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J. Michael Monahan

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## Waiting by the Phone: Why Telephone Number Mnemonics Warrant Trademark Protection

Telephone number mnemonics, hereinafter referred to as mnemonics, are an increasingly popular method of advertising a business' phone number by utilizing the letters on the telephone keypad to spell words or short phrases. Many businesses in the information age have used mnemonics to distinguish their phone numbers, and corresponding services, from competing numbers.<sup>1</sup>

Mnemonics are popular with many businesses, because a seven letter word is easier for the average consumer to remember than a seven digit number.<sup>2</sup> In many industries, telecommunications is the primary link between the consumer and the producer.<sup>3</sup> Hot lines, telephone psychics, phone sales, and long distance phone services are but a few of the businesses conducted solely over the telephone. Consumers in these markets do not go to a store or other traditional outlet to conduct business. Often, these consumers only know of the business by the telephone number.<sup>4</sup> For these intangible players, the mnemonic is a powerful marketing tool.

So widely used are these marketing tools, that, as phone sales, hot lines, and other telecommunications-based markets have expanded, the traditional toll-free means of communication, the 1-800 phone number, has been exhausted. In order to keep up with the demand for toll-free telecommunications, the Federal Communications Commission has had to approve a new toll free area code, 1-888.<sup>5</sup>

The saturation of the business world with telecommunications-driven markets has created an interesting problem in trademark law. Simply put, the question is: can these mnemonics be protected as trademarks? The federal circuits have split over this issue for a variety of reasons. The Second Circuit Court of Appeals, in *Dial-A-Mattress Franchise Corp. v. Page*,<sup>6</sup> found these mnemonics worthy of trademark protection, but did not evaluate the strength of the mark presented.<sup>7</sup> The Third Circuit Court of Appeals, in *Dranoff-Perlstein Associates v. Sklar*,<sup>8</sup> found that such mnemonics are not subject to trademark

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1. Some examples include 1-800-COLLECT (MCI's collect calling service), 1-800-CLARITIN (an information hot line for the prescription drug Claritin), and of course 1-800-FLOWERS (a nationwide delivery network for floral arrangements).

2. *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 676 (2d Cir. 1989).

3. 1-800 COLLECT (MCI's collect calling service), 1-800-THE-CARD (American Express' phone application number for the American Express Card), and 1-800-GO-U-HAUL (U-Haul's nationwide reservation number) are but a few examples of these numbers as important links between consumer and provider. See *infra* text accompanying notes 56-57 and 204-206.

4. For example, 1-800-FLOWERS is both the name of that business and its telephone number. The mnemonic is not associated with any other identifying name or symbol.

5. United Communications Group Telecommunications Alert, "888 Begins Today" (March 1, 1996).

6. *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 678 (2d Cir. 1989).

7. See *infra* text accompanying notes 131-151.

8. 967 F.2d 852, 857 (3d Cir. 1992).

protection when they utilize generic terms. Recently, the Sixth Circuit Court of Appeals joined the fray, while deciding another issue,<sup>9</sup> in *Holiday Inns Inc. v. 800 Reservation Inc.*<sup>10</sup>

This paper evaluates the mnemonic as a trademark and addresses the narrow issue of whether mnemonics that spell generic terms should be protected under trademark law. In Part I, unfair competition is investigated as a concurrent means of protecting this new marketing implement. Part II reviews the tools available under current trademark law and how they can be applied to mnemonics. The treatment of mnemonics in the federal circuits is the subject of Part III, and Part IV addresses other scholars' comments on mnemonics as trademarks. Finally, Part V offers guidelines as to how trademark law and unfair competition law can be used to protect mnemonics, particularly those that spell out generic terms.

### I. UNFAIR COMPETITION AS A MEANS OF PROTECTION

Unfair competition is a commercial tort used by courts to regulate the morality of the competitive model.<sup>11</sup> Beyond that, it is difficult to define.<sup>12</sup> While trademark protection focuses on similarities in the marks held by the parties, unfair competition looks to the totality of the evidence.<sup>13</sup> The law of unfair competition has remained broad in order to provide courts with a flexible tool. Unfair competition has been able to adapt to the changing business world, because it allows courts a great deal of discretion to determine what sorts of practices are acceptable.<sup>14</sup> What constitutes unfair competition is generally determined on a case-by case basis.<sup>15</sup>

Like any other tort claim, claims of unfair competition must set forth an injury caused by the defendant.<sup>16</sup> Once that has been shown, the court can use the flexible tool of unfair competition to determine if the defendant's actions were "unfair."<sup>17</sup> Conduct is considered "unfair" when it involves fraud, misrepresentation, deception, breach of fiduciary duty, or comparably unethical conduct.<sup>18</sup> Practices that "offend public policy" or are "immoral, unethical, oppressive, unscrupulous, or substantially injurious to consumers"<sup>19</sup> are also deemed "unfair." While the breadth of these modifiers gives a court plenty of room to

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9. See *infra* text accompanying notes 172-197.

10. 86 F.3d 619 (6th Cir. 1996).

11. J. Thomas McCarthy, *Trademarks and Unfair Competition* § 1:3, at 12 (2d ed. 1984).

12. *Id.*

13. See *Corporate Risk Int'l Inc. v. Assicurazioni Generali*, No. 95-1440-A, 1996 U.S. Dist. LEXIS 19720, at \*7 (E.D.Va. March 15, 1996).

14. McCarthy, *supra* note 11, §§ 1:3-1:4, at 12-16.

15. *Faris Wyatt v. PO2, Inc.*, 651 So. 2d 359, 361 (La. App. 2d Cir. 1995).

16. McCarthy, *supra* note 11, § 1:12, at 28.

17. *Gilbert/Robinson Inc. v. Carrie Beverage-Missouri Inc.*, 758 F. Supp. 512, 527 (E.D. Mo. 1991).

18. *Wyatt*, 651 So. 2d at 361.

19. *Id.*

maneuver, their vagueness places a significant burden upon the plaintiff in an unfair competition claim.

To prevail on an unfair competition claim, a plaintiff must first prove he was injured commercially, and then prove that the injury was caused by the unfair actions of the defendant. In the commercial arena, injuries are generally lost profits which are tremendously difficult to attribute to any one competitor and his actions.<sup>20</sup> Assuming that the plaintiff can overcome this burden, he must then argue that the defendant's actions that caused this injury were "unfair."<sup>21</sup>

Unfair competition is easier to define by example than in the abstract.<sup>22</sup> Among things labeled unfair competition are: trademark infringement; use of similar corporate, business or professional names; simulation of product configuration; simulation of trade dress; "palming off" goods by substituting one brand for the brand ordered; and theft of trade secrets.<sup>23</sup> These individual torts are all species within the genus of unfair competition.<sup>24</sup>

Claims of unfair competition are available at both the state and federal levels. At the state level, laws against unfair trade practices exist in all fifty states and the District of Columbia.<sup>25</sup> At the federal level, Section 43(a) of the Lanham Act<sup>26</sup> provides a federal statutory unfair competition tort, *sui generis*.<sup>27</sup>

A number of state statutes can be utilized to address unfair competition. Many states have adopted laws based on the Uniform Deceptive Trade Practices Act.<sup>28</sup> These provisions provide relief for passing off, disparagement, use of false designations of origin, and other forms of unfair competition.<sup>29</sup> States also prohibit unfair competition through consumer protection statutes, closely modeled on Section 5 of the Federal Trade Commission (FTC) Act,<sup>30</sup> which are designed to protect the public against both unfair competition and deceptive trade practices.<sup>31</sup>

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20. McCarthy, *supra* note 11, § 1:12, at 29.

21. Gilbert, 758 F. Supp. at 527.

22. McCarthy, *supra* note 11, § 1:5, at 16.

23. *Id.* at 16-17.

24. *Id.* at 17.

25. Restatement (Third) of Unfair Competition § 1 statutory note (1995).

26. 15 U.S.C. § 1125(a) (1995).

27. Doris E. Long, *Unfair Competition and the Lanham Act* 17 (1993).

28. See, e.g., Colo. Rev. Stat. Ann. §§ 6-1-101 to -114 (West 1996); Del. Code Ann. tit. 6, §§ 2531-2537 (1993); Ga. Code Ann. §§ 10-1-370 to -375 (1994); Haw. Rev. Stat. §§ 481A-1 to -5 (Michie 1995); 805 Ill. Comp. Stat. Ann. 510/1-510/7 (West 1993); Me. Rev. Stat. Ann. tit. 10 §§ 1211-1216 (West 1964); Minn. Stat. Ann. §§ 325D.43-48 (West 1995); Neb. Rev. Stat. §§ 87-301 to -306 (1994); N.H. Rev. Stat. Ann. § 358A (1995); N.M. Stat. Ann. §§ 57-12-1 to -22 (Michie 1978); Ohio Rev. Code Ann. §§ 4165.01-.04 (Banks-Baldwin 1995); Okla. Stat. tit. 78, §§ 51-55 (West 1995); Or. Rev. Stat. §§ 646.605-.656 (1987); R.I. Gen. Laws §§ 6.13.1-1 to -19 (1992); Tex. Bus. & Com. Code §§ 17.41-.826 (West 1987).

