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Paper No. 11  
RLS/csl

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Leonard P. Gietz, M.D.

Serial No. 75/858,278

L. Kyle Ferguson of Novakov Davis & Munck, P.C. for Leonard P. Gietz, M.D.

Khanh Le, Trademark Examining Attorney,  
Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Leonard P. Gietz, M.D. (applicant) has appealed from  
the final refusal of the Trademark Examining Attorney to  
register on the Principal Register the mark shown below



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for the rental of wireless telephones.<sup>1</sup> Applicant has disclaimed the words "Rent-a-Phone" apart from the mark as shown and has described his mark as follows:

The mark consists of the phrase "RENT-A-PHONE" in light green letters within an elliptical field providing a white background with a light green border.

The Examining Attorney has refused registration, arguing that applicant's mark does not create an inherently distinctive commercial impression separate and apart from the descriptive words "Rent-a-Phone." Applicant and the Examining Attorney have submitted briefs but no oral hearing has been requested.

We affirm.

It is the Examining Attorney's position that, while applicant's mark may be capable of indicating origin (and therefore registrable on the Supplemental Register), here applicant's entire mark is not inherently distinctive because it consists of merely descriptive words with a background element consisting of a common geometric shape in the form of an oval in light green color. Accordingly, the Examining Attorney argues that the graphic elements of applicant's mark do not create a separate and distinctive commercial impression or serve a trademark function. The

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<sup>1</sup> Application S.N. 75/858,278, filed November 26, 1998, based upon applicant's bona fide intention to use the mark in commerce.

Examining Attorney maintains that applicant's mark is unregistrable without a showing of acquired distinctiveness under Section 2(f) of the Act.

Applicant, on the other hand, while conceding that common geometric shapes are not generally regarded as trademarks in the absence of evidence of acquired distinctiveness (brief, 8), contends that here his mark consists of a descriptive and disclaimed term in light green letters in an italicized sans serif font on a white background within a green ellipse. Applicant argues, therefore, that his mark consists of stylization and ornamentation which is sufficiently distinctive to permit registration without proof of acquired distinctiveness, and that his mark including the design features creates a commercial impression separate and apart from the unregistrable components of the mark so that the mark serves a trademark function.<sup>2</sup>

An applicant may register a background design with descriptive words if the background design creates a commercial impression separate and apart from the descriptive word portion of the mark. See *In re Benetton*

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<sup>2</sup> In his reply brief, 9, 10, applicant argues that in order to affirm this refusal, the Board must conclude that applicant's mark is *incapable* of distinguishing his services. That is incorrect. Here, applicant is seeking registration on the Principal Register and not on the Supplemental Register; only the latter requires us to consider the question of capability.

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*Group S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998), *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) and *In re Miller Brewing Company*, 226 USPQ 666, 668 (TTAB 1985). If the background is inherently distinctive, it may be registered without evidence of acquired distinctiveness. Ordinary geometric shapes such as circles, ovals, squares, etc., are generally regarded as non-distinctive and protectable only upon proof of acquired distinctiveness. *In re Anton/Bauer, supra*. Also, subject matter that is merely a decorative feature does not identify and distinguish applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans or other trade dress.

In determining whether a proposed mark is inherently distinctive, factors to be considered include whether the subject matter is unique or unusual or whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation.

In *In re Benetton Group S.p.A., supra* at 1216, the Board held that a common shape with color (green rectangle) serving as a background for different words and designs was unregistrable.

The fact that applicant's rectangle is green does not change the standard by which these types of marks are judged. We find that

applicant's green rectangle falls into the category of a background design requiring proof of acquired distinctiveness for purposes of registration.

See also *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991), where the Court stated that, if a mark is dominated by a descriptive and disclaimed element, that portion imparts non-registrable meaning to the entire mark. The Court explained that where a mark containing insignificant elements is dominated by descriptive and unregistrable matter, the entire mark remains unregistrable because the nonregistrable meaning is imparted to the entire mark. The Court stated, 21 USPQ2d at 1051:

Such a mark, in effect, has no "unregistrable component" because the dominant feature of the mark extends a nonregistrable meaning to the whole. The entire mark becomes nonregistrable.

Upon careful consideration of this record and the arguments of the attorneys, it is our judgment that applicant's mark falls into the category of marks that are not inherently distinctive and are unregistrable without a showing of acquired distinctiveness. The mark consists of the words "Rent-a-Phone" in relatively non-distinct green lettering within a green elliptical border on a white

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background. Aside from the fact that color alone is not inherently distinctive,<sup>3</sup> the oval or elliptical design is a relatively common background design that fails to indicate origin without sufficient exposure and recognition by the relevant public as an indication of origin (acquired distinctiveness). It does not create a commercial impression separate and apart from the remainder of the mark. Accordingly, the determination of the Examining Attorney that applicant's mark as a whole is not inherently distinctive is correct, and the refusal of registration is affirmed.

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<sup>3</sup> In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211, 54 USPQ2d 1065, 1068 (2000), the Supreme Court held that color can never be inherently distinctive. The Court, citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161 (1995), stated, "with respect to at least one category of marks - colors - we have held that no mark can ever be inherently distinctive."