ESTTA Tracking number: **ESTTA612065**
Filing date: **06/25/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85077031
Applicant	Michelin North America, Inc.
Applied for Mark	1-800-TIRE-911
Correspondence Address	FRED W HATHAWAY DICKINSON WRIGHT PLLC 1875 EYE STREET, NW SUITE 1200 WASHINGTON, DC 20006 UNITED STATES FHathaway@dickinsonwright.com, malcantara@dickinsonwright.com, trademark@dickinsonwright.com, mjackson@dickinsonwright.com
Submission	Reply Brief
Attachments	Reply Brief.pdf(381603 bytes)
Filer's Name	Melissa Alcantara
Filer's e-mail	trademark@dickinsonwright.com, fhathaway@dickinsonwright.com, malcantara@dickinsonwright.com, mjackson@dickinsonwright.com
Signature	/Melissa Alcantara/
Date	06/25/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of	:	
	:	
Michelin North America, Inc.	:	Michael Webster
	:	Trademark Examining Attorney
Serial No.: 85/077,031	:	Law Office 102
	:	
Filed: July 2, 2010	:	
	:	
Mark: 1-800-TIRE-911	:	
	:	
	:	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPELLANT'S REPLY BRIEF

MICHELIN NORTH AMERICA, INC.

Fred W. Hathaway, Esq.
Melissa Alcantara, Esq.
DICKINSON WRIGHT PLLC
1875 Eye Street, N.W., Suite 1200
Washington, DC 20006
Tel.: (202) 457-0160
Attorneys for Applicant

TABLE OF CONTENTS

1. INTRODUCTION 3

2. APPELLANT'S REPLY ARGUMENT 3

A. The Fact That A Designation Is Informational Does Not Preclude It From Functioning As a Source-Identifier 3

B. The Third-Party Registrations Cited By Appellant Demonstrate That The Examining Attorney's Arguments Conflict With Established Trademark Office Practice 5

C. As Used On The Specimens Of Record, Appellant's Mark Functions As A Designator Of Source 8

3. CONCLUSION 11

ALPHABETICAL TABLE OF AUTHORITIES

CASES

In re Eilberg,
Serial No. 75/162,788, 1998 TTAB LEXIS 522,
49 U.S.P.Q.2D (BNA) 1955 (T.T.A.B. Dec. 30, 1998) 3, 4

In re Roberts,
2008 TTAB LEXIS 22, 87 U.S.P.Q.2D (BNA) 1474 (T.T.A.B. May 2, 2008) 4

In re Volvo Cars of North America, Inc.,
Serial No. 74/212,578, 1998 TTAB LEXIS 20, 46 U.S.P.Q.2D (BNA) 1455 (T.T.A.B. 1998) 7

Plus Prods. v. Natural Organics, Inc.,
1979 TTAB LEXIS 85, 204 U.S.P.Q. (BNA) 773 (T.T.A.B. Aug. 2, 1979) 5

TREATISES

1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7.17.50 (4th ed. 2013) 4

Introduction

The Examining Attorney argues in his Brief that, because the mark of Appellant Michelin North America, Inc. (hereafter, "Appellant") is in the format of a toll-free "vanity" number, the mark would be immediately recognized by consumers merely as a means to contact Appellant and not as a source-indicator. However, as shown by the case law cited within the Examining Attorney's own Brief, as well as the registrations made of record by Appellant, the Examining Attorney's argument proves too much and is misplaced. A designation that is inherently informational, such as a website address or a toll-free vanity number, can function as a mark so long as it is being used as an indicator of source.

Appellant's mark is it appears on the specimens of record is clearly being used as a source-identifier. Appellant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision and allow the mark to proceed to registration.

