

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 18, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **AutoNation Incorporated**

Serial No. 75/126,814

Mark H. Tidman of Baker & Hostetler LLP for AutoNation
Incorporated

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney)

Before Simms, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

AutoNation Incorporated (applicant), a Florida
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the asserted mark
shown below

for automobile dealership services.¹ The Examining Attorney has refused registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 USC §§ 1051, 1052, 1053 and 1127, arguing that the asserted mark fails to function as a service mark and that, therefore, applicant must submit substitute specimens evidencing use of the asserted mark as a service mark.

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

The specimens of record consist of a full page advertisement of applicant's services. In reduced form, that advertisement is show below.

¹ Application Serial Number 75/126,814, filed June 28, 1996, based upon applicant's allegations of a bona fide intention to use the mark in commerce. Before applicant's mark was published for opposition, applicant submitted an amendment to allege use, claiming use in commerce since November 8, 1996.

Essentially, it is the Examining Attorney's position that the asserted mark appears as an informational statement that does not identify and distinguish applicant's services. The Examining Attorney notes that applicant's

asserted mark appears with six other similar traffic sign designs which contain highly descriptive phrases or informational statements highlighting the features of applicant's services, such as low prices, a 99-day warranty, a money-back guarantee, etc. The Examining Attorney argues that a consumer would see "AutoNation USA" as the name of applicant's dealership and would not view the proposed mark as identifying and distinguishing applicant's services. Further, the Examining Attorney contends that if applicant's advertisement contained only applicant's asserted mark without the identifying name AutoNation USA, a consumer would have no idea concerning the source of applicant's services.

It is also the Examining Attorney's position that the use of "carriers" to highlight information concerning one's services is often used in advertisements. The Examining Attorney has submitted some examples of what she regards as similar usage. Finally, the Examining Attorney contends that the use of the designation "TM" does not alter the perception of the asserted mark to potential purchasers.

Applicant, on the other hand, aside from arguing that newspaper advertisements promoting one's services under the mark are appropriate specimens, argues that the asserted mark serves to identify the source of applicant's services.

Applicant contends that the fact that the asserted mark also provides information or describes a characteristic of applicant's services does not mean that it cannot also function as a service mark. Applicant's attorney points out that a product or service may bear more than one trademark or service mark. Also, applicant contends that the fact that the asserted mark appears with other marks does not militate against a finding that it is also a mark. Applicant points to the "TM" designation used in connection with its asserted mark. Applicant distinguishes the third-party advertisements submitted by the Examining Attorney as being of highly descriptive phrases which merely highlight various features concerning the goods or services being advertised. Finally, applicant, with its request for reconsideration, noted that it has obtained two registrations of the mark "1 LOW PRICE" and design for automobile dealership services and for automotive repair and maintenance services based upon specimens identical to those submitted herein. Applicant argues that this is evidence that the asserted mark does function as a service mark to identify and distinguish applicant's services and that purchasers will recognize the traffic design motif of

its numerous design marks.²

Whether an asserted mark functions as a service mark depends upon how it is used and how potential purchasers would perceive it. Upon careful consideration of this record and the arguments of the attorneys, we affirm the refusal of the Examining Attorney. While it is possible that the asserted mark may be capable of identifying and distinguishing applicant's services (an issue not now before us), it is our opinion that the asserted mark, conveying information that applicant has a large selection of automobiles, is not one which functions as a service mark and is registrable on the Principal Register without further support. We believe that potential purchasers would view the asserted mark as merely providing information about the features of applicant's automobile dealerships (that it has a large selection of automobiles) and not as a service mark identifying and distinguishing the source of those services. While a different Examining

² Applicant stated in its brief that the Examining Attorney had withdrawn the approval of its amendment to allege use. We can find no such approval in this record. Rather, crossing in the mail with the Examining Attorney's Examiner's Amendment classifying applicant's goods in Class 35 and approving applicant's mark for publication, applicant submitted its amendment to allege use and specimens of record. The notice of publication was issued after review of applicant's intent-to-use application and was not an approval of the amendment to allege use.

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Attorney has permitted registration with respect to a different asserted mark, it should be noted that the Board is, of course, not bound by decisions of Examining Attorneys in other applications. In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991). Each case must be decided on its own merits. Also, merely because an applicant intends an asserted mark to so function does not mean that it in fact does function as a service mark. See In re Morganroth, 208 USPQ 284, 287 (TTAB 1980).

Decision: The refusal of registration is affirmed.

R. L. Simms

G. D. Hohein

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board