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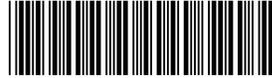
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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86335576

MARK: DIGITAL REAL ESTATE



**CORRESPONDENT ADDRESS:**

WILLIAM J KOLEGRAFF

THOMAS WHITELAW

18101 VON KARMAN AVE STE 230

IRVINE, CA 92612-7132

**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

APPLICANT: dPackaging LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

bkolegraff@twtlaw.com

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's<sup>1</sup> final refusal to register the trademark DIGITAL REAL ESTATE on the Principal Register under Section 2(e)(1) of the Trademark Act for "a retail space for technology driven brands to showcase product and service offerings and to enable consumers to directly interact with and experience the brand, products, and services, namely, providing

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<sup>1</sup> The Office has reassigned this application to the undersigned trademark examining attorney.

a live forum for companies to showcase, display, demonstrate and promote new and innovative ideas, products and services in the technology field; advertising and showcasing the goods and services of others by providing a set of retail outlets in close proximity featuring goods and services that are offered for on-line sale” in Class 35. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because the proposed mark merely describes a feature and/or characteristic of the applicant’s services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

#### FACTS

On July 13, 2014, the applicant filed the application at issue to register the mark DIGITAL REAL ESTATE, alleging intent-to-use in commerce under Trademark Act Section 1(b) for “a retail space for technology driven brands to showcase product and service offerings and to enable consumers to directly interact with and experience the brand, products, and services; a set of retail outlets in close proximity for displaying and advertising goods and services that are offered for on-line sale” in Class 35.

The examining attorney issued an Office Action on September 8, 2014 refusing the mark for being merely descriptive under Trademark Act Section 2(e)(1) and also finding the identification of services indefinite and requiring clarification. Additionally, the examining attorney included a Supplemental Register advisory, notifying the applicant that amendment to the Supplemental Register would only be available after an acceptable Amendment to Allege Use was filed.

On March 9, 2015, the applicant responded to the Office Action with arguments against finding the mark merely descriptive under Trademark Act Section 2(e)(1) and also accepting the examining attorney's suggested amendment to the identification of services. The applicant did not file an Amendment to Allege Use or otherwise request amendment to the Supplemental Register.

On May 5, 2015, the examining attorney issued a Final Office Action stating that the mark is merely descriptive of applicant's services under Trademark Act Section 2(e)(1) and finding the applicant's arguments unpersuasive.

The applicant filed its Appeal Brief on January 4, 2016.

#### ISSUE

The sole issue for consideration before the Board is whether the mark, DIGITAL REAL ESTATE, is merely descriptive of a feature and/or characteristic of the applicant's services under Trademark Act Section 2(e)(1).

#### ARGUMENT

**I. THE MARK, DIGITAL REAL ESTATE, IS MERELY DESCRIPTIVE OF A FEATURE OR CHARACTERISTIC OF APPLICANT'S SERVICES UNDER TRADEMARK ACT SECTION 2(e)(1).**

Registration is refused because the applied-for mark merely describes a feature or characteristic of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b),

1209.03 *et seq.* *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)).

The determination of whether a mark is merely descriptive is made in relation to an applicant’s services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b).

**A. The Wording DIGITAL REAL ESTATE is Descriptive of Applicant’s Services.**

The combination of descriptive terms in the applicant’s mark describes a feature or characteristic of applicant’s services. The term “digital” is defined as “storing information such as sound or pictures as numbers or electronic signals,” “relating to or used in e-commerce (...buying and selling goods on the internet),” and “using or characterized by computer technology.” *Macmillan Dictionary Online*, search of “digital,” [www.macmillandictionary.com/dictionary/american/digital](http://www.macmillandictionary.com/dictionary/american/digital) (September 8, 2014) (attached to September 8, 2014 Office Action); *Merriam-Webster Dictionary Online*, search of “digital,” [www.merriam-webster.com/dictionary/digital](http://www.merriam-webster.com/dictionary/digital) (September 8, 2014) (attached to September 8, 2014 Office Action). “Real estate” is defined as both “land and the buildings on it” and “something that someone owns or can make money from, especially online.” *Macmillan Dictionary Online*, search of “real estate,” [www.macmillandictionary.com/dictionary/american/real-estate](http://www.macmillandictionary.com/dictionary/american/real-estate) (September 8, 2014) (attached to September 8, 2014 Office Action). When these terms are combined, the term “digital real estate” describes online space. *See* attached evidence from various websites describing investing in “digital real estate.”

