

PTO Form 1857 (Rev 5/2006)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78491274
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p>REQUEST FOR RECONSIDERATION</p> <p>Applicant hereby requests reconsideration of the final rejection and argues as follows:</p> <p>ARGUMENT</p> <p>The Examining Attorney has finally rejected the mark for registration because the mark allegedly merely describes the services, citing Trademark Act (as amended) § 2(e)(1); 15 U.S.C. § 1052(e)(1). Applicant disagrees with the Examiner's analysis in this case and requests reconsideration of its application.</p> <p>The Examiner has summarized Applicant's argument as simply that the definition presented by the Examiner is not the primary, nor the first listed definition in the dictionary. This is an incorrect interpretation of the whole of Applicant's argument. As Applicant has previously argued, the mark DIGITAL is not merely descriptive of Applicant's services because consumers will not connect the mark with the services, thus it is not descriptive.</p> <p>The Examiner has stated that the "fact that a term may have different meanings in other contexts is not controlling." However, the Examiner leaves the argument with that unsupported statement. The Examiner seems to imply that other meanings are irrelevant, which is not correct.</p> <p>TMEP 1209.03(e) discusses instances in which a term has more than one meaning and states that multiple definitions may not be controlling, but that "descriptiveness must be determined in relation to the goods or services for which registration is sought." This is where the Examiner's argument and evidence fall short. The examiner, in the first office action, only referred to a dictionary definition, and in the final office action attached 12 references to digital radio from the Internet (and half of those are foreign references). Interestingly, a Google search for "digital" returned a reported 3.1 <u>billion</u> hits, yet to applicant's knowledge, there is only one other entity using the term "Digital" as a portion of a trademark for radio broadcasting services. Interestingly, Registration 2666824 for THE</p>	

DIGITAL GENERATION is registered on the primary register without any disclaimer. Additionally, the references cited by the Examiner are not relevant to the listed services -- at best, they could be argued to be related to radio hardware. i.e. The equipment used to broadcast the radio signal. The type of hardware used by a station is invisible to radio listeners, and irrelevant when it comes to causing an association between the mark and the relevant services being provided to the relevant consumer group.

The only connection between the mark and the services that the Examiner has made is in the original office action in which it was stated that the mark, "...merely serves to inform the public that it broadcasts digital audio signals." Despite the requirement that the PTO establish a prima facie case that the proposed mark is merely descriptive, there has been no evidence supplied that the mark would cause the public to believe that Applicant broadcasts digital audio signals. *In re Establisements Darty et Fils*, 759 F.2d 15 (Fed. Cir. 1985).

At the end of the day, DIGITAL simply doesn't describe radio broadcasting services. Listeners, upon hearing the mark, would not associate the mark with radio broadcasting services. While not "determinative," the fact that there are other more common definitions, and a multitude of other uses of "digital" (yet not for radio broadcasting services) support this position.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Cline H. White/
SIGNATORY NAME	Cline H. White
SIGNATORY POSITION	Attorney for Applicant
SIGNATURE DATE	05/30/2006

FILING INFORMATION SECTION

SUBMIT DATE	Tue May 30 18:47:34 EDT 2006
TEAS STAMP	USPTO/ROA-65.66.184.221-2 0060530184734614340-78491 274-332ca14aba971e14ff8b4 0b910e7172c-N/A-N/A-20060 530184158611100

PTO Form 1957 (Rev 5/2008)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. 78491274 has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

Applicant hereby requests reconsideration of the final rejection and argues as follows:

ARGUMENT

The Examining Attorney has finally rejected the mark for registration because the mark allegedly merely describes the services, citing Trademark Act (as amended) § 2(e)(1); 15 U.S.C. § 1052(e)(1). Applicant disagrees with the Examiner's analysis in this case and requests reconsideration of its application.

The Examiner has summarized Applicant's argument as simply that the definition presented by the Examiner is not the primary, nor the first listed definition in the dictionary. This is an incorrect interpretation of the whole of Applicant's argument. As Applicant has previously argued, the mark DIGITAL is not merely descriptive of Applicant's services because consumers will not connect the mark with the services, thus it is not descriptive.

The Examiner has stated that the "fact that a term may have different meanings in other contexts is not controlling." However, the Examiner leaves the argument with that unsupported statement. The Examiner seems to imply that other meanings are irrelevant, which is not correct.

TMEP 1209.03(e) discusses instances in which a term has more than one meaning and states that multiple definitions may not be controlling, but that "descriptiveness must be determined in relation to the goods or services for which registration is sought." This is where the Examiner's argument and evidence fall short. The examiner, in the first office action, only referred to a dictionary definition, and in the final office action attached 12 references to digital radio from the Internet (and half of those are foreign references). Interestingly, a Google search for "digital" returned a reported 3.1 billion hits, yet to applicant's knowledge, there is only one other entity using the term "Digital" as a portion of a trademark for radio broadcasting services. Interestingly, Registration 2666824 for THE DIGITAL GENERATION is registered on the primary register without any disclaimer. Additionally, the references cited by the Examiner are not relevant to the listed services -- at best, they could be argued to be related to radio hardware. i.e. The equipment used to broadcast the radio signal. The type of hardware used by a station is invisible to radio listeners, and irrelevant when it comes to causing an association between the mark and the relevant services being provided to the relevant consumer group.

The only connection between the mark and the services that the Examiner has made is in the original office action in which it was stated that the mark, "...merely serves to inform the public that it broadcasts digital audio signals." Despite the requirement that the PTO establish a prima facie case that the proposed mark is merely descriptive, there has been no evidence supplied that the mark would cause the public to believe that Applicant broadcasts digital audio signals. *In re Etablissements Darty et Fils*, 759 F.2d 15 (Fed. Cir. 1985).

At the end of the day, DIGITAL simply doesn't describe radio broadcasting services. Listeners, upon hearing the mark, would not associate the mark with radio broadcasting services. While not "determinative," the fact that there are other more common definitions, and a multitude of other uses of "digital" (yet not for radio broadcasting services) support this position.

Response Signature

Signature: /Cline H. White/ Date: 05/30/2006

Signatory's Name: Cline H. White

Signatory's Position: Attorney for Applicant

Serial Number: 78491274

Internet Transmission Date: Tue May 30 18:47:34 EDT 2006

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