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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79144500

MARK: RADIODNS HYBRID RADIO DNS



CORRESPONDENT ADDRESS:

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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: Nicholas Piggott

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1196774

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ON APPEAL

Applicant: Nicholas Piggott

Trademarks: RADIODNS HYBRID RADIO
RADIO DNS HYBRID RADIO and design

Serial Nos.: 79140372
79144500

Attorneys: BRIAN M DAVIS
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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant has appealed the examining attorney's final refusal to register the proposed marks, RADIODNS HYBRID RADIO and RADIO DNS HYBRID RADIO and design, for various goods in Class 9 that feature or relate to radio or radio broadcasting, Class 16 goods such as printed matter about radio or radio broadcasting, Class 38 telecommunications services relating to radio broadcasting and various entertainment services in Class 41 that relate to radio broadcasting, including radio programs and entertainment provided through such radio programs.¹

¹ The identification of goods and services in International Classes 16 and 38 for Application Serial Nos. 79140372 and 79144500 are identical and reads as follows:

- Printed matter, namely, books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; books in the field of radio and radio broadcasting; brochures in the field of radio and radio broadcasting; manuals in the field of radio and radio broadcasting; magazines in the field of radio and radio broadcasting; newspapers in the field of radio and

radio broadcasting; periodical publications in the field of radio and radio broadcasting; posters, photographs and prints; guidebooks in the field of radio and radio broadcasting; handbooks in the field of radio and radio broadcasting; calendars; folders; notebooks; diaries; address books; stationery; printed instructional and teaching materials in the field of radio and radio broadcasting; greeting cards; postcards; pens; pencils; erasers; pen and pencil cases; decalcomanias and stickers, in International Class 16

- Telecommunication, namely, radio broadcasting and Internet broadcasting; broadcasting services, namely, radio broadcasting and Internet broadcasting; radio broadcasting; transmission of radio programmes by radio transmitter, satellite and the Internet and providing information about telecommunication relating thereto; streaming of radio material on the Internet; broadcasting of radio programmes; radio broadcasting; radio broadcasting of information and other programs; radio transmission services, namely, transfer of data and information by radio; radio transmission services, namely, communication of data by means of radio; Internet radio broadcasting services; information, advisory and consultancy services in relation to the aforesaid services, in International Class 38

The identification of goods and services in International Classes 9 and 41 for Application Serial No. 79140372 reads as follows:

- Apparatus for recording, transmitting or reproduction of sound, music, images, data and videos; computer software for use in combining broadcast radio with the Internet; embedded software for use in combining broadcast radio with the Internet for radios, and radio apparatus and instruments; application software for mobile devices, tablet computers and smartphones for use in combining broadcast radio with the Internet; radios; radio tuners; car radios; radios for vehicles; portable radios; radios incorporating clocks; wireless broadband radios; digital radios; mobile devices incorporating radios, namely, cell phones, MP3 players, MP4 players, tablet computers, digital audio players and digital video players; mobile telephones incorporating radios; computers incorporating radios; tablet computers incorporating radios; digital audio players; digital audio players incorporating radios; MP3 players incorporating radios; MP4 players; MP4 players incorporating radios; television and radio decoders; sound reproducing and sound recording apparatus and instruments; downloadable electronic media, namely, audio, data and video files provided from the Internet featuring computer software for use in combining broadcast radio with the Internet, and information relating thereto; publications downloaded in electronic form from the Internet in the nature of books, newsletters, magazines, periodicals and newspapers in the field of radio and radio broadcasting; printed matter in electronic form recorded on computer media in the nature of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; downloadable on-line publications, namely, magazines, periodicals and newspapers in the field of radio and radio broadcasting; downloadable electronic multimedia file containing text, audio and visual images in the field of radio and radio broadcasting; printed matter in electronic form recorded on computer media in the nature of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; downloadable photographs and still photographs in electronic form recorded on computer media in the field of radio and radio broadcasting, in International Class 9
- Entertainment, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; radio entertainment services, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; entertainment by means of radio, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; entertainment services provided by radio, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or

celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; production and preparation in the nature of post-production, production, distribution and syndication of television and radio programmes and of films, production and post-production of sound and video recordings; production of radio broadcasts; publication of books; publishing services, namely, publishing of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; arranging and conducting of colloquiums, conferences, congresses, seminars and symposiums in the field of radio and radio broadcasting, and conducting training in the nature of workshops in the field of radio and radio broadcasting; arranging and conducting of lectures, live educational demonstrations, displays, exhibitions, presentations and seminars for teaching and training purposes in the field of radio and radio broadcasting; entertainment services, namely, live music concerts and live theatrical performances; organizing of events, namely, music festivals and music concerts for entertainment purposes; conducting instructional, teaching and coaching classes, courses, seminars, presentations, and workshops in the field of radio and radio broadcasting; entertainment in the nature of factual knowledge and talent competitions in the field of radio where entry is by personal attendance, mail, email, telephone, text message or via the Internet; online library services, namely, providing electronic library services for the supply of electronic information, including archive information, in the form of electronic texts and audio and video information and data; providing on-line publications, non-downloadable, namely, books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; entertainment services, namely, providing digital sound and video recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital sound and video recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP3 and MP4 Internet websites; entertainment services, namely, providing digital sound recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital sound recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP3 Internet websites; entertainment services, namely, providing digital music and sound recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital music and sound recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows,

drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP3 Internet websites; entertainment services, namely, providing digital videos featuring images, motion picture film and radio and TV programmes in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital videos featuring images, motion picture film and radio and TV programmes in the field of music, musical recordings, musical performances, musical groups, motion picture films about music, radio, radio broadcasting and radio technology, or featuring drama, comedy, action, adventure, animation and documentaries, celebrity interviews, artistic theatrical performances, music concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP4 Internet websites; provision of information relating to music, musical recordings and musical entertainment; information, advisory and consultancy services in relation to the aforesaid services, in International Class 41

The identification of goods and services for International Classes 9 and 41 for Application Serial No. 79144500 reads as follows:

- Apparatus for recording, transmitting or reproduction of sound, music, images, data and videos; computer software for use in combining broadcast radio with the Internet; embedded software for use in combining broadcast radio with the Internet for radios, and radio apparatus and instruments; application software for mobile devices, tablet computers and smartphones for use in combining broadcast radio with the Internet; radios; radio tuners; car radios; radios for vehicles; portable radios; radios incorporating clocks; wireless broadband radios; digital radios; mobile devices incorporating radios, namely, cell phones, MP3 players, MP4 players, tablet computers, digital audio players and digital video players; mobile telephones incorporating radios; computers incorporating radios; tablet computers incorporating radios; digital audio players; digital audio players incorporating radios; MP3 players incorporating radios; MP4 players; MP4 players incorporating radios; television and radio decoders; sound reproducing and sound recording apparatus and instruments; downloadable electronic media, namely, audio, data and video files provided from the Internet featuring computer software for use in combining broadcast radio with the Internet, and information relating thereto; publications downloaded in electronic form from the Internet in the nature of books, newsletters, magazines, periodicals and newspapers in the field of radio and radio broadcasting; printed matter in electronic form recorded on computer media in the nature of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; downloadable on-line publications, namely, magazines, periodicals and newspapers in the field of radio and radio broadcasting. downloadable electronic multimedia file containing text, audio and visual images in the field of radio and radio broadcasting; printed matter in electronic form recorded on computer media in the nature of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; downloadable photographs and still photographs in electronic form recorded on computer media in the field of radio and radio broadcasting, in International Class 9
- Entertainment, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; radio entertainment services, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; entertainment by means of radio, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers,

gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; entertainment services provided by radio, namely, provision of ongoing radio programs in the field of music, musical recordings, musical performances, musical groups and members thereof, celebrity interviews, spoken word, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, gameshows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement; production and preparation in the nature of post-production, production, distribution and syndication of television and radio programmes and of films, production and post-production of sound and video recordings. production of radio broadcasts; publication of books; publishing services, namely, publishing of books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; arranging and conducting of colloquiums, conferences, congresses, seminars and symposiums, and conducting training in the nature of workshops in the field of radio and radio broadcasting; arranging and conducting of lectures, live educational demonstrations, displays, exhibitions, presentations and seminars for teaching and training purposes in the field of radio and radio broadcasting; entertainment services, namely, live music concerts and live theatrical performances; organizing of events, namely, music festivals and music concerts for entertainment purposes; conducting instructional, teaching and coaching classes, courses, seminars, presentations, and workshops in the field of radio and radio broadcasting; entertainment in the nature of factual knowledge and talent competitions in the field of radio where entry is by personal attendance, mail, email, telephone, text message or via the Internet; online library services, namely, providing electronic library services for the supply of electronic information, including archive information, in the form of electronic texts and audio and video information and data; providing on-line publications, non-downloadable, namely, books, magazines, brochures, leaflets, printed guides, printed periodicals, catalogues, newsletters and newspapers in the field of radio and radio broadcasting; entertainment services, namely, providing digital sound and video recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films, celebrity interviews, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital sound and video recordings in the field of music, musical recordings, musical performances, musical groups, motion picture films, celebrity interviews, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP3 and MP4 Internet websites; 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With respect to Application Serial No. 79140372, applicant has appealed the examining attorney's final refusal on the Principal Register, pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark RADIODNS HYBRID RADIO is merely descriptive of the goods and services.² With respect to Application Serial No. 79144500, applicant has also appealed the examining attorney's final requirement to disclaim RADIO DNS HYBRID RADIO³, pursuant to Trademark Act Section 6(a), 15 U.S.C. §1056(a) and Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), on the ground that RADIO DNS is merely descriptive of the goods and services.

STATEMENT OF FACTS

Application Serial No. 79140372

On August 21, 2013, applicant filed an application under Section 66(a) of the Trademark Act seeking to register the mark RADIODNS HYBRID RADIO for various goods and services in International Classes 9, 16, 38 and 41. On January 7, 2014, the examining attorney refused registration, pursuant to Section 2(e)(1) of the Trademark Act, on the ground that the mark was merely descriptive in relation to the goods and services, and required applicant to provide a more definite recitation of goods and services and additional information about the mark and the goods

comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from the Internet; entertainment services, namely, providing digital video, image, film radio and TV recordings and programmes in the field of music, musical recordings, musical performances, musical groups, motion picture films, celebrity interviews, artistic performances, concerts, appearances by a celebrity or celebrities, appearances by professional entertainers, game shows, drama, comedy, action, adventure, animation, documentaries, fashion, health, beauty, lifestyle, clothing and self-improvement, not downloadable, from MP4 Internet websites; provision of information relating to music, musical recordings and musical entertainment; information, advisory and consultancy services in relation to the aforesaid services, in International Class 41

² The refusal in Application Serial No. 79140372 excludes the following goods in International Class 16: pens; pencils; erasers; pen and pencil cases.

³ Applicant has disclaimed HYBRID RADIO.

and services. On February 28, 2014, applicant presented arguments as to the refusal, submitted a disclaimer of HYBRID RADIO, amended the identification and responded to the request for information.

On March 21, 2014, the examining attorney requested additional information and maintained the requirement to provide a more definite identification of goods and services. On July 18, 2014, applicant responded to the request for information and amended the identification. On August 19, 2014, the examining attorney issued a non-final action to clarify the status of the descriptiveness refusal, provided information as to claiming acquired distinctiveness under Section 2(f) and maintained the requirement as to the identification of services. On January 9, 2015, applicant amended the identification of services and provided additional arguments as to the refusal. On January 28, 2015, the examining attorney issued an additional requirement as to the identification of services. On July 28, 2015, applicant amended the identification of services.

