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Sent: 6/5/2014 11:43:10 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 85077031 - 1-800-TIRE-911 - 1033821-0006 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85077031

MARK: 1-800-TIRE-911



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Michelin North America, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

1033821-0006

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the service mark 1-800-TIRE-911 on the ground that it is merely informational and fails to function as a service mark within the meaning of Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051-1053, 1127.

FACTS

On July 27, 2010, Michelin North America filed a use-based application for the service mark 1-800-TIRE-911 in standard characters for a variety of vehicle related services in the field of “emergency roadside services.”¹ In addition to requiring applicant to identify the goods more specifically, the examining attorney refused registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051-1053, 1127, because the proposed mark, as used on the specimen of record, did not function as a service mark. Applicant responded by amending the basis of the application to intent-to-use under Section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), and properly specifying the nature of the emergency roadside services in International Classes 37, 39, and 45.²

Upon submission of the Statement of Use, the examining attorney again refused the application because the proposed mark, as used on the specimens, does not function as a service mark. The examining attorney also required additional specimens to show use with the specific roadside services in International Class 39 and 45. On July 8, 2014, the refusal for failure to function as a service mark and requirement for additional specimens were made Final. Applicant’s request for reconsideration included acceptable specimens showing use with the services in classes 39 and 45. However, reconsideration of the refusal for failure to function as a service mark under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127 was denied. The appeal now follows.³

ARGUMENT

¹ Application Serial No. 85077031 was filed under Trademark Act Section 1(a), 15 U.S.C. 1051(a).

² Application was published for opposition on November 8, 2011.

³ Appeal filed January 2, 2014.

THE MARK FAILS TO FUNCTION AS A SERVICE MARK BECAUSE IT MERELY PROVIDES INFORMATION ABOUT HOW TO CONTACT THE APPLICANT.

Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051-3, and 1127, provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods or services. See TMEP §1202. In *In re Standard Oil Company*, 125 USPQ 227, 229 (CCPA 1960), the Court of Appeals stated, "[t]he Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or service mark) and, unless words have been so used, they cannot qualify for registration."

A. The Inherent Nature of the Mark in the Format of a Toll-Free Vanity Telephone Number Would be Immediately Recognized as the Means to Contact Applicant and not as a Source-Indicator.

Consumers would immediately recognize the format of the alphanumeric designation 1-800-TIRE-911 as the means to contact applicant by telephone in order to obtain the services. The "1-800" prefix in applicant's mark signifies to consumers that the proposed mark is the toll-free telephone number⁴ that a potential consumer would use if in need of roadside assistance services. The Trademark Trial and Appeal Board in *In re Page*, 51 USPQ2d 1660, 1664-65 (TTAB 1999), stated, "the 888 prefix in the mark does not have any source-identifying significance. Rather, in our view, the number will be readily perceived as nothing more than the prefix used in a toll-free telephone number, without trademark (or service mark) significance."⁵ See also, *800 Spirits v. Liquor by Wire*, 14 F. Supp. 2d 675,

⁴ See definitions of "800 numbers" at Exhibit 2 attached to Denial of Request for Reconsideration, August 20, 2013.

⁵ Applicant's statement that *In re Page* is "inapposite" is misplaced. (Applicant's brief at 9, n.5). The statement by the Board in *Page* is directly pertinent to consumer perception of the numeric prefix. It

681 (D.N.J. 1998) (“within the circumstances of telephone number designations, the number 800 is a functional term that represents a toll-free area code”).

Because applicant’s proposed mark begins with a toll free telephone number designation, the substance of applicant’s mark is merely informational in nature. The use of an alphanumeric telephone number, beginning with a toll free number designation, is much like the use of a website address that begins with “www.” and ends with “.com”. In *In re Eilberg*, 49 USPQ2d 1955, 1956 (TTAB 1998), the Board stated, “the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant’s website appears. It does not separately identify applicant’s legal services as such.” *See also, In re Roberts*, 87 USPQ2d 1474, 1479 (TTAB 2008) (IRESTMYPAGE used in website address served only as an “address by means of which one may reach applicant’s Internet website” and not also used to indicate the source of applicant’s legal services.)

