

ESTTA Tracking number: **ESTTA663480**

Filing date: **03/27/2015**

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

Proceeding	79137054
Applicant	Microsoft Mobile OY
Applied for Mark	MIXRADIO
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Submission	Appeal Brief
Attachments	79137054 - MIXRADIO and Design Appeal Brief - 2015-03-27.pdf(75788 bytes )
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re MICROSOFT MOBILE OY

Serial No.: 79/137,054

Mark:  **MixRadio**

Filing Date: August 21, 2013

Examining Attorney: Kristin Carlson, L.O. 105

**APPEAL BRIEF OF APPELLANT  
MICROSOFT MOBILE OY**

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Appellant Microsoft Mobile OY (“Appellant”), submits this brief in support of its appeal of the Examining Attorney’s refusal to register its trademark MIXRADIO and Design (“MIXRADIO Mark”) on the Principal Register of the United States Patent and Trademark Office (“USPTO”) without a disclaimer of the wording “MIX RADIO.” For the reasons discussed below, the requirement of a disclaimer is improper because (a) the Examining Attorney failed to present a prima facie case that the wording “MIX RADIO” is descriptive of the goods and services specified in the application; (b) the Examining Attorney mischaracterized use of the wording “MIX RADIO” by third parties in a trademark manner to establish without basis that the wording is descriptive; (c) the combination of the terms “MIX” and “RADIO” into the compound term “MIXRADIO” results in a suggestive, if not arbitrary, term; and (d) the MIXRADIO Mark is unitary insofar as its text and design elements create a commercial impression separate and apart from any unregistrable component. For these reasons, Appellant respectfully requests that the Examining Attorney’s Final Refusal of the application be reversed and that the application be approved for publication without a disclaimer of the wording “MIX RADIO.”

#### **PROSECUTION HISTORY AND RECORD ON APPEAL**

Appellant’s mark is the subject of Application Serial No. 79/137,054 (the “Application”) filed by predecessor-in-interest Nokia Corporation (“Nokia”) on August 21, 2013, under Sec. 66(a) based on International Registration No. 1177894. The Application covers “*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 (collectively, the “Goods and Services”). On August 14, 2014, the USPTO recorded the change of ownership of the Application from Nokia to Appellant.

In the initial Office Action (“First Office Action”), mailed on December 10, 2013 the Examining Attorney initially requested that Nokia disclaim the wording “MIX RADIO”, alleging that the wording “merely describes a feature, function, quality, characteristic, purpose, or use of applicant’s goods and/or services.” The Examining Attorney presented evidence alleged to show that Appellant’s “goods and services involve the provision of online streaming radio which include ready-made mixes of songs and personalized mixes of songs.” Thus, the Examining Attorney concluded, “the wording ‘MIX RADIO’ merely describes a feature, characteristic, function or purpose of applicant’s goods and services. Nokia submitted a response to the Office Action on June 11, 2014, declining to disclaim the wording “MIX RADIO” on the basis that (a) the USPTO routinely allowed marks including the terms “RADIO” or “MIX” for music related goods and services on the Principal Register without a disclaimer of these terms or proof of acquired distinctiveness; and (b) the combining of the terms “MIX” and “RADIO” into a single word creates an arbitrary, or at least suggestive, term (the “First Response”). In connection with the First Response, Nokia submitted TESS records of registrations on the Principal Register including the terms “RADIO” or “MIX” for which no disclaimer was required; a Wikipedia webpage entry for “Audio Mixing”; and online dictionary definitions for “Mix.”

On June 30, 2014, the Examining Attorney issued the second, final Office Action (“Final Action”), maintaining the requirement to disclaim the wording “MIX RADIO” and rejecting Nokia’s arguments. Specifically, the Examining Attorney argued that none of the third party registrations cited by Nokia contain both terms “MIX” and “RADIO”, and that--in any event--each

application must be considered on its own merits. Moreover, the Examining Attorney pointed to the marks RADIOMIXER (reg. no. 1621760) and RADIOMIXERS (reg. no. 4177225), both registered on the Supplemental Register, as “probative evidence on the issue of descriptiveness.” The Examining Attorney further argued that the combination of “MIX” and “RADIO” in a single word did not render the term non-descriptive, and in support thereof, attached evidence of third party websites alleged to use the combined term “MIX RADIO” descriptively “to refer to the broadcasting of a combination of music.”

