

ESTTA Tracking number: **ESTTA264262**

Filing date: **02/03/2009**

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

|                        |   |
|------------------------|---|
| Proceeding             | 79039874  |
| Applicant              | Axel Springer AG  |
| Applied for Mark       | TVDIGITAL   |
| Correspondence Address | Peter C. Stomma<br>Boyle Fredrickson S.C.<br>840 N. Plankinton Ave<br>Milwaukee, WI 53203<br>UNITED STATES<br>docketing@boylefred.com |
| Submission             | Applicants Request for Remand and Amendment   |
| Attachments            | MotionToSuspend.PDF ( 19 pages )(589687 bytes )   |
| Filer's Name           | Peter C. Stomma   |
| Filer's e-mail         | pcs@boylefred.com, dawn@boylefred.com, docketing@boylefred.com  |
| Signature              | /peter c. stomma/   |
| Date                   | 02/03/2009  |

I hereby certify that this correspondence is being electronically submitted to the Trademark Trial and Appeal Board on the date indicated below.

  
\_\_\_\_\_  
Peter C. Stomma

2/3/09  
Date

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

Application of: AXEL SPRINGER AG

Serial No.: 79/039,874

Mark: TVDIGITAL

Filed: April 4, 2007

MOTION TO SUSPEND APPEAL AND REQUEST FOR REMAND

COMMISSIONER FOR TRADEMARKS  
BOX 1451  
Arlington, VA 22313-1451

**I. INTRODUCTION**

At issue in this appeal is the Trademark Examining Attorney's final refusal to register Applicant's mark on the ground that the identification of goods and services in International Classes 16, 35, 38 and 41 are indefinite. See, Trademark Act §1(b)(2), 15 USC §1051(b)(2); Trademark Rule 2.32(a)(6); and 37 CFR 2.32(a)(6). Concurrently herewith and attached as Exhibit 1 hereto, Applicant has filed a Response to Office Action which Applicant believes places the present application in condition for allowance. For the reasons hereinafter noted, Applicant respectfully requests the Board to suspend the pending appeal and remand the present application the Examining Attorney to consider the newly filed Response.

**II. BACKGROUND**

On or about April 4, 2007, Applicant filed the present application seeking registration of the mark, TVDIGITAL. On the same day, Applicant filed a second application seeking registration of the mark, TV DIGITAL, U.S. Serial No.: 79/039,873 (hereinafter, the '873 application). It is noted that both marks were filed with identical identifications of goods and services.

The present application was assigned to Examining Attorney Sonya B. Stephens who issued a first Office Action on July 30, 2007 rejecting the mark for a variety of reasons, including on the grounds that the identification of goods and services was indefinite. In that Office Action, she recommended changes to the identification of goods and services. In response, on January 28, 2008, Applicant amended the identification in a *bona fide* effort to comply with the Examining Attorney's suggestions. However, on April 28, 2008, the Examining Attorney made final her rejection of the identification of goods and services, as being indefinite and requiring clarification.

Before the due date for the response to outstanding final Office Action in the present application, the co-pending '873 application was approved for publication with an amended identification of goods and services. As such, Applicant contacted the Examining Attorney by telephone to suggest amending the identification of goods and services in the present application to mirror the identification in the '873 application, since such identification had been approved by the Office. In response, the Examining Attorney advised Applicant that the '873 application was in the process of being withdrawn from publication because the identification in the '873 application was indefinite. This statement by the Examining Attorney, however, was incorrect. The '873 publication was

withdrawn from publication solely to permit entry of a properly worded disclaimer. Subsequently, the '873 application was published on January 6, 2009 with the same identification of goods and services as suggested by Applicant to the Examining Attorney in the aforementioned telephone conference.

In view of the foregoing, on or about October 27, 2008, Applicant filed a notice of appeal and a response to the outstanding office action in the present application in a *bona fide* attempt to address the Examining Attorney's concerns with respect to the identification of goods and services. Unfortunately, the Examining Attorney refused reconsideration in an office action dated December 5, 2008.

As a result of the reconsideration exchange, the sole remaining issue in present application is the Examining Attorney's objection to the identification of goods and services in International Classes 16, 35, 38 and 41 as being indefinite, and hence, unacceptable. In order to place the present application in condition for allowance, concurrently herewith, Applicant filed a response to the office action of December 5, 2009 wherein Applicant amended the identification of goods and services in International Classes 16, 35, 38 and 41 to be identical to the identification of goods and services in published co-pending '873 application for the mark, TV DIGITAL. Attached as Exhibit 1 is copy of the response, as filed.

