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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: .music  
Applicant: theDot Communications Network LLC  
Serial No.: 77/622,947  
Filing Date: Nov. 26, 2008

**APPLICANT’S APPEAL BRIEF**

**TABLE OF CONTENTS**

**INTRODUCTION** ..... 2

**STATEMENT OF FACTS** .....2

**ARGUMENT** ..... 7

I. THE EXAMINING ATTORNEY DID NOT CONSIDER THE GOODS AND SERVICES AS AMENDED; THUS REMAND IS APPROPRIATE ..... 7

II. .MUSIC IS SUGGESTIVE, DISTINCTIVE OR ARBITRARY AS TO APPLICANT’S SERVICES ..... 7

.MUSIC is Not Descriptive of any of Applicant’s Services ..... 8

Applicant’s Mark is Unitary, and thus Entitled to Registration ..... 10

A Mark That Can be Understood as a Double Entendre is Inherently Suggestive ..... 11

III. CONSIDERATION OF THIRD PARTY REGISTRATIONS IS APPROPRIATE ..... 15

A “Dot” Often Transforms Arguably Descriptive Terms into Registerable Marks ..... 16

A Legally Equivalent Mark Was Allowed for US Registration in 2003 ..... 17

The Name of a TLD Is Distinctive and Functions as a Trademark ..... 18

IV. ANY DOUBT MUST BE RESOLVED IN FAVOR OF APPLICANT .....22

## **INTRODUCTION**

Applicant appeals from the Examining Attorney's final refusal to register the Applicant's .MUSIC (pronounced "dot Music") trademark. Applicant respectfully requests the Trademark Trial and Appeal Board to either 1) remand this matter back to the Examining Attorney for reconsideration of Applicant's amended application, or 2) reverse the Examining Attorney's final decision that the Applicant's mark is merely descriptive of the services identified in the amended application, and direct that it be published for opposition.

## **STATEMENT OF FACTS**

Applicant seeks registration on the Principal Register of its .MUSIC mark, for the following services in Class 35:

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.

Applicant provided a thorough response to the Examining Attorney's initial refusal to register, arguing that the mark is not merely descriptive of the services. Applicant provided indisputable evidence of its intended use of the mark, and refuted false evidence from the Examining Attorney, who had assumed that a certain website was related to Applicant. Applicant argued that its mark is unitary, and is intended as a double entendre – and thus is suggestive. Applicant further demonstrated that a legally equivalent "dotMusic" mark had been granted Principal registration in 2003, and that indeed there are dozens of "dot" marks on the Principal Register or approved therefor.

(Marks and serial nos. listed in Response to Office Action, pages 14-15, 17-20, with TARR records attached as Exhibits D, H and J thereto.) Finally, Applicant argued that any doubt regarding suggestiveness of the mark must be resolved in favor of Applicant.

Yet, nineteen days later, the Examining Attorney maintained the Section 2(e)(1) refusal, citing only the following as support: 1) a dictionary definition of the word “music,” 2) a number of third party registrations that disclaim the word “music”, 3) a proposition that “adding punctuation marks to a descriptive term will not ordinarily change the term into a non-descriptive one,” and 4) a proposition that “if the applicant’s mark refers to the top-level domain name extension .MUSIC, then the applicant’s mark is descriptive in that it merely describes the types of websites where the applicant’s services will be offer[ed], namely websites containing the top-level domain name extension .MUSIC. A generic TLD in the applied-for mark indicates an Internet address and, in general, adds no source identifying significance.”

In response, Applicant substantially narrowed the scope of the described services in the application. Applicant then again argued that the mark is in fact suggestive or arbitrary in reference to Applicant’s services, as described in the amended application. Applicant further argued that the Examining Attorney's position is not in accord with USPTO practice with respect to many similar existing registrations and pending applications, such as dotradio, .poker, .movie, .kids, .golf, .home, .casino, .buy, .books and .baby. (TARR records attached as Exhibit A to Request for Reconsideration.) At the time of the final refusal, each of these applications recently had been examined and approved by their Examining Attorneys. None were subject to any initial or final

refusal based upon descriptiveness.

