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Paper No. 26
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **McCaw Cellular Communications, Inc.**

Serial No. 74/**801,178**

Frank L. Politano, R. A. Ryan and Michele A. Farber of for
applicant.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law
Office 102 (Myra K. Kurzbard, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by McCaw Cellular
Communications, Inc.¹ to register the designation 1-800-
IMAGINE for "cellular telephones and parts therefor; pagers

¹The application originally was filed by McCaw Cellular
Communications, Inc., and all of the papers in this case,
including applicant's briefs, were filed by its attorney, Lynne
E. Graybeal. After all the briefs were in, applicant filed a
substitute power of attorney, with the new attorneys being shown
above. In that paper, it was stated that the applicant,
formerly McCaw Cellular Communications, Inc., is now AT&T
Wireless Services, Inc. A check of Office records reveals,
however, that the appropriate assignment documents have not been
recorded. See: Trademark Trial and Appeal Board Manual of
Procedure, §§ 125, 512.01 and 512.03.

and parts therefor; facsimile machines and user manuals and instructional books sold as a unit therewith."²

The Trademark Examining Attorney has refused registration under Sections 1, 2 and 45 of the Act³ on the ground that the designation sought to be registered, as used on the specimens of record, does not function as a trademark.

After an initial examination and entry of an examiner's amendment relating to the identification of goods, the application was approved for publication and the mark was published in the Official Gazette. No opposition being filed, the Office issued a notice of allowance. Applicant subsequently filed a statement of use with the required specimens. Upon review of these documents, the Examining Attorney issued the refusal. When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.

Applicant contends that 1-800-IMAGINE, as it appears on the specimens of record, functions as a trademark to identify and distinguish applicant's goods from the goods of others. That is to say, the designation sought to be registered functions both as a phone number to contact

²Application Serial No. 74/801,178, filed November 13, 1991, based on a bona fide intention to use the mark in commerce. Applicant subsequently filed a statement of use alleging dates of first use of July 1992.

³The Examining Attorney's reference to Section 3 is unnecessary inasmuch as the involved application does not involve a service mark.

applicant, as well as a trademark. Applicant asserts that customers call 1-800-IMAGINE to purchase applicant's goods, that the fact that the phone number is used on the specimens as part of a phrase does not diminish its source-indicating function, and that the designation is one of a family of IMAGINE marks used by applicant to identify applicant's various goods and services. In urging that the refusal be reversed, applicant submitted the declaration of Bryn Frazier, applicant's assistant corporate advertising manager. Mr. Frazier states, in pertinent part, that potential customers can and do call the 1-800-IMAGINE phone number to order products and to obtain information about applicant's products and services; and that the phone number appears on labels on the products on display at applicant's stores and on the products when they are sold. Applicant also relied upon the declaration of Louis Briones, the account director of an outside advertising agency who handles advertising for applicant's goods.⁴ In this connection, Mr. Briones asserts that applicant frequently uses 1-800-IMAGINE and IMAGINE NO LIMITS together in the advertising and sale of its goods and services. The declaration is accompanied by five advertisements that applicant has placed: two on the radio, one in a printed

⁴Mr. Briones' declaration and related exhibits were submitted with applicant's appeal brief. Although the submission of evidence with an appeal brief is untimely, the Examining Attorney in this case considered the evidence as if properly introduced. Thus, we have treated the evidence to be of record.

publication and two in golf tournament publications. The text of the radio advertisements shows that at the end of the ad, the announcer says "Cellular One. No one delivers better service, better call quality or better coverage...Call 1-800-IMAGINE." The printed advertisements instruct interested readers to "call us at 1-800-IMAGINE." Applicant also submitted a list of six third-party registrations of "1-800-..." marks. Lastly, applicant has relied upon a list of its registrations and applications for marks comprising, in whole or in part, the word "IMAGINE." The list was followed up with soft copies of these official records.⁵ Applicant places significant value on its ownership of Registration No. 1,718,806, issued September 22, 1992, for the mark 1-800-IMAGINE for "telecommunication services."

