

ESTTA Tracking number: **ESTTA1196954**

Filing date: **03/16/2022**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ex parte appeal no.	90106071
Appellant	The New York Times Company
Applied for mark	THE NEW OLD AGE
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Submission	Appeal brief
Attachments	Applicant Appeal Brief.pdf(796882 bytes)
Appealed classes	Class 016. First Use: Oct 22, 2013 First Use In Commerce: Oct 22, 2013 All goods and services in the class are appealed, namely: Columns on the subject of science, aging, health, and personal finances Class 041. First Use: Jul 3, 2008 First Use In Commerce: Jul 3, 2008 All goods and services in the class are appealed, namely: Providing on-line publications in the nature of articles, columns, and newspapers in the field of science, aging, health, and personal finances
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**IN THE U.S. PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application Serial Nos./Marks:

90106071 for THE NEW OLD AGE
90112154 for A GOOD APPETITE
90112577 for HUGRY CITY
90115155 for WORK FRIEND
90115337 for LIKE A BOSS
90115491for OFF THE SHELF

Applicant: The New York Times Company

Appeal instituted: October 6, 2021

Appeal Brief Due: March 16, 2022

APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

Applicant, The New York Times Company (hereinafter “Applicant”), appeals the Examiners’ final refusal of registration of Applicant’s pending trademark applications that are the subject of this consolidated appeal, namely:

Serial No. 90106071 for THE NEW OLD AGE
Serial No. 90112154 for A GOOD APPETITE
Serial No. 90112577 for HUGRY CITY
Serial No. 90115155 for WORK FRIEND
Serial No. 90115337 for LIKE A BOSS
Serial No. 90115491 for OFF THE SHELF

These applications are collectively referred to herein as “the Applications.”

Applicant additionally notes that action on numerous of Applicant’s other pending trademark applications is suspended pending the outcome of this proceeding because the Board’s decision in this matter will affect the Examining Attorneys’ decisions in those similarly situated applications still in the examination phase.

II. STATEMENT OF THE ISSUE

Whether, under T.M.E.P §1202.07, an Applicant’s independently accessible online/digital newspaper column constitutes a “separate good in trade” for the purposes of obviating a refusal of registration relating to the same mark for a non-syndicated print newspaper column in Class 16 under Sections 1, 2 and 45 of the Lanham Act.

The Board’s decision in this matter will provide much needed guidance for news and content providers because T.M.E.P. §1202.07 *et. seq.* does not expressly address the issue presented. As further explained *infra*, Examining Attorneys have also been very inconsistent in their determinations on this issue, including in the prior applications of Applicant. The Board’s direction is therefore needed.

III. STATEMENT OF RELEVANT FACTS

Applicant filed the Applications around the same time in August 2020. As evidenced in the record, each application identifies print and online publications in Classes 16 and 41. By way of example, Applicant's use-based trademark application for "Work Friend," Serial No. 90115155, identifies the following goods and services:

(Int. Cl. 16) columns on the subject of business, office, money, careers and work-life balance; and

(Int. Cl. 41) providing on-line publications in the nature of articles, columns, and newspapers in the field of business, office, money, careers and work-life balance

In all of Applicant's applications, the Examining Attorneys refused registration of the marks for the goods in Class 16 on the Principal Register on the basis that the goods identified in Class 16 did not constitute a "separate good in trade." For example, the Examining Attorney wrote in the first Office action for the "Work Friend" application dated December 10, 2020:

Registration is refused because the applied-for mark identifies only a portion of applicant's publication and therefore is not used on separate goods in trade. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see* TMEP §§904.07(b), 1202.07(a)(ii). Portions of a periodically-issued printed publication, downloadable publication, or publication recorded on electronic media, such as columns or sections, are integral elements of the complete publication and are therefore generally not considered separate goods in trade. *See* TMEP §§1202.07(a), 1202.07(a)(ii).

Terms adopted to distinguish one portion of a publication from other portions of the same publication function as trademarks only when the particular portion is advertised or promoted separate and apart from the complete publication. *See In re Broad. Publ'ns, Inc.*, 135 USPQ 374, 375 (TTAB 1962) (citing *Ex parte Meredith Publ'g Co.*, 109 USPQ 426, 426 (Comm'r Pats. 1956)). When selecting a periodically-issued publication, purchasers generally rely on the mark identifying the complete publication as a source indicator and are often unfamiliar with column or section titles. *See* TMEP §1202.07(a) (quoting *Ex parte Meredith Publ'g Co.*, 109 USPQ at 426).

