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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Points.com Inc.

Serial No. 76359741

Thad N. Leach of Lewis, Rice & Fingersh, L.C. for  
Points.com Inc.

Esther A. Belenker, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

Before Chapman, Bucher and Grendel,<sup>1</sup> Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Points.com Inc. (a Canadian corporation) filed on  
January 17, 2002 an application to register on the  
Principal Register the mark shown below

*. global*  
**points**  
*xchange*

<sup>1</sup> Formerly known as Bottorff.

for services identified as "providing a web site on the global computer network for the tracking and redemption of customer loyalty rewards" in International Class 35. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant disclaimed "points xchange."

The Examining Attorney refused registration on the ground that applicant's mark is merely descriptive of applicant's services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

As a preliminary matter, we will address the new evidence attached to applicant's brief on the case. Applicant, citing to TBMP §1207.01 (2d ed. June 2003), asserts that Exhibits A and B, printouts of two additional pages from its website, are allowed because the Examining Attorney made a few pages from applicant's website of record in her Final Office action. (See applicant's brief, footnote 5.) Regarding Exhibits C-W, printouts of third-party registrations from the USPTO's Trademark Electronic Search System (TESS), applicant acknowledged that third-party registrations were not previously filed, but

applicant requested that the Examining Attorney stipulate them into the record. (See applicant's brief, footnote 8.)

The Examining Attorney did not stipulate any of the late-filed evidence into the record. The third-party registrations are clearly untimely under Trademark Rule 2.142(d), as recognized by applicant. With regard to applicant's argument that the two pages from its website should be allowed into the record, the TBMP section cited by applicant in support thereof refers to situations where one side submitted excerpted stories retrieved from the Nexis database and the other side submitted the full stories with its brief. The situation in the case now before us is quite different and involves a different source. Here, applicant submitted pages from its website not previously submitted into the record by either the Examining Attorney or applicant. The transitory or changing nature of websites (i.e., Internet postings may be modified or deleted at any time) is not analogous to the printout in full format of a story previously submitted in excerpted format from a printed publication. See *In re Trans Continental Records Inc.*, 62 USPQ2d 1541, footnote 2 (TTAB 2002).

Applicant could have requested a remand under Trademark Rule 2.142(d), but chose not to do so. We have

not considered applicant's untimely filed Exhibits A-W. We add that even if considered, they would not alter our decision herein.

The Examining Attorney argues that the words "global," "points" and "exchange" have dictionary meanings relating in a descriptive manner to applicant's services; that applicant's minor misspelling of the word "xchange" does not alter that it is perceived by consumers as "exchange"; that the concept of exchanging points earned for shopping for various things such as flying on certain airlines, or buying from certain vendors or exchanging the points for gifts, merchandise and services is not new; that the phrase "points exchange" and thus, "points xchange" is merely descriptive of applicant's services (and is disclaimed by applicant); that even if the term "global" has several meanings, if any of the meanings is merely descriptive in relation to applicant's services, then the overall mark is merely descriptive; that it is not necessary that a mark describe all functions, characteristics or features of the services, it need only describe one such attribute; and that the slight stylization of the fonts of the words GLOBAL POINTS XCHANGE in applicant's applied-for mark does not obviate the mere descriptiveness of the phrase. The Examining Attorney concludes that the phrase GLOBAL POINTS

XCHANGE informs the purchasing public that applicant's services allow customers to exchange points in a comprehensive manner and are accessible anywhere in the world via the Internet; and that the phrase is therefore merely descriptive of the desirable feature of applicant's services, which are global, i.e., comprehensive in nature and are available on the Internet.

In support of the descriptiveness refusal, the Examining Attorney has made of record the following definition from The American Heritage Dictionary (Third Edition 1992):

- (1) **global** adjective 2. Of, relating to, or involving the entire earth, worldwide... 3. Comprehensive; total...;
- (2) **point** noun 20. A single unit, as in counting, rating, or measuring...; and
- (3) **exchange** noun A place where things are exchanged, especially a place where stocks or commodities are bought and sold: a stock exchange.