Appellant's Reply Argument

A. The Fact That A Designation Is Informational Does Not Preclude It From Functioning As a Source-Identifier

Contrary to the Examining Attorney's suggestion at Section A of his Brief, a designation that inherently imparts information can function as a designation of source. The case law cited by the Examining Attorney illustrates this very point. In *In re Eilberg,* Serial No. 75/162,788, 1998 TTAB LEXIS 522, 49 U.S.P.Q.2D (BNA) 1955 (T.T.A.B. Dec. 30, 1998), the Board considered whether the applicant's domain name functioned as a service mark. The specimens of record showed the proposed mark was used inconspicuously in a very small and subdued typeface on applicant's letterhead, and the mark appeared below other informational listings for applicant's mailing address, phone, fax and e-mail addresses. 1998 TTAB LEXIS 522, at *2-3. Although the Board agreed with the Examining Attorney that the applicant's mark—*as displayed*

on applicant's letterhead—did not function as a service mark, the Board stated: "This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or services marks." 1998 TTAB LEXIS 522, at *6.

A toll-free vanity number is as inherently informational as a domain name in that it permits one to locate or communicate with a place or person. However, as *In re Eilberg* instructs, the mere fact that a designation serves an informational purpose does not preclude it from functioning as a source identifier. *See* 1998 TTAB LEXIS 522, at *6; *see also In re Roberts*, 2008 TTAB LEXIS 22, 87 U.S.P.Q.2D (BNA) 1474 (T.T.A.B. May 2, 2008) (stating that the purpose of applicant's mark as an Internet website address "does not per se preclude it or a portion thereof from serving as a source identifier").

The key to legal protection and registration of a designation that serves an informational purpose, such as a domain name, is its "use…as a mark." 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7.17.50 (4th ed. 2013) (emphasis added). "The key is whether the designation claimed as a protectable mark has been used to make such a visual impression that the viewer would see it as a symbol of origin separate and apart from anything else." *Id.* Accordingly, contrary to the Examining Attorney's argument, the fact that Appellant's mark will be recognized as serving an informational purpose, does not automatically mean that consumers will perceive Appellant's mark as merely a means to contact Appellant and not a source-indicator. The Examining Attorney's argument is, no more no less, that there should be no telephone number trademark registrations issued in that all of them, no matter how used, inform consumers about how to reach the owner by telephone.

B. The Third-Party Registrations Cited By Appellant Demonstrate That The Examining Attorney's Arguments Conflict With Established Trademark Office Practice

At Section C of his Brief, the Examining Attorney argues that the third-party registrations cited by Appellant should be disregarded. Appellant respectfully disagrees.[1] The third-party registrations cited by Appellant in its Appeal Brief are relevant and should be considered by the Board chiefly because they show the Trademark Office's practice with regard to the registration of telephone number marks, and that the Examining Attorney's arguments are in conflict with that established Trademark Office practice. *Cf. Plus Prods. v. Natural Organics, Inc.*, 1979 TTAB LEXIS 85, at *20-21, 204 U.S.P.Q. (BNA) 773 (T.T.A.B. Aug. 2, 1979) (inferring from the third-party registrations made of record the Trademark Office's practice with respect to registering different "PLUS"-formative marks for vitamins).

For example, if it were the case as the Examining Attorney argues at Section A of his Brief that a designation that begins with the prefix "1-800" would be recognized by consumers as being only informational in nature as a toll-free number to contact its owner and not as a source-indicator, then none of the "1-800" structure telephone number marks which are identified at pages 9 through 11 of Appellant's Appeal Brief would have been allowed for registration by the Trademark Office. The Examining Attorney clearly goes too far in arguing that Appellant's mark would be immediately recognized as a means to contact Appellant and not as a source-indicator due its inherent nature in the format of a toll-free vanity telephone number.

