

This Opinion is not a  
Precedent of the TTAB

Mailed: May 10, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Packaging 22, LLC*

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Serial No. 86212977

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William J. Kolegraff, Esq.  
for Packaging 22, LLC.

Khanh M. Le, Trademark Examining Attorney, Law Office 116,  
Christine Cooper, Managing Attorney.

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Before Quinn, Adlin and Lynch,  
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Packaging 22, LLC (“Applicant”) seeks registration on the Principal Register of the proposed mark DIGITAL BOOTH (in standard characters) for “metal phone booths” in International Class 6.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86212977, filed March 6, 2014 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on its allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark, when applied to Applicant's goods, is merely descriptive thereof.

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

We affirm.

The Examining Attorney maintains that the proposed mark is merely descriptive of a feature and intended use of the goods. More specifically, the Examining Attorney contends that DIGITAL BOOTH describes booths that will feature digital computer technology in providing voice over IP ("VoIP") telephone services. The Examining Attorney introduced dictionary definitions of the word "digital" and "VoIP," and excerpts of third-party websites. The Examining Attorney, in the appeal brief, also relies on a definition of "booth," of which we take judicial notice.<sup>2</sup>

Applicant argues that the mark is only suggestive, stating that "there is nothing digital about a metal phone booth," and that it requires several intellectual steps and mature thought to articulate how the booths might be used. (4 TTABVUE 7). Applicant goes on to contend that the Examining Attorney "has to stretch long and hard to make the rejection, somehow linking 'digital' to 'phone calls' and then to 'transmission' and finally finding that descriptive of how the booth might ultimately be used." *Id.* The only link between the mark and the goods, Applicant asserts, is that

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<sup>2</sup> The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

the booth may incorporate electronic equipment that operates with communication devices that use a digital format. Applicant also argues that its mark is incongruous:

Here the mark “Digital Booth” has a strong incongruity. “Booth” is something tangible, physical, and of low technology. “Digital” denotes modern, high tech, and something ephemeral. Something that is a “booth” is [sic] cannot be “digital.” And something “digital” cannot be a physical “booth.” Read together, the mark “digital booth” is nonsensical and means nothing unless mature reasoning and thought is used.

(4 TTABVUE 8-9). Applicant, in its brief, relies upon a dictionary definition of “digital,” of which we take judicial notice.

A term is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in

connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the relevant marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the goods listed in the identification. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012), quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation to the services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 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). *See also 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, Inc.*, 64 USPQ2d at 1318 (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). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for “bakery products”); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”). “If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what characteristics the term identifies, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also In re Shutts*, 217 USPQ at 364-365; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

The word “digital” means, in relevant part, “using or characterized by computer technology.” (www.merriam-webster.com, Office action, 6/13/14). Another definition reads “available in electronic form; pertaining to, noting, or making use of computers and computerized technologies, including the Internet.” (www.dictionary.com, judicial notice in Applicant’s brief). The word “booth” is defined as “a small, often enclosed compartment, usually accommodating only one person; a voting booth.” (www.ahdictionary.com). The term “VoIP” is defined as follows:

Stands for “Voice Over Internet Protocol,” and is often pronounced “voip.” VoIP is basically a telephone connection over the Internet. The data is sent digitally, using the Internet Protocol (IP) instead of analog telephone lines.

VoIP is also referred to as IP telephony, Internet telephony, and digital phone.  
(www.techterms.com)

In response to the Examining Attorney’s request under Trademark Rule 2.61(b),

Applicant submitted the following response and image:

**REQUEST FOR INFORMATION** The applicant has attached example pictures of the expected booth structure. **EXAMINER QUESTIONS** Do the goods consist of digital telephones? No, the goods have been narrowed to be only metal phone booths. Do the goods feature or include digital telephones? As illustrated by the pictures, the booth is anticipated to have a voice handset that in cooperation with a computer touch screen will provide voice-over-ip telephone service.



(Response, March 16, 2015).

Also of record are excerpts of third-party websites showing a variety of booths featuring VoIP technology for the digital transmission of telephone calls. (Office action, 4/1/15).

The GLCyberBooth solution enables service providers to use voice over IP (VoIP) technology to deploy long distance telephony services easily and cost efficiently in various locations such as in-store phone booths, call shops or internet cafes. It combines all the benefits of a traditional phone booth service with the affordability and portability of VoIP technology.  
([www.groupofgl.com](http://www.groupofgl.com))

If you own telephone booth(s) or Internet Cafe(s), our VoIP solution value-add service is [the] right choice for you. With minimum investment, our low rates and volume discount will increase your profitability.  
([www.seawolftech.com](http://www.seawolftech.com))

Gallaudet University, the nation's premiere school for the deaf, turned to VoIP for its phone system, for its speech to text implementation, for trying video phone booths around campus, and to see whether wideband VoIP can lead to better speech understanding.  
([www.von.org](http://www.von.org))

Callspice platform [sic] purpose is deployment of VoIP telephone booths with the support of hospitality services. (www.callspice.com)

Google Voice Phone Booths To Start Popping Up In Airports, Universities  
[I]t announced the launch of phone calls and Google Voice integration into Gmail, the company disclosed that it's going to begin installing Google Voice telephone booths into universities and airports. (www.techcrunch.com)

When the terms “digital” and “booth” are combined “the mark[s] as a whole, i.e., the combination of the individual parts,” does not convey “any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *In re Oppedahl & Larson*, 71 USPQ2d at 1372. To the contrary, from “the perspective of a prospective purchaser or user” of Applicant’s goods, “because ... the combination of the terms does not result in a composite that alters the meaning of [any] of the elements ... refusal on the ground of descriptiveness is appropriate.” *In re Petroglyph Games*, 91 USPQ2d at 1341. There is nothing incongruous about the proposed mark; rather, the mark as a whole immediately describes a purpose or function of the goods, that is, the phone booth is designed and built to house digital technology, namely a VoIP phone. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1757 (SNAP SIMPLY SAFER merely descriptive for “medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes”); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (GROUP SALES BOX OFFICE 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).

The third-party websites show that phone booths now employ digital phone technology, commonly referred to as VoIP. Applicant's information indicates that its booth will be used to house such technology, thus the goods are a "digital booth." On this record, we conclude that consumers familiar with Applicant's goods would immediately understand, upon seeing Applicant's proposed mark, that the goods are designed and built to house a digital telephone. No imagination or thought is required by a prospective purchaser to discern that a significant purpose or feature of Applicant's "metal phone booths" is use with digital technology, namely VoIP. Furthermore, Applicant's competitors who also might offer similar goods should have the opportunity to use the term "digital booth" or variations thereof to explain the purpose or function of their goods. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1920-21 (TTAB 1998), *aff'd*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Abcor Development*, 200 USPQ at 217 ("The major reasons for not protecting [merely descriptive] marks are ... to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products."). The fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012).

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Accordingly, we find that the proposed composite mark DIGITAL BOOTH is merely descriptive of Applicant's "metal phone booths."

**Decision:** The refusal to register is affirmed.