The Examining Attorney also submitted (i) copies of numerous excerpted stories retrieved from the Nexis database to show how applicant and others use the words "points exchange" in the context of the type of service offered by applicant; and (ii) certain pages printed from

four websites (including applicant's) to show that, with regard to the word "global," applicant itself promotes its services as a points exchange with global aspects, and that other services utilize "global" in the same sense.

Examples of the excerpted stories retrieved from the Nexis database include the following (emphasis added):

Headline: Surviving the Time-Share Sharks' Attack Visitors to Mazatlan Bombarded with Offers  
...In our hotel lobby, we were swarmed over by smartly dressed young women pushing a frequent-flier-style **points-exchange** program. ... "The Denver Post," October 5, 2003;

Headline: A Custom Time Share; Marriott Vacation Club Betting Millions Historic Tower Will Satisfy Need of Those Seeking an Urban Destination  
...Every other year, for example, owners of the Boston time shares would be allowed to trade their week for points that could be used for stays at Marriott hotels worldwide or for cruises, air travel and rental cars. The **point exchange** has not been set yet, but at many resorts, one week during high season equals seven nights at a Marriott hotel or two roundtrip air tickets. ... "The Boston Globe," October 3, 1995;

Headline: Weathering Severe Turbulence  
... The SkyMiles and Mileage Plus programs also suffered the same blow in March when partner Hilton Hotels announced it was suspending a **point exchange** program with their two airlines.... "Credit Card Management," May 2003; and

Headline: Hyatt Benefits from Outsourcing  
..Customers calling 1-800-GO HYATT speak to an employee in the Interval Resort & Financial Services Group who makes reservations for them at their own resort, another Hyatt resort or at one of the Hyatt hotels that participate in Interval Internationals' **point exchange** system. "Lodging Hospitality," March 15, 2000.

Applicant's website includes the following statements regarding "global":

Great Pacific International, Inc. (GPI, TSX Venture:GPI) a global provider of loyalty program enhancements, and Points International Ltd. (Points, TSX Venture:PTS) today announced that GPI has acquired an agreement with Points.com Inc., a wholly owned subsidiary of Points.

...  
Through a portfolio of custom technology solutions, Points is building rewarding partnerships with the world's leading player loyalty players. ...

Applicant urges reversal of the refusal arguing that the term "global," when used in connection with applicant's identified services, may suggest any of the following meanings to consumers (brief, p. 6.):

"(1) applicant's services are comprehensive, complete or total in scope; [applicant's footnote omitted]

(2) applicant's services may be accessed anywhere in the world via the Internet;

(3) applicant's services have an aura of sophistication and international travel;

(4) applicant's services are of terrestrial origin; and/or

(5) applicant's services are leading, significant and important."

Applicant contends that the Examining Attorney essentially argues that "global" relates to the first two items listed, but applicant argues that when "global" is used in connection with miles and points earned in the travel industry, much more is conveyed than that the points could have been earned anywhere in the world or that the services may be accessed from anywhere in the world; that the mark is not merely descriptive because the term "global" conveys at least one meaning to consumers of applicant's identified services that is at least suggestive; and that the term means the latter three items listed. Applicant further argues that third-party registrations on the Principal Register for internet-related services which incorporate the word "global" support its argument that the mark is suggestive;<sup>2</sup> that "the distinctive and stylized display of the mark" strengthens

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<sup>2</sup> However, these third-party registrations have not been considered, as explained previously in this decision.

consumer perception of the phrase as a mark; and that doubt is resolved in applicant's favor.<sup>3</sup>

Specifically applicant argues as follows (brief, pp. 9-10):

