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1-800-I-AM-VAIN: SHOULD TELEPHONE MNEMONICS BE PROTECTED AS TRADEMARKS?

I. INTRODUCTION

Mnemonics for telephone numbers,¹ such as “1-800-FLOWERS,” are now protected as trademarks by many courts. This protection resembles that of traditional alphanumeric protection, which has an established history. Alphanumeric symbols, such as “A.1” and “V-8,” which include both letters and numerals in a nonsense term, are protected as trademarks if they serve to indicate the origin of the product.² As a general rule, a symbol of this type is not treated any differently than other marks; however, the nature of the mark itself creates some specific problems that must be confronted before trademark protection should be allowed. For example, if the symbol is an acronym or abbreviation for a generic term, it may not be protected.³ Also, if the mark either indicates the quality or grade of the product, or acts as a model number, protection as a trademark is denied unless it has achieved secondary meaning as to the origin of the product.⁴

Mnemonics are faced with similar problems impeding their protection as trademarks. Unlike regular alphanumericics, telephone mnemonics generally are not “nonsense” terms, but rather they create words that are easily remembered. Telephone technology affects the ability of a business to obtain a mnemonic in that a number can contain only a finite number of digits and must have a specified arrangement of letters. The courts, however, do not confront these issues separately. Instead, they assume that a mnemonic can be trademarked and then analyze the particular case under the traditional trademark principles. Because of the unique problems created by telecommunications technology and because of

¹ In this Note, the term “mnemonic” refers to marks used in association with telephone numbers. The term “alphanumeric,” when used alone, refers to marks containing both letters and numbers which do not spell a recognizable word.
² See infra notes 20-36 and accompanying text.
³ See infra notes 22-36 and accompanying text.
⁴ See infra notes 37-61 and accompanying text.

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the parallels between these mnemonics and alphanumerics, especially serial numbers, telephone mnemonics should be held to a higher standard of scrutiny before they are accorded protection. The descriptiveness of the mark should be presumed in order to increase the burden on the party trying to prove secondary meaning.

This paper will first examine the history of nonsense alphanumeric trademarks. Then, a review of the use of telephone mnemonics will shed light on the inherent limitations of these marks. Furthermore, tracing the development of trademark protection of telephone mnemonics will illuminate the approaches of the courts. Finally, the problems that telephone mnemonics present in the context of trademarks will be examined to show why these marks should be held to a higher standard of scrutiny.

II. UNDERSTANDING THE PAST: ALPHANUMERICS AS TRADEMARKS GENERALLY

Alphanumeric mnemonic marks can be protected by the Lanham Act. In order for either a registered or unregistered mark to be protected, the infringing mark must be "likely to cause confusion" as to the source of the mark. 

7 15 U.S.C. § 1125(a)(1)(A) (1994). The courts of appeals have developed various sets of factors to be used to determine whether there is a likelihood of confusion. The lists differ, but most contain the same basic elements. For example, the Ninth Circuit's factors are "(1) strength of the mark; (2) similarity of the marks; (3) marketing channels and proximity of the goods or services; (4) good faith and intent; and (5) evidence of actual confusion." Societe de Developments et D'Innovations des Marches Agricoles et Alimentaires-Sodima-Union de Cooperatives Agricoles v. International Yogurt Co., 662 F. Supp. 839, 845-846, 3 U.S.P.Q.2d (BNA) 1641, 1645 (D. Or. 1987) [hereinafter Sodima]. The Sixth Circuit, on the other hand, uses the following list: "(1) the strength of plaintiff's mark; (2) relatedness of the goods; (3) similarity of the mark; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines." Holiday Inns, Inc. v. 800 Reservation, Inc., 838 F. Supp. 1247, 1254 (E.D. Tenn. 1993). The Third Circuit has a more detailed list of factors: "(1) the degree of similarity between the owner's mark and the alleged infringing mark; (2) the strength of owner's mark; (3) the price of the goods [or services] and other factors indicative of the care and attention expected of consumers when making a purchase; (4) the length of time defendant has used the mark without evidence of actual confusion arising; (5)
The cases interpreting the Lanham Act identify four categories of marks based on the level of "inherent distinctiveness" in the mark. The amount of protection available to a mark depends on how it is categorized. The categories are, in descending order of protection, arbitrary, suggestive, descriptive, and generic.

Arbitrary marks bear no logical or suggestive relation to the actual characteristics of the goods and are protected without a showing of secondary meaning. Suggestive marks imply the characteristics of the goods and are protected because many available alternatives exist which can apply to a product, making the appropriation of one word an insignificant burden on competi-

the intent of the defendant in adopting the mark; (6) the evidence of actual confusion; (7) whether the goods [or services], though not competing, are marketed through the same channels of trade and advertised through the same media; (8) the extent to which the targets of the parties' sale efforts are the same; (9) the relationship of the goods [or services] in the minds of the public because of the similarity of function." Dranoff-Perlstein Assocs. v. Sklar, 967 F.2d 852, 862-63, 23 U.S.P.Q.2d (BNA) 1174, 1183 (3d Cir. 1992) (hereinafter Dranoff-Perlstein) (quoting Ford Motor Co. v. Summit Motor Prods., Inc., 930 F.2d 277, 293 (3d Cir. 1991)).

In order for there to be infringement, all of the circuits require that the goods be somehow similar. This requirement need not be odious, however, and confusion as to sponsorship is actionable. See Standard Brands, Inc. v. Smidler, 151 F.2d 34, 37 (2d Cir. 1945) (noting that vitamin tablets called "V-8" could infringe mark of vegetable juice cocktail called "V-8" because it is reasonable that maker of food would also make vitamins).

See also Holiday Inns, Inc., 838 F. Supp. at 1253 ("While unfair competition is a broad field within which lies the concept of trademark infringement, the standard for relief is substantially identical—likelihood of confusion.") (quoting Wynn Oil Co. v. Thomas, 669 F. Supp. 831, 834 (M.D. Tenn. 1986), rev'd in part and aff'd in part, 839 F.2d 1183 (6th Cir. 1988)).

Dranoff-Perlstein, supra note 7, at 855; see Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 769 (2d Cir. 1976) (correlating categories with eligibility for trademark status).

Dranoff-Perlstein, supra note 7, at 855.


Dranoff-Perlstein, supra note 7, at 857. Note that the function of a trademark is to make the good or service unique and recognizable as compared to other goods or services in the same genus. See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 2.01[2], at 2-3 (3d. ed. 1993) (hereinafter McCarthy) ("From an economic point of view, a trademark is merely a symbol that allows a purchaser to identify goods or services that have been satisfactory in the past and reject goods or services that have failed to give satisfaction.").
tion. Suggestive marks differ from descriptive marks in that the former require imagination, thought, or perception to obtain information about the nature of the goods. The latter receive protection only on a showing of secondary meaning, i.e., when there is mental association between the alleged mark and the single source of the product by a substantial segment of the consumers. Generic marks, on the other hand, which indicate the class of the goods, can never receive protection as trademarks, even if the mark has acquired secondary meaning.

The number of available alternatives to the chosen symbol indicates whether a term is suggestive, descriptive, or generic. If a symbol has many available alternatives, competitors are not overly disadvantaged from the inability to appropriate that mark for themselves. If, however, a mark has few available alternatives,
the term seems to describe the genus of the product rather than its qualities. The number of available alternatives inversely relates to the likelihood that the term is generic.¹⁹

Numerals and letters can be trademarks within certain limitations. Not only must the mark perform the function of a trademark by indicating origin, but that must be its sole or primary function.²⁰ These marks tend to be descriptive, either as acronyms or abbreviations of generic or descriptive terms, or as serial or model designators which are descriptive inherently. However, if an alphanumeric functions to indicate origin, the policies behind protecting all marks apply with equal force.²¹

A. ACRONYMS AND ABBREVIATIONS

One of the unique problems with protecting alphanumerics is that many of the marks are abbreviations or acronyms for other terms. For example, in *Wise v. Bristol-Myers Co.*,²² the owner of the registered mark “BUpH 3.5” for antacid tablets objected to the use of “Bufferin” for an antacid analgesic.²³ The court found the second mark to be valid because the plaintiff disclaimed any rights

¹⁹ See *Qualitex Co. v. Jacobson Products Co.*, 115 S. Ct. 1300, 1304 (1995) (finding depletion of alternatives argument unpersuasive in determination of whether to allow color alone to be trademark because if there was color scarcity, “functionality doctrine” would most likely prevent color from being trademarked). In the context of telephone mnemonics, the restricted number of alternatives is related to the “functioning” of the trademark, not the product. In the *Qualitex* case, the court’s decision was based on the functionality relating to the product, i.e. the black outboard motors cannot be trademarked because the color was necessary to the proper use of the motor itself. Telephone mnemonics are trademarks that are physically separated from the product, like the name. The functionality doctrine as formulated does not apply to telephone numbers.

²⁰ Nature’s Bounty, Inc. v. Basic Organics, 432 F. Supp. 546, 551, 196 U.S.P.Q. (BNA) 622 (E.D.N.Y. 1977) (protecting numerals and letters that are arbitrary or fanciful and have no connection with product or its features or if mark is designed solely to indicate origin) (citing 3 Callman, Unfair Competition, Trade-Marks and Monopolies § 73.1 (3d ed. 1969)).

²¹ See *Qualitex*, 115 S.Ct. at 1304 (“It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes.”); see generally *McCarthy*, supra note 11, § 2.01, (“The interest of the public in not being deceived has been called the basic policy. Moreover the plaintiff’s interest in not having the fruit of his labor misappropriated should not be disregarded.”).


