

ESTTA Tracking number: **ESTTA183730**

Filing date: **12/28/2007**

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

Proceeding	78491274
Applicant	Border Media Partners, LLC
Applied for Mark	DIGITAL
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Submission	Reply Brief
Attachments	BMP - Applicant's Reply Brief.pdf (5 pages)(16694 bytes)
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APPLICANT'S REPLY BRIEF

BACKGROUND

Applicant has filed an application for the mark DIGITAL for radio broadcasting services (the "Mark"). The Examining Attorney initially rejected the mark for registration arguing the mark allegedly merely describes the services, citing Trademark Act (as amended) § 2(e)(1); 15 U.S.C. § 1052(e)(1); TMEP § 1209, et seq. Subsequently, the Examining Attorney went on to argue that the mark is allegedly generic for applicant's services, citing Trademark Act Section 23(c), and 15 U.S.C. §1091(c).

ISSUES

Applicant appeals the Examiner's ruling and seeks a determination that the Mark is not merely descriptive of the described services, and registration of the Mark on the principle register be allowed. Alternatively, if the TTAB determines the Mark is merely descriptive, Applicant seeks a determination that the Mark is not generic for the described services, and registration of the Mark on the supplemental register be allowed.

ARGUMENTS AND AUTHORITIES

Merely Descriptive

The Examiner has ignored his obligation to prove that the Mark is merely descriptive. Instead, he seems to imply that Applicant has admitted same and moves on to make broad generalizations regarding the mark being generic. This is an error on the part of the Examiner. In fact, the Mark is not merely descriptive of Applicant's services, and is protectable on the Primary Register. Only in the alternative does Applicant seek a ruling that the mark is capable of registration on the Supplemental Register.

Authorities Cited By Examiner

The Examiner seems to rely on authorities that have no connection to the case at bar. He simply cites cases with outcomes he likes and leaves it at that. If, for example, LA LINGERIE was found to be generic for “lingerie,” as is cited by the Examiner, Applicant agrees with the result in that case. If Applicant was seeking to register the mark RADIO BROADCASTING SERVICES for “radio broadcasting services,” then that case would probably be relevant. As for the mark Applicant is seeking registration on, Registration 2666824 for THE DIGITAL GENERATION cited previously by Applicant seems to be much more applicable. For that registration, THE DIGITAL GENERATION for “[e]lectronic equipment, namely video cameras, video cassette recorders, video disks, video tape recorders, blank cassettes, musical sound recordings, sun glasses, laser pointers, video game controllers, and miniature televisions. ... [l]unch boxes, lunch pails, paper cups, paper plates, beer mugs, glass mugs, and porcelain mugs. ... [c]andy, breakfast cereal, grain based beverages, herbal food beverages and non-dairy, non-vegetable based food beverages. ... underwriting insurance in the field of automobile, home, and life; banking services; funds investment; electronic funds transfer and financial information provided by electronic means, for purposes of banking, debit card and smart card transactions. ... [and] [t]elecommunication services, namely cellular telephone services and television and *radio broadcasting services*,” [emphasis added] was not required to disclaim “Digital” for radio broadcasting services. It is not consistent for the PTO to hold that “Digital” for radio broadcasting services (in part) is fully protectable on the Primary Register in one instance, but is generic in another.

Lack of Evidence Provided by the Examiner

The Examiner, with a universe of information available on the Internet and Lexis/Nexis Research database, only is able to claim, without providing same, that there are 853 hits. Of these claimed hits, the Examiner provides three (3) blurbs in his brief. This “evidence,” without comment on its applicability, is so minimal as to be no evidence at all.

It seems that the Examiner is attempting to use short blurbs in unreferenced stories that apparently refer to the type of hardware that radio waves can be transmitted with. Again this seems irrelevant, or at least removed from the services that Applicant is providing. There is no evidence of common usage of the Mark in relation with radio shows, or what consumers hear disc jockeys say on the radio. For example, “hits” it used all of the time in radio broadcasting services to describe popular songs. Along this same line, “oldies,” “rock,” “jazz,” and the like, refer to genres of music played in radio broadcasting services. Contrarily, “Digital” has no similar usage or meaning in radio broadcasting services, and the Examiner has provided no evidence that it does.

Dictionary Definitions

In regard to dictionary definitions, the Examiner seems to argue both sides of the fence – discounting Applicant’s arguments, but presenting his own. The Examiner correctly states that whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. However, again the Examiner makes a correct

statement, then cites some cases that have outcomes he likes without relating them to the case at bar, and then concludes with a broad generalization.

The Examiner cites the Merriam-Webster Dictionary for a definition in support of his argument. Specifically, he states, “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.” This is somewhat misleading in that the entire definition relates to an “audio *recording method*,” not radio broadcast services. The entire definition is, “relating to an audio recording method in which sound waves are represented **digitally** (as on magnetic tape) so that in the recording wow and flutter are eliminated and background noise is reduced.” [emphasis in original] Merriam-Webster’s full definition shows how inapplicable it is to Applicant’s services.

Placement of Mark in Specimen

The Examiner notes in his brief that, in determining the registerability of a mark one must look, in part, at, “... the context in which it is used on the specimens of record... .” The Examiner notes that Applicant’s specimen is a billboard with the mark at the top. He then speculates that this placement is “more than likely” because the term “identifies an important, indeed the salient feature of applicant’s radio broadcasting services.” This speculation is both illogical and incorrect. Following the Examiner’s reasoning, Applicant would also or just as likely have placed “switches,” “antennas,” “microphones,” or the like at the top of its advertising billboard. Applicant, like most trademark users, placed its mark in the dominant position on its billboard because it

wants consumers to recognize and remember the source or sponsor of its radio broadcasting services. In other words, Applicant is using its mark like a trademark.

CONCLUSION

Applicant's mark DIGITAL is not merely descriptive, nor generic, of Applicant's services because there is no link, or only a tenuous link, between the mark and the services. "DIGITAL" has multiple meanings and is suggestive. The consumer's mind would not jump instinctively from a contemplation of this mark to knowledge of a quality or characteristic of the goods or services or even that it was used on or in connection with radio broadcasting services.