

From: MacFarlane, James

Sent: 2/11/2014 1:02:54 PM

To: TTAB E filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85468736 - PERSONAL LIBERTY DIGEST - 12967-0002 - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 85468736.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

## U.S. APPLICATION

**SERIAL NOS.** 85468736 and 85468795



**MARK:** PERSONAL LIBERTY DIGEST

## CORRESPONDENT ADDRESS:

C BRANDON BROWNING

MAYNARD COOPER & GALE PC

1901 6TH AVE N SUITE 2400

BIRMINGHAM, AL 35203-4604

## GENERAL TRADEMARK INFORMATION:

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

## TTAB INFORMATION:

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

**APPLICANT:** Personal Liberty Media Group, LLC

## CORRESPONDENT'S REFERENCE/DOCKET NO:

12967-0002

## CORRESPONDENT E-MAIL ADDRESS:

bbrowning@maynardcooper.com

## EXAMINING ATTORNEY'S APPEAL BRIEF

The Examining Attorney apologizes for this Brief being filed after the February 7, 2014 due date set by the Board. The original Motion to Consolidate requested that the consolidated Brief be due 60 days after the granting of the Motion. When the Motion was granted, the due

date set in the Order was inadvertently overlooked and the due date for the Brief was incorrectly calendared. The Examining Attorney respectfully requests that the Board accept and fully consider this Brief in rendering its decision. TBMP §1203.02(b); *see In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984).

Applicant has appealed the Trademark Examining Attorney's final refusals to register the proposed trade and service marks "PERSONAL LIBERTY" (containing International Classes 16, 35 and 36) and "PERSONAL LIBERTY DIGEST" (containing International Classes 35 and 36) on the basis that the marks are merely descriptive of the goods and services under Trademark Act Section 2(e)(1). The applications are for the following goods and services:

International Class 16 – Newsletters in the fields of current events, economics, politics, wealth management and personal management

International Class 35 – Providing a website featuring information in the fields of economics and politics

International Class 36 – Providing a website featuring information in the field of wealth management

As demonstrated herein, the refusals to register the marks should be affirmed.

## **I. FACTS**

On November 9, 2011, applicant, Personal Liberty Media Group, LLC, applied for registration on the Principal Register for the marks "PERSONAL LIBERTY" and "PERSONAL LIBERTY DIGEST" in standard characters, covering the following goods and services:

International Class 16 – Newsletters in the fields of current events, economics, politics, wealth management and personal management

International Class 35 – Providing a website featuring information in the fields of economics and politics

International Class 36 – Providing a website featuring information in the field of wealth management

The marks were initially passed to publication, with a disclaimer of the word “DIGEST” entered by the consent of applicant, on March 2, 2012. Upon further consideration by the Office, registration of the marks was refused on February 28, 2013, under Trademark Act Section 2(e)(1), because the proposed marks are merely descriptive of the applied-for goods and services.

Applicant responded and argued against the Section 2(e)(1) refusals on August 20, 2013. Final refusals of registration were issued on September 30, 2013. Applicant filed its Notices of Appeal on October 30, 2013, and its Appeal Briefs on November 13, 2013. The Examining Attorney filed a Motion to Consolidate the separate appeals on December 3, 2013, which was granted by the Trademark Trial and Appeal Board on December 13, 2013.

## **II. ARGUMENT**

### **A. THE WORDING “PERSONAL LIBERTY” AND “PERSONAL LIBERTY DIGEST” IS MERELY DESCRIPTIVE OF APPLICANT’S GOODS AND SERVICES.**

A mark is merely descriptive if it conveys an immediate idea of the ingredients, features, qualities, characteristics, purposes or uses of the identified goods and/or services. *See In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005); TMEP §1209.01(b). The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254 (Fed. Cir. 2012); TMEP §1209.01(b).