29. Long, *supra* note 27, at 332.

30. 15 U.S.C. § 45 (1997).

31. Long, *supra* note 27, at 333. See, e.g., Alaska Stat. §§ 45.50-471 to -561 (Michie 1996); Ariz. Rev. Stat. Ann. §§ 44-1521 to -1534 (West 1994); Ark. Code Ann. §§ 4-88-101 to -112 (Michie 1996); Cal. Bus. & Prof. Code §§ 17000-17101 (West 1997); Colo. Rev. Stat. Ann. §§ 6-2-101 to -117

Whether at the state or federal level, unfair competition claims compliment trademark infringement claims nicely. In the realm of mnemonic marks, unfair competition may be used to protect mnemonic users who are not able to achieve trademark rights. For instance, mnemonics that spell generic terms are likely to be held unprotectable as generic marks, particularly in the Third Circuit.<sup>32</sup> Other mnemonic holders may seek redress for a competitor's use of a confusingly similar phone number, but not a mnemonic. Both of these situations might well be beyond the scope of trademark protection available to mnemonics, but they could be remedied by unfair competition actions.

While the broad genus of unfair competition offers uncertainty to a mnemonic holder seeking to protect his mnemonic from competitors, one of its species, "passing off," is an especially viable means of protection. "The gravamen of unfair competition is passing off one's own goods or services as those of another amounting to fraud."<sup>33</sup> Passing off has long been recognized as a means of relief at common law.<sup>34</sup> Passing off is generally a misrepresentation of a product's origin.<sup>35</sup> There are no technical requirements as to how the misrepresentation is made.<sup>36</sup> It may happen at the point of sale through labels or packaging, or in advertisements via radio, TV, or catalogs.<sup>37</sup> It may be written, oral, or even inferred from a competitor's conduct.<sup>38</sup> With such a broad range of vehicles for passing off, use of a telephone number could certainly be a means of deceiving consumers.

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(West 1996); Conn. Gen. Stat. §§ 42-110a to -110q (West 1992); Del. Code Ann. tit. 6, §§ 2511-2527 (1993); D.C. Code Ann. §§ 28-3901 to -3909 (1996); Fla. Stat. Ann. §§ 501.201 to .213 (West 1997); Ga. Code Ann. §§ 10-1-390 to -407 (1994); Haw. Rev. Stat. Ann. § 480-2 (Michie 1995); Idaho Code § 48-601 (1977); 815 Ill. Comp. Stat. Ann. 505/1-505/12 (West 1993); Kan. Stat. Ann. §§ 50-623 to -643 (1994); Ky. Rev. Stat. Ann. § 367 (Banks-Baldwin 1995); La. R.S. 51:1401-1418 (1987); Me. Rev. Stat. Ann. tit. 5, §§ 206-214 (West 1964); Md. Code Ann. Com. Law §§ 13-301 to -316 (1996); Mass. Ann. Laws ch. 93A, §§ 1-11 (Law Co-op. 1994); Mich. Comp. Laws Ann. §§ 445.901-.922 (West 1989); Miss. Code Ann. §§ 75-24-1 to -131 (1972); Mo. Ann. Stat. §§ 407.010 to .020 (West 1990); Mont. Code Ann. § 30-14-101 (1995); Neb. Rev. Stat. §§ 59-1601 to -1623 (1993); N.H. Rev. Stat. Ann. §§ 358-A:1 to A:13 (1995); N.J. Stat. Ann. §§ 56:8-1 to -48 (West 1989); N.M. Stat. Ann. § 57-12-2 (Michie 1970); N.Y. Gen. Bus. Law § 349 (McKinney 1988); N.C. Gen. Stat. § 75-1.1 (1994); N.D. Cent. Code ch. 51-10 (1989); Ohio Rev. Code Ann. ch. 1345 (Banks-Baldwin 1993); Okla. Stat. Ann. tit. 15, §§ 751-789 (West 1993); Pa. Stat. Ann. tit. 73, §§ 201-1 to 9.2 (West 1993); S.C. Code Ann. §§ 39-5-10 to -5-160 (Law Co-op. 1976); S.D. Codified Laws § 37-24-6 (Michie 1994); Tenn. Code Ann. §§ 47-18-101 to -18-121 (1995); Utah Code Ann. §§ 13-5-1 to -5-18 (1995); Vt. Stat. Ann. tit. 9, §§ 2451-2462 (1993); Va. Code Ann. §§ 59.1-196 to .1-207 (Michie 1992); Wash. Rev. Code Ann. §§ 19.86.010-.920 (West 1989); W. Va. Code § 46A-6-101 to -110 (1996); Wis. Stat. Ann. § 100.20 (West 1997); Wyo. Stat. Ann. §§ 40-12-101 to -12-112 (Michie 1997).

32. See *infra* text accompanying notes 152-171.

33. T.G.I. Friday's, Inc. v. International Restaurant Group, Inc., 569 F.2d 895, 899 (5th Cir. 1978).

34. Long, *supra* note 27, at 213-14.

35. Restatement (Third) of Unfair Competition § 4 (1995).

36. Restatement (Third) of Unfair Competition § 2 cmt. g (1995).

37. *Id.*

38. *Id.*

Passing off, like many forms of unfair competition, is much broader in scope than trademark infringement.<sup>39</sup> Most elements of trademark infringement are also relevant to unfair competition.<sup>40</sup> For instance, both trademark infringement and unfair competition can arise from the use of a similar mark. In unfair competition, however, use of such a mark is probative of intent.<sup>41</sup> While intent is neither necessary for, nor conclusive of, unfair competition, it is probative of unfair competition and thus relevant.<sup>42</sup> On the other hand, intent is irrelevant to trademark infringement.<sup>43</sup> An unfair competition claim can succeed where one for trademark infringement would fail. If a competitor intends "to ensnare buyers by use of a similar mark, he may be unsuccessful enough at his simulation to be free of liability under the trademark laws."<sup>44</sup> His intent to fool buyers may, however, be probative of unfair competition and therefore allow a successful unfair competition claim.<sup>45</sup> Because unfair competition can act as this "safety net," the claims compliment each other, particularly in the uncertain field of mnemonic marks.

A claim for passing off would help mnemonic holders in those jurisdictions where mnemonics that spell generic terms are not protected.<sup>46</sup> Even though these jurisdictions will not allow trademark protection because they deem such a mark generic, this holding does not foreclose a claim for unfair competition.<sup>47</sup> In these jurisdictions the practitioner may be forced to rely on unfair competition in lieu of trademark protection.

Those jurisdictions that might protect a mnemonic utilizing a generic term<sup>48</sup> will still only protect a mnemonic from a limited form of infringement.<sup>49</sup> If a holder of a mnemonic mark is faced with a competitor who is using a similar phone number but is not advertising it as a mnemonic, or a competitor whose mnemonic is similar but not confusingly so, that holder will not likely prevail in an action for trademark infringement. Because unfair competition encompasses a wide range of practices generally described as a misappropriation of the skill, expenditures and labor of another,<sup>50</sup> the mnemonic holder may still prevail under an unfair competition theory.

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39. B.H. Bunn Co. Inc. v. AAA Replacement Parts Co., 451 F.2d 1254, 1264 (5th Cir. 1971).

40. *Id.*

41. *Id.*

42. *Id.*

43. *Id.*

44. *Id.*

45. *Id.*

46. Such as the Third Circuit Court of Appeals. See *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 857 (3d Cir. 1992).

47. *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 102 (2d Cir. 1989).

48. Such as the Second Circuit Court of Appeals. See *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989).

49. See *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996).

50. See *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 662 (2d Cir. 1979).

## II. TRADEMARK PROTECTION IN GENERAL

Trademark law is a subset of the general law of unfair competition.<sup>51</sup> While unfair competition focuses on the bad faith of and confusion created by a competitor, trademark law focuses on protecting certain rights generated through commercial marks,<sup>52</sup> regardless of the intent of the infringing mark holder.

Both consumers and producers benefit from trademarks. Trademarks are identifying devices that inform the consumer of the identity of the producer of the good or service marked.<sup>53</sup> They also act as a symbol of quality. Trademarks guarantee to the consumer that all goods that carry the same mark are of the same quality.<sup>54</sup> Therefore, if a consumer enjoys his experience with a good or service and notices its mark, he will select similarly marked items the next time he needs that good or service. When that mark is protected from confusingly similar marks, the consumer is assured that he will get consistent quality from other goods or services carrying a familiar mark.<sup>55</sup> Moreover, if he is dissatisfied with a marked good or service, the consumer can easily seek redress from the producer, because the trademark identifies the source of that good or service.

Mnemonics often fulfill these same roles. As a clever label for a phone service, mnemonics identify the source of that service. In industries where much of the consumer's interaction with the producer is over the phone, the mnemonic acts as a system of quality control, because it is a consistent identifier of the source of that service.