The Examining Attorney maintains that the specimens do not show use of 1-800-IMAGINE as a trademark for the identified goods. Rather, in the Examining Attorney's view, the specimens show use of the phone number as part of a phrase that is merely informational (that is, customers and

⁵Although the list prepared by applicant is not sufficient to properly make of record applicant's registrations and applications, the soft copies are sufficient to do so. And, while the soft copies were not submitted until applicant filed its appeal brief, the Examining Attorney, in his brief, addresses applicant's "family of marks" argument based on this evidence. Inasmuch as the Examining Attorney did not object to this evidence, but rather essentially treated it as if properly made of record, we have considered the evidence in reaching our decision.

potential customers can obtain more information about applicant's goods and services by calling 1-800-IMAGINE).

The term "trademark", as defined in relevant part in Section 45 of the Trademark Act, means "any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Clearly, not every word or combination of words which appears on an entity's goods functions as a trademark. In re Remington Products Inc., 3 USPQ2d 1714 (TTAB 1987). Thus, the mere fact that applicant's 1-800-IMAGINE telephone number appears on the specimens does not make it a trademark. To be a mark, the designation must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. Mere intent that a word or combination of words functions as a trademark is not enough in and of itself to make the word or combination of words a trademark. Id.

A critical element in determining whether a term is a trademark is the impression the term makes on the relevant public. In the type of case presently before us, the inquiry becomes a question of whether the designation sought to be registered would be perceived as a source indicator or, rather, as merely an informational telephone number.

Based on the evidence of record, with a particular eye toward the specimens (labels affixed to the goods), we find that 1-800-IMAGINE is merely an informational phone number that would not be perceived by others as a trademark for applicant's goods. The specimens show prominent use of applicant's mark **CELLULARONE**. In subordinate fashion in small print appear the following uses: "Additional information on phones and service--1-800-IMAGINE" or "For information or service call 1-800-IMAGINE". A sample specimen label is reproduced below.



Applicant's uses of 1-800-IMAGINE convince us that it would be perceived as nothing more than an informational telephone number that interested consumers could call. Every use by applicant of 1-800-IMAGINE, which is the specific proposed mark at issue here, is that of a phone number to call for additional information on applicant's products and services. We cannot find, based on the evidence of record, that 1-800-IMAGINE has been used in such a manner that it would be readily perceived as identifying the specified goods and distinguishing a single source or origin for the goods. As the Examining Attorney points out, the fact that consumers can purchase applicant's goods by

calling the telephone number may bear on use of the telephone number as a service mark, but does not, as demonstrated by the specimens, show trademark use for goods.⁶

The third-party registrations of "1-800-..." marks are not persuasive of a different result in this case. Although uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine whether applicant's particular mark is registrable. As the Board often has stated, each case must be decided on its own facts, and we are not privy to the file records (in particular, the specimens) of the registrations which applicant listed. Likewise, applicant's ownership of several registrations and applications for IMAGINE marks does not compel a different result.

This case is distinguishable from the one heavily relied upon by applicant, namely, *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992). Suffice it to say that there the record as a whole established that the mark had a source-indicating function. Here, 1-800-IMAGINE would be

⁶Applicant's reliance on *Amica Mutual Insurance Co. v. R. H. Cosmetics Corp.*, 204 USPQ 155 (TTAB 1979) is misplaced. Applicant argues that its telecommunication goods are intimately related to its telecommunication services such that "this nexus...strengthens the mark's function as an identifier of a single source for the goods." (brief, p. 9) Applicant overlooks an important observation by the Board in that case, however, to the effect that there was a distinction between the trademark and service mark use of AMICA *for purposes of registration*. That same distinction applies here.

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perceived as merely a telephone number to call for more information about applicant's goods and services.

The briefs have made and debated, and we have considered, arguments other than those we have discussed above, all of which we find unnecessary to specifically comment on.

Decision: The refusal to register is affirmed.

R. L. Simms

T. J. Quinn

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

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