

This Opinion is Not a
Precedent of the TTAB

Mailed: July 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Nicholas Piggott

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Serial Nos. 79140372 and 79144500

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Brian M. Davis of VLP Law Group LLP for Nicholas Piggott.

Melissa Vallillo, Trademark Examining Attorney, Law Office 105,
Susan Hayash, Managing Attorney.

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Before Zervas, Wellington, and Heasley, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Nicholas Piggot (“Applicant”) seeks Principal Register registrations for the marks
RADIODNS HYBRID RADIO (in standard characters) and the stylized version
with a design shown below:



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each for a long list of goods and services in International Classes 9, 16, 38 and 41.¹ Applicant has disclaimed HYBRID RADIO in both applications.

The Examining Attorneys responsible for the two applications each took the position that the term RADIO DNS is merely descriptive of Applicant's goods and services. Accordingly, the standard character mark (Application '372) was refused registration on the ground that the entire mark is merely descriptive under Section 2(e)(1) of the Trademark Act ("the Act"), 15 U.S.C. § 1052(e)(1); and the stylized with a design mark (Application '500) was refused registration in the absence of a disclaimer of the term RADIO DNS, under Section 6(a) of the Act, 15 U.S.C. §1056(a).²

After the refusals became final, Applicant appealed. With respect to the '500 Application only, Applicant filed a motion for reconsideration, which was denied by the Examining Attorney. Applicant filed briefs for both appeals, which were consolidated.³ The Examining Attorney responsible for Application '372, identified

¹ Application Serial No. 79140372 (standard character mark), filed August 21, 2013 and Application Serial No. 79144500 (stylized with design mark), filed on October 17, 2013. Both applications were filed under Section 66(a) based on international registrations. The identifications of goods and services in both applications are the same for classes 16 and 38, and differ slightly for classes 9 and 41. The identifications are extremely lengthy, so for the sake of brevity, we refer only to the relevant goods and services from the respective classes that are common to both applications.

² The Examining Attorney handling Application '372 excluded the following goods in International Class 16 from the descriptiveness refusal: "pens; pencils; erasers; pen and pencil cases." See Office Action issued on September 2, 2015.

³ In its appeal brief for the '372 Application, Applicant requested that the appeals be consolidated. In an order dated February 11, 2016, the Board consolidated the appeals. Unless specified otherwise, all citations in this decision are made to Applicant's brief filed in the '372 appeal.

above was assigned to Application '500. She then filed a single brief addressing both appeals.

The Record

During the prosecution of the '372 Application, the Examining Attorney submitted the following materials in support of her contention that the wording RADIO DNS is merely descriptive of the identified goods and services:

- Definitions for the terms “radio” and “domain name system (DNS),” with the latter being defined as “Hierarchical 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.”⁴
- Printouts from a Wikipedia entry for “RadioDNS” describing it as “a method for a hybrid radio receiver, meaning one receiving the broadcast radio signal and connected to the Internet, to find 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. The project is open standard, initially created by a series of broadcasters and manufacturers.”⁵

The same Wikipedia entry also describes “RadioDNS” as “originally created as a collaborative project between Global Radio (at that time call GCap Media) and the BBC, to investigate creating a mechanism for linking Broadcast Radio and IP delivered web services.”⁶

- Printout from the BBC website discussing “RadioDNS” technology.⁷

⁴ Attached to Office Action issued on January 6, 2014. The provided “domain name system (DNS)” definition was obtained from BusinessDictionary.com (www.businessdictionary.com).

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

- Printouts from various websites, including Applicant's, describing "RadioDNS" – the following are some excerpts:⁸

"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

"We will link your radio station and your internet domain together in DNS, and then RadioDNS Hybrid Radio compatible devices will be able [to] connect automatically to you via the internet."¹⁰

"It's not new technology. It uses existing DNS – the robust, callable technology that makes the internet work alongside the information already being broadcast on FM, DAB, HD and other radio platforms."¹¹

"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."¹²

"We at Radio DNS have adopted an open approach to technology development, which is inspired by the collaborative nature of Internet standards. We use existing Internet technologies like DNS, but glue them together in a way that's helpful for radio. All the data and interaction goes directly from the listener to the broadcaster, and not via RadioDNS."¹³

⁸ Attached to Office Action issued on September 2, 2015.

