

TTAB

10-04-2001

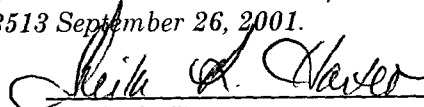
U.S. Patent & TMC/ TM Mail Rpt Dt. #26

.....E MARK

Docket No. R448:110.2-1

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

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 September 26, 2001.



Sheila R. Harter

In the matter of Application Serial No. 75/855,095 filed December 8, 1999 for the mark **PHONESPELL** in Class 42, as published in the Trademark *Official Gazette* on June 5, 2001.

NOTICE OF OPPOSITION

Box TTAB NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

September 26, 2001

Commissioner:

Rugly Enterprises, LLC, a California limited liability company, having its principal place of business in Van Nuys, California, believes that it will be damaged by registration of the mark sought in application serial no. 75/855,095 filed December 8, 1999 for the mark **PHONESPELL** in Class 42, as published in the Trademark *Official Gazette* on June 5, 2001 and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

1. Applicant seeks to register the mark **PHONESPELL** for "consulting services in the field of telephone number selection including creating mnemonics for telephone numbers, available through the use of a global computer information network," in International Class 42 as evidenced by the publication of the mark in the *Official Gazette* on June 5, 2001.

2. Opposer operates a website at the Universal Resource Locator (URL) <http://www.phonespell.com>. Opposer's website offers services relating to vanity telephone numbers, and more particularly, toll free consulting services that include searching, identifying and locating hard to find 800, 888, 877, 866 and 855 toll free phone numbers that spell the names of businesses.

In the matter of Application
Serial No. ~~75/931,090~~ 75/855,095

3. On August 23, 2000, Applicant instituted a civil action against Opposer by filing a complaint in the United States District Court for the Northern District of California. Applicant's complaint alleged, among other things, that Opposer's website at the URL <http://www.phonespell.com> was unlawful and violated Applicant's trademark rights in the term PHONESPELL.

4. The mark PHONESPELL should not be registered on the Principal Register because the mark is merely descriptive of the Applicant's services, namely providing consumers the service of telling them what their *phone numbers spell*. Moreover, Applicant's use of the term PHONESPELL in commerce does not involve providing "consulting services in the field of telephone number selection" as was stated by Applicant in its application for registration in International Class 42. Rather, as evidenced by Applicant's website at the URL <http://www.phonespell.org>, which reflects the only service provided by Applicant, the mark is used as a mere description of Applicant's service of answering the question "What does your phone number spell?" Such a descriptive use of the mark cannot be afforded trademark protection under the laws of the United States.

5. Additionally, during the prosecution of Applicant's PHONESPELL application before the United States Patent and Trademark Office, Applicant effectively disclaimed protection for PHONESPELL as a word mark, and can only seek protection for the specific stylized PHONESPELL mark articulated by Applicant.

On April 17, 2000, a Patent and Trademark Office action ("Office action") issued for Applicant's PHONESPELL application. In the Office action, the Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because it so resembles the PHONESPELL mark in U.S. Registration No. 2140204, registered to Siemens Business Communication Systems, Inc. ("Siemens") in International Class 9 for "telephones and communication switches and servers and computer programs for providing directory service."

In the matter of Application
Serial No. ~~75/081,920~~ 75/855,095

On October 9, 2000, Applicant responded to the Office action and attempted to distinguish its use of PHONESPELL from that of the registrant Siemens. In doing so, Applicant expressly limited its mark to a stylized mark. Particularly, when faced with the prospect of being denied a registration because Siemens had already registered the mark, Applicant unconditionally admitted that its mark is presented in a stylized manner "in balloon or cartoon-like font with the caricature of a rotary phone dial in the letter 'o' of the mark." Therefore, if Applicant has any trademark rights at all in the mark PHONESPELL, those rights only extend to the stylized mark that Applicant described in order to obtain those rights.

7. Based on the foregoing, Opposer will be damaged and injured by the registration of the mark herein opposed.

Wherefore, the Opposer prays that application serial no. 75/855,095 be rejected and that the mark therein sought for the services specified in international class 42 be denied and refused.

Please address all correspondence to **CHRISTIE, PARKER & HALE, LLP, P.O. BOX 7068, Pasadena, CA 91109-7068.**

In accordance with 37 CFR 2.104, a duplicate copy of the notice of opposition and the fee of \$300 are enclosed herewith.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

Wesley W. Monroe
626/795-9900

10-04-2001

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #26

SERVICE MARK

Docket No. 110.2*1/WWM/R448

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Sheila R. Harter

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Arlington, Virginia 22202-3513

September 26, 2001

Commissioner:

Enclosed for filing are the following:

1. Notice of Opposition (original and copy) filed by Rugly Enterprises, LLC relating to the following registration application:

Mark : PHONESPELL
Serial No. : 75/855,095
Filed : December 8, 1999
Class(es) : 42
Applicant : Jeremy Grodberg

2. Our check for \$300.00 for the opposition filing fee.


The Commissioner is authorized upon filing or during prosecution of this opposition to charge any additional fees which may be required or credit any overpayment of fees to Deposit Account No. 03-1728. Please show our docket number with any Deposit Account transaction. **A copy of this letter is enclosed.**

Please address all correspondence to **CHRISTIE, PARKER & HALE, LLP, P.O. Box 7068, Pasadena, California 91109-7068.**

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By


Wesley W. Monroe
626/795-9900

AK



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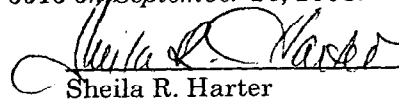
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