Additionally, Applicant pointed out thirteen different “dot”-formative marks allowed and/or registered in Class 35, and provided TARR screenshots as Exhibit B to the Request for Reconsideration:

- “.home” registered in February, 2010 for “Residential real estate marketing and advertising services.”
- “.tel” (with slight design element) was allowed for registration in November, 2009 for “Services relating to the analysis, evaluation, creation and brand establishment of domain names.”
- “dotGreen” was allowed registration in 2009 for almost all services within Class 35, including:

Arranging and conducting auctions in the field of Internet Domain Names; ...  
"Business process outsourcing services in the field of Internet Domain Names; ...  
Catalog ordering service featuring Internet Domain Names; ... Commercial  
administration of the licensing of Internet Domain Names of others; ...  
Computerized on-line retail store services in the field of Internet Domain  
Names; ... Distributorship services in the field of Internet Domain Names; ...  
Operating an online shopping site in the field of Internet Domain Names."

- “dotFortune (logo)” was registered in November, 2009 for a wide variety of services in Class 35, including "Advertising, marketing and promotional Services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes; ... Business management consultancy and advisory services; ... On-line business networking services; Promoting the goods and services of others by distributing advertising materials through a variety of methods."
- “dotvideo” was allowed for registration in 2007 for:  
  
Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Post-production editing services for video and

audio commercials; Producing audio or video infomercials; Producing promotional videotapes, video discs, and audio visual recordings.

- "DOTMENU" registered in 2007 for "Providing an on-line website for the purpose of providing information to accept orders for restaurant and catered take-out food and delivery of such food."
- "dotloan.com" registered in 2007 for "Providing business marketing information to insurance, financial and mortgage companies pertaining to business information, namely, information regarding prospective customers and sales information via the Internet; ... and providing an online searchable directory of insurance, financial and mortgage information via the Internet."
- ".learn" was registered in 2006 for "Providing on-line registration services for digital distribution of downloadable educational computer software for use in teaching and learning in the fields of sciences, mathematics, engineering, business and economics, humanities, and the social sciences."
- ".web" was registered in 2006 for "Online retail store services featuring computer accessories."
- "dotMed" has been registered since 2004 for "services in the field of providing an on-line marketplace concerning equipments and services used in medical, dental and health care fields, namely directory listings, auctioning and bartering." And again DOTMED was registered in 2009 to the same party for even broader services.
- "dot-films" has been registered since 2004 for "consulting services in advertising, marketing, and promotion in the film, television, audio, electronic, on-line, and interactive media industries and; production of audio-visual promotional presentations for others."

- "DOTAM" and "DOTFM" have been registered since 2002 for "Information services, namely, providing online directories for locating computer network addresses, demographic information, organizations, individuals, addresses, and resources, accessible through a global computer network."
- ".Coop" has been registered since 2003 for "Computer services, namely maintaining a registry of computer network addresses."

Despite all of that evidence, just two days later on March 17, 2010, the Examining Attorney denied Applicant's request for reconsideration, finding that no compelling new facts were presented by Applicant. He dismissed Applicant's third party evidence by citing an unspecified "change in Office Policy" regarding the registration of marks allegedly composed entirely of a top level domain extension.

Yet all of these TARR records, among others, indicate that the Trademark Office regularly and appropriately grants protection for marks and services highly analogous to those contained in Applicant's application, as amended. Thus, like those applications, Applicant's application should be published for opposition. Applicant is incredibly curious to know which "Office Policy" had suddenly changed, as in his written actions, and in a phone call, the Examining Attorney could not cite any such "Office Policy" nor any change to it. Thus, this appeal was then timely filed, and is now timely briefed.