Applying these standards to applicant’s marks, it is clear that the wording “PERSONAL LIBERTY” and “PERSONAL LIBERTY DIGEST” is merely descriptive of applicant’s goods and services. The definitions of record from dictionary.com, infoplease, Wikipedia, businessdictionary.com, and Merriam-Webster show that the wording “personal liberty” refers to “the freedom of the individual to do as [s]he pleases limited only by the authority of politically organized society to regulate [his] action to secure the public

health, safety, or morals or of other recognized social interests.” (February 28, 2013 Office action at pages 2-15.)<sup>1</sup> The definitions of record from the Yahoo and Collins online dictionaries show that the word “digest” means a periodical, a collection of published material such as articles, or a comprehensive and systematic compilation of information. (February 28, 2013 Office action at pages 37-42.)

As noted above, applicant’s goods and services consist of newsletters in the fields of current events, economics, politics, wealth management and personal management, and of providing a website featuring information in the fields of economics, politics and wealth management. Its goods and services thus concern “personal liberty,” namely the freedom of people generally to do as they please, within those contexts. Applicant’s website confirms that its goods and services are in this area, as applicant clearly offers “personal liberty” articles, applicant’s slogan is “Live Free in an Unfree World,” and the categories available on the website include such topics as:

2nd Amendment Under Fire

Civil Liberty

Freedom Concerns

Liberty

Privacy

Freedom Watch

(November 9, 2011 Application at pages 3-6.)

Moreover, the additional evidence of record shows the widespread use of the wording “personal liberty” within these contexts, as well as the importance of the concept of “personal liberty”

---

<sup>1</sup> Please note that references to TICRS evidence herein are to the record in Application Serial No. 85468736, though the records in both cases are nearly identical but for the additional dictionary definitions of “digest” not included in Application Serial No. 85468795.

as a part of political philosophy. For example, the evidence from *Politics in America* by Thomas R. Dye includes a chapter on “Politics and Personal Liberty.” (February 28, 2013 Office action at pages 16-19.) This chapter notes that “the classic dilemma of people in a democratic society is how to balance the authority they need with the personal liberty they want,” and goes on to discuss the protections provided by the Bill of Rights to help secure personal liberties. Thus, guarantees of the freedom of religion, rights of privacy, the right to bear arms, etc., are all rooted in the concept of “personal liberty.” The evidence from the Bill of Rights Institute sets forth a number of important Supreme Court cases that deal with the concept of “personal liberty.” (February 28, 2013 Office action at pages 20-21.)

The evidence from Headcount Blog discusses the views of Mitt Romney and President Obama on “personal liberty,” noting that for Romney liberty refers in large part to economic freedom, including not being unduly taxed and reducing government spending on various programs. (February 28, 2013 Office action at pages 34-36.)

The evidence from the website of the Modern Whig Party shows various posts tagged as “personal liberty” on such topics as gun control, campaign contributions, and regulating the internet. (February 28, 2013 Office action at pages 2-4.)

Finally, the evidence from the American Thinker shows an article discussing “personal liberty” as part of the modern Republican and Tea Party movement, expressing the view that the concept should be embraced as it applies to individual liberties as well as market freedom and property rights. (February 28, 2013 Office action at pages 10-13.)

Taken together, these resources and the other evidence of record demonstrate that the concept of “personal liberty” intersects with and touches all of the enumerated fields in applicant’s listing of goods and services – namely, the fields of current events, economics, politics, wealth management and personal management. This wording thus immediately and directly tells the consumer that applicant’s

goods (newsletters) and services (websites featuring information) all concern the concept of “personal liberty.”

With regard to the word “digest,” this word also is descriptive in the context of the services, as it describes the form in which the information is presented. As shown by the evidence submitted by applicant from its website, attached as a specimen to its initial application, its offerings in fact include articles. (November 9, 2011 Application at pages 3-6.) Moreover, applicant has admitted that this wording is descriptive by voluntarily disclaiming it, and applicant has not argued against its descriptiveness.