²³ Id. at 801.
in the generic term "pH 3.5" apart from the rest of the mark.\textsuperscript{24} The argument of the defendant was that the mark of the plaintiff was a contraction for the admittedly descriptive term "buffer" and therefore could not be protected.\textsuperscript{25} Although the court rejected this argument, thereby protecting "BUpH 3.5", the court also rejected the argument of the plaintiff that the use of the term "buffer" in the mark of the defendant infringed the plaintiff's mark:

One can not [sic] acquire a trade-mark right in a descriptive word because the allowance of such right would preclude others from exercising their right to use the proper word to describe a similar characteristic of their products. Plaintiff accordingly could not acquire an exclusive trade-mark right to use the word "buffer." He can not [sic] achieve the same result by indirection, through the simple expedient of adopting only a meaningless part of the descriptive word, without which part the proper descriptive word could not be used.\textsuperscript{26}

The use of abbreviations for words can limit the effectiveness of the mark. However, not all abbreviations are subject to such drawbacks.\textsuperscript{27} The mark "V-8" for vegetable juice cocktail was found to be arbitrary and fanciful despite the fact that the "V" in the mark stood for "vegetable" and the "8" in the mark stood for the number of different vegetable juices.\textsuperscript{28} Abbreviations of established trademarks, however, will not be protected. In \textit{Chanel, Inc. v. Suttner},\textsuperscript{29} the mark "C No 5" was an infringement of "Chanel

\textsuperscript{24} Id. at 802.
\textsuperscript{25} Id.
\textsuperscript{26} Id.
\textsuperscript{27} See \textit{Television Enter. Network, Inc. v. Entertainment Network, Inc.}, 630 F. Supp. 244, 247, 229 U.S.P.Q. (BNA) 47 (D.N.J. 1986) (protecting mark "TEN" as abbreviation because it is distinctive as to television programming industry and requires explanation before it conveys any meaning).
\textsuperscript{28} \textit{Standard Brands, Inc. v. Smidler}, 151 F.2d 34, 36 (2d Cir. 1945); \textit{see also Nature's Bounty, Inc. v. SuperX Drugs Corp.}, 490 F. Supp. 50, 54, 207 U.S.P.Q. (BNA) 263 (E.D.N.Y. 1980) (protecting mark "KLB 6" for food supplement containing kelp, lecithin, and vitamin B6 on grounds that mark was suggestive as to ingredients, not descriptive).
\textsuperscript{29} 109 U.S.P.Q. (BNA) 493 (S.D.N.Y. 1956).
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No. 5".30 The court noted that the designation "C No 5" was a "readily understood abbreviation" and a "colorable imitation" such that there was a likelihood of confusion by the customers as to the source of the merchandise.31

Another problem particularly relevant to alphanumeric numbers as well as telephone mnemonics, is the "slight variation" problem. When a slightly different mark is involved, the courts have no difficulty finding infringement if the original mark was strong.32 The most plausible explanation seems to be that the change in only one facet of the mark is not enough to prevent confusion when the marks in their entirety are compared. The problem is more acute in the area of alphanumericics as a result of the ease with which a mark can be substantially altered with only slight changes of one character.33 For example, in Nabisco Brands, Inc. v. Kaye,34 the court found that the mark "A.2" infringed the mark "A.1" for steak sauce because of the risk that consumers would believe that "A.2" sauce was a product line extension.35 Even if there is not confusion between the two goods at issue, there is confusion as to sponsorship, which is actionable as trademark infringement.36

B. THE SERIAL NUMBER PROBLEM

The "A.1" steak sauce example indicates the complexity of trademark issues surrounding a series of symbols. This section deals specifically with the problem of the protection of marks in a pre-existing series rather than customer confusion as to the

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30 Id. at 495. See also Chanel, Inc. v. Jules V. Riviere Perfumes, Inc., 8 F. Supp. 473 (S.D.N.Y. 1934) (holding that use of mark "No. 5" was infringement of plaintiff's mark "No. 5").


33 See In re Standard Kollsman Indus., Inc., 156 U.S.P.Q. (BNA) 346, 347 (T.T.A.B. 1967) (refusing registration for acronym "SKI" because it too closely resembled previously registered marks "SK-97", "SK-128", "SK-98", and "SK-58"). In the telephone mnemonic context, not only is the nature of the mark as an advertising tool changed by a one-letter alteration, the function of the mnemonic in corresponding to the telephone number is radically altered.


35 Id. at 26-27.

36 See supra note 7 and accompanying text.
creation of a series. Some quality marks which are not part of a defined series, yet still serve to distinguish between two products of one manufacturer, are discussed as well.

Model or serial numbers are not given the same level of protection as routine alphanumeric marks. The descriptive nature of the marks forms the basis of the complaint:

[T]he principal objection raised to a model or grade designation asserted as a trademark is analogous to the objection raised to a merely descriptive term asserted as a trademark: both serve primarily to describe the classification or quality of the product, rather than to distinguish the goods of one party from like goods of others. 37

37 In re Petersen Mfg. Co., 229 U.S.P.Q. (BNA) 466, 468 (T.T.A.B. 1986) (registering model numbers after finding secondary meaning); see also Humphreys Homeopathic Medicine Co. v. Hilton, 60 F. 756, 758 (C.C.S.D.N.Y. 1894) (refusing to protect series of numbers assigned to various medicines after finding that they were descriptive because they were used in series). The distinction between the use of the marks to distinguish the goods of another manufacturer and the goods of the same manufacturer is a common one drawn by the courts when explaining why the model numbers are not protected. In re Dana Corp., 12 U.S.P.Q.2d (BNA) 1748, 1750-1 (T.T.A.B. 1989) (refusing to register series of alphanumeric marks for universal joint couplings).

The seminal cases in the area of purely numeric serial marks are Gillott v. Esterbrook, 48 N.Y. 374 (1872) (holding that numeral "303" could function as trademark for writing pen), Lawrence Mfg. Co. v. Lowell Hosiery Mills, 129 Mass. 325 (1880) (holding that numeral "523" could function as trademark for hosiery), and Boardman v. Meriden Britannia Co., 35 Conn. 402 (1868) (holding that numeral "2340" could function as trademark for spoons). These cases involved purely numerical as opposed to mixed marks, but they established that a mark which was a nonsense term could function as a trademark if it served to indicate origin. In all three cases a finding was made that the mark in question did actually function to indicate origin, Gillott, 48 N.Y. at 377; Lawrence Mfg., 129 Mass. at 325; Boardman, 35 Conn. at 416, although by today's standards these cases may have come out differently. For example, in Gillott v. Esterbrook, other trademarks of the plaintiff always accompanied the mark at issue. Gillott, 48 N.Y. at 378. (Also, in Boardman, the numeral had been used in conjunction with the manufacturer's name, but the court in that case found that such use was not a detriment to a finding that the mark was valid. Boardman, 35 Conn. at 416. See infra note 83 and accompanying text.) However, because the court found that the mark served to indicate origin, the mark was protected.
The nature of alphanumerics gives rise to situations in which numbers, actually being used as grade or quality marks, are being used as trademarks as well. Those marks being used solely to designate the size or capacity of the product cannot become trademarks because they are descriptive. It should be noted that the early cases did not address the issue of secondary meaning as applied to these types of marks—a finding of which allows protection of descriptive terms under current law. However, the court found that the marks did function to indicate origin—the equivalent of a modern finding of secondary meaning.

Some courts label alphanumerical marks not only as descriptive, but also as “weak”, requiring a strong showing of secondary meaning to receive trademark protection. Despite finding these marks weak and merely descriptive, the courts stop short of

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39 See In re Union Oil Co. of Cal., 88 F.2d 492, 494 (C.C. Pa. 1937) (recommending caution in holding letters or numerals to be trademarks because of risk of their use to indicate grade or quality), cert. denied sub nom. Star Stationary Co. v. Rogers, 302 U.S. 691 (1937). But see Scriven v. North, 134 F. 366, 370 (4th Cir. 1904) (holding that alphanumerical “No. 50” was arbitrary for undergarments because it did not indicate size).

40 Fram Corp. v. Boyd, 230 F.2d 931, 934, 109 U.S.P.Q. (BNA) 4 (5th Cir. 1956) (holding that marks “C-4”, “C-21”, “C-100”, “C-130”, and “C-134” could not be infringed by use of marks “B-4”, “B-21”, etc.); In re Armco Steel Corp., 127 U.S.P.Q. (BNA) 135, 137 (T.T.A.B.) (finding that “17-4PH” and “17-7PH” could not be registered as marks for stainless steel because marks were indicators of grade of steel), rev’d sub nom. Armco Steel Corp. v. Watson 188 F. Supp. 554 (D.D.C. 1960). Note that the Fram case indicates a departure from the rule that slight variations will give rise to infringement when the marks at issue are being used to indicate size. See infra notes 51-57 and accompanying text.

41 Ideal Indus., Inc. v. Gardner Bender, Inc., 612 F.2d 1018, 1022, 204 U.S.P.Q. (BNA) 177 (7th Cir. 1979) (“Apparently these courts did not have before them the question whether the numbers indicating style or grade had achieved a secondary meaning as symbols of the source of the goods.”), cert. denied 447 U.S. 924 (1980). See supra notes 13-15 and accompanying text.

42 See supra note 37 and accompanying text.

labeling them generic, which would preclude all trademark protection. A mark also need not be descriptive in the traditional sense to be found to be a “descriptive” serial number. In J.M. Huber Corp. v. Lowery Wellheads, Inc., the marks at issue clearly did not describe any physical characteristic of the product. The court still analyzed the marks as descriptive ones:

Although Huber’s alphanumeric symbols do not describe the physical characteristics of its various wellheads, it is clear that the symbols distinguish one Huber wellhead from another. Thus, the symbols are “descriptive” and are only entitled to trademark protection upon a showing that they have acquired a secondary meaning.

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44 See id. at 1902 (finding that symbols were not generic because they were not capable of identifying product to buyer without interchangeability chart). Contra Eastman Kodak Co. v. Bell & Howell Document Management Prods. Co., 23 U.S.P.Q.2d (BNA) 1878, 1880 (T.T.A.B. 1992) (“We believe that it is possible for a numerical designation, which functions only in part to designate a model or grade, to be inherently distinctive and registrable without a showing of secondary meaning.”), aff’d 994 F.2d 1569, 1574 26 U.S.P.Q.2d (BNA) 1912, 1916 (Fed. Cir. 1993) (holding that in intent to use application, mark cannot be presumptively descriptive unless applicant originally claims use of mark as only model designator).

45 Ideal Industries, Inc. v. Gardner Bender, Inc., 612 F.2d 1018, 1023 (7th Cir. 1979) (using series of consecutive numbers to designate increasing sizes was not arbitrary, but descriptive of size of connectors in relation to other connectors in series), cert. denied, 447 U.S. 924 (1980).

46 See supra note 37 and accompanying text.

47 778 F.2d 1467, 228 U.S.P.Q. (BNA) 206 (10th Cir. 1985).

48 The marks at issue were a variety of marks such as “A7S,” to which the defendant Lowery added the letter “L” to create the mark “L-A7S.” The defendant’s purpose in adopting these marks was to indicate that its wellheads were interchangeable with those of the plaintiff. Id. at 1469.

49 Id.
A finding that a mark is being used to indicate size, style, or grade is not determinative. The marks are deemed to be presumptively descriptive, and therefore can be protected on a showing of secondary meaning. For example, in *Wesley-Jessen Division of Schering Corp. v. Bausch and Lomb*, the marks “U3” and “U4” were protected even though they represented that the contact lens were of an ultrathin thickness and 13.5 mm and 14.5 mm in diameter, respectively. The crucial issue was not whether the purchasers (eye care professionals) believed that the marks were “brands” as opposed to “sizes”, but whether they associated the marks with a single source.