On September 2, 2015, the examining attorney accepted applicant's amended identification of services and made final the descriptiveness refusal pursuant to Section 2(e)(1) of the Trademark Act. On December 7, 2015, applicant filed a Notice of Appeal, a motion to consolidate its appeal with Application Serial No. 79144500 and an appeal brief. On December 16, 2015, the appeal brief was forwarded to the examining attorney. On February 11, 2016, the Trademark Trial and Appeal Board granted applicant's request to consolidate the appeals, and Application Serial No. 79144500 was reassigned to the undersigned examining attorney.

Application Serial No. 79144500

On October 17, 2013, applicant filed an application under Section 66(a) of the Trademark Act seeking to register the mark RADIO DNS HYBRID RADIO and design for various goods and services in International Classes 9, 16, 38 and 41. On April 8, 2014, the examining attorney

required applicant to disclaim RADIO DNS HYBRID RADIO and to provide a more definite identification of goods and services and additional information about the mark and the goods and services. On October 7, 2014, applicant submitted a disclaimer of HYBRID RADIO, presented arguments as to the requirement to disclaim RADIO DNS, amended the identification of goods and services and responded to the request for information.

On November 17, 2014, the examining attorney made final the disclaimer requirement and the requirement to provide an acceptable identification of services. On May 18, 2015, applicant filed a Notice of Appeal and submitted a request for reconsideration of the final action, presenting arguments against the disclaimer and amending the identification of services. On June 11, 2015, the examining attorney denied the request for reconsideration.

On August 23, 2015, applicant filed an appeal brief, which was forwarded to the examining attorney on August 25, 2015. On September 8, 2015, the examining attorney requested remand, and jurisdiction was restored to the examining attorney on September 16, 2015. On October 6, 2015, the examining attorney issued a non-final action requiring applicant to provide his entity type and citizenship and a more complete mark description. On October 15, 2015, applicant provided his entity type and citizenship and amended the mark description. On November 6, 2015, the examining attorney made final the disclaimer and mark description requirements. On November 11, 2015, applicant submitted a request for reconsideration amending the mark description. On February 9, 2016, the examining attorney accepted the mark description and denied the request for reconsideration.

On February 11, 2016, the Trademark Trial and Appeal Board granted applicant's motion to consolidate the appeals, and Application Serial No. 79144500 was reassigned to the undersigned

examining attorney. On February 11, 2016, applicant's brief was forwarded to the examining attorney.

ISSUES

The issues on appeal are: 1) whether the mark RADIODNS HYBRID RADIO is merely descriptive of the goods and services identified above, pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); and 2) whether RADIO DNS is merely descriptive of the goods and services identified above, pursuant to Trademark Act Section 6(a), 15 U.S.C. §1056(a) and Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), such that the wording RADIO DNS HYBRID RADIO, rather than just HYBRID RADIO, must be disclaimed.

ARGUMENTS

- I. With respect to Application Serial No. 79140372, the mark is descriptive of the goods and services because they relate to hybrid radio or hybrid radio broadcasting and utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS).**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)); Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

Applicant seeks to register the mark RADIODNS HYBRID RADIO for various goods in Class 9 that feature or relate to radio or radio broadcasting, Class 16 goods such as printed matter about radio or radio broadcasting, Class 38 telecommunications services relating to radio broadcasting and various

entertainment services in Class 41 that relate to radio broadcasting, including radio programs and entertainment provided through such radio programs. The evidence attached in the final Office action describes HYBRID RADIO as follows:

If you mix traditional broadcast radio with IP technologies you get a hybrid radio – a radio that uses the technology of both worlds. A Hybrid Radio holds the possibility to aggregate additional information and media to your radio broadcast by fetching it from the internet.⁴

Applicant has also submitted a disclaimer for HYBRID RADIO, thus conceding that this wording is not inherently distinctive. See TMEP §1213.01(d).

