

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZD Inc.

Serial Nos. 75/063,530 and 75/063,533

James E. Rosini and Karen L. Feisthamel of Kenyon & Kenyon
for ZD Inc.

Gary L. Thayer, Trademark Examining Attorney, Law Office
103 (Mike A. Szoke, Managing Attorney).

Before Hanak, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

ZD Inc.¹ filed an application for registration of the
mark "DIGITAL RETAIL WEEK" for "prerecorded CD-ROMs and
computer disks containing electronic versions of print and
on-line publications, namely, pamphlets, brochures,

¹ Although "Ziff-Davis Publishing Company" filed the original
application, in April 1997 applicant's name was changed to "Ziff-
Davis Inc.," and then in May 1998, applicant changed its name
again to the current "ZD Inc."

magazines, and newspapers, and supplements thereto, journals, newsletters featuring text and graphical information in the fields of information, computer and high technology, computers, computing, electronics, and marketing and distribution and related software" in Int. Cl. 9; for "printed publications, namely, pamphlets, brochures, magazines, and newspapers, and supplements thereto, journals, newsletters featuring text and graphical information in the fields of information, computer and high technology, computers, computing, electronics, and marketing and distribution and related software" in Int. Cl. 16;² and a second application to register the same mark for "computer services, namely, providing online publications, namely, magazines and newspapers, and information about information technology marketing and distribution; providing multiple user access to a global computer network for the transfer and dissemination of information about information technology marketing and distribution" in Int. Cl. 42.³

² Serial No. 75/063,530, in International Classes 9 and 16, filed February 26, 1996, based upon an allegation of a *bona fide* intention to use the mark in commerce.

³ Serial No. 75/063,533, in International Class 42, filed February 26, 1996, based upon an allegation of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney issued a final refusal to register in each of the applications based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark "DIGITAL RETAIL WEEK," when used on these publications (electronic and printed) and services, is merely descriptive of the publications and services because it identifies characteristics of the goods and services.

Inasmuch as these two co-pending applications involve common questions of law and fact, and each has been treated in substantially the same manner by the applicant and by the Trademark Examining Attorney, we decide these two appeals by issuing a single opinion.

The Trademark Examining Attorney placed photocopies of dictionary entries and of on-line definitions into the record (*inter alia*, of the words "digital," "retail" and "week"). We see from at least one of the submissions that the term "digital" narrowly means the use of the numbers "0" and "1" in a computerized environment. The Trademark Examining Attorney also submitted ten news stories from the LEXIS/NEXIS database using the phrases "digital retail" and "digital retailing." As seen in the context of the LEXIS/NEXIS entries, the "digital" of "digital retailing"

has a much broader meaning synonymous with "electronic," "on-line" or "Web-based." The Trademark Examining Attorney's Nexis excerpts reflect the use of these terms in U.S. publications throughout the decade of the 90's. These publications show that currently the terms "digital retailing" or "digital retail" are synonymous with the terms "electronic retailing," "digital commerce" or "electronic commerce."

In our estimation, the fact that applicant may be identified with one particular sector of the economy (i.e., the computer industry) is not the primary focus.⁴ What is material to our decision is that applicant's proposed publications and services, as identified, encompass information and services designed to help others use electronic media for digital retailing. A close look at applicant's identification of goods and recital of services demonstrates that the content of these publications and services deals with the marketing, selling and various other business-related activities in the high technology world of computers, networks and software.

⁴ "[T]he phrase ['digital retail week'] aptly describes a publication whose subject matter includes the field of selling/marketing (i.e. the 'retail' or 'retailing') of 'digital' equipment (i.e. computers and the like)..."

(Trademark Examining Attorney's Appeal Brief, p. 5).

As seen in third-party federal registrations made of record by the Trademark Examining Attorney and by the applicant, the word "Week" is commonly used for periodical publications having weekly issue dates, or even weekly updates on-line. This usage is consistent with the dictionary definitions supplied by the Trademark Examining Attorney. In the third-party registrations submitted by the Trademark Examining Attorney, when the word "Week" is part of composite marks for publication names, it is either disclaimed or registered under Section 2(f) of the Act. In turn, applicant has submitted other third-party registrations for "... WEEK" publications wherein the word "WEEK" appears to be a registrable component of the composite mark. However, these third-party registrations are not determinative herein, as each case must be decided on its own unique set of facts, including the way in which different words may interact with each other within a composite mark.

Finally, we see nothing in the joining of the term "Digital Retail" with the word "Week" that creates a new or different meaning than one would anticipate when melding

these individual components.⁵ Upon seeing the mark "DIGITAL RETAIL WEEK" for these goods and services, we conclude that one would immediately think of a weekly publication dealing with information technology marketing and distribution.

Decision: We affirm the refusal of the Trademark Examining Attorney to register this matter.

E. W. Hanak

C. E. Walters

D. E. Bucher

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⁵ Cf., The Second Circuit agreed with a lower court that the designation "MARKETING WEEK" is descriptive (albeit with acquired distinctiveness possible). See *Centaur Communications Ltd. v. A/S/M Communications Inc.*, 830 F.2d 1217, 4 USPQ2d 1541 (2nd Cir. 1987), affirming 652 F.Supp 1105, 1 USPQ2d 1958 (S.D.N.Y. 1987). The federal registration for "MARKETING WEEK" (Reg. No. 1,555,708) issued to Centaur under the provisions of Section 2(f) of the Lanham Act. Also, we note that applicant's own Reg. No. 1,325,664 for "PC WEEK and design," has a disclaimer of the word "Week."