In order to make this determination, the court reviewed evidence
of how other manufacturers were designating their sizes as well as the method by which customers order the goods. For example, if the goods of the plaintiff are ordered with only the alphanumeric with the expectation that the order will be filled with the plaintiff's product, there is a presumption that the mark is an indicator of origin. Another relevant factor is whether the name of the company or another trademark of the company is used in conjunction with the alphanumeric. Such use is an indication that the alphanumeric mark is being used as a serial or model number.

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55 Wesley-Jessen, 698 F.2d at 866 (noting that other lens manufacturers used "U4" mark to indicate plaintiff's lenses when comparing them to their own, which were designated as "CSI" lenses); see Keller, Inc. v. Chicago Pneumatic Tool Co., 298 F. 52, 59-60 (7th Cir. 1924) (invalidating mark which represented size of tool, partially on grounds that competitors of owner used same figures to indicate sizes of their tools); Smith & Davis Mfg. Co. v. Smith, 89 F. 486, 487 (C.C.N.D. Ill. 1898) (refusing to protect mark "27" for mattress because industry custom was to grade mattresses with numbers 1 through 27 and other manufacturers were currently using number "27" as grade for their mattresses); see also J.M. Huber Corp. v. Lowery Wellheads, Inc., 778 F.2d 1467, 1471 (10th Cir. 1985) (noting that, although no defense to trademark infringement action that third parties are also infringing the mark, evidence of similar use by third parties is relevant in deciding if there is a "likelihood of confusion").

56 American Solid Leather Button Co. v. Anthony, Cowell & Co., 15 R.I. 338 (1886) (protecting numerals used to designate sizes of nail heads because the numeral of the plaintiff was known as an indicator that plaintiff's goods were sought).

57 In J.M. Huber Corp. v. Lowery Wellheads, Inc., the marks in question were used on the products of both companies in conjunction with the house mark of the company, which was placed immediately above the alphanumeric mark in a "conspicuous" manner. 778 F.2d 1467, 1469 (10th Cir. 1985). When an alphanumeric is used in conjunction with another trademark of the manufacturer, there is a presumption that the alphanumeric is a part or model number. Neapco, Inc. v. Dana Corp., 12 U.S.P.Q.2d (BNA) 1746, 1748 (T.T.A.B. 1989); Dennison Mfg. Co. v. Scharf Tag, Label & Box Co., 135 F. 625, (6th Cir. 1905) (using house mark with number precludes use of number to indicate origin); see also Certain Sickle Guards, supra note 43, at 1899 (noting that alphanumeric marks at issue, which were not given protection, were used in conjunction with name of manufacturer).
The use of another mark with the alphanumeric serial number is not determinative. In In re Petersen Manufacturing Co., 58 the alphanumerics at issue, "18R", "9LN", etc., identified various types of locking hand tools made by the applicant. All of the marks appeared in conjunction with the mark "VISEGRIP", which was a factor in finding that the marks were descriptive. The marks were still registered, however, because the applicant proved secondary meaning for the numbers themselves among the purchasing public. 69 The court relied on the fact that the symbol itself was promoted and recognized as a mark distinguishing the goods of the mark user from the same or similar goods of others:

In the present cases, we have no doubt that the designations sought to be registered, as used in the specimens of record, function as model designations to distinguish between applicant's various locking hand tools. However, there is no question that such model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations. 60

Abb. N. Cas. 17 (N.Y. Sup. Ct. 1879) (holding a series of numbers used for dual purpose of indicating origin and distinguishing between sizes of photographic mounts could be protected even though numbers were not used in connection with name of manufacturer).

This split of authorities indicates that a finding of secondary meaning for the alphanumeric itself would probably give rise to trademark protection, with the use of the house mark raising the burden of proof of secondary meaning. See supra notes 20-21 and accompanying text; In re Marsh Stencil Machine Co., 178 U.S.P.Q. (BNA) 318, 319 (T.T.A.B. 1973) (refusing to adopt per se rule that use of house mark with style designator precludes registration of style designator and allowing registration of style mark used in prominent fashion in advertising).

59 Id. at 468.
60 Id. See also In re Armco Steel Corp., 127 U.S.P.Q. (BNA) 135, 137 (T.T.A.B.) (refusing registration to "17-4PH" and "17-7PH" after finding them to be serial marks which had not developed secondary meaning), rev'd sub nom. Armco Steel Corp. v. Watson, 188 F. Supp. 554, 127 U.S.P.Q. (BNA) 415 (D.D.C. 1960) (finding secondary meaning to exist on facts); see also Certain Sickle Guards, supra note 43, at 1900 (noting advertisements of goods did not prominently display alphanumeric symbols); Ex parte The Esterbrook Pen Co., 109 U.S.P.Q. (BNA) 368, 369 (Comm'r Pat. 1956) (holding number "2668" could not be trademark because it was advertised as style number in series of style numbers). But see Certain Sickle Guards, supra note 43, at 1900 (finding extent of advertising done is not important, but rather its effectiveness in establishing secondary meaning); Corbett Bros. Co. v. Reinhardt-Meding Co., 76 A. 243, 245 (N.J. Ch. 1910) (protecting numbers chosen arbitrarily for purpose of
Once there has been a determination of secondary meaning, the mark can be protected against infringement.\textsuperscript{61}

Slight variations in serial numbers are not as noticeable as slight variations in other contexts.\textsuperscript{62} In cases where the industry utilizes a certain serial system and all manufacturers use similar yet distinguishable marks, each mark is descriptive though it is technically unique.\textsuperscript{63} For example, in Paddington Corp. v. Attiki Importers & Distributors, Inc.,\textsuperscript{64} manufacturers of ouzo customarily named the product by a number, such as "No. 12 Ouzo" or "# 1 Ouzo." In that industry, the use by a manufacturer of a similar number, for example using "No. 12" when it includes the digit "1,"

\textsuperscript{61} Descriptive terms have only been protected since approximately 1938 under modern trademark analysis. See McCarthy, supra note 11, § 4.03[3], at 4-7 to 4-8 (discussing courts' recognition of modern trademark analysis). However, some courts still managed to provide some relief to the user of the serial mark. In Vacuum Oil Co. v. Climax Refining Co., the Sixth Circuit found that the mark "600W" for oil could only be protected for its secondary meaning and not as a trade-mark: "When a descriptive or geographical word or symbol comes by adoption to have a secondary meaning denoting origin, its use in this secondary sense may be restrained, if it amounts to unfair competition." 120 F. 254, 256 (6th Cir. 1903). If a mark is not protected under the law of trademark, the law of unfair competition is still available. Williams v. Curtiss-Wright Corp., 691 F.2d 168, 172, 217 U.S.P.Q. (BNA) 108 (3d Cir. 1982).

\textsuperscript{62} See supra notes 32-36 and accompanying text.

\textsuperscript{63} See K-S-H Plastics, Inc. v. Carolite, Inc., 408 F.2d 54, 59, 161 U.S.P.Q. (BNA) 75 (9th Cir.) (holding that plaintiff could not enjoin defendant's use of "C-number" on grounds that plaintiff's mark "K-number" had become generic in industry through use of similar marks, e.g. "P-number"), cert. denied, 396 U.S. 825 (1969).

\textsuperscript{64} 996 F.2d 577, 27 U.S.P.Q.2d (BNA) 1189 (2d Cir. 1993).
did not constitute infringement. The use of prefixes and suffixes with the same mark as a competitor has been held to reduce the similarity between the marks, even without a showing of industry custom.

Alphanumeric are now protected without question as long as the considerations above have been satisfied. As with the early history of those trademarks, the appropriateness of any protection for mnemonic trademarks is uncertain.

III. MNEMONIC ALPHANUMERICS AS TRADEMARKS

Telephone mnemonics differ from the alphanumeric described above in several crucial ways. First, the mnemonic is not entirely arbitrary in that the letters chosen correspond to the pre-assigned letters on the telephone keypad. The inability to choose any letters or numerals in random order is one of the crucial limitations on these marks, as will be discussed below. Second, because the letters are chosen to make the telephone number memorable, the mark often becomes connected with the business that uses the number and not the product directly. Finally, unlike a nonsense term like “A.1”, the mark possesses some meaning beyond its use as a mnemonic. These unique features create special problems for the use of these marks as trademarks.

A. HISTORY OF TELEPHONE MNEMONICS

Telephone mnemonics are a recent phenomenon that have taken over the American advertising landscape. In the wake of the popularity of vanity license plates, especially in California, telephone companies began to consider exploiting the vanity market with telephone numbers that matched letters on the dial of the telephone keypad.

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65 Id. at 588 (“Where there is no evidence of industry custom, and where larger numbers or numbers combined with letters are used for a trademark, courts have been more willing to find similarity between marks containing numbers.”).

66 Certain Sickle Guards, supra note 43, at 1904 (finding that the use of the prefixes “MCM”, “RS”, “OM”, “GB”, and the suffix “O” were sufficient to reduce the similarity with the alphanumeric bearing the prefixes “BU”, “BC”, and “BT”).

67 See infra notes 161-166 and accompanying text.
telephone in such a way that a word was spelled. The idea was not new. The advent of 800 toll-free service brought on the use of telephone mnemonics as a widespread advertising technique, as opposed to the dialing method used by all parties. AT&T introduced 800 toll-free service for large business customers in 1967. Since that time, its use by business customers of all sizes has expanded dramatically such that "[t]hose companies not using 800 numbers are at a competitive disadvantage." The use of vanity mnemonics increased as the use of 800 numbers expanded.

When the AT&T monopoly was dismantled in 1982, toll-free telephone service began to undergo rapid changes, especially in the prices and features offered. These changes allowed many smaller companies to purchase 800 service for use in their business, in addition to the large companies who had been the standard toll-

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68 Pacific Bell in California was the first company allowed to list its vanity telephone numbers in the directories, with the limitation that the listings must be free of sexual connotations and vulgarity and that the first three numbers must correspond to the customer's current prefix. California PUC Approves Vanity Phone Numbers, REUTERS LTD., July 17, 1986. See also infra notes 166-167 and accompanying text (discussing availability and portability of mnemonics).

69 The current dialing system, which utilizes only numerals, differs from the previous method of dialing used by the telephone companies, which used letters as prefixes such as Butterfield. These "mandatory" mnemonics were not advertising tools as a general rule. The advent of 800 service brought on the mnemonic craze that we see today.

