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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Publishing Agency, Inc.

Serial No. 76/132,747

Norris D. Wolff of Kleinberg, Kaplan, Wolff & Cohen, P.C.
for The Publishing Agency, Inc.

Sonya B. Stephens, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 22, 2000, applicant, a Delaware
corporation, filed the above-referenced application to
register the mark "BrandedContent" on the Principal
Register for services which the application described as
follows: "applicant creates a digitally stored body of
content - words, images and sound - to serve the marketing
communications purposes of a specific brand or group of

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brands. The service includes establishing which body of content is appropriate for a brand or group of brands; overseeing the creation and editing of the content, storing the content digitally; preparing the content for publication in any medium, traditional or interactive; and distributing the content in any form, including the form specifically requested by the customer." Applicant claimed first use of the mark in connection with its services on September 1, 2000, and first use of it in commerce in connection with the services on the same day.

In addition to finding that the recitation of services and the specimen of use were unacceptable, the Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. 1052(e)(1), on the ground that the mark is merely descriptive of the services set forth in the application. In support of the refusal to register, she submitted the results of a search she conducted of the Lexis Nexis database of publications. Included were a number of examples of the term "branded content" used in connection with information provided on websites by sponsors. Examples include the following:

"Consider the e-book as a new-technology channel of distribution for all kinds of branded content." Forbes, September 18, 2000.

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"As a start-up Internet-based branded content creation, production, distribution and marketing company, we're really the Disney of the 21st century." August 21, 2000 edition of the Los Angeles Business Journal.

"KnowHow Inc., an Eden Prairie publisher of branded, authoritative content in the online learning marketplace..." February 4, 2000 edition of Citibusiness.

"Time Warner, for its part, had failed to implement a viable Net strategy, despite the advantages of unique branded content, multiple routes to market and broadband delivery." January 27, 2000 edition of Marketing Week.

"My view is that the concept is consistent with one of Disney's core strengths, which is marketing branded content," he said." September 14, 1997 edition of the San Diego Union-Tribune.

and

"Our strategy is to use branded content of the highest quality, to make full use of all the programming groups at ABC..." May 13, 1995 edition of Billboard.

Applicant responded to the first Office Action by amending the recitation of services in the application to read as follows: "preparing print, audio and visual presentations for use in advertising name brand products, in International Class 35; and database development services, namely development of databases which serve the marketing communications of a specific brand or group of brands, in International Class 42."

Applicant argued that the refusal to register under Section 2(e)(1) of the Act was not well taken because "BrandedContent" is "arbitrary and fanciful," rather than

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merely descriptive of applicant's services. Applicant provided long lists of what it argued were registered marks which consist of or include the word "brand" or the word "content," and argued that the search which the Examining Attorney conducted which resulted in the above-referenced excerpts was premised on "faulty methodology."

The Examining Attorney was not persuaded by the arguments of applicant. She accepted the amendment to the recitation of services, but made final the refusal to register under Section 2(e)(1) of the Act. She found the specimens of record to be proper for Class 35, but maintained and made final the requirement for acceptable specimens showing use of the mark in connection with the services in Class 42.

Included as additional support of the refusal were more excerpts from published articles referring to "branded content." The March 13, 2001 edition of the San Jose Mercury News, for example, noted that "[a]dvertising types say consumers can expect to see a lot more of this advertiser-produced entertainment, which they call 'branded content.'" The June 26, 2000 edition of Newsbytes stated that "Asiaconent.com" is "an Asian Internet company integrating branded content sites, Internet advertising and e-commerce services..." In addition to the excerpted

articles, the Examining Attorney submitted copies of pages from various websites wherein different businesses promoted their services of creating or presenting branded content on Internet websites. "Ask Jeeves," for example, lists "Branded Content" as one of the features of its advertising services, and states that "Branded Content provides Ask Jeeves users with engaging, relevant content about your brand at the moment they are in the most appropriate mindset: when they're asking a related question." Another website features information about health care promotional strategies. Under the heading of "Branded Content/Featured Sponsor," it states that "[b]randed content is an excellent means of online sponsorship. It gives the sponsor an opportunity to provide the necessary product or service to the consumer while linking their name to that product or service."

