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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79137054

MARK: MIXRADIO

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: Microsoft Mobile OY

CORRESPONDENT'S REFERENCE/DOCKET NO:

41827

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1177894

Microsoft Mobile OY ("applicant"), a Finnish corporation, has appealed the trademark examining attorney's final requirement that applicant disclaim the wording MIX RADIO under Trademark Act § 6(a),

15 U.S.C. § 1056(a), on the grounds that the wording is merely descriptive when used in connection with applicant's goods and services.

I. FACTS

On August 21, 2013, applicant[1] filed a request for extension of protection of a foreign registration under the Madrid Protocol, Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a). Applicant is seeking registration on the Principal Register of the composite mark MIXRADIO and design, for the goods and services of:

> "Computer software for providing access to pre-recorded music and video for download to smart phones, mobile phones, tablets and computers via the Internet; computer software for use in the delivery, distribution and transmission of digital music and entertainment-related audio, video, text and multimedia content; computer software for enabling transmission, storage, sharing, collection, editing, organizing and modifying audio, video, messages, images and other data; computer software for creating searchable databases of information and data for peer-to-peer social networking databases; computer programs for use in streaming or downloading music, film, tv-programs, audio books and games" in International Class 9;
>
> "Online retail store services featuring music for download" in International Class 35;
>
> "Electronic transmission and streaming of digital media content for others via global and local computer networks" in International Class 38; and
>
> "Entertainment services, namely, providing non-downloadable prerecorded music on-line via a music subscription service" in International Class 41.

[1] The request for extension of protection was originally filed by Nokia Corporation; however, on August 14, 2014, a NEW HOLDER/REPRESENTATIVE OF AN INTERNATIONAL REGISTRATION was filed which transferred ownership to the present applicant, Microsoft Mobile OY.

On December 11, 2013, the examining attorney issued an initial Office action requiring that applicant disclaim the wording MIX RADIO[2] and comply with other procedural requirements.

On June 11, 2014, applicant filed a response in which it argued against the disclaimer requirement and complied with the other procedural requirements. On June 30, 2014, a final Office action was issued making final the requirement that applicant disclaim the wording MIX RADIO.

On December 30, 2014, applicant concurrently requested reconsideration of the final disclaimer requirement and filed a notice of appeal. On January 20, 2015, finding applicant's arguments unpersuasive, the examining attorney denied applicant's request for reconsideration and maintained as final the requirement that applicant disclaim MIX RADIO.

The sole issue on appeal is whether the wording MIX RADIO is merely descriptive under 15 U.S.C. § 1052(e)(1), such that it should be subject to a disclaimer under Trademark Act § 6(a).

II. ARGUMENT

An applicant may be required to disclaim an unregistrable component of the mark, including wording that is merely descriptive of an applicant's goods and/or services. 15 U.S.C. §§ 1052(e)(1), 1056(a); *see* TMEP §§1209.03(f), 1213.03 *et seq*. Such words or designs need to be freely available for other businesses to market comparable goods or services and should not become the proprietary

[2] Although the wording MIXRADIO is intentionally misspelled in the mark as all one word, an applicant is required to show wording in its correct spelling in a disclaimer, consistent with how the evidence of descriptiveness shows the wording used, i.e., as MIX RADIO in the present case. *See* TMEP §§ 1213.05(a), 1213.08(c).

domain of any one party. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

Wording is merely descriptive if it describes a quality, characteristic, function, feature, purpose or use of an applicant's goods and/or services. TMEP § 1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

A. THE IDENTIFICATION OF GOODS AND SERVICES AND THE EVIDENCE OF RECORD ESTABLISH THE WORDING "MIX RADIO" IS MERELY DESCRIPTIVE OF APPLICANT'S GOODS AND SERVICES

Applicant has applied for a composite mark consisting of the compound word MIXRADIO and a design. In the case of a "composite" mark consisting of wording combined with a design, the unregistrable component of the composite mark is subject to a disclaimer. TMEP § 1213.02.

Upon the initial examination of the applied-for mark, the examining attorney determined the design was an inherently distinctive element of the mark, but that the compound word MIXRADIO was merely descriptive. Therefore, applicant was required to submit a disclaimer of the wording MIX RADIO. *See* TMEP § 1213.05(a) ("If a composite mark consists of a compound word combined with arbitrary matter, and the compound word is unregistrable, a disclaimer of the compound word may be required"). Further, as the evidence of descriptiveness showed the wording MIX RADIO used with a space between the words, applicant was required to disclaim the wording in that same form, with a space separating the two words. *Id*.

The examining attorney concluded that MIX RADIO is merely descriptive because "applicant's goods and services involve the provision of online streaming radio which include ready-made mixes of

songs and personalized mixes of songs." See initial Office action dated 12/11/2014 at unnumbered page 2.