The applicant’s amended services are “a retail space [...] and [...] providing a set of retail outlets in close proximity featuring goods and services that are offered online for sale.” *See* application.

“Digital” describes the nature of the “real estate,” (i.e., this is “electronic” real estate – an online marketplace). Taken in consideration of applicant’s identification of services, “digital real estate” clearly describes online retail space.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression.”)

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

The applicant argues that the mark DIGITAL REAL ESTATE is not descriptive, but suggestive. *See Applicant’s Appeal Brief*, p. 5, January 4, 2016. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the services described in the mark; whereas a descriptive term immediately and directly conveys some information about the services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a). In this case, the very definitions of the terms that make up applicant’s mark directly convey information about applicant’s services.

**B. Descriptiveness of the Wording DIGITAL REAL ESTATE is Supported by Common Use Amongst Relevant Consumers.**

The trademark examining attorney provided numerous examples in the Final Office Action of third-party usage of the term “digital real estate.” See Final Office Action, p. 1, May 5, 2015. The previously attached websites demonstrate the usage of this wording, and the excerpts below, as provided in the Final Office Action, highlight the mark being used in a descriptive manner.

“And **digital real estate** is serious business. It gives companies and individuals the chance to build a platform, get heard, and above all, make money online.”

<http://flippa.com/blog/digital-real-estate/>

“That Land’s Empty O’er There! Should You Buy or Build **Digital Real Estate**?”

<http://www.brightervision.com/finding-websites-to-buy/>

“Why you should invest in **digital real estate.**” <http://www.lyopia.com/2014/01/why-you-should-invest-in-digital-real.html>

In response to these examples, applicant further argues that the examining attorney misunderstood the identified services to mean “space on the internet.” See Applicant’s Appeal Brief, p. 5, January 4, 2016. Applicant’s identification of services, however, encompasses both brick and mortar retail space as well as online retail space. Applicant never amended the identification of services to exclude online retail space. Even if the identified services were to be interpreted in such a fashion as applicant suggests, it does not avoid a finding of the mark being merely descriptive of applicant’s services. The term “digital” is merely descriptive of the products and services applicant intends to “showcase, display, demonstrate, and promote,” as the products and services are, in applicant’s own words, in the technology field. See identification of services in Application. Furthermore, applicant provides in the identification of services that these goods and services are to be offered “online for sale,” which is within the “relating to or used in e-commerce” definition of digital. *Id.* The term “real

estate” is merely descriptive of the “retail space” and “retail outlets” in which applicant intends to provide its services, including space online. Accordingly, when these terms are combined, the mark as a whole is descriptive of the applicant’s services.

Regardless of whether the services involve space on the internet or a physical location, the fact remains that the mark as a whole is merely descriptive of the service applicant offers. Specifically, “real estate” describes applicant’s offering of “a retail space” because “real estate” is defined as “land and the buildings on it” and also as “something that someone owns or can make money from, especially online.” Furthermore, “digital” describes the nature of the business being conducted as part of applicant’s services, namely, “technology driven brands,” and “products and services in the technology field” because “digital” is defined as “relating to or used in e-commerce” and also means “using or characterized by computer technology.” Accordingly, the interpretation of whether applicant’s services involve space on the internet or a physical location is immaterial to the determination of descriptiveness.

Accordingly, the mark DIGITAL REAL ESTATE is merely descriptive of retail space and advertising and showcasing the goods and services of others. Thus, the mark should be refused under Trademark Act Section 2(e)(1) because it merely describes the basic nature of applicant’s online services.

#### CONCLUSION

As illustrated by the evidence of record, the proposed mark, DIGITAL REAL ESTATE, is merely descriptive of a feature and/or characteristic of the applicant’s services in Class 35. The commercial impression of the mark corresponds with the accepted definitions of the terms, and the use of the terms in the mark describes applicant’s services. Therefore, when the mark is analyzed as a whole in relation

to the applicant's services, it is merely descriptive of a feature and/or characteristic of the applicant's services, and thus cannot be registered as a trademark on the Principal Register. Accordingly, the trademark examining attorney respectfully requests that the refusal to register the applicant's mark, DIGITAL REAL ESTATE, under Trademark Act Section 2(e)(1) be affirmed.