1-800-COLLECT, MCI's collect calling service, is an excellent example of how mnemonics serve this dual function. A consumer who needs to make a collect call does not go to a store to purchase such a service. His choice is made as he faces the phone and dials one of the variety of numbers that will connect him to a collect call server.<sup>56</sup> When he dials 1-800-COLLECT, he has chosen one among many sources, perhaps as a result of MCI's massive advertising of the mnemonic. If his experience with the service is satisfactory, he will associate the good experience with the mnemonic. In fact, he has no other mark to associate with the experience, because, unlike traditional goods and services, he can use the service from any phone anywhere. There are no signs or storefronts to carry marks with which to associate the service. His only identifiable link with the producer is the mnemonic. The mnemonic both denotes the source of the service and guarantees consistent quality. In short, 1-800-COLLECT has fulfilled both of these trademark functions.

Not all mnemonics fit the trademark mold so neatly. Many industries do not use phone sales or phone services as the focus of their business, but still use

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51. *Freedom Sav. and Loan Ass'n v. Way*, 583 F. Supp 544, 552 (M.D. Fla. 1984).

52. McCarthy, *supra* note 11, § 2:2, at 51.

53. McCarthy, *supra* note 11, § 3:2, at 107.

54. McCarthy, *supra* note 11, § 3:4, at 111-12.

55. McCarthy, *supra* note 11, § 3:4, at 113.

56. Such numbers include 1-800-COLLECT, 1-800-CALL-ATT, 1-800-PIN-DROP (Sprint).

mnemonics. These businesses will have some difficulty protecting their mnemonic as a trademark, because it is not acting as a trademark.<sup>57</sup> Others whose mnemonic marks are weak may also have difficulty distinguishing their mnemonics from others. Furthermore, competitors may infringe on a mnemonic mark yet not fall into the narrow scope of trademark infringement.<sup>58</sup> In these situations, unfair competition law remains available as a means of protection from unscrupulous competitors.

Trademark cases are often very similar to unfair competition cases because of trademark law's relationship to the law of unfair competition.<sup>59</sup> Unfair competition looks beyond the competing marks at all aspects of the parties' selling efforts.<sup>60</sup> Unfair competition, however, generally focuses on the unfairness of the totality of the defendant's acts.<sup>61</sup> In trademark law, only the exclusive symbol held forth as a trademark and the competing mark are used to determine whether or not consumers will likely be confused.<sup>62</sup> Trademarks have some aspects of property ownership, such as a right to exclude other users of a mark, but are not viewed solely as property.<sup>63</sup>

Trademarks are created and regulated throughout the United States by the Lanham Trademark Act of 1946.<sup>64</sup> Using its power to regulate interstate commerce, Congress granted substantive and procedural rights in trademarks and against unfair competition.<sup>65</sup> The procedural right is in the form of federal registry with the Patent and Trademark Office.<sup>66</sup> Substantive rights, which are available to both registered and unregistered marks,<sup>67</sup> are governed by the use of trademark infringement<sup>68</sup> or unfair competition claims.<sup>69</sup>

Because the status of mnemonics as trademarks is currently dubious, most, if not all, claims of infringement of a mnemonic will be brought by holders of unregistered mnemonic marks. Section 43(a) of the Lanham Act provides the holder of an unregistered trademark an action against competitors who have confused or are likely to confuse the consumer through the use of a mark that is the same or substantially similar to the holder's.<sup>70</sup> Any claim for trademark

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57. See *infra* text accompanying notes 202-205.

58. See *infra* text accompanying notes 172-196.

59. *Freedom Sav. & Loan Ass'n v. Way*, 583 F. Supp. 544, 552 (M.D. Fla. 1984).

60. *McCarthy*, *supra* note 11, § 2:2, at 53.

61. See *National Artists Management Co. v. Weaving*, 769 F. Supp. 1224, 1230 (S.D.N.Y. 1991).

62. *McCarthy*, *supra* note 11, § 2:2, at 52.

63. *Union Nat'l Bank of Texas, Laredo v. Union Nat'l Bank of Texas, Austin*, 909 F.2d 839, 843 (5th Cir. 1990).

64. 15 U.S.C. §§ 1051-1123 (Supp. 1997).

65. *McCarthy*, *supra* note 11, § 5:4, at 141.

66. 15 U.S.C. § 1051 (Supp. 1997).

67. 15 U.S.C. §§ 1051, 1123, 1125 (Supp. 1997).

68. 15 U.S.C. § 1123 (infringement of registered marks); 15 U.S.C. § 1125(a) (Supp. 1997) (infringement of unregistered marks).

69. 15 U.S.C. § 1125(a).

70. Section 43 of the Lanham Act provides:



infringement must satisfy two requirements. First, the plaintiff must establish that his mark is capable of protection.<sup>71</sup> Second, he must establish that, because of the infringer's actions, there is a likelihood of confusion in the market between his goods and the infringer's goods.<sup>72</sup> It is the first stage that relies on the four categories of distinctiveness.

#### A. The Four Categories of Distinctiveness

"The threshold issue in any action for trademark infringement is whether the word or phrase is [protectable]."<sup>73</sup> Not all marks are subject to protection, and those that are protected fall into a hierarchy of distinctiveness.<sup>74</sup> The courts have delineated four categories of marks to determine distinctiveness of a trademark and its subsequent protection.<sup>75</sup> These categories are, from strongest to weakest: (1) arbitrary or fanciful; (2) suggestive; (3) descriptive; and (4) generic.<sup>76</sup> These categories "tend to blur at the edges" and are "more advisory than definitional."<sup>77</sup> Nonetheless, the court's categorization of a mark will dictate whether and to what extent it can be protected.

Arbitrary, fanciful, and suggestive marks are protected automatically, without any showing of secondary meaning.<sup>78</sup> Descriptive marks can only be protected

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,  
shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C.S. § 1125(a) (Supp. 1997).

71. Registration creates a presumption of validity, so those actions under § 32 often go straight to the second element. 15 U.S.C.S. § 1123 (Supp. 1997).

72. *Tripleedge Prods. Inc. v. Whitney Resources Ltd.*, 735 F. Supp. 1154, 1161 (E.D.N.Y. 1990); *Gilbert/Robinson Inc. v. Carrie Beverage-Missouri Inc.*, 758 F. Supp. 512, 521 (E.D. Mo. 1991).

73. *Zatarains Inc. v. Oak Grove Smokehouse, Inc.* 698 F.2d 786, 790 (5th Cir. 1983).

74. *Id.*

75. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852 (3d Cir. 1992). See also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) and *Zatarains Inc. v. Oak Grove Smokehouse Inc.*, 698 F.2d 786, 790 (5th Cir. 1983).

76. *Dranoff-Perlstein*, 967 F.2d at 855.

77. *Zatarains*, 698 F.2d at 790.

78. *Dranoff-Perlstein*, 967 F.2d at 859 (quoting *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986)).

if they have developed secondary meaning.<sup>79</sup> Generic marks are those marks that are so descriptive that they cannot acquire secondary meaning and are therefore unprotectable.<sup>80</sup>

The most important result of categorization is whether the mark will require a showing of secondary meaning in order to receive protection. "The concept of secondary meaning recognizes that words with an ordinary and primary meaning of their own 'may by long use with a particular product, come to be known by the public as specifically designating that product.'"<sup>81</sup> Quite simply, secondary meaning is the association, made by the public, of the mark with the product.<sup>82</sup> Secondary meaning can only be generated by continuous and exclusive use of the mark in commerce.<sup>83</sup> This shift in the public perception is unnecessary for arbitrary, fanciful, and suggestive marks and is irrelevant to generic marks, but is pivotal for descriptive marks to be protected.<sup>84</sup> Secondary meaning also delineates the limits of protection.<sup>85</sup>

The strongest of the four categories is comprised of those marks which are arbitrary or fanciful. Marks that fall into this category are always protected in the geographic and product markets of relevance.<sup>86</sup> Arbitrary marks are those marks that utilize an existing dictionary word to identify a product, but use the term out of its normal context.<sup>87</sup> Arbitrary terms "bear no relationship to the products or services to which they are applied."<sup>88</sup> Because the term is not normally associated with the product, only that association generated by its use in commerce can exist. "Tiger," used as a mark for hot sauce, is an example of an arbitrary mark. Fanciful marks are those marks that consist of made up or nonsense words.<sup>89</sup> These marks can only be associated with the producer because they would not exist had he not created them. "Twinkies" and "Ho-Ho's" are examples of fanciful marks. Marks of this category are always protected and receive the most extensive protection available.<sup>90</sup>

The second category, suggestive marks, are those marks that utilize terms describing the product, or a quality thereof, but require some imagination on the part of the consumer to be associated with the good.<sup>91</sup> These terms "suggest rather than describe some particular characteristic" of the goods or services

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79. *Zatarains*, 698 F.2d at 791.

80. *Id.*

81. *Zatarains*, 698 F.2d at 791 (quoting *Volkswagenwerk Aktiengesellschaft v. Rickard*, 492 F.2d 474, 477 (5th Cir. 1974)).

82. Long, *supra* note 27, at 67.

83. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 858 (3d Cir. 1992).

84. *Zatarains*, 698 F.2d at 791.

85. *Id.* at 796.

86. *Dranoff-Perlstein*, 967 F.2d at 855.

87. McCarthy, *supra* note 11, § 11:4, at 439.

88. *Zatarains*, 698 F.2d at 791.