On December 30, 2014, Appellant submitted a Request for Reconsideration after Final Action (“Request for Reconsideration”), restating the arguments in the First Response and further arguing that (a) the Examining Attorney improperly based the initial disclaimer requirement on use of the MIXRADIO Mark by Nokia rather than the Goods and Services of the applied-for mark; (b) the RADIOMIXER and RADIOMIXERS marks cited by the Examining Attorney are irrelevant to the alleged descriptiveness of the wording “MIX RADIO” in the context of the Application; (c) the Examining Attorney mischaracterized the evidence of third party use of the wording “MIX RADIO”, which did not reflect descriptive use of the wording apart from trademarks used by those parties (and often related to non-probative use outside of the United States); and (d) the MIXRADIO Mark is closely associated with Nokia and (now) the Appellant through substantial promotion and public recognition. In connection with the Request for Reconsideration, Appellant submitted evidence of the use of the MIXRADIO Mark by Nokia and/or the Appellant as well as public recognition of the MIXRADIO Mark in association with these parties.

On January 20, 2015, the Examiner issued a denial of Appellant’s Request for Reconsideration (“Reconsideration Letter”), stating that the evidence of record (including additional examples included therewith) “establishes that no unique, incongruous, or nondescriptive meaning is created in relation to the identified goods and services through the combination of the merely descriptive terms MIX and RADIO.”

## ARGUMENT

The Examining Attorney has the discretion to require an applicant to disclaim an unregistrable component of a mark otherwise registrable, as in the case of a descriptive word in an otherwise registrable composite mark. See Trademark Act Section 6, 15 U.S.C. §1056. When assessing the descriptiveness of a mark or portion of a composite mark, descriptiveness is assessed based on the mark or portion in view of the goods and services covered by the application. TMEP §1209.01(b). It is well settled that where reasonable people may differ, doubt as to the descriptiveness of the mark should be resolved in the applicant's favor. In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981) and In re Gourmet Bakers, 173 USPQ 565 (TTAB 1972). Furthermore, if a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required. TMEP §1213.05(a), citing In re EBS Data Processing, Inc., 212 USPQ 964, 966 (TTAB 1981) (finding that “[a] disclaimer of a descriptive portion of a composite mark is unnecessary . . . if the elements are so merged together that they cannot be regarded as separable elements . . . for example, . . . by combining two words or terms, one of which would be unregistrable by itself . . .”). Likewise, a mark that is “unitary”, meaning the elements of the mark are so integrated that they cannot be regarded as separable, “no disclaimer of an element, whether descriptive, generic, or otherwise, is required.” TMEP §1213.05.

Here, the Examining Attorney erred in requiring a disclaimer of the wording “MIX RADIO” and in refusing the register the MIXRADIO Mark on that basis. Specifically, it is Appellant’s position in this appeal that (a) the Examining Attorney failed to present a prima facie case that the wording “MIX RADIO” is descriptive, particularly on the basis of the goods and services specified in the application; (b) the evidence relied upon by the Examining Attorney does not use the wording “MIX RADIO” in a descriptive manner; (c) the combination of the terms “MIX” and “RADIO” into the compound term “MIXRADIO” results in a suggestive, if not arbitrary, term

without obvious meaning or descriptive connotation; and (d) the MIXRADIO Mark is unitary insofar as its elements are inseparable. Accordingly, Appellant respectfully requests that the Examining Attorney's Final Refusal of the application to register the MIXRADIO mark on the Principal Register without the disclaimer of the wording "MIX RADIO" be reversed and that the application be approved for publication.