Notably, in the Office action dated December 10, 2020, for the "Work Friend" application (and in the corresponding refusals for the other marks at issue), the Examining Attorney invited

Applicant to “submit evidence that the column or section is in fact separate goods in trade” as a means of overcoming the refusal.

In response to these refusals, Applicant responded with evidence that Applicant’s trademarks were indeed separately promoted and used with “separate goods in trade” because the exact same trademarks are used with the online versions of the print columns identified in Class 16. As Applicant explained, in addition to appearing in the print edition of *The New York Times*, the columns are also available through Applicant’s online newspaper -- the online version of *The New York Times* at the URL *nytimes.com*. To further support its position in each application, Applicant provided documentation showing that the newspaper columns can be found and accessed directly through conducting Internet searches on the trademarks (through Google, for example) and clicking on the Internet search result for each mark to access the online version of the column at dedicated pages within the *nytimes.com* website.

In addition to the evidence described above showing that Applicant’s marks were used and promoted in online formats, Applicant provided TESS printouts of Applicant’s already subsisting trademark registrations on the Principal Register that identify both print newspaper columns in Class 16 and online newspaper columns in Class 41. As Applicant explained, the Examining Attorneys for these prior applications did not refuse registration of the marks for the goods in Class 16 under Sections 1, 2 and 45, and Applicant requested that its instant applications be examined in a manner consistent with these previously issued registrations. *See, e.g.*, Reg. No. 4921368 for “Letter of Recommendation,” Registration No. 4921369 for “First Words,” Registration No. 5645457 for “The New New World,” and Reg. No. 6262032 for “Rewind.”

Applicant’s explanations, arguments, and evidence, however, did not persuade the Examining Attorneys to withdraw the initial refusals and the Examining Attorneys subsequently issued “final” Office actions in the Applications. The wording of the final refusals tracked almost

identically with the wording in the first Office actions, and contained only the following additional commentary, as exhibited in the final Office action for the “Work Friend” application issued on April 6, 2021: “Applicant’s evidence does not, however, show that its column is separately sold, syndicated, or offered for syndication. As such, this evidence does not establish that the column constitutes separate goods in trade.” Nonetheless, the Examining Attorney again invited Applicant to “submit evidence that the column or section is in fact separate goods in trade” as means of overcoming the refusal” (emphasis in original).

In response to the final refusals, Applicant filed requests for reconsideration and concurrently filed notices of appeal. In Applicant’s requests for reconsideration (filed, for example, in the “Work Friend” application on October 6, 2021), Applicant submitted additional printouts of Applicant’s online columns bearing the mark, as they appear online through Applicant’s online *The New York Times* publication, and made additional arguments to try and explain the nuance of why Applicant’s online columns were, in fact, the evidence of Applicant’s promotion and use of the same trademark with “separate goods in trade” that the Examining Attorneys were specifically requesting. In this regard, Applicant argued as follows:

In this case, Applicant’s column is separately sold. More specifically, the column is separately sold as part of Applicant’s online version of *The New York Times*. In other words, the fact that Applicant's column also appears online and is accessible by the Internet, in addition to the print edition of *The New York Times*, indicates that Applicant's mark is used with a separate good in trade, *i.e.*, those services identified in Class 41 in this application.

Moreover, Applicant's online use of the column name in Class 41 (a separate good/service as made evident by the different classifications in the Trademark Office) is indeed sold separately because a separate subscription is required for the online or "digital" side of Applicant's publication than Applicant's print newspaper. See attached evidence of same.

(emphasis added).

Notwithstanding that Applicant did submit additional argument and evidence with its Requests for Reconsideration (*e.g.*, additional copies of Applicant’s online columns and evidence

that a separate subscription is required for the “digital” or online portion of Applicant’s publication), the Examining Attorneys largely ignored the argument and evidence and wrote as follows (taken from the Reconsideration denial in the “Work Friend” application):

Applicant has not submitted new evidence, but rather “cites back to its prior response and supporting evidence (Internet search results)”, which applicant contends shows that applicant’s column constitutes “separate goods in trade because the column also appears in an online format.” Applicant asserts that, because a separate subscription is required for the online version of applicant’s publication, the column is a separate good in trade. This argument remains unpersuasive. Applicant has not been refused registration for its Class 41 service of “providing online publications”; it has only been refused registration only for its Class 16 printed, downloadable, or recorded publications. Therefore, its argument regarding its online services are irrelevant.

