

This Opinion is a  
Precedent of the TTAB

Hearing: July 12, 2017

Mailed: March 26, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Serial Podcast, LLC*

Serial Nos.  
86454420  
86454424  
86464485

Matthew T. Furton, Sean C. Fifield, and David T. Van Der Laan  
of Locke Lord LLP, for Serial Podcast, LLC.

Colleen M. Dombrow, Trademark Examining Attorney, Law Office 101,  
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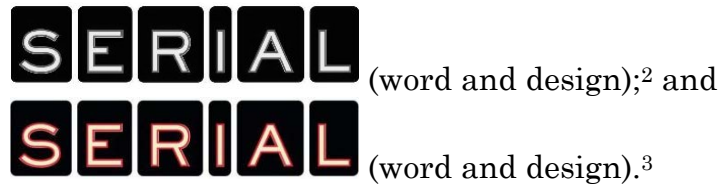
Before Taylor, Shaw and Heasley,  
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Serial Podcast, LLC (“Applicant”) seeks registration on the Principal Register of  
three marks:

SERIAL (in standard characters);<sup>1</sup>

<sup>1</sup> Application Serial No. 86454420 was filed on November 14, 2014, based upon a claim of first use anywhere and use in commerce since at least as early as September 19, 2014. 15 U.S.C. § 1051(a).



All three marks are for “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling” in International Class 41.

The Examining Attorney has refused registration of all three marks on the grounds that each is generic for the identified services, or, if not generic, merely descriptive of the services. 15 U.S.C. §§ 1051, 1052(e)(1), 1053, and 1127. In each case, Applicant has responded that the mark is not generic, and has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). The Examining Attorney has nonetheless maintained the genericness refusals and has found Applicant’s evidence insufficient to prove acquired distinctiveness. When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals

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<sup>2</sup> Application Serial No. 86454424 was filed on November 14, 2014, based upon a claim of first use anywhere and use in commerce since at least as early as September 19, 2014. 15 U.S.C. § 1051(a). The Application includes the following description of the mark: “The mark consists of the word ‘SERIAL’ in outlined letters, with each letter placed in a rectangle with rounded corners.” Color is not claimed as a feature of the mark.

<sup>3</sup> Application Serial No. 86464485 was filed on November 25, 2014, based upon a claim of first use anywhere and use in commerce since at least as early as September 19, 2014. 15 U.S.C. § 1051(a). The Application includes the following description of the mark: “The colors red, yellow and black are claimed as a feature of the mark. The mark consists of the word ‘SERIAL’ in yellow letters outlined in red, with each letter placed in a black rectangle with rounded corners. The color white in the drawing represents background and is not a feature of the mark.”

resumed and were consolidated.<sup>4</sup> Applicant and the Examining Attorney submitted briefs, and appeared at an oral hearing before the Board.

## **I. THE STANDARD CHARACTER MARK**

The Examining Attorney maintains that the proposed standard character mark, SERIAL, is generic for the services recited in the application. Applicant maintains that the proposed mark is not generic, but descriptive, and has acquired distinctiveness under Section 2(f), which states that “nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of applicant’s goods [or services] in commerce.” 15 U.S.C. §§ 1052(f), 1053.

### **A. The Proposed Standard Character Mark, SERIAL, Is Generic**

“A generic term is the common descriptive name of a class of goods or services.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (quoting *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) and *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) (internal punctuation omitted)). Generic terms are “the ultimate in descriptiveness.” *Marvin Ginn*, 228 USPQ at 530, *quoted in In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015). They are not registrable because “[g]eneric terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*,

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<sup>4</sup> 14 TTABVUE. Unless otherwise stated, all references to the record and the arguments pertain to Application Serial No. 86464485. All references to the Trademark Status & Document Retrieval (“TSDR”) database are to the downloadable .pdf version.

828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987), *quoted in Cordua*, 118 USPQ2d at 1634.

“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *Marvin Ginn*, 228 USPQ at 530, *quoted in Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017). Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530; *see Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1483 (TTAB 2017). The Examining Attorney must establish with clear and convincing evidence that a proposed mark is generic. *Cordua*, 118 USPQ2d at 1635.

The Examining Attorney and Applicant concur that the genus in this case is set forth by the recitation of services in each subject application: “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling.” *See generally Cordua*, 118 USPQ2d at 1636; *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (“[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration.”). The relevant public consists of ordinary listeners of audio programs.<sup>5</sup> Evidence of the relevant public’s understanding of a

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<sup>5</sup> Applicant’s brief p. 7, 7 TTABVUE 10, Examining Attorney’s brief 9 TTABVUE 6.

term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *See Cordua*, 118 USPQ2d at 1634.

The Examining Attorney has adduced dictionary definitions showing that the word “SERIAL” means something that is published or broadcast in installments at regular intervals, *e.g.*:

- **MacMillan Dictionary:** Serial: “A story that is broadcast or published in a series of separate parts.”
- **Dictionary.com:** Serial: “Anything published, broadcast, etc., in short installments at regular intervals, as a novel appearing in successive issues of a magazine.”
- **Oxford Dictionary:** Serial: “A story or play appearing in regular installments on television or radio or in a periodical.”<sup>6</sup>

Applicant produces an ongoing audio program, a podcast<sup>7</sup> appearing in regular weekly installments. According to its website:

*Serial* tells one story – a true story – over the course of an entire season. Each season, we’ll follow a plot and characters wherever they take us. And we won’t know what happens at the end until we get there, not long before you get there with us. Each week we bring you the next chapter in the story, so it’s important to listen to the episodes in order, starting with Episode 1.<sup>8</sup>

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<sup>6</sup> Macmillan Dictionary, 3/20/2016; Dictionary.com, 3/20/2016; OxfordDictionaries.com /us/definition/American\_english/ serial, 3/20/2016, March 22, 2016 Office Action TSDR pp. 29, 30, 34.

<sup>7</sup> “A podcast is a digital audio file about a specific topic that is released in a serial format for download to a computer or personal device.” NUIGalway.ie 3/21/2016, March 22, 2016 Office Action TSDR p. 70.

<sup>8</sup> SerialPodcast.org 2/9/2015 Feb. 10, 2015 Office Action TSDR p. 10.



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