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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re I.P. International, Inc.

Serial No. 76190599

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I.P. International, Inc.

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Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 5, 2001, I.P. International, Inc.
(applicant) applied to register the mark "1-800-711-CASH"
(typed) on the Principal Register for services ultimately
identified as "financial services, namely, wire fund
transfers" in International Class 36. The application
(Serial No. 76190599) was based on an allegation of a bona
fide intention to use the mark in commerce.

The examining attorney¹ refused registration on the ground that the mark, when used in association with the services, is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because the mark describes a feature of the services. "The proposed mark is descriptive because the alphanumeric portion of the mark does not function as an indicator of source as it will be perceived as nothing more than the toll-free prefix and first three numbers of a phone number and because the literal portion of the mark conveys an immediate idea of a characteristic of the applicant's services." Brief at 3. The examining attorney relied on numerous printouts and websites that showed that the term "cash" was commonly used as a feature of wire fund transfer services.

Western Union wire transfers are an excellent way to get cash to a loved one in a hurry.

www.tesecu.com

The wired funds are deposited to your payees' accounts or to your central account and are available as cash after receipt at the receiving financial institution. Marquette.com

To wire transfer cash.

www.4cite.org

Send Money
Quick ways to wire cash
The Independent Traveler, Inc.

¹ The current examining attorney was not the original examining attorney in this case.

[T]he person promises, he'll wire the cash to that account, and you'll get to keep a hefty cut.
The Plain Dealer, May 29, 2002

Martin and the woman deny the transaction, and Rowe has yet to produce evidence that he wired cash to Martin.
Chattanooga Times/Chattanooga Free Press, May 23, 2002.

Bank Program Helps Wire Cash
Bank of America's Safesend helps people wire money to Mexico.
News & Record (Greensboro, NC), May 6, 2002.

Bierbauer said that Adonay had the cash because he was going to wire it home to Honduras.
Lexington Herald Leader, April 12, 2002.

[H]e was wired cash by the same European operative who sent money to the other terrorists.
Star Tribune (Minneapolis, MN), March 29, 2002.

On the other hand, applicant maintains that "1-800-711-CASH, does not in fact describe any services... CASH means cash, and with a single exception, it refers to the noun cash, which is not a service" Brief at 2 (emphasis in original). Applicant also argues that the mark must be considered as a whole and its mark contains the components "1-800-711-" in addition to the "CASH" element. It concludes by arguing that, when the mark is considered as a whole, it is not merely descriptive of the services.

After the examining attorney made the refusal final, applicant appealed to this board.²

We affirm.

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Applicant is correct in maintaining that we must consider the mark as a whole. However, when we do consider the mark, we do not consider it in a vacuum. In other words, the test is not whether prospective purchasers can guess what applicant's services are after seeing

² In a paper dated October 27, 2003, applicant withdrew its request for an oral hearing.

applicant's mark alone. Abcor Dev., 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"). We must look at the mark in the context of applicant's services to see if the mark informs prospective purchasers of a feature or characteristic of applicant's services.

Viewed in this context, we find that the examining attorney's evidence convinces us that the term "cash" at least describes a significant feature of applicant's wire fund transfer services. The excerpts show that the term "cash" is commonly used to refer to a feature of wire fund transfers. For example, the stories show such uses as "To wire transfer cash"; "Quick ways to wire cash"; and "wire transfers are an excellent way to get cash." It is clear that when prospective purchasers see the term "cash" used in the context of wire fund transfer services, they will immediately recognize that the term describes the fact that wire transfer services can be used to move cash or money from one location to another.

The only other question is whether the addition of the number "1-800-711-" changes the mark from a merely

descriptive term to a suggestive term. More than one hundred years ago, the Supreme Court held that adding the word "company" to a descriptive term did not create a suggestive trademark. "The addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or sell them. Thus parties united to produce or sell wine, or to raise cotton or grain might style themselves 'Wine Company,' 'Cotton Company,' or 'Grain Company'... Names of such articles cannot be adopted as trademarks... nor will the incorporation of a company in the name of an article of commerce, without more specification, create any exclusive right to the use of the name." Goodyear Rubber Mfg. Co. v. Goodyear Rubber Co., 128 U.S. 598, 602-03 (1888).

Similarly, adding a part of a phone number to a descriptive term does not automatically change the term into a suggestive term. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001) ("Although '1-888-M-A-T-R-E-S-S' is not generic for a service offering mattresses by telephone, it immediately conveys the impression that a service relating to mattresses is available by calling the telephone number"). Indeed, the examining attorney has cited a case where the term "cash" used as part of a phone number was nonetheless

determined to be descriptive. Express Mortgage Brokers Inc. v. Simpson Mortgage Inc., 31 USPQ2d 1371, 1373 (E.D. Mich. 1994) ("The court finds that the CASH alpha-numeric [369-CASH] used in the context of a telephone number for mortgage-related services is a descriptive mark").

Similarly here, applicant uses the word CASH in an alphanumeric phone number. In this case, incorporating the area code and exchange of a phone number with a descriptive term would simply describe the fact that services related to transferring cash or money are available by calling the phone number.

Applicant's final argument is that "[s]ignificantly, too, the mark is not 'CASH' all by itself. It is a composite mark of the lucky numbers 7 and 11, together with the word CASH, all taken with the 800 toll free exchange. The composite, 1-800-711-CASH, is far more than the mere reference to CASH, and is, by any standard, not a fair way to describe the underlying services." Brief at 3. In regard to the "lucky number" argument, there is no evidence that prospective purchasers will recognize the numbers as lucky numbers. We further note that applicant's mark is not 7 and 11 but 711. Furthermore, the number 711 is buried in the middle of a phone number. Finally, applicant has not shown the relevance of "lucky" numbers to wire

transfer services as opposed to gambling or casino services. Indeed, even if the middle numbers of the mark were viewed as 7 and 11, and even if prospective customers would view them as "lucky" numbers, it is not clear why that would make the mark not merely descriptive. There is certainly no per se rule that any generic or descriptive term that is part of a phone number from a "711" exchange is no longer merely descriptive.

When we view the record in this case, we are left without any doubts that the term "cash" is merely descriptive of wire fund transfer services. When we view the mark in its entirety, we find there is nothing incongruous about combining that term with numbers to make the alphanumeric telephone number 1-800-711-CASH. The resulting combination of terms is merely descriptive of applicant's services.

Decision: The refusal to register is affirmed.