**1. THE EXAMINING ATTORNEY FAILED TO PRESENT A PRIMA FACIE CASE THAT THE TERM "MIXRADIO" IS DESCRIPTIVE**

The Examining Attorney has the burden to establish a prima facie case that a designation sought for registration is descriptive, thereby warranting a disclaimer. A mark or portion thereof is considered "merely descriptive" if it "describes an ingredient, quality, characteristic, function, feature, purpose, or use *of the specified goods or services.*" TMEP § 1209.01(b) (emphasis added). The determination must be made "from the vantage point of purchasers of applicant's goods" and/or services, and where any doubt exists as to whether a term is descriptive, "such doubt should be resolved in favor of the applicant." In re Box Solutions Corp., 79 USPQ2d 1953, 1955 (TTAB 2006). The descriptiveness of the designation sought for registration is determined on the basis of the goods or services listed in the application, not the goods or services actually used or intended to be used. In re Vehicle Information Network Inc., 32 USPQ2d 1542 (TTAB 1994) (descriptiveness of an ITU application is determined solely on the basis of the goods listed, not on the possibility of the mark being used in a different manner). Appellant submits that the Examining Attorney has failed to establish a prima facie case that the wording "MIX RADIO" is descriptive of the Goods and Services, relying improperly on evidence of actual use by the Appellant--which, in fact, does not reflect descriptive use of the wording "MIX RADIO"--rather than the Goods and Services listed in the Application.

In the First Office Action, the Examining Attorney explained the disclaimer requirement for the wording "MIX RADIO" by referencing examples of Nokia websites featuring the mark NOKIA MIXRADIO (or NOKIA MUSIC MIX RADIO) and a news article incorrectly referencing

Nokia's music service as "Mix Radio." The Examining Attorney concluded that, because Nokia offers music streaming services with combinations of songs, the wording "MIX RADIO" therefore "merely describes a feature, characteristic, function or purpose of applicant's goods and services, namely, *the provision of radio mixes* through software to access music, music downloads, music transmission and music streaming" (emphasis added). The reliance on such examples of actual use by Nokia is improper in at least two respects. First, the examples presented by the Examining Attorney reflect proper trademark use of MIXRADIO as a trademark, rather than descriptive use as implied by the Examining Attorney. Moreover, the Examining Attorney failed to explain how the allegedly descriptive term "MIX RADIO" described any of the Goods or Services specified in the Application. The Examining Attorney referenced "the provision of radio mixes" (without defining the meaning of "radio mixes"); yet, the Goods and Services of the Application do not include "the provision of radio mixes" as a service.

The Examining Attorney failed to address this discrepancy when raised by the Appellant in the Request for Reconsideration, stating only in the Reconsideration Letter that

The combined wording MIX RADIO merely describes applicant's software and retail services for downloading and accessing music, music transmission and streaming services, and music subscription services related to the provision of music mixes.

Here again, the Goods and Services do not include "the provision of music mixes." As the Board has observed, "[A]ctual use of the proposed mark [is] not relevant to our inquiry. We must make our determination based on the applied-for mark ... and the goods *as identified*." In re Rebecca Brough, 2008 WL 885914, \*2 (TTAB Jan. 30, 2008) (emphasis added). A music "mix" will be understood commonly as the combination and sequencing of different music--not, for example, services allowing consumers to download, stream, or access music (let alone the other Goods or Services covered by the Application such as "computer software for creating searchable databases of information and data for peer-to-peer social networking databases").

In fact, to the contrary of the Examining Attorney's observations, use of the MIXRADIO Mark by Nokia and the Appellant, respectively, has principally created strong consumer recognition of the mark as a source indicator. As Appellant demonstrated through documentary evidence in the Request for Reconsideration, the use of the MIXRADIO Mark in connection with Applicant's goods and services has been well-publicized and has generated a significant amount of public recognition both by reporting media and consumer blogs. At the time of the change of ownership from Nokia to Appellant, Nokia was recognized as holding the second largest share in the global mobile-phone market (<http://www.cnet.com/news/nokia-hangs-on-to-second-place-in-mobile-phone-market/>). The move to Microsoft brought the goods and services offered under the MIXRADIO Mark to even greater prominence, including a well-publicized partnership with Adidas (<http://www.engadget.com/2014/11/27/adidas-micoach-smart-run-mixradio/>). Most recently, the publicity surrounding the publicly announced plan to sell "[Microsoft's] MixRadio Service" further underscores the close association the Mark has with Applicant in the eyes' of its consumers (*see, e.g.* <http://www.theverge.com/2014/12/18/7415685/line-acquires-microsoft-nokia-mixradio>).

Insofar as (a) the Examining Attorney has failed to establish a prima facie case that the wording "MIX RADIO" is descriptive in the context of the Goods and Services of the Application, and (b) in attempting to do so, the Examining Attorney relies improperly on "actual use" of the MIXRADIO Mark rather than the Goods and Services identified in the Application, the disclaimer requirement should be rescinded.

