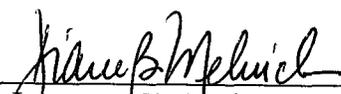
This is clear guidance for the present situation. The applicant is entitled to a fresh view of its mark, in light of all available arguments for registration. Applicant is not bound by its previous concessions, to concede that its mark is descriptive, when it is in fact suggestive.

The Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the refusal to register, and allow this application to move forward towards publication.

Dated: New York, New York
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Respectfully submitted,

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& ZISSU, P.C.

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