From: Salemi, Dominick

Sent: 12/9/2007 2:03:34 PM

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Subject: TRADEMARK APPLICATION NO. 78491274 - DIGITAL - 80559.00004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	**Border Media Partners, L.L.C.**	**:**	**BEFORE THE**
Trademark:	**DIGITAL**	**:**	**TRADEMARK TRIAL**
Serial No:	**78-491274**	**:**	**AND**
Attorney:	**Cline H. White**	**:**	**APPEAL BOARD**
Address:	**Tuggey Rosenthal Pauerstein Sandolosky Agather LLP Suite 200 755 East Mulverry Ave San Antonio TX 78212**	**:**	**ON APPEAL**

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Attorney's refusal to register the mark DIGITAL under Section 23 of the Trademark Act on the ground that the subject matter for registration, used to identify applicant's radio broadcasting services, is incapable of identifying those services and distinguishing them from those of others.

FACTS

Applicant has applied to register the designation DIGITAL on the Supplemental Register for "radio broadcasting services." Registration was finally refused under Section 23 of the Trademark Act on the ground that the designation was incapable of identifying and distinguishing applicant's services. This finding was based on

dictionary definitions, applicant's specimens and excerpts from the Lexis/Nexis Research database, all of which have been made of record.

ARGUMENT

THE DESIGNATION, DIGITAL, USED TO IDENTIFY RADIO BROADCASTING SERVICES, IS INCAPABLE OF IDENTIFYING AND Distinguishing SAID SEVICES AND THUS SHOULD NOT BE ACCORDED REGISTRATION ON THE SUPPLEMENTAL REGISTER.

It is now well established that to be considered unregistrable on the Supplemental Register, a designation must be incapable of functioning as an indication of origin for the goods or services in question. Section 23 of the Trademark Act, 15 USC 1091. Unregistrable matter has been defined to include generic and common descriptive terms for goods or services as well as designations considered to be so highly descriptive of the identified goods or services that they have come to lack all ability to denote origin in any person or legal entity. See: *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 4460447 (TTAB 1980) (BODY SOAP for a body shampoo held to be unregistrable on the Supplemental Register.)

In determining whether a designation is registrable on the Supplemental Register, one must look to the meaning of the term or designation as applied to the goods or services, the context in which it is used on the specimens of record, and the likely reaction to said designation or term when discovered or encountered by the average purchaser. *In re Cosmetic Factory, Inc.*, supra.

For proof that applicant's designation is incapable of identifying and distinguishing its radio broadcasting services, one need only look at a dictionary definition of "digital." Merriam-Webster's Dictionary defines the word as one in which "sound waves are represented . . . so that wow and flutter are eliminated and background noise is reduced." Thus, the word or term used in this context, identifies an important, indeed the salient feature of applicant's radio broadcasting services, much the way "high definition" would and is used in connection with television broadcasting and with television sets. This, moreover, is more than likely the reason applicant places the word at the top of its billboard advertisement (the specimen provided by applicant), as it is this feature that it deems most important in promoting its radio broadcasting services.

Applicant contends, essentially, that the word "digital" cannot be generic here as it does not identify a "thing"; but, rather, a feature of its services and so at most can only be considered descriptive. However, it is well established that a term that serves as the common descriptor of a key ingredient, characteristic or feature of the

goods is also generic and thus incapable of distinguishing source. A term need not relate solely to the name of the goods or services in order to be held incapable of serving as an indicator of origin. *A.J. Canfield Co. v. Honickman,* 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas); *Miller Brewing Co. v G. Heileman Brewing Co*., 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977) (LITE generic for beer), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.,* 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (PASTEURIZED for face cream incapable); *Roselux Chemical Co, Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (SUDSY generic for ammonia); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (ART DECO generic for flatware); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for stores that sell lingerie); *In re National Patent Development Corp.*, 231 USPQ 823 (TTAB 1986) (ULTRA PURE for interferons for medical use incapable); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of wicker furniture and accessories); *In re Hask Toiletries,* 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983) (BEE POLLEN FROM ENGLAND for bee pollen incapable).

Turning to just a few of the entries from the hundreds found in the Lexis/Nexis Research database, we find "digital" widely used in the generic sense to refer to a prized and very particular feature of radio broadcasting. So widespread is the use of "digital," that it can be safely said that it is today readily employed and recognized as a term of art in the broadcasting field, and one that the purchasing public would recognize as the common or class name of a characteristic and important feature of a radio broadcast. See: *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

> **HD Radio is a new form of digital broadcasting . . .**
> **So far, more than 1,200 stations nationwide have**
> **adopted the technology.**
>
> **Story 1 0f 853**

> **HD Radio is a new form of digital radio broadcasting that**
> **allows radio stations to deliver extra music content . . .**
>
> **Story 4 of 853**

> **The Australian government passed digital radio broadcasting**

in May 2007. Digital radio broadcasting will begin in capital cities . . .

Story 10 of 853

Finally, applicant contends that the mark is not generic – although it also argues that the mark is not descriptive as well – as there are many different definitions of "digital." Toward proving that point, applicant has provided dozens of entries from various dictionaries. However, it must be remembered that the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. See: *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); see, *e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (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) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk" where relevant trade uses the denomination "concurrent" as a descriptor of this particular type of operating system); see TEMP Section 1209.01(b). Moreover, the fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. See also: *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, LTD.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974); TMEP Section 1209.03(c). And in the context of radio broadcasting, the undersigned examining attorney believes it has been clearly shown that "digital" is a term of art in the industry for a type of radio broadcasting.

CONCLUSION

For the foregoing reasons, the refusal to register on the Supplemental Register, on the ground that DIGITAL is incapable of identifying and distinguishing applicant's radio broadcasting services, should be affirmed.

Respectfully submitted,

/s/Dominick J. Salemi
Trademark Attorney

Mary Sparrow
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