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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re U-Haul International, Inc.

Serial No. 75/535,232

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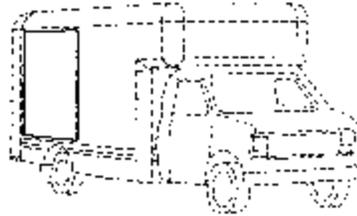
Before Seeherman, Walters and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 12, 1998, U-Haul International, Inc.
(applicant) applied to register the mark shown below on the
Principal Register for goods ultimately identified as:

Rental services, namely, rental of trucks, trailers, vans, moving vans, automobiles, recreational vehicles, automobile freight trailers, ramps, hitches, pads, tow bars, dollies, carriers, hand trucks, camper jacks, moving equipment, canoes, boats, boat motors, boat trailers, vehicles, general storage services; warehouse and storage space rental services; warehouse storage services; rental of garage space; parking lot services; rental of parking spaces; cargo handling;

cargo unloading; furniture moving services; delivery of goods by truck, car or van; moving van services; truck hauling; [and] truck towing in International Class 39.¹



The mark is described as follows:

The mark consists of the specific placement of an illustration readily identifiable with one of the fifty United States, the District of Columbia, or one of the Canadian provinces, on the rear portion of the side panel of a vehicle, extending from about the top to about the bottom of the panel and between a point adjacent to the rear of the side panel and a point adjacent to the rear axle well.

Applicant has also included a statement that the "matter shown in dotted lines is not a part of the mark and serves only to show the position of the mark."

The examining attorney² has refused to register applicant's mark under Sections 1 and 45 of the Trademark Act (15 U.S.C. §§ 1051 and 1127) because the application seeks registration of more than one mark. Because the examining attorney held that application is for more than one mark, the examining attorney also required the

¹ Serial No. 75/535,232. The application contains an allegation of a date of first use and a date of first use in commerce of December 31, 1987.

² The current examining attorney was not the original examining attorney in this case.

applicant to amend the drawing to show only one mark and to amend the description of the mark to describe only one mark. When the refusal and the requirements were made final, this appeal followed.

The examining attorney's position is that Trademark Rule 52 "explicitly states that 'the drawing must show only one mark.'" Examining Attorney's Brief at 12.³ In addition, the examining attorney held that "the proposed mark is clearly comprised of [an] element that is subject to change and unregistrable because it includes more than a single mark." Id. In support of his position, the examining attorney cited the case of In re International Flavors & Fragrances Inc., 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999) and held:

Relying on the plain language in the description, the proposed mark, at a minimum, could be one of fifty-eight possible illustrations. However, the seventy-two photographs in the record demonstrate that several states are represented by multiple illustrations and many cities also have their own representative illustrations. Other evidence in the record, such as newspaper articles and email communications, show that applicant periodically introduces new illustrations for placement on the side of its vehicles and equipment, all of which applicant believes will be incorporated under the mark identified in the present application. Moreover, additional geographic designations and places and events of historical or educational curiosity are also included within the

³ We note that the examining attorney's requirements for a new drawing and an amended description of the mark are dependent on the refusal that applicant is impermissibly seeking registration for multiple marks in a single application.

applicant's broad description of the mark. Following the applicant's logic, and in light of the evidence in the record, the mark is one of a potentially unlimited number of illustrations that are constantly evolving with the creation of new graphics to use on the applicant's vehicles.

Examining Attorney's Brief at 14-15.

Applicant responded to the refusal by submitting evidence and argument in support of its position that its mark is registrable on the Principal Register. Applicant maintains that its "mark is not unlimited, and the mark as described by Applicant, can be searched against conflicting marks." Reply Brief at 2. Applicant's evidence consisted of the survey questionnaires of 69 individuals who had rented a truck for household or business goods within the previous three years. According to an attorney from the law firm of Jeffer, Mangels, Butler & Marmaro LLP, applicant's law firm at that time, approximately 85.5% of respondents "associate the mark with a particular company or companies. Furthermore, well over half (approximately 58%) of the survey respondents identified applicant by name as a source of Applicant's Mark." Lofgren declaration at 6.

Applicant also submitted photographs of the various displays on the sides of its vehicles and the sides of its competitor's vehicles, advertising, promotional materials,

newspaper articles, emails, and the declaration of two U-Haul employees and two independent U-Haul distributors. Applicant also distinguished the International Flavors decision on which the examining attorney relied by arguing that its mark appears in the same location; it conveys the same commercial impression, it always appears in bold, vibrant colors, and that since applicant has submitted 79 representations "the public can view the scope of the mark." Applicant's Brief at 22. Applicant goes to maintain that it "has precisely defined the characteristics of Applicant's Mark that establish it as more than just a concept" and that it is entitled to registration. Applicant's Brief at 24.

It has long been held that the "Statute, Rules and TMEP are all firmly grounded on the principle that a single application may seek to register only one mark." In re Audi NSU Auto Union AG, 197 USPQ 649, 651 (TTAB 1977). The Federal Circuit has held that an applicant is not permitted to register more than one mark in the same application.