89. McCarthy, *supra* note 11, § 11:3, at 436.

90. *Id.*

91. *Zatarains*, 698 F.2d at 791.

marked and, therefore, force the consumer to "exercise the imagination in order to draw a conclusion as to the nature of the goods [or] services."<sup>92</sup> Thus, the association is substantially assisted, but not quite created, by the creator of the mark. "Arrid" antiperspirant is an example of a suggestive mark. Such marks are protected without requiring the plaintiff to show that the mark has acquired any secondary meaning.<sup>93</sup>

Descriptive marks are those marks describing a product or a quality of a product in a way that requires little or no imagination on the part of the consumer to be associated with the product.<sup>94</sup> The line between suggestive marks and descriptive marks is often difficult to discern.<sup>95</sup> Descriptive marks are not normally protectable as trademarks, but may become sufficiently distinctive if they have acquired secondary meaning.<sup>96</sup> "Beachwood Aged," used to describe Budweiser Beer, is an example of a descriptive mark that has acquired secondary meaning.

Generic marks are so weak that they are never protected.<sup>97</sup> If a mark is found to be generic, it fails the threshold requirement of distinctiveness, and the court will not evaluate the likelihood of confusion between the parties' goods or services.<sup>98</sup> Generic terms "connote[s] the 'basic nature of articles or services' rather than the more individualized characteristics of a particular model."<sup>99</sup> Generic marks are those terms that are so vital to describing or naming the product itself that they cannot be separated from the product.<sup>100</sup> To allow one producer the exclusive use of such a term would unfairly disadvantage all other producers.<sup>101</sup> For example, a producer of soft drinks could not obtain trademark protection for the word "soda." If one producer had the exclusive use of "soda," then all other producers of carbonated soft-drinks would have no adequate way to name their own products. Generic terms are never protected because "even complete 'success . . . in securing public identification . . . cannot deprive competing manufacturers of the product the right to call an article by its name."<sup>102</sup> Similarly, some qualities of products are so necessary to the market as a whole that they must remain available to all producers.<sup>103</sup> Therefore, not

92. *Id.*

93. *Id.*

94. *Id.* at 790.

95. McCarthy, *supra* note 11, § 11:21, at 491.

96. Zatarains, 698 F.2d at 790.

97. Dranoff-Perlstein Assocs. v. Sklar, 967 F.2d 852, 856 (3d Cir. 1992).

98. *Id.*

99. Zatarains, 698 F.2d at 790 (quoting American Heritage Life Ins. Co. v. Heritage Life Ins. Co., 494 F.2d 3, 10 (5th Cir. 1974)).

100. McCarthy, *supra* note 11, § 12:1, at 520.

101. Dranoff-Perlstein, 967 F.2d at 857; A.J. Canfield Co. v. Honickman, 808 F.2d 291, 306 (3d Cir. 1986).

102. Dranoff-Perlstein, 967 F.2d at 855 (quoting A.J. Canfield Co. v. Honickman, 808 F.2d 291, 297 (3d Cir. 1986)).

103. McCarthy, *supra* note 11, § 12:2, at 526.

only is "soda" incapable of being protected, but "grape," "orange," and "lemon-lime" are also terms that are generic within the soft drink market.<sup>104</sup>

The market for the service or product marked has tremendous bearing on which category a product's mark falls into. A market is defined by geographic aspects and product aspects.<sup>105</sup> Some marks are limited by geography, particularly those held by small local businesses. If two producers use similar marks but at opposite ends of the globe, geography keeps them from infringing on each other. The product itself also dictates the market. The same term may be used by two different producers if their products are sufficiently different. For instance, Microsoft makes entertainment software called "Close Combat." "Combat" is also a mark for roach and ant traps. These marks offer no confusion to the consumer because the products are so diverse; therefore, neither party would claim trademark infringement as to the other party.

#### *B. The Four Categories and their Application to Telephone Number Mnemonics*

The trademark categories become difficult to apply in the context of telephone number mnemonics. Under traditional analysis, the term is evaluated in relation to the product or service. If that relationship is artificial, as is the case for arbitrary terms, the mark is source-indicative and therefore protected. If the relationship is natural, as is the case for generic terms, the mark merely denotes what the product is without denoting the source and must remain available to competitors. Often the relationship is in the gray area between these two poles, and courts must place them in the spectrum of suggestive or descriptive.

With mnemonics, the mark labels a means of communicating with the producer and is thus inherently source-indicative. Additionally, the product in most telephone mnemonic cases is more complex than a simple good or service. For instance, 1-800-FLOWERS is a mnemonic that uses the term "flowers," which is arguably generic in the floral industry. However, in the context of that firm's business, 1-800-FLOWERS indicates not only the product, flowers, but also the service, a nationwide network taking orders for and delivering flowers. "FLOWERS," in that scenario, signifies more than just floral arrangements. In the 1-800 FLOWERS context, "FLOWERS" is used to identify a convenient means of ordering flowers from anywhere in the nation and sending them anywhere in the nation. Because the term is multi-faceted, that mark should not be classified as generic. Combined with secondary meaning, achieved in the traditional manner of continuous and exclusive use in commerce, product

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104. See, e.g., *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986) ("chocolate fudge" generic as to diet soda).

105. *DuKuyper & Zoon v. Phillips Prods. Co.*, No. 92-C-4996, 1993 WL 134903, at \* 4 (N.D. Ill. April 22, 1993).

complexity makes 1-800-FLOWERS a mark of considerable strength, notwithstanding its origins as an otherwise generic term.

To bar protection of mnemonics that spell generic terms simply because of the genericness of the term spelled ignores an important element of all trademark analysis. When evaluating the distinctiveness of a mark and the likelihood of confusion between two marks, the whole mark must be taken into account, not just its parts.<sup>106</sup> Mnemonics consist of more than just the term spelled. Intrinsic to the mnemonic mark is its use as a phone number. To base the distinctiveness of a mnemonic mark entirely upon the term spelled ignores this fundamental aspect.

The availability aspect of the genericness doctrine is also answered when the mark is viewed as a whole. Certainly, generic terms and descriptive terms must remain available to competitors so that they can have an adequate means to identify their products. However, are competitors necessarily entitled to use such a name as a phone number? Such a policy is self-defeating. With or without trademark protection, not all competitors will be able to use the generic name of their product as a phone number. Some products cannot be described in seven letters or less. Those that can are still limited by the logistics inherent in the phone number system. Within any given area code, there can be only one seven letter mnemonic. Some area codes, particularly the toll-free area codes (1-800 and 1-888), overlap local codes. Even so, within any locality, the potential number of identical seven letter mnemonics is three.<sup>107</sup> Therefore, to say that the denial of protection to mnemonics that spell generic terms keeps those terms available to competitors is simply not true.

This is not to say that the distinctiveness of the term utilized is irrelevant. To the contrary, mnemonics that spell arbitrary, fanciful, or suggestive terms will indeed be stronger than those that use generic or descriptive ones. However, the weakness of the term is not necessarily the weakness of the mark. With respect to mnemonics that utilize generic or descriptive terms, the court should require the holder of the mark to show secondary meaning in order to obtain protection. However, it is important to note that these mnemonic marks *can* acquire secondary meaning despite their use of weak terms. Thus, while automatic protection may not be granted, the use of a generic term should not be fatal to a holder of a mnemonic mark.

### C. *How Genericness Affects Mnemonics*

The driving force behind the failure to protect generic terms is the policy of keeping those terms that are necessary to define a product, or its qualities,

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106. *Du Kuyper & Zoon v. Phillips Prods. Co.*, No. 92-C-4996, 1993 WL 134903, at \*4 (N.D. Ill. April 22, 1993).

107. For instance, a local widget market could maintain WIDGETS, 1-800-WIDGETS, and 1-888-WIDGETS. In order for any other seller of widgets to use WIDGETS as a phone number he would have to attach it to another area code outside of the locality, or use one of the limited premium toll numbers such as 1-900.

available to all competitors.<sup>108</sup> Certain terms are so inherent to a product that to protect one producer's use of them would have a grave impact upon all other producers in that market. If other producers are denied these terms, they are left with no means to identify their products without infringing upon the protected term.<sup>109</sup>

When the term is used in a mnemonic, however, protection of the mnemonic does not run afoul of this policy. If a generic term is used as a phone number, the holder of that number is certainly not entitled to remove that term from commerce.<sup>110</sup> However, if the protection is limited to the narrow scope of mnemonics, the term remains available in all other contexts. Competitors are free to use the term to describe their products in any advertising medium. What they are not free to do is use the term as a phone number in the same market as the holder of the mnemonic mark.<sup>111</sup>

#### D. Public Perception Test

At the heart of trademark protection is public perception. If the policies behind trademarks are to protect the consumer from confusion and to protect the producer's goodwill generated through the use of the mark, then the meaning the consumer attaches to the mark is crucial to trademark analysis. The spectrum of public perception runs from source-indicative to product-indicative. If a mark answers the question "Who are you?" or "Where do you come from?" it is source-indicative.<sup>112</sup> If it only answers the question, "What are you?" without telling the consumer the product's origin, it is product-indicative.<sup>113</sup> If the public associates the mark with the holder, then the mark is protectable.<sup>114</sup> If the public associates it merely with the product itself, and not any particular producer, then the mark is weak, possibly too weak to be protected.<sup>115</sup>

The public perception test was first created by Judge Learned Hand in *Bayer Co. v. United Drug Co.*<sup>116</sup> Judge Hand, holding that ASPIRIN is generic, declared: "The single question, as I view it, is merely one of fact: What do buyers understand by the word for whose use the parties are contending?"<sup>117</sup> This question is central to all trademark analysis. By categorizing a term, the courts attempt to answer Judge Hand's question.