70 M. Daniel Rosen, Expanding Your Sales Operation? Just Dial 1-800 . . . , SALES AND MARKETING MGMT., July 1990, at 82 (hereinafter Rosen). In the first phase of toll-free calling (1967-1976), large companies with a strong need for customer service used the 800 service to make the company more accessible to customers. In the second phase of toll-free calling (1977-1986), changes in technology made the toll-free calls much faster and allowed a company to use the same 800 telephone number nationwide. Toll-free Calling—Better Known as 800 Service—is 25 Years Old!, SW Newswire, July 24, 1992. See also Trend-setters Note: Just Dial V-A-N-I-T-Y, CHI. TRIB., March 11, 1985, § M, at 1 ("In 1982 . . . it became technologically possible for businesses to obtain one umbrella number so that they have a single-number identity nationwide. 'Once they do that, that makes the vanity number even more attractive,' [Pete Webster, staff AT&T marketing manager] said."). In the third phase of toll-free calling (1987-present [in 1992]), the effects of deregulation were felt as prices fell and services expanded. In this phase, more small businesses were able to use the service. SW Newswire, July 24, 1992. Portability of 800 telephone numbers has ushered in the most recent stage of toll-free calling by giving customers control over their number. See infra note 75 and accompanying text.

71 Rosen, supra note 70, at 82. Sheraton Corporation was the first company to use a toll-free marketing campaign in 1969.

72 Nena Baughman, 1-800-buy-fast: Competition has cut costs and added features to "800" telephone services, IND. BUS. MAG. May 1991, at 43.
free customers in the past.

Even after the Ma Bell breakup, the old 800 number system had its limitations. For the purposes of vanity mnemonics, the single biggest drawback to the 800 system was the inability to get any seven letters from any carrier. Because the three-digit prefixes were assigned to specific carriers,\textsuperscript{73} a limitation paralleling that on local prefixes, a customer either had to choose a number assigned to his or her carrier or choose the carrier assigned to his chosen number.\textsuperscript{74} In September of 1991, the Federal Communications Commission demanded that the industry implement technology by March of 1993 to make 800 numbers "portable" so that customers could change carriers without changing telephone numbers. The technology was not in place until May 1, 1993, but now customers can switch carriers without switching telephone numbers in which they have a strong advertising interest.\textsuperscript{75} This change in technology means that the telephone company does not "own" the telephone number; the customer does.\textsuperscript{76}

\textsuperscript{73} Victor Toth, \textit{What Price Number Portability?}, BUS. COMM. REV., Oct. 1991, at 64. Under the old 800 system, calls to 800 numbers were routed differently than other outgoing calls because the NXX digits (i.e. the first three digits of the regular seven digit telephone number) were assigned to separate interexchange carriers (IXC). The local exchange carriers "route 800 calls to the [IXC] selected by the 800 service subscriber (i.e., the called party), rather than to the IXC that is presubscribed to the line that the calling party is using." \textit{Id.}

Because the method of identifying the IXC was through the NXX prefix, once a company had chosen a carrier and had gotten a number with a given NXX, they could not switch carriers without switching their NXX prefix to a prefix that was available to the new IXC. Also, any company that had an interest in obtaining a specific telephone number for its mnemonic equivalent had to get the number from the carrier that controlled the NXX prefix.

\textsuperscript{74} See supra notes 166-167 and accompanying text.

\textsuperscript{75} Gary Strauss, \textit{All Parties Claim Win in War of 800 Lines}, USA TODAY, May 21, 1993, at 4B. The "cost" to customers in switching is an indication of the proprietary interest that customers had in their telephone numbers and vanity mnemonics.

\textsuperscript{76} The newest technology in this area is the personal 700 number that will follow the customer, precluding the need for a change in telephone number when the customer moves to a new area. This technology may be expanded to 800 service soon, as well. \textit{Toll-free Calling—Better Known as 800 Service—is 25 Years Old!}, SW Newswire, July 24, 1992, available in LEXIS, News Library, Wires File. However, because most of the users of this service will be private individuals as opposed to businesses, the new technology is beyond the scope of this Note.

It is interesting to note that before the May 1 switch, MCI was unable to use its chosen mnemonic, "1-800-COLLECT," because it was assigned to a different telephone company. MCI did not want to be the customer of a rival telephone company, and therefore had to wait until portability was possible before obtaining its now-famous mnemonic. Carla Lazzareschi, \textit{MCI Tries to Ring Up Sales With Collect Call Service}, L.A. TIMES, May 20, 1993, § D, at 1.
May 1 change added over 100 new prefixes for 800 service, thereby providing the new customers with more mnemonics from which to choose.  

With the expansion of the use of 800 telephone mnemonics, companies developed a proprietary interest in mnemonics apart from any interest in the number itself. The inability of subscribers to transfer "their" telephone numbers to other companies was the impetus for the development of portability technology. In fact, the FCC pushed the date of portability forward at the expense of the quality of the service because of the importance of portability to the industry. Portability changed the proprietary quality of toll-free telephone numbers. "The change means 800 carriers no longer 'own' toll-free numbers—customers do."

B. HISTORY OF TELEPHONE MNEMONICS AS TRADEMARKS

These telephone mnemonics do not "fit" into current trademark theory. The courts have forced mnemonics into the traditional categories even though their technological anomalies require special consideration.

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77 Strauss, supra note 75, at 4B. Under the old system, the prefixes had to have been assigned to carriers in order to be available for use. With the abolition of that requirement, any telephone number could be chosen without limitation. See infra notes 166-167 and accompanying text.

78 There is an argument that before portability, a company which had advertised its mnemonic had a proprietary interest in its telephone number by virtue of consumer recognition. See McCarthy, supra note 11, at § 2.11 at 2-57 to 2-58 ("A trademark that has attained consumer recognition has an inherent value and should be protected from imitation by those who would like to profit from advertising expenditures that they did not make."). Even though the company could not change its number, that number acted to encourage consumer recognition. Id.

79 "Established customers generally are unwilling to move to alternative 800 providers because of their vested interest in well-established and heavily promoted AT&T 800 numbers." Victor Toth, What Price Number Portability?, BUS. COMM. REV., October 1991, at 64. "[The requirement that a company changing companies had to change their telephone number] made changing totally impractical for companies with highly advertised numbers such as 1-800-THE-CARD (American Express), 1-800-HILTONS (the hotel chain) or 1-800-FLOWERS." John Eckhouse, Telephone Foes Fight for 800s: Toll-free Numbers Can be Shifted, S.F. CHRON., April 30, 1993, at D1.


81 Toll-free Calling—Better Known as 800 Service—is 25 Years Old!, SW Newswire, July 24, 1992, available in LEXIS, News Library, Wires File.
1. Propriety Interests in Telephone Numbers. The hierarchy of rights in a telephone number provides background for deciding who "owns" a telephone number. For example, a subscriber's rights to the telephone number are superior to everyone but the telephone company, including someone who had been using the number.\footnote{Darman v. Metropolitan Alarm Corp., 528 F.2d 908, 910 (1st Cir. 1976).} Once a business subscribes to a telephone number, they "own" that number as against all the world except the telephone company.

The first case dealing with telephone numbers as trademarks in any context was \textit{Rocky Mountain Bell Telephone Co. v. Utah Independent Telephone Co.},\footnote{88 P. 2d (Utah 1906).} in which the plaintiff had established a "Trouble Department" which customers could reach by dialing "888", while the defendant, a new telephone company using different telephones, established a "Trouble Clerk" which could be reached by dialing "888".\footnote{\textit{Id.} at 26-27.} The court refused to restrain the defendant's use of the number for a variety of reasons. First, the court denied that the number was being used as a trademark, but rather "for the sole purpose of making it possible and convenient for the patrons of [plaintiff] to communicate with that department."\footnote{\textit{Id.} at 28.} Second, any mistakes in reaching the correct company resulted from the carelessness of the customer in dialing from the wrong phone, not fraud or misrepresentation by the defendant:\footnote{\textit{Id.} at 29.} "Surely it cannot seriously be contended that [defendant] organized its system and is conducting it in that way for the sole purpose of benefitting itself from chance occurrences such as those above mentioned."\footnote{But see infra notes 98-100 and accompanying text.} The court also noted that if the mark "888" were to be protected, the plaintiff telephone company could prevent the use of all of its telephone numbers on the grounds that the second use caused inconvenience. Since the company could not prevent duplication of telephone numbers by patrons because it would be impractical, the numbers of the company itself could also not be
protected. Finally, the court distinguished telephone numbers for trouble departments from other number marks used on articles of commerce by saying that the customers would not be deceived by the two different trouble numbers when deciding which telephone carrier to chose for communications service. The trouble numbers would not cause confusion as to the origin of the service and therefore could not be protected.

The first modern case dealing with telephone numbers as trademarks is *Chicago World’s Fair - 1992 Corp. v. 1992 Chicago World’s Fair Commission,* in which the court held that the plaintiff had rights in the telephone number 444-1992 against the defendant’s use of the telephone number 434-1992, in addition to having infringed the plaintiff’s other registered trademarks. The defendant was ordered to change the number to one not confusingly similar to plaintiff’s. Although *Chicago World’s Fair* is an unpublished opinion, it is the first one recognizing a trademark right in the telephone number itself.

2. Alphanumeric Mnemonics As Trademarks. The rapidly changing telephone technology described above affects a business’ interest in a telephone number. Previous courts ignored the nature of the technology when making decisions regarding the proprietary interests in these mnemonic marks. The following section is a compilation of the cases dealing with trademarks and mnemonics to date.

The first court confronted with a mnemonic mark summarily rejected trademark protection. The California Court of Appeal refused to protect “321-READ” because there was no precedent protecting mnemonics as trademarks and because the word “read” was in common use in all contexts.

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88 88 P. 26, 29-30 (Utah 1906).
89 Id. at 30.
91 Id. at *7.
92 Id. at *8-9.
93 Id. at *11.
95 Id. at 112. Analysis under the author’s system achieves the same result because the mnemonic is generic and therefore should be given no protection and because the difference in prefixes serves to distinguish the marks.
Several cases compare a mnemonic with a traditional word mark and vice versa, as opposed to two mnemonics, to determine whether or not there has been an infringement. Courts in this situation ignore the unique technological background of the mnemonic and analyze it as a traditional word mark. For example, in Societe de Developments et D'Innovations des Marches Agricoles et Alimentaires-Sodima-Union de Cooperatives Agricoles v. International Yogurt Co.,96 the defendants used the telephone mnemonic “800 YOCRÉAM”, which conflicted with the plaintiff’s mark “YOCREME”. The court invalidated and cancelled the plaintiff’s trademark on other grounds, and as a result never addressed the validity of 800 YOCRÉAM as a mark in and of itself, but rather as an addendum to the “YOCRÉAM” mark.97

Another example of a court viewing a mnemonic as simply another word mark is American Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp.,98 in which the court found that the defendant 800 service had infringed the trademark “AMERICAN” intentionally by obtaining a listing in the airline companies section of the yellow pages immediately before the American Airlines listing, although the defendant was a travel agency.99 The court noted that had the defendant used the name and telephone number legitimately, e.g. as a travel agency, then the defendant could have used the name and telephone number.100 In this case, as opposed to the Sodima case, the use of the telephone mnemonic itself infringed the word mark, but the court still focused on the use as a word and not as a mnemonic.

