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AUG 3, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Mary Ann Walker**

Serial No. 74/579,223

William C. Steffin of Lyon & Lyon for Mary Ann Walker

Kelley L. Wells, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney)

Before Cissel, Seeherman and Hairston, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Mary Ann Walker has appealed from the refusal of the Trademark Examining Attorney to register 1-800-636-3636 as a mark for "preparing and placing radio, newspaper, and television advertising for others and providing an attorney referral service for others."¹ Applicant seeks registration

¹ Application Serial No. 74.579,223, filed September 21, 1994, and asserting first use and first use in commerce as early as September 4, 1984.

under the provisions of Section 2(f) of the Trademark Act.² Registration has been refused pursuant to Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052, 1053 and 1127, on the basis that the asserted mark does not function as a service mark because it is merely informational, and that applicant's evidence of acquired distinctiveness is not persuasive of a different result.³ We read this

² Although applicant, in her response to the first Office action, sought registration under Section 2(f) in the alternative, that is, if her arguments about the inherent distinctiveness of its mark were not persuasive, and has made references in her briefs to what might be construed as an argument that the mark is inherently distinctive, her briefs are primarily directed to the point that the telephone number has acquired distinctiveness and there is no reference that this argument has been made in the alternative. In any event, at the oral hearing applicant's attorney specifically stated that applicant was not contending that the mark was inherently distinctive, but only that it had acquired distinctiveness. In view thereof, the only issue we have considered in this appeal is whether the telephone number has acquired distinctiveness as a mark.

³ In its reply brief applicant states that the final refusal was not based on the lack of inherent distinctiveness or secondary meaning, but only on the assertion that the mark failed to function as a mark because it was merely informational. Applicant states that, as a result, in its appeal brief it only addressed the argument relating to the failure of the mark to function as a service mark, and therefore the other bases for refusal should be deemed to have been withdrawn. First, the refusal that 1-800-636-3636 fails to function as a mark is, in effect, a refusal because the asserted mark is not inherently distinctive. As for the refusal that the asserted mark has not been shown to have acquired distinctiveness, it is true that, although in the second Office action the Examining Attorney found the Section 2(f) evidence to be insufficient to establish that the mark has acquired distinctiveness, in the final Office action the Examining Attorney stated that applicant's evidence "that the matter has acquired distinctiveness is of no avail." Although the Examining Attorney should have stated that the evidence submitted by applicant was insufficient to demonstrate that the

statement as a refusal based on the insufficiency of applicant's evidence to demonstrate that its purported mark has acquired distinctiveness.

Applicant and the Examining Attorney have filed briefs,⁴ and applicant filed a reply brief. An oral hearing was held before this Board.

In view of applicant's acknowledgment that its asserted mark is not inherently distinctive, we need only consider whether applicant has demonstrated that her telephone number has acquired distinctiveness, such that it is recognized as a mark for applicant's identified services.

Clearly applicant's asserted mark, 1-800-636-3636, is a telephone number and, in that respect, serves an

telephone number had acquired distinctiveness as a mark, we do not consider the irregularity in the language used to render the final refusal premature. Indeed, there is no question that applicant was aware that the sufficiency of her evidence of acquired distinctiveness was at issue in the proceeding, since both her appeal brief and reply brief discuss this point extensively.

⁴ With her brief the Examining Attorney submitted yellow pages directory listings, and asked that we take judicial notice of "the fact that businesses have telephone numbers and that they frequently and sometimes prominently utilize these phone numbers in advertising." Applicant has objected. Although we can and do take judicial notice of the generally known fact that businesses have telephone numbers, see Fed. R. Evid. 201, the exhibit attached to the Examining Attorney's brief, purporting to show prominent use of telephone numbers in advertisements, is not properly a subject of judicial notice. Because this material was not submitted during the examination phase, and in view of applicant's objection, it has not been considered.

informational function. The question for us is whether, considering the evidence of record, applicant has shown that this telephone number also serves an additional function, namely, to act as a source-identifier for the services identified in applicant's application. In this connection, it is not sufficient that consumers know that by calling 1-800-636-3636 they can reach applicant; rather they must regard this number as indicating, in the manner of a mark, the source of applicant's services.

We take judicial notice that telephone numbers are used by virtually all businesses. Given this ubiquitous use, the degree of evidence necessary to show that consumers regard this particular telephone number as a service mark of applicant, rather than merely as a way of contacting applicant, must necessarily be high.

With respect to its service of preparing and placing radio, newspaper, and television advertising for others, applicant has submitted as a specimen what appears to be a flyer. At the bottom of the flyer is the name and address for Walker Advertising, Inc., which is a corporation owned by applicant. The advertisement states "Los Defensores produces impressive results by purchasing a substantial amount of advertising time on the Southland's key Spanish-speaking television and radio stations...." It is not

entirely clear from the record, but it appears from the specimens that applicant, through Walker Advertising, Inc., offers her advertising service to attorneys who become part of the Los Defensores, Inc. organization. In other words, attorneys become part of applicant's Los Defensores, Inc. lawyer referral service. The telephone number 1-800-636-3636 prominently appears on the advertisement, above the words "Y El Exito Legal Esta A Su Alcance." Applicant has not furnished a translation of these words, and we therefore cannot view the Spanish statement as in any way promoting to the consumers of applicant's advertising services that the telephone number is a trademark, such that these consumers would recognize it as a mark.⁵ Further, all of the information applicant has provided with respect to the use and advertising of her purported mark, and customers of her services, is in connection with her Los Defensores, Inc. company. Applicant has provided no sales and advertising figures with respect to the identified advertising services.