Applicant responded by making of record a number of the third-party registrations it had listed in response to the first Office Action, and asking the Examining Attorney to consider applicant's arguments on the issue of mere descriptiveness in light of such registrations. Applicant simultaneously filed a Notice of Appeal and its Appeal Brief. The appeal was instituted by the Board, but action on it was suspended and the application was remanded to the

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Examining Attorney for consideration of the third-party registrations. She was not persuaded thereby to withdraw the refusal to register or the requirement for specimens for Class 42, so the file was returned to the Board for resumption of action on the appeal.

In applicant's brief and in the Notice of Appeal, applicant states that in view of the acceptability of its specimens for the Class 35 services, applicant is choosing to proceed only as to that class. The fee to appeal as to only one class of services was submitted. In view of applicant's actions, we deem the application to have been amended to delete reference to the services in Class 42. This makes the requirement for proper specimens for that class a moot issue.

This appeal goes forward, then, only on the question of whether applicant's slightly stylized presentation of the term "BrandedContent" is merely descriptive of applicant's service of "preparing print, audio and visual presentations for use in advertising name brand products."

The test for determining whether a mark is merely descriptive of services within the meaning of Section 2(e)(1) of Lanham Act is well settled. Under this section, a mark is unregistrable if it describes with particularity a characteristic, feature, function or purpose of the

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services. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). This determination is made by considering the mark in relation to the services specified in the application, rather than by considering the mark in the abstract. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Combining two descriptive words without spaces between them will not result in a mark which is registrable unless the combination thus formed yields a term which is not merely descriptive in connection with the services with which it is used. In re Associated Theater Clubs Co., 9 USPQ2d 1660 (TTAB 1986).

In the case before us, the record supports the refusal to register. The mark "BrandedContent," as shown in the drawing submitted with the application, is merely descriptive of preparing presentations for advertising name brand products because the mark identifies a significant feature or characteristic of applicant's services, namely that applicant's clients use the presentations that applicant prepares as branded content for advertising their name brand products.

The computer dictionary definition submitted by the Examining Attorney demonstrates that the word "content" is used to refer to "information or text provided by a

publisher that is useful or of interest to a user." The record establishes that the term "branded content" is used in the field of advertising and marketing to refer to the marketing technique of associating a particular brand name for products or services with content which relates to the products or services in order to sell such products or services. A seller of pet foods may, for example, sponsor a website about dogs and cats wherein information is provided on subjects such as how to select a family pet, how to housebreak such an animal, what to feed it and how to find a veterinarian. The information provided on such a website is known as "content." Along with making such content available, the business sponsoring a website presents its brand name so that visitors to the website associate that brand with the relevant information or products and will know about the brand and purchase the goods or services sold under it.

The record is very clear that such content, when it is associated with a brand, is called "branded content." The presentations that applicant prepares for use in advertising name brand products become branded content when brand names are used in association with it. As applicant stated in its original recitation of services, "applicant creates a digitally stored body of content... to serve the

marketing communications purposes of a specific brand or group of brands." Applicant's services include "preparing the content for publication in any medium, traditional or interactive." Applicant prepares content for its clients, and when such content is linked to a client's brand, it is known as "branded content."

Applicant's criticism of the search methodology the Examining Attorney employed in order to retrieve the publication excerpts quoted above is unwarranted. How the Examining Attorney located these examples of use of the term "branded content" is not relevant to the issue of the meaning of the term in question.

In a similar sense, that other businesses have registered marks which include variations on the word "brand" or on the word "content" is not determinative of the issue before us, i.e., whether "BrandedContent" is merely descriptive in connection with the services recited in this application.

Because the term describes a significant feature or characteristic of applicant's services, it is unregistrable under Section 2(e)(1) of Lanham Act. Presenting this descriptive term with no space between the two words does not result in a term without a descriptive connotation in connection with these services. To the contrary, the

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descriptive significance of "branded content" is not altered by presenting the term as "BrandedContent."

DECISION: The refusal to register under Section 2(e)(1) of the Act is affirmed.