We agree with the Commissioner that under the Lanham Act and the rules promulgated thereunder, a trademark application may only seek to register a *single* mark. See, e.g., 15 U.S.C. Section 1051 (1994) ("The owner of a *trademark* ... may apply to register his or her *trademark* under this chapter on the principal register established: ... (3) By complying with such rules or regulations, not inconsistent with law, as may be

prescribed by the Commissioner.") (emphasis added). The language of the relevant regulations also contemplate that an application may seek to register only a single mark. See, e.g., 37 C.F.R. Section 2.51(a)(1) (1998) ("In an application under section 1(a) of the [Lanham] Act, the drawing of the trademark shall be a substantially exact representation of *the mark* as used on or in connection with the goods") (emphasis added). Furthermore, the PTO's own trademark prosecution guidelines make clear that "[t]here may not be more than one mark on a drawing, since an application *must be limited to one mark.*" U.S. Patent and Trademark Office, Trademark Manual of Examining Procedure Section 807 (2d ed. 1993 rev. 1.1 Aug. 1997) (emphasis added).

International Flavors, 51 USPQ2d at 1516 (punctuation and emphasis in original).

Current rules and practice similarly prohibit the registration of more than one mark in a single application. 37 CFR § 2.52(a) (2003) ("A drawing depicts the mark sought to be registered. The drawing must show only one mark"); TMEP § 807.03 (May 2003) ("An application must be limited to one mark"); TMEP § 1214.01 (May 2003) ("Where an applicant seeks registration of a mark with a changeable or 'phantom' element, the examining attorney should refuse registration under §§ 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that the application seeks registration of more than one mark").

Applicant submits that its alleged mark "is a single mark" and therefore not a phantom mark. Applicant's Brief at 9. We start by noting that applicant has included more

than seventy photographs of what apparently is the use of its mark on various vehicles. Since virtually each photograph is different, applicant's argument that its mark is a single mark is difficult to accept. Applicant's description of its mark is "an illustration readily identifiable with one of the fifty states, the District of Columbia, or one of the Canadian provinces." A review of applicant's photographs of its trucks reveal some of the following illustrations: rockets, a helicopter, a moose, a dogsled team, a motorcyclist, cacti, a surfer, a jet fighter, tigers jumping through flaming hoops, a cowboy, the Space Shuttle, a fisherman, fish, whitewater rafters, peaches, a dairy farm, a football player, farm equipment, hot air balloons, horses, an eagle, a snowmobile driver, and a steam train. Applicant's declarant has indicated that it is not even limited to these depictions of record. See Burke declaration at 2 ("The 'unveiling' of additional depictions of the Mark is extensively promoted").

Applicant argues that "Applicant's mark is not unlimited, and the mark, as described by Applicant, can be searched against conflicting marks." Reply Brief at 2. Considering just some of the illustrations described above, if the mark in the application does not encompass unlimited or

virtually unlimited illustrations, we are not sure what the word "unlimited" means.

While applicant attempts to distinguish International Flavors, we find that the case compels a conclusion that applicant is seeking to register more than a single mark in one application. In that case, the marks applied-for were LIVING XXXX FLAVORS and LIVING XXXX FLAVOR for, inter alia, essential oils in the manufacture of foodstuffs. The "XXXX" was identified as a placeholder for "a botanical or extract thereof." The Court held that "marks with missing elements ... encompass too many combinations to make a thorough and effective search possible." 51 USPQ2d at 1517. The situation is even more ambiguous in the present case. Unlike the mark in International Flavors, which consisted of three words with one element missing, applicant's alleged mark is simply an illustration on the side of a vehicle.

We also note that International Flavors does not require that only marks that have "unlimited" representations are unregistrable. 51 USPQ2d at 1518 ("[W]e hold that under the Lanham Act, a trademark registrant may seek to register only a single mark in a registration application..."). In addition, the Office rules require that only a single mark may be registered in a

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single application. Clearly, applicant's description of its mark encompasses more than one mark. See also In re Upper Deck Co., 59 USPQ2d 1688, 1690 (TTAB 2001):

We find applicant's present attempt to register a hologram which may have a myriad of shapes, sizes, contents and the like to encompass an even larger number of combinations than the XXXX-containing word marks in In re International Flavors. The specimens themselves show the varying commercial impressions created by the holograms as used on the trading cards. The design may be a baseball field, a racing flag, or whatever applicant adopts for that particular card. The constructive notice which the Court found fundamental to federal registration would be virtually non-existent were applicant permitted to register "a hologram" as applied to trading cards.

Accord In re Elvis Presley Enterprises Inc., 50 USPQ2d 1632 (TTAB 1999) (Applicant not permitted to register a mark consisting of "the likeness and image of Elvis Presley" in a single application when the mark was intended to cover any image of Elvis Presley).

