From: Rappaport, Seth A.

Sent: 8/25/2010 10:06:31 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77622947 - .MUSIC - theDot

****
Attachment Information:
Count: 1
Files: 77622947.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/622947

MARK: .MUSIC

CORRESPONDENT ADDRESS:
MIKE RODENBAUGH
RODENBAUGH LAW
548 MARKET STREET BOX NO 55819
SAN FRANCISCO, CA 94104

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: theDot Communications Network LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
theDot
CORRESPONDENT E-MAIL ADDRESS:
mike@rodenbaugh.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's refusal to register the mark .MUSIC. Registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is merely descriptive of the identified goods and services.

FACTS

On November 26, 2008, the applicant theDot Communications Network LLC filed four intent-to-use trademark/service mark applications seeking registration on the Principal Register of the mark .MUSIC.

In U.S. Application Serial No. 77622944, the applicant applied to register the mark .MUSIC in International Class 042 for a variety of computer and technology-related

services. In U.S. Application Serial No. 77622947, the applicant applied to register the mark .MUSIC for a variety of business and promotional services in International Class 035. In U.S. Application Serial No. 77622948, the applicant applied to register the mark .MUSIC for a variety of goods in International Class 009, such as MP3 files and sound recordings. Finally, in U.S. Application Serial No. 77622945, the applicant applied to register the mark .MUSIC for a variety of publishing and entertainment services in International Class 041.

In Office Actions mailed on February 26, 2009 and March 3, 2010, the examining attorney refused registration of each mark under Trademark Act Section 2(e)(1) as being merely descriptive of the goods and services. The examining also required in the Office Action for U.S. Application Serial No. 77622948 that the applicant amend the identification of goods. On August 26, 2010, the applicant responded, resolving the identification of goods issue in U.S. Application Serial No. 77622948 and arguing against the refusal to register each mark under Section 2(e)(1). On September 14, 15, and 16, 2009, the examining attorney issued a Final Office Action in each case with respect to the Section 2(e)(1) refusal.

The applicant noted the instant appeal on March 16, 2010 and concurrently filed a request for reconsideration in each case. The applicant argued against the refusal under Section 2(e)(1) and amended the identification of goods/services in each application.

The applicant amended the identification of services in U.S. Application Serial No. 77622944 to “Computer services, namely, creating an on-line community for registered users to participate in competitions, showcase their skills, get feedback from their peers, form virtual communities, engage in social networking and improve their

talent; Computer services, namely, hosting on-line web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; Computer services, namely, interactive hosting services which allow the user to publish and share their own content and images on-line; Providing a web site featuring temporary use of non-downloadable software allowing web site users to upload, post and display online videos for sharing with others for entertainment purposes; Providing a web site that gives multiple computer users simultaneously the ability to upload, create and edit documents, printed publications, online publications, photographs, product packaging and advertisements; Providing an online website for creating and hosting micro websites for businesses." Furthermore, the applicant amended the identification of services in U.S. Application Serial No. 77622947 to "Arranging subscriptions of the online publications of others; On-line wholesale and retail store services featuring downloadable sound, image, video and game files; Promotional services, namely, promoting the goods of others by means of providing online gift cards; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Providing an online video business directory; Publishing of advertising texts" and the identification of goods in U.S. Application Serial No. 77622948 to "Downloadable MP3 files, MP3 recordings, on-line discussion boards, webcasts and podcasts featuring audio books and news broadcasts; Sound recordings featuring entertainment in the nature of performing arts; Video recordings featuring entertainment in the nature of performing arts." Finally, the applicant amended the identification of services in U.S. Application Serial No. 77622945 to "Digital video, audio, and multimedia publishing services; Multimedia entertainment services in the nature of recording, production and post-production services

in the fields of video and films; Multimedia publishing of books, magazines, journals, software, games and electronic publications; Post-production editing services in the field of videos and films; Publishing of electronic publications; Publishing of reviews; Publishing of web magazines."

The examining attorney entered the applicant's amendments to the identification of goods/services in each case and denied reconsideration on March 17, 2010 in each case with respect to the Section 2(e)(1) refusal. The applicant filed their briefs on June 23, 24, and 30, 2010. The files was forwarded to the examining attorney for statement on June 23 and 28, 2010 and July 1, 2010. On July 7, 2010, the examining attorney filed a motion to consolidate requesting that the four applications be consolidated into one for purposes of this appeal brief due to the similarity of the marks and the similarity of the issue at hand. On July 23, 2010, the Board granted the examining attorney's motion to consolidate.