Respectfully submitted,

/Jason R. Nehmer/

Examining Attorney

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Michael W. Baird

Managing Attorney

Law Office 121



## Why Smart People Invest in Digital Real Estate

DECEMBER 18, 2013 OLLE LINDHOLM ENTREPRENEURSHIP, GETTING STARTED, LEARNING 7 COMMENTS 0



Photo courtesy: Cheryl

I overheard this interesting conversation at the Flippa HQ the other day.

"I've already parked my kid's domain name. It's all set."

"Great. You can give it to him when he's 21. It'll be worth more than a car!"

OK, maybe not, but you have to forgive us. We can't help but to obsess over [websites](#), [domains](#), and [apps](#) here at Flippa. It's just so much fun.

The future is digital. The future is now. And digital real estate is serious business. It gives companies and individuals the chance to build a platform, get heard, and above all, make money online.

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Do you have your own piece of land? Here's why it's the best investment you can make for 2014.

## 1. Become Your Own Landlord

My grandmother always used to say that it's better to own a house than to rent it.

In fact, there's a lot of "renting" going on online. Just think about Facebook, Twitter and LinkedIn. You provide them with your private details and they give you a "free" space to interact with your friends, followers, and colleagues.

Why not spend more time and energy on *your own* property?

**Bottom line:** It's not a good idea to build your entire business on someone else's land.

Copyblogger calls this practice [digital sharecropping](#), and it works in a similar fashion to the [feudal system](#), where the landlords reap the rewards, and the peasants do all the work.

We don't know which empires will stand strong in the future. Facebook, Twitter and LinkedIn change their terms and conditions on a regular basis, and as tenants, we don't know what they have in store for us.

Empires rise and fall, and that is true for the online world as well. Remember what happened to Squidoo and MySpace? These places are still active, but they're not nearly as powerful as they once used to be.

So, why not buy your own digital land and start creating your online assets right now?

We've seen it happen again and again here on Flippa. Smart, motivated people invest in [websites](#), [domains](#), and [apps](#). They see an opportunity to make better use of the land, which the previous owner had missed, or didn't have the time to do something about.

Jon Yau, [the buyer of StockPhoto.com](#), is a great example of someone who not only sees the value in digital real estate, but is also determined to make his new land work for him and his business goals. Heck, he even convinced his wife it was worth the \$250,000 investment.

Digital properties are here to stay. Are you missing out?

## 2. Choose Your Own Lifestyle

Yes, a full-blown website requires maintenance, but it's not as much physical labor as looking after a block of land and a house. You decide how far you want to take your website, domain or app. How much you want to work on it.

You choose the what, where, and how. You choose your own lifestyle.

State of the Market

Uncategorized

Website Optimisation

Websites

Websites for Sale

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...the chance to make, more, and more. ...the chance just with energy.

You can access your digital asset from anywhere in the world, as long as you have a decent internet connection. And this is what makes it so much easier and valuable to own digital properties.

Forget spending three hours in a car to get to your summer house – your digital assets travel with you. They don't care if you're in sunny Australia or snowy Sweden!

### 3. Make Money with Your Land

Of course, you can make money from your digital property. After all, that's the dream. Whether you want to spend more time with your family or quit your day job, your digital properties can help you achieve that.

Obviously, it's a lot of work, but [it is doable](#). The sad truth is if you don't own any digital property you're not even in the game.

Owning your own land is the most efficient way to make money online because *you* reap the rewards. Whether it be through advertising, selling your own services and products or becoming an affiliate for someone else's product, precious digital real estate can help you earn more money.

### Over to You

A block of land is always a block of land. No matter how virtual it is, the land is still yours to use in any way you choose. The question is what you will use it for. To establish your [latest startup](#)? To grow your online portfolio? To give to your children on their 21st?

In the digital age, your websites, domains, and apps are your most valuable business asset. What's stopping you from investing in digital real estate? And how do you plan to make your land more valuable in 2014? Please share your thoughts in the comments.

**P.S. Become your own landlord today by buying your next [website](#), [domain](#), or [app](#) right here on Flippa.**

RECOMMENDED READING



About Author: Olle Lindholm

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Max · 2 years ago

Older but wiser is 100% spot on. The only people who will consistently make money are those who profit from selling those dreams. Registrars and auction sites such as this one.

Domain names are infinite. Granted good domain names are far rarer. But who thought facebook Google or twitter were good domains? Those companies made them good domains. Only LinkedIn is a good domain by itself.

Btw the title is very condescending that it is stupid not to have it. I think it is stupid to pay the stupid high flippant fees. :)

10 | Reply · Share



Older but Wiser · 2 years ago

Digital real estate is a huge call if you hope not to lose all your money.