Since the identification of goods and services, as amended, in the present application has been deemed acceptable by the Trademark Office in the co-pending '873 application, Applicant believes that such identification of goods and services should be acceptable in the present application.

### **III. ARGUMENT**

#### **A. APPLICANT REQUESTS REMAND OF THE PRESENT APPLICATION IN ORDER FOR THE EXAMINING ATTORNEY TO CONSIDER THE RESPONSE OF FEBRUARY 3, 2009**

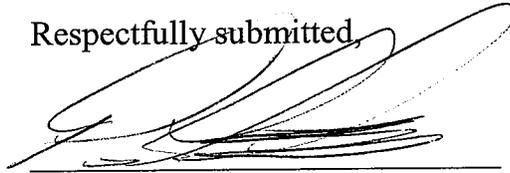
Under TBMP §1209.04, the Trademark Trial and Appeal Board may remand the present application to the Examining Attorney in response to Applicant's request, provided a showing of good cause is made. As hereinafter described, Applicant believes that there is clearly good cause to remand the present application.

As heretofore described, the Examining Attorney denied the Applicant's request for reconsideration on December 5, 2008 because, in the Examining Attorney's opinion, the identification of goods and service in the present application was indefinite. However, the Examining Attorney did not consider the

Applicant's current proposed amendment making the identification of goods and services in International Classes 16, 35, 38 and 4 identical to the identification of goods and services in the published, co-pending '873 application. This amendment was not formally presented to the Examining Attorney because Applicant had been mistakenly advised by the Examining Attorney that the '873 application was pulled from publication due to the indefiniteness of identification of goods and services. Instead, Applicant made a further effort to comply with the Examining Attorney's suggestions to avoid the perceived indefiniteness issues by making other changes to the identification of goods and services, changes that were ultimately rejected as insufficient. It is noted that the Notice of Publication in the '873 application was sent to Applicant on December 11, 2008 and that the '873 application was published January 6, 2009, well after the Examining Attorney's denial of Applicant's request for reconsideration.

In view of the Office's prior acceptance of the identification of goods and services offered by Applicant in the concurrently filed Amendment, it is believed that Applicant has shown good cause to suspend the present appeal and remand the application back to the Examining Attorney for consideration of Applicant's Response to Office Action dated February 3, 2009.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter C. Stomma', written over a horizontal line.

Peter C. Stomma, Reg. No. 36,020

Dated: 2/3/09  
Boyle Fredrickson, S.C.  
840 North Plankinton Avenue  
Milwaukee, Wisconsin 53203  
Phone: (414) 225-9755  
Attorney Docket No.: 1366.008

# EXHIBIT 1

**TRADEMARK**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of: ) **CERTIFICATE OF MAILING**  
 )  
AXEL SPRINGER AG ) I hereby certify that this correspondence is  
 ) being deposited with the United States Postal  
Serial No.: 79/039,874 ) Service as first class mail with sufficient  
 ) postage in an envelope addressed to: Assistant  
Filed: April 4, 2007 ) Commissioner For Trademarks, 2900 Crystal  
 ) Drive, Arlington, VA 22202-3513, the  
Examiner: Sonya B. Stephens ) 3rd day of February, 2009.  
 )  
Law Office: 105 )  
 )  
Mark: TVDIGITAL ) Dawn M. Olenzak February 3, 2009  
 ) Date

**RESPONSE TO OFFICE ACTION**

ASSISTANT COMMISSIONER  
FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, VA 22202-3513

Sir:

Responsive to the Office Action dated December 5, 2008, the sole issue being the identification of goods and services, please amend the above-identified application as follows:

**Identification of Goods/Services**

Please amend the identification of goods and services to read as follows:

**International Class 16:**

Paper and cardboard cartons, boxes, and containers; printed matter and

materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming; printed teaching and educational materials in the field of digital TV.

**International Class 35:**

Providing a database for collecting, compiling, processing, updating, selecting, evaluating and providing data reproduction services for third parties; data processing and data reproduction services.