Another case using the same analysis as A 1-800-A-M-E-R-I-C-A-N is Kelley Blue Book v. Car-Smarts, Inc.,101 in which “1-900-BLU-BOOK” and “1-800-BLUE-BOOK” infringed “Kelley Blue Book”, a descriptive word mark.102 The analysis was not altered because the infringing marks were telephone numbers. For

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96 662 F. Supp. 839, 3 U.S.P.Q.2d (BNA) 1641 (D. Or. 1987); see also supra text accompanying note 7.
97 Id. at 851 (finding plaintiff abandoned mark after registering it).
99 Id. at 686.
100 Id. at 686-87.
102 Id. at 288.
example, in discussing the similarity of the marks in order to determine whether there was a likelihood of confusion, the court compared the sight, sound, and meaning of the marks without making an allowance for the fact that one of the marks was clearly a telephone mnemonic. Even the fact that the defendants used their name along with the mnemonic was not enough to distinguish the marks. The cases comparing traditional word marks with mnemonics generally do not confront the special nature of telephone mnemonics.

The only case between a traditional word mark and a mnemonic mark that addressed a distinguishing characteristic of telephone mnemonics was *Multi-Local Media Corp. v. 800 Yellow Book Inc.*, in which the mark "Yellow Book," as used for a telephone directory, was protected against "800 Yellow Book" as a referral service for businesses. The addition of "800" did not change the analysis because "800" is a generic term for toll-free calling incapable of distinguishing marks.

These cases address the issue of confusion of sponsorship rather than confusion of the marks. For example, in *Kelley Blue Book*, there was little doubt that the telephone mnemonic was not a book, but there was confusion as to whether or not the telephone number was associated with the original "blue book." The courts in cases pitting a traditional mark and a mnemonic against each other find that the mnemonic infringes the word mark because the marks are similar. Because mnemonics are clearly associated with telephone numbers, confusion really stems from whether or not the plaintiff company had established the phone line or not. By not couching their opinions in these terms, the courts have established a line of precedent against protecting alphanumeric mnemonics.

In one of the few cases outside of the Second or Third Circuits

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103 *Id.* at 287.
104 *Id.*
106 *Id.* at 206.
107 *Id.* at 204. *Contra* Bell v. Kidan, 836 F. Supp. 125, 127, 28 U.S.P.Q.2d (BNA) 1077 (S.D.N.Y. 1993) (distinguishing between local call and toll-free call because that difference would be significant to potential callers, thus serving to differentiate numbers in memory of customer, and because "an ordinary customer would expect even slight variations in a telephone mnemonic to yield an entirely different number").
containing a dispute between the users of two alphanumerics, as opposed to an alphanumeric and a traditional word mark, the District Court for the Eastern District of Michigan refused to preliminarily enjoin the defendant's use of a telephone number while also refusing the defendant's motion for summary judgment on the issue of confusion between the numbers. In the U-Haul litigation, the defendant had been an authorized U-Haul dealer for approximately ten months and had obtained the telephone numbers 800-468-4255, 800-408-4285, and 800-408-4255 (which correspond to 800-GO-U-HALL, 800-G0[zero]U-HAUL, and 800-G0[zero]-U-HALL, respectively) during that period. The plaintiff had been using the telephone number and mnemonic 800-GO-U-HAUL for several years, and upon dissolution of the relationship requested that the defendant stop using the similar numbers. On the defendant's refusal to comply, the plaintiff brought suit for trademark infringement and unfair trade practice. The court denied the plaintiff's motion for a preliminary injunction because the plaintiff had been unable to produce any evidence that the defendant had actually used the mnemonics as opposed to just the telephone numbers. When confronted with the defendant's motion for summary judgment, however, the court found that despite the lack of evidence of advertising and the defendant's affidavit that it had never used the mnemonic 800-GO-U-HALL in its advertising, a material issue of fact existed as to whether or not "defendant's use of the complementary telephone lines constitute violations of section 1114 or 1125." These two orders indicate that the use of a complementary telephone number without any advertising of the mnemonic may constitute violation of the


110 U-Haul II, infra note 108, at 1311. The court refused to apply Holiday Inns, Inc. v. 800 Reservation, Inc., 838 F. Supp. 1247 (E.D. Tenn. 1993), in which the court found trademark and unfair trade violations in the use by a travel agency of the complementary mnemonic for 800-HOLIDAY because of the intent of the defendant to deceive customers into calling the complementary number. Because the U-haul defendant had no intent to take advantage of the complementary number, the court did not find Holiday Inns, Inc. persuasive. Id. See infra notes 98-100 and accompanying text.
On the defendant's renewed motion for summary judgment, Judge Gadola again refused to allow the defendants to terminate the suit because discovery was not complete, especially as to whether the defendant had advertised the telephone number as a mnemonic. In doing so, the court reasoned that such a determination would be required in order to find a trademark violation because no authority existed that the use of the bare telephone number could constitute a trademark violation. In support of its position, the court cited Chicago Blackhawk Hockey Team v. Madsen, a case in which the Chicago Blackhawks sued Madsen to keep him from using the telephone number (736-HAWK) which had previously been used by both parties as a sports hotline. Because the defendant had rights to the telephone number and was not using the mnemonic, the court refused to enjoin his use of the telephone number alone. That the defendant had previously advertised the mnemonic with the cooperation of the Blackhawks was analogized to a former franchisee running a new store in the same type of business in the same location with a new name. Because the defendant did not create sufficient confusion based on a trademark, the court held that there can be no trademark violation.

3. The Second and Third Circuit Debate Over Genericness. The foregoing discussion of the major cases in the area of alphanumeric mnemonics as trademarks highlights the lack of analysis as to whether these types of marks should be protected at all. The only courts that have squarely confronted the issue of the nature of these marks are the Second and Third Circuit Courts of Appeals. These two courts are engaged in an ongoing battle as to whether or not a mnemonic which is generic can be protected.

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112 Id. at *7.
114 Id. at *21.
115 Id. at *24-25.
116 For an excellent analysis of the debate between these two circuits, see Terry Ann Smith, Comment, Telephone Numbers That Spell Generic Terms: A Protectible Trademark or an Invitation to Monopolize a Market, 28 U.S.F. L. REV. 1079 (1994).
The Second Circuit does not require that a mark in an alphanumeric mnemonic be descriptive, suggestive, or arbitrary in order to be protected. In *Dial-A-Mattress Franchise Corp. v. Page*, the court protected the generic mnemonic "MATTRESS" because the defendant used a confusingly similar telephone number. By focusing on the fact that the telephone numbers were identical with the exception of the addition of the 800 toll-free prefix, the court disregarded the generic nature of the mnemonic itself. The underlying telephone numbers are only important in mnemonic advertising to the extent that the business has to get the number to get the mnemonic. Generally, the underlying number is either not advertised at all, or it is cited parenthetically for the benefit of callers who may not have telephone keypads with both letters and numbers. In the *Dial-A-Mattress* case, no conflict would have arisen if the defendant had used a different mnemonic than mattress for the same telephone number. By sidestepping this issue, the Second Circuit protected a generic mark even though such protection is never afforded to conventional generic marks.

Relying on the *Dial-A-Mattress* decision, the District Court in Minnesota, in *Murrin v. Midco Communications, Inc.*, found that "L-A-W-Y-E-R-S" was protected as a mark against the use of "1-800-LAWYERS" in the same geographic area where the original mnemonic was used. Although the court stated that it did not need to decide the question of whether a mnemonic could be a trademark, it cited the Second Circuit and other courts for the proposition that a confusingly similar use of a telephone number could constitute either trademark infringement or unfair competition. Given the limited number of available mnemonics, protecting a generic mark in this context penalizes a competitor in another area code or with the toll-free 800 prefix.

The Third Circuit, on the other hand, will not protect a generic

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118 Id. at 678.
119 See supra note 107 and accompanying text.
120 See supra notes 16-17 and accompanying text.
122 Id. at 1200.
123 See infra notes 158-166 and accompanying text.
alphanumeric mnemonic. In Dranoff-Perlstein Associates v. Sklar, the court found that the mnemonic “INJURY” was generic. Because the term was being used as a mnemonic, the court considered the reduced number of available alternatives, as the limited amount of digits and the specific combinations of letters required to correspond to the telephone pad severely restricts the available alternatives for a mnemonic. Even though the term “injury” may have been descriptive for traditional word marks, the severe reduction in alternatives justified the term being categorized as generic. Under this kind of analysis, mnemonics are more likely to be found generic than other terms, especially since many mnemonics are chosen for their descriptive quality.

In Dranoff-Perlstein, the two marks at issue were “INJURY-1” and “INJURY-9,” a fact which highlights the slight variation problem. The court noted that generic terms with suffixes could be protected, but only if there was a likelihood of confusion between the suffixes themselves, i.e. “1” and “9,” and if the first user had acquired secondary meaning in the composite mark “INJURY-1” in the field of personal injury law. The court remanded with a cautionary note to the lower court that the fact that “injury” was generic should be a strong factor in a consideration of whether a likelihood of confusion existed between the two marks.

The District Court for the Southern District of New York has not allowed the Dial-A-Mattress decision to hinder its analysis of the mnemonic problem. In Bell v. Kidan, the user of “Call-Law” as a mnemonic tried to restrict the use of “Law-Call” for similar legal

124 Supra note 7.
125 Dranoff-Perlstein, 967 F.2d at 860.
126 Id. at 857.
127 See infra notes 158-166 and accompanying text.
128 See infra notes 158-166 and accompanying text.
129 Dranoff-Perlstein, supra note 7, 861-62.
130 Id. ("[T]he district court should consider the likelihood of confusion between the two marks in their entireties, with the emphasis of the inquiry on the non-generic portions of the disputed marks."). No mention, however, was made of the functional difference between the two suffixes in the dialing of the telephone number and the impact that difference should have in the analysis of the likelihood of confusion. See infra notes 179-182 and accompanying text.
131 Bell, 836 F. Supp. 125.
services. The court found that a preliminary injunction was not warranted, even though "Call-Law" was a registered mark, because, inter alia, it could not be distinguished from other mnemonics and because the mnemonic was easily identifiable as a telephone number and not as a mark for services. The court classified the mark as either "suggestive" or "descriptive," but its classification did not affect the determination that the mark would not be protected by an injunction. Judge Stanton did not even mention the Dial-A-Mattress decision in his order on a motion for a preliminary injunction. His order treated the mark as a mnemonic and not as a traditional word mark. The factual predicate for the decision was distinguishable from Dial-A-Mattress in that the two underlying telephone numbers themselves were not the same; Dial-A-Mattress was based on the theory that the two numbers were confusingly similar. Whether the Bell decision signals an end to the chasm between the Second and Third Circuits remains to be seen.

