

Phantom Marks, the Twilight Zone of Intellectual Property

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The situation of these marks is not as spooky as actual ghouls haunting at cemeteries or abandoned houses, but they still cause many trademark offices to run off and refuse their submission. These trademarks contain “phantom” or changeable elements in their denominations usually represented by inserting a blank (in figurative marks), or by using dots, dashes, underlining, or a designation such as “XXXX” (in denominative marks).

An overly known example of these, is the American trademark “----- For Dummies”, used in an extensive and varied set of self-help books, where the dashed lines represent different descriptive terms which vary according to the subject matter of the books e.g., Accounting For Dummies, French for Dummies, Online Dating For Dummies, and including Patents, Copyrights & Trademarks For Dummies.



Other examples include marks incorporating a date (usually a year), a geographic location, or a model number that is subject to change. While these are some of the most common examples of the types of elements involved, there are many variations.

Its use was originally recognized in the U.S.; however, since the mid-'90s, the United States Patent & Trademark Office (PTO) became more strict when evaluating these applications, unwilling to grant them at all and following the indications in their trademark manual of examining procedure (TMO) which says in the article No. 1214 “Where an applicant seeks registration of a mark with a changeable or “phantom” element, the examining attorney must refuse registration under sections 1 and 45 of the Trademark Act, [...], on the ground that the application seeks registration of more than one mark.”

Since then, the American PTO has denied many applications that included a “phantom” element based on the certainty that they contravened the golden rule of “one mark per application” as well as the main objective of a trademark registration which is to ensure the publicity of each mark in order to protect its unauthorized-use from third parties and to be easily found in case a third party searched for trademarks that are similar to the sign they intend to register. Many authors have agreed upon the fact that this type of trademark contradicts its reason for being and fails to “give adequate constructive notice to third-parties as to the nature of the mark and a thorough and effective search for conflicting marks is not possible”, as stated in their TMO.

A clear example of this inconvenience is the case of a New York corporation “International Flavors & Fragrances Inc.” (IFF) who requested to register with the PTO, “LIVING XXXX FLAVORS” and “LIVING XXXX FLAVOR” as trademarks for the following goods: essential oils for use in the manufacture of flavored foodstuffs, smoking tobacco compositions, smoking tobacco articles, chewing tobacco compositions, chewing gums, oral care products and beverages in International Class 3; and non-synthetic and synthetic flavor substances for use in the manufacture of flavored foodstuffs, smoking tobacco compositions, chewing tobacco compositions, smoking tobacco articles, chewing gums, oral care products, and beverages, in International Class 30. Along with “LIVING XXXX” for use in connection with non-synthetic and synthetic flavor substances for use in the manufacture of colognes, cosmetics, hair preparations, toiletries, detergents, fabric softeners, odorants, deodorants, bleaches, brighteners and air fresheners, in Class 1; and essential oils for use in the manufacture of colognes, cosmetics, toiletries, hair preparations, detergents, fabric softeners, odorants, deodorants, bleaches, brighteners and air fresheners in Class 3.

In the first two applications, the “XXXX” served to denote “a specific herb, fruit, plant or vegetable” and in the last, to indicate “a botanical or extract thereof, to wit: ‘flower’, ‘fruit’, ‘yellow sunset orchid’, ‘osmanthus’, ‘fragrance’, ‘raspberry’ and the like.”

As one can surely guess, the applications were denied under the review that the requested signs encompassed too many combinations and permutations to make a thorough and effective search possible. Thus, cannot provide proper notice to other trademark users, failing to help bring order to the marketplace and defeating one of the vital purposes of a trademark. Also, the trademark examining attorneys confessed that the core of the problem was that they could not allow registration of an unlimited and unknown number of elements in one mark.

Despite the disadvantages and valid arguments against its use, I believe in its utility and convenience for future applicants. Registering a phantom trademark would help applicants reduce their usual expenses when investing in various trademark registrations that vary in just one or two words since it would all be done in one application. These signs, though different, would have to be essentially the same since the purpose of this kind of trademark is to protect a single mark that may change over time (regarding years, months or volumes) or depend on certain circumstances (regarding location, subject matter, stage/level).

Although it is true that phantom marks are usually and constantly denied, in 2001 the Court of Appeals PTO emitted the disposition of the Trademark Trial and Appeal Board - TTAB where it claimed that in the case of the trademark application for “(212) M-A-T-R-E-S-S” as a phantom trademark, where the “212” appeared in dotted lines, was the legal equivalent to the registered trademark “1-888-M-A-T-T-R-E-S-S”, and therefore, proceeded to its registry. Their decision was final on the grounds that:

“[...] 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. [...] The area code is 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.”

In the same way, in a phantom mark in which the changeable elements are arbitrary or fanciful, it is correspondingly likely that the various permutations of the mark will result in different commercial impressions and therefore constitute different marks. By contrast, where the changeable elements are generic or merely descriptive, it is conceivable that the permutations of the mark may constitute a single mark. This seemed to be the case with the Dial-A-Mattress example in which the numbers 212 and 888 were merely generic area codes, thus not creating different commercial impressions.

In conclusion, it is safe to say that according to the previously mentioned case, it is clear that not all phantom marks are prohibited, per se, from registration. However, phantom marks will be denied if the Examining Attorneys should determine that they encompass too many permutations to make a thorough and effective search, making it impossible to meet with the requirement of providing proper notice to other trademark users; and moreover, if the difference is such that it generates the impression of a whole other trademark. One would only have to argue that the changeable element in the phantom mark is generic, and therefore would not create a different commercial impression on the mark. This type of mark is not regulated in our country but in my opinion, if we focused more on its utility, we could help incorporate it in our legislation, being necessary of course, to regulate detailed aspects to assure it does not interfere with our current norms.

A clear example of how we can take advantage of a phantom mark’s purpose is the registration of the famously known titles of EGACAL that begin with “El ABC del Derecho ...” and continue with different fields of law on the dotted lines. If phantom marks were permitted in Peru, this company would have been able to secure the ownership of those marks with just one application alleging that their changeable element would be limited by the different fields of the law, making those modifications predictable and limited; and therefore, would have no prohibition against its registration.

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