"...the mark GLOBAL POINTS XCHANGE (stylized), as used in connection with Applicant's services,<sup>4</sup> is suggestive rather than merely descriptive because a single descriptive meaning is not immediately apparent from the Mark as applied to the identified services. See *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1536 (TTAB 1988)('the fact that a

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<sup>3</sup> In addition, applicant argues that the word "global" does not identify any particular geographical location, and applicant cited to cases wherein the words "world" and "globe" were found not geographically descriptive, and in footnote 6 of its brief, applicant explained as follows:

Applicant is aware that the Trademark Attorney has never expressly refused to register the mark on the Principal Register based upon being "primarily geographically descriptive" under Section 2(3)(2) of the Trademark Act. Nevertheless, the Trademark Attorney has consistently described Applicant's services as an "international, or global, exchange" and respecting points earned from "all around the world, that is, globally," which appear to characterize Applicant's services in geographic terms, rather than in merely descriptive terms.

Inasmuch as applicant's mark has not been refused registration on a geographically descriptive basis, we shall not further address this argument.

<sup>4</sup> While applicant argues with regard to use of the mark, applicant has not submitted an Amendment to Allege Use, and thus there are no specimens of record. The Examining Attorney has submitted printouts of pages from applicant's website. (Applicant submitted other pages from its website which have not been considered, as explained previously in this decision.) The pages from applicant's website do not indicate use of the applied-for mark for the identified services. This record includes no evidence of use of the applied-for mark.

descriptive word has a double meaning may indicate that the word is not 'merely descriptive' of the ... services.'). The Mark operates to not only describe a customer loyalty reward program that may be accessed anywhere in the world via the internet, but it also (i) suggests that such services are leading, important, significant and terrestrial in nature and (ii) provides an attractive allusion of international travel. The Mark is therefore registerable on the Principal Register. (case citations omitted) TMEP §1213.05(c) ('The mark that comprises the 'double entendre' will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the ... services.')

Ultimately, applicant contends as follows in its reply brief (p. 2):

The Examining Attorney's interpretation of the law is not correct as applied to the facts of this appeal. A mark may be registered on the Principal Register if the mark is suggestive, notwithstanding the fact that it may also convey a descriptive meaning to the ordinary consumers of the goods or services. Section 1213.05(c) of the Trademark Manual of Examining Procedure provides that "[t]he mark that comprises the 'double entendre' will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the...services." The leading treatise on trademark law similarly provides that "[a] mark that connotes two meanings - one possibly descriptive, and the other suggestive of some other association - can be called suggestive, as the mark is not 'merely' descriptive." 2 J.

Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §11:19, 11-30 (2001). This is due to the fact that 'merely means 'only.'

The test for determining whether a term or phrase is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.* 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

Finally, it should be noted that a term or phrase may be "descriptive though it merely describes one of the qualities or properties of the goods [or services]." In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

We find that the phrase "GLOBAL POINTS XCHANGE" is merely descriptive of the subject matter of applicant's services of providing an Internet website for the tracking and redemption (or exchange) of customer loyalty rewards. We agree with the Examining Attorney that applicant's use of the term "xchange" (deleting the letter "e"), if noticed by purchasers, would still be understood by purchasers to mean "exchange." The words forming applicant's mark are English words with dictionary definitions, which would be generally understood by the relevant purchasers of applicant's services. It is clear on this record that

"points exchange" refers to an exchange of points in customer loyalty programs; and that these words immediately convey information about the nature and purpose of applicant's services. "Global" is defined as of or relating to the entire earth -- worldwide, or comprehensive and total. While applicant argues that the term has several other non-dictionary but "double entendre" meanings -- specifically, (i) sophistication and international travel, (ii) leading or significant or important, and (iii) terrestrial origin -- it has provided no evidence that consumers would so understand or perceive the term "global" in the context of applicant's services. Rather, we are of the opinion, based on this record, that consumers will understand the term "global" in its dictionary senses of worldwide and comprehensive, and thus, that applicant's services involve a comprehensive exchange of points earned in loyalty reward programs and that the services are accessible worldwide via the Internet.

