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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Guitar Corp.

Serial No. 76610100

Martha B. Allard and Lucian Wayne Beavers of Wadley & Patterson, P.C. for Gibson Guitar Corp.

Sani Khouri, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).¹

Before Seeherman, Grendel and Holtzman, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark THE HOME DIGITAL JUKEBOX (in standard character form) for goods identified in the application, as amended, as "digital music audio recording and playback system consisting of a recorder/playback unit, speakers and remote

¹ A different Trademark Examining Attorney handled the application prior to appeal.

control," in Class 9.² In compliance with the Trademark Examining Attorney's requirement, applicant has disclaimed the exclusive right to use DIGITAL JUKEBOX apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground of mere descriptiveness. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). We affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

² Filed September 1, 2004. The application is based on intent-to-use under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, 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); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

Applicant has disclaimed DIGITAL JUKEBOX, and does not dispute the mere descriptiveness of those words. Applicant argues, however, that its mark as a whole is not merely descriptive. Applicant contends that its mark is comprised of four words which have never been combined in exactly

this way before. Applicant further contends that the resulting composite is incongruous, and thus inherently distinctive, because "jukeboxes are traditionally found in smoky bars and other commercial establishments, not homes." (Applicant's brief, p. 3.)

We are not persuaded. First, even if applicant were the first or only user of the four-word composite THE HOME DIGITAL JUKEBOX, that fact would not negate the mere descriptiveness of the mark. *See In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). Second, even if applicant is correct in contending that traditional jukeboxes (which play vinyl records or compact discs) are often located in bars or other commercial establishments, the NEXIS and Internet evidence made of record by the Trademark Examining Attorney clearly establishes that digital jukeboxes are for home use as well. For example (emphasis added):

D.S.P. chips are the electronic brains in almost all CD players, cellular telephones, personal organizers, digital cameras, car audio systems, **digital jukeboxes in homes** and digital music players.
(The New York Times, October 19, 2000);

That kind of online storage effectively lets consumers take their collection wherever they travel, as long as they can connect to the Net. It also lets consumers assemble their own custom

playlists and, potentially, **turns any device in the home with an Internet connection into a digital jukebox.**

(San Jose Mercury News, June 9, 2000);

Build a **Digital Jukebox** with Windows Media Player 10

...

Never again will you have to hunt through stacks of CDs or risk scratching your disks, because Windows Media Player 10 can organize and deliver instant access to your music. With your digital jukebox you can always find the mix you're in the mood to hear...**There are three easy steps to building a digital jukebox: Copying music from CD to your computer, organizing your music, and creating playlists.** ...

(www.microsoft.com/windowsxp);

My project: **the home digital jukebox**

...In fact making an [sic] perfect digital copy of a CD for yourself is considered fair use of that product. **With that in mind I'm planning to create a digital jukebox. It will have a large collection of my favorite music. And that collection will be available to anyone within my household via the high speed computer network in my house. I'm going to do this with all Open Source software. In the future I think that many homes will have this kind of digital music appliance.**

(www.vindaloo.com);

Want to watch your HBO while waiting at the doctor's office, or use your cell phone instead of a portable music player to listen to songs **from your home's digital jukebox?**

(Associated Press Online, October 11, 2004); and

About NetMusic: Edmonds, Washington-based NetMusic Entertainment is a global digital media company focused on **providing consumers entertainment on their own terms: anytime,**

anywhere. The company offers digital music downloads, **digital jukeboxes**, video-on-demand and online video rental services across the globe. (PrimeZone Media Network, April 5, 2005).

Thus, there is nothing incongruous about combining THE HOME and DIGITAL JUKEBOX. Consumers may and do create their own digital jukeboxes for home use. We therefore find that applicant's mark, THE HOME DIGITAL JUKEBOX, is merely descriptive of applicant's goods as identified in the application, which must be presumed to comprise or include a digital jukebox for home use. DIGITAL JUKEBOX is a generic name for the goods, and THE HOME merely describes where that digital jukebox may be created and/or used. The composite mark is as merely descriptive as its components are separately. Applicant's arguments to the contrary are wholly unpersuasive.

Decision: The refusal to register is affirmed.