

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZD Inc.¹

Serial No. 75/095,168

James E. Rosini of Kenyon & Kenyon for applicant.

Gary R. Thayer, Trademark Examining Attorney, Law Office
103 (Michael A. Szoke, Managing Attorney).

Before Simms, Cissel and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

ZD Inc. has filed a trademark application to register
the mark DIGITAL MERCHANDISING MAGAZINE for "providing
information via an interactive computer information network

¹ Applicant submitted with its request for reconsideration notice of its April, 1997, change of name from Ziff-Davis Publishing Company to Ziff-Davis Inc.; and, with its reply brief, notice of its further change of name, dated May 1, 1998, to ZD Inc. Applicant is advised that this name change would have to be recorded with the Patent and Trademark Office if applicant prevailed on appeal and wanted a registration issuing from this application to issue in applicant's new name.

about distribution channels for high technology products and information technology products."²

The Trademark Examining Attorney has finally refused registration on the ground that applicant's mark is merely descriptive of its services, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).³ Additionally, the Examining Attorney has issued a final requirement for further information about the nature, subject matter and channels of trade of the proposed services, under Trademark Rule 2.61(b), 37 CFR 2.61(b), and has finally refused registration on this basis.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusals to register on both the ground of mere descriptiveness under Section 2(e)(1), and on the failure to comply with the requirement, under Trademark 2.61(b), for additional information.

² Serial No. 75/095,168, in International Class 42, filed April 26, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

³ In his brief, the Examining Attorney indicated for the first time that he is refusing registration, alternatively, on the ground that the mark is deceptively misdescriptive, under Section 2(e)(1) of the Act. Applicant objects in its reply brief and correctly points out that it is inappropriate to raise a new ground of refusal for the first time in an appeal brief. We have given no consideration to this ground of refusal.

Mere Descriptiveness

Turning, first, to the refusal to register on the ground of mere descriptiveness, the Examining Attorney contends that the mark DIGITAL MERCHANDISING MAGAZINE merely describes "the subject matter and nature of the services, namely, on-line information publications in the nature of electronic magazines which feature information about the merchandising of computers and high-tech (i.e., 'digital') equipment." In support of his position, the Examining Attorney submitted fourteen excerpts of articles from the LEXIS/NEXIS database to "demonstrate descriptive usage of the term 'digital merchandising' in connection with the marketing/merchandising of computers and related high-tech 'digital' equipment." The Examining Attorney submitted with his brief dictionary definitions, of which we take judicial notice, of the words "digital," "merchandising," "magazine" and "distribution."

Applicant contends that "the provision of multiple user access and information via a global information network can be likened to electronic publications in many instances, and thus the marks for such services should be treated similarly to marks which are the titles of printed publications"; and that the issue of descriptiveness is "a unique problem" with respect to publications. Applicant

further argues that the fourteen excerpts of articles from the LEXI/NEXIS database do not establish the descriptiveness of the term "digital merchandising." Applicant submitted with its brief dictionary definitions, of which we take judicial notice, of the words "digital" and "merchandising," and argues that the mark DIGITAL MERCHANDISING MAGAZINE is not merely descriptive because it has several "equally viable connotations ... none of which accurately describes Applicant's services." In this regard, applicant contends that "digital merchandising" "could be understood to indicate the subject of Applicant's services include (*sic*) marketing any type of products in a digital medium," or "the term 'digital' could be understood to modify the word 'magazine' such that the mark could be understood to indicate Applicant's services are of a publication, available in an electronic medium, about general marketing and sales promotion," or DIGITAL MERCHANDISING MAGAZINE could be understood to mean "the services are in the nature of providing information on the use of digital equipment to effectively merchandise."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product

or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Applicant's argument that the test for descriptiveness in connection with publications, either print or electronic, is somehow different from the general test for descriptiveness articulated herein is not well taken. In support of its position, applicant cites *In re Distribution Codes, Inc.*, 199 USPQ 508 (TTAB 1978), wherein the mark CODE & SYMBOL was found to be "highly suggestive," but not merely descriptive, in connection with journals dealing with the applied science of product identification. The principal language in that case quoted by applicant in

support of its position is inapposite as it pertains to the Board's discussion of the registrability as trademarks of titles of periodicals or a series, as opposed to titles of a single book or issue. In that case, the Board established, first, that the subject publication was a periodical and, thus, subject to registration, and then addressed the question of descriptiveness in connection with the particular subject matter of the identified publication. In that regard, the Board stated, *supra* at 510, "we apply a test as close as possible to the tests of descriptiveness or validity applied to a mark used for any goods or services." When this quote is read in the context of the entire discussion of descriptiveness in that case, it does not mean that we should apply a test of descriptiveness to a trademark for a periodical publication that is somehow different from the general test of mere descriptiveness applied to a mark for any other goods or services. In that case the Board pointed out the unique aspects of the publishing industry and the tendency of publishers to favor suggestive titles for periodical publications, and applied the same test of descriptiveness applicable to any mark for any goods or services. It is well settled that the criteria applied to a determination of the descriptiveness of a trademark are equally

applicable to those standards involved in ascertaining whether or not the title of a publication falls within the proscriptions of Section 2(e)(1). *In re Hunter Publishing Company*, 204 USPQ 957, 962 (TTAB 1979); and *In re Waverly Inc.*, 27 USPQ2d 1620, 1622 (TTAB 1993).