Applicant's contention that the word "global" has "double entendre" meanings and therefore the mark is not merely descriptive is not persuasive. Applicant submitted no evidence of any non-dictionary meanings. Even if we assume *arguendo* that there are non-dictionary meanings or concepts related to the world "global," applicant submitted

no evidence of consumer perception of those asserted meanings or concepts and particularly in relation to applicant's services.

The cases applicant cites with regard to "double entendre" meanings include *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for bakery products); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994) (MufFuns (stylized lettering) for baked mini muffins); *Ex parte Barker*, 92 USPQ 218 (Comm. 1952) (CHERRY-BERRY-BING for fruit and berry preserves); and *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 USPQ 55 (2nd Cir. 1961) (patent and trademark infringement and unfair competition involving POLY PITCHER for pitchers).

As stated by our primary reviewing Court in *In re Gyulay*, supra, 3 USPQ2d at 1010 when addressing that applicant's reliance on the *Blisscraft of Hollywood* case:

*Blisscraft* held that "'Poly Pitcher' ... is an incongruous expression, and has the characteristics of a coined or fanciful mark", more suggestive of Molly Pitcher than descriptive of polyethylene. *Id.* APPLE PIE is not a coined or fanciful expression and does not benefit from this ruling.

Likewise, in the case now before us involving the phrase GLOBAL POINTS XCHANGE (in stylized lettering), we do not

find on this record that the word "global" in the phrase "global points xchange" has a double entendre meaning. Rather, here "global" (in "global points xchange") describes a key characteristic of applicant's identified services.

When we consider the mark GLOBAL POINTS XCHANGE (in stylized form) as a whole, and in the context of applicant's services, we find that the phrase immediately informs consumers that applicant's services involve providing a comprehensive points exchange program which is accessible worldwide.

Moreover, the combination of these English words does not create an incongruous or unique mark, but instead, when used in connection with applicant's identified services, "GLOBAL POINTS XCHANGE" immediately describes, without need of conjecture or speculation, an essential characteristic of applicant's services. No exercise of imagination or mental processing or gathering of further information is required in order for purchasers or prospective customers for applicant's services to readily perceive the merely descriptive significance of the phrase GLOBAL POINTS XCHANGE as it pertains to the identified services in connection with which applicant asserts a bona fide intention to use the mark. See *In re Gyulay*, supra; *In re*

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Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505 (CCPA 1980); In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999); In re Patent & Trademark Services Inc., 49 USPQ2d 1537 (TTAB 1998); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

While evidence of descriptive use of the multiple words together is generally persuasive that such a multiple word mark is merely descriptive, there is no requirement that an Examining Attorney must obtain evidence of all the words used together in order to make a prima facie showing that a multiple word mark is merely descriptive.<sup>5</sup> See In re Nett Designs Inc., supra (Court affirmed Board holding THE ULTIMATE BIKE RACK merely descriptive and subject to disclaimer for carrying racks for mounting on bicycles and accessories for bicycle racks, namely attachments for expanding the carrying capacity of a carrying rack.) See also, In re Shiva Corp., 48 USPQ2d 1957 (TTAB 1998).

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<sup>5</sup> The issue here is not whether the phrase is generic for applicant's identified services, but rather is whether the phrase is merely descriptive in the context of applicant's services.

We are not persuaded that the two font styles and sizes of the words "global," "points" and "xchange" present a "distinctive and stylized display" which overcomes the mere descriptiveness of the phrase. The words are simply presented in all lower case letters, in two rather normal fonts.

Finally, even if applicant was the first (and/or only) entity to use the phrase "global points xchange" (stylized lettering) in relation to providing a website for tracking and redeeming customer loyalty rewards, such is not dispositive where, as here, the phrase unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2005).

**Decision:** The refusal to register on the ground that the proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.