ISSUE

The only issue on appeal is whether the mark .MUSIC, when used on or in connection with the applicant's goods and services, is merely descriptive of those goods and services.

ARGUMENT

The applicant's mark, .MUSIC, immediately describes a feature and a characteristic of the applicant's goods and services. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Furthermore, the determination of

whether a mark is merely descriptive is considered in relation to the identified goods or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The evidence submitted by the examining attorney in the Final Office Action shows that the term MUSIC is defined as "the art of arranging sounds in time so as to produce a continuous, unified, and evocative composition, as through melody, harmony, rhythm, and timbre" or "Vocal or instrumental sounds possessing a degree of melody, harmony, or rhythm" or "a musical composition." Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show

relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Music is a feature of the applicant's goods and services. While the wording MUSIC may not describe all attributes of the applicant's goods and services, "[a] mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

With respect to the services in International Class 042 in U.S. Application Serial No. 77622944, the applicant's services are broad enough to include services that feature music and music-related content. The applicant is providing on-line communities for users to form virtual communities and interact with other users. This service is broad enough to include such services with respect to music (i.e. songs, albums, artists, etc.). The applicant is also providing hosting services which allow users to publish and share their own content, including music, on-line with other users. Furthermore, the applicant is providing a website that gives users the ability to upload, create, and edit documents and publications that may feature music.

With respect to the services in International Class 035 in U.S. Application Serial No. 77622947, the applicant is providing business and promotional services that are broad enough to include such services in the field of music. Since the applicant has not stated a specific field for many of the services being provided, the services are broad enough to include services in the field of music or services related to the music field. The applicant is providing services in the nature of the arranging subscriptions to online publications that may be in the field of music. The applicant is also providing on-line wholesale and retail store services that feature downloadable sound files. Since the applicant has not stated the specific content on the downloadable sound files, the applicant's identification is broad to include retail and wholesale store services that feature downloadable sound files featuring music. Furthermore, the applicant is providing an online advertising database and an online video directory that are identified broadly enough so that they may feature the music-related goods and services of others. Finally, the applicant is also providing the publication of advertising texts that feature advertisements, These advertisements may be for music-related goods and services since the applicant has not stated a specific field or subject matter for these services.

In U.S. Application Serial No. 77622948, the applicant is providing goods in International Class 009 that are broad enough to include goods that feature music or information about music. The applicant is providing downloadable files that feature audio books. Since the applicant has not stated the subject matter of the audio books, the identification of goods is broad enough to include audio books that feature information about music and news broadcasts that feature music-related news. Further, the applicant is providing sound recordings and video recordings feature entertainment in the field of

the performing arts. Since the performing arts include music and music performance, the applicant's goods are broad enough to include sound recordings and video recordings in the field of music.

With respect to the services in International Class 041 in U.S. Application Serial No. 77622945, the applicant is providing entertainment and publishing services that are broad enough to include such services in the field of music. The applicant is providing audio, video, and multimedia production services that are broad enough to feature music or information about music or the music field. The applicant is also providing publication services that are broad enough to include publication services that feature music. Furthermore, the applicant is providing the publication of books, magazines, journals, software, games, electronic publications, reviews, and web magazines. Since the applicant has not stated the specific field of these publications, the identification is broad enough to include publications in the field of music.

Furthermore, the examining attorney refers to the attached registrations in the Final Office Action, which include the term MUSIC and a disclaimer of that term. These registrations tend to show that the Office has treated this term as descriptive with respect to entertainment-related services and music-related services, and that other applicants using this term to refer to such services have agreed that this term is descriptive. For example, in the mark HONOR ROLL MUSIC (U.S. Registration No. 3491771), the applicant disclaimed the descriptive wording MUSIC because it was descriptive of the applicant's entertainment services and production services that feature music. Furthermore, in the mark MUSIC SHOWCASE (U.S. Registration No. 2358164), the applicant disclaimed the descriptive wording MUSIC because it was descriptive of the

feature of the applicant's retail store services. Thus, these registrations support a finding that the term MUSIC is descriptive with respect to the applicant's goods and services.