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108. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 856-57 (3d Cir. 1992).

109. See *supra* text accompanying notes 97-104.

110. *Dial-a-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 678 (2d Cir. 1989).

111. *Id.*

112. *McCarthy*, *supra* note 11, § 12:1, at 520.

113. *Id.*

114. *Id.*

115. *Id.*

116. 272 F. 505 (S.D.N.Y. 1921).

117. *Id.* at 509.

The test was further polished in *Kellogg Co. v. National Biscuit Co.*<sup>118</sup> While determining the trademark status of the term "shredded wheat," the Court declared that in order for a term to receive trademark protection its primary significance, in the minds of the consumer, must be the producer not the product.<sup>119</sup> Thus, a mark cannot be equally source-indicative and product-indicative. Rather, its primary function must be to indicate the source of the product.<sup>120</sup>

The percentage of the consuming public that must recognize the term as source-indicative was determined in *Dupont Cellophane Co. v. Waxed Products Co.*<sup>121</sup> There, the court determined that the term "cellophane" was generic because the majority of consumers only recognized the term as indicative of the product without recognizing it as Dupont's product.<sup>122</sup> Thus, a mark must not only be primarily source-indicative, but it must be so in the minds of the majority of the consumers in the pertinent market.<sup>123</sup>

The public perception test is at the core of the four categories of trademark protection.<sup>124</sup> When evaluating a mark, the courts categorize it based on an assumption of public perception. Arbitrary marks are certainly source-indicative in the majority of consumers' minds, because the connection between the mark and the product source could not otherwise be made. At the other extreme, generic terms must fail the public perception test, because no consumer could associate those terms with any one producer.<sup>125</sup>

Mnemonics have an advantage in this regard, because they are always source-indicative. The public cannot associate a phone number, or a clever way of dialing that number, without thinking about the product source at the other end of the call. Thus, if asked whether 1-800-FLOWERS describes flowers in general or a particular source of floral arrangements, a consumer will certainly recognize 1-800-FLOWERS as a means of contacting a particular source of flowers, if not the source itself.

Because of this inherent quality, particular to mnemonics, mnemonics that spell out generic terms might indeed deserve protection. While the generic term

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118. 302 U.S. 111, 59 S. Ct. 109 (1938).

119. *Id.* at 117, 59 S. Ct. at 113.

120. *Id.*

121. 85 F.2d 75 (2d Cir. 1936).

122. *Id.* at 82.

123. McCarthy, *supra* note 11, § 12:2, at 523.

124. The public perception test has been attacked by commentators because of proof difficulties. Proof of public perception generally relies on market surveys. These surveys often are confusing and fail to take into account brand distinctions, etc. See Terry Ann Smith, Comment, *Telephone Numbers that Spell Generic Terms: A Protectable Trademark or an Invitation to Monopolize a Market?*, 28 U.S.F. L. Rev. 1079, 1096 n.125 (1994). Notwithstanding these implementation problems, the root of trademark protection is public perception.

125. Unless that producer was a monopolist. This situation, however, would be in violation of Section 2 of The Sherman Antitrust Act. That raises questions in that body of trade regulation which is beyond the scope of this paper.

should not be removed from commerce through absolute protection, a producer could have the mnemonic protected from other confusingly similar mnemonics. Because protecting the mnemonic does not remove the term spelled from commerce, protecting a mnemonic that spells a generic term would not have the detrimental effects to competitors that flow from absolute protection of a generic term as a trademark.

### III. TREATMENT BY THE COURTS

Mnemonic trademarks have only recently become an issue for the courts. While mnemonics have been in use for some time, there is little case law on the subject of protecting the mnemonic itself. Earlier phone number cases dealt with mnemonics infringing on traditional word marks, but did not address whether a mnemonic itself could be protected.<sup>126</sup>

Three of the federal circuits have decided cases dealing with the issue of protection of mnemonics as trademarks.<sup>127</sup> Their analyses yielded varying results. The Second Circuit found such marks to be protectable with little analysis.<sup>128</sup> The Third Circuit held that mnemonics are subject to the same analysis as other traditional word trademarks, with those mnemonics utilizing generic terms being denied protection.<sup>129</sup> Finally, the Sixth Circuit, based not on analysis but on a defendant's concession, found that mnemonics are subject to trademark protection.<sup>130</sup> These cases not only show how courts have responded to mnemonics as trademarks, but also show how tangled the issues that arise from this question can be.

#### A. Dial-A-Mattress: *Our Story Begins*

In *Dial-A-Mattress Franchise Corp. v. Page*,<sup>131</sup> the Second Circuit was faced with two competitors, both seeking trademark protection for their mnemonics. Plaintiff, a retail mattress dealer whose business came primarily from telephone orders, used the mnemonic MATTRES in various area codes in the New York metropolitan area.<sup>132</sup> Plaintiff had previously sought to obtain an 800 number that corresponded to its mnemonic to

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126. See *American Airlines, Inc. v. A 1-800-AMERICAN Corp.*, 622 F. Supp. 673 (N.D. Ill. 1985) (use of 1-800-AMERICAN found to infringe on American Airlines' trademarks); and *Sodima v. International Yogurt Co.*, 662 F. Supp. 839 (D. Or. 1987) (1-800-YO-CREAM found to infringe on the trademark "Yoplait").

127. *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989); *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852 (3d Cir. 1992); and *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996).

128. *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989).

129. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 857 (3d Cir. 1992).

130. *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 625 (6th Cir. 1996).

131. 880 F.2d 675 (2d Cir. 1989).

132. *Id.* at 676.



increase its business with toll-free calls, but that particular number was then unavailable.<sup>133</sup>

Defendant, Anthony Page, originally a seller of a reclining sofa bed, had recently expanded into the mattress business.<sup>134</sup> Although he was fully aware of Dial-A-Mattress' use of the mnemonic "MATTRES" in the New York area, he sought an 800 number that spelled out MATTRES.<sup>135</sup> When he discovered that the number was unavailable, he found a number that contained the first three letters (MAT) and then exchanged the last four digits with the holder of the full number.<sup>136</sup>

Both parties promoted their numbers as mnemonics through various means of advertisement.<sup>137</sup> Plaintiff told consumers to dial MATTRES and to "drop the S, for savings"; defendant promoted his mnemonic as 1-800-MATTRESS<sup>138</sup>

Plaintiff filed suit in the Eastern District of New York, claiming trademark infringement and unfair competition.<sup>139</sup> The district court held that Dial-A-Mattress had trademark rights in their mnemonic.<sup>140</sup> It ordered Page to notify the phone company to limit his 800 service so that no calls could be received from those area codes wherein Dial-A-Mattress had used the mnemonic.<sup>141</sup>

The pivotal issue on appeal was whether Dial-A-Mattress could obtain judicial protection for its mnemonic where the term spelled was a generic term.<sup>142</sup> The court held that Dial-A-Mattress indeed had trademark rights in the telephone number, and subsequently upheld the preliminary injunction issued below.<sup>143</sup>

The court rejected the notion that the mnemonic might be denied protection because it utilized a generic term, noting the limited impact of extending protection to phone numbers. Accordingly, the court found that the rationale for denying protection of generic terms in other contexts is inapplicable in the context of mnemonics.<sup>144</sup> According to the court, protecting plaintiff's mnemonic did not remove the word MATTRES(S) from commerce.<sup>145</sup> Rather, it merely protected plaintiff against "a competitor's use of a confusingly similar phone number and a confusingly similar means of identifying that number."<sup>146</sup>

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133. *Id.*

134. *Id.* at 677.

135. *Id.*

136. *Id.*

137. *Id.*

138. *Id.* at 676-77. Note that the additional letter in a mnemonic does not affect the ability of consumers to complete the call.

139. *Id.* at 677.

140. *Id.*

141. *Id.*

142. *Id.*

143. *Id.* at 678.

144. *Id.*

145. *Id.*

146. *Id.*

This notion of limited protection available to mnemonics is central to the arguments for their protection, particularly when the mnemonic spells out a generic term. Because the mnemonic, not the term itself, is protected, many of the policies behind keeping generic terms available to competitors are not threatened by protecting mnemonics.<sup>147</sup> The Second Circuit recognized this and was therefore quick to protect Dial-A-Mattress' mnemonic irrespective of the fact that it used the generic term "MATTRES." Unfortunately, the court did not analyze the possible impact of protecting a mnemonic based on a generic term. In fact, the court did not analyze the strength of Dial-A-Mattress' mark at all. Without any analysis of the mark, the Second Circuit's position was weak, and offered little guidance for subsequent courts. While the result in *Dial-A-Mattress* is probably the correct one, the court's analysis was inadequate.