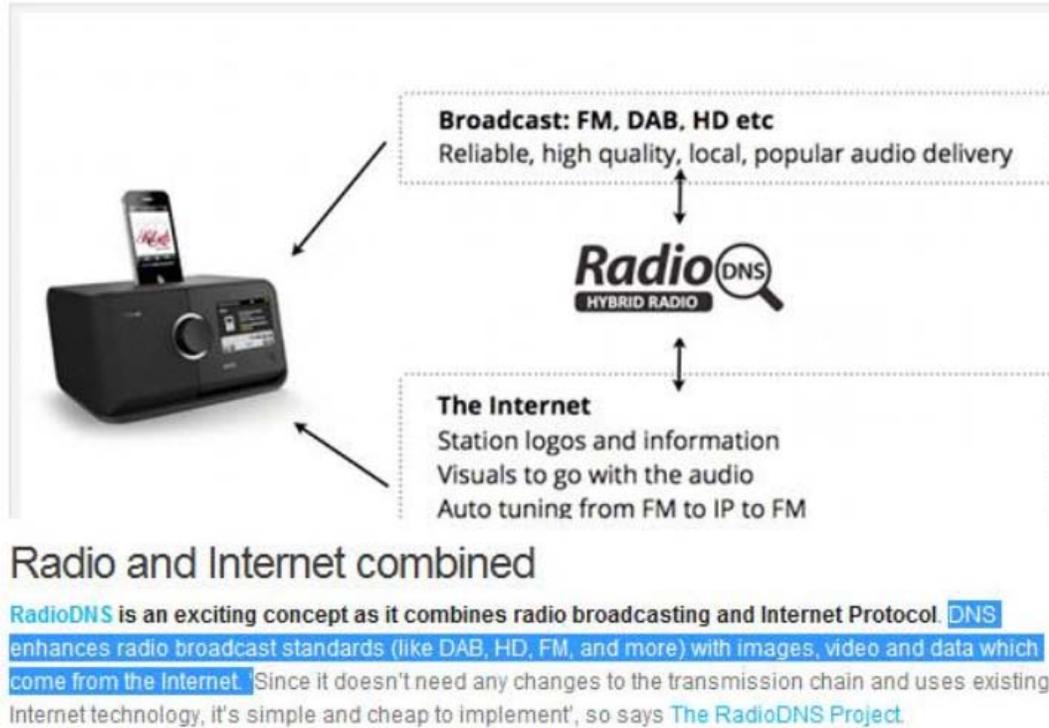
⁹ *Id.* at p. 4.

¹⁰ *Id.* at p. 5.

¹¹ *Id.* at p. 7.

¹² *Id.* at p. 9.

¹³ *Id.* at p. 20.



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Many of the same materials described above were submitted by the Examining Attorney during the prosecution of the '500 Application. In addition, the Examining Attorney attached the following to an Office action in the '500 Application:

- Printouts from the "SearchNetworking" website (www.searchnetworking.com) defining "domain name system (DNS)" as "...the way that Internet domain names are located and translated into Internet Protocol addresses."¹⁵

Applicable Law

A mark is deemed to be merely descriptive, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the goods or services for which it is used. *In re Bayer Aktiengesellschaft*,

¹⁴ *Id.* at p. 26.

¹⁵ Attached to Office action dated April 7, 2014, at p. 8.

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488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods and services for which registration is sought, the context in which it is being used on or in connection with the goods and services, and the possible significance that the mark would have to the average purchaser of the goods and services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).¹⁶

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods and services, the combination results in a composite that is itself merely descriptive. *See e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir.

¹⁶ Applicant's reliance on the descriptiveness "tests" set forth in *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 USPQ 502 (TTAB 1985) is misplaced. *See In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009).

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2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry).

Under Section 6(a) of the Act, “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable,” such as a component that is merely descriptive under Section 2(e)(1). Failure to comply with a disclaimer requirement is a basis for refusing registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

Analysis

The evidence of record establishes that the term RADIO DNS (or RADIODNS, without space between the terms) is merely descriptive of certain identified goods and services in each of the applications’ Classes 9, 16, 38 and 41. Specifically, the term

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(and the entire mark with respect to Application ‘372) is merely descriptive of goods and services, including: “radios” in Class 9, “printer matter, namely, books, magazines ... in the field of radio” in Class 16, “radio broadcasting and internet broadcasting” services in Class 38, and the “provision of ongoing radio programs” in a variety of fields in Class 41. The fact that we identify these particular goods and services does not mean that the term, or entire mark, is not descriptive of other goods and services listed in the lengthy identifications. Rather, these are the goods in common to both applications to which the Examining Attorney has referred. We do bear in mind, however, that the refusal to registration with respect to Application ‘372 does not include “pens; pencils; erasers; pen and pencil cases” in Class 16 (see Note 2 *supra*).

Applicant has disclaimed the literal portion, HYBRID RADIO, in both marks. Applicant does not dispute that this wording is merely descriptive in the context of the goods and services, and the evidence shows that a “hybrid radio” is a specific type of radio that “uses existing FM or HD broadcasts as a robust and reliable way to deliver audio, but presents them like an app, by using additional meta-data (such as logos and descriptions) delivered over an IP connection (WiFi, 3G, LTE).”¹⁷ One benefit of a hybrid radio, aside from reducing IP data consumption and battery drain on portable devices, is that “[i]f the listener loses FM reception, he or she can be

¹⁷ From “RadioDNS: Hybrid Radio Accelerates” article (www.radioworld.com), attached to Office action dated April 7, 2014 (Application ‘500) at p. 14.

