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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rentalift, Inc.

Serial Nos. 76198801 and 76198802

Stephen Cannavale of Hoffmann & Baron, LLP for Rentalift, Inc.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Rentalift, Inc. has applied to register the marks RENTALIFT, in typed form, (Serial No. 76198801) and RENTALIFT and design, as shown below, (Serial No. 76198802) for "rental of forklifts." Both applications were filed on January 24, 2001, and both assert first use and first use in commerce in January 1983.

Registration has been finally refused with respect to RENTALIFT in typed form pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive of applicant's services; with respect to the application for RENTALIFT and design, the Examining Attorney has made final, pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), a requirement that applicant disclaim exclusive rights to RENTALIFT. Applicant has asserted that RENTALIFT is inherently distinctive, and has also argued, in the alternative, that if the term is not inherently distinctive, it has acquired distinctiveness.[1] The Examining Attorney has found that applicant's showing of acquired distinctiveness is not persuasive.

Applicant filed notices of appeal in both applications. Both applicant and the Examining Attorney

[1] Although applicant did not specifically state that it was seeking registration pursuant to Section 2(f) in the alternative, it is clear from all of its papers that it continues to argue that the mark is inherently distinctive.

have filed briefs, but applicant did not request an oral hearing. Because both appeals involve substantially the same record and the same issue, namely, whether RENTALIFT is merely descriptive of the service of "rental of forklift" or whether that term has acquired distinctiveness, we decide both appeals in a single opinion.

As a preliminary matter, we note that applicant has submitted, with its brief, exhibits that had not previously been made of record. The Examining Attorney has objected to these exhibits as untimely. The Examining Attorney's objection is well taken. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). The Examining Attorney has also objected to applicant's reference to certain third-party registrations in its brief, because such registrations had not been properly made of record. The Examining Attorney is correct that applicant never properly made any third-party registrations of record. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974) (the submission of a list of registrations is insufficient to make them of record). However, applicant did list the registration in its response to the second Office action, and the Examining Attorney, in his final Office action, never advised

applicant as to any deficiency with the submission. Accordingly, we will consider the listing of registrations for whatever probative value it may have. However, because applicant has literally only listed marks, without indicating the registration number, the goods or services, or whether they were registered on the Principal or Supplemental Register or registered under the provisions of Section 2(f), their probative value is virtually nil.

We turn now to the substantive issues in this appeal. Section 2(e)(1) of the Trademark Act, inter alia, prohibits the registration of a mark which, when used on or in connection with the goods of the applicant, is merely descriptive of them. Section 3 makes this provision applicable to marks used in connection with services. Section 6(a) provides that an applicant may be required to disclaim an unregistrable component of a mark.

A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The determination is made not in a vacuum but in relation to the goods on which, or the services in connection with which, it is used. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). See also, In re Abcor Development

Corporation, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, mere misspelling does not add trademark significance to an otherwise unregistrable merely descriptive term. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

Applicant does not dispute that RENTALIFT would be perceived by consumers as the equivalent of "rent a lift." In fact, applicant likens this term to registrations for "Rent-A-Painter," "Rent-A-Laser-Die" and "Rent-A-Server." Applicant's principal argument on the issue of whether RENTALIFT is merely descriptive is that there are over 30 definitions for the word "lift," with "a machine or device designed to pick up, raise, or carry something"[2] being the closest to a fork lift. Applicant also notes that there are three definitions for the word "rent." As a result, applicant contends that with "over 30 definitions that a consumer may associate with the trademark sought to be registered," "such a multitude of definitions … is unlikely to lead to a consumer seeing the mark as merely descriptive." Brief, p. 4.[3] Applicant does not, however, point to any definitions for these words that would convey

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[2] The American Heritage Dictionary of the English Language, 3d ed. ©1992.

[3] Because the records in each application are virtually identical, cites to Office actions and briefs refer to papers in each application.

a meaning other than the rental of the type of equipment known as a lift.

As noted above, the determination of whether a mark is merely descriptive is made in relation to the goods or services with which it is used. Thus, we must consider the impression of RENTALIFT as it is used in connection with the service of "rental of forklifts." When used with such services, consumers would immediately understand the word "lift" in applicant's mark to refer to the equipment, and not to such other definitions as "an elevation of the spirits" or "a rise or an elevation in the level of the ground" or "one of the layers of leather, rubber, or other material making up the heel of a shoe." Although the most apt definition of "lift" for applicant's services does not limit a lift to a "forklift," a forklift, which is defined as "a small industrial vehicle with a power-operated pronged platform that can be raised and lowered for insertion under a load to be lifted and moved,"[4] would certainly fall within the meaning of a "lift."

Accordingly we find that RENTALIFT, when used in connection with the rental of forklifts, directly conveys,

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[4] The Examining Attorney submitted definitions, taken from The American Heritage Dictionary of the English Language, 3d ed. © 1992, for "lift," "forklift" and "rent."

without any need for the exercise of imagination or thought, that applicant offers consumers the opportunity to rent a lift, including a forklift.

