This Opinion is Not a Precedent of the TTAB

Mailed: August 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Enterprise Holdings, Inc.

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Serial No. 85675437

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Thomas A. Polcyn of Thompson Coburn LLP
for Enterprise Holdings, Inc.

Brian Pino, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Quinn, Kuhlke and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Enterprise Holdings, Inc. ("Applicant") seeks registration on the Principal Register of the mark 

for

> Vehicle dealership services, namely, dealerships in the field of automobiles, trucks, cars and other land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial purposes in International Class 35;

> Vehicle fleet management services, namely, facilitating and arranging for financing, and insurance agency services in the fields of liability, collision, and comprehensive insurance, of vehicles for others in International Class 36; and
>
> Vehicle rental and leasing services, and reservation services for the rental and leasing of vehicles in International Class 39.[1]

The Examining Attorney has refused registration of Applicant's mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, on the grounds that Applicant seeks registration of more than one mark in its application (that it is a phantom mark); and that the specimens do not reflect the mark as depicted in the drawing.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. In his appeal brief, the Examining Attorney withdrew the refusals with respect to the services in Class 35. Thus, this appeal relates solely to the refusals to register the mark for the services in Classes 36 and 39. We reverse the refusals.

I. Phantom Mark Refusal.

The asserted basis for the first refusal under Sections 1 and 45 is that Applicant is attempting to register more than one mark. According to the Examining Attorney, the "mark contains a blank space below the wording ENTERPRISE into

[1] Application Serial No. 85675437 was filed on July 12, 2012, based upon Applicant's claim of first use anywhere and use in commerce in connection with the services in International Classes 35 and 36 since at least as early as December 4, 2006, and in connection with the services in International Class 39 since at least as early as February 28, 2007.

which [A]pplicant inserts changeable merely descriptive wording" and, as such, the mark constitutes a phantom mark. Examining Attorney's Brief, p. 4, 9 TTABVUE at 5.

The Court of Appeals for the Federal Circuit has described a phantom mark as "one in which an integral portion of the mark is generally represented by a blank or dashed line acting as a placeholder for a generic term or symbol that changes, depending on the use of the mark." *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1515 n.1 (Fed. Cir. 1999). Other phantom elements can, for example, be a date, or a geographic location, or a model number that is subject to change. *In re Primo Water Corp.,* 87 USPQ2d 1376, 1378 (TTAB 2008).

Registration of phantom marks is prohibited since one cannot ascertain the designation used to identify and distinguish the goods covered by the mark, which makes it impossible to conduct a comprehensive search. *In re International Flavors & Fragrances Inc.*, 51 USPQ2d at 1515. "The registration of such marks does not provide proper notice to other trademark users, thus failing to help bring order to the marketplace and defeating one of the vital purposes of federal trademark registration." *In re Primo Water Corp.,* 87 USPQ2d at 1378. Determination of whether a mark contains phantom elements is based on the description of the mark. According to J. Thomas McCarthy,

> [a] "phantom registration" is one in which the description of the mark contains missing "phantom elements" consisting of blanks or dashes representing changeable parts of the mark. A hypothetical example is an attempt

> to register the designation BIOTIC _____ BLEND for coffee, the applicant intending to substitute various geographical names such as BIOTIC NEW YORK BLEND, BIOTIC CALIFORNIA BLEND, BIOTIC ROCKY MOUNTAIN BLEND, BIOTIC SUN BELT BLEND etc. Another hypothetical example is an attempt to register the designation HERBAL ESSENCE OF xxxx for organic ingredients of dietary supplements, the applicant intending to substitute various fruit names such as HERBAL ESSENCE OF APPLE, HERBAL ESSENCE OF MANGO, HERBAL ESSENCE OF PAPAYA, etc.

3 McCarthy on Trademarks and Unfair Competition, § 19:61.50 (4th ed. 2014).

In this case, the description of the mark reads:

> The mark consists of a green square to the left of a black rectangle. The letter "e" is white and positioned within the green square. The letters "nterprise" are white and positioned within the black rectangle. The foregoing elements are positioned over a barrel-shaped shield design that is white outlined in black.

The description does not indicate that there are missing elements or elements that will change. Further, the drawing depicts a single mark that constitutes Applicant's entire mark. Accordingly, we reverse the refusal under Sections 1 and 45 on the ground that the mark is a phantom mark.

