

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed: December 5, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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In re Donald G. Bronn  
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Serial No. 78916919  
(filed June 26, 2006)  
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John R. Benefiel of Law Offices of John R. Benefiel for  
Donald G. Bronn.

Frank J. Lattuca, Trademark Examining Attorney, Law Office  
109 (Dan Vavonese, Managing Attorney).

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Before Walters, Zervas, and Wellington, Administrative  
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Donald G. Bronn filed an intent-to-use application for  
the mark DIGITAL BOARD OF MEDICAL EXPERTS (in standard  
character format) for "providing medical information,  
consultancy and advisory services" in International Class  
44. Applicant has disclaimed BOARD OF MEDICAL EXPERTS.<sup>1</sup>

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<sup>1</sup> In the first Office action, the examining attorney required a disclaimer of this term, requested additional information concerning applicant's services and the significance of the term "digital," but did not refuse registration under Section 2(e)(1). Applicant responded to the Office action by providing the disclaimer and responding to the information/ significance requests. The descriptiveness refusal was then raised, for the first time, in the second Office action.

The Examining Attorney has finally refused registration on the grounds that the mark merely describes the goods under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. We affirm the refusal for the reasons discussed below.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. See Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052. See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *Abcor Dev.*, 200 USPQ at 218

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("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"). The issue is whether someone who knows what the services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990).

The record includes dictionary definitions of the terms: DIGITAL, BOARD, MEDICAL, and EXPERT.<sup>2</sup> In particular, the examining attorney relies on the following definition for DIGITAL:

ELECTRONIC <digital devices>, also: characterized by electronic and especially computerized technology <the digital age>.<sup>3</sup>

In addition, the examining attorney submitted copies of four third-party registrations containing disclaimers of

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<sup>2</sup> The definitions for the words "board", "medical" and "expert" were provided in the examining attorney's Office action dated December 5, 2006, and ascertained from *The American Heritage Dictionary of the English Language, Third Edition* copyright 1992.

<sup>3</sup> Attached to Office action dated June 30, 2007, from *Merriam-Webster Online*, based on the print version of *Merriam-Webster's Collegiate® Dictionary, Eleventh Edition*).

one or more of the following terms, "medical", "expert" and "board."

The examining attorney also points to applicant's response to an Office action wherein applicant states that his services will "be provided to health insurance carriers and involve providing expert opinions to the carrier" and that this information "will be communicated in writing and/or via the internet."<sup>4</sup> The examining attorney concludes that the mark is descriptive because "applicant is providing access to an organized body of medical experts through a digital medium." Brief, p. 3

Applicant has acknowledged that BOARD OF MEDICAL EXPERTS is merely descriptive of the recited services in his arguments and by virtue of the disclaimer. However, he argues that the term DIGITAL is not descriptive and is incongruous when combined with the descriptive phrase, BOARD OF MEDICAL EXPERTS. Specifically, applicant argues that the latter phrase "denotes a group of human medical experts" and the term DIGITAL "cannot apply to human beings, i.e., there are no digital people." Brief, p. 2. Applicant also argues that the term "digital" does not "in itself mean 'electronic'" nor is the term synonymous with

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<sup>4</sup> Applicant's response to Office action dated June 5, 2007.

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"computer" or "internet." *Id.* And, applicant acknowledges that his services may be delivered by use of the internet, but "this is not suggested by the term DIGITAL, but rather would involve 'mature thought' or a multistage reasoning process." *Id.*, citing to *In re Tennis in the Round*, 199 USPQ 496 (TTAB 1978). Finally, applicant notes that there is no evidence of record showing use of the term "digital" in the field of providing medical information, consultancy or advisory services, and the lack of such evidence "is a strong indicator of suggestiveness."

After considering the evidence of record and all arguments presented by applicant, we conclude that the mark DIGITAL BOARD OF MEDICAL EXPERTS is descriptive of the identified medical information, consultancy and advisory services. Again, our determination is not made not in the abstract, but is made in relation to the services for which registration is sought. In this case, when prospective purchasers encounter the mark DIGITAL BOARD OF MEDICAL EXPERTS for the recited services, they will immediately understand, as the examining attorney explained, that the mark describes the fact that applicant's medical information, consultancy and advisory services will be rendered via electronic or computerized technology (e.g., internet) by a group of experienced or knowledgeable

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persons in the field of medicine. There is nothing incongruous or left to the imagination when DIGITAL is combined with BOARD OF MEDICAL EXPERTS, and the mark as a whole is viewed in relation to the recited services. Finally, although the examining attorney has not presented evidence showing use of the term "digital" in connection with the recited services, we find that the term, as defined, is applicable and will be readily understood in connection with applicant's recited services. In other words, because applicant's services may be rendered "digitally" or electronically, as applicant has confirmed this is one of the possible modes of delivery, the term "digital" has descriptive value in this context. Therefore, we find that applicant's mark, DIGITAL BOARD OF MEDICAL EXPERTS, is merely descriptive of the services identified in the application.

**Decision:** The descriptiveness refusal under Section 2(e)(1) of the Act is affirmed.