

3/21/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Media West-RDC, Inc.

Serial No. 75/607,234

Kevin J. Kuzas for Media West-RDC, Inc.

Robert H. Coggins, Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney).

Before Seeherman, Hanak and Holtzman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Media West-RDC, Inc.(applicant) seeks to register in typed drawing form THE NEWS JOURNAL for "newspapers for general circulation." The application was filed on December 17, 1998 with a claimed first use date of July 4, 1975. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use the word NEWS apart from the mark in its entirety.

This application has had a tortured history. Initially, the Examining Attorney refused registration

pursuant to Section 2(d) of the Trademark Act on the basis

Ser. No. 75/607,234

that applicant's mark was confusingly similar to a previously registered mark. This ground of refusal was subsequently withdrawn. The current grounds for refusal are best articulated at page 1 of applicant's brief:

The Examining Attorney has refused registration of applicant's mark, THE NEWS JOURNAL, arguing that THE NEWS JOURNAL is the generic term for applicant's goods, which are daily newspapers, and therefore cannot acquire secondary meaning. Applicant brings this appeal because it believes that the only generic term for its goods is "newspapers" and not "news journals." Furthermore, although the phrase "news journal" may be descriptive of applicant's newspapers, applicant has submitted abundant evidence to show that THE NEWS JOURNAL has acquired secondary meaning as a source of applicant's newspapers.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

At the outset, two points should be clarified. First, in the above statements taken from page 1 of applicant's brief, applicant contends that its goods "are daily newspapers." This may be true, but it is irrelevant. Applicant seeks to register the purported

mark THE NEWS JOURNAL not for "daily newspapers," but rather for

2

Ser. No. 75/607,234

"newspapers for general circulation." In other words, applicant seeks to register THE NEWS JOURNAL not simply for daily newspapers, but rather for newspapers for general circulation which may be distributed on a daily, weekly or monthly basis. In this regard, it is extremely critical to remember that "a proper genericness inquiry focuses on the description of services [or goods] set forth in the" application, rather than on what applicant's actual goods may be. Magic Wand Inc. v. RDB, Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991).

Second, applicant argues that "the only generic term for its goods is 'newspapers' and not 'news journals.'" While it is true that a few products have but one generic name, in most cases, products have more than one generic name. As Professor McCarthy succinctly states: "There is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those [generic

designations] is incapable of trademark significance." 2
J.McCarthy, McCarthy on Trademarks and Unfair Competition
Section 12:9

3

Ser. No. 75/607,234

at page 12-21 (4th ed. 2001).

In support of his claim that applicant's purported mark THE NEWS JOURNAL is a generic term for "newspapers for general circulation," the Examining Attorney relies upon dictionary definitions and upon approximately fifty stories wherein the term "news journal" is used in a generic manner to refer to various types of publications. The Examining Attorney refers to The American Heritage Dictionary of the English Language (3d ed. 1992). At page 6 of its brief, applicant quotes from Webster's II New College Dictionary (1995) which defines the term "newspaper" as "a typically daily or weekly publication containing recent news, feature articles, editorials, and usually advertising." (emphasis added). The underlined portion of the definition of the term "newspaper" selected by applicant undercuts applicant's argument at pages 8 and 9 of its brief that

the Examining Attorney's articles which use the term "news journal" in connection with weekly publications are of no value in proving that the term "news journal" is essentially

4

Ser. No. 75/607,234

synonymous with the clearly generic term "newspaper."

As for the term "journal," applicant's chosen dictionary defines it as, in one sense, "a daily newspaper." (Applicant's brief page 6). The American Heritage Dictionary of the English Language (3d ed. 1992) defines "journal" as "a newspaper." A dictionary consulted by this Board also defines "journal" as "a newspaper." Webster's New World Dictionary (1996). Thus, while the term "journal" is synonymous with "a daily newspaper," it is also synonymous with "a newspaper." It is true, as applicant points out, that the term "journal" has other meanings. However, these other meanings are essentially irrelevant when applicant seeks to register THE NEWS JOURNAL for "newspapers for general circulation." As previously noted in the Magic Wand case, the genericness of a term is not judged in the

abstract, but rather is judged in relation to the goods set forth in the application, in this case, "newspapers for general circulation."

In sum, the above dictionary definitions demonstrate that when used in connection with "newspapers for general circulation," the terms "journal" and

5

Ser. No. 75/607,234

"newspaper" (or "daily newspaper") are synonyms. Moreover, applicant's own chosen definition of the term "newspaper" demonstrates that this term is not limited to a publication produced solely on a daily basis.

However, this Board does not rely simply on dictionary definitions in order to find that applicant's purported mark THE NEWS JOURNAL is one generic term for "newspapers for general circulation." The Examining Attorney has made of record literally dozens of articles where the term "news journal" is used to refer to daily newspapers, as well as weekly publications. For example, in the October 17, 1999 edition of The San Francisco Chronicle, a reader writes to the editor complaining that The San Francisco Chronicle has become "too much like a tabloid and not enough like a true news journal." In the

August 17, 1999 edition of The San Jose Mercury News, there is an article regarding The Palo Alto Daily News (another daily newspaper) which states that this latter daily newspaper "has devolved from being viewed as a respected news journal to a novelty." In the July 24, 1999 edition of The Orlando Sentinel a reader writes to the editor and

6

Ser. No. 75/607,234

refers to The Orlando Sentinel "as a news journal." Finally, there are of record a number of articles discussing the Daytona Beach News-Journal.