**2. THE EXAMINING ATTORNEY RELIES UPON EVIDENCE THAT DOES NOT USE THE WORDING "MIX RADIO" IN A DESCRIPTIVE MANNER**

The Examining Attorney also failed to establish that the wording "MIX RADIO" is descriptive as a general matter. In the Final Rejection, the Examining Attorney conceded that "MIX RADIO" is not found in any dictionaries, pointing instead to the dictionary definitions of "RADIO" and "MIX"--the latter being defined simply as "a combination of different things." In lieu

of a dictionary entry for “MIX RADIO”, the Examining Attorney instead relied heavily on examples of third parties using the term “MIX RADIO” in an allegedly descriptive manner. However, as Appellant noted in the Request for Reconsideration, the examples of third party use presented by the Examining Attorney in fact showed the wording either in the context of a third party’s own trademark use or by parties outside of the United States, therefore of limited probative value as to the descriptiveness of the wording to U.S. consumers.

The Examining Attorney countered Appellant’s observation by attaching additional examples of third parties purported to use the wording “MIX RADIO” in a descriptive manner. Yet, here again, further examination of the evidence shows that these third parties are also using the term in a trademark rather than a descriptive manner:

- The website <http://www.clubmixradio.net/> shows use of the term CLUB MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://tunein.com/radio/Kool-Mix-Radio-s67026/> shows use of the term KOOL MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://www.brooklynmix.com/> shows use of the term BROOKLYN MIX RADIO HD as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://www.wpkn.org/shows/wilfredo-soto-2/> shows use of the term DANCE MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://www.live365.com/index.live#stations/konpamaniax> shows use of the term KONPA MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.

- The website <http://www.excelmixradio.ca/> shows use of the term EXCELMIXRADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://lovemixradio.radio.net/> shows use of the term LOVE MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.
- The website <http://absolutemixradio.com/player/> shows use of the term ABSOLUTE MIX RADIO as a trademark without descriptive use of the wording “MIX RADIO” apart from the mark.

Thus, the examples of third party use cited by the Examining Attorney do not, in fact, support the alleged descriptiveness of the wording “MIX RADIO.”

To the extent that these examples show third parties providing “music mixes” (as described by the Examining Attorney) via online streaming radio programs, it is also left unclear how these examples of third party use relate to the Goods and Services as specified in the Application. “Third-party use for unrelated [good or services] is not relevant when evaluating descriptiveness.” Xtreme Lashes, LLC v. Xtended Beauty, Inc., 91 USPQ2d 1385, 1392 (5th Cir. 2009). Even assuming, *arguendo*, that these third party examples relate to the Goods and Services, the fact that third parties find the same wording attractive for their goods does not render a mark descriptive. “The fact that a trademark is desirable does not, and should not, render it unprotectable. The need to use a term because it is generic or highly descriptive should be distinguished from the desire to use it because it is attractive.” *Id.* (quotation and internal citation omitted). As the Fifth Circuit has observed, “[T]he ubiquity of constituent terms does not relegate a compound mark to the realm of the descriptive.” *Id.* (“‘Just,’ ‘do,’ and ‘it’ are very common, but Nike can still trademark ‘Just Do It.’”).

The evidence produced by the Examining Attorney only goes to show that the wording “MIX RADIO” is a common component of third parties offering online streaming radio programs featuring mixes of music. The record does not support the conclusion otherwise that the wording

“MIX RADIO” is descriptive, in particular with regard to the Goods and Services as specified in the Application.

**3. THE COMBINATION OF THE WORDS “MIX” AND “RADIO” INTO THE COMPOUND TERM “MIXRADIO” RESULTS IN A SUGGESTIVE IF NOT ARBITRARY TERM**

Appellant submits that the Examining Attorney erred in finding the compound term “MIXRADIO” descriptive rather than suggestive. Where the combination of words renders the compound word registrable, a disclaimer is inappropriate against a component of the compound word even if unregistrable by itself. TMEP §1213.05(a). In In re Box Solutions Corp., the Board recognized that the proper outcome with regard to a compound word that combines an unregistrable component and a registrable component into a single word is registration without disclaimer. 79 USPQ2d 1953, 1955 (TTAB 2006), *citing* TMEP § 1213.05(a) (4th ed. April 2005). The mark cited by the Board was ENERGYSOLUTIONS, Reg. No. 2881792, which was registered on the Principal Register without a disclaimer despite the fact that the mark covers computer software relating to the energy industry. The Board acknowledged the registration of this mark with approval, despite the fact that “the term ‘SOLUTIONS’ has been regarded as merely descriptive in a number of [other] third-party marks.” 79 USPQ2d at 1955. The same outcome is appropriate here.