With respect to the wording RADIODNS, the dictionary evidence attached in the first Office action defines “radio” as “a communication system based on broadcasting electromagnetic waves”⁵ and indicates that DNS is an acronym for “domain name system.”⁶ The dictionary entry attached in that Office action also defines “domain name system” as a “[h]ierarchical system of names, standards, and servers that organizes the internet as an aggregate of domains, and enables the translation of domain names into their unique four-part Internet Protocol (IP) addresses.”⁷ Moreover, the Wikipedia entry attached in the same Office Action describes Radio DNS as follows:

RadioDNS is a method for a hybrid radio receiver, meaning one receiving the broadcast radio signal and connected to the Internet, to find the Internet address of the interactive service corresponding to the radio station actually tuned. It uses the existing Domain Name System to allow the connected radio receiver to look up web resources based on their broadcast parameters, such as the station identifier received within the broadcast signal.⁸

Moreover, as the Internet evidence attached in the final Office action from applicant’s own website indicates, applicant’s hybrid radio broadcasting services use DNS, or a domain name

⁴ See Page 2 of the final Office Action dated September 2, 2015.

⁵ See Page 3 of the Office Action dated January 7, 2014.

⁶ See Page 7 of the Office Action dated January 7, 2014.

⁷ See Page 7 of the Office Action dated January 7, 2014.

⁸ See Page 9 of the Office Action dated January 7, 2014.

system, indicating that “RadioDNS uses the existing Domain Name System to link your FM, HD, DAB or DAB+ broadcasts with your presence on the internet. We operate the DNS root server for radiodns.org to a published trust model.”⁹ Likewise, entities that discuss radio broadcasting services discuss using the domain name system, or DNS, in the delivery of such services. For example:

1. Imagination Community - references the technology used by applicant, indicating that “It’s not new technology. It uses existing DNS – the robust, scalable technology that makes the internet work – alongside the information already being broadcast on FM, DAB, HD and other radio platforms.”¹⁰
2. BBC - features an article regarding applicant’s technology, indicating that “That’s where RadioDNS comes in. Put simply, it uses information that is already broadcast to create a kind ‘unique ID’, which, by using standard DNS technology on the internet, can point your radio quickly and simply to the broadcaster - and from there, to advertise to the radio what this broadcaster supports.”¹¹
3. TCF - discusses that “the paradox is that as radio and the Internet are appearing together on the same devices, they aren’t properly converged.” It goes on to explain the solution provided by radio DNS, indicating that “It is designed to work with most forms of broadcast and streaming radio – FM, HD, DAB, DRM, satellite – and uses pre-existing information already in the transmissions, such as RDS PI codes in FM and Sid codes in DAB. This information can be concatenated to form a pseudo-domain with which you can query any DNS server to find out the real domain associated with that broadcaster.”¹²
4. SADIBA - indicates that “It’s not new technology. It uses existing DNS - the robust, scalable technology that makes the internet work.”¹³
5. Radio World – article wherein applicant indicates that “We use existing Internet technologies like DNS, but glue them together in a way that’s helpful for radio.”¹⁴
6. Radioiloveit – discusses combining of radio and Internet, indicating that “DNS enhances radio broadcast standards (like DAB, HD, FM, and more) with images, video and data which come from the Internet.”¹⁵

⁹ See Page 4 of the final Office Action dated September 2, 2015.

¹⁰ See Page 7 of the final Office Action dated September 2, 2015.

¹¹ See Page 9 of the final Office Action dated September 2, 2015.

¹² See Pages 15-17 of the final Office Action dated September 2, 2015.

¹³ See Page 19 of the final Office Action dated September 2, 2015.