These cases raise serious questions about treating telephone mnemonics as traditional word marks for the purposes of trademark law. The specific problems created by mnemonics are discussed below, along with suggestions for a new method of analyzing protection issues for these marks.

IV. ANALYSIS

Because alphanumeric mnemonics are subject to many of the same defects from which serial alphanumerics suffer, they should carry the same presumption of descriptiveness. In addition, because the protection of alphanumerics implicates serious telecommunications concerns, the courts should decide these types of cases according to principles of unfair competition law rather than trademark law.

One of the similarities between telephone mnemonics and serial numbers is that both marks are not being used primarily to

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132 Id. at 126.
133 Id. at 127.
134 Id.
135 See id.
136 See discussion supra at 70.
designate the goods of the business, a function of trademarks. Serial numbers distinguish the goods of the manufacturer from each other. Telephone mnemonics, on the other hand, identify the business's telephone number, not the source of the goods. Usually, use of the number to distinguish the goods or services from those of another company determines whether or not the serial number could also serve as a trademark. Similarly, if a mnemonic distinguishes a service or good from that of another company, it should receive protection as a trademark. However, while mnemonics may be able to serve that function, they were not designed for it.

The effectiveness of advertising in reducing transactional costs to

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137 See McCarthy, supra note 11, § 2.01[2] at 2-3 ("From an economic point of view, a trademark is merely a symbol that allows a purchaser to identify goods or services that have been satisfactory in the past and reject goods or services that have failed to give satisfaction.").

138 See supra notes 37-42 and accompanying text.

139 See Cytanovich Reading Ctr. v. Reading Game, 208 Cal. Rptr. 412, 417, 225 U.S.P.Q. (BNA) 588 (Cal. Ct. App. 1985) (where court held four digit/letter mnemonic is not trademark); see also Rocky Mountain Bell Tel. Co. v. Utah Indep. Tel. Co., 88 P. 26 (Utah 1906) (where telephone company adopted same phone number formerly used by competitor and court held that practice did not constitute unfair competition or trademark violation.). Although the mnemonic makes the telephone number itself easier to remember, the companies which use the numbers have to do a "sufficiently good job in advertising . . . so that the consumer associates it with them." Trend-Setters Note: Just Dial V-A-N-I-T-Y, CHI. TRIB., March 11, 1985, § M, at 1. In this respect, the mnemonic is no different than any other trademark, which can only be protected if it is used by the owner to identify its goods. Mnemonics are used specifically for the purpose of increasing recognition and name identification by the consumer. Penny Pagano, Firms Find Custom Phone Numbers Ring A Few Bells, L.A. TIMES, September 27, 1986, at 20. See Robert Strand, Proprietary to the United Press Int'l, July 16, 1986, Regional News ("For a business, a letter number helps identify the nature of its activity, helps customers remember the number and implies that the company is somehow creative . . ."); Carolyn Culberson, Dial 1-800-innovation: Why More and More Growing Companies Are Using 800 Numbers, Telemarketing, August 1994, at 50 ("[A vanity number] provides a unique identity and/or easy name recall by simply spelling a name, acronym or product with your 800 number."). But cf. James S. Winchurch, All-Letter Phone Nos. Overlook Big Market, CHI. SUN-TIMES, April 28, 1993, at 30 (noting that in order to be useful, mnemonic must be translated into telephone number and that advertising of mnemonics should include number itself to be effective); In Many Firms' Phone Lines, All is Vanity, ST. LOUIS POST-DISPATCH, November 1, 1992, at 8E ("The downside of vanity numbers is that consumers have to translate the letters into numbers on their telephone key pad or dial . . .").

140 See supra notes 37-52 and accompanying text; see also Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300, 1308, 34 U.S.P.Q.2d (BNA) 1161 (1995) (holding that if color can distinguish one company's product from another company's product, it should be protected).
consumers, another function of trademarks, weights in favor of treating mnemonics as trademarks. In the debate over portability, a determinative issue was that when a company changed its number to change service carriers, it had to change its advertising, letterhead, etc., and its customers had to learn a new number. This added trouble indicates that the mnemonic reduced costs to the consumer in remembering the telephone number of the business. The companies for which switching created a burden had achieved secondary meaning in their number and/or mnemonic because of this memory-assisting function. Although this function makes the mnemonic useful in advertising, its relevance to trademark law is questionable.

Mnemonics work because they associate a business with a telephone number, not a good or service with a business. The customer usually does not remember the mnemonic for an extended period of time. Even though the search costs are reduced, the incentive to provide a quality product is instigated because the customer will remember the product and its mark, not the telephone number. For example, if the number for reaching the XYZ florist is FLO-RIST, a customer who uses the mnemonic to remember the number and is satisfied with the service, will associate the service with the mark XYZ, not the mnemonic, which is just a method by which customers can reach XYZ.

Because trademarks must distinguish the goods or services of the business from other goods, mere advertising of the mnemonic does not create a trademark. In Bell v. Kidan, discussed above, the court refused to protect a registered mark, “Call-Law,” because it could not be distinguished from other mnemonics, and because the mnemonic was easily identifiable as a telephone number and

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141 Qualitex, 115 S. Ct. at 1308; McCarthy, supra note 11, § 2.01(2), at 2-3.
142 See supra note 75 and accompanying text.
143 Rosen, supra note 70, at 101.
144 Dranoff-Perlstein, supra note 7, at 863 (Stapleton, J., concurring).
145 Companies for whom the mnemonic is the primary means of identification may fall out of this analysis. One example is 1-800-FLOWERS, which is not advertised in conjunction with any other corporate name.
146 Cf. Sodima, supra note 7, at 846 (“Advertising may increase the strength of a mark by increasing consumer recognition of it, but advertising does not of itself automatically make a suggestive mark strong.”).
not as a mark for services. The gravamen of trademark law is that the mark must identify the source of the services in order to be protected. If the mark is not identifying the source, but rather the telephone number, then it does not perform that vital function.

Trademarks perform these functions when appurtenant to the good will of an existing business and are therefore not rights in gross. The converse of that assertion is that as long as a symbol is functioning as a trademark, the user of the mark has “property” rights in it. Even with portability, the customer of the telephone number can lose its ownership rights in a mark by not paying the telephone bill. Other types of marks are lost through failure to use or inappropriate use. This risk of losing a functioning mark goes against the theory of abandonment. If a trademark owner generally can only lose rights in a mark by not using it, and a telephone mnemonic owner can lose rights in a mark despite any secondary meaning established in the mind of the public, the mark owner does not truly “own” the mark, despite portability.

Portability raises another theoretical problem in the determination of whether or not a mnemonic can function as a trademark. As a result of portability, entrepreneurs reserve telephone numbers for the purpose of licensing the mnemonic to various businesses

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148 Id. at 127.
149 See McCarthy, supra note 11 and accompanying text.
150 See Sodima, supra note 7, at 847 ("An axiom of trademark law is: no trade, no trademark."); see generally McCarthy, supra note 11, § 2.07, at 2-34 (stating that property rights in trademark are appurtenant to good will of established business); Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc., 841 F. Supp. 1339, 1350 (E.D.N.Y. 1994) ("A trademark or service mark is merely the symbol by which the public recognizes that reputation and hence has no independent significance apart from the owner's good will.").
151 See supra note 82 and accompanying text.
152 See also Telephone Numbers—Spelling for Profit, BUS. WIRE, Jan. 27, 1994 (Attorney lost use of his local telephone mnemonic “Dial LEGAL-10” when local telephone company reassigned his telephone number to different area code. The attorney simply changed mnemonic.). The telephone companies still assert ownership rights in the telephone numbers even after the advent of portability of 800 numbers. Jo Gilbert, 1-800-on-the-go: Companies Now Can Take a Hike With Their Toll-free Numbers, IND. BUS. MAG., June 1993, at 51 (noting that telephone number is not owned by customer because it cannot be bought or sold as commodity). But see supra notes 74-77 and accompanying text.
153 See Sodima, supra note 7, at 848 (cancelling mark because owner had abandoned mark by not using it).
which could use it.\textsuperscript{154} The licensing phenomenon indicates that a mnemonic is not being associated with a single manufacturer as a general rule, but with a type of good or service. This phenomenon is a result of the limited number of marks available\textsuperscript{155} and the ability to reserve marks without using them. The mark is being licensed as intellectual property before the mark has achieved trademark status. Licensed marks cannot indicate that the services are associated with a single source unless there is some sort of franchise; marks of this type are inherently generic.\textsuperscript{156}

At the heart of the problem of protecting telephone mnemonics lies the limited availability of alternative marks within the field of telephone mnemonics. This restriction weighs strongly against the free availability of trademark protection for telephone mnemonics. In the traditional trademark case, if a company uses an especially clever trademark, its competitors could simply be more clever to appropriate a distinguishing mark. Because a mnemonic can have

\textsuperscript{154} There are firms that use computers to list all of the available mnemonics for a given telephone number and the telephone numbers that will form given words. Bristol Voss, A 10-letter Word for 800 Numbers? Toll-free Number Services, SALES AND MARKETING MGMT., Sept. 1988, at 97. One company has even reserved a block of 800 numbers that can be associated with a given popular mnemonic for a "disposable, reusable industry," such as 1-800-OVEN-HOT for a pizza restaurant, or 1-800-DeBUG-911 for an exterminator. The company then licenses the use of the telephone number to small businesses in different areas of the country. 800 Numbers Dishing Out Dough: Magco Inc.'s Mnemonic Numbers, AMERICA'S NETWORK, Mar. 15, 1994, at 12. See, e.g., Telephone Numbers—Spelling For Profit, BUS. WIRE, Jan. 27, 1994. See also Suzanne Oliver, 1-800-GETCASH, FORBES, Jan. 17, 1994, at 55 (describing the buying and selling of numbers which correspond to the names or trademarks of established companies, such as 1-800-FIRESTONE, 1-800-IBM-PCUSA, 1-800-NIKEUSA); Neil J. Rubenking, Create Mnemonic Phone Numbers With FONEN WORD, PC MAG., Oct. 26, 1993, at 367 (describing computer program that will create mnemonic words from telephone numbers). The telephone companies object to this kind of number brokering, alleging that it is unfair to small businesses, who cannot afford to pay the inflated prices for desirable vanity numbers which would otherwise be available. Kevin Maney, Dial 1-800-I'M-RICH: Brokers Cash in on Numbers Game, USA TODAY, Apr. 28, 1994, at 2B.