The USPTO reached a similar outcome in a number of third party registrations cited by Nokia in the First Response, where marks comprising compound words including either “MIX” or “RADIO” were registered on the Principal Register without a disclaimer of either term. These marks even include goods and/or services directly related to the provision of music. Examples include:

- EARTH RADIO (reg. no. 4,351,219) covering, *inter alia*, "on-going series featuring music ... and radio broadcasts" in Class 41;
- BABY RADIO and Design (reg. no. 4,356,266) covering, *inter alia*, "internet radio broadcasting services, radio broadcasting" in Class 38;

- 2DAYRADIO (reg. no. 4,527,669) covering "Broadcasting services, namely, radio broadcasting and broadcasting of radio programs over the internet and via satellite" in Class 38;
- ARADIO and Design (reg. no. 3,746,916) covering, *inter alia*, "Electric and electronic apparatus and appliances, namely, audio and video recording, reproduction and transmission equipment, namely, radios ... " in Class 9;
- CBNRADIO (reg. no. 3,672,868) covering "radio broadcasting" in Class 38;
- CHARITYMIX (reg. no. 3,678,793) covering, *inter alia*, "Online retail store services featuring downloadable pre-recorded music and video" in Class 35;
- CLICKMIX (reg. no. 3,724,508) covering "Providing a website featuring online non-downloadable software that enables a user to custom mix music from downloadable pre-recorded audio files, enabling user to choose the songs, the order, the tempo, and have them automatically beat mixed together without gaps between tracks" in Class 42;
- EL MIX (reg. no. 3,952,161) covering, *inter alia*, "Entertainment services in the nature of distribution and programming of. .. music . . ." in Class 41;
- BANDMIX (reg. no. 3,233,326) covering, *inter alia*, " ... electronic transmission of ... music ... via the internet" in Class 38;
- ANYMIX (reg. no. 4,304,045) covering, *inter alia*, " ... audio apparatuses . . . apparatus for recording, transmission or reproduction of sound . . . digital audio players ... " in Class 9, " ... entertainment in the nature of. .. audio presentations, namely, live music concerts ... production of radio and television programs" in Class 41 and " ... scientific research, analysis, testing in the field of audio processing, audio recording and audio distribution ... " in Class 42.

In an effort to rebut these examples, the Examining Attorney cited to the registrations of the marks RADIOMIXER (reg. no. 1621760) and RADIOMIXERS (reg. no. 4177225) on the Supplemental Register (but without a disclaimer of “MIX” or “RADIO”) to support the conclusion that the wording “MIXRADIO” is descriptive of the Applicant’s Offerings. However, such examples are of limited probative value in establishing the descriptiveness of the term “MIXRADIO.” First, neither mark is identical with the term at issue. Second, the USPTO did not require a disclaimer of the terms “MIX” or “RADIO”; though, disclaimers are often required even on the Supplemental Register for unregistrable elements. TMEP § 1213.03(b). Moreover, the goods covered under Registration No. 1621760 (“audio mixing console”) are distinguishable from the type of goods and services covered by the Application and therefore has even less probative value in this instance.

Even assuming, *arguendo*, that the composite terms “MIX” and “RADIO” are descriptive in the context of the Application, the compound phrase “MIXRADIO” is at least suggestive. The simplest test of descriptiveness is to search for the term in the dictionary. Here, neither Appellant nor the Examining Attorney has identified a dictionary definition for the compound term “MIXRADIO” or the terms “MIX RADIO” together. The Examining Attorney has cited to TMEP § 1209.03(b) to support the position that the absence of a word from the dictionary “is not controlling on the question of registrability” (Final Rejection”); however, the cited passage in TMEP § 1209.03(b) states in full: “The fact that a term is not found in a dictionary is not controlling on the question of registrability *if the examining attorney can show that the term has a well understood and recognized meaning.*” (Emphasis added.) As discussed in Part 2, supra, the Examining Attorney has not shown that the term “MIXRADIO” has a well recognized meaning. As such, the lack of a dictionary definition is, if not controlling on the question, certainly probative as to the non-descriptive nature of the term.