Of course, there are also stories wherein the term "news journal" is used in a generic manner to refer to publications that are produced on a weekly basis. These stories are just as valuable in establishing that the term "news journal" is another generic term for "newspaper" because, as previously noted, the very dictionary definition relied upon by applicant at page 6 of its brief for the word "newspaper" defines the term as "a typically daily or weekly publication containing recent news, feature articles, editorials, and usually advertising." The August 21, 1999 edition of The

Saturday Oklahoman refers to U.S. News & World Report as "an internationally known news journal." The August 6, 1999 edition of The Times-Picayune refers to "Newsweek and other serious news journals." Finally, the October 20, 1999 edition of The Washington Times refers to The Economist as "the world's leading news journal."

The foregoing are but some of the dozens of

7

Ser. No. 75/607,234

articles made of record by the Examining Attorney where the term "news journal" is used in a generic manner to refer to a daily or weekly newspaper. Our primary reviewing Court has cautioned this Board that when an applicant seeks to register a phrase, the Board may not hold the phrase to be generic without "conducting an inquiry into the meaning of the disputed phrase as a whole." In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). The Examining Attorney's evidence has clearly established that the phrase "news journal" is one generic term for the goods set forth in the application, namely, "newspapers for general circulation," whether distributed on a daily or weekly basis.

Three additional comments are in order. First, we acknowledge that the Examining Attorney has failed to uncover any generic uses of the phrase "the news journal." The word "the" has little if any source identifying significance. Given the fact that the Examining Attorney has established that the phrase "news journal" is generic for newspapers for general circulation, we find that the addition of the word "the" to this term does not alter its

8

Ser. No. 75/607,234

generic character. By way of analogy, there is absolutely no dispute that the word "newspaper" is a generic term for "newspapers for general circulation." We are of the firm belief that no one would contend that the phrase "the newspaper" is not likewise a generic term for newspapers for general circulation. If the term "the newspaper" is generic for said goods, then the term "the news journal" is likewise generic.

Second, we do not take issue with applicant that as used in connection with newspapers for general circulation, the term "newspaper" is an infinitely more popular generic term than is "news journal" or "the news

journal." However, as previously pointed out, most products have more than one generic term, and all generic terms must remain in the public domain to be freely used by all competitors.

Finally, if there were any lingering doubts as to whether the term "the news journal" was generic for newspapers for general circulation, this doubt is totally eliminated when one carefully reviews the five declarations made of record by applicant in an attempt to establish that

Ser. No. 75/607,234

THE NEWS JOURNAL is indeed a mark, and not a generic term. The first declaration is from applicant's treasurer, and he states in paragraph 5 that "to his knowledge, the great majority of residents in the circulation area of THE NEWS JOURNAL newspaper [Wilmington, Delaware] understand the phrase 'news journal' to refer to THE NEWS JOURNAL newspaper and not to a generic general circulation newspaper." (emphasis added). Employees of Lord & Taylor, Macy's, Best Buy, and Boscov's Department Stores who are responsible for placing advertising in newspapers all state that when

they "conduct business ... in Wilmington, Delaware," they do not use "the phrase 'news journal' or 'the news journal' to refer to any newspaper other than THE NEWS JOURNAL newspaper in Wilmington, Delaware."

The declarations of these five individuals selected by applicant were very carefully worded so as to simply claim that in Wilmington, Delaware, the title of applicant's newspaper (THE NEWS JOURNAL) may no longer be a generic term, but rather is understood as referring to a particular newspaper. However, applicant has made no effort whatsoever to demonstrate that the title of its

10

Ser. No. 75/607,234

newspaper (THE NEWS JOURNAL) has lost its generic status anywhere besides Wilmington, Delaware. In other words, even applicant's own chosen declarants (including its own treasurer) make no claim whatsoever that to the vast majority of Americans residing outside of Wilmington, Delaware, the term "the news journal" would be perceived as anything other than a generic term for newspapers for general circulation.

We are fully aware that applicant has made use of THE NEWS JOURNAL on a newspaper for general

circulation in Wilmington for over a quarter of a century. In Wilmington, Delaware and perhaps surrounding areas, the term THE NEWS JOURNAL may indeed be viewed by most residents as referring exclusively to applicant's daily newspaper. However, by means of its current application, applicant seeks to gain exclusive rights to the phrase "the news journal" for newspapers for general circulation in every part of the United States.

Applicant's evidentiary showing is totally lacking in rebutting the showing put forth by the Examining Attorney that in most of the United States, the term "the news journal" is one generic term for newspapers for

11

Ser. No. 75/607,234

general circulation.

Assuming that our determination that applicant's mark is generic in the vast majority of the United States is found to be erroneous, we turn now to a consideration of whether the merely descriptive term "the news journal" has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act as indicating a general circulation newspaper emanating solely from applicant. To cut to the quick, applicant has totally failed to establish that to

any appreciable number of Americans, applicant's purported mark THE NEWS JOURNAL has acquired distinctiveness as indicating a newspaper emanating solely from applicant. At most, applicant has established that its purported mark has acquired distinctiveness simply in Wilmington, Delaware and perhaps surrounding communities.

Decision: The refusal to register on the basis that applicant's mark is generic to the vast majority of Americans is affirmed. The alternate basis for refusal, that applicant's mark is merely descriptive to the vast majority of Americans and lacks acquired distinctiveness, is also affirmed.