

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
May 12, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JSB Enterprises, Inc.

Serial No. 78578985

Thomas E. Anderson of Gifford, Krass, Groh, Sprinkle,
Anderson & Citowski, P.C. for JSB Enterprises, Inc.

Stephanie M. Ali, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Walters, Walsh and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

JSB Enterprises, Inc. filed a use based application to register the term NO MORE ACTIVATION FEES, in standard character format, for services ultimately identified as "retail store services, online store services and wholesale distributorship services featuring telephone communications equipment," in Class 35. Applicant submitted the newspaper advertisement, shown below, as its specimen of use.

According to a newspaper story in the March 25, 2005 issue of the *Detroit Free Press*, applicant, "a cell-phone superstore chain," will pay the activation fee for customers who sign up for phone service at one of applicant's stores. The newspaper story reported that applicant "has trademarked the 'no more activation fees' phrase and patented the program." ¹

The Examining Attorney refused registration on the ground that the term sought to be registered does not function as a service mark. Sections 1, 2, 3, and 45 of the Trademark Act of 1946, 15 U.S.C. §§1051, 1052, 1053, and 1127. The Examining Attorney argued that, as used by applicant, NO MORE ACTIVATION FEES is merely an advertising or informational slogan describing a feature of applicant's services. To support her contention that NO MORE ACTIVATION FEES is merely an advertising or informational slogan, the Examining Attorney submitted copies of advertisements featuring variants of the term NO MORE ACTIVATION FEES used by others to demonstrate that the purported mark is a common advertising phrase:²

¹ March 8, 2007 Office Action.

² We did not consider the excerpt from the Sears website at www.searsconnect.ca because it is a Canadian website, and we have no basis to conclude that consumers in the United States would encounter this web site.

1. An excerpt from the 1-800-RECONEX website (www.reconex.com), a telephone service provider, displaying the following claim for each state:
PAY NO ACTIVATION FEES;
2. An excerpt from the Telestial Wireless Solutions for Travelers website (www.telestial.com), a phone service provider, promoting the following features for its calling card services:
No activation fees
No monthly fees
No first minute connection charges
3. An excerpt from the ATech Group website (www.atech.com) providing rate information for its ISP dial up services, including
\$20.00 per month (no activation fees)
\$108.00 biannual prepaid (no activation fees)
\$204.00 annual prepaid (no activation fees)
4. Excerpts from the Vonage VoIP Forum (www.vonage-forum.com) regarding "No Activation fee on Retail bought adapters?";
5. An excerpt from a posting from the Craigslist website (<http://honorolulu.craigslist.org>) regarding a private transfer of a Sprint PCS

contract entitled "Free Bluetooth Phone, Free Incoming Minutes, NO Activation Fees";

6. An excerpt from the Global Satellite website (www.globalsatellite.us) promoting its prepaid Africa accounts without activation fees: NO MORE ACTIVATION FEES FOR THE PREPAID AFRICA ACCOUNTS"; and,
7. An advertisement for Verizon Wireless one year plans with no activation fees posted on the DIGG website (<http://digg.com>).

Applicant argued that, "[t]he specimen of record adequately demonstrated that the mark is an easily recognized source identifier. The mark is substantially larger than the surrounding text and is further highlighted by the use of a contrasting background color."³ Applicant also asserted that the Examining Attorney's evidence does not show that competitors need to use the term NO MORE ACTIVATION FEES.⁴ Finally, applicant listed four third-party registrations for the marks with the preface NO MORE, and argued that, "[e]ach of the above registrations plainly referred to a commercial promise and/or sales inducement for services, yet all were registered on the principal

³ Applicant's Brief, p. 4.

⁴ Applicant's Brief, p. 6.

Serial No. 78578985

register. Applicant's mark is no different, and it too merits registration on the principal register."⁵

The issue before us is whether the term NO MORE ACTIVATION FEES is used as a service mark. A service mark is any word, name, symbol, design, or device, or any combination thereof, used to identify and to distinguish the services of one person from the services of others. Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127. If NO MORE ACTIVATION FEES is used as a service mark, it may be registered. If it is not used as a service mark, then it cannot be registered.

