Attorney Docket 10210.3272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Fox Media LLC
Serial Number:	88423210
Filing Date:	May 9, 2019
Mark:	FOX ALTERNATIVE ENTERTAINMENT
Examining Atty.:	Marcya N. Betts
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Commissioner for Trademarks
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RESPONSE TO OFFICE ACTION

Fox Media LLC ("Applicant") submits the following in response to the Office Action dated July 29, 2019.

DISCLAIMER

The Examining Attorney requests a disclaimer of ALTERNATIVE ENTERTAINMENT apart from the mark as a shown. For the reasons set forth below, Applicant respectfully requests reconsideration and withdrawal of the refusal.

I. "ALTERNATIVE ENTERTAINMENT" Is Suggestive and Should Not Be Disclaimed

The Examining Attorney contends that Applicant must disclaim ALTERNATIVE ENTERTAINMENT "because it is not inherently distinctive" and is "merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's services." (Office Action, p. 2.) In support of her refusal, the Examining Attorney relies upon dictionary definitions for the separate terms "alternative" and "entertainment." Applicant respectfully submits that the Examining Attorney has failed to show that

Applicant's phrase "ALTERNATIVE ENTERTAINMENT" is merely descriptive and warrants a disclaimer.

A term is merely descriptive "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 or services." *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792, 1792 (TTAB 1996) (emphasis added); *see also In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); TMEP § 1213 *et seq*. The Federal Circuit in *In re Driven Innovations, Inc*. 115 USPQ2d 1261 (TTAB 2015) also made clear that "if the mental leap between the word and the [service's] attributes is *not almost instantaneous*, this strongly indicates suggestiveness, not direct descriptiveness." *See also Nautilus Grp., Inc. v. ICON Health & Fitness, Inc*., 372 F.3d 1330, 1340 (Fed. Cir. 2012). Similarly, a term that suggests a number of things but falls short of describing the services with any "degree of particularity" is suggestive, and not merely descriptive. *See In re TMS Corp. of Americas*, 200 USPQ 57, 59 (TTAB 1978).

Further, when analyzing the issue of descriptiveness, a trademark should not be broken down in to separate component parts, but rather should be examined as a whole. *Polymer Dynamics Inc. v. Cabot Corp.,* 13 USPQ2d 1220, 1222 (TTAB 1989). Even if one component of a phrase may be descriptive, the totality or combination of terms may create a distinctive phrase. *See In re Driven Innovations, Inc*. 115 USPQ2d 1261 (finding that a phrase with combined terms should be considered as a whole); *In re TBG Inc*., 229 USPQ 759 (TTAB 1986). Such is the case with the phrase ALTERNATIVE ENTERTAINMENT.

In this case, the Federal Circuit's decision in *Driven Innovations* and the prevailing case law supports the registration of Applicant's phrase ALTERNATIVE ENTERTAINMENT without a disclaimer. Here, the Examining Attorney relies on dictionary definitions for the separate words "alternative" and "entertainment." But this evidence does not show that the combined phrase ALTERNATIVE ENTERTAINMENT is merely descriptive of Applicant's services, namely, television transmission and broadcasting services, podcasts, or video-on-demand services, among other things.

Moreover, while "entertainment" alone may be descriptive, there is no evidence that consumers are exposed to or understand the meaning of the combined phrase—ALTERNATIVE ENTERTAINMENT—to *immediately and instantaneously* describe Applicant's services. The Examining Attorney's dictionary defines "alternative" as "available as another possibility or choice" and provides examples of "various alternative methods of resolving a dispute" or an "alternative lifestyle." But none of these definitions mention or apply to Applicant's services or even "entertainment." Indeed, the Examining Attorney has submitted no evidence that consumers will understand with specificity what ALTERNATIVE or ALTERNATIVE ENTERTAINMENT mean in relation to Applicant's services.

Further, the combination of ALTERNATIVE ENTERTAINMENT is inherently vague in relation to Applicant's services. In fact, the juxtaposition of the combined terms "ALTERNATIVE" and "ENTERTAINMENT" creates a play on words and suggestive impression. These terms are not normally used together or combined to convey any *immediate* meaning in relation to Applicant's services, including television transmission and broadcasting services, podcasts, or video-on-demand services,

among other things. This incongruous combination instead raises questions in consumers' minds, for example, whether Applicant's services are an "alternative" to "entertainment," if so, how, and what is offered. The terms ALTERNATIVE ENTERTAINMENT may also suggest a different kind of "entertainment," but at the same time fail to immediately describe the identified services with any "degree of particularity." This type of mental process consumers must use to reach any conclusion as to the nature, feature, and purpose of Applicant's services is the hallmark of suggestiveness. *See In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978). Accordingly, the phrase ALTERNATIVE ENTERTAINMENT does not meet the standard of descriptiveness for Applicant's services and should not be disclaimed.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the application for publication.