As explained below, in finding MIX RADIO to be merely descriptive, the examining attorney relied on the following: (1) applicant's own identification of goods and services, (2) information obtained from applicant's own website, and (3) evidence from third-party websites and articles showing descriptive usage of the wording MIX RADIO.

1. "MIX RADIO" MERELY DESCRIBES FEATURES AND FUNCTIONS OF APPLICANT'S GOODS AND SERVICES

The determination of whether wording is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In its brief, applicant stresses that its identification of goods and services does not expressly include the wording "the provision of music mixes." Applicant's Brief at 6. However, the following goods and services, as identified in the application, are broad enough to include the provision of music mixes:

1. "Computer software for **providing access to pre-recorded music** and video for download to smart phones, mobile phones, tablets and computers via the Internet" in Class 9;

- The identified functions of the software are broad enough to include the provision of pre-recorded music mixes via the internet.

2. "Computer software for use in the **delivery, distribution and transmission of digital music** and entertainment-related audio, video, text and multimedia content" in Class 9;

   - The identified functions of the software are broad enough to include software for the delivery, distribution and transmission of digital music mixes.

3. "Computer programs for use in **streaming or downloading music**, film, tv-programs, audio books and games" in Class 9.[3]

   - The identified functions of the software are broad enough to include streaming or downloading of music mixes.

4. "Online retail store services featuring **music for download**" in Class 35;

   - The stated services are broad enough to include music mixes for download.

5. "Electronic **transmission and streaming of digital media content** for others via global and local computer networks" in Class 38; and

   - The stated services are broad enough to include the transmission and streaming of digital music mixes. Further, the "transmission and streaming" of media content are functions of an online radio service.

6. "Entertainment services, namely, **providing non-downloadable prerecorded music on-line via a music subscription service**" in Class 41.

   - The stated services are broad enough to include the provision of non-downloadable music mixes via a music radio subscription service.

[3] The Class 9 identification includes additional identifications which the examining attorney maintains MIX RADIO also merely describes; however, in the interest of brevity the examining attorney focuses on just three of the Class 9 identifications because a descriptiveness finding "is proper 'if the mark is descriptive of any of the [goods or] services for which registration is sought.'" *See In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc*., 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

In sum, applicant's goods and services state that applicant is providing, delivering, transmitting and streaming music, which includes music mixes. Further, the delivery, transmission and streaming of music are core features or functions of a radio service, which includes "the work of broadcasting sound programs for the public to listen to." See definition of RADIO at attachment 10 of Final Office Action dated 6/30/2014.

Applicant's own website, as discussed below, provides further confirmation that MIX RADIO merely describes each of the above-described goods and services.

2. APPLICANT'S OWN WEBSITE CONFIRMS "MIX RADIO" MERELY DESCRIBES APPLICANT'S GOODS AND SERVICES

Applicant alleges that "the Examining Attorney relies improperly on 'actual use' of the MIXRADIO Mark rather than the Goods and Serviced [sic] identified in the Application. . . ." Applicant's Brief at 7.

To the contrary, "[t]he examining attorney **should** check applicant's own website for information about the goods/services." TMEP § 710.01(b) (emphasis added). *See also In re Reed Elsevier Props*., 482 F.3d 1376, 1379 (Fed. Cir. 2007) (finding it appropriate to review an applicant's website to inform the understanding of the claimed services).

Moreover, because the instant application was filed under the Madrid Protocol, Trademark Act § 66(a), no use-based evidence, such as specimens, is required. In such cases, it may be particularly necessary to check an applicant's website for information. *Cf. In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (rejecting applicant's argument that it was improper for the examining attorney to rely on evidence obtained from applicant's website when the application was based on intent to use and no specimens were yet required).

Therefore, it is entirely proper to consider the following evidence of record from applicant's website to inform the understanding of applicant's goods and services used under the MIXRADIO mark:

- "**MixRadio is a streaming music service**" that includes "an ever-changing **mix** based on the music you love" and "hundreds of handcrafted **mixes**."

  - See attachment 2 of Request for Reconsideration Denied letter dated 1/20/2015.

- "**MixRadio** for laptop and tablet" "**Your own personal radio station**.'"

  - *Id*. at attachment 3.

- "**Stream Music for free with MixRadio**" "Imagine a **radio station** that seems to always know the music you want to hear. Enter **MixRadio**: a music app that **personalizes mixes**.'"

  - *Id*. at attachment 4.

- "Play Me is where you'll find a fresh new **mix of music**, customized to your own music taste."

  - *Id*. at attachment 5.

- "Looking for inspiration? Try a ready-made **mix**"
  "**MixRadio is filled with mixes** put together by our team of global music experts. . . ."