The Second Circuit made many assumptions. The court assumed the mnemonic involved was protectable.<sup>148</sup> Not all numbers that spell generic terms deserve protection.<sup>149</sup> While some generic terms should be protected, the strength of the mark must still be determined. Many mnemonics that use generic terms could certainly be so weak that they are "merely descriptive" under the Lanham Act.<sup>150</sup> These marks, without secondary meaning, would not be protected.<sup>151</sup> This determination was not made by the Second Circuit in *Dial-A-Mattress*.

#### B. Dranoff-Perlstein: *The Plot Thickens*

The Third Circuit took a markedly different approach to mnemonic protection in *Dranoff-Perlstein Associates v. Sklar*.<sup>152</sup> Plaintiff, Dranoff-Perlstein Associates, was a law firm that practiced personal injury law in the Delaware Valley.<sup>153</sup> Since 1984, it had used the mnemonic INJURY-1 as its phone number, and promoted it in newspaper and radio advertisements.<sup>154</sup> Defendant, Harris J. Sklar, was also a personal injury lawyer who, in 1990, started promoting his practice by using the mnemonic INJURY-9 and advertising it through similar local media.<sup>155</sup>

In May of 1990, both parties applied for registration for their respective mnemonics as service marks on the principle register at the United States Patent

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147. See *supra* text accompanying notes 108-111.

148. *Dial-A-Mattress*, 880 F.2d at 677-78.

149. See *supra* text accompanying notes 106-107.

150. See *supra* text accompanying notes 106-107.

151. This is often the case with partial mnemonics where only part of the number is used to spell out a word (example: 555-ARMS (for a pistol range)). With these numbers many competitors share the partial mnemonic and therefore do not use the mnemonic exclusively. Without exclusive use, it may be difficult to generate secondary meanings.

152. 967 F.2d 852 (3d Cir. 1992).

153. *Id.* at 853.

154. *Id.*

155. *Id.* at 854.

and Trademark Office.<sup>156</sup> In July of that same year, Dranoff-Perlstein filed suit against Sklar for unfair competition and trademark infringement.<sup>157</sup> The district court found that both marks were functional and generic.<sup>158</sup> Therefore, they were not subject to trademark protection.<sup>159</sup> Alternatively, the court found that if the marks were descriptive, that no showing of "secondary meaning" had been made or could be made.<sup>160</sup>

On appeal, the Third Circuit rejected *Dial-A-Mattress*' holding that telephone numbers correlating to generic terms may be subject to trademark protection.<sup>161</sup> The court found that the technical aspects of telecommunications did not alter the trademark analysis used in other contexts.<sup>162</sup> Thus, in the Third Circuit, mnemonics must satisfy traditional trademark analysis in order to receive protection.

The court then analyzed the marks "INJURY-1" and "INJURY-9" to determine which category of mark applied.<sup>163</sup> It quickly determined that they were not arbitrary or fanciful as they bore some "logical or suggestive relation" to the services supplied by the holders.<sup>164</sup> Because little or no imagination was required to associate the term "injury" to personal injury legal services, neither mark could be described as "suggestive."<sup>165</sup>

In its determination of whether the term "injury" was generic or descriptive vis-a-vis personal injury lawyers, the court looked to *A.J. Canfield Co. v. Honickman*,<sup>166</sup> a case in which the term "chocolate fudge" was found to be a generic term not subject to trademark protection in the diet soda market.<sup>167</sup> There, the court determined that "chocolate fudge" could not be protected as a trademark because it would deny other manufacturers of similarly flavored soft drinks a term vital to the marketing of that product.<sup>168</sup> The court then determined that the relationship between the term "injury" and the market of personal injury law was such that, in that context, "injury" was also generic.<sup>169</sup>

After detailed analysis of "injury" under the traditional trademark standards for words, the court remanded the case for a factual determination of whether the addition of the suffixes "-1" and/or "-9" created any likelihood of confusion

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156. *Id.*

157. *Id.*

158. *Id.*

159. *Id.*

160. *Id.*

161. *Id.* at 857.

162. *Id.* at 855.

163. *Id.* at 857.

164. *Id.*

165. *Id.* at 858.

166. 808 F.2d 291 (3d Cir. 1986).

167. 967 F.2d at 855.

168. *A.J. Canfield Co.*, 808 F.2d at 306.

169. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 860 (3d Cir. 1992).

between the two sources of legal services and whether any secondary meaning could be established.<sup>170</sup>

While this court's analysis of the term "injury" is detailed, the court misses the point of mnemonics as trademarks. Holders of mnemonic marks do not seek to protect the term absolutely, neither can they realistically expect to remove the term from commerce. What is generally sought is protection of a mnemonic utilizing the term; therefore the court's analysis of the term above is somewhat irrelevant.

*Dranoff-Perlstein* offers a question that was not pondered by the court: did either parties' use of INJURY consist of trademark use? As law firms, the parties used the number as a means for new clients to hire them. It is possible that little actual business was conducted over the phone. Therefore, little goodwill could be generated through that mnemonic. If the number was not serving as a trademark, then no protection would be warranted no matter how unique the term used.<sup>171</sup> Had the court taken this approach, it could have reached the same result without deciding that mnemonics based upon generic terms are not protectable.

By ignoring the actual use of the mnemonic and, instead, focusing on a detailed analysis of the term used, the Third Circuit's decision, while perhaps correct on the facts before it, bodes ill for many mnemonic marks. An absolute bar to the protection of mnemonics that spell generic terms totally ignores the telecommunication aspects of mnemonics, treating these marks as mere word marks. This folly would force mnemonics to be *protectable* as words but only actually *protected* as mnemonics. Accordingly, plaintiffs would have to prove their marks were inordinately stronger than necessary, in that the mnemonic would have to be distinctive enough to allow the word spelled to be removed from commerce, when in actuality the word would remain available for all non-mnemonic uses.

### C. Holiday Inns: *A New Chapter, or a New Story?*

In *Holiday Inns, Inc. v. 800 Reservation Inc.*,<sup>172</sup> the Sixth Circuit addressed a complaint by Holiday Inns, Inc. of trademark infringement and unfair competition. Holiday Inns, the nationwide hotel chain, claimed that defendants used a phone number that was deceptively similar to its reservation hot line, 1-800-HOLIDAY (465-4329).<sup>173</sup> The defendant, Call Management Systems, operated a "service bureau" that assisted business customers in obtaining and operating 800 phone numbers.<sup>174</sup> Albert Montrueil, the fifty percent owner of

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170. *Id.* at 862.

171. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 863 (3d Cir. 1992) (Stapleton, J., concurring).

172. 86 F.3d 619 (6th Cir. 1996).

173. *Id.* at 620.

174. *Id.*

Call Management, admitted that one of the most common mistakes made by consumers is to dial zero instead of the letter "O."<sup>175</sup> Well aware of this phenomenon, Montrueil discovered that the number 1-800-405-4329 (H-zero-LIDAY) was available and reserved that number for potential customers.<sup>176</sup>

Soon thereafter, Call Management made arrangements with two different reservations firms, Earthwinds Travel, Inc. and 800 Reservations, Inc., to process calls for them through this number.<sup>177</sup> None of the defendants ever advertised their phone number as a mnemonic.<sup>178</sup> With the exception of a three week run of a small classified ad in a nationwide newspaper, the firms never advertised their phone number at all.<sup>179</sup> Defendants fully admitted that their entire business relied upon the misdialings of Holiday Inn's customers.<sup>180</sup> Were it not for Holiday Inns' multi million-dollar annual advertising budget, defendants would have had no customers.<sup>181</sup>

Because of this parasitic arrangement, Holiday Inns alleged that 800 Reservations violated the Lanham Act by "using" Holiday Inns' trademark.<sup>182</sup> Defendants argued that while they indeed benefited from the advertising efforts of Holiday Inns, they never used any of Holiday Inns' trademarks nor any variants thereof; rather, they only used the phone number 1-800-405-4329.<sup>183</sup>

The court, in analyzing Holiday Inns' claim, looked at both *Dial-A-Mattress* and *Dranoff-Perlstein*, yet managed to distinguish both cases.<sup>184</sup> The court found that the Second Circuit's holding regarding the protection of mnemonics as trademarks was easily distinguishable because both parties in *Dial-A-Mattress* had promoted identical mnemonics, thus creating confusion.<sup>185</sup> The Third Circuit's holding, that mnemonics are protectable if they have acquired secondary meaning,<sup>186</sup> was irrelevant to the *Holiday Inns* court because defendants conceded that Holiday Inns had trademark rights in 1-800-HOLIDAY.<sup>187</sup> Thus, the court managed to disregard both federal circuit cases dealing with trademark rights in mnemonics.

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175. *Id.* at 621. The letter "O" is the number 6 on a telephone keypad.

176. *Id.*

177. *Holiday Inns*, 86 F.3d at 621.

178. *Id.* at 623-24.

179. *Id.* at 624 n.6.

180. *Id.* at 621.

181. *Id.* at 624.

182. *Id.* at 623.

183. *Id.*

184. *Id.*

185. *Id.* at 624.