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## ARGUMENT

### **I. THE EXAMINING ATTORNEY DID NOT CONSIDER THE GOODS AND SERVICES AS AMENDED; THUS REMAND IS APPROPRIATE**

In Applicant's request for reconsideration, Applicant revised the description of the goods and services by removing all services arguably "described" by the mark - essentially amending its applications to no longer seek registration covering those services. In the Examining Attorney's response to this request there was no mention of the amended services descriptions and instead the Attorney stated that no new facts or reasons had been presented by Applicant that would warrant a shift in the Attorney's refusal decision. This disregard of Applicant's amendments was erroneous on the part of the Examining Attorney. Thus the Board should remand this matter to the Examining Attorney for further consideration. In the event the Board wishes instead to resolve the matter, Applicant restates its arguments below.

### **II. .MUSIC IS SUGGESTIVE, DISTINCTIVE OR ARBITRARY AS TO APPLICANT'S SERVICES**

The Examining Attorney has argued in his Office Actions that the applied for marks are merely descriptive of the goods and services offered under the marks, offering for support, dictionary definitions of the word music. Applicant does not dispute that the word "music" has various recognized meanings, however that is not the issue at hand. The question instead is whether the marks in question are worthy of registration for the services recited in the amended application. The .MUSIC (or equivalent "dotMusic") mark does not merely describe ANY of the services of Applicant. Rather, the unitary mark is a suggestive or distinctive source identifier of the described

services, and so should be allowed registration on the Principal Register.

**.MUSIC is Not Descriptive of any of Applicant's Services**

To be deemed merely descriptive, a mark must immediately convey knowledge of the services listed in the application. If information about the product or service given by a term used as a mark is indirect or vague, then this indicates that the term is being used in a suggestive, not descriptive, manner. If the applied for mark “clearly does not tell the potential consumer only what the goods are, then the mark is not ‘merely descriptive.’” 2 McCarthy § 11:51, 4<sup>th</sup> ed. (citing *In re Colonial Stores, Inc.*, 394 F.2d 549 (CCPA 1968)). “Unless a word gives some reasonably accurate -- some tolerably distinct knowledge -- as to what the product is made of, it is not descriptive within the meaning of trademark terminology.” *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-700, 131 U.S.P.Q. 55 (C.A.N.Y. 1961) (holding POLY PITCHER suggestive for polyurethane pitchers); *see also, e.g., In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); *Huntington Laboratories, Inc. v. Onyx Oil & Chemical Co.*, 76 U.S.P.Q. 319 (1948).

In this matter, .MUSIC, or even the word “music” alone, clearly does not merely describe any of the wide variety of intended services of Applicant. The Dial-A-Mattress case is instructive, where the court found that mark inherently distinctive for the selling of mattresses. *Dial-A-Mattress Operating Corp. v. Mattress Madness Inc.*, 841 F. Supp. 1339, 1347-48 (E.D.N.Y. 1994) (“The phrase ‘dial a mattress,’ while certainly establishing a link between the telephone and bedding products, does not begin to describe the nature, scope or extent of the services that name has come to represent.”); *citing*

*Blisscraft*, 294 F.2d at 699-700; *see also, e.g., Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1325 (9th Cir.1998) (comparing domain name to 1-800-HOLIDAY). Likewise, while the unitary .MUSIC mark may establish a link between online services and music, it does not begin to describe the nature, scope or extent of those services.

Applicant's mark is even more suggestive than the marks at issue in the cases above. Just as the "Dial A" portion of the mark in that case added an element that made the mark "Dial A Mattress" suggestive for the sale of mattresses, so does the "." in ".MUSIC" add an additional element of suggestiveness. However, in Applicant's case, the mark is even more suggestive, as Applicant does not intend to make and sell its own music, but instead intends to offer a wide variety of other goods and services, some related and some entirely unrelated to music (however it may be defined). (ROA, Baldrige Decl., para. 2.)