We start with the proposition that not every word or combination of words used in the sale or advertising of services is registrable. *In re Wakefern Food Corp.*, 222 USPQ 76, 77 (TTAB 1984); *In re Dun-Donnelly Publishing Corp.*, 205 USPQ 575, 578 (TTAB 1979), *recon. denied*, 208

⁵ Applicant's Brief, p. 7. Applicant identified the following third-party registrations: Registration No. 2888761 for the mark NO MORE MOSQUITOS. PERIOD; Registration No. 2647813 for the mark NO MORE COLD CALLING; Registration No. 2367614 for the mark NO MORE THAN 3 STOPS; and Registration No. 2786188 for the mark NO MORE PAPER PUSHING. Applicant did not submit copies of the registrations. A list of registrations is insufficient to make them of record. If the applicant wants the Board to consider registrations, copies of the registrations must be submitted. *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). However, the Examining Attorney did not object to applicant's list of registrations, and, in fact, she referred to them in her brief. Accordingly, we will consider the registrations for whatever probative value they may have.

Serial No. 78578985

USPQ 946 (TTAB 1980). The fact that words are prominently displayed does not in and of itself make them registrable. To be registrable on the Principal Register, a slogan must be a service mark. *In re Wakefern Food Corp.*, 205 USPQ at 77; *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980); *In re European-American Bank & Trust Co.*, 201 USPQ 788, 789 (TTAB 1979). If the slogan is used as a mark, the registration is mandatory unless it is prohibited by one of the provisions of Section 2 of the Trademark Act of 1946, 15 U.S.C. §1052. *In re Wakefern Food Corp.*, 205 USPQ at 77.

To ascertain the manner or use and the commercial impression engendered by the term sought to be registered, we must look at the specimen of record. *In re Wakefern Food Corp.*, 205 USPQ at 77; *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976); *In re Restonic Corp.*, 189 USPQ 248, 249 (TTAB 1975). The term sought to be registered must indicate the origin of the services and be of such a nature that ordinary consumers would consider the term to be a trademark. *In re Brock Residence Inns, Inc.*, 222 USPQ 920, 921-922 (TTAB 1984).

The term NO MORE ACTIVATION FEES is a readily understood term that has been used by applicant to convey

Serial No. 78578985

the fact that if you purchased a cell phone and signed-up for telephone service at applicant's retail store, there will not be an activation fee in connection with the telephone service. The Examining Attorney has submitted sufficient evidence to show that other cell phone service providers use a variation of the term "no activation fees" to convey the same message. Accordingly, consumers viewing the term NO ACTIVATION FEES as used by applicant will interpret the phrase in its ordinary meaning. It is intended to attract consumers to a valuable feature of applicant's services - - the waiving of activation fees. There is no basis for believing that consumers will view the term NO MORE ACTIVATION FEES as a service mark identifying the source of the services (*i.e.*, consumers will not interpret the term as NO MORE ACTIVATION FEES brand retail store services).

This case is distinguishable from *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985) relied on by applicant. In *Post*, the Board found that the term QUALITY SHOWS was not an ordinary informational statement because it was set off from the surrounding advertising copy in a distinctive and extremely large typeface, and its source indicating quality was reinforced by its repetition throughout the advertisement. Moreover, there was no

Serial No. 78578985

evidence that any other competitor used a similar term in connection with their services. In this case, the use of the term NO MORE ACTIVATION FEES by applicant conveys a very specific and easily understood message, whereas "Quality Shows" does not. Moreover, the term NO ACTIVATION FEES is simply informational, and not distinctive. It is simply one of many messages on a very busy advertisement, and as indicated above, variations of that term have been used by others to convey the same message.

Accordingly, we are in full agreement with the Examining Attorney that the term NO MORE ACTIVATION FEES, as used by applicant, does not function as a service mark.

Decision: The refusal to register the term NO MORE ACTIVATION FEES is affirmed.