Land on Planet Earth is finite. Business ideas, sourced from the human imagination are infinite.

Land is permanent. Business ideas regularly get wipeout in processes like Darwinian evolution and simply being ripped off.

Land is protected by a state run system of land title. Business ideas have no such system of protected ownership; especially on the globalised internet in which national boundaries cease to exist.

Most of the land that existed 50 years ago still has the same relative value today. Many of the blue chip businesses from 50 years ago have long since disappeared.

from 50 years ago have long since disappeared.

Land is for wealth protection. Buy a business only if you have the confidence to surf the waves of change.

5 | · [Reply](#) · [Share](#)



**Karl Hensel** · 2 years ago

I believe that consumers today do not have the fixation on .com as the oldtimers do. They will be dethroned and all extensions will be considered equal

1 | · [Reply](#) · [Share](#)



**Parley** · 4 months ago

This has to be approved by flipa to say what i feel about digital real estate??? WOW!!!!

| · [Reply](#) · [Share](#)



**Parley** · 4 months ago

Domainers, auction houses and domaining websites sure have a way with words that would lead u to believe u should be investing in domain names, and that everyone are selling these said domains for LOTS of money, but if they believed in that why wouldnt they charge u on the backend instead of getting your money up front whether you sell your domain or not?? Theyre in it for the money and are great "salesmen"

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**Kaloyan Baney** · 2 years ago

Can't agree more with this statement. Absolutely true! I doubt that Internet will ever die. Internet is not only the new form of entertainment, but the best source of knowledge and excellent business environment.

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**Peter Mead** · 2 years ago

Certainly there is value in a website or a domain name with the right attributes. A premium aged domain name, is worth a lot for good reasons. Put a great income positive website on that premium domain, there is great value.

These things do not fall down in the last shower, they take time and rely on quality and investments.

Who would not want to own a premium money making website?

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# Anything Domain For Beginners

Welcome to Lyopia - Anything Domain for Beginners blog! Here you will find free information on domaining and establishing your online presence, whether is it for business or personal.

Beef up your business.



Monday, 13 January 2014

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## Why You Should Invest In Digital Real Estate

Welcome 2014! It's gonna be a great year for me. I am passionate about digital real estate. Why? Because they say that the future is digital. And the future is now.

With the fast-changing internet landscape and the digital era we are in, having an internet address becomes necessary.

Having your own domain name and a website is like building your own home - virtual home - on the internet. The domain name is the property address. Your website is the digital property. Your property can be a shop, a home where you share your thoughts, photos and videos or a place where you simply connect with other people.

Physically, land is scarce and the cost of properties are ever-increasing. Starting a business required capital and it also has its own challenges. One can reach more people online on the internet than offline. That is why smart people are turning to the internet to take their businesses to the next level.

Not only that but more and more people are investing in digital real estate. They are investing in domain names, websites and apps. Buying your own domain name and developing your own property (website) is better than renting from someone else. Though this will require some effort, it is not too expensive and labor-intensive as developing a physical property.

This year, I will give my best shot in being consistent in updating this blog to provide free information and resources that will assist you purchase your own piece of land on the internet and developing your digital real estate. If you are a new domainer starting our investing in virtual properties, this blog is especially for you.

I hope the information provided here is of help.

Happy Investing in Digital Real Estate!

Posted by Kejanmy at 04:22

Recommend this on Google

Labels: buy domain names, digital real estate, domain names, invest, investing, properties, real estate, virtual

8 comments:

Raveles Mateo 20 February 2014 at 07:55

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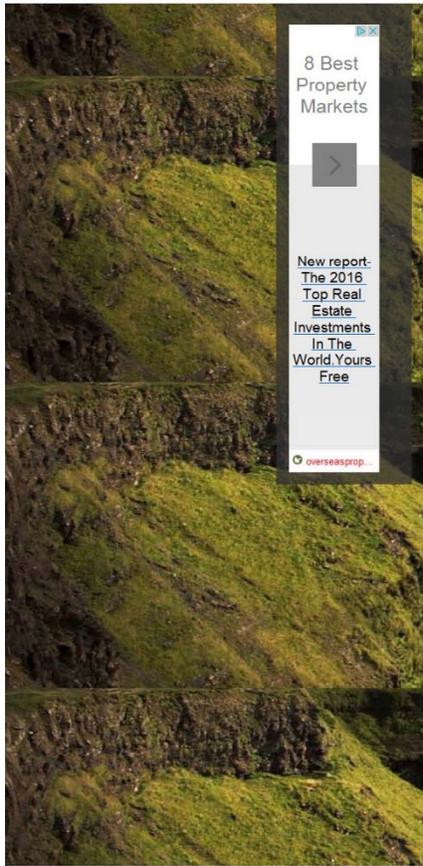
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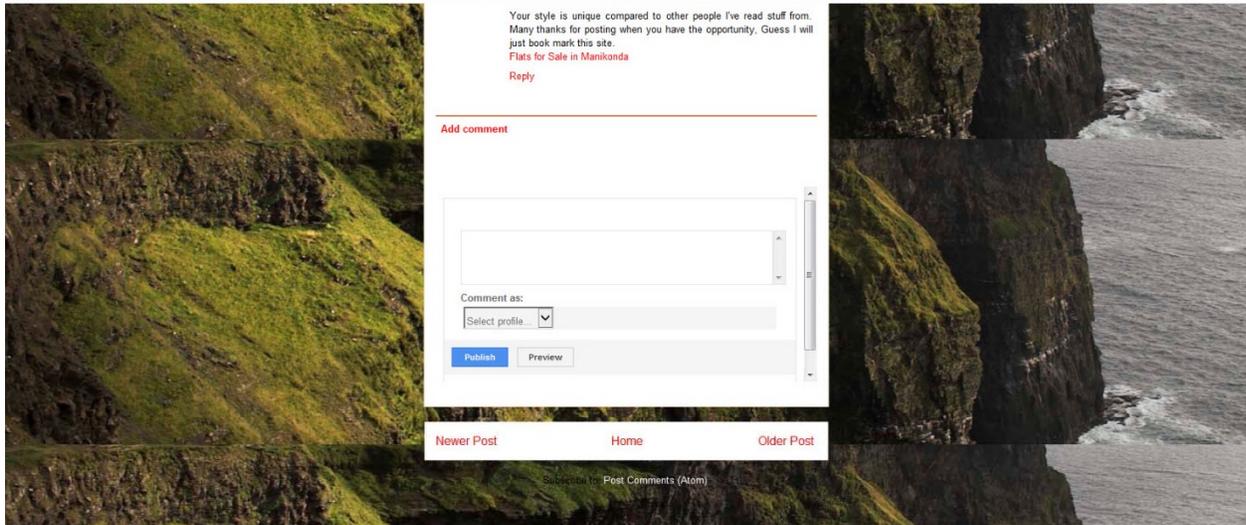
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- Raveles Mateo** 20 February 2014 at 07:55  
Digital real estate helps us to have our Real Estate Investments market more better. The best that we can get is all right under the digital era nowadays. We should learn everything on how we can succeed on our investment and that is what will help us control our business well for our future.  
<http://www.realestateinvestment-australia.com.au/>  
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- Anton Rey** 5 March 2014 at 02:56  
That is very interesting. You are an excessively professional. I am searching a great post related to real-estate and property business. thanks  
[Residential Property Alpine](#)  
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- Someone Critique** 4 April 2014 at 00:22  
I believe that planning is the best way to keep your property investment stable. Make use of your time well and make efficient. Planning helps you do things in a rightly manner.  
[Rancho Palos Verdes Certified Home Inspector](#)  
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- Jason Simpson** 19 April 2014 at 04:37  
Thanks for taking the time to discuss this, I feel strongly about it and love learning more on this topic.  
[USA property investing](#)  
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- Mateo Koales** 15 September 2014 at 07:54  
*This comment has been removed by the author.*  
[Reply](#)
- Tony Stark** 10 December 2014 at 02:32  
It is a well constructed article. As the article suggests, I too have invested in digital real estate. I registered my domain name and got the hosting service for my website from [TuckTail.com](#) at low cost with 24/7 customer support. I am satisfied with their services.  
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- Raju Kumar** 13 January 2016 at 02:44

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## That Land's Empty O'er There! Should You Buy or Build Digital Real Estate?

June 17, 2013 by [Perry Rosenbloom](#) 2 Comments

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Should you buy or build a website? Here's my experience in buying or building a niche website, my recommendations & strategies for finding websites to buy.

Once again, I've got the itch—The itch to get involved in a new niche. I'm not 100% sure which I'm going to tackle, but I have a pretty good idea.

After my success with [Bicycle Touring Guide](#), I realized it's important to weigh all your options