Additionally, applicant has not provided any evidence that its use of the mark serves to distinguish its column from columns in **other** publications, rather than to distinguish it from columns in **its own** publication. The fact that consumers can purchase its online newspaper without purchasing its print newspaper does not show that the column itself is a separate good in trade, but rather shows that applicant offers its Class 41 services separately from its Class 16 goods. In the case of applicant’s Class 16 goods, to show use of the mark as “separate goods in trade”, applicant would need to show that the column may be purchased without purchasing the entire newspaper. *See In re Broad. Publ’ns*, 135 USPQ 374 (TTAB 1962); *Ex parte Meredith Publ’g*, 109 USPQ 426 (Comm’r Pats. 1956).

Applicant has not shown that its Class 16 goods constitute separate goods in trade, and simply reiterated its previous arguments. Accordingly, the request for reconsideration did not raise a new issue, resolve the outstanding issue, provide new evidence with regard to the outstanding issue, or present new analysis or arguments regarding the outstanding issue and the request for reconsideration is denied.

Following the Examining Attorneys’ denial of Applicant’s Requests for Reconsideration, the Board instituted the relevant appeals. Following Applicant’s motion to consolidate the appeals, the appeals were consolidated on January 10, 2022.

IV. STATEMENT OF LAW AND ARGUMENT

A. Applicant's Class 16 Goods Are Separately Sold

Regarding the refusals of Applicant's goods in Class 16 under Sections 1, 2 and 45, Applicant and the Examining Attorneys for the Applications agree that T.M.E.P § 1202.07(a)(ii) sets forth the standard for determining whether a refusal should issue under Sections 1, 2 and 45:

A column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication is not, in and of itself, considered to be separate goods in trade. Therefore, where the specimen, identification of goods, or other evidence in the record indicates that the mark identifies a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media **that is not separately sold**, syndicated, or offered for syndication, the examining attorney should refuse registration on the Principal Register under Sec. 1, 2, and 45 of the Trademark Act; 15 U.S.C. Sec. 1051, 1052, and 1127, on the ground that the mark is not used on separate goods in trade.

(Emphasis added).

Applicant and the Examiners disagree, however, regarding whether Applicant's online versions of the columns under the same trademark constitute a "separate good in trade" that is "separately sold" under the foregoing section of the T.M.E.P. Applicant also submits that a later section of T.M.E.P. § 1202.07, namely T.M.E.P. § 1202.07(b), offers guidance for addressing trademarks that identify both print and online columns.

As an initial matter, Applicant submits that its Class 16 goods are indeed "separately sold" both because they are separately published through Applicant's online publication at *nytimes.com* and because they require a subscription that is separate from the subscription needed for Applicant's print publication in which the Class 16 goods appear. As a result, readers may independently access those columns either directly through general Internet searches for the column names or through Applicant's *nytimes.com* website home page. In other words, as explained at length in the underlying record, it is Applicant's provision of the online columns (classified in International Class 41) that demonstrates that Applicant's trademarks for the Class

16 goods are used with a separate good in trade – namely the Class 41 services themselves. Accordingly, the “separate goods in trade” are the online versions of the columns – which can be accessed independently through Internet search engines and for which readers must purchase a separate subscription.

As noted *supra*, the Examining Attorneys in these matters posit that Applicant needs to show that its “column may be purchased without purchasing the entire newspaper,” and that is exactly what Applicant’s online columns demonstrate: an Internet user can conduct a search for the trademark “Work Friend” (and all of the other marks) on the Internet and obtain a search result that allows the user to directly access the online version of the print column without having to review or read the “entire newspaper.” To gain unlimited access to the online columns, the reader must also purchase a separate digital newspaper subscription. Crucially, the user does not need to go to *nytimes.com* and then review all the pages of that website for the relevant column; the user can instead directly access the column through searching for the column name in an Internet search engine.¹

As also noted *supra*, the Examining Attorneys each invited the Applicant to submit evidence that Applicant’s column is in fact separate goods in trade, but the Examining Attorneys repeatedly rejected Applicant’s online version of its column as evidence of same – notwithstanding that such online columns are independently accessed through the Internet and require a separate subscription, as is clear in the evidence of record.