¹⁴ See Page 20 of the final Office Action dated September 2, 2015.

¹⁵ See Page 25 of the final Office Action dated September 2, 2015.

7. gappster.com - simplifies applicant's technology project, indicating that "In non-techie words, the project aims to use the information that is already broadcasted and, by using standard technology, connect to the Internet to allow users to discover more about what they are listening to."¹⁶

Therefore, the mark is descriptive in relation to the goods and services in that they comprise hybrid radio broadcasting, relate to hybrid radio or hybrid radio broadcasting, or are rendered through hybrid radio or hybrid radio broadcasting, and utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS).

Applicant contends that the mark is not descriptive and suggests that the combination of descriptive terms featured in the mark "creates a unitary mark with a unique, nondescriptive meaning" and that the "composite has a bizarre or incongruous meaning as applied to the goods." (Applicant's Brief, Page 6). Applicant also indicates that, because consumers would read RADIODNS as "radio domain name system," it would be impossible for such wording to describe the goods and services. (Applicant's Brief, Page 7). However, applicant has not indicated the alternative unique, nondescriptive, incongruous or bizarre meaning created by the combined descriptive terms RADIO and DNS.

Moreover, when two descriptive terms are combined, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER merely descriptive for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes"); TMEP §1209.03(d). In this case, both the individual components and the composite result are descriptive of applicant's goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and

¹⁶ See Page 12 of the final Office Action dated September 2, 2015.

services. Specifically, while both RADIO and DNS are descriptive, both words retain their descriptive meanings in the phrase RADIODNS, identifying goods and services relating to radio that utilizes DNS, or the domain name system. The combined wording does not create a unique, incongruous or nondescriptive meaning.

Applicant also contends that the evidence of record utilizes the phrase RADIODNS to identify applicant's open source technology. (Applicant's Brief, Page 7). While such evidence may describe applicant's technology, such technology is described in a manner that shows the descriptive nature of the phrase RADIODNS – technology that utilizes DNS, or domain name system, for radio broadcasting. Moreover, as applicant correctly notes, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that “radio DNS” is merely descriptive. See *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

Applicant also contends that there is no “direct connection” between the goods and services and the term DNS. (Applicant's Brief, Page 8). However, the connection between the goods and services and the term DNS has been established in the discussion above. Specifically, because DNS stands for “domain name system” and because applicant's goods and services relate to radio and radio broadcasting that utilizes DNS, or domain name system, to link radio broadcasts to a radio station's domain name system, the mark is descriptive in relation to the good and services.

Applicant also contends that the mark warrants registration because other registrations featuring the wording RADIO or DNS were allowed to register. (Applicant's Brief, Pages 8-13). This argument should be found unpersuasive because the marks referenced by applicant differ from the marks at issue. Moreover, the fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue 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).

In addition, 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.

Because the goods and services comprise hybrid radio broadcasting, relate to hybrid radio or hybrid radio broadcasting, or are rendered through hybrid radio or hybrid radio broadcasting, and utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS), the applied-for mark, RADIODNS HYBRID RADIO, is descriptive in relation to the goods and services.

II. With respect to Application Serial No. 79144500, RADIO DNS is descriptive of the goods and services and must also be disclaimed because they utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS).

A “disclaimer” is a statement in the application record that an applicant does not claim exclusive rights to an unregistrable component of the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive of an applicant’s goods and services. 15 U.S.C. §1052(e); *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 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); Trademark Act Section 6(a), 15 U.S.C. §1056(a) and Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

Applicant seeks to register the mark RADIO DNS HYBRID RADIO and design for various goods in Class 9 that feature or relate to radio or radio broadcasting, Class 16 goods such as printed matter about radio or radio broadcasting, Class 38 telecommunications services relating to radio broadcasting and various entertainment services in Class 41 that relate to radio broadcasting, including radio programs and entertainment provided through such radio programs. (Applicant has disclaimed HYBRID RADIO.) As the evidence attached in the first Office action indicates, “radio” is defined as “a system of broadcasting information and programs that people can listen to”¹⁷ and “DNS” is an acronym for “domain name system.”¹⁸ Moreover, “domain name system” is defined as “the way that Internet domain names are located and translated into Internet Protocol addresses. A domain name is a meaningful and easy-to-remember ‘handle’ for an Internet address.”¹⁹