**International Class 38:**

Telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news; transmission of sound and pictures via cable and satellite; providing information concerning telecommunications and communication services in the fields of telecommunications access and communication by electronic computer terminals and television services; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; providing multiple-user access to a global computer information network via the internet, other networks, namely, a global computer information network, and on-line internet and broadcasting services featuring, news and entertainment programs; providing access to electronic media transmission services and information via the internet, especially on-demand transmission services; electronic transmission of news and information, e-mail and mobile communications services featuring transmission of news, information and pictures via computer, teletext services; transmitting information of all kinds of internet addresses, namely, web-messaging; providing information about telecommunications

featuring electronic media transmission services and information via the internet.

**International Class 41:**

Educational and entertainment services, namely, organizing community sporting and casual activities, and providing continuing radio and television programs featuring news and entertainment programs and providing information related thereto; publication and editing of printed matter in particular newspapers and magazines; electronic publishing services for others, namely, on-line publication of electronic media, electronic text, graphics, and pictures with all featuring news and entertainment programs and sound information, as well as, language data available via computer networks; production of motion picture film, image and sound recordings, namely, production of motion pictures and video films, and recording of audio and video tapes for others; online publishing of electronic books, electronic magazines and electronic newspapers, and image and sound recording works of others.

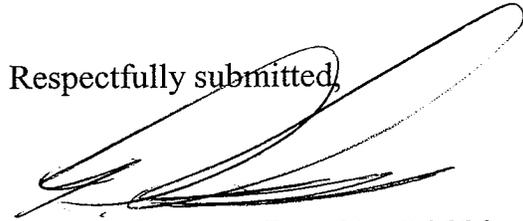
**REMARKS**

The sole remaining issue in present application is the Examiner's objection to the identification of goods and services in International Classes 16, 35, 38 and 41 as being indefinite, and hence, unacceptable. In response, Applicant hereby amends the identification of goods and services in International Classes 16, 35, 38 and 41 to be identical the identification of goods and services in co-pending application S.N. 79/039,873 for the mark, TVDIGITAL, which was accepted by the Office and published for opposition on January 6, 2009 (See, Exhibit A attached hereto) Since the amended identification of goods and services has been deemed acceptable by the Trademark Office in the co-pending application, Applicant believes that such identification of goods and services should be acceptable in the present application. As such, withdrawal of the Examiner's objection is respectfully requested.

Applicant believes that the present application is now in proper form for allowance and passage to publication is respectfully requested. Applicant believes that there are no fees associated with this Amendment. However, the Director is hereby authorized to charge payment of any other fees associated with this communication or credit any overpayment to Deposit Account No. 50-1170.

The Examiner is invited to contact the undersigned to expedite the allowance of the above-identified application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter C. Stomma', written over the text 'Respectfully submitted,'.

Peter C. Stomma, Reg. No. 36,020

Dated: 2/3/09  
Boyle Fredrickson, S.C.  
840 North Plankinton Avenue  
Milwaukee, Wisconsin 53203  
Phone: (414) 225-9755  
Attorney Docket No.: 1366.008

## EXHIBIT A

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2009-02-03 11:24:03 ET**

**Serial Number:** 79039873 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** (NOT AVAILABLE)

**Mark**



**(words only):** TV DIGITAL

**Standard Character claim:** No

**Current Status:** Application has been published for opposition.

**Date of Status:** 2009-01-06

**Filing Date:** 2007-04-04

**The Information will be/was published in the Official Gazette on 2009-01-06**

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 105

**Attorney Assigned:**  
BIBBINS ODESSA B

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2008-12-03

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Axel Springer AG

**Address:**

Axel Springer AG  
Axel-Springer-Strasse 65  
10888 Berlin  
Fed Rep Germany

**Legal Entity Type:** stock corporation ("Aktiengesellschaft")

**State or Country Where Organized:** Fed Rep Germany

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**GOODS AND/OR SERVICES**

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**International Class:** 016

**Class Status:** Active

Paper and cardboard cartons, boxes, and containers; printed matter and materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming; printed teaching and educational materials in the field of digital TV

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 035

**Class Status:** Active

Providing a database for collecting, compiling, processing, updating, selecting, evaluating and providing data reproduction services for third parties; data processing and data reproduction services

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 038

**Class Status:** Active

Telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news; transmission of sound and pictures via cable and satellite; providing information concerning telecommunications and communication services in the fields of telecommunications access and communication by electronic computer terminals and television services; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; providing multiple-user access to a global computer information network via the internet, other networks, namely, a global computer information network, and on-line internet and broadcasting services featuring, news and entertainment programs; providing access to electronic media transmission services and information via the internet, especially on-demand transmission services; electronic transmission of news and information, e-mail and mobile communications services featuring transmission of news, information and pictures via computer, teletext services; transmitting information of all kinds of internet addresses, namely, web-messaging; providing information about telecommunications featuring electronic media transmission services and information via the internet