In the same way as an Internet website address, a physical address, or other designation that provides information about the applicant, a telephone number immediately imparts information about how to reach applicant regardless of whether the alphanumeric number contains descriptive wording. Where the substance of the designation is informational in nature, the presumption is that the use thereof is for informational purposes. Consequently, the mark must be clearly used and displayed as a source-indicator. *See, e.g., Id* at 1481 n.2 (Board noted that due to the highly suggestive nature of applicant’s mark, perception as a service mark is even more dependent on specimen displaying proper use as a mark).

addresses the “inherent nature” of the mark as a telephone number and supports the examining attorney’s contention that the mark is merely informational in nature. The fact that the issue in *Page* was mere descriptiveness is irrelevant.

Applicant argues that the unique content, structure and substance of its number-word combination “is not merely informational or merely descriptive in nature.”⁶ However, “[w]ords are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated.” *In re Standard Oil Company*, 125 USPQ 227, 229 (CCPA 1960) (Emphasis in quoted matter). Additionally, the fact that applicant’s alphanumeric telephone number, also known as a vanity number, is not in the standard format for telephone numbers does not affect how consumers would initially perceive the vanity number that begins with the toll free area code 1-800. In the Final Action, the examining attorney attached several examples of web pages for third-party providers of roadside assistance services where the provider uses a toll free vanity number containing distinctive wording to identify the means to reach the roadside assistance provider.⁷ The examples include the following:

Call 1-800-ALLSTATE (1-800-255-7828)

Need help? 1.800.MYAMFAM (692.6326)

1-800-PROGRESSIVE

Help is just a call away 1(800) HelpPoint.

Or, dial 1-87-ROADSIDE (1877-623-7433).

This evidence shows that, in the field of roadside assistance, consumers are familiar with emergency service providers using unique or memorable toll-free vanity telephone numbers and would clearly recognize the designation as telephone dialing information. Consequently, consumers would

⁶ Applicant’s brief at 6.

⁷ See Final Action, July 8, 2013.

immediately recognize the *inherent nature* of applicant's proposed mark as the toll-free telephone number used to access applicant's services.

B. As Used on the Specimens of Record, Applicant's Proposed Mark Merely Functions as a Telephone Number and Does not Separately Indicate the Source of the Services.

In order to function as a service mark, the asserted mark must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application. TMEP §1301.02(a). A mark that is in the form of an alphanumeric telephone number (e.g., 800 or 888 followed by wording) may be registrable on the Principal Register without a showing of acquired distinctiveness if the wording is not merely descriptive or generic for the services. However, "the designation must also be used in the manner of a mark." TMEP §1209.03(l). Whether the designation functions as a mark that identifies and distinguishes the recited services is determined by examining the specimens and any other evidence in the record that shows how the designation is used. *In re Morganrath*, 208 USPQ 284, 287 (TTAB 1980).

In connection with its Statement of Use, applicant submitted a specimen that appears to be a brochure advertising applicant's emergency road services. Applicant's previously registered mark MICHELIN® is displayed at the top of the specimen. The proposed mark 1-800-TIRE-911 is displayed below the informational wording "Consistent, High-Quality, 24-Hour Emergency Road Service" in a slightly smaller font. It is immediately preceded by the wording "MICHELIN ONCall". The numerical digits of the telephone number appear directly beneath the mark. The proposed mark is displayed similarly throughout the specimen.

As used on applicant's specimens of record, consumers are likely to view the proposed mark as merely providing information about how to contact applicant regarding its "On Call" services. The

definition of “on call” is: available when called for or summoned.⁸ In the August 20, 2013 denial of reconsideration, the examining attorney provided evidence of several third-party registrations containing the term “ON CALL” that are either registered on the Supplemental Register or include a disclaimer of “ON CALL”.⁹ The third-party registrations confirm the descriptiveness of the term when communication by phone is a characteristic of the services. Contrary to applicant’s contention, whether applicant is using or intends to use the wording MICHELIN ONCall as a trademark on the specimen is irrelevant because the term “ONCall” does not lose its descriptive or informational meaning merely because it is used within a service mark.¹⁰ Therefore, consumers would clearly recognize that the use of 1-800-TIRE-911 following the informational wording “ONCall” is solely for use as a vanity telephone number through which applicant’s services may be obtained. Thus, consumers would view this use on the specimen only as a statement that applicant can be summoned by dialing the telephone number that follows “ONCall”.