In more detail, Applicant's business model focuses on providing tools and resources necessary to empower performing artists and help them achieve their goals. These tools include computer software for creating, composing and processing digital files, and a platform for disseminating those files to others. These tools also include services such as advertising, management, production and publishing of entertainment content. Most importantly, Applicant is developing a new and innovative Internet web architecture, which is intended to result in the creation of the world's largest network of web sites for performing artists to showcase their talents. This new "social network" will allow users, *inter alia*, to "participate in competitions, showcase their skills, get feedback from their peers, form virtual communities, and improve their talent". *Id.*,

para. 3.

**Applicant's Mark is Unitary, and thus Entitled to Registration**

A mark or portion of a mark is considered “unitary” when it creates a commercial impression separate and apart from any unregistrable component. TMEP 1213.05. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required. In general, a mark is unitary if the whole is something more than the sum of its parts, such that the combination itself has a new meaning. *Id.*

The examining attorney must consider a number of factors in determining whether matter is part of a single or unitary mark: whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services.

*Id.* (citing *Dena Corp. v. Belvedere Int'l Inc.*, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991)).

In this matter, Applicant's mark is clearly unitary, as the non-descriptive “dot” immediately precedes and is inextricably connected to the allegedly descriptive “music” portion of the mark. Any descriptive significance of the word “music” in relation to Applicant's goods is lost, and the combination functions as a unit. TMEP 1213.05 provides several examples that support Applicant's position on this issue:

‘Black Magic’ ... has a distinct meaning of its own as a whole. The word “black” is not intended to have color significance in relation to the goods, and should not be disclaimed even if the mark is applied to goods that are black in color.”

*See e.g., B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964) (KUPPENHEIMER and SUP-PANTS combined so that they shared

the double “P,” making “an indivisible symbol rather than two divisible words”); *In re Hampshire-Designers, Inc.*, 199 USPQ 383 (TTAB 1978) (DESIGNERS PLUS+ for sweaters held unitary; thus, no disclaimer of “DESIGNERS” deemed necessary); *In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509 (TTAB 1974) (E GEM for bath oil containing vitamin E held unitary; thus, no disclaimer of “E”).

TMEP 1213.05(a)(ii) is further consistent, as it provides that when a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary. *“X” Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 USPQ 327, 329 (Comm’r Pats. 1955) (requirement for a disclaimer of “TIRE” deemed unnecessary in application to register TIRE-X for a tire cleaner). Furthermore, word marks consisting of two terms joined by an asterisk (*e.g.*, RIB\*TYPE), a slash (*e.g.*, RIB/TYPE) or a raised period (*e.g.*, RIB°TYPE) are analogous to hyphenated words. Therefore, no disclaimer of portions of marks formed by asterisks, slashes or raised periods is necessary. *Id.*

The Examining Attorney should have viewed Applicant’s mark as analogous to these examples within the TMEP, and thus should have allowed the application for registration on the Principal Register.

**A Mark That Can be Understood as a Double Entendre is Inherently Suggestive**

TMEP Section 1213.05(c) states that a “mark that comprises a ‘double entendre’ will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.”

A “double entendre” is a word or expression capable of more than one interpretation. For trademark purposes, a “double entendre” is an expression

that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

A true “double entendre” is unitary by definition. An expression that is a “double entendre” should not be broken up for purposes of requiring a disclaimer.

Where there is such a “double meaning” for a mark, inherently it can not *immediately* signify *only* the goods and services with which it is associated, and thus must be suggestive. A mark that connotes more than one meaning, one possibly descriptive, and the others suggestive, is entitled to registration without proof of secondary meaning because such a mark is not *merely* descriptive. *E.g., In re: David Crystal, Inc.*, 145 U.S.P.Q. 95 (TTAB 1965).

There are many alternative meanings embodied in the .MUSIC mark, which are not merely descriptive of Applicant’s goods and services. As discussed above, Applicant’s mark is not the word “music” alone and further, Applicant’s mark will not be used to identify any good or service that consists solely of music. The use of the “dot” before the word music serves a highly transformative function in the perception of and interpretation of Applicant’s mark.