  - *Id*. at attachment 6.

- "Whether you're looking for a new soundtrack for your workout or for the perfect party playlist, our **mixes** have you covered."

  - *Id*. at attachments 6-7.

- "When you've discovered some **mixes** you love, let those closest to you know . . . Your friends will be able to listen to your favorite **mixes**."

  - *Id*. at attachment 7.

- "For just a small monthly fee, you get premium benefits like unlimited track-skipping, unlimited **offline mixes**, high quality audio over Wi-Fi and more."

  - *Id*. at attachment 8.

- "Listen to MixRadio – unlimited FREE **music mixes** to play now or download for later." "Get **personalized mixes** based on your music collection."

  - *Id*. at attachment 9.

The above-quoted information taken from applicant's website dissipates any doubt that MIX RADIO merely describes the goods and services. Applicant expressly states "**MixRadio is a streaming music service**," namely, "**Your own personal radio station**" featuring "**unlimited FREE music mixes to play now or download for later**." These descriptions confirm that MIX RADIO merely describes applicant's Class 9 software for use in "providing access to pre-recorded music" and "streaming or downloading music," as well as the Class 35 retail store services featuring "music for download," the Class 39 services of "transmission and streaming of digital media content," and the Class 41 services of "providing non-downloadable prerecorded music on-line." Material obtained from applicant's own website is acceptable as competent evidence. *See In re N.V. Organon*, 79 USPQ2d 1639, 1642-43 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d at 1302-03; *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1898 (TTAB 2001); TBMP § 1208.03; TMEP § 710.01(b).

As with many modern-day music providers, the evidence from applicant's website shows its music mixes are provided over the internet via a "streaming music service." See attachment 2 of Request for Reconsideration Denied letter dated 1/20/2015. However, the delivery of the media

content via the internet rather than through traditional radio broadcasting does not alter the descriptive nature of the term RADIO when used in connection with goods and services for providing, delivering, and streaming music.

3. THE RECORD CONTAINS EVIDENCE OF THIRD-PARTIES USING "MIX RADIO" IN A MERELY DESCRIPTIVE MANNER IN CONNECTION WITH THE SAME OR SIMILAR SERVICES

In addition to the evidence of record from applicant's own website, the record also contains numerous examples of third-parties using the wording MIX RADIO in connection with radio services featuring a mix of music. Applicant contends that this evidence shows MIX RADIO used as a trademark rather than in a merely descriptive manner. Applicant's Brief at 8. However, the determination of whether the wording is used in a merely descriptive manner must be made in relation to the goods and/or services, not in the abstract. *DuoProSS Meditech Corp.*, 695 F.3d at 1254, 103 USPQ2d at 1757; *In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219; TMEP § 1209.01(b).

In this case, the fact that each of the third-parties is using the wording MIX RADIO in connection with radio services is a strong indicator that the term RADIO is merely descriptive or generic. Further, each of the following sources is a United States based radio provider that specifically states that it provides a music "mix," which is a strong indicator that the term MIX within MIX RADIO is also merely descriptive:

A1 <u>MIX RADIO</u> (from Vermont, USA)

- "A-1 Mix Radio plays the best **<u>mix</u> of music** from the 70's, 80's, 90's, 2k and today!"

- See attachment 13 of Request for Reconsideration Denied letter dated 1/20/2015.

CLUB <u>MIX RADIO</u> (from northern California, USA)

- "We're playing the **best <u>mixes</u> of electronic dance music**, featuring all genres."

  - *Id.* at attachment 15.

KOOL <u>MIX RADIO</u> (from Chattanooga, TN, USA)

- "**<u>Radio</u> playing a <u>Mix</u>** of 60s 70s 80s all the Greatest, Classic and Super hits. . ."

  - *Id.* at attachments 16-17.

BROOKLYN <u>MIX RADIO</u> HD (from Brooklyn, NY, USA)

- "Brooklyn **<u>Mix Radio</u>** is a versatile **<u>radio</u> station** catering to the greater Caribbean community with in New York…" "Download **<u>mixtapes</u> and <u>remixes</u>**"

  - *Id.* at attachments 20-21.

WPKN DANCE <u>MIX RADIO</u> (from Bridgeport, CT, USA)

- "WPKN's programming **<u>mix</u>** is a cornucopia of genres and styles."

  - *Id.* at attachments 23-25.

The record also includes full articles from the LexisNexis® computerized database in which MIX RADIO appears in reference to radio that plays a mix of music. See the following excerpts:

- "Cary Judd delivers a poppy punch that has at least three tracks worth **mix radio** rotation…"

  - See attachment 39 of Request for Reconsideration Denied letter dated 1/20/2015.

- "Silver had a productive 2013 and looks as if he will carry that over into 2014. His country **mix radio** show is now being nationally syndicated and can now be heard outside of Nashville."