In response, applicant argues in its Appeal Briefs that its marks “PERSONAL LIBERTY” and “PERSONAL LIBERTY DIGEST” do not merely describe the goods and services, and there is no evidence that others are using this wording for newsletters and websites in the fields specified by applicant. Specifically, applicant first argues that the words “personal” and “liberty” have various different meanings, and that when combined these differing meanings can create in the minds of consumers “a multitude of meanings,” none of which immediately tells consumers the nature of the goods and services. (Applicant’s Appeal Brief at 4-6.)<sup>2</sup>

Applicant’s position is not supported by the evidence of record. Certainly the individual words “personal” and “liberty” may have various meanings when viewed separately and in a vacuum, but that does not mean that the words do not describe applicant’s goods and services. The descriptiveness of a mark is determined in relation to an applicant’s goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, (Fed. Cir. 2007)); TMEP

---

<sup>2</sup> Please note that references to Applicant’s Appeal Brief herein refer to the Brief in Application Serial No. 85468736, which is nearly identical to the Brief in Application Serial No. 85468795.

§1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64. Moreover, the fact that the individual terms may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

The wording at issue here is the phrase “personal liberty,” not the individual terms “personal” and “liberty.” As shown above, it is a fundamental concept in political philosophy, and the phrase is in widespread use in relation to politics, economics, and current events. Nothing about the two words taken together, the phrase as it appears in the mark, or the phrase as used in the evidence of record and in applicant’s specimen of record, will lead consumers to dissect it or ascribe differing meanings to it. Rather, consumers will view the wording and immediately and rightfully conclude that applicant’s goods and services are on the topic of “personal liberty.”

Regarding applicant’s contention that there is no evidence that others are using this wording for newsletters and a website in the same fields of use as applicant, the evidence of record discussed above clearly contradicts this assertion. Moreover, even if applicant were the first to use this wording in this precise context, this would not overcome its descriptiveness in relation to the identified goods and services. The fact that an applicant may be the first and only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive when the evidence, as it does here, shows that the wording is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

Applicant also refers to one of the definitions of “personal liberty” and argues that the Examining Attorney has improperly focused on the phrase “except for those restraints imposed by law to safeguard the physical, moral, political and economic welfare of others” in his analysis. (Applicant’s

Appeal Brief at 6-9.) Applicant argues that the essential element of the definition is “the liberty of an individual to do his or her will freely” and that its identification does not mention “freedom or rights of any kind.” (*Id.* at 7.)

The analysis of descriptiveness set forth in the record, however, does not misconstrue or misapply the definitions of this phrase. Applicant’s argument ignores the evidence of record, which clearly shows the use of the phrase “personal liberty” in a myriad of contexts, including the fields of politics, economics and current events. This use shows that the term is a fundamental concept in political philosophy and an underpinning of our Constitution. It establishes that the idea that individuals can do as they please, free from government regulation, is a common and widespread concept recognized by consumers and implicated in discussions of governmental and economic policy.

Thus, consumers who know what applicant’s goods and services are “will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). Specifically, they will immediately conclude that the goods and services concern newsletters and information about and related to “personal liberty” in the fields of current events, economics, politics, wealth management and personal management. The fact that applicant has not used the wording “liberty” or “freedom” in its identification in no way impacts the descriptiveness of the mark in the context of the goods and services or the conclusions that consumers will draw when encountering the mark. Applicant’s identification does not indicate that the goods and services are offered in fields completely unrelated to the concept of “personal liberty;” rather, it indicates that the goods and services are offered in the precise fields where “personal liberty” is most recognized and relevant.

In addition, as noted above, applicant’s own website confirms that its goods and services concern “personal liberty.” (November 9, 2011 Application at pages 3-6.) This further establishes the

descriptiveness of the mark and makes it practically impossible for a consumer to be oblivious to the descriptiveness of the mark as applied to the goods and services.

Applicant next argues that the wording “PERSONAL LIBERTY” is not merely descriptive of its goods and services because the Office has registered the word “liberty” in a number of existing registrations without a disclaimer or a distinctiveness claim. (Applicant’s Appeal Brief at 10-14.) First, the Examining Attorney notes that 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.

