

This Opinion is Not a
Precedent of the TTAB

Mailed: December 28, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Tod Reed Arbutina
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Serial No. 88219477
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John W. McIlvaine of The Webb Law Firm,
for Tod Reed Arbutina.

Jonathan R. Falk, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

—
Before Thurmon, Deputy Chief Administrative Trademark Judge, and Greenbaum
and Johnson, Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

I. Background

Tod Reed Arbutina (“Applicant”) seeks registration on the Principal Register of
the mark DIGITAL ASSET COOPERATIVE (CO-OP),¹ in standard characters (“the

¹ Application Serial No. 88219477, filed on December 6, 2018, under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to
use the mark in commerce.

Page references to the application record are to the downloadable .pdf version of the United
States Patent and Trademark Office’s (“USPTO” or “Office”) Trademark Status & Document
Retrieval (TSDR) system. Citations to the briefs on appeal are to TTABVUE, the Board’s
online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB
2014). Specifically, the number preceding TTABVUE corresponds to the docket entry

Applied-For Mark”), as a mark for “cooperative advertising and marketing services for advertising members’ shared digital assets in virtual e-commerce marketplaces in exchange for subscriber revenues and any other direct or in-direct forms of payment,” in International Class 35.

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 the Applied-For Mark is merely descriptive of Applicant’s services.² Applicant filed a Request for Reconsideration³, and the Examining Attorney denied the request. Nearly three months later, Applicant filed a Notice of Appeal⁴. The case has been briefed. We affirm the refusal.

II. Law, Evidence, and Analysis

A. Mere Descriptiveness

Section 2(e)(1) of the Trademark Act prohibits the registration of a mark which, when used on or in connection with an applicant’s goods or services, is merely descriptive of them. “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102

number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

² Examining Attorney’s Brief, 6 TTABVUE 3.

³ March 3, 2020 Request for Reconsideration After Final Action at 1-4.

⁴ Notice of Appeal, 1 TTABVUE. The next day, Applicant filed a Petition to the Director “to Revive an Abandoned Application for failure to timely respond to an Office Action due to the COVID-19 outbreak.” June 2, 2020 Petition to Director at 1-7. The petition was dismissed several months later. Nov. 4, 2020 Petition Decision at 1-2.

USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Descriptiveness is analyzed in relation to an applicant's identified goods or services, “the context in which the [term] is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use”; that a term may have other meanings in different contexts is not controlling. *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. And, descriptiveness is not considered in the abstract. *Id.* The question is whether someone who knows what the goods or services are will understand the term to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

As here, when two or more merely descriptive terms are combined, the determination of whether the composite mark is also merely descriptive 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 or 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, 1372, 1374 (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).

The Examining Attorney argues that the term “digital asset cooperative” is merely descriptive of Applicant’s identified services because it immediately conveys knowledge about a feature or the subject matter of Applicant’s services, specifically that the “wording merely describes the purpose of applicant’s services, a cooperative enterprise for collective advertising of the members’ digital assets.”⁵ In contrast, Applicant contends that “digital asset cooperative” is not merely descriptive because the term is used for “a platform in which a client’s digital assets can be collectively maintained and managed,” and because the term is rendered “incongruous or unique” by combining the elements “digital asset” and “cooperative.”⁶

B. Evidence

In order to determine whether the Applied-For Mark is merely descriptive, we must evaluate the evidence. The Examining Attorney proffered a Wikipedia page and dictionary definitions to show that “digital asset cooperative” describes the fundamental purpose of Applicant’s services. Specifically, “digital asset” is defined in Wikipedia as “anything that exists in a binary format and comes with the right to

⁵ Examining Attorney’s Brief, 6 TTABVUE 6.

⁶ Applicant’s Appeal Brief, 4 TTABVUE 7.

use,”⁷ and cooperative, abbreviated as “co-op,”⁸ is defined in the AMERICAN HERITAGE DICTIONARY as “an enterprise or organization that is owned or managed jointly by those who use its facilities or services.”⁹

The Examining Attorney also submitted blogs, articles, and abstracts from Internet web sites that discuss “digital assets” and the cooperative marketing and management of them in a variety of industries.