  - *Id*. at attachment 41.

- "Denny Randell and Biddy Schippers, who also performed on the recording, have together written and produced a number of national club and **mix radio** hits, most recently their own 'Alice In Wonderland,' also a video hit…"

  - *Id*. at attachment 42.

- "He was host of the Independent Film Channel's The Henry Rollins Show and the radio show 'Harmony in my Head' on Indie FM in Los Angeles. He currently hosts this own **music mix radio** show on KCRW-FM."

  - *Id*. at attachment 44.

Thus, the above examples show the wording MIX RADIO is merely descriptive when used in connection with radio services featuring a particular mix of music.

B. THE COMBINATION OF "MIX" AND "RADIO" CREATES A MERELY DESCRIPTIVE MEANING IN CONNECTION WITH APPLICANT'S GOODS AND SERVICES

Applicant contends that even if the individual terms MIX and RADIO are merely descriptive, the combination of MIXRADIO into one word creates a suggestive meaning. Applicant's Brief at 12. However, the evidence of record, as discussed above, shows that MIX RADIO, and likewise MIXRADIO,

creates a merely descriptive meaning when used in connection with applicant's goods and services, which include music mixes provided via an online music streaming service.

Specifically, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services when combined, then the combination results in a composite mark that is itself descriptive and not registrable. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (holding BATTLECAM merely descriptive of computer game software with a feature that involve battles and provides the player with the option to utilize various views of the battlefield); *In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL merely descriptive of publications featuring news and information about Atlanta where THEATL was the equivalent of the nickname THE ATL for the city of Atlanta); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of highly automated cooling towers); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1085 (TTAB 2001) (holding AGENTBEANS merely descriptive of computer software for use in developing and deploying application programs on a global computer network).

Here, the applicant has failed to articulate any new, non-descriptive meaning created by the combination of MIX and RADIO. Absent any new or incongruous meaning or unique commercial impression, the ordinary meaning of the words applies. The dictionary definitions of the terms MIX and RADIO define them as, respectively, "a combination of different things" and "the work of broadcasting sound programs for the public to listen to." See attachments 5 and 7 of Final Office Action dated 6/30/2014. The combined wording MIX RADIO therefore merely describes goods and services related to broadcasting sound programs that feature a combination of different songs, i.e., a "music mix."

In addition, the lack of a dictionary definition of the combined terms MIX RADIO or MIXRADIO is not controlling on the question of registrability, where, as here, the evidence of record shows that the wording MIX RADIO is merely descriptive. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004)

(finding the absence of the term GASBUYER in a dictionary is not probative of descriptiveness where evidence shows that the mark as a whole is descriptive); *see also In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977); TMEP § 1209.03(b).

C. THE THIRD-PARTY REGISTRATIONS PROVIDED BY APPLICANT ARE NOT DISPOSITIVE ON THE QUESTION OF WHETHER "MIX RADIO" MERELY DESCRIBES APPLICANT'S GOODS AND SERVICES

Applicant cites to various third-party registrations made of record that contain either the word RADIO or MIX, but not both terms, in which no disclaimer was required. Applicant's Brief at 10-11.

However, none of the third-party registrations listed by applicant contain the wording in question in the current case, MIX RADIO, or any formation containing both MIX and RADIO. Thus, none of the third-party marks are similar to the applied-for mark. Further, even if the marks were similar to the applied-for mark, third-party registrations are not conclusive on the question of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP § 1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP § 1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP § 1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

The examining attorney does note, however, that there is one similar registered mark of record, RADIOMIXES, in Reg. No. 4177225. See registration at attachments 3-4 of Final Office Action dated 6/30/2014. The RADIOMIXES mark is registered on the Supplemental Register because it was determined to be merely descriptive. Third-party registrations featuring the same or similar marks for the same or similar goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

Applicant counters that no disclaimer of the term RADIO or MIXES was required with regard to the unitary mark RADIOMIXES in Reg. No. 4177225, which is registered on the Supplemental Register. Applicant's Brief at 12. However, only generic matter is disclaimed in marks registered on the Supplemental Register. TMEP § 1213.03(b). If all components of a mark are merely descriptive, the entire mark is refused under Section 2(e)(1) and a disclaimer is not required unless there is generic "stand-alone" matter in the mark, which is not the case in the compound mark RADIOMIXES. *See* TMEP § 1209.03(d).

III. CONCLUSION

For the foregoing reasons, the final refusal of registration under 15 U.S.C. §§ 1052(e)(1), 1056(a), which requires a disclaimer of the wording MIX RADIO, should be affirmed because the wording merely describes features or functions of applicant's goods and services related to online streaming of music mixes.

Respectfully submitted,

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