Moreover, as the evidence of record shows, applicant’s goods and services relate to or feature radio and radio broadcasting and utilize the existing DNS, or domain name system, to link traditional radio broadcasts to a radio station’s Internet domain. For example, applicant’s website indicates that “RadioDNS provides the DNS lookup which enables additional services and applications to be built.”²⁰ Likewise, applicant indicates that “It is not new technology. It uses existing DNS – the robust, scalable technology that makes the internet work alongside the information already being broadcast on FM, DAB, HD and other radio platforms.”²¹ Lastly, applicant indicates that “RadioDNS uses the existing

¹⁷ See Page 3 of the Office Action dated April 8, 2014.

¹⁸ See Page 9 of the Office Action dated April 8, 2014.

¹⁹ See Page 9 of the Office Action dated April 8, 2014.

²⁰ See Pages 2-3 of the final Office Action dated November 17, 2014.

²¹ See Page 20 of the Office Action dated April 8, 2014.

Domain Name System to link your FM, HD, DAB or DAB+ broadcasts with your presence on the internet.

We operate the DNS root server for radiodns.org to a published trust model.”²²

In addition, the evidence of record shows that third parties describe technology such as applicant’s as radio broadcasting that utilizes DNS. For example:

1. BBC – blog indicating “That’s where RadioDNS comes in. Put simply, it uses information that is already broadcast to create a kind ‘unique ID’, which, by using standard DNS technology on the internet, can point your radio quickly and simply to the broadcaster - and from there, to advertise to the radio what this broadcaster supports.”²³
2. MYRADIODNS.COM – discussion entitled OUT OF THE BOX SOLUTION FOR DNS RADIO²⁴
3. SADIBA - indicates that “It’s not new technology. It uses existing DNS - the robust, scalable technology that makes the internet work.”²⁵
4. Radio World – article wherein applicant indicates that “We use existing Internet technologies like DNS, but glue them together in a way that’s helpful for radio.”²⁶
5. Radioiloveit – discusses combining of radio and the Internet, indicating that “DNS enhances radio broadcast standards (like DAB, HD, FM, and more) with images, video and data which come from the Internet.”²⁷
6. TCF - discusses that “the paradox is that as radio and the Internet are appearing together on the same devices, they aren’t properly converged.” It goes on to explain the solution provided by radio DNS, indicating that “It is designed to work with most forms of broadcast and streaming radio – FM, HD, DAB, DRM, satellite – and uses pre-existing information already in the transmissions, such as RDS PI codes in FM and Sid codes in DAB. This information can be concatenated to form a pseudo-domain with which you can query any DNS server to find out the real domain associated with that broadcaster.”²⁸
7. gapster.com - simplifies applicant’s technology project, indicating that “In non-techie words, the project aims to use the information that is already broadcasted and, by using standard technology, connect to the Internet to allow users to discover more about what they are listening to.”²⁹

²² See Page 23 of the denial of the Request for Reconsideration dated June 11, 2015.

²³ See Page 10 of the final Office Action dated November 17, 2014.

²⁴ See Page 13 of the final Office Action dated November 17, 2014.

²⁵ See Page 9 of the denial of the Request for Reconsideration dated June 11, 2015.

²⁶ See Page 11 of the denial of the Request for Reconsideration dated June 11, 2015.

²⁷ See Page 16 of the denial of the Request for Reconsideration dated June 11, 2015.

²⁸ See Pages 5-6 of the denial of the Request for Reconsideration dated June 11, 2015.