Another test employed by the courts to determine whether a term is suggestive or merely descriptive is the “imagination test.” Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 217 USPQ 988, 995-996 (5th Cir. 1983) (abrogated on other grounds). Under “imagination test”, courts assess the descriptiveness of a term by “measure[ing] the relationship between the actual words of the mark and the product to which they are applied.” Id. That is, the more imagination that is required on the part of a consumer to recognize a description of the product from the term, the more likely the term is suggestive rather than descriptive. As stated in Stix Products, Inc. v. United Merchants and Manufacturers, Inc., 160 USPQ 777, 785 (S.D.N.Y. 1968):

A term is suggestive if it requires little imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it *forthwith* conveys an immediate idea of the ingredients, qualifiers or characteristics of the goods. The test is whether the subject is so close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such goods, or is ... remote and subtle that it is fanciful and not needed by other merchants of similar goods (emphasis added) (internal citation omitted).

Thus, if one must use complex thought or follow a multi-stage reasoning process to determine attributes of the product, the term is suggestive, not descriptive. Worthington Foods, Inc. v. Kellogg Co., 14 USPQ2d 1577, 1589 (S.D. Ohio 1990). "If the mental leap between the word and the products' attributes is not almost instantaneous, this strongly indicates, suggestiveness, not direct descriptiveness." J. Thomas McCarthy, Trademarks and Unfair Competition, Section 11:21 (1998).

In Worthington, the court considered the strength of the mark HEARTWISE for vegetable protein products, specifically considering “how much imagination a buyer must use to cull a direct message from the mark about the quality, ingredients or characteristics of the product or service.” 14 U.S.P.Q.2d at 1589. While the court recognized that the mark had “a descriptive element to it”, the court ultimately found the mark to be suggestive on the basis that “a multi-stage reasoning process is necessary before the consumer can cull the message conveyed by

the mark.” *Id.* The court also noted that assuming HEARTWISE meant "wise for one's heart," it might refer to a large number of goods or services such as “running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column.” *Id.* Similarly, in *In re Kopy Kat, Inc.*, 182 USPQ 372, 373 (CCPA 1974), the court rejected the argument that the slogan "WE PRINT IT IN A MIN-IT" was merely descriptive, explaining that it was “obviously, highly suggestive of speed with respect to some kind of printing service, but one cannot tell what kind. It could be printing photographs, or printing with type, or making photostatic, xerographic, lithographic, photo offset of other copies.”

As with the foregoing cases, the compound word "MIXRADIO" does not specifically, directly, or immediately describe a feature, characteristic or function of the Goods or Services specified in the Application. That is, the same “multi-stage” process described above is necessary before the consumer can “cull a direct message” from the MIXRADIO Mark regarding “electronic transmission and streaming of digital media content”, for example, or “computer software for creating searchable databases of information and data for peer-to-peer social networking databases.” The significant use of a consumer's imagination required to determine the nature of the Goods and Services from the term "MIXRADIO" further supports the suggestive nature of the MIXRADIO Mark.

#### **4. THE MIXRADIO MARK IS A UNITARY MARK INsofar AS ITS ELEMENTS ARE INSEPARABLE**

A mark or portion of a mark is considered “unitary” when it creates a commercial impression separate and apart from any unregistrable component. The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. TMEP § 1213.05. Here, the commercial impression created by the combination of text and design elements is unitary insofar as the upside-down headphone design doubles as a smiley face that plays directly off the association of the term “RADIO” with music services:



Thus, the disclaimer of individual nondistinctive elements is unnecessary. TMEP § 1213.05(f).

**CONCLUSION**

For the foregoing reasons, Appellant respectfully requests that the Examining Attorney's Final Refusal of the application be reversed and that the application be approved for publication without a disclaimer of the wording "MIX RADIO."

Date: March 27, 2015

Respectfully submitted,

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