The word “dot” has many meanings, not least of which is to refer to Applicant, theDot Communications Network LLC. The unitary mark is clearly intended to refer to theDot’s .MUSIC project. ROA, Baldrige Decl., para. 4.

In addition, dictionary definitions of “dot” indicate many other accepted meanings, per the Dictionary.com page attached as Exhibit A to the ROA. At least two of these are clearly relevant to Applicant’s mark:

- a period, esp. as used when pronouncing an Internet address
- *Music*: a point placed after a note or rest, to indicate that the duration of the note or rest is to be increased one half. A double dot further increases the duration by one half the value of the single dot. OR a point placed under or over a note to indicate that it is to be played staccato.

Thus, people encountering Applicant and its mark may have any of at least three specific meanings of the “dot”, either as the name of their service provider (the Applicant), as a period in a domain name, or as the point used in musical composition.

Indeed there is even a fourth, perhaps most likely connotation. More broadly many users may understand the “dot” to refer generally to online services. Baldrige Decl., para. 4. A wide variety of registered US trademarks have been allowed which begin with a ‘dot’, many of which are listed in the ROA and the Request for Reconsideration. These trademarks have been used to connote a more general online or computer-related aspect of the associated goods and services. Given the proliferation of more than 250 top level domains approved to date by ICANN alone, and more than 80 registered “dot” trademarks for online or computer-related services, it is reasonable to assume that internet users have come to distinguish between the large number of various marks and/or TLDs that contain the “dot”.

Furthermore, none of the services in Applicant’s applications are “music”, in any sense of the word. The Examining Attorney’s dictionary evidence from Bartleby.com lists at least seven different meanings for the word as a noun, including “vocal or instrumental sounds possessing a degree of melody, harmony, or rhythm.” But Applicant is not intending to sell any of those things. Applicant intends to offer many goods and services with some relation in the broadest sense to music, and many things

entirely unrelated to music, as listed in the applications – but Applicant does not intend to make and sell its own music and such goods are not listed in any of the applications. Baldrige Declaration, para. 5.

The word “music” is used in many common, incongruous phrases such as “music to my ears” where it denotes anything pleasant to the listener, whether musical or not. Another common phrase is “face the music” – to accept the consequences of one's actions, whether or not they have anything to do with music. Also “chin music” for any sort of talk or chatter, and also for a high inside fastball in baseball. In addition, “stop the music” is a common idiom for “stop everything”, regardless of whether the activity to be stopped has anything to do with music. See, Exhibit B, FreeDictionary.com list of idioms. These idioms each stem from perceived definitions of “music” other than any of the dictionary definitions. These are all extremely common phrases, indicating that “music” may have many definitions to many members of the purchasing public, and therefore is not likely to be viewed as descriptive of Applicant's products.

“Music” also is defined as “any a pleasing or harmonious sound.” Combined with the “dot” in any of its three most apposite definitions listed above, the unitary .MUSIC mark will signify a virtual eco-system where diverse actors can converge in harmony to promote a new way of supporting and promoting the performing arts industry. As such, .MUSIC will signify “harmony” or cooperation in the new online community. Baldrige Declaration, para. 6. The 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.

Given that Applicant's mark can have so many apposite meanings to those who encounter it, it is not merely descriptive of any of Applicant's services. Instead it will function as an inherently distinctive mark, entitled to registration on the Principal Register.