- From MediaValet.com:

Many people consider digital assets to only include photos and videos, but over the years, others have started including other digital files in their definition, such as documents, presentations, and spreadsheets. ... [I]t’s important to remember that the file format is only part of the definition. The other portion ... is derived from the value the asset brings to the company.¹⁰

⁷ March 13, 2019 Office Action at 3 (citing https://en.wikipedia.org/wiki/Digital_asset). Regarding evidence from Wikipedia, we note that “[t]he Board gives guarded consideration to evidence taken from Wikipedia, bearing in mind the limitations inherent in this reference work, so long as the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question.” *In re Hinton*, 116 USPQ2d 1051, 1053 n.10 (TTAB 2015); *see also In re Swatch Group Management Services AG*, 110 USPQ2d 1751, 1754 n.4 (TTAB 2014) (Board considered Wikipedia evidence submitted with examining attorney’s first office action, which applicant had an opportunity to rebut); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.03 (2020). Here, Applicant also cites the Wikipedia page for the term “digital asset,” so we consider the Wikipedia evidence for whatever probative value it may have.

⁸ We take judicial notice of “co-op” as an abbreviation for “a cooperative.” THE AMERICAN HERITAGE DICTIONARY (2020) (<https://ahdictionary.com/word/search.html?q=co-op>) (last accessed Dec. 15, 2020). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁹ March 13, 2019 Office Action at 2 (citing THE AMERICAN HERITAGE DICTIONARY, <https://www.ahdictionary.com/word/search.html?q=cooperative>).

¹⁰ *Id.* at 7 (*What is a Digital Asset?*, <https://www.mediavalet.com/blog/what-is-a-digital-asset-2/>).

- From Researchgate.net:

In this paper we present a series of activities carried out within the National Research Council of Italy (CNR) and aimed at the development of a unique, certified and open archive of CNR's digital research products ... we then briefly talk about OA issues and the role played by CNR's Information System Office in providing technological tools for **digital asset management** ... We then talk about the solution we propose for the development of a unique, certified and open archive using a **cooperative** approach that takes into account previous experiences, existing repositories, policy and organizational issues.¹¹ (emphasis added)

- From SproutLoud, a “Through Channel Marketing Automation” company focusing on digital marketing platforms utilizing co-op marketing and payment solutions: “An outdated Digital Asset Management tool can derail even the most effective National-to-Local Marketing strategy. When it becomes a bottleneck for local marketing tasks or a deterrent keeping partner networks from participating in brand-preferred Co-Op Advertising campaigns, it’s time to look for an upgrade.”¹²
- From JGSullivan Interactive, a company offering digital marketing management solutions combined with co-op management of marketing and

¹¹ Oct. 4, 2019 Final Office Action at 4 (Maurizio Lancia et al., *Cooperative Digital Asset Management in the Scientific Field: Strategies, Policies, Interoperability and Persistent Identifiers*, in A KEYPHRASE-BASED PAPER RECOMMENDER SYSTEM pp. 144-59 (located at https://www.researchgate.net/publication/221333894_Cooperative_Digital_Asset_Management_in_the_Scientific_Field_Strategies_Policies_Interoperability_and_Persistent_Identifiers) (abstract)).

¹² *Id.* at 5 (Elizabeth Vempala, *Is Your Digital Asset Management Tool Right for Your Partners?*, SPROUTLOUD (last visited Dec. 17, 2020), <https://sproutloud.com/blogs/is-your-digital-asset-management-tool-right-for-your-partners>).

payment processes: “Corporate ad budgets are shrinking every year and every co-op dollar is more important than ever. ... JG Sullivan’s marcom portal with integrated ad builder, digital asset management, and co-op system is the winning solution to lock down the entire local marketing process.”¹³

- From the Interactive Advertising Bureau, an industry trade group focused on digital ad marketing: “Internet advertising brings with it a range of new challenges ... Offering guidance on next steps in digital gaining a foothold in the sector, ‘Co-Op Advertising: Digital’s Lost Opportunity?’ provides recommendations to meet those challenges head on”¹⁴
- From F&I and Showroom Magazine, an automotive retail and finance industry trade publication:

Digital asset management systems (DAMs) once had promise. Unfortunately, they suffer from low adoption rates, fail to engage dealers, and can’t build out a localized marketing campaign. ... Trends point to the eventual elimination of the standard co-op model in favor of a dealer-centric, digital-friendly alternative.¹⁵

In support of his position, Applicant, who also cited the Wikipedia page for “digital asset,”¹⁶ proffered a link to Nolo.com’s encyclopedia page that discusses “digital assets”:

¹³ *Id.* at 6 (*Co-Op Management*, <https://www.jgsullivan.com/our-technology/co-op-management/>).

¹⁴ *Id.* at 7 (<https://www.iab.com/insights/co-op-advertising-digitals-lost-opportunity-a-new-study-by-iab-local-search-association/>).

