

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB 11, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Standard Register Company

Serial No. 74/557,722

B. Joseph Schaeff of Killworth, Gottman, Hagan & Schaeff for applicant.

Hannah Fisher, Trademark Examining Attorney, Law Office 104
(Thomas Lamone, Managing Attorney).

Before Sams, Hanak and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

The Standard Register Company has filed a trademark application to register the mark ISG TALK FREE for "telephone calling cards."¹

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is

¹ Serial No. 74/557,722, in International Class 16, filed August 5, 1994, based on an allegation of a bona fide intention to use the mark in commerce. On March 15, 1995, during the prosecution of this application, applicant filed an amendment to allege use, alleging a date of first use and first use in commerce as of July 11, 1994.

deceptively misdescriptive in connection with its goods or, alternatively, under Section 6 of the Trademark Act, 15 U.S.C. 1056, requiring a disclaimer of TALK FREE on the ground that it is merely descriptive in connection with applicant's goods.²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

In its brief, applicant describes its goods as follows:

[Applicant's] goods consist of paper or plastic cards imprinted with information used to make long distance telephone calls. The cards are designed to include an authorization code. When the 800 number is dialed and the authorization code is entered, the caller may make his or her telephone calls for the allotted amount of time. . .

[Applicant's] calling cards sometimes contain memory permitting a cash value to be programmed into the cards which are prepaid. [Applicant] typically distributes prepaid calling cards bearing the mark to companies which further distribute the cards to their customers. These cards allow the ultimate users to make telephone calls from one location to another without using actual coins, currency, credit cards or collect call procedures. [Applicant] acknowledges that it

² Neither the Examining Attorney nor applicant have raised any question about the registrability of the first part of this composite mark, the acronym ISG. Further, the Examining Attorney's refusal pertains explicitly only to the phrase TALK FREE. Thus, we do not consider any question regarding the registrability of ISG to be before us. However, while the Examining Attorney's refusal on the ground of mere descriptiveness includes a requirement for a disclaimer of TALK FREE, her alternative refusal pertaining to deceptive misdescriptiveness does not include a requirement for a disclaimer of TALK FREE; rather it appears to be a refusal to register the mark as a whole. As a disclaimer of the phrase TALK FREE would be equally appropriate whether it is merely descriptive or deceptively misdescriptive, we consider the refusal herein on both or either of these grounds to be in the nature of a requirement for a disclaimer of TALK FREE.

frequently gives phone cards bearing the ISG TALK FREE mark to customers and prospective customers.

The Examining Attorney contends that since applicant acknowledges it gives at least some of its phone cards to customers and prospective customers for no charge, the phrase TALK FREE merely describes that at least some portion of applicant's business customers may receive the cards free of charge and that persons may use these cards to place telephone calls free of charge. In support of her position, the Examining Attorney has submitted a photocopy of a coupon from MCI, a long distance phone carrier, for ten minutes of free telephone calls. The coupon includes the following copy:

MCI® FREE CALL COUPON
Enjoy one FREE MCI Card®
call - up to 10 MINUTES.

Additionally, upon remand, the Examining Attorney submitted a copy from the PTO records of a third-party registration of the mark "BUY SMART. TALK FREE." for "promoting the services of others through the administration of a bonus award program comprising the sale of cellular telephone airtime certificates to retail businesses for distribution and use by their customers." The registration includes a disclaimer of the phrase TALK FREE. The Examining Attorney contends that this establishes both that this phrase is merely descriptive "in the industry" and that, "if

applicant's cards do not entail some free long distance calling time, customers are likely to be misled."³

Regarding the Examining Attorney's alternative argument, that the phrase TALK FREE is deceptively misdescriptive, the Examining Attorney contends that, although applicant gives away some of its cards, since applicant asserts that its cards are not free of charge, the phrase TALK FREE "conveys false and plausible information about the goods."⁴

Applicant contends that TALK FREE would not be recognized as merely descriptive of telephone cards. Applicant argues that the phrase, TALK FREE, has "several alternative connotations which render the mark as a whole incongruous," in particular, that, considered in connection with applicant's goods, TALK FREE suggests that applicant's

³ The Examining Attorney makes several statements regarding alleged common practices in different industries. For example, she states that free long distance telephone time "is the subject matter of intense competition, as demonstrated by the huge volume of television advertising and telemarketing generated by telephone companies"; that "such sales incentives are increasingly common"; that "an analogous sales incentive is common in the cosmetics industry"; and that "the airlines almost universally award bonus miles and coupons to frequent flyers." The Examining Attorney has submitted absolutely no evidence in support of these statements, nor are they of such a nature as to warrant us taking judicial notice thereof. Thus, we give no consideration to these statements in our determination of the issues before us.