### **III. CONSIDERATION OF THIRD PARTY REGISTRATIONS IS APPROPRIATE**

In his refusal of Applicant's request for consideration, the Examining Attorney dismissed Applicant's third party registration evidence, stating that the registrations were granted before "Office Policy" regarding the registration of top level domains was changed. This disregard for third party registrations and applications based on an unspecified "Office Policy" is clearly erroneous. It is appropriate here for the Examining Attorney to look to the "commercial realities" demonstrated by the third party registration evidence provided by Applicant. *E.g., Keebler Co. v. Associated Biscuits Ltd.*, 207 U.S.P.Q. 1034, 1039 (TTAB 1980) (Third Party registrations recognized as evidence that a certain term was used extensively in marks, thus demonstrating its commercial acceptance.) The third party evidence provided by Applicant clearly shows the longstanding practice within the Trademark Office of granting trademark registrations to marks similar to Applicant's, for services similar to Applicant's. *Id.* at 1038 (a pattern of registrations used to show "long-standing and extensive practice within the Patent and Trademark Office" of recognizing the adoption of marks as applied to a certain field of business and that the registrations "define fields of use and, conversely, the boundaries of use and protection surrounding the marks . . .").

Here, Applicant has provided ample evidence that the use of a “.” (or equivalent “dot”) in third party marks has often served to transform a descriptive term into a registrable mark.

**A “Dot” Often Transforms Arguably Descriptive Terms into Registrable Marks**

A review of marks registered on the Principal Register reveals over 100 registrations containing a “.” or the legally equivalent “dot”.<sup>1</sup> The following examples, with TARR records at ROA, Exhibit D, are illustrative that the addition of a “dot” often has transformed an arguably descriptive term into a registrable mark, and/or often is used in connection with online or computer-related services:<sup>2/3</sup>

.AIR	3450792	DOT CELLS	77657901
.ANIME DOT ANIME	77195261	DOT CHIP	77192425
.BIO	3069730	DOT MED	2857363
.ECO	77452991	DOT RACING	3403325
.FAB	3623517	DOT.CHE	2949491
.GAY THE DOT GAY EXTENSION	77588135	DOT.COMMONS	3036075
.HOME	3571130	DOTBLOG	77219128
.LEARN	3123499	DOTBLOG	77073701
.MED TECHNOLOGY	2902929	DOTCAL	77711774
.MOBILE	3083937*	DOTCAST	2875143
.OFFICE	2670180	DOTCOMMUNITY, INC.	2714559
.PING	77746209	DOTCONTROL	77682856
.SECURITY	2708205*	DOTCOOL	77589804
.SLIDE	78579412	DOTDUDE.COM	2711415

<sup>1</sup> See TMEP 1212.04(b) (“A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.”), *citing, In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

<sup>2</sup> A few of these applications have been initially refused but on technical grounds, other than mere descriptiveness. A few others, marked with an asterisk, are registered on the Supplemental Register.

<sup>3</sup> See also ROA Exhibits H & J, discussed below, containing “dot” formative marks used in connection with registration services, and often a much broader array of online services as well.

.TEST	3077902*	DOTEARTH	77541242
.WAVE	78764834	DOTFAMILY	3579999
DOT-FILMS	2915458	DOTGO	3556937
DOT-FILMS	2911922	DOTGUIDES	2562201
DOT-FILMS	2852356	DOTHOME	77165948
DOTMENU	3293828	DOTIMAGE	2953319
DOTVIDEO	77241463	DOTLAB	77708605
DOTNEXT	77611287	DOTLINK	3183118
DOTNEXT	77611268	DOTLOAN.COM	3191990
DOTORGANIZE	3275249	DOTMED	77594526
DOTPROOF	3177622	DOTSPOTS	77346033
DOTSTAFF	2955002	DOTSPOTS	2693776

Given this proliferation of “dot” formative marks, it is clear that users encountering them have learned to distinguish between them, and that therefore they function as source identifiers entitled to registration on the Principal Register. In particular, many of these refer to online entertainment and information services, similar or identical to those described in the applications, e.g. DOT-FILMS, DOTVIDEO, DOTBLOG, AND .ANIME.