Additionally, the use of the numeric telephone number directly beneath the mark further emphasizes the informational quality of the mark. As several of the third-party web pages indicate, it is a common practice to provide the numeric telephone number in connection with the vanity number for those who may find numeric version easier to follow when dialing.¹¹ Because applicant’s mark follows a descriptive term and is then followed by the numeric telephone number, the mark is used in the context of informational matter. The specimen first identifies that applicant can be reached by telephone (“ONCall”), and then provides the toll-free alphanumeric telephone number to reach applicant. The nature of the proposed mark as a telephone number is affirmed by the provision of the numeric digits

⁸ Collins Online American English Dictionary, www.collinsdictionary.com (2014).

⁹ On page 5 of its brief, applicant claims the term “OnCall” as one of its unregistered service marks despite the fact that being on call is a primary feature of emergency services. This claim is also contrary to the third-party registrations in evidence disclaiming the wording “on call”.

¹⁰ Applicant’s brief at 14.

¹¹ See Final Action, July 8, 2013.

below it. Accordingly, this use of the alphanumeric telephone number on the specimen does not separately identify the source of the services.

Applicant argues that the fact that the proposed mark appears in the same large size and font as the service mark above it and is also used with the trademark designation symbol (™) weighs in favor of finding that consumers would also perceive 1-800-TIRE-911 as a trademark.¹² However, the size of the proposed mark does not make it registrable if it is not used in a manner that would be perceived by consumers as an indicator of source. *See, In re Wakefern Food Corp.* 222 USPQ 76 (TTAB 1984). For services such as emergency roadside services, where being able to contact the service provider by telephone is very important, merely emphasizing the telephone number would not appear to change its informational significance to the relevant public.

Additionally, the presence of the “TM” symbol merely shows applicant’s intent to claim the applied-for mark as a trademark and is not an indicator of whether the telephone number is actually perceived by the public as a source-indicator. “[T]he use of the “TM” does not, ipso facto, make a trademark or service mark out of the term or expression in connection with which it is used. Wishing does not make a trademark or service mark be.” *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) (citations omitted); *See also, In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984). By Applicant’s reasoning, if its numeric telephone number 1-800-847-3911 were also used in a larger font and followed by the “TM” symbol, consumers would also perceive that number as a source-indicator because it is not descriptive of the services.

Applicant further argues that the cited authorities support its position in that they recognize that informational marks *may* be registrable if used in a manner that indicates source.¹³ However, whether vanity telephone numbers are registrable if used appropriately is not in dispute. The Board’s

¹² Applicant’s brief at 5.

¹³ Applicant’s brief at 7, citing *In re Eilberg*, 49 USPQ2d 1955, 1956 (TTAB 1998)

example of acceptable use in *In re Eilberg*, 49 USPQ2d 1955, 1956 (TTAB 1998), provided that, if the website address were presented prominently “as the name under which applicant was rendering its legal services, then that mark may well be registrable.” In this case, applicant’s asserted mark is clearly not presented as the name under which the services are rendered or in any other manner that would be perceived as a source indicator.

Applicant’s use of its name or house mark MICHELIN® and the service mark MICHELIN ONCALL clearly signifies that the proposed mark 1-800-TIRE-911 is merely a means to contact applicant. Throughout the specimens, applicant refers to its services by the name “MICHELIN ONCall service”. For example, applicant’s specimens submitted November 28, 2013 state the following:

MICHELIN ONCall service can bring Michelin dependability to your emergency road service needs.

MICHELIN ONCall is available to Fleets large and small as well as Owner-Operators.

You don’t have to be a registered Premier fleet to use the MICHELIN ONCall service, but registration will save you time and help us provide fast service to your specification and provide you with the reporting benefits you deserve.

It is clear from the emphasis on “MICHELIN ONCall service” that consumers would perceive MICHELIN ONCall as the source of the services and, consequently, as the sole service mark for the emergency roadside services. As used on the specimen, the proposed mark 1-800-TIRE-911 merely provides contact information and is not separately used in a manner that would indicate the source of the services.

