

To: Sabatino , Carl J. (tmcketny@kenyon.com)
Subject: TRADEMARK APPLICATION NO. 78696567 - THE CHRISTMAS CHANNE - 13118/2
Sent: 8/3/2007 8:37:07 AM
Sent As: ECOM117@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/696567

MARK: THE CHRISTMAS CHANNE

78696567

CORRESPONDENT ADDRESS:
ANTHONY GIACCIO, ESQ.
KENYON & KENYON
1 BROADWAY
NEW YORK, NY 10004-1007

RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Sabatino , Carl J.

CORRESPONDENT'S REFERENCE/DOCKET NO :
13118/2

CORRESPONDENT E-MAIL ADDRESS:
tmcketny@kenyon.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 8/3/2007

This Office action supplements the first office action sent on 8/3/07.

The first office action sent on 8/3/07 was inadvertently transmitted without certain evidence from the Lexis/Nexis database. Accordingly, the text of the first office action sent on 8/3/07 is restated in its entirety below, with the evidence from the Lexis/Nexis database appended at the end of the current office action. Please note that all other evidence referred to below was transmitted with the first office action sent on 8/3/07, or as part of prior office actions. The examining attorney regrets any inconvenience to the applicant.

This letter responds to applicant's communication filed on 6/5/2007.

Applicant's response to the additional information requirement has been entered into the record and accepted.

The refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

FINAL REFUSAL UNDER SECTION 2(e)(1) OF THE TRADEMARK ACT

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made **FINAL**.

Applicant argues that the mark THE CHRISTMAS CHANNEL is not merely descriptive of the applicant's services by asserting that (1) the mark does not immediately convey any information about the purpose or function of the services, and (2) that the mark is ambiguous and requires thought and imagination by the purchasers before they understand the significance of the mark as applied to the services.

The examining attorney disagrees. The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods or services, not in the abstract. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

Applicant's services are identified as "cable television broadcasting via a global computer information network." In this case, the wording "THE CHRISTMAS CHANNEL" immediately conveys to consumers that the applicant's cable television broadcasting services will feature Christmas-themed programming. (See attached definitions.) The examining attorney notes that the applicant has conceded in its response that its broadcasts will contain Christmas themed media and that portions of its broadcasts will feature Christmas programs and Christmas themed movies.

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. E.g., In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark so created imparts an incongruous meaning as used in connection with the goods and/or services. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive. E.g., In re Copytele Inc., 31 USPQ2d 1540, 1542 (TTAB 1994); Associated Theatre Clubs, 9 USPQ2d at 1662. (See attached definitions.)

As evidenced by the attached article excerpts from the Lexis/Nexis database and the Internet, Christmas themed programming is widely disseminated through many broadcast outlets, and the wording "Christmas channel" is used in the broadcasting industry to identify channels, stations, and websites that feature Christmas themed programming and information. (See attached articles.)

For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. In re Dial-a-Mattress Operating Corp., 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("[A] mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services.") (quoting In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

The fact that a term is not found in the dictionary is not controlling on the question of registrability. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).

The two major reasons for not protecting descriptive marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods or services; and (2) to avoid the possibility of costly infringement suits brought by the registrant. This thus enables businesses and competitors to have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382, 383 (C.C.P.A. 1968); Armour & Co. v. Organon Inc., 245 F.2d 495, 114 USPQ 334, 337 (C.C.P.A. 1957); In re Styleclick.com Inc., 58 USPQ2d 1523, 1526-1527 (TTAB 2001); In re Styleclick.com Inc., 57 USPQ2d 1445, 1448 (TTAB 2000). In this case to allow one registrant to exclusively use the wording "THE CHRISTMAS CHANNEL" would unjustifiably inhibit competitors from being able to accurately identify and market their Christmas channels that feature Christmas themed programs.

Thus it is clear that the wording THE CHRISTMAS CHANNEL is descriptive of the applicant's services and must be refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act. This action is **FINAL**.

RESPONSE GUIDELINES – FINAL ACTIONS

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). See 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

John Kelly /jmck/
Trademark Attorney
Law Office 117
571.272.9412
Fax: 571.273-9117 (official responses only)

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office's Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

LEXIS/NEXIS EVIDENCE

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MAIL-IT REQUESTED: AUGUST 2, 2007

10083K

CLIENT: JK
LIBRARY: NEWS
FILE: ALLNWS

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
CHRISTMAS W/1 PROGRAMMING

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 666

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
4-5,14,18-19,21-22,28,34,40,43,51,58,68,85,89,96

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