

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/092228

APPLICANT: Intermedia Advertising Group, Inc.

SEP 16 2003

CORRESPONDENT ADDRESS:
Francie R. Gorowitz
O MELVENY & MYERS
1999 AVE OF STARS STE 700
LOS ANGELES CA 90067-6035

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom105@uspto.gov

MARK: REWARDTV

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Intermedia Advertising Group, Inc.	:	BEFORE THE
Trademark:	REWARDTV	:	TRADEMARK TRIAL
Serial No:	75/894264	:	AND
Attorney:	Francie R. Gorowitz	:	APPEAL BOARD
Address:	O'Melveny & Meyers LLP 1999 Avenue of the Stars Suite 700 Los Angeles, CA 90067	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the proposed trademark under Trademark Act Section 2(e)(1).

I. FACTS

The applicant applied to register REWARDTV for services ultimately identified as "business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the internet; and providing a website which features advertisements for the goods and services of others on the Internet, and entertainment services, namely providing an on-line computer game; entertainment services, namely providing information on-line about television programs."

The examining attorney refused registration on the basis that the proposed mark is merely descriptive of the applicant's services under Section 2(e)(1) of the Trademark Act. The applicant argued against the refusal and amended the recitation of services. The amendment was accepted, but the refusal was made final. This appeal followed.

II. ARGUMENT

THE APPLICANT'S PROPOSED TRADEMARK IS MERELY DESCRIPTIVE OF THE SERVICES WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it conveys information about a quality, characteristic, or feature of the applicant's services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a mark is merely descriptive must be determined not in the abstract, but rather in relation to the services for which registration is sought, the context in which the mark is used in connection with those services, and the possible significance which the mark would have, because of the context in which it is used, to the average purchaser of the services in the market place. *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The applicant uses the proposed mark REWARDTV in connection with "business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the internet; and providing a website

00/26/2009 11:45

which features advertisements for the goods and services of others on the Internet, and entertainment services, namely providing an on-line computer game; entertainment services, namely providing information on-line about television programs." As will be shown below, when the proposed mark is used in conjunction with the services, no amount of imagination, thought or perception is required to determine the nature of the services, and in fact, the proposed mark describes the applicant's services.

The proposed mark merely corresponds to wording which is not arbitrary, but bears a logical relationship to the services provided by the applicant. The words REWARD and TV refer to rewards or prizes given to those who watch TV. As shown in the first Office Action, dated December 13, 2000, these terms are defined as follows.

re·ward (rî-wôrd¹) *noun*

1. Something given or received in recompense for worthy behavior or in retribution for evil acts.¹

TV (tê'vê') *noun*
plural TVs or TV's
Television.²

tel·e·vi·sion (tè'l'e-vîzh'en) *noun*

1. The transmission of visual images of moving and stationary objects, generally with accompanying sound, as electromagnetic waves and the reconversion of received waves into visual images.
2. **a.** An electronic apparatus that receives electromagnetic waves and displays the reconverted images on a screen. **b.** The integrated audible and visible content of the electromagnetic waves received and converted by such an apparatus.
3. The industry of producing and broadcasting television programs³

The term REWARDTV, as applied to the applicant's services, conveys to consumers that the applicant offers recompense in the form of merchandise to people who watch particular television programs. The applicant's specimens of use are excerpts from the applicant's website

¹*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

²*Id.*

explaining the game, showing the merchandise users can earn or win by playing, and the rules for playing the games and getting prizes. Throughout its specimens, the applicant explains the services by using the terms in the mark descriptively. The examining attorney lists some examples below.

“What is REWARDTV? It’s the FREE TV Trivia site that awards cash & prizes for watching TV!”

“Make this your personal wishlist of great rewards!”

“RTV Winners ... Our latest winners – and the cool stuff they got!”

“How to Play RewardTV Games . . . To play, go to <http://www.rewardtv.com> and sign in using your email address and password. Click on the "Play" button. Under 'Active Shows,' click on a Primetime Show which you watched during the preceding 19-27 hours, depending on the time zone in which you reside. . . . You will then be asked a series of multiple-choice trivia and survey questions about that Primetime Show and the commercial advertising that aired during its broadcast. Use your mouse to click on the answer you wish to submit. For each correct answer you submit for a question about a Primetime Show, you will receive 100 TV Points. . . . In order to complete a RewardTV Game, you must answer all questions in sequential order. All submitted answers are final. After you have finished playing, the amount of TV Points you earned will be displayed and automatically credited to your Account.”

“How to Redeem TV Points . . . TV Points in your Account may be redeemed only for available products and/or services (“Rewards”) listed in the Rewards Catalog (“Rewards Catalog”) on the Site, provided that your Account contains the minimum number of TV Points required for redemption of the requested Reward.”

“It’s the place where you get stuff for watching TV.”

“It’s the frequent flyer program for TV lovers.”

Another page of the applicant’s website has a section entitled “REWARDS for watching” where some of the reward links are titled, “Hollywood Insider,” “Food Me,” and “Pay My Bills.” See the evidence attached to the Final Office Action, dated September 19, 2001.

The applicant argues that its combination of these two descriptive terms result in a mark that is only suggestive. While it is true that a mark which combines descriptive terms may be

³*Id.*

00/26/2008TTAB

registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001). In this context, no separate, nondescriptive meaning is formed. No novel spellings or unique juxtapositions are apparent in the mark to support a finding of a nondescriptive or suggestive meaning. The combination of REWARD and TV does not lend itself to any other meaning or significance other than identifying a quality or feature of the services, namely that rewards are given for watching TV.

In order to know who should be given rewards, the applicant must be able to determine who has actually watched the television programs. One way to track viewers is to have them provide answers to questions that only a person who watched the program would know. The fact that the applicant chose a trivia game as a method of identifying viewers does not amount to a series of questions or steps that would invoke imagination, thought or perception in a consumers mind such that it would make the mark nondescriptive. The mark is not suggestive simply because the trivia game feature of the services is not a part of the mark. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. It is enough if the term describes one attribute of the services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982). Ultimately, the mark REWARDTV describes at least one feature of the applicant's services, namely that viewers get rewards for watching television.

III. CONCLUSION

Given the record which contains the dictionary definitions of the terms in the proposed mark and the applicant's descriptive use of terms in the mark, it is clear that the applicant's proposed trademark is merely descriptive of a quality, characteristic, or feature of the applicant's services under Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). Accordingly, the refusal to register the proposed mark under Section 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

00119005795700

/Idi Aisha Clarke/
Trademark Attorney
Law Office 105
(703) 308-9105 Ext. 248
Fax: (703) 872-9825

Thomas G. Howell
Managing Attorney
Law Office 105
(703) 308-9105 Ext. 105