The Board has held that an applicant was impermissibly seeking the registration of multiple marks when it sought "to register all combinations and permutations of green, amber and red squares in a grid." In re Hayes, 62 USPQ2d 1443, 1446 (TTAB 2002). The Board found that a thorough and effective search of that mark was not possible. Id. Even more so in the instant case, a search here is not possible because, as indicated above, the range of images

that could be associated with applicant's design is virtually unlimited.

Applicant relies heavily on the survey questionnaires mentioned above in an attempt to show "that consumers recognize Applicant's Mark as a single mark that identifies Applicant and its services and distinguishes them from the services of others." Applicant's Brief at 12. In that survey, the respondents were shown a representation of the drawing in this application and told that the truck "has a representation or depiction, identifiable with one of the U.S. states, on the rear portion of the side panel." Lofgren declaration, Ex. A. We do not find the survey to be persuasive.

First, even if a large percentage of respondents associate applicant's design with a single company, that would not constitute an exception to the requirement that an applicant can only apply for one mark in a single application. Elvis Presley Enterprises, 50 USPQ2d at 1633-34 ("This is not the first time that an attempt has been made to claim that the likeness and image of Elvis Presley in general serves as a mark. Such an attempt was rejected in the past, and we, like the Examining Attorney, reject it now. See Estate of Elvis Presley v. Russen, 513 F. Supp. 1339, 211 USPQ 415, 439 (D.N.J. 1981))."

Second, applicant argues that its mark "is recognized as a single service mark" apparently because 85.5% of respondents "associated Applicant's mark with a particular company or companies." Applicant's Brief at 9-10. The evidence that applicant has presented does not suggest that its alleged mark is a single service mark. Indeed, the evidence shows that applicant is using numerous designs on the side of its vehicles. In addition, applicant's survey does not indicate that 85.5% of the respondents in the survey associate applicant's alleged mark with a particular company as applicant argues in its reply brief (page 2). As applicant's main brief correctly notes, the survey respondents associated the design "with a particular company or companies." Applicant's Brief at 10 (emphasis added). To the extent that applicant is arguing that this evidence demonstrates that its alleged mark functions as a service mark, the application has not been refused registration on this basis and the evidence is not relevant to the refusal of record.

Even if we view the survey in the context of the issue of whether applicant has applied for a single mark, the survey does not support applicant's argument. The majority of survey respondents either did not associate the alleged mark with any particular company or companies or, if they

did, the respondents associated it with more than one company or they had no opinion as to whether the alleged mark was associated with one or more than one company. These results, if anything, suggest that the respondents do not view the alleged mark appearing on the vehicles as a mark, but as multiple designs from different sources.

In addition, applicant relies on Levi Strauss & Co. v. GTFM Inc., 196 F. Supp.2d 971, 62 USPQ2d 1394 (N.D. Calif. 2002). However, in that case the court found that the marks in the Levi's Tab registrations are "specific, definite, and clear." 62 USPQ2d at 1401. Indeed, while applicant has argued that its mark is similar, the registrant in the Levi Strauss case was not claiming anything displayed on its tab. The trademarks in that case were "a small, rectangular tab of a defined dimension extending from the seam of a garment." Levi Strauss, 62 USPQ2d at 1401. In effect, the mark was the tab and its location. Applicant in the instant case is not claiming a rectangular sign design on the rear side panel of a vehicle. Indeed, a comparison of the drawing and the designs on the vehicles show that applicant's designs are painted on the rear side of applicant's vehicles without any line separating the design from the rest of the material on the side of the vehicles. Unlike the Levi

Strauss case, the applicant's mark is described as varying illustrations associated with states and provinces displayed on the side of its vehicles.

Regarding applicant's other evidence, even if consumer recognition would justify the registration of more than one mark in a single application, the evidence that applicant has submitted is equivocal regarding whether the public recognizes the designs on applicant's vehicles as anything other than decorative pictures. For example, the email communications that applicant has received indicate that members of the public often consider the designs on applicant's vehicles as mere decorations. See, e.g. (1) "I would like to see a U-Haul with seals and walruses and polar bears and orca whales on it"; (2) "How about Wolves??? They can be really cool looking!!!"; (3) "Native Americans"; (4) "You guys should think about doing a fishing graphic. Fly fishing is one of the fastest growing sports in America"; and (5) "You should picture the Earth from space, showing the Internet as trails of light zigzagging across the United States."

Finally, applicant argues that its design "always appears in bold, vibrant colors and includes the name of the applicable U.S. state or Canadian province with the illustration of the mark." Applicant's Brief at 21.

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Neither of these characteristics are a feature of the mark applicant has applied to register and therefore they do not provide any basis for concluding that applicant's alleged mark is registrable.

Decision: The examining attorney's refusal to register applicant's mark because it impermissibly seeks to register more than one mark in a single application under Sections 1 and 45 of the Trademark Act is affirmed. Similarly, the examining attorney's requirements for a drawing that depicts a single mark and a description of the mark that describes only a single mark are affirmed.