The fact that applicant previously owned a registration for the identical mark for identical services does not change this determination.[5] That registration was cancelled in 1994, and no longer has any effect. In re National Retail Hardware Association, 219 USPQ 851, 854 (TTAB 1983). As the Board stated in In re BankAmerica Corp., 229 USPQ 852, 853-854 (TTAB 1986):

> The Act requires the Board to decide an appeal from a final refusal to register. Our responsibility is to make such a decision based on the record before us. We are not bound by the judgment of the Examining Attorney who passed applicant's previous application to publication. In re Calzaturificie Munari, 197 USPQ 564 (TTAB 1977), and In re Dayco Corp., 193 USPQ 379 (TTAB 1976).

See also, TMEP §1216.01 and cases cited therein.

We next consider whether applicant's mark RENTALIFT, or the term RENTALIFT in applicant's RENTALIFT and design mark, has acquired distinctiveness. During the course of prosecution, applicant stated that "the trademark sought be

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[5] Registration No. 1458715, issued September 22, 1987. This registration was cancelled on March 28, 1994 for failure to file a Section 8 affidavit of use.

to registered has been in substantially exclusive and continuous use since 1983 in all manner of advertisements and identification." Response dated January 31, 2003. However, despite the Examining Attorney's advising applicant, in both the Office actions mailed July 31, 2002 and July 28, 2003 that applicant would need to supply an affidavit or declaration attesting to substantially exclusive and continuous use since 1983, applicant chose not to submit such support.

Trademark Rule 2.41 discusses proof of distinctiveness under Section 2(f):

> (a) When registration is sought of a mark which would be unregistrable by reason of §2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with §2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.

> (b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

Applicant did not submit the required affidavit or declaration supporting the statement that it has used its mark since 1983, or has made substantially continuous and exclusive use in commerce for the five years before the claim of distinctiveness was made. Accordingly, we give no consideration to its attorney's statements regarding use.

Further, applicant has not made of record any evidence as to its advertising or other promotion of its mark. As noted previously, the untimely submissions of a telephone directory advertisement and Internet materials submitted with applicant's brief have not been considered.

Applicant also seeks to rely on its cancelled registration for RENTALIFT for rental of forklifts as evidence of acquired distinctiveness. As the quoted

language indicates, ownership of a prior registration on the Principal Register of the same mark may be accepted as prima facie evidence of distinctiveness. However, citing, TMEP §1212.04(d), which in turn cites In re BankAmerica Corp., supra, the Examining Attorney contends that a claim of acquired distinctiveness cannot be based on a registration that is cancelled or expired.

Applicant asserts that the Board in the BankAmerica decision "did not consider nor hold that a claim of acquired distinctiveness cannot be based on a registration that is cancelled or expired." Brief, p. 7. Applicant points to the following language of the Board, found at page 853 of that decision:

> If the issue were whether the term sought to be registered had become distinctive within the meaning of Section 2(f), a subsisting registration might be accepted as prima facie evidence of distinctiveness, but here we are presented with neither a subsisting registration nor the issue of registrability under Section 2(f).

The BankAmerica case bears many similarities to the present situation, in that registration was refused on the ground that the mark was merely descriptive, and the applicant in that case also claimed ownership of a registration for the same mark for the same services which registration was cancelled under Section 8 of the Act.

However, in that case the applicant did not claim in the alternative that its mark had acquired distinctiveness. Although the Board noted that both applicant and the Examining Attorney had made arguments as to whether the mark had acquired distinctiveness, the Board stated that, because the applicant had specifically declined to formally enter such a claim, the issue of whether the mark had acquired distinctiveness was not before it. In this sense, the Board's statement regarding the need for a subsisting registration as a basis for a Section 2(f) claim was dicta. However, there is no ambiguity in the Board's view that, in order to base a Section 2(f) claim on a prior registration, that registration had to be subsisting. That principle has been repeated in other Board decisions. See In re Dial A Mattress Operating Corp., 52 USPQ2d 1910, n. 16 (TTAB 1999), rev'd on other grounds, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). Although a subsisting registration may be evidence that distinctiveness shown by that registration has transferred to the mark for the goods and services in an application, a cancelled or expired registration is not evidence of any distinctiveness whatsoever. That basis for that principle is especially evident in the present situation, where applicant's prior registration was cancelled more than ten years ago. We

cannot assume that any distinctiveness that might have existed with respect to applicant's mark ten years ago has transferred to applicant's mark today.

Accordingly, we find that applicant has failed to demonstrate that RENTALIFT has acquired distinctiveness.

Decision: The refusal to register the application for RENTALIFT in typed form, Serial No. 76198801, on the ground that applicant's mark is merely descriptive is affirmed. We further find that applicant has failed to show that its mark has acquired distinctiveness, and therefore it is not entitled to registration under the provisions of Section 2(f) of the Trademark Act. Similarly, because the term RENTALIFT is merely descriptive and has not been shown to have acquired distinctiveness, the requirement for a disclaimer of RENTALIFT in Application Serial No. 76198802 is also affirmed. However, if applicant submits the required disclaimer within thirty days, Application Serial No. 76198802 will be forwarded for publication.