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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dial-A-Mattress Operating Corp.

Serial No. 76290744

Susan Okin Goldsmith of Duane Morris LLP for Dial-A-Mattress Operating Corp.

Andrea D. Saunders, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Hanak, Walters and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Dial-A-Mattress Operating Corp. has filed an application to register on the Principal Register the mark 1-800-MATTRESS, with "800" appearing in dotted lines, for, as amended, "telephone shop-at-home retail services and retail store services in the field of mattresses and bedding, namely sheets, mattress pads and pillows," in

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International Class 35.¹ The application includes the statement that "the drawing is lined to indicate that the area code will change." Applicant claims ownership of Registration Nos. 1,589, 453 ((212)MATTRES with the notation that the area code may change); 1,728,356 (1-800-MATTRES, AND LEAVE OFF THE LAST S THAT'S THE S FOR SAVINGS); 1,339,658 (DIAL A MATTRESS); 1,554,222 (DM DIAL A MATTRESS and design); 1,748,796 (DIAL-A-MATTRESS and design); and 1,757,763 (PHONE-A-MATTRESS).

Additionally, in response to a refusal to register based on mere descriptiveness, the application was amended to add a claim of acquired distinctiveness, under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), based on use of the mark for more than five years and ownership of the above-noted registrations. This claim was accepted by the Examining Attorney and the mere descriptiveness refusal was withdrawn.

The Trademark Examining Attorney has issued a final refusal to register, under Sections 1 and 45 of the Trademark Act, 15 U.S.C. 1051 and 1127, on the ground that applicant's mark "is merely a 'phantom' mark because the applicant seeks registration of more than one mark in an application."

¹ Serial No. 76290744, filed July 27, 2001, based on use of the mark in commerce, alleging first use and use in commerce as of December 31, 1995.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney and applicant disagree about the relevance to the application herein, and the interpretation, of the decisions issued by our primary reviewing court, the Court of Appeals for the Federal Circuit, in *In re International Flavors & Fragrances Inc.*, 183 F.3d 1365, 51 USPQ2d 1513 (1999), and *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (2001). Thus, we begin by reviewing these two decisions.

In *International Flavors, supra*, applicant sought to register LIVING XXXX FLAVORS and LIVING XXX.FLAVOR for essential oils and flavor substances for use in the manufacture of various products, wherein XXXX denoted "a specific herb, fruit, plant or vegetable." The Court agreed with the Board's conclusion that the marks at issue were "phantom" marks and stated that "a phantom trademark is one in which an integral portion of the mark is generally represented by a blank or dashed line acting as a placeholder for a generic term or symbol that changes, depending on the use of the mark" (*id.* at 1517). After reviewing the purpose of federal registration and the significance of constructive notice, the Court drew the following conclusion (at 1517 - 1518):

In order to make this constructive notice meaningful, the mark, as registered, must accurately reflect the way it is used in commerce so that someone who searches the registry for the mark, or a similar mark, will locate the registered mark. "Phantom" marks with missing elements, especially those sought to be registered by [applicant], encompass too many combinations and permutations to make a thorough and effective search possible. The registration of such marks does not provide proper notice to other trademark users, thus failing to help bring order to the marketplace and defeating one of the vital purposes of federal trademark registration.

. . .
Conclusion

Because we hold that under the Lanham Act, a trademark registrant may seek to register only a single mark in a registration application, and trademark applications seeking to register "phantom" marks violate the one mark per registration requirement, the decision of the Board is affirmed.

In *Dial-A-Mattress, supra*, applicant had filed an intent-to-use application to register 1-888-M-A-T-R-E-S-S for "telephone shop-at-home retail services in the field of mattresses." Applicant had asserted that its mark is inherently distinctive or, alternatively, that it had acquired distinctiveness based on a declaration and its prior claimed registrations. The Board affirmed the refusal to register on the ground that the proposed mark is generic or, alternatively, that it is merely descriptive and applicant presented insufficient evidence of acquired distinctiveness. The Court reversed. With respect to genericness, the Court stated that the proposed mark bears closer resemblance to a phrase than a compound mark and,

thus, the proper test is that set forth in *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and that the evidence does not support a conclusion that the proposed mark is generic. The Court concluded that the proposed mark is merely descriptive and that the evidence is sufficient to establish acquired distinctiveness.