**A Legally Equivalent Mark Was Allowed for US Registration in 2003.**

The PTO has already allowed a registration for the legally equivalent mark “dotMusic” seven years ago, for many of services included within Applicant’s descriptions of goods and services. Namely, that Application S/N 76162974 covered goods and services in five classes.<sup>4</sup> ROA, Exhibit C, TARR record. These services included

<sup>4</sup> Class 009 -- Downloadable electronic publication in the nature of a magazine in the field of music and entertainment; downloadable musical sound recording; Class 016 -- Printed matter, namely magazines in the field of music and entertainment; Class 035 -- Advertising services, namely, promoting the goods and services of others by preparing and placing advertisements on web sites; Class 039 -- Travel agency services, namely, making reservation and bookings for transportation and arranging travel tours; Class 041 -- Providing information in the fields of music and entertainment namely, news, interviews, music-ranking charts, discographies, biographies and reviews relating to musical recordings, musical performances, motion pictures, performers and recording artists; entertainment services, namely, providing a website featuring musical performances, prerecorded

“downloadable music sound recording,” “electronic publication ... in the field of music,” “placing advertising,” and “providing information in the fields of music...”.

This application was allowed in 2003, after an initial rejection for descriptiveness, by the Examining Attorney at that time. The global service was operated by British Telecom since at least 2000, acquired by Yahoo! in 2003, and then abandoned (with domain name redirecting to Yahoo! Launchcast) by January 2005. Exhibit C contains evidence of the history of that service. Given all of the evidence and argument provided in this Response, and the lack of any substantial and contrary evidence presented by the Examining Attorney, at minimum the Applicant should be allowed to register its legally equivalent mark for analogous services as set forth in that prior allowed application. See TMEP 1212.04 and 1212.04(b).

**The Name of a TLD Is Distinctive and Functions as a Trademark**

The Examining Attorney has maintained that the Applicant’s mark is “merely a TLD” and has cited two cases for the proposition that a Top Level Domain (“TLD”) can not be a source indicator. Preliminarily, the two cases cited do not relate directly to the Applicant’s mark at hand, as the issue does not concern the addition of a TLD to other matter, but instead whether a unitary mark serves as a source indicator for domain registration services -- and many other goods and services. Moreover, in this application, Applicant has not sought to register for any sort of domain registration services.

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music, musical videos, related film clips, photographs, on-line reviews, commentary and articles about music and other multi-media materials; theatrical booking agency services for tickets to cinemas, theaters, shows and concerts.

In the case of *In re Steelbuilding.com*, vacating the Board's determination that STEELBUILDING.COM was generic for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems," the Federal Circuit criticized the Board for considering STEELBUILDING and .COM separately, holding that:

[t]he addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include 'building' or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure. 415 F.3d, 1293, 1299, 75 USPQ2d 1420, 1423 (Fed. Cir. 2005).

The Court also criticized the Board for relying on evidence that "steel building" or "steel buildings" is generic, where there was an alternative meaning of the composite term STEELBUILDING as denoting the act of building steel structures. The two cases cited by the Examining Attorney refer to the addition of a generic TLD indicator, like .com, to a descriptive term – i.e., lawyers.com. Still, the Federal Circuit cautioned that a term that is not distinctive by itself may acquire some additional meaning, even from the addition of a truly generic TLD such as .com. *In re Steelbuilding.com*, 415 F.3d at 1297, 75 USPQ2d at 1422 (STEELBUILDING.COM for "computerized on line retail services in the field of pre-engineered metal buildings and roofing systems" held not merely descriptive).

Similarly in this matter, Applicant's .MUSIC mark incorporates two elements to suggest internet services which might have applications related to music, in addition to other performing arts, entertainment and news. Both the "dot" and the word "music" have several apposite meanings, and combine to form a unitary mark that does not

“merely describe” any of Applicant’s services. Applicant’s mark is not intended for use “merely as a TLD” as Applicant has demonstrated above. In fact Applicant intends to offer a wide variety of services listed in the applications, of which domain registration is only one fairly minor facet. Baldrige Decl., para. 7. But in this application, no such services are described.