²⁹ See Page 2 of the denial of the Request for Reconsideration dated June 11, 2015.

8. Technology360 – indicates that “RADIO-DNS” is a “clear and logical name” for a radio system wherein a “simple program grabs the already present station ID information and looks up the station’s web presence as listed in the Domain Name System...”³⁰

Therefore, the RADIO DNS descriptive in relation to the goods and services in that they apply or utilize DNS, or the domain name system, to link traditional radio broadcasts to a radio station’s Internet domain. Thus, the wording RADIO DNS HYBRID RADIO, rather than just HYBRID RADIO, should be disclaimed.

Applicant contends that the wording RADIO DNS would be perceived by consumers as RADIODNS. (Applicant’s Brief, Page 6). However, because DNS is featured within a magnifying glass and is not connected to the word RADIO in any manner, the first portion of the mark is likely to be perceived as RADIO DNS. Moreover, assuming, *arguendo*, that consumers would perceive this wording as RADIODNS, this would not alter this wording’s descriptive significance, as consumers are likely to perceive this portion of the mark as a combination of two descriptive terms – radio and DNS - both of which, as discussed below, retain their descriptive meanings.

Applicant also contends that the mark is not descriptive and suggests that the combination of descriptive terms featured in the mark “creates a unitary mark with a unique, nondescriptive meaning” and that the “composite has a bizarre or incongruous meaning as applied to the goods.” (Applicant’s Brief, Page 6). Applicant also indicates that, because consumers would read RADIODNS as “radio domain name system,” it would be impossible for such wording to describe the goods and services. However, applicant has not indicated the alternative, unique, nondescriptive, incongruous or bizarre meaning created by the combined descriptive terms RADIO and DNS.

³⁰ See Page 21 of the denial of the Request for Reconsideration dated June 11, 2015.

Moreover, when two descriptive terms are combined, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER merely descriptive for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes"); TMEP §1209.03(d). In this case, both the individual components and the composite result are descriptive of applicant's goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services. Specifically, while both RADIO and DNS are descriptive, both words retain their descriptive meanings in the phrase RADIODNS, identifying goods and services relating to radio that utilizes DNS, or domain name system. The combined wording does not create a unique, incongruous or nondescriptive meaning.

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services and the term DNS has been established in the discussion above. Specifically, because DNS stands for “domain name system” and because applicant’s goods and services relate to radio and radio broadcasting that utilizes DNS, or domain name system, to link radio broadcasts to a radio station’s domain name system, the mark is descriptive in relation to the good and services.

Applicant also contends that the mark warrants registration because other registrations featuring the wording RADIO or DNS were allowed to register. (Applicant’s Brief, Pages 8-13). This argument should be found unpersuasive because the marks referenced by applicant differ from the marks at issue. Moreover, the fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue 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).

In addition, 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.

Because the goods and services utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS), RADIO DNS is descriptive in relation to the goods and services. Thus, the wording RADIO DNS HYBRID RADIO, rather than just HYBRID RADIO, must be disclaimed.

III. CONCLUSION

Because the goods and services comprise or relate to hybrid radio broadcasting and utilize technology that links the radio broadcast to the Internet using the existing Domain Name System (DNS), the applied-for mark, RADIODNS HYBRID RADIO, is descriptive in relation to the goods and services. Likewise, because the goods and services utilize DNS, or the domain name system, to link traditional radio broadcasts to a radio station's Internet domain, RADIO DNS is also descriptive in relation to the goods and services.

For the foregoing reasons, it is respectfully requested that the refusal to register the applicant's proposed mark, RADIODNS HYBRID RADIO, under Section 2(e)(1) of the Trademark Act, be affirmed. For the foregoing reasons, it is also respectfully requested that the requirement to disclaim RADIO DNS HYBRID RADIO, under Sections 6(a) and 2(e)(1) of the Trademark Act, be affirmed.

Respectfully submitted,

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