In this regard, the Court found that the proposed mark 1-888-M-A-T-R-E-S-S is legally equivalent to the mark (212)M-A-T-T-R-E-S (with "212" appearing in dotted lines to indicate that the area code can change) in the prior claimed registration; and that the respective services are similar. The USPTO had argued that, because the "212" area code is subject to change, the mark is a phantom mark that is not registrable and should be given little weight. The Court gave the following rationale for permitting applicant to rely on this registered mark to establish acquired distinctiveness (at 1813):

Although the registration of the "(212)M-A-T-T-R-E-S" mark is a "phantom" mark, the use of which we have questioned, see *In re Int'l Flavors & Fragrances, Inc.*, [*supra*], it is apparent in the present case that the missing information in the mark is an area code, the possibilities of which are limited by the offerings of the telephone companies.

In the case now before us, the same applicant, Dial-A-Mattress Operating Corp., argues that, "while the Federal Circuit had 'questioned' the registration of phantom marks,

it has never prohibited them entirely" (Brief p. 3).

Applicant contends that the Federal Circuit "has distinguished this applicant's registered area code mark from other phantom marks in which the phantom element is not an area code." Applicant states the following (Brief, p. 5):

[T]his applicant has registered a phantom mark [(212)M-A-T-T-R-E-S, with the drawing lined to indicate that the area code will change]. The validity of that mark has been addressed by the CAFC. The CAFC did not agree with the Director that the registered area code mark was not registrable. It was given full weight.

The CAFC itself distinguished the registered area code mark from phantom marks consisting of word combinations. The missing information in the phantom telephone mnemonic mark is a series of numbers that are area codes. Area codes are devoid of source-identifying qualities, and the possible combinations are limited to what is offered by the phone companies. Indeed, the CAFC has recognized that a telephone mnemonic mark consists of seven numbers, not ten or eleven. The area code portion is really just an indication that the mark is in fact a telephone mnemonic and not some other symbol.

Thus, a phantom area code mark has a quality that sets it apart from the mark considered in *International Flavors*. It is immediately apparent that the phantom portion consists of a three-number combination which is an area code. There is no ambiguity. It is a telephone mnemonic.

Applicant contends that its mark herein and its registered mark (212)M-A-T-T-R-E-S are legally identical and that the same situation is presented in this case as was decided by the Federal Circuit in the case discussed herein involving applicant.

On the other hand, the Examining Attorney contends that the mark involved herein is a phantom mark and, as such, it is not a single mark; that as a phantom mark, applicant's mark is not entitled to registration under the law enunciated in the *International Flavors* decision; that the *Dial-A-Mattress* decision is inapposite because "the issue was genericness, not phantom marks." (Brief, unnumbered p.4.) The Examining Attorney contends that an area code mark with a changeable area code is not an exception to the prohibition against the registration of phantom marks. She states that "[n]either the fact that the area codes are limited by the offerings of the telephone companies or the fact that the number of area codes may be a finite number alters the reality that the applicant seeks to register several marks in one application in contravention of the Trademark Act." (Brief, unnumbered p. 8.) She further states the following (Brief, unnumbered p. 10):

[B]ecause the term MATTRESS is a generic term which merely describes the subject of the services[,] the examining attorney searching the mark must focus on the dominant feature, namely, the area code. However, with an indeterminable area code a different commercial impression is created each time the area code changes thereby preventing *all* the elements of the mark to be effectively searched.

Clearly, the two decisions discussed by the Examining Attorney and applicant must be considered together. From these two decisions it is clear that not all phantom marks

are prohibited, *per se*, from registration. Further, the *Dial-A-Mattress* decision is directly applicable to the case now before us. To establish herein its claim of acquired distinctiveness, which the Examining Attorney appears to have accepted, applicant has relied, again, on its registration for the valid mark (212)M-A-T-T-R-E-S (with the "212" appearing in dotted lines to indicate that the area code may change). Consistent with the law of the *Dial-A-Mattress* case, the mark involved herein, 1-800-MATTRESS (with the "800" appearing in dotted lines to indicate that the area code may change), is legally equivalent to both the mark 1-888-M-A-T-R-E-S-S (with the "888" appearing in dotted lines to indicate that the area code may change) at issue in that case and to the registered mark relied upon therein, (212)M-A-T-T-R-E-S.

Contrary to the Examining Attorney's position, the fact that the basis for the refusal in the *Dial-A-Mattress* case was that the mark was generic does not negate the applicability of that case to the case now before us. The Court in the *Dial-A-Mattress* case noted that the registered mark was a phantom mark, but concluded that the mark was a valid trademark and could be relied upon to establish the acquired distinctiveness of the legally equivalent applied-for mark. There is no reason for the Board to reach a different conclusion in this case. Therefore, we find that

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on the facts of the case before us, the Examining Attorney incorrectly refused registration of the mark 1-800-MATTRESS.

Decision: The refusal under Sections 1 and 45 of the Act is reversed.