Moreover, it is likely that consumers will understand that the mark means more than “merely a TLD” because many existing TLD operators provide a variety of value-add services under their TLD names/marks, other than domain registration. To establish that a mark comprising a generic term with a TLD is generic, the Examining Attorney must show that the relevant public would understand the mark as a whole to have generic significance. *See In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM held generic for “providing an online interactive database featuring information exchange in the fields of law, legal news and legal services,” where the record included pages from applicant’s website showing that applicant’s services include providing information about lawyers and assistance in selecting a lawyer, and pages from eight other websites containing “lawyer.com” or “lawyers.com”). In this matter, the Examining Attorney has not provided any such evidence, and cannot do so since any .MUSIC TLD would be unique and effectively perpetually granted, as described in the ROA, pages 18-19 and Exhibits I.

Indeed, ROA, Exhibits H and J include TARR records of many existing TLD trademark registrations and allowed applications, including the following:

.LA	3510613	.4U	77514695
.ORG	3044328	DOT.SEX	2880635
.TEL	77415964	DOT.EARTH	2762106
.TEL	3617902	DOT.EASY.COM	3049871
.TEL	3617901	DOT.FAM DOT.FAMILY	3597850 3579999
.TEL	2878200	DOT.GREEN	77386714
.TRAVEL	3313153	DOT.MANIAC.COM	3093089
DOT COOP	2767646	DOT.NOW	2794524
DOT VN	2966712	DOT.PLANET	2998497
DOTAM	2641862	DOT.REGISTRAR	2478239
.BIZ	2746004	DOT.SPORT	77499377
DOT TRAVEL	2924877	DOT.WIZ	2772865
DOTFM	2603972	DOT.WORLDS	3373356
.NU DOMAIN	2724674	.NUDOMAIN	2922456

All of these include domain registration services, and many include a much broader variety of online services.

DotAM and DotFM, in particular, are extremely close to .MUSIC due to their “musical” connotations, and with services described as “Information services, namely, providing online directories for locating computer network addresses, demographic information, organizations, individuals, addresses, and resources, accessible through a global computer network.”

Additionally, the following had not yet passed examination, but were not found merely descriptive after initial Office Action, and include domain registration services (ROA, Exhibit J contains the TARR records):

.BABY	77719708	.KIDS	77719822
.BOOKS	77719768	.MOVIE	77719662
.CASINO	77719628	.POKER	77719729
.EARTH	77541619	DOT.GAME	77701618
.GOLF	77719683	DOT.RADIO	77708802

Like all of the marks listed above, .MUSIC will not “merely describe” any of the

wide variety of goods and services it provides, but instead will clearly identify the inherently distinctive source of those goods and services. Indeed the DOTRADIO application was approved for publication this week, on June 20, 2010, in Class 42 for the following services: “Computer IP address management services, namely, enabling entities to access, add, modify or delete information relating to their computer network addresses; computer services, namely, hosting websites of others on computer name servers in a global computer network.”

Thus it does not appear that any “Office Policy” has changed, and Applicant’s mark should also be approved for publication for the services it describes in this Class.

#### **IV. ANY DOUBT MUST BE RESOLVED IN FAVOR OF APPLICANT**

In the event there remains any doubt as to whether Applicant’s mark is suggestive or merely descriptive, this uncertainty must be resolved in favor of the Applicant. As the Board stated in *In re Bed-Check Corp.*, 226 USPQ 946 (TTAB 1985) (holding SENSORMAT was not merely descriptive of, *inter alia*, an electrical sensor mat to be placed under a patient):

We recognize that there is often a thin line separating merely descriptive from suggestive terms and that judgments in these cases are frequently subjective. However, where there is doubt in the matter, the doubt should be resolved in Applicant’s favor.

*See also In re: Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994)

(holding “Muffuns” not merely descriptive of muffins).

Since a published mark can still be opposed by interested parties, Applicant respectfully requests that allowance be made for its application to be published for opposition.

Respectfully submitted,

June 23, 2010

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