¹ In addition, that print and online columns, respectively, are classified differently under the Trademark Office’s goods and services classification system is evidence that such services constitute “separate goods” within the meaning of T.M.E.P. § 1202.07(a)(ii), and as confirmed in T.M.E.P. §1202.07(b), which expressly states that “an online publication is considered a service rather than a product” (emphasis added) Accordingly, if an online publication is a “service” rather than a product, Applicant’s use of a mark like “Work Friend” in connection with an online column can be nothing other than use with a “separate good in trade,” *i.e.*, a good that is separate from the goods identified in Class 16.

In sum, because Applicant publishes an online column under the same mark as it publishes the print column, Applicant has provided evidence that Applicant's columns are "separately sold." Contrary to the alleged basis for the continued refusals, Applicant's evidence of record patently does not indicate that the trademark is only used as the name of a column or section of a "printed publication, a downloadable publication, or a publication recorded on electronic media." *See* Final refusals in each application. To the contrary, the evidence of record shows beyond any question that the print column is separately sold through the online version of Applicant's newspaper.

Finally, that Applicant's online columns constitute "separate goods in trade" is also firmly established in T.M.E.P. §1202.07(b):

An online publication is considered a service rather than a product. Therefore, refusal of registration on the ground that the proposed mark is not used on goods in trade is inappropriate. Unlike a printed column or section, an online column or section can be accessed directly and can exist independent of any single publication. *See Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 14, 47 USPQ2d 1087, 1093 (D.D.C. 1998). Therefore, a mark that identifies an online column or section is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f) if registration is not barred by other sections of the Act.

(emphasis added).

Accordingly, if "an online publication is considered a service rather than a product," then the Applicant's online version of its print column must also be considered a "service rather than a product," and therefore constitute a "separate good in trade."

Similarly, T.M.E.P §1202.07(b) expressly states that "a mark that identifies an online column or section is registrable on the Principal Register without resort to §2(f) of the Trademark Act." (emphasis added). Because Applicant's marks undeniably identify both a print and an online column, registration should not be barred, *i.e.*, Applicant's marks do indeed identify an online column, and the T.M.E.P. does not expressly state that print column names should be treated differently than online column names when the marks are the same and appear in both formats. In other words, T.M.E.P. §1202.07(b) does not say that a mark that "only" identifies an online column

is registrable on the Principal Register – it is therefore reasonable to interpret this provision to mean that a mark that identifies both print and online columns to be registrable on the Principal Register.

B. Neither T.M.E.P. § 1202.07(a)(ii) nor T.M.E.P. §1202.07(b) Expressly Contemplate a Trademark that Identifies a Column or Section of Publication Provided in Both Print and Online Formats

While T.M.E.P. §1202.07(b) does indicate fairly clearly that Applicant’s mark for Class 16 should be registered because it also identifies an online column, the T.M.E.P. does not expressly address situations where a column name is used in both print and online formats. Indeed, as is clearly evident in a review of the plain language in T.M.E.P. § 1202.07(a)(ii), this section of the T.M.E.P., which is primarily cited in the Examining Attorneys’ refusals, contemplates a world before the Internet and the prevalence of online columns, features, and blogs. This deficiency necessitates the Board’s updating

Indeed, the only caselaw set forth in this section of the T.M.E.P. is from 1956 and 1962, namely, *In re Broad. Publ'ns*, 135 USPQ 374 (TTAB 1962) and *Ex parte Meredith Publ'g*, 109 USPQ 426 (Comm’r Pats. 1956). These cases were decided approximately 35 years before the Internet made possible the publication of news through online versions of print newspapers, and about 65 years before Applicant filed the instant applications. In other words, the courts in these cases addressed non-syndicated columns that appeared in print media only – they of course could not fully contemplate a column appearing in print and online media, because online media did not exist at the time.

And while T.M.E.P. §1202.07(b) meaningfully updated the T.M.E.P. to reflect the importance of the Internet in this context and to accord with the determination made in *Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 14, 47 USPQ2d 1087, 1093 (D.D.C. 1998) (that a mark used in connection with the service of providing an online non-downloadable column or section is

registrable on the Principal Register), the T.M.E.P has not been clearly updated to reflect the reality that columns are almost always now provided in print and online formats concurrently, and that an online column must therefore definitionally constitute a “separate good in trade” as that term is set forth in T.M.E.P. § 1202.07(a)(ii).