The applicant argues that the applicant's mark is not descriptive because it is a unitary mark that combines a non-descriptive period with the descriptive term MUSIC. The applicant argues that the use of the "dot" before the word serves a highly transformative function in the perception and interpretation of the applicant's mark. However, the Board has held on numerous occasions that adding punctuation marks to a descriptive term will not ordinarily change the term into a non-descriptive one. *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637, 1639 (TTAB 2006) (holding 3-0'S merely descriptive of car wheel rims); *In re Samuel Moore & Co.*, 195 USPQ 237, 240 (TTAB 1977) (holding SUPERHOSE! merely descriptive of hydraulic hose); *see also In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55 (TTAB 1984) (holding that separating the term DESIGNERS and FABRIC with a slash does not alter the commercial impression of merely descriptive mark for retail store services in the field of fabrics and related items); TMEP §1209.03(u).

The applicant also attempts to compare the mark in this case to unitary marks such as BLACK MAGIC, TIRE-X, and RIB/TYPE. However, as noted above, the period before the wording MUSIC does not change the commercial impression of the term. The commercial impression of terms such as TIRE and RIB are changed when terms such as X or TYPE are combined with them. Furthermore, the applicant's mark also identifies a top-level domain name extension and, thus, it has no source identifying significance in the minds of consumers. A TLD in the applied-for mark indicates an Internet address and, in general, adds no source-identifying significance. *See, e.g., In re Hotels.com, L.P.*, 573

F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379-80, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007); *see also In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) ("Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark.").

The applicant argues that the wording MUSIC has so many meanings to consumers that consumers will not immediately know what is being described about the goods or services. The applicant also argues that the applicant's mark will not be used to identify any good or service that consists solely of music. However, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The applicant also states that the applicant's goods and services will feature music by noting that "[t]he descriptions of the very diverse goods and services provided by the .MUSIC environment exemplify that .MUSIC will be a

broad space that brings back a "harmony" in the way artists, producers, and consumers interact."

While the applicant's mark is descriptive of a characteristic or feature of the applicant's goods and services, the applicant's mark is also descriptive because it merely identifies a top-level domain name extension where the applicant's goods and services are to be provided to consumers. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004); TMEP §§1209.03(m), 1215.04. As noted above, a TLD, in general, has no source-identifying significance. *See, e.g.*, *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379-80, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007); *see also In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) ("Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark."). The applicant argues that the examining attorney must show that the TLD is generic. However, no such showing is required as the examining attorney is establishing that the applicant's mark is descriptive of the identified goods and services, not generic.

The examining attorney has attached evidence showing that .MUSIC is a top-level domain name extension that represents "…the global music community, giving music entities a unique identity online." The website set up to support the .MUSIC top-level domain name extension (http://music.us) states that with respect to the .MUSIC top-level domain name extension , "…[n]ot only does it increase a brand's visibility on the net, .music removes second-guessing & confusion by immediately associating a brand's line

of business with a memorable identity: ***music***." The website further states that "[t]he .music generic top level domain (gTLD)…will enable the music community to provide their music services/products to their target audience within minutes." Thus, consumers will clearly view the applicant's mark as merely being a top-level domain name extension where the applicant's goods and services are to be provided. Thus, along with the applicant's mark being descriptive of a feature of the applicant's goods and services, the applicant's mark is also descriptive of a characteristic of the applicant's goods and services, namely that they are provided at websites with the top-level domain extension .MUSIC.

The applicant cited other registrations that have been registered by the Office that include the term DOT or a period in front of another term. First, the applicant has cited many marks that have not yet been registered by the Office and marks that are registered on the Supplemental Register. Thus, these marks are irrelevant with respect to the applicant's argument because the marks have either not yet been registered or have been found to be descriptive by the Office. With respect to many of the other marks cited by the applicant, many of the marks show the term DOT or a period in front of terms that are not descriptive of the identified services. For example, marks such as .PING, DOTNEXT, DOTPROOF, and DOTGO are not analogous to the applicant's case. These marks contain the term DOT or a punctuation mark in front of a term that is either suggestive or arbitrary with respect to the services being provided. In addition, many of the marks cited by the applicant include a design that carries the mark with the descriptive wording disclaimed or were registered before *In re Hotels.com* was decided by the Board and the Federal Circuit, respectively. Thus, while those marks remain registered, the decisions

made with respect to the registration of those marks were not made under the current case law with respect to top-level domain names.

Furthermore, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (C.C.P.A. 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.*, 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000). The Board has held that prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is merely descriptive of the goods and services should be affirmed.

Respectfully submitted,

/Seth A. Rappaport/
Seth A. Rappaport
Trademark Examining Attorney
Law Office 103
Phone: (571) 270-1508
Fax: (571) 270-2508
Email: seth.rappaport@uspto.gov
Michael Hamilton
Managing Attorney
Law Office - 103