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Sent: 11/24/2015 2:34:49 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86185707 - BRODDCAST - 136252-01070 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86185707

MARK: BRODDCAST



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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: Fuel Industries Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

136252-01070

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EXAMINING ATTORNEY'S APPEAL BRIEF

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The applicant has appealed the final refusal holding the mark BRODDCAST descriptive.

PROCEDURAL HISTORY

Applicant applied for the mark BRODDCAST for “Multimedia software for digital content creation of entertainment videos using electronic media; multimedia software for digital video recording, editing and playback videos; multimedia software for digital recording, editing and playback of entertainment videos; downloadable software for digital recording, editing and playback of entertainment videos” (as amended) on February 5, 2014. The mark was refused registration under Trademark Act Section 2(e)(1) on May 20, 2014 because the mark was found to be descriptive of the goods. On November 20, 2014, applicant responded by traversing the refusal. The descriptiveness refusal was made final on December 19, 2014. Applicant filed a request for reconsideration on June 19, 2015 which was denied on July 24, 2015. This appeal ensued. In its appeal brief, applicant amended the identification of goods. There are no objections to this amendment and such has been made of record.

ISSUE

Whether the mark BRODDCAST is descriptive under Trademark Act Section 2(e)(1) for “Multimedia software for digital content creation of entertainment videos using electronic media; multimedia software for digital video recording, editing and playback videos; multimedia software for digital recording, editing and playback of entertainment videos; downloadable software for digital recording, editing and playback of entertainment videos.”

ARGUMENTS

Applicant's mark, BRODDCAST, is deemed descriptive because the term is phonetically identical to BROADCAST, which is a common term used in the trade and thus viewers of the mark would have a clear concept of the nature of the goods being offered.

A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. See *In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953) (holding "FASTIE," phonetic spelling of "fast tie," merely descriptive of tube sealing machines); *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 76 USPQ 97 (C.C.P.A. 1947) (holding "KWIXTART," phonetic spelling of "quick start," merely descriptive of electric storage batteries); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (holding "URBANHOUSING" phonetic spelling of "urban" and "housing," merely descriptive of real estate services); *In re State Chem. Mfg. Co.*, 225 USPQ 687 (TTAB 1985) (holding "FOM," phonetic spelling of "foam," merely descriptive of foam rug shampoo); TMEP §1209.03(j).

Applicant's goods are "Multimedia software for digital content creation of entertainment videos using electronic media; multimedia software for digital video recording, editing and playback videos; multimedia software for digital recording, editing and playback of entertainment videos; downloadable software for digital recording, editing and playback of entertainment videos." Essentially applicant's goods are multimedia software for creating, editing and most importantly, for playing back or "broadcasting" videos over a network. No imagination or fanciful thinking is required to determine that applicant's mark BRODDCAST identifies goods for broadcasting.

Upon seeing the term BRODDCAST for software that can be used for broadcasting, consumers are apt to know the nature of the goods. The evidence of record (Office action mailed May 20, 2014) establishes that broadcasting software is a critical element to develop programs for broadcasting (see e.g., <http://spacial.com/sam-broadcaster>). Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the

goods are, but “whether someone who knows what the goods ... will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002));

Despite assertions to the contrary, broadcasting videos created by using applicant’s software is seen as an integral purpose of the goods. Applicant webpage (made of record in applicant’s response of November 20, 2014) includes the following: “Are you a YouTube creator?” and “a new creation and digital puppetry tool that gives YouTube creators a brand new avenue for expressions...” . Further, applicant’s software allows individuals “a chance to play, experiment and share...and upload them to social channels for free.” Applicant also states in its appeal brief that its goods are for creating videos that can be disseminated. It is this precise act of dissemination that is the act of transmission of the video programs that is the definition of “broadcasting.” See definition from <https://www.ahdictionary.com/word/search.html?q=broadcast> attached to the Office action mailed December 19, 2014 showing “broadcast” is defined as “signal, message, or audio or video program that is broadcast over a communication network.”

Applicant’s goods are a tool that allows users to create content for the explicit function of broadcasting. BRODDCAST is deemed descriptive for goods that allow individuals to broadcast or to transmit a video, and as such, the term identifies a feature and purpose of the goods as shown in the applicant’s website. The attenuated difference that applicant seeks in describing the mark in relation to the goods would not be perceived by customers who would see the mark BRODDCAST as BROADCAST which is the primary objective of the use of the goods.

Applicant argues that prior Office treatment of the term BROADCAST augurs for registration of its mark. In its request for reconsideration filed on June 19, 2015 and in its appeal brief, applicant submitted third party registrations for marks that included the term BROADCAST or variations thereof (the first three examples are detailed below):

Reg. No. 4607358 for MORE THAN JUST A BROADCAST! for “Downloadable computer software for providing music; Downloadable software for providing transmission of voice, data, video, and media content via the Internet and the worldwide web; Downloadable software in the nature of a mobile application for the uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communication networks”

Reg. No. 4091955 for IBROADCASTING for “Television receivers”

Reg. No. 4091955 for BROADCASTR and design for “Downloadable software in the nature of a mobile application for creating audio recordings associated with a user's location, making said recordings searchable online and within the application, and finding and interacting with other users and locations.”

The registrations provided by applicant are not on point vis-à-vis the current application. The examples include unitary marks, different wording and stylizations. Nevertheless, third-party registrations are 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).

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.

Thus, third-party registrations of applicant's mark or portions of applicant's mark are not probative on the question of descriptiveness. Each case must be taken on its own facts. *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991); TMEP §1209.03(a).

Concerning the submission of a copy of applicant's mark Serial No. 86388876 (BRODDCAST in a highly stylized presentation) in applicant's appeal, objection is made as a copy was not made of record prior to appeal. 37 C.F.R. §2.142(d); TMBP §1208.02.

Applicant also argues for registration based on the doctrine of double entendre. A "double entendre" is an expression that has a double connotation or significance as applied to the goods. TMEP §1213.05(c); *see In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme "sugar and spice and everything nice").

A mark that comprises a "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods. TMEP §1213.05(c). However, the multiple meanings that make an expression a "double entendre" must be well-recognized by the public and readily apparent from the mark itself which is not the situation here. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE not a double entendre in relation to wines and affirming requirement to disclaim ROUGE); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470-71 (TTAB 2005) (finding THE GREATEST BAR not a double entendre in relation to restaurant and bar services and affirming refusal to register based on descriptiveness of the mark); *In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158-59 (TTAB 2003) (finding ETHNIC ACCENTS not a double entendre in relation to television programs in the field of home décor and affirming refusal to register based on descriptiveness of the mark).

Applicant states that its mark can be perceived as both, BROADCAST and brODDcast, with the term “odd” referring to strangely shape characters in the form of puppets available for use in the editing software. However, as the mark is in standard character form, it may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, whether consumers would perceive BRODDCAST to mean that the editing software offered by applicant includes odd characters is a matter of great conjecture, particularly as the double entendre argument centers around a portion of the mark and not its entirety. Moreover, as marks are typically used graphically and orally, especially in a trade dedicated to video and audio, the speculative perception on how the mark will be seen graphically is of diminished consequence as that perception would be lost when the mark is used verbally.

CONCLUSION

For the foregoing reasons, the refusal to register applicant’s mark under Section 2(e)(1) of the Trademark Act as the mark is descriptive when used in connection with the identified goods should be affirmed.

Respectfully submitted,

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