⁴ The Examining Attorney states in this regard that "[m]oreover, the cards themselves refer to the remaining balance" and "that the true nature of the goods may be indicated on the back of the cards does not negate the validity of [the refusal]." The back of the telephone calling card submitted as a specimen herein contains instructions for the use of the card. Reference to "the remaining balance" concerns the number of minutes of use remaining on the card. To the extent that the Examining Attorney is arguing that the text of the instructions on the back of the card somehow supports her position, we find this argument unpersuasive.

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"telephone calling cards allow purchasers to 'speak freely' and to make calls free from the typical encumbrances incumbent in the use of public telephones."

Concerning the question of whether the phrase TALK FREE is deceptively misdescriptive in connection with the identified goods, applicant contends that the phrase TALK FREE is suggestive and has an incongruous connotation and, thus, this phrase does not misdescribe the goods. Applicant argues, further, that:

[E]ven if 'TALK FREE' was held to misdescribe [applicant's] goods (*i.e.*, that 'TALK FREE' means there is no charge for [applicant's] phone cards) no one is likely to believe that, after purchasing the goods with money, the goods are free.

Turning, first, to the issue of whether TALK FREE is merely descriptive of applicant's goods, we consider whether TALK FREE immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of applicant's product. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). We determine this question on the basis of the identification of goods or services in the application before us. *See, In re Allen Electric and Equipment Co.*, 458 F.2d 1404, 173 USPQ 689 (CCPA 1972); *In re Vehicle Information Network Inc.*, 32 USPQ 2d 1377 (TTAB 1994); and *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994). In this regard, we agree with applicant's

contention that, in connection with telephone calling cards, TALK FREE is, at most, suggestive of a characteristic of such cards. In particular, TALK FREE may suggest that applicant's cards may be used to place telephone calls without coins or a credit card, *i.e.*, that the cards permit the user to make prepaid telephone calls. However, TALK FREE does not directly or immediately convey this information.⁵ Thus, we find that TALK FREE is not merely descriptive in connection with applicant's telephone calling cards.

We find the Examining Attorney's focus on the factual question of whether applicant sells its telephone calling cards or distributes them free of charge to be misplaced. It is clear from the record, and applicant admits, that it does both. It is likely, although not established herein, that applicant distributes a certain number of cards free as a promotional device. However, we find no support for the Examining Attorney's contention that TALK FREE directly or immediately conveys any information about whether the cards

⁵ The evidence of a single registration for a mark including the phrase TALK FREE in connection with promotional services for third parties is not persuasive of a different result herein. Not only is the record of that registration not part of the record herein, but our determination of whether TALK FREE is merely descriptive or deceptively misdescriptive must be based upon the goods recited in the application before us. That a term may be descriptive of certain goods or services is not determinative of whether it is descriptive of other goods or services. *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1995). Here, the identification of goods is different from the one in the noted registration.

must be purchased from applicant or whether the cards are available from applicant free of charge.⁶

With respect to the Examining Attorney's refusal on the ground that TALK FREE is deceptively misdescriptive in connection with the identified goods, we note that the inquiry is twofold. First we must determine whether the proposed mark misdescribes a characteristic, quality, function, composition or use of the goods. If so, we must determine whether the misdescription is deceptive, in other words, whether prospective purchasers are likely to believe that the misdescription actually describes the goods. The burden is on the Examining Attorney to submit sufficient evidence to establish that the term sought to be registered falls within the proscription of the statute. *In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993) citing *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988). We have determined herein that TALK FREE is not merely descriptive in connection with the identified goods. Similarly, we find that TALK FREE does not immediately convey misdescriptive information concerning a quality, characteristic, function, ingredient,

⁶ The evidence of record that MCI has advertised a coupon for free telephone calls is support only for the fact that a telephone company may offer, under certain circumstances, free long distance telephone calling. Applicant does not dispute this fact. This evidence is not persuasive of the Examining Attorney's contention that consumers would perceive of TALK FREE as describing that applicant's telephone calling cards are free of charge.

attribute or feature of applicant's goods. While it is unnecessary for us to proceed to the second part of the test for deceptive misdescriptiveness, we note that, even if we had found the phrase to be misdescriptive in connection with applicant's goods, the Examining Attorney has presented no argument regarding the second prong of the analysis of deceptive misdescriptiveness. As such, we would be constrained to find that she has not met her burden of establishing that prospective purchasers would be likely to believe that any perceived misdescription actually describes the goods.

In conclusion, we find that TALK FREE is neither merely descriptive nor deceptively misdescriptive in connection with telephone calling cards, the goods identified herein.

Decision: The refusal under Section 2(e)(1) of the Act and the requirement for a disclaimer is reversed.

J. D. Sams

E. W. Hanak

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board