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 041

**Class Status:** Active

Educational and entertainment services, namely, organizing community sporting and casual activities, and providing continuing radio and television programs featuring news and entertainment programs and providing information related thereto; publication and editing of printed matter in particular newspapers and magazines; electronic publishing services for others, namely, on-line publication of electronic media, electronic text, graphics, and pictures with all featuring news and entertainment programs and sound information, as well as, language data available via computer networks; production of motion picture film, image and sound recordings, namely, production of motion pictures and video films, and recording of audio and video tapes for others; online publishing of electronic books, electronic magazines and electronic newspapers, and image and sound recording works of others

**Basis:** 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Color(s) Claimed:** The color(s) black, red, blue, yellow, white is/are claimed as a feature of the mark.**Disclaimer:** "TVDIGITAL"**Description of Mark:** The color yellow appears in the letters "TV" in the term "TVDIGITAL"; the colors blue and white appear in a circle representing the earth superimposed in the center of the letters "TV"; the color white appears in the letters "DIGITAL" and in what appears as the shape of a white semi-circle under the letters "G I T" in the term "DIGITAL"; with all the foregoing inside a red rectangle, with all the foregoing on a black background in the mark.**Design Search Code(s):**

01.07.01 - Globes with outlines of continents

26.11.11 - Rectangles divided twice into three sections

26.11.21 - Rectangles that are completely or partially shaded

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**MADRID PROTOCOL INFORMATION**

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**International Registration Number:** 0857547**International Registration Date:** 2005-01-03**Priority Claimed:** No**Date of Section 67 Priority Claim:** (DATE NOT AVAILABLE)**International Registration Status:** Request For Extension Of Protection Processed**Date of International Registration Status:** 2007-07-19**International Registration Renewal Date:** 2015-01-03**Notification of Designation Date:** 2007-07-19**Date of Automatic Protection:** 2009-01-19**Date International Registration Cancelled:** (DATE NOT AVAILABLE)**First Refusal:** Yes

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2009-01-15 - Notification Of Possible Opposition - Processed By IB

2009-01-06 - Published for opposition

2008-12-25 - Notification Of Possible Opposition Sent To IB

2008-12-25 - Notification Of Possible Opposition Created, To Be Sent To IB

2008-12-17 - Notice of publication

2008-12-03 - Law Office Publication Review Completed

2008-12-02 - Approved for Pub - Principal Register (Initial exam)

2008-11-26 - TEAS Change Of Correspondence Received

2008-11-26 - Examiner's amendment mailed

2008-11-25 - Examiner's Amendment Entered

2008-11-25 - Examiners Amendment -Written

2008-11-25 - Previous allowance count withdrawn

2008-10-10 - Withdrawn From Pub - Og Review Query

2008-09-29 - Law Office Publication Review Completed

2008-09-28 - Approved for Pub - Principal Register (Initial exam)

2008-08-30 - Amendment From Applicant Entered

2008-08-30 - Communication received from applicant

2008-08-26 - Assigned To LIE

2008-08-18 - PAPER RECEIVED

2008-07-10 - New Representative At IB Received

2008-03-04 - Priority Action Mailed

2008-03-03 - Priority Action Written

2008-02-29 - Amendment From Applicant Entered

2008-02-29 - Communication received from applicant

2008-02-28 - Assigned To LIE

2008-01-24 - PAPER RECEIVED

2007-08-17 - Refusal Processed By IB

2007-07-23 - Non-Final Action Mailed - Refusal Sent To IB

2007-07-23 - Refusal Processed By MPU

2007-07-22 - Non-Final Action (Ib Refusal) Prepared For Review

2007-07-21 - Non-Final Action Written

2007-07-20 - Assigned To Examiner

2007-07-20 - New Application Entered In Tram

2007-07-19 - Sn Assigned For Sect 66a Subseq Desig From IB

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Peter C. Stomma

**Correspondent**

Peter C. Stomma

Boyle Fredrickson S.C.

840 North Plankinton Ave

Milwaukee WI 53203

Phone Number: 414-225-9755

Fax Number: 414-225-9753

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