The Examining Attorney also notes that none of the registrations presented by applicant concern the precise wording at issue here – “personal liberty.” Many are also phrases or are unitary and would not have required a disclaimer or distinctiveness claim because the word “liberty” is united with registrable matter, like “LIBERTY OR BONDAGE,” EXPLODING LIBERTY,” “FREEDOM NETWORK WHERE LIBERTY DWELLS,” and others.

Finally, the Examining Attorney notes that a number of the third-party registrations presented by applicant are either cancelled or expired, such as Registration No. 1679329 (THE LIBERTY TREE) and 1760218 (LIBERTY INFOLINE). A cancelled or expired registration is not evidence that the mark listed therein is currently in use in the marketplace; it is evidence only that the registration issued. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); TBMP §704.03(b)(1)(A). Thus, these third-party registrations have little, if any, probative value with respect to the registrability of applicant’s mark.

Applicant also argues that several of the registrations introduced by the Examining Attorney in which “liberty” was disclaimed are not relevant because the identifications include references to “liberty,” whereas applicant’s identification includes no such references. (Applicant’s Appeal Brief at 14.) As explained above, however, the evidence establishes that the mark is descriptive of the goods and services whether or not the words “freedom” or “liberty” are present in the identification, and applicant’s website confirms the descriptiveness.

Applicant’s final argument against the refusal to register is based on a number of different cases with distinct facts. (Applicant’s Appeal Brief at 14.) Applicant argues that these cases support the conclusion that “PERSONAL LIBERTY” is suggestive as applied to applicant’s goods and services. It is well-settled, however, 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 ( Fed. Cir. 2001); 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). As demonstrated herein, the evidence establishes that “PERSONAL LIBERTY” and “PERSONAL LIBERTY DIGEST” are descriptive of applicant’s newsletters and website. Consumers who encounter the marks in the context of applicant’s goods and services will immediately be informed that they concern “personal liberty” issues within the context of current events, economics, politics, wealth management and personal management, delivered in whole or in part in “digest” form. Thus, the wording of the marks merely describes applicant’s goods and services.

**B. THE TERMS IN “PERSONAL LIBERTY DIGEST” RETAIN THEIR MERELY DESCRIPTIVE SIGNIFICANCE WHEN COMBINED.**

A mark that merely combines descriptive phrases and words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the

combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012). The combination of descriptive terms must create a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services in order for such a mark to become registrable. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968).

Here, not only are the individual components “PERSONAL LIBERTY” and “DIGEST” descriptive of applicant’s goods and services, the words also retain their descriptive meaning when combined – nothing about the wording “PERSONAL LIBERTY DIGEST” when considered as a whole changes its significance. In its Appeal Briefs, applicant has not argued against the descriptiveness of the word “DIGEST” and has not argued that its combination with “PERSONAL LIBERTY” somehow creates a non-descriptive phrase, but rather has focused on the phrase “PERSONAL LIBERTY” and the individual terms “PERSONAL” and “LIBERTY,” as discussed above. Thus, the combination of words does not yield a non-descriptive phrase with a separate meaning that overcomes the descriptive meaning of the individual phrase and word.

### **III. CONCLUSION**

The record thus establishes that applicant’s marks “PERSONAL LIBERTY” and “PERSONAL LIBERTY DIGEST” merely describe its goods and services of “newsletters in the fields of current events, economics, politics, wealth management and personal management,” “providing a website featuring information in the fields of economics and politics,” and “providing a website featuring information in the field of wealth management.” The words “PERSONAL LIBERTY” and “PERSONAL LIBERTY DIGEST” convey an immediate idea of the subject matter contained within the content of the goods and services. Applicant has introduced no evidence to the contrary. Accordingly, the refusals to register the marks

should be affirmed because the marks are merely descriptive of applicant's goods and services under 2(e)(1) of the Trademark Act.

Respectfully submitted,

/James MacFarlane/

Examining Attorney

Law Office 104

(571) 270-1512 (phone)

(571) 270-2512 (fax)

[james.macfarlane@uspto.gov](mailto:james.macfarlane@uspto.gov)

Chris Doninger

Managing Attorney

Law Office 104