II. Specimen Refusal.

Registration was also refused under Sections 1 and 45 on the ground that the specimens do not reflect the mark as depicted in the drawing. The mark depicted in the drawing is 

. The specimens (brochures) for the services in Classes 36 and 39 show the mark as follows:

Class 36

Class 39.

The Examining Attorney asserts that "the specimen[s] display[] the mark as ENTERPRISE FLEET MANAGEMENT and design and ENTERPRISE COMMERCIAL TRUCKS and design; and the drawing shows the mark as ENTERPRISE and design without any additional wording"; and as such, "the mark in the drawing is not a substantially exact representation of the mark on the specimen." Examining Attorney's Brief, p. 9, 9 TTABVUE at 10.

In determining this issue, we turn to the cases involving mutilation of a trademark because, in effect, the Examining Attorney is asserting that by omitting the wording FLEET MANAGEMENT and COMMERCIAL TRUCKS in the drawing, Applicant has mutilated its mark. The question for us to decide is, "what exactly is the trademark? *Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992).

> It is well settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See *Institut National des Appellations D'Origine v. Vintners International Co. Inc.,* 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and *Chemical Dynamics Inc.*, 939 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial

> impression, the result is an impermissible mutilation of the mark as used

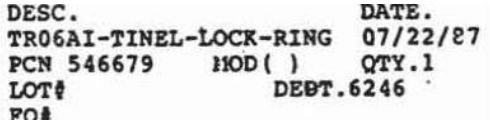
In re 1175856 Ontario Ltd., 81 USPQ2d 1446, 1448 (TTAB 2006). To support the refusal, the Examining Attorney argues that

> [t]he wording FLEET MANAGEMENT is merely descriptive and not the generic term for any of the services in International Classes 36 or 39; … The wording COMMERCIAL TRUCKS is also not the generic term for any particular service. … As a result, it is clear that the addition of the merely descriptive wording FLEET MANAGEMENT and COMMERCIAL TRUCKS changes the impression of the mark.

Examining Attorney's Brief, pp. 7-9, 9 TTABVUE at 8-9. This argument assumes that Applicant's omission of either the term FLEET MANAGEMENT or COMMERCIAL TRUCKS in the mark changes the commercial impression of the mark. We disagree. Contrary to the Examining Attorney's assertion, FLEET MANAGEMENT is generic for fleet management services and COMMERCIAL TRUCKS is highly descriptive of, if not generic for, services for the leasing or rental of commercial trucks. See *In re Cordua Rests. LP*, 110 USPQ2d 1227 (TTAB 2014) (CHURRASCOS held generic for a restaurant featuring churrasco steaks). These terms alone cannot function as marks for Applicant's services. Further, the terms are separable from the rest of the mark, thus the deletion of this verbiage does not change the commercial impression of Applicant's mark. *Cf. In re Yale Sportswear Corp.*, 88 USPQ2d 1121 (TTAB 2008) (Board affirmed refusal to register "UPPER 90," finding that it does not form a separate and distinct commercial impression apart from the degree symbol that appears on the specimen); *In re Semans,* 193 USPQ 727 (TTAB 1976) (the term "KRAZY," displayed on the specimen on the same

line and in the same script as the expression "MIXED-UP," does not in itself function as a registrable trademark apart from the unitary phrase "KRAZY MIXED-UP"); and *In re Mango Records,* 189 USPQ 126 (TTAB 1975) (the typed mark "MANGO" is so uniquely juxtaposed with the pictorial elements of the composite that it is not a substantially exact representation of the mark as used on the specimen and does not show the mark in the unique manner used thereon). Accordingly, we find that the specimens submitted by Applicant are acceptable to show use of the mark as it appears in the drawing.

The cases relied on by Applicant support this finding. For example, in the *Raychem Corp*. case, the Board found that the following specimen supported registration of the mark TINEL-LOCK for metal rings, despite the fact that this term was connected to other terms by hyphens, and all were shown in the same size, i.e., TRO6AI-TINEL-LOCK-RING, because the prefix "TR06AI" is a part or stock number and "RING" is the generic name of the goods:


DESC. DATE.
TR06AI-TINEL-LOCK-RING 07/22/87
PCN 546679 MOD( ) QTY.1
LOT# DEPT.6246
PO#

In re Raychem, Corp., 12 USPQ2d 1399, 1400 (TTAB 1989).

Decision: The refusals to register Applicant's mark 

are reversed.