The Examining Attorney also contends in Section A of his Brief that the Appellant's mark in substance is merely informational in nature. However, the third-party registrations cited

[1] In addition, to the extent the Examining Attorney denies that the third-party registrations were considered during prosecution of the application, Appellant notes that at page 6 of the August 20, 2013 letter denying Appellant's Request for Reconsideration, the Examining Attorney did comment that "there [were] clear and obvious differences in the uses of the parties". This comment suggests that the third-party registrations were, in fact, considered.

within Appellant's Appeal Brief show this contention to be false. At page 7 of its Appeal Brief, Appellant cites a number of "[word] 911" structured marks that have been allowed by the Trademark Office for registration on the Principal Register for comparable assistance and/or repair services and without a disclaimer of "911". These registrations demonstrate that the term "911", when used immediately after a word as it is in Appellant's mark, at a minimum, creates a combination that is suggestive. Accordingly, Appellant's "[word] 911" structured mark is, at a minimum, a suggestive mark and carries significance other than just dialing information.

The Examining Attorney further argues in Section B of his Brief that, because Appellant's mark is immediately preceded by the wording "MICHELIN ONCall", consumers are likely to view Appellant's proposed mark as merely providing information about how to contact Appellant regarding its "On Call" services. First, the Examining Attorney's argument is misleading in that Appellant's mark is not simply preceded by the terms "MICHELIN ONCall". Rather, the mark on the specimen actually appears below Appellant's famous "house" mark MICHELIN® and ONCall™ or MICHELIN® ONCall™, which are both being used as marks:

Second, even if for argument's sake "ONCall" were being used by Appellant as merely informational matter and not as a mark, the placement of Appellant's mark beneath that term does not automatically negate the mark's source-indicating significance. If it were the case that such placement automatically means that the designation would be perceived by consumers only informationally as a number to dial and not also as a mark, then, by analogy, none of the specimens for the registered telephone number trademarks listed at page 16 of Appellant's Appeal Brief would have been sufficient to establish service mark usage. The placement of the

telephone number marks in the specimens that appear at page 16 of Appellant's Brief do not differ in any material way from the placement of Appellant's mark as it appears in Appellant's specimen above. The specimens cited by Appellant demonstrate that, just because a designation is displayed in a manner that it readily and inescapably will be perceived as a telephone number, that does not mean that the designation will be perceived only informationally, and not also as a mark.

Lastly, the Examining Attorney argues in Section B of his Brief that the use of the numeric-only telephone number directly beneath Appellant's mark emphasizes the informational quality of Appellant's mark and shows that Appellant's mark does not separately identify the source of Appellant's services. However, the Examining Attorney's statement is in conflict with the large multiplicity of registrations issued by the Trademark Office for alpha-numeric marks, many of which are displayed in the specimens as an alpha-numeric telephone number with the numeric-only telephone number below or with it, for example, as in the registrations identified at page 17 of Appellant's Appeal Brief.

Insofar as the third-party registrations cited by Appellant show that the Examining Attorney's arguments are in conflict with Trademark Office practice, the registrations are relevant and should not be disregarded.[2]

[2] The Examining Attorney, at Section C of his Brief, cites *In re Volvo Cars of North America, Inc.*, Serial No. 74/212,578, 1998 TTAB LEXIS 20, 46 U.S.P.Q.2D (BNA) 1455 (T.T.A.B. 1998) in support of his argument that Appellant's third-party registrations should be disregarded. However, that case can be easily distinguished because the applicant there merely submitted an applicant-compiled listing of third-party registrations and/or applications. 1998 TTAB LEXIS 20, at *4 n.2. Here, the Appellant has made of record copies of the cited registration certificates, as well as materials from the associated files, including copies of specimens of record.