186. Note that this is a rather inaccurate citing of that case. The Third Circuit held that generic mnemonics are not protected and that descriptive marks would only be protected if the mark had acquired secondary meaning. That mnemonics involve special technology was of little consequence to the Third Circuit's analysis. See discussion *supra* at notes 152-171.

187. *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 623 n.5 (3d Cir. 1992).

The court was instead persuaded by a line of cases that suggest active promotion of a mnemonic is necessary to infringe on another's trademark rights.<sup>188</sup> Specifically, the court relied on *American Airlines v. A 1-800-A-M-E-R-I-C-A-N Corp.*<sup>189</sup> That case, however, involved a travel agent who utilized a phone number mnemonic to infringe upon a traditional trademark and said nothing of whether mnemonics themselves could be trademarks.<sup>190</sup>

Without addressing the potential impact of trademark protection of mnemonics, the court held that Holiday Inns did own trademark rights in its mnemonic.<sup>191</sup> The court then found, however, no infringement on the part of defendant under Section 32<sup>192</sup> nor under Section 43(a) of the Lanham Act.<sup>193</sup> Defendants, according to the court, did not create any confusion; they merely capitalized on existing confusion.<sup>194</sup> The court added that Holiday Inns could have prevented such activity had it, like many other industries that use mnemonics, taken the "simple precaution" of reserving the complementary number used by the defendant.<sup>195</sup>

This opinion highlights many of the issues surrounding trademark protection for mnemonics. The kind of protection which should be granted to the holder of a mnemonic mark is exemplified here. Defendants were not infringing on Holiday Inns' mnemonic trademark, because they used no mnemonic themselves. This type of limited protection is precisely what should be granted to mnemonic mark holders.

What is conspicuously absent from the Sixth Circuit's opinion is treatment of the unfair competition claim. Defendants, while not infringers, were admittedly taking a free ride on Holiday Inns' advertising efforts. Unfair competition includes a wide range of unfair practices generally described as a "misappropriation of the skill, expenditures, and labor of another."<sup>196</sup> Defendants were indeed misappropriating the skill, expenditures, and labor that went into Holiday Inns' massive advertising campaign. Surely, this could be included in the broader definition of unfair competition. Plaintiff included a claim for unfair competition,<sup>197</sup> but the court spoke only in terms of trademark infringement. While trademark protection would have been inappropriate, unfair competition should have barred defendant from using the misleading phone number in such a way as to appropriate the benefits of plaintiff's advertising.

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188. *Id.* at 624-25.

189. *American Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp.*, 622 F. Supp. 673 (N.D. Ill. 1985).

190. *Id.*

191. *Holiday Inns*, 86 F.3d at 625.

192. 15 U.S.C. § 1114 (Supp. 1997). This portion of the Lanham Trademark Act provides an action for infringement on registered trademarks.

193. 15 U.S.C. § 1125(a) (Supp. 1997).

194. *Holiday Inns*, 86 F.3d at 625.

195. *Id.*

196. *Murphy Door Bed Co. Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 102 (2d Cir. 1989).

197. *Holiday Inns*, 86 F.3d at 620.

## IV. OTHER TREATMENT OF THIS ISSUE

Commentary surrounding this topic has generally been in accordance with the Third Circuit's holding that mnemonics that correspond to generic terms should never be protected.<sup>198</sup> The arguments against protecting mnemonics fall into three basic categories. First, mnemonics should not be protected because they are not associated with the product in the same manner as trademarks traditionally are.<sup>199</sup> Second, it is argued that mnemonics are derived from a necessarily finite pool and therefore are susceptible to depletion.<sup>200</sup> Finally, it is urged that, because mnemonics are similar to serial numbers, legal principles generated in that area should be applied to mnemonic marks; specifically, all mnemonics should be burdened with a presumption of descriptiveness except those that utilize generic terms, which should never be protected.<sup>201</sup>

*A. Lack of Association with the Product*

One argument against the protection of mnemonics is that they are not associated with a product.<sup>202</sup> In some cases, the mnemonic is so separate from the product that it cannot be protected as a trademark.<sup>203</sup> This is particularly true in the case of a traditional retailer. Contrast the following two situations.

Mutt and Jeff are both in the business of widget sales and service. Mutt, a traditional retailer, sells widgets from a retail store. His customers come in and purchase the widgets over the counter. Jeff, on the other hand, sells widgets through phone sales. Jeff's customers never see him or his employees. The customers place their orders by phone and receive their goods through mail delivery. If they need service or want to purchase more widgets, they call Jeff on the telephone because there is no geographic location to go to, as far as the customer is concerned.

Mutt obtains the number 1-800-WIDGETS, and Jeff obtains 1-888-WIDGETS, and both producers advertise extensively through radio, TV, and other media. As far as Mutt, the traditional retailer, and his customers are concerned, the mnemonic is an easy way to remember the phone number to his establishment. They will only call that number, however, if they are interested in determining where the store is located or need information about sales. Whether they purchase widgets from Mutt will be determined far more by their experiences within the retail establishment than by their experiences over the phone. Jeff's mnemonic, on the other hand, acts as the only means of contact

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198. See generally Elizabeth A. Horkey, *1-800-I-AM-YAIN: Should Telephone Mnemonics be Protected as Trademarks?*, 3 J. Intell. Prop. L. 213 (1995); and Smith, *supra* note 124.

199. See Horkey, *supra* note 198, at 240.

200. *Id.* at 242-46.

201. *Id.* at 252.

202. *Id.* at 242-46.

203. *Id.* at 241.

between his operation and the public. If a consumer wants to buy widgets from Jeff, they will call his mnemonic. If they need more widgets or services for the widgets they have already bought, they will call the mnemonic. Any goodwill generated by Jeff will be generated through the use of his mnemonic. Thus, Jeff's mnemonic acts as a trademark while Mutt's does not.

As the Mutt and Jeff hypothetical indicates, mnemonic trademarks add a step to the trademark analysis. Before the mnemonic can be classified, it must be determined whether it is being used as a trademark at all. A mark cannot be protected if it does not fulfill its central purpose of source-identification.<sup>204</sup> On the other hand, many mnemonics are a producer's sole method of market participation. Examples include 1-800-FLOWERS and Jeff's widget business in the above hypo.

The courts have not looked to the manner of use in mnemonic cases, probably because the manner of use of trademarks is generally obvious. In traditional trademark cases the mark is affixed to the product or is prominently displayed in an advertisement and is clearly used to identify services. Telephone mnemonics are not always so clear. In *Dranoff-Perlstein*, the numbers "INJURY-1" and "INJURY-9" were not subjected to this kind of analysis, although, in a concurring opinion, Judge Stapleton did acknowledge that some mnemonics might not act as trademarks and would be denied protection.<sup>205</sup>

This additional step in analyzing mnemonics as trademarks would create a continuum upon which mnemonics could be placed. Those mnemonics that are intrinsic to the service marked, such as MCI's 1-800-COLLECT, clearly act as trademarks. Those used merely as a phone number for a traditional retail establishment do not act as trademarks. Many mnemonics will fall somewhere in between. Reservations and telemarketing benefit greatly from telephone number mnemonics as the telephone is intrinsic to the services that they provide. Similarly, hotlines also benefit from easily remembered mnemonics. In these industries, the mnemonic may deserve protection as a trademark, so long as it meets trademark requirements. Those mnemonics that do not act as trademarks will fail this threshold requirement, and thus receive no protection at all. Where a mnemonic falls in between these two antipodes will have relevance in determining secondary meaning and other factors in the actual trademark categorization.

### *B. Depletion Theory*

Commentators have been hesitant to protect telephone number mnemonics and have been hostile towards protecting those that spell out generic terms.<sup>206</sup>

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204. George J. Alexander, *Commercial Torts* 13 (2d ed. 1988).

205. *Dranoff-Perlstein Assoc. v. Sklar*, 967 F.2d 852, 863 (3d Cir. 1992) (Stapleton, J., concurring).

206. See generally Horkey, *supra* note 198 and Smith, *supra* note 124.



Most of their arguments are derived from the theory of anti-competitive depletion. Depletion theory, in the realm of mnemonics, is concerned with the fact that a finite number of mnemonics exist, and if one holder of a mnemonic achieves trademark protection, then other holders will soon follow, and there will eventually be no mnemonics left available to new or existing competitors in the market.<sup>207</sup> Based upon this depletion theory, several objections to the protection of mnemonics that spell generic terms have been advanced.<sup>208</sup>

One extreme application of the depletion theory suggests that, by granting protection of a mnemonic that utilizes a generic term, the courts would allow that holder to gain a monopoly on the relevant market.<sup>209</sup> The crux of this argument is that protecting a mnemonic that spells a generic term is tantamount to protecting the term itself. Because the generic term would no longer be available to competitors, the holder of that mark would have a unique advantage over his competitors, and the protection of his mark would facilitate monopolization of the market.

The idea that protecting a mnemonic as a trademark would somehow confer a monopoly on the holder is simplistic at best. Those terms that are generic to the product market do not necessarily make mnemonics based on those terms generic. Protecting the term as a mnemonic will not prevent other producers in the relevant market from using the term in commerce. Competitors will still be able to use the term in advertising in any number of mediums. They will only be precluded from utilizing such a term as a phone number, if such use would create confusion in the relevant market.