Regarding use of a mark as a trademark, Professor Thomas McCarthy states the following:

For a designation to become a trademark, “it must be used in such a manner that its nature and function [as a trademark] are readily apparent and recognizable without

extended analysis or research and certainly without legal opinion.” (Case citations omitted). In other words, if it takes extended analysis and legalistic argument to attempt to prove that a designation has been used in a trademark sense, then it has not. In the ordinary course of shopping, customers do not spend long periods of time examining labels and advertising copy with a magnifying glass. Usually, if when viewed in context, it is not immediately obvious that a certain designation is being used as an indication of origin, then it probably is not. In that case, it is not a trademark.

McCarthy on Trademarks and Unfair Competition, Fourth Edition, §3.3. In this case, it is clearly not immediately obvious to consumers that applicant is separately using its telephone number, which provides the information needed to contact applicant, as an indicator of the source of its services.

C. Applicant’s Evidence Consisting of Third-Party Registrations is not Relevant to this Refusal which is Based on How Applicant Uses its Mark.

As evidence in support of registration, applicant has submitted copies of several third-party registrations for other toll-free telephone numbers that have been registered by the Office.¹⁴ Applicant argues that the fact that other telephone numbers were accepted by the Office “is probative of the fact that Appellant’s mark, as shown on the specimen of record, also would be perceived by consumers as having source-identifying function.”¹⁵ This argument is incorrect and contrary to well-established case law.¹⁶

¹⁴ The Examining Attorney did not consider the registrations as evidence during prosecution of the application. In the August 20, 2013 action, the Examining Attorney merely stated that the registrations are not relevant to the refusal and that, generally, there are differences in applicant’s use and the registered marks because no use is exactly the same.

¹⁵ Applicant’s brief at 11.

¹⁶ Applicant’s citation of *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 U.S.P.Q. (BNA) 693, 694-95 (C.C.P.A. 1976), is misplaced because the issue in that case was descriptiveness. Third-party registrations are acceptable evidence of the meaning of a term or phrase but not probative of whether a different mark is used or perceived as a source-indicator.

Evidence consisting of third-party registrations, even if the registrant's specimens are included, is not probative of the issue of whether applicant's mark functions as a service mark, and the evidence should be disregarded. It is well-settled law that in order to assess the commercial impact created by a designation "we look to the specimens and other materials which show how *the mark is actually used* in the marketplace." *In re Volvo Cars of North America*, 46 USPQ2d 1455, 1456 (TTAB 1998) (*emphasis added*) (citing *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976)). As the Board made clear in *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980), a service mark "must be used as such in order to lay a foundation for registration, and the *only basis* for determining such use is necessarily the specimens filed with the application in question." (Emphasis added). Inasmuch as the third-party registrations do not provide examples of how *applicant's mark* is used in the marketplace, they should not be considered as evidence in this case.

Additionally, third-party registrations are not probative evidence of whether consumers actually perceive the marks as trademarks or service marks. "It is the perception of the ordinary customer that determines whether the asserted mark functions as a service mark, not the applicant's intent, hope, or expectation that it do so." TMEP §1301.02; *See also, In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960). It is noted that the applicant in *In re Volvo Cars of North America, Inc., supra*, also argued that the Office had registered or published many similar marks. In response, the Board noted the following:

even if considered, this evidence would have had scant probative value on the specific issue in this case involving the registrability of applicant's designation. Further, we are not privy to the records of the listed registrations and applications; the propriety of the issuance of those registrations is not before us; and neither the Board nor the Examining Attorney is bound by the determinations made by other Examining Attorneys who handled those cases.

Id. at n.2.

Inasmuch as the third-party registrations are not evidence of how applicant's proposed mark is used or perceived by the relevant public and do not provide evidence of *consumer* perception of the phone numbers therein, the evidence should be disregarded when considering whether the telephone number 1-800-TIRE-911 functions as a trademark.

CONCLUSION

Applicant's proposed mark 1-800-TIRE-911, which identifies a telephone number, does not separately function as a trademark because it merely provides information to consumers about how to contact applicant by telephone. The inherent nature of the mark would immediately be recognized by consumers as a vanity telephone number and the manner in which applicant uses the mark on the specimens does not separately indicate the source of the services. Accordingly, the refusal of the proposed mark under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051-1053 and 1127, should be affirmed.

Respectfully submitted,

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