\textsuperscript{155} The exception to the rule that a mnemonic is generic is when the number, through advertising, is associated with one company, or when the goods or services attached to the number are associated with one company. Henry R. Hoke, Family Tastes Sweet Success With Onions, DIRECT MARKETING MAG., January 1994, at 32 (placing 1-800-VIDALIA directly on onions with stickers, to create association by consumer between mark and type of onion). Other companies have created an association in the mind of the public through extensive advertising. See Telephone Numbers—Spelling For Profit, BUS. WIRE, Jan. 27, 1994 (describing use of mnemonics such as 1-800-THE-CARD by American Express to increase sales).
seven functional letters at most, its competitors face a restricted pool of available alternatives from which to choose its own mark if a company appropriates a clever mark. The fact that Q and Z are not available for use in the mnemonic exacerbates this problem.\(^{157}\) Because the competition for good telephone numbers is stiff, the first company in an industry to get an appropriate mnemonic has a permanent advantage over its competitors, who may not be able to obtain a telephone number which corresponds to a “good” word.\(^{158}\) As in the game Scrabble, companies must create words, not out of the limitless supply of letter combinations in the English language, but out of a restricted pile of letters dealt to it. The court in Dranoff-Perlstein held telephone mnemonics to a higher standard for overcoming genericness because of a limited number of alternative marks.\(^{159}\)

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\(^{157}\) The letters Q and Z were omitted when the telephone keypad configuration was designed in 1918. The number zero was reserved for the operator and the number one was reserved as a way to signal another directory. In order to make the alphabet divide evenly among the remaining numbers, two letters had to be dropped. Because Q and Z are the letters least used in directory names, they were left off of the keypad. Tom Swan, *Telephone Mnemonics and the Chocolate Coefficient*, DR. DOBB’S JL. OF SOFTWARE TOOLS, June 1993, at 147.

\(^{158}\) Because there are a limited number of terms available, it is more likely that a competitor will be trying to use a very similar term as a mnemonic. If the frequency of use of the term by competitors is high, then the term should be classified as descriptive rather than generic. *See* Dranoff-Perlstein, *supra* note 7, at 858 (classifying term “INJURY” as descriptive for telephone mnemonics in personal injury law field because of its frequent use by competitors of senior user of “INJURY-I”).

\(^{159}\) If there are no commonly used available alternatives which can communicate the same information, the term should be classified as generic as opposed to descriptive. *See* supra note 29 and accompanying text. Telephone numbers inherently have a restricted supply of available alternatives. Furthermore, there is the practical limitation that the number which is associated with an alternate mnemonic may not be available. *See* Dranoff-Perlstein, *supra* note 7, at 859 (“Because telephone numbers contain only an area code and seven digits, the range of commonly used alternatives which effectively communicate the same functional information as the word “injury” is severely limited in that context.”).

Another way to describe the phenomenon of restricted availability of acceptable alternative marks is that the telephone mnemonic market has inherent barriers to entry. One reason that trademarks are not considered “monopolies” on words is that there is an almost infinite supply of words from which to choose a mark. *See* McCarthy, *supra* note 11, § 2.05[1], at 2-23 (asserting that trademarks are less appropriate targets for charges of monopoly than patent or copyright because trademarks are only exclusive rights when accepted by buying public; “Trademark law in this sense is truly democratic, for the creation of marks and the test of infringement lie in the minds and purchasing habits of the buying public.”). Therefore, the appropriation of one word for the purpose of reducing consumer confusion does not create a barrier to entry into the market. *See* McCarthy, *supra* note 11, § 2.05[3], at 2-28.
Other limitations on the number of alternatives at the local level contribute to the "available alternatives" problem. The three digit prefix for a local number is determined by geographic area and cannot be chosen by the customer, further restricting the choices of a business in picking a mnemonic. However, the wide range of letter combinations available for most prefixes prevents this limitation from being a death knell for local mnemonics. The range of letter combinations is only useful to a certain extent when two competitors in the same geographic area are vying to find appropriate mnemonics for the same type of business. In addition, because the numbers 1 and 0 do not correspond to any letters, a prefix with one or both of those numbers is more limited than one without them, creating a situation where the ability to protect the mark is determined, not by the relevant geographic and business market, but by the random assignment of telephone numbers and prefixes by the telephone company.

In addition to restrictions that apply to local numbers, there is a limited supply of telephone numbers available nationwide.

(noting that barriers to entry are created not by mark, but by market, through such exclusions as lower costs for first comer and restricted numbers of viable competitors because of nature of market). However, in the context of telephone mnemonics, the appropriation of a word does create a barrier because of the limited supply of available telephone numbers and the limited supply of mnemonics to match.

160 Now, Say it With Numbers, N.Y. TIMES, Mar. 27, 1987, § A, at 22 (noting mnemonics must use available three digit prefixes and must not already be in use); California Game: Name That Phone, WASH. POST, Aug. 21, 1986, at C5 (noting areas of higher density may have more prefixes available); Diane Ketchum, Long Island Journal, N.Y. TIMES, Jan. 18, 1987, § 21LI, at 3 (noting that local exchanges must be used).

161 Clarence Petersen, If We Fix It Fails, Sue Them, CHI. TRIB., July 28, 1986, at C1 (listing available combinations for the prefix 234). Another way to get around the prefix limitation is to use remote call-forwarding, which allows a customer to choose any number within an area code, regardless of which local switching office has been assigned its prefix. Illinois Bell Rings in New Service for Custom Phone Numbers, ST. LOUIS POST-DISPATCH, Sept. 24, 1990, at 2BP.

162 There is concern in the telecommunications industry that the supply of ten-digit numbers is being depleted because of the increased consumption of phone numbers. Victor J. Toth, Leveraging the North American Numbering Plan, BUS. COMM. REV., May 1994, at 68 (indicating depletion is partly caused by impact of competition, added services, and multi-line households); New Area Code Format Is Here, STAR*LINES (Southern Bell, Atlanta, GA), Vol. VI, No. 1, 1995, at 2:

Because of the increasing demand for services like pagers, cellular phones, fax machines, and telephone lines, the telecommunications industry is running out of area codes available for assignment. In
The increased consumption of telephone numbers causes difficulty in finding appropriate mnemonics. A business can corner the market of mnemonics by appropriating the best mnemonic, with the help of a telephone system that has severely limited local and national alternatives. Furthermore, if a change in digits does not reduce the likelihood of confusion, the supply of available alternatives decreases because a party could prevent others from using mnemonics which were similar to, but not exactly like, his mnemonic and which were based on an entirely different telephone number. For example, if "INJURY-1" can be a trademark, then the parties that own "INJURY-2" through "INJURY-9" are precluded from using that mark. The risk of severe reduction in the number of available alternatives cautious against providing trademark protection to partial telephone mnemonics without a presumption that changes in digits distinguish the marks.

response, a new area code format has been introduced for the United States, Canada, and parts of the Caribbean, effective January 1, 1995.

See In Many Firms' Phone Lines, All is Vanity, supra note 146, at 8E (noting increased difficulty in finding vanity numbers "that click" because of increased use by companies); Barry Meir, Vanity Phone Numbers Can Fluster Callers, HOUSTON CHRON., July 15, 1992, at 1 (noting majority of most easily remembered words and phrases have already been appropriated and that need for vowels in most mnemonics is another special hurdle to obtaining good telephone number); Rubenking, supra note 160, at 367 (noting many telephone numbers yield no helpful mnemonics). But see Swan, supra note 163, at 147 (noting each seven digit number has 2,187 unique letter combinations, excluding those numbers with ones or zeros, but that all seven-digit numbers have 1.7 billion letter combinations and that all ten-digit numbers have almost half-trillion combinations).

See infra note 166 and accompanying text (examining decreasing supply of telephone numbers).

See also Dranoff-Peristein, supra note 7, at 857 (articulating concern that if generic terms are protectible, first firm in given market to obtain telephone number would gain unfair advantage over its competitors).

But see Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300, 1305-06 (1995) (rejecting argument that pure colors should not be protected on grounds that there is limited supply of color and responding that there would generally be alternative available and that occasional risk that color would not be available should not justify blanket prohibition, especially in light of availability of "functionality doctrine" to keep a competitor from retaining functional element of product as trademark). Unlike in the context of colors, telephone mnemonics have more inherent technological barriers to alternatives. For example, while there will occasionally be limitations on what colors can be used on a certain product in a given industry, a finite number of mnemonics exist for use by all industries regardless of the product. Also, if one industry has appropriated a color as a trademark, another unrelated industry can still use the color as a trademark as long as there is no likelihood of confusion between the products. Once a mnemonic is chosen, it cannot be used
When comparing telephone mnemonics, it is important to note that many businesses already have telephone numbers in which they have a business interest. This pre-existing interest restricts the number of mnemonic options. The courts should consider not only that most telephone numbers have already been appropriated, but also that some businesses have a vested interest in the number that they are currently using and therefore choosing another number to obtain a mnemonic is not an option.

The independent interest that companies have in other marks which can act as telephone mnemonics complicates the analysis. Those companies with established trademarks have an interest in the associated telephone mnemonic. For example, Firestone, the tire company, has an interest in the 1-800-FIRESTONE telephone number. As the cases above illustrate, Firestone could keep a company from using the mnemonic, but it could not obtain the use of the number through a trademark suit. The superior interest in the number of both the telephone company and the current user prevent ownership of the trademark “Firestone” from allowing its use as a telephone mnemonic. This phenomenon makes the telephone number itself valuable, even if it is not used in association with an advertised mnemonic. The question becomes whether the mnemonic itself is protected or the underlying telephone number. One telephone number has value to multiple companies because each number gives rise to many mnemonics. If the underlying number is being protected as opposed to the mnemonic, as the Second Circuit tried to do, then more mnemonics will be affected by the decision to protect one number.

by any other industry within the same geographic area (for local numbers) or even nationwide (for 800 numbers). The Qualitex reasoning on the depletion of alternatives argument is not persuasive in the context of mnemonics. One of the justifications of the rejection of the depletion argument was the “functionality doctrine,” which is unavailable to mnemonics. A mnemonic will never be an element or function of the underlying product such that the law of patent would be the appropriate type of protection because the product and the mnemonic are completely unrelated.

See supra notes 72-77 and accompanying text (discussing need for change in telephone technology prompted by businesses' need for portability).

See supra notes 82-81 and accompanying text (addressing cases dealing with proprietary rights in numbers).


See supra notes 117-123 and accompanying text (discussing Second Circuit position).
If mnemonics serve as trademarks, the owner in essence has a right to the underlying telephone number, subject only to the superior rights of the telephone company. Therefore, a company should be able to achieve a trademark in a telephone number that is not associated with a mnemonic. Bare telephone numbers are rarely granted protection, but the Second Circuit cases may indicate a trend towards such protection. If a telephone number itself can be the subject of a trademark, could a trademark owner prevent a subsequent user or a user in a different area code from advertising the telephone number for its business? Under the analysis used by the courts today, there is no reason that a business could not restrict the behavior of its competitor in this way. These concerns implicate communications law in a way that has not been addressed by the courts. The severity of the impact of allowing a telephone number to be protected counsels caution against protecting mnemonics.

