

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 11

TJQ

Mailed: March 27, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mountain Marketing Group, LLC

Serial Nos. 76/054,955 and 76/098,055

Scott W. Petersen of Holland & Knight for applicant.

Robert L. Lorenzo, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Quinn, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Mountain Marketing
Group, LLC to register the mark 1-800-PET DOCS for
"veterinary services"¹ and the mark 1-800-SKIN DOC for
"medical services."²

The Trademark Examining Attorney has refused

¹ Application Serial No. 76/054,955, filed May 23, 2000, alleging first use anywhere on April 3, 2000, and first use in commerce on April 10, 2000.

² Application Serial No. 76/098,055, filed July 27, 2000, alleging first use anywhere on May 29, 2000, and first use in commerce on June 5, 2000.

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registration in each application on two bases, namely (i) that applicant's mark, as used in connection with applicant's services, is merely descriptive thereof under Section 2(e)(1), and (ii) that the specimens of record fail to show use of the mark in connection with the identified services.³

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.⁴ An oral hearing was not requested. Because of the similarity of the issues involved in these appeals, the Board shall decide them in one opinion.

³ Although, in each application, registration was also refused under Section 2(d), such refusals have been withdrawn.

⁴ In the penultimate paragraph of its briefs, applicant essentially offers, for the first time, alternative positions relative to the two refusals. First, applicant states that if the specimen refusal is affirmed, "applicant would agree in the alternative to convert this application to an intent-to-use application." See: TMEP §806.03(c). Second, applicant states that if the mere descriptiveness refusal is affirmed, applicant "would agree to registration of this mark on the Supplemental Register." See: TMEP §1212.02(c) and TBMP §1215. As the Examining Attorney points out in his brief, however, no formal amendments were ever filed and, thus, we will not consider, at this late juncture, the alternative positions proposed by applicant. Once an application has been considered and decided by the Board on appeal, an application may not be "reopened," that is, an applicant may not amend its application at this stage except in two very limited situations, neither of which pertains herein. TBMP §1218. In any event, applicant here could not amend its application to an intent-to-use basis while, at the same time, seek registration on the Supplemental Register. TMEP §1102.03.

Mere Descriptiveness

The thrust of applicant's arguments is that there are numerous third-party registrations of marks which include the terms "pet," "skin" and "doctor."⁵ Applicant also relies upon its ownership of four Federal trademark registrations and four Illinois state trademark registrations of vanity phone numbers involving the term "injured" (e.g., 1-800-INJURED). Applicant asserts that telephone numbers can be owned by only one entity, and that its present applications are being singled out for unfair treatment.

The Examining Attorney maintains that the marks sought to be registered immediately convey the impression that services relating to veterinarians and dermatologists, respectively, are available by calling the relevant phone number. The Examining Attorney has submitted dictionary listings for "pet," "skin" and "doc," as well as "800."⁶ In

⁵ The Examining Attorney, in his brief, objected to the listing of the "doctor" third-party registrations in applicant's brief. The objection is sustained inasmuch as copies of the registrations were never properly made of record. In re Duofold Inc., 184 USPQ 638 (TTAB 1974). The Examining Attorney went on to address the minimal probative value of this evidence as if it were properly of record, and we share his view that the third-party registrations relied upon by applicant do not compel a different result in this case (see discussion, infra).

⁶ The last listing accompanied the Examining Attorney's brief. Inasmuch as dictionary evidence is proper subject matter for judicial notice, we have considered this listing.

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addition, the Examining Attorney has relied upon excerpts retrieved from the NEXIS database showing uses of "pet doc" to identify a veterinarian and uses of "skin doc" to identify a dermatologist. Also of record are third-party registrations of vanity phone numbers that have issued either on the Principal Register under Section 2(f) or on the Supplemental Register.

It is well settled that a term is considered to be merely descriptive of services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The dictionary evidence shows that "800" is a prefix indicating a toll-free telephone number for long distance

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calls. The other dictionary listings for the words "pet," "skin" and "doc," coupled with the NEXIS evidence showing widespread use of the terms "pet doc" and "skin doc" in connection with veterinarians and dermatologists, respectively, leave no doubt that "pet doc" is merely descriptive for veterinary services and that "skin doc" is merely descriptive for medical services.

It is curious to us that applicant and the Examining Attorney have argued back and forth over the applicability of the case of *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). It is clear that the Federal Circuit's opinion is apposite to the facts herein:

We next examine whether the proposed mark [1-888-M-A-T-R-E-S-S] is "merely descriptive" of the recited services and registrable upon a showing of acquired distinctiveness. A trademark is descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the product. [citation omitted] Dial-A-Mattress argues that its mark is not descriptive because, although it suggests the nature of its services, it does not describe their full scope and extent. This argument is unavailing because the mark need not recite each feature of the relevant goods or services in detail to be descriptive. [citation omitted] Although "1-888-M-A-T-R-E-S-S" is not generic for a service offering mattresses by telephone, it immediately conveys the

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impression that a service relating to mattresses is available by calling the telephone number.

Id. at 1812. See also: In re Page, 51 USPQ2d 1660 (TTAB 1999). Likewise, we find that the mark 1-800-PET DOCS is merely descriptive of veterinary services because it immediately conveys the impression that a service relating to veterinary care is available by calling the telephone number; and that the mark 1-800-SKIN DOC is merely descriptive of medical services because it immediately conveys the impression that a service relating to dermatology care is available by calling the telephone number.

The third-party registrations do not compel a different result herein. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]. We recognize that the competing registration evidence submitted by applicant and the Examining Attorney show the Office's somewhat inconsistent treatment of vanity

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telephone number marks.⁷ However, while uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark sought to be registered here is merely descriptive. As is often stated, each case must be decided on its own merits. See, e.g.: In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

In view of the above, we find that the respective marks are merely descriptive of the identified services under Section 2(e)(1).

Specimens

The Examining Attorney maintains that the original specimens and the substitute specimens show use of the respective marks in connection with licensing services, and not with either veterinary services or medical services.

In its briefs, applicant makes its defense to the refusal in one sentence: "The Applicant submits that the specimens are acceptable to describe the services."

As our primary reviewing court has indicated, "it is not enough for the applicant to be a provider of services; the applicant also must have used the mark to identify the

⁷ In this connection, we also note that two of applicant's previously issued registrations of vanity telephone numbers issued under Section 2(f).

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named services for which registration is sought." In re Advertising & Marketing, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987), citing In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). See also: In re Adair, 45 USPQ2d 1211 (TTAB 1997).

In the past, when appropriate, the Board has been fairly flexible in accepting service mark specimens. See, e.g.: In re Ralph Mantia Inc., 54 USPQ2d 1284 (TTAB 2000); and In re Metriplex Inc., 23 USPQ2d 1315 (TTAB 1992).

In the present case, however, it is clear that although the specimens feature the marks applicant seeks to register, the specimens do not in any way show use of the marks in connection with the services identified in the involved applications, namely veterinary services and medical services.

The specimens show use of the marks only in connection with licensing services. The specimens indicate that applicant "is now offering the exclusive use of [the vanity telephone numbers] in your market area. This unique marketing tool provides unparalleled response and instant name recognition in your market." The specimens tell the reader to call the vanity telephone number "for information on how to take advantage of this incredible licensing tool" and that "licensing is on a first come, first served

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basis." Simply put, the specimens do not show use of the marks in connection with the actual rendering or sale of the identified veterinary and medical services.

Decision: The refusals to register in each of the applications are affirmed.