¹⁵ *Id.* at 8-14 (Ben Carcio, *Time to Reimagine Co-Op Marketing*, F&I AND SHOWROOM (Mar. 8, 2018), <https://www.fi-magazine.com/311124/time-to-reimagine-co-op-marketing>).

¹⁶ Sept. 13, 2019 Response to Office Action at 1; *see also supra* p. 4.

Technically speaking, digital assets are any “electronic record” that you own, license, or control. This includes just about any online account or digital file that you have authority to access – email, online banking, social media accounts, cloud storage, blogs, and just about anything else that you do online, on your phone, or on your computer that requires a login.¹⁷

C. Analysis

Based on the evidence of record, the Applied-For Mark, DIGITAL ASSET COOPERATIVE (CO-OP), is merely descriptive of “cooperative advertising and marketing services for advertising members’ shared digital assets in virtual e-commerce marketplaces in exchange for subscriber revenues and any other direct or in-direct forms of payment.”

The record establishes that “digital asset” is an expansive term encompassing “anything that exists in a binary format and comes with the right to use.” The term incorporates photos, videos, documents, presentations, spreadsheets, email, online banking, social media accounts, cloud storage, blogs, and “just about anything else that you do online, on your phone, or on your computer that requires a login.”

The record also establishes that a “cooperative,” or “co-op,” is “an enterprise or organization that is owned or managed jointly by those who use its facilities or services.” So, when they see the term “Cooperative (CO-OP),” used with “Digital Asset,” consumers are likely to think that digital assets are jointly, or cooperatively, managed. The record includes evidence from digital asset management firms, trade

¹⁷ Sept. 13, 2019 Response to Office Action at 1 (citing <https://www.nolo.com/legal-encyclopedia/what-are-digital-assets.html> (last accessed Dec. 17, 2020)).

organizations, trade publications, blogs, and a research abstract showing the use of “CO-OP” or “cooperative” in connection with “digital asset.” This type of evidence can signal that a term is merely descriptive. *Cf. In re Recreational Equipment, Inc.*, 2020 USPQ2d 11386, at *5 (TTAB 2020) (without any evidence, the record does not support a finding that the mark CO-OP is merely descriptive of the goods claimed in the application) (citing *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979) (identifying types of evidence useful in determining consumer perception, such as purchaser testimony, consumer surveys, and listings in dictionaries, trade journals, newspapers and other publications)).

Applicant contends that the Examining Attorney has failed to supply any evidence that DIGITAL ASSET COOPERATIVE (CO-OP) is used in conjunction with what Applicant describes as “a platform in which a client’s digital assets can be collectively maintained and managed by owner of said mark.”¹⁸ However, a determination of mere descriptiveness must be based on the significance of the terms in connection with the services listed in the identification. Here, the record evidence, as well as the identification itself—which includes the terms “digital asset” and “cooperative”—demonstrate that the Applied-For Mark is merely descriptive of Applicant’s services.

Applicant also contends that the combination of the terms “digital asset” and “cooperative (CO-OP)” results in DIGITAL ASSET COOPERATIVE (CO-OP) being unique, or incongruous.¹⁹ But the terms “digital asset” and “cooperative” retain their

¹⁸ Applicant’s Appeal Brief, 4 TTABVUE 7.

¹⁹ *Id.*

descriptive meanings when combined: basically, the collective management of digital assets. No new or non-descriptive meaning is created by combining the terms, so their composite is merely descriptive and unregistrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); *see also Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1851 (TTAB 2017) (MEDICAL EXTRUSION TECHNOLOGIES merely descriptive of medical extrusion goods produced by using medical extrusion technologies). In fact, here, “cooperative” is used in a non-source identifying way that describes Applicant’s business structure. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.03(d) (Oct. 2018); *cf. In re Recreational Equipment, Inc.*, 2020 WL 11386, at *2, 6, 7 (“co-op” described applicant’s business structure, but without sufficient evidence, proposed mark CO- OP not merely descriptive; no per se rule equating descriptiveness of source with descriptiveness of goods). Generally, a mark composed of combined descriptive terms is registrable only where the combination of such terms creates a unitary mark with a unique, incongruous, or nondescriptive meaning in relation to the services claimed. *In re Oppedahl & Larson LLP*, 71 USPQ2d at 1372, 1374. Again, that principle does not apply to DIGITAL ASSET COOPERATIVE (CO-OP).

III. Conclusion

The record supports a finding that the Applied-For Mark, DIGITAL ASSET COOPERATIVE (CO-OP), immediately conveys to average consumers information about a quality, feature, or characteristic of the services claimed in the application.

Decision: The refusal to register under Section 2(e)(1) is affirmed.