⁵ The burden is on applicant to prove acquired distinctiveness. If the evidence which applicant submits is in a language other than English, it is applicant's responsibility to provide a translation. (As an aside, we have ascertained that the phrase can be roughly translated "And legal success is within your reach." Nothing about this phrase would lead consumers to conclude that the telephone number shown above it is a trademark.)

Accordingly, applicant's evidence of acquired distinctiveness of the telephone number with respect to her advertising services is woefully inadequate to demonstrate that the number would be perceived as a mark by the relevant consumers of such services.

Applicant has not provided any information about the activities of Los Defensores, Inc., other than to say that she has personal knowledge of the services provided by it, and that since 1984, over 200,000 consumers of Los Defensores' services have been referred to attorneys. From this we conclude that Los Defensores, Inc. is a lawyer referral service. Applicant has also stated, in her first declaration, that through this corporation, of which she is sole shareholder, she has used the mark 1-800-636-3636 continuously in commerce since 1984; that the mark has been advertised extensively on television and radio, and placed on promotional items such as T-shirts, cup holders and caps; and that since 1984 over \$20 million has been spent promoting the mark.

In addition to the information provided in the first declaration, applicant submitted a second declaration stating that she directed that consumers who have used Los Defensores, Inc.'s services should be contacted. As a

result, 37 signed a form bearing the following statement at the top:

For at least ___ years now I have seen "1-800-636-3636" advertised in connection with the attorney referral and advertising services provided by Los Defensores, Inc.

I have come to look upon the "1-800-636-3636" trademark as a symbol identifying the services provided by Los Defensores, Inc., and not of any other company in this field.

Below this statement are signatures of various individuals, along with the date they signed the form and the number of years referred to in the first paragraph.

The photograph submitted by applicant shows a cap with the asserted mark printed above a logo which includes the words LOS DEFENSORES, which is in turn above the same Spanish-language phrase used on the specimen for her advertising services, namely, "Y El Exito Legal Esta A Su Alcante." This same photograph shows a T-shirt, the top of which has been folded over, so that all that is visible is the asserted mark and the Spanish-language phrase. The cup holder, which is also in the photograph, shows portions of the asserted mark above a phrase which is too small for us to read. As noted, all three promotional items referred to by applicant in her declaration are shown in a single photograph, which is itself of a rather small size. As a

result, none of the items appears particularly clear, to the extent that it is a struggle to see what appears on the lower portion of the cap, and we have been unable to read all the wording on the cup holder. Moreover, portions of the items are blocked from view. We do not know if applicant deliberately folded the T-shirt in such a way to obscure additional wording or marks, but the result is that we are unable to ascertain the impact these items would have on consumers. From the portions of the items we can view, we cannot conclude that the telephone number printed on them conveys the impression to consumers that 1-800-636-3636 is a trademark for lawyer referral services.

As for applicant's television and radio advertising, she has not shown the manner in which the telephone number is used in such commercials. Thus, although applicant asserts that she has expended over \$20 million in television and radio advertising and distribution of promotional items, based on the record before us we cannot conclude that the telephone number has been promoted in such a way that the public would recognize it as a trademark.

Similarly, applicant has not provided any materials regarding her use of the number in connection with her lawyer referral services, such that we can conclude that

the impact of the use since 1984 has been as a trademark, rather than as a merely informational telephone number.

The document signed by 37 consumers of Los Defensores, Inc.'s lawyer referral services is, to some extent, evidence of the public perception of the number. Although case law states that form declarations are acceptable to show acquired distinctiveness of a mark, clearly information which has been provided in an individual's own words is of greater probative value. The evidence provided in this case is of particular concern because applicant's legal referral services are apparently directed to a Spanish-speaking audience, as evidenced by the Spanish-language slogan shown on the promotional items, and the statement, in applicant's reply brief, that the number is advertised in Spanish. p. 2. It is unclear whether Spanish-speaking consumers would understand the somewhat technical language employed in the form statement of acquired distinctiveness. Further, the statement says that the signers have seen the mark "advertised in connection with the attorney referral and advertising services provided by Los Defensores, Inc.," but it appears to us, from the information in the file, that applicant's advertising services are rendered through Walker Advertising, Inc., not Los Defensores, Inc. Certainly

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applicant's declaration indicates that Los Defensores, Inc.'s customers use attorney referral services, not applicant's advertising services. In view of the foregoing, we believe that the letter signed by 37 customers is entitled to little weight. See **In re EBSCO Industries Inc.**, 41 USPQ2d 1913 (TTAB 1996).

In any event, the evidence required to show acquired distinctiveness is directly proportional to the descriptiveness or, in this case, non-distinctiveness, of the mark at issue. See **Yamaha International Corp. v. Hoshino Gakki Co. Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Given the ubiquitous use by businesses of telephone numbers as a purely informational vehicle, applicant has not met its burden of proving that its telephone number 1-800-636-3636 has acquired distinctiveness as a mark for applicant's identified services.

Decision: The refusal of registration is affirmed.

R. F. Cissel

E. J. Seeherman

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board