Even in the much earlier days of online publications, the court in *Ludden v. Metro Weekly* identified the danger in not recognizing the ever-changing landscape of the digital world and specifically contemplated exactly what is happening with Applicant’s marks at issue being offered in both print and online formats under the same mark. As the court wrote in *Ludden v. Metro Weekly* – only shortly after the Internet became widely used for the consumption of news content:

In the rapidly expanding media universe in which we now live, a bright-line rule excluding individual newspaper or magazine column titles from receiving trademark protection would be particularly disastrous. The broad sweep of the Lanham Act mandates that courts keep an eye open to the changing dynamics of use and context. *See Qualitex, 514 U.S. at 162-63, 115 S. Ct. 1300.*

* * * *

Now, there has been explosive growth in "printed matter," which under a flexible interpretation would have to include digitally stored text. The emergence of magazines available only on the Internet (so-called Web zines) have the potential to radically alter readers' view of the printed matter that they receive. See James F. Breisford, Online Liability Issues: Defamation, Invasion of Privacy and Negligent Publishing, 482 PLI/ PAT 471, 528 (1997) (suggesting how the *Metro Publishing* holding applies to electronic publishing); *see also Blumenthal v. Drudge*, 992 F. Supp. 44, 47 (D.D.C.1998) (describing how electronic gossip column was made available to public).

The notions either that "it is doubtful that magazine readers ordinarily purchase a magazine merely to receive a section of it" or that "the purchaser receives the sections whether he wants them or not" may soon become quaint relics of the past, if they have not already. On the Internet, where one might use the title of a newspaper or magazine column as a search term, reading printed matter à la carte is both possible, and perhaps preferred by regular users of that medium. Other technological and cultural developments, such as the advent of so-called "push" technology, see Parry Aftab, Bells and Whistles: Java and Push Technology 1003 PLI/CORP. 69, 73-74 (1997), and the rise of "mass customization," Chris Woodyard, Mass Production Gives Way to Mass Customization, USA TODAY, Feb. 16, 1998, at B3, have the potential to allow readers to assemble their own personal electronic newspaper composed of columns from a number of different

publications. These developments suggest that the identity of a column not only can be distinct from that of the publication in which it appears but also that an electronic column can exist independent of any single publication.

In this case, these developments serve only as a reminder that courts should be wary of adopting per se rules regarding the scope of protection under the Lanham Act and that reliance on out-of-date information regarding use is equally to be avoided. Relying solely on the present record, the Court holds that under the Lanham Act a newspaper or magazine column is capable of being a good or service distinct from the publication in which it appears and, therefore, that the title of a newspaper column or magazine is amenable to protection as a trademark in its own right so long as it meets the other requirements, such as distinctiveness and use.

(Emphasis added).

The point is this: the Examining Attorneys' inflexible reliance on the provisions of T.M.E.P. § 1202.07(a)(ii) and precedent that preceded the Internet by 35+ years and these cases by 65+ years yields a result that is both non-sensical and highly prejudicial to Applicant. In this case, Applicant has presented substantial evidence that its trademarks are used with online columns that readers can access independently and that require a separate subscription, as contemplated in *Ludden v. Metro Weekly*. These online columns are the "separate goods in trade" that T.M.E.P. § 1202.07(a)(ii) contemplates as being sufficient to overcome a refusal under Sections 1, 2 and 45, but because this T.M.E.P. section does not expressly provide Examining Attorneys with that instruction, and notwithstanding that T.M.E.P. §1202.07(b) impliedly states that Applicant's mark for the goods in Class 16 should be registered because it also identifies an online column, the Examining Attorneys have chosen to inflexibly take an antiquated view of the goods identified in Class 16. Thus, while T.M.E.P. §1202.07(b) clearly expresses a more modern recognition that online columns constitute "separate goods in trade," that section of the T.M.E.P. does not expressly provide direction to Examining Attorneys regarding how to address applications that identify print and online columns.

For the Board to not recognize the reality that print newspaper columns are now almost always also provided in online formats will result in the kind of disastrous legal result that the

court in *Ludden v. Metro Weekly* specifically cautioned against. The current media universe, as made clear through Applicant's use of its column names in both print and online formats, calls for a different result.

V. **CONCLUSION**

In this Appeal Brief and through its prior submissions in the matter, Applicant has clearly demonstrated that it provides its goods in Class 16 as "separate goods in trade" as required to achieve registration of the marks for the goods in Class 16 on the Principal Register without a showing of acquired distinctiveness.

Applicant respectfully requests that the refusal be withdrawn for the goods in Class 16 and that Applicant's mark be passed to publication.

Respectfully submitted,



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