C. As Used On The Specimens Of Record, Appellant's Mark Functions As A Designator Of Source

The Examining Attorney argues at Section B of his Brief that Appellant's mark is not registrable because it is not presented as the name under which Appellant's services are rendered or in any other manner that would be perceived as a source indicator. The Examining Attorney contends that consumers would perceive MICHELIN® ONCall™ as the sole source of the services. However, a review, for example, of the specimen submitted by Appellant on November 28, 2012 shows the Examining Attorney's contentions to be false:

As the above specimen demonstrates, Appellant's mark 1-800-TIRE-911 is clearly being used as a designator of source. The mark appears prominently in the specimen, it is displayed along with a "™" symbol in the same location, size and font as the famous MICHELIN® mark (and is displayed in larger font than Appellant's ONCall™ trademark), it appears in close proximity to the description of Appellant's emergency roadside assistance services, it is not embedded within informational matter or along with a listing of Appellant's contact details (such as Appellant's address, fax number, email and website address), and the real numeric telephone

number that consumers are to dial in order to contact Appellant for its services is displayed separately and differently below Appellant's mark (and in much smaller type as is all the other informational text in the specimen).

Nothing in Trademark Manual of Examining Procedure ("TMEP") § 1209.03(l), which addresses examination of telephone numbers as trademarks, or in TMEP § 1301.04, which addresses the issue of acceptable specimens for service marks, requires or even implies that specimens for telephone number marks may be examined under different standards from all other service marks. Section 1209.03(l) states only that, in order to be registered, a telephone number mark must be distinctive (or have acquired distinctiveness). Section 1209.03(l) then states that "the designation must also be used in the manner of a mark" and cites TMEP §§ 1202-1202.16, the TMEP provisions of general application that require that in all applications filed under Section 1 of the Lanham Act, the applied-for mark function as a trademark. *See* TMEP § 1202. TMEP § 1202, in turn, cites to TMEP §§ 1301.02-1301.02(f), which contain the analogous rules for use of a designation as a service mark. It is clear then that a specimen showing use of a designation in the form of an alphanumeric telephone number, such as Appellant's 1-800-TIRE-911 mark, should be analyzed under the very same rules that apply to all service marks.

As stated in TMEP § 1301.02:

> Factors that the examining attorney should consider in determining whether the asserted mark functions as a service mark include whether the wording claimed as a mark is physically separate from textual matter, whether a term is displayed in capital letters or enclosed in quotation marks, and the manner in which a term is used in relation to other material on the specimen.

Consideration of the foregoing factors, as discussed above, reveals that, as used on the specimens of record, Appellant's mark functions as a service mark. It does not require extended analysis to

conclude that, Appellant's mark, as used on the specimens of record, creates a commercial impression separate and apart from the other elements of the brochure that comprises Appellant's specimen, such that the designation will be recognized by prospective purchasers as a source-identifier.

The Examining Attorney does not dispute that a party may use multiple marks in the specimens for its goods and services. As used on the specimens of record, MICHELIN® ONCall™ and 1-800-TIRE-911™ would be perceived as separate marks that denote the emergency roadside assistance services offered by Appellant.

Conclusion

Appellant's mark, as shown on the specimens of record, is being used as and would be perceived as a service mark. The fact that it is also recognizable as a telephone number does not negate the source-identifying significance of the mark. Moreover, the reasons proffered by the Examining Attorney do not demonstrate that Appellant's mark as used and displayed on the specimens of records would be perceived by consumers only informationally and not as a mark. When Appellant's use of the mark, as shown on the specimens of record, is evaluated against the factors that should be considered in determining whether a mark functions as a service mark, the inescapable conclusion is that the mark is being used as an identifier of source. For the reasons set forth herein, Appellant's 1-800-TIRE-911 mark as shown on the specimens of record functions as a source indicator and is entitled to registration.

Further and favorable action, namely, reversal of the refusal to register grounded in Sections 1, 2, 3 and 45 of the Trademark Act, is respectfully requested.

MICHELIN NORTH AMERICA, INC.

Date: June 25, 2014

By: /Melissa Alcantara/

Fred W. Hathaway, Esq.
Melissa Alcantara, Esq.
DICKINSON WRIGHT PLLC
1875 Eye Street, N.W., Suite 1200
Washington, DC 20006
Tel.: (202) 457-0160
Email: FHathaway@dickinsonwright.com
MAlcantara@dickinsonwright.com

Attorneys for Applicant

DC 338210-613 245090v1