A separate problem results from the technology behind telephones: the slight variation problem. For example, in Bell v. Kidan, the court distinguished the marks “Call-Law” and “Law-Call” in that one mnemonic was associated with a toll-free number while the other was a toll call. This case illustrates that the impact of a slight change in the mark is even more acute in the case of mnemonics because the change of one digit has a functional impact on the telephone number itself. Because the letters correspond to specific numbers on the telephone dial, any change in the term results in a different telephone number and hence a different business. If any change in a mnemonic results in knowledge by the consumer that they will be reaching a different

171 See supra notes 103-123, 144-152 and accompanying text. Contra Chicago Blackhawk Hockey Team v. Madsen, No. 90-C5833, 1991 U.S. Dist. LEXIS 1720 (N.D. Ill. Feb. 7, 1991) (refusing to enjoin defendant's use of bare telephone number that had previously been used by both plaintiff and defendant in conjunction with mnemonic).

172 The analysis in Chicago Blackhawk, supra note 171, illustrates an effective distinction between the mnemonic and the underlying telephone number. See supra notes 118-120 and accompanying text.

173 See supra notes 108-120 and accompanying text (discussing U-Haul litigation as example of slight variation problem).


175 Bell, 836 F. Supp. at 127.
telephone number, protecting the mnemonic causes no reduction in the likelihood of confusion.

Unlike slight changes in serial numbers, mnemonics containing slight variations do not create the impression that the goods associated with the mark are in a series. 176 However, if a mnemonic is being used in such a way as to intentionally deceive the customers of the first user and pass off the business of the second as the business of the first, unfair competition protects the mark without giving the user the broad protection allowed under trademark law. For example, in Mini Maid Services Co. v. Maid Brigade Systems, Inc., 177 the defendant's franchisee obtained the telephone number of a competitor and was receiving business from an advertisement in the Yellow Pages that associated the telephone number with the plaintiff's franchisee's business. 178 Although the court held that the franchisor might not be liable for the actions of its franchisee, the defendant's franchisee was not allowed to engage in that behavior. 179

Some courts faced with the slight variation problem compare those parts of the mark that are different (comparing the "-1" and "-9" in "INJURY-1" and "INJURY-9"). Under this system, no mnemonic will ever be protected because each telephone number is unique. Another company could never obtain the exact same trademark because there would at least be a different area code. If there are two local numbers at odds, the difference in the geographic area based on the area code serves as a distinguishing factor.

Complementary numbers permute the slight variation problem in this context. 180 An example of complementary numbers is O (the letter) and 0 (zero), which correspond to different numbers on

176 See supra notes 32-37 and accompanying text (describing risk of giving impression that series is involved).
177 967 F.2d 1516 (11th Cir. 1992).
178 Id. at 1518.
179 Id.
180 "A complementary number is a euphemism for a misdialed number—except it is a misdialed number which can be easily predicted." Holiday Inns, Inc. v. 800 Reservation, Inc., 838 F. Supp. 1247, 1250 (E.D. Tenn. 1993).
the telephone keypad. 181 If the defendant is not using the mark for the purpose of deceiving the public, but to exploit pre-existing customer confusion and misdialing, is there a trademark violation? In Holiday Inns, Inc. v. 800 Reservation, Inc., 182 the user of 1-800-HOLIDAY sued the user of 1-800-H[zero]LIDAY for trademark infringement. The court found both trademark violation and unfair competition. In the view of the court, the fact that the defendant did not create the confusion, only anticipated it, supported a finding that there was an infringement. 183 This case distorts trademark theory by not requiring a finding of a likelihood of confusion as a result of the introduction of the second mark. The defendant was not even using the mark in advertising, but rather taking advantage of existing misdialing. It also exemplifies how unfair competition can be used to effectively protect a mnemonic from genuinely improper business practice.

The use of telephone mnemonics and serial alphanumerics correlate in that for both, the mark is generally advertised along with another mark of the company, thereby diluting the use of the mark as an indicator of origin. For example, advertisements for American Express utilizing 1-800-THE-CARD use the American Express mark as the prominent feature in the advertising with the mnemonic as a way to reach the company. The mnemonic associates the telephone number with the company, not the product or service itself.

Courts following Cytanovich Reading Center v. Reading Game 184 began to protect telephone mnemonics as trademarks under the traditional “likelihood of confusion” analysis without

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181 Complementary numbers also create a practical problem for the companies using Os in their mnemonics. The Sprint Corporation has taken out two telephone numbers to match the mnemonic 1-800-PINDROP, one which uses a zero for DROP and one which uses the number six, which corresponds to the letter “O” on the telephone keypad. Barry Meier, Vanity Phone Numbers can Fluster Callers, HOUS. CHRON., July 15, 1992, at 1. In fact, because of the phenomenon of complementary numbers, “some long distance carriers encourage their clients to subscribe to both the vanity and complementary numbers.” Holiday Inns, 838 F. Supp. at 1250.


183 Id. at 1255; but see Rocky Mtn. Bell Tel. Co. v. Utah Ind. Tel. Co., 88 P. 26, 27 (Utah 1906) (finding it unlikely that new telephone company organized its system to take advantage of misdialed numbers).

inquiry into whether these mnemonics could function as a trademark, much less whether they should function as trademarks.\textsuperscript{185} Because the first business to get a telephone mnemonic can thereby preempt its use by other businesses holding similar or identical telephone numbers, the first entrant obtains an unfair advantage without a corresponding benefit to the public in reducing confusion among goods.\textsuperscript{186} Safeguards against the use of trademarks to obtain an unfair advantage should be incorporated into the analysis of telephone mnemonics. The analysis of serial alphanumeric marks provides some guidance on ways to protect those mnemonics which are truly designating origin while weeding out those marks which are not.

Telephone mnemonics have many traits in common with the serial number functions of alphanumeric trademarks. Both become entirely different symbols with the change of one digit, a rare occurrence for traditional word marks.\textsuperscript{187} As with serial numbers, the ordinary consumer can recognize that any change in the mnemonic should correspond to a different product. Also, both marks by nature describe the product or service. Alphanumeric serial numbers, even those which do not correspond to specific characteristics of the product, have been held to be descriptive because their function is to distinguish between the products of one manufacturer. Similarly, mnemonics generally utilize a generic term because their function is to associate the product and the telephone number in the mind of the customer \textit{i.e.}, 54-PIZZA, when the customer is hungry. This generalization does not always hold true, but it is a feature of mnemonics which is more like a serial number than a traditional word mark, even though the mnemonic may utilize words. These similarities illuminate which protections should be transferred from the realm of serial alphanumericics to telephone mnemonics.

\textsuperscript{185} See Dranoff-Perlstein Assoc., 967 F.2d at 856 (3d Cir. 1992) (allowing protection of mnemonic if it performed traditional function of indicating source and if it met other qualifications of trademark law, \textit{i.e.}, if it was not generic.).

\textsuperscript{186} Id. at 857. This is especially true if one accepts the proposition of the Dranoff-Perlstein court that many companies frequently promote their telephone numbers as the primary access to their business as well as a crucial means of source identification. \textit{Id.} at 856.

\textsuperscript{187} See supra notes 33-36 and accompanying text (discussing this phenomenon in relation to traditional alphanumericics).
Because telephone mnemonics contain the flaws described above, they should not be given protection lightly. The treatment given to serial alphanumeric marks suggests a possible solution.

The presumptive descriptiveness of serial alphanumeric marks should be applied to telephone mnemonics. The presumption operates for model designations because they inherently function to describe the product and distinguish it from other products made by the same manufacturer. In addition, serial marks generally are not used without other house marks. Similarly, telephone mnemonics are inherently descriptive. These marks describe the telephone number of the company, not the product or service. In fact, mnemonics are more descriptive than model numbers because they are descriptive in their function. They are designed to tell the consumer specific information about the company while model numbers are at least arbitrarily chosen and usually do not have any actual relationship to the qualities of the product or the business.

By making mnemonics presumptively descriptive, they would be protected only after an affirmative showing that the mark functions as a trademark. Protection for traditional word marks categorized as arbitrary or suggestive occurs without any showing that the mark indicates origin. Because of the limited number of available alternatives, only those mnemonics which are actually functioning to indicate origin should be protected as trademarks. By creating the presumption of descriptiveness, only those marks which already indicate the origin of the product will be protected. As noted above, there is a very tenuous line between those marks which are suggestive and those which are descriptive. Many mnemonics will be technically “suggestive” because of the nature of the mnemonic (i.e., the limited number of alternatives demands that the mark user be creative and use imagination in creating a mnemonic). This dynamic will create a situation when there are too many protected mnemonics, depleting the available advertising alternatives for competitors. The presumption of descriptiveness should include a presumption that as between a determination in favor of suggestiveness or descriptiveness, a mnemonic is descriptive.

In addition to this presumption, the view of the Third Circuit
should be adopted with regard to generic marks. No generic mnemonics should ever be allowed to be protected as trademarks for the reason given above: limited alternatives.

Finally, several additional factors should be considered when deciding if a mark is being used as an indicator of origin. The use of other marks in connection with the mnemonic should be given more weight in determining descriptiveness. Business advertising of a house mark with the mnemonic indicates that the mnemonic is being used to associate the telephone number and not the product itself. Advertising alone does not create trademark rights. The use of a mnemonic, which is not used on the product or service itself, with a mark that is more directly connected with the product should keep the mnemonic from being protected.

If the mark is being licensed to other companies, it should not be protected. For example, the companies that reserved toll-free numbers associated with a mnemonic dealing with pizza and plumbing should not be able to prevent other firms from using similar marks. Because they could predict that this mark would be useful to all firms in a given business, the mark should be conclusively generic and not worthy of trademark protection. The mnemonic clearly indicates the product or the licensor would not have reserved the number.

Finally, in the context of slight variations, any change in the mnemonic should be enough to distinguish the marks. As noted above, any change in a mnemonic is a functional change in the operation of the telephone which will be noticed by the consumer. Clearly any change in a mnemonic will be a change in the underlying telephone number. In order to prevent a firm from monopolizing a group of numbers through the luck of being the first to get to a telephone number, slight variations should distinguish the second mark.

Telephone mnemonics are a relatively new development in advertising and the legal implications of these marks have not yet been completely worked out. The fact that mnemonics correspond to actual telephone numbers after a conversion using a telephone keypad counsels that these marks be treated differently. The courts have not yet addressed the technological limitations on mnemonics such as the limited number of alternative marks and the functional impact of a slight change in the mark. Some courts
have summarily rejected trademark protection while others have granted overly broad protection. In order to allow effective competition through the use of telephone mnemonics, the courts need to address their functional restrictions in light of the overriding purpose of trademark law to promote competition.

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