

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
January 30, 2014

Hearing:  
January 9, 2014

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Dana Limited

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Serial No. 85447797

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John A. Borell, Jr. and Stephen P. Evans of Marshall & Melhorn,  
LLC for Dana Limited.

Benji Paradewelai, Trademark Examining Attorney, Law Office 101  
(Ronald R. Sussman, Managing Attorney).<sup>1</sup>

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Before Quinn, Taylor, and Ritchie, Administrative Trademark  
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Dana Limited ("applicant") filed an application to register  
the mark shown below for "axles for vehicles" in International  
Class 12<sup>2</sup>:

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<sup>1</sup> The Examining Attorney who appeared at the oral hearing was Matthew McDowell.

<sup>2</sup> Serial No. 85447797, filed October 14, 2011, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming acquired distinctiveness in whole based on prior Registration Nos. 0856983, 1682538, and 3000840. See TMEP § 1212.04 (2013).



The description of the mark reads: The mark consists of a diamond design with the word "DANA" within the diamond, "DANA" shown in solid lines, and "44" shown on the lower right corner of the diamond, "44" shown in brokes [sic] lines represents that any number with at least two digits may be used.

The Trademark Examining Attorney refused registration of applicant's mark under Sections 1 and 45 of the Trademark Act of 1946, 15 U.S.C. §§ 1051 and 1127, on the ground that applicant seeks to register more than one mark with its application. When registration was finally refused, applicant filed this appeal. Both applicant and the examining attorney filed briefs, and applicant filed a reply brief. At applicant's request, a hearing was held and presided over by this panel, on January 9, 2014. For the reasons discussed herein, upon careful consideration of the evidence and arguments presented, we affirm the refusal to register.

#### **Refusal for Multiple Marks**

An application must be limited to only one mark. 15 U.S.C. §§ 1051 and 1127; Trademark Rule 2.52. A mark that contains a

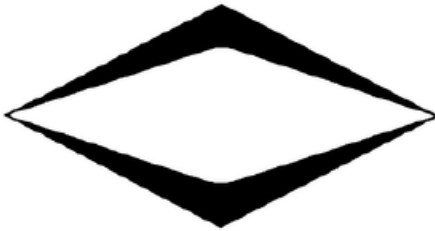
changeable or "phantom" element is considered to be more than one mark. See *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Primo Water Corp.*, 87 USPQ2d 1376 (TTAB 2008). It is the examining attorney's position that an element of applicant's mark is a changeable or phantom element, specifically, the changing number described as "any number with at least two digits." Therefore, according to the examining attorney, this makes an accurate search for conflicting marks impossible, and gives insufficient notice of applicant's mark on the register, since it does not accurately reflect use in commerce.

Applicant does not dispute that its mark contains a phantom element. (appl's brief at 2). However, applicant asserts that it is not barred from registration for three reasons: 1) applicant's mark is the "legal equivalent" of its prior registered marks; 2) applicant's mark is limited, and such marks have been allowed by case law; and 3) prior Office practice indicates that it should be allowed. We consider each of these arguments.

Applicant has applied for registration of its mark with a claim of acquired distinctiveness "in whole" based on the following three prior registered marks:



<sup>3</sup> for, *inter alia*, "drive axle units," in International Class 12;



<sup>4</sup> for, *inter alia*, "one and two speed axles," in International Class 12; and



<sup>5</sup> for "engine bearings" in International Class 8 (Cancelled).

Our primary reviewing court considered the issue of legal equivalents for phantom marks in *In re Dial-A-Mattress Operating*

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<sup>3</sup> Registration No. 0856983, Registered September 17, 1968. Sections 8 and 15 acknowledged and accepted. Renewed twice.

<sup>4</sup> Registration No. 1682538, Registered April 14, 1992. Sections 8 and 15 acknowledged and accepted. Renewed.

<sup>5</sup> Registration No. 3000840, Registered September 27, 2005. Cancelled for failure to file Section 8 affidavit of use, October 5, 2012. An expired or cancelled registration is not evidence of anything except that the registration issued. See TBMP § 1208.02 (2013); *In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant).

*Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

There, the Court noted:

A proposed mark is the "same mark" as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. Whether marks are legal equivalents is a question of law subject to our *de novo* review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991).

Upon analysis of applicant's prior existing registrations, we do not find any of them to be legal equivalents within this meaning. The marks are simply not the same where applicant seeks to add the additional matter of a changeable element that may include an essentially unlimited number of digits, any combination of which may change the commercial impression of applicant's mark.

Applicant, while seeming to agree that an unlimited number of changeable digits may render its mark unregistrable, argues that it actually seeks a limited number of two-digit combinations "only." (appl's brief at ftnt 1 "Dana intends to always use a two-digit number"). This is clearly not supported by applicant's description of its mark however, which states that "at least two digits may be used." Thus applicant's reliance on the *In re Dial-A-Mattress* for the proposition that

phantom marks with limited possibilities may be registered is simply misplaced. The phantom mark in that case was an area code, of which, the Court noted, there are limited possible combinations. This is not so with the essentially unlimited combinations of applicant's mark which, as described, may be any two, three, four, or more digits. Accordingly, we do not find the phantom element in applicant's mark to be limited, nor do we find the situation in *In re Dial-A-Mattress* to be analogous. Rather, we agree with the examining attorney's assessment that applicant's proposed phantom mark makes an accurate search for conflicting marks impossible, and gives insufficient notice of applicant's mark on the register.

Finally, applicant argues that prior Office practice dictates that its mark should be registered. In particular, applicant points to third-party registrations of the marks NDA[],<sup>6</sup> WEBSTRATEGIES---,<sup>7</sup> \_\_\_COWLENDER,<sup>8</sup> and SPL123X.<sup>9</sup> The examining attorney points out that the first two have been cancelled. Although the final mark is owned by applicant, and includes a phantom element for "part or model number consisting of two or three digits which vary depending on use of the mark," it is axiomatic that every case must be decided on its own

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<sup>6</sup> Registration No. 2277043, Registered September 14, 1999. Cancelled.

<sup>7</sup> Registration No. 2298605, Registered December 7, 1999. Cancelled.

<sup>8</sup> Registration No. 2221084, Registered February 2, 1999. Sections 8 and 15 acknowledged and accepted. Renewed.

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merits. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).<sup>10</sup>

In conclusion, we find that applicant seeks to register multiple marks in violation of Sections 1 and 45 of the Trademark Act. Therefore, applicant's applied-for mark is unregistrable.

Decision: The refusal to register is affirmed.

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<sup>9</sup> Registration No. 1802662, Registered November 2, 1993. Sections 8 and 15 acknowledged and accepted. Renewed.

<sup>10</sup> We also note, in this regard, that none of these registrations issued within the past ten years, and applicant's in particular, predates the relevant caselaw.