Turning to the case before us, we agree with the Examining Attorney that DIGITAL MERCHANDISING MAGAZINE is merely descriptive in connection with the identified services, notwithstanding applicant's arguments to the contrary. As applicant essentially concedes, its proposed services are in the nature of an electronic publication, which information the MAGAZINE portion of applicant's mark directly conveys. The DIGITAL MERCHANDISING portion of the mark clearly indicates the subject matter of the electronic publication, or magazine.

While applicant posits several possible connotations of the term "digital merchandising," we must consider the meaning of the term in connection with the identified services. In this regard, we note that "digital" is defined as "[t]raditionally, the use of numbers and comes from digit, or finger ... [t]oday, synonymous with computer"⁴ and as follows:

⁴ *The Computer Glossary* (8th ed.). The Examining Attorney should have also submitted information indicating the publisher and date of publication. However, the submitted cover page includes a statement

2. In telecommunications, recording or in computing, digital is the use of a binary code to represent information. ... So digital transmission is much "cleaner" than analog transmission. The second major benefit of digital is that the electronic circuitry to handle digital is getting cheaper and more powerful. It's the stuff of computers. Analog transmission equipment doesn't lend itself to the technical breakthroughs of recent years in digital.⁵

"Merchandising" is defined as "the planning and promotion of sales by presenting a product to the right market at the proper time, by carrying out organized, skillful advertising, using attractive displays."⁶

Although the term "digital merchandising," considered in the abstract, could have the meanings suggested by applicant, applicant has provided no evidence that the term would be so perceived by the relevant public. Further, considering the term in the context of the services as described in the application, as we must, the term "digital merchandising" directly conveys information about the nature of applicant's services, namely, that applicant's proposed electronic publication provides information about distribution channels for high technology and information

endorsing the book dated 1993, so we conclude that the definition is sufficiently recent to be relevant herein.

⁵ *Newton's Telecom Dictionary* (1998).

⁶ *Random House Unabridged Dictionary* (2nd ed.). We take judicial notice of the 1987 publication date of this dictionary.

technology products. This conclusion is supported by applicant's own identification of services and by the dictionary definitions in the record. Further, this conclusion is not contradicted by any of the other evidence of record.⁷

In the present case, it is our view that, when applied to applicant's services, the term DIGITAL MERCHANDISING MAGAZINE immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, the subject matter and nature of the electronic publication. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term DIGITAL MERCHANDISING MAGAZINE as it pertains to applicant's services.

⁷ We agree with applicant that the LEXIS/NEXIS evidence is insufficient, alone, to support our conclusion herein. Of the fourteen excerpts submitted, seven are from newswire service stories and, therefore, are of limited probative value because it is not clear that such stories have appeared in any publication available to the consuming public. See, *In re Marico Inc.*, 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). Further, four excerpts refer to Digital Corporation and one excerpt is obtuse. Only two excerpts appear to use the term "digital merchandising" to describe on-line marketing and sales of products. Although there are only two excerpts that support the Examining Attorney's position, it is not necessary that a designation be in common usage in the particular industry in order for it to be merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Requirement for Additional Information

The Examining Attorney argues that applicant's failure to comply with his several requests for information constitutes a ground for refusal to register. Trademark Rule 2.61(b) provides:

The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

The Trademark Rules of Practice have the effect of law and the failure to comply with a request for information is grounds for refusal of registration. *In re Babies Beat, Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (TTAB 1978); *In re Air Products and Chemicals, Inc.*, 192 USPQ 84, 85-86 (TTAB 1976); and *In re Morrison Industries, Inc.*, 178 USPQ 432, 433-434 (TTAB 1973). The Examining Attorney's request is reasonably necessary for the proper examination of this application in view of his contention that the mark is merely descriptive. Because this is an intent-to-use application and, except for the identification of services, the application contains no information regarding the exact nature of the intended services, the Examining Attorney correctly asked applicant for additional information regarding the nature of the services. Such a request is relevant to the issue

of mere descriptiveness. Contrary to its statement in applicant's brief, applicant completely disregarded the Examining Attorney's request. Even after the Examining Attorney made the request final, applicant, in its request for reconsideration, made no attempt to respond to the requirement with additional information or explain, if appropriate, why additional information was unavailable. Applicant states in its brief that it "intends to provide information on a wide variety of topics regarding the distribution channels of high technology and information technology products." This statement is wholly inadequate. Examination and prosecution of an application must be complete prior to appeal. Accordingly, we agree with the Examining Attorney that applicant's complete failure to respond to the Examining Attorney's requests for information required the Examining Attorney to proceed with an incomplete understanding of the exact nature of applicant's intended services, which information would have allowed the Examining Attorney to conduct a more thorough and informed evaluation of the issue of mere descriptiveness. Applicant's failure to comply with the requirements for additional information, therefore, justifies refusing registration.

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Decision: The refusal under Section 2(e)(1) of the Act and the refusal based on the failure to comply with the requirement for more information, under Trademark Rule 2.61(b), are affirmed.

R. L. Simms

R. F. Cissel

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board