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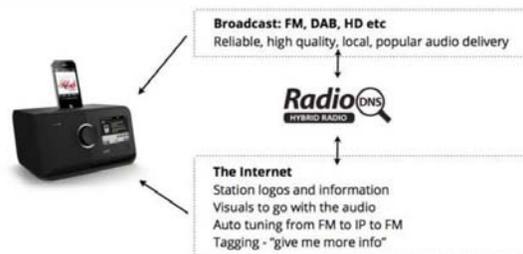
switched automatically to streaming until such time as the FM signal improves, and then automatically switched back to FM.”¹⁸

The record further establishes that hybrid radios use the Internet’s “domain name system” (abbreviated as “DNS”) to locate and translate Internet domain names into Internet Protocol (IP) addresses. Consequently, in the context of hybrid radios or services involving hybrid radios, RADIO and DNS are descriptive terms that immediately convey information about the goods and services. Consumers who are aware of Applicant’s goods and services will have no trouble understanding the significance of these terms. As exemplified on Applicant’s website (www.radiodns.org), “DNS” is not only prefaced with RADIO, but the technology is touted in a descriptive manner as an integral part of the hybrid radios:¹⁹



RadioDNS Lookup

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**.



¹⁸ *Id.*

¹⁹ Attached to Office Action issued on September 2, 2015, at p. 4.

RADIO and DNS directly describe the type of “radios” in Class 9, *i.e.*, they are hybrid radios using DNS technology; and further describe the subject matter of the “printed matter, namely, books, magazines ... in the field of radio” in Class 16. Likewise, in the context of Applicant’s “radio broadcasting and internet broadcasting” services in Class 38 and “provision of ongoing radio programs” in a variety of fields in Class 41, consumers will readily understand these terms as describing the type of communication *i.e.*, radio, and that DNS technology is being employed in the broadcasting and provision of the radio programs because they the broadcasts are being linked to the broadcaster’s Internet domain name.

The combination of the two words, RADIO and DNS, does not diminish the descriptive nature of each word or result in a nondescriptive composite. The lack of space between RADIO and DNS, *i.e.*, RADIODNS, in Application ‘372, is inconsequential, as it does not obviate the overall merely descriptive nature of the two terms. See *In re Petroglyph*, 91 USPQ2d 1332; *In re Carlson*, 91 USPQ2d 1198.

Applicant cites to the existence of various third-party registrations containing either RADIO or DNS in tandem with other terms. These registrations have little persuasive value. Many of the registered marks are distinguishable and lack relevance because they contain additional elements that may have been deemed registrable and thus carry the entire mark, or because they involve goods and services that differ from those in the involved Applications. In any event, we are not bound by the past decisions of individual examining attorneys in considering different applications. Rather, the Board makes its own findings of fact, and that duty may not

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be delegated by adopting the conclusions reached on past occasions by examining attorneys. *See In re Cordua Rest., Inc.*, __ F.3d __, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *In re Loggerhead Tools, LLC*, No. 85700986 __ USPQ2d __ (TTAB June 30, 2016); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986). In this case, we have ample evidence showing the two terms RADIO and DNS, and their combination RADIODNS, immediately impart information about Applicant's goods and services.

Applicant asserts the record almost exclusively shows "RadioDNS," being associated with Applicant's open source technology. While this may be true, this does not detract from or diminish the descriptive nature of the term. RADIO DNS will still be immediately understood by consumers, in the context of the goods and services, as conveying specific information about the goods and services. Even if Applicant is the first or only user of the term RADIO DNS, this does not render the term incongruous or distinctive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems*, 59 USPQ2d at 1087; TMEP §1209.03(c). Furthermore, in this regard, we note that there is no claim that the term has acquired distinctiveness under Section 2(f) and thus that issue is not before us.

Applicant is also correct that to the extent there is any doubt whether the term RADIO DNS (or RADIODNS or the entire mark in the '372 Application) is merely descriptive of involved goods and services, we should resolve the matter in favor of Applicant. However, in this case, the record supports our aforementioned findings and we have no doubt in this regard.

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Decision: The refusal to register the standard character mark in the ‘372 Application is affirmed with respect to all of the goods and services in International Classes 9, 16, 38 and 41, excluding “pens; pencils; erasers; pen and pencil cases” in International Class 16.

The refusal to register the stylized with a design mark in the ‘500 Application for all identified goods and services in the absence of a disclaimer of RADIO DNS is affirmed. This decision with respect to the ‘500 Application will be set aside if, within thirty days of the mailing date of this order, Applicant submits to the Board a proper disclaimer of RADIO DNS. Trademark Rule 2.142(g). The disclaimer should be worded as follows:

“No claim is made to the exclusive right to use RADIO DNS apart from the mark as shown.”