Because infringement against a mnemonic trademark could only be carried out through another mnemonic, few competitors would actually be impacted. If Jeff holds 1-888-WIDGETS, he will only preclude others in the widget markets that he is involved in from acquiring that number or numbers that are likely to cause confusion among consumers. A competitor is perfectly able to acquire 1-800-GIZMOES to compete. Moreover, 1-888-WIDGETS, while not generic, would probably be descriptive, which would require Jeff to prove secondary meaning in order to have a protectable mark. If Jeff proves secondary meaning, his mark is not associated merely with the product (generic) but carries goodwill because of Jeff's commercial efforts.

Depletion theory revolves around the idea that because there are only a limited number of combinations on the phone pad, the options are limited. Therefore, we should be hesitant to protect mnemonics as opposed to other marks. Ironically, depletion is exaggerated by the current lack of protection. Because a firm cannot be confident that its mnemonic will be protected, it is encouraged to purchase those numbers that complement the mnemonic it

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207. Horkey, *supra* note 198, at 244 n.159.

208. See generally Horkey, *supra* note 198 and Smith, *supra* note 124.

209. See generally Smith, *supra* note 124.

advertises.<sup>210</sup> Thus, rather than removing one number from the pool, two, three, or more numbers are removed in a sort of "trademark self-help." (Depletion is exacerbated by the variety of markets available and term crossover.)

For any one seven-letter mnemonic, there are only two or three choices available without protection (i.e. local, 1-800, and 1-888). Therefore, depletion exists without trademark protection. Because protection would encourage firms to use only one number, it could serve to eliminate the self-help practices of large businesses.

### C. *The Serial Number Analogy*

Another argument put forth to restrict protection of telephone number mnemonics is that they are similar to serial numbers and should therefore carry the presumption of descriptiveness that burden serial number marks.<sup>211</sup>

Because both serial number marks and mnemonics are not used to designate the goods of a producer, serial numbers, and their treatment under trademark law, have been put forward as a source for an analogous solution to mnemonic trademark issues.<sup>212</sup> Serial numbers distinguish between different goods from the same producer, but are ancillary to the manufacturer's main trademark.<sup>213</sup> Mnemonics have been likened to these numbers because the mnemonic seldom is the trade name of the business, but is merely a means of communication. The goods are generally not marked with the mnemonic and thus are not associated with the mnemonic mark.<sup>214</sup>

Because serial numbers are used in conjunction with other, usually stronger, marks and are used primarily to distinguish different goods from the same producer, they carry a presumption of descriptiveness when asserted as trademarks.<sup>215</sup> This model has been offered as a means to determine the strength of mnemonic trademarks.<sup>216</sup>

Forcing mnemonics into the same legal role as serial numbers is impractical because it fails to address a growing section of the modern market. Telemarketing, information hot-lines, and telecommunications services are among the wide variety of services that utilize mnemonics in a trademark capacity.<sup>217</sup> In many

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210. See *supra* text accompanying notes 194-195.

211. Horkey, *supra* note 198, at 252.

212. *Id.*

213. For example, Sig Sauer, a maker of semi-automatic handguns carries the P226, a full size 9mm handgun, and a P228, a compact version. The serial numbers P226 and P228 might be trademarks of Sig Sauer, but are secondary to the Sig Sauer mark.

214. See *supra* text accompanying notes 202-205.

215. Horkey, *supra* note 198, at 220-27.

216. *Id.*

217. 1-800-FLOWERS (flower delivery), 1-800-CLARITIN (pharmaceutical information line), and 1-800-COLLECT (collect calling service) are examples of specific mnemonics in each of the named categories.

of these, the mnemonic is the name of the producer or is closely associated with that firm's service. These mnemonics are not means for the customer to connect with a service. Rather, they are inextricably meshed with the service themselves. They serve not to distinguish different services from the same producer but to distinguish one producer's service from the next, the quintessential function of a trademark.

While in some markets, especially traditional retail establishments similar to Mutt's in the above hypo,<sup>218</sup> a mnemonic may be nothing more than a clever way to get in touch with a firm without a transaction or service occurring over the phone, a significant portion of the mnemonics are not. Those mnemonics that are separate from a transaction or service simply will not function as trademarks. If so, it matters not whether they are descriptive, generic, or even arbitrary. If they are not functioning as trademarks, then they should receive no protection.

Mnemonics have also been compared to serial numbers because both are almost always used in conjunction with another mark.<sup>219</sup> Because the serial number is usually juxtaposed with the name of the producer, the serial number is weakened as a mark alone. For instance, the Mazda 929 is a luxury automobile made by Mazda but distinguished from Mazda's other cars by the model number "929". Because most, if not all, of Mazda's advertising efforts refer to the car as the "Mazda 929" rather than just "929," "929" on its own is a very weak mark.

Similarly, telephone mnemonics are often used in conjunction with a trade name or other mark, and commentators have suggested that this weakens their status as trademarks.<sup>220</sup> Those same commentators have gone further to suggest that this common practice among holders of mnemonic marks warrants a presumption of descriptiveness to represent this weakness.<sup>221</sup>

This presumption is entirely too broad. While many mnemonics are used in conjunction with another mark, this is merely a factor in determining the strength of that mark, and should therefore be evaluated on a case-by-case basis. Some firms have used the mnemonic as the trade name of the company;<sup>222</sup> other mnemonics are advertised with no reference to the company that holds them.<sup>223</sup> These marks are not weakened by conjunctive use with another mark and should not be burdened with a presumption of weakness. Those marks that are used in conjunction with a trade name or other trademark should merely suffer the natural

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218. See *supra* text accompanying notes 202-205.

219. Horkey, *supra* note 198, at 241.

220. *Id.*

221. *Id.*

222. For instance, 1-800-FLOWERS is not only the phone number to reach that company, it is also that company's corporate name.

223. An example of this is 1-800-COLLECT, MCI's collect calling service. In the many advertisements for this number, none of them makes clear that the service is produced by MCI. Thus, 1-800-COLLECT is not used in conjunction with any other mark.

consequences. Because they are not used on their own they may be weaker than those mnemonics that are. These marks may achieve strength in other ways, however. They may use terms that are arbitrary, fanciful, or suggestive. The holder may just have to invest more time, money, and effort in a blitzkrieg advertising campaign. In any event, whether the mnemonic is used in conjunction with another mark is a matter of individual evaluation, and not consistent enough to warrant a presumption that condemns all mnemonic marks.

These similarities to serial numbers do not support the presumption of descriptiveness suggested.<sup>224</sup> Under this presumption, those marks that use arbitrary or fanciful terms will be presumed descriptive, with no deference given to the strength of the term used. Also, those mnemonics that are derived from existing trademarks (i.e., 1-800-HOLIDAY) are now delegated to descriptive status, even if they were derived from arbitrary, fanciful, or suggestive marks. Moreover, if the existing trademark was descriptive with secondary meaning, does the mnemonic get to utilize the secondary meaning of the word mark, or must it achieve it separately?

Serial numbers and mnemonic trademarks raise different questions and, therefore, require different solutions. A presumption of descriptiveness may work in the realm of serial number marks, but is inadequate for mnemonics.

## V. CONCLUSION

Telephone number mnemonics operate in many industries as trademarks, but they do so only in a very narrow medium. The narrowness of this medium offers the potential to protect these trademarks where analogous word marks might not be protectable. Mnemonic trademarks should only be protected from other mnemonics. Other forms of infringement, such as use of a similar phone number but not the corresponding mnemonic, should be policed through unfair competition law. Thus, unfair competition, while insufficient as the only means of protecting mnemonic marks, can supplement the narrow protection given to mnemonic trademarks.

Courts and commentators have struggled with the idea of protecting these marks because of fears of depletion coupled with the new technology utilized in carrying the marks. However, neither depletion nor technology should be obstacles to extending protection. Traditional, well-founded principles of trademark law are more than capable of ensuring proper protection for both the mnemonic mark and its market.

Technology only adds one step to the analysis of a mnemonic mark: is it being used to mark goods or services? If so, then the standard tests of distinctiveness and likelihood of confusion should determine whether trademark protection is warranted. If not, then its failure to act as a trademark should bar its protection, rather than the technology involved.

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224. Horkey, *supra* note 198, at 252.

Depletion, of particular concern when a generic term is utilized in a mnemonic, also should not obstruct protection. The limited medium in which mnemonic marks operate is not only that which suggests depletion issues, but is also that which limits the scope of potential depletion. Protecting a mnemonic that uses a generic term does not remove that term from commerce. On the other hand, not protecting mnemonics encourages those who use mnemonics to abuse the limited resource of phone numbers to protect themselves where the law is hesitant to do so by purchasing numbers that they do not need. In this sense, a policy against depletion is forwarded by extending protection rather than denying it.

The "information age" is so named because information is a product and a service. As demand for this new commodity increases, competitors, both old and new, need a means with which to identify their wares and distinguish them from others'. Traditionally trademarks have been the weapon of choice for such protection. Despite technological advances, trademark law can adapt and continue to protect this new generation of producers and consumers, but only if it is allowed to do so.

*J. Michael Monahan*