

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Rosch Holdings S.A. ^[1]	:	BEFORE THE
Trademark:	ROSCH	:	TRADEMARK TRIAL
Serial No:	75/504.609	:	AND
Attorneys:	Gene S. Winter, Esq. Mark J. Speciner, Esq.	:	APPEAL BOARD
Address:	St. Onge Steward Johnston & Reens LLC 986 Bedford St. Stamford, CT 06905	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal under Trademark Act Section 2(e)(4) to register ROSCH on the Principal Register for use in connection with "toilets featuring electric fluid controls and seats sold therewith," in International Class 11. The sole issue on appeal is whether applicant's mark is primarily merely a surname.

FACTS

On June 18, 1998, applicant filed an application under Trademark Act Section 1(b) to register ROSCH on the Principal Register for use on goods identified as "toilets, electrical and fluid and [*sic*] controls for the toilet and seats sold as a unit."

In the first Office action, the previous examining attorney refused registration on the Principal Register under Trademark Act Section 2(e)(4) on the ground that the mark is primarily merely a surname. The examining attorney advised applicant that the mark would be eligible for registration on the Supplemental Register upon the filing of an acceptable amendment to allege use. The examining

attorney also required applicant to amend the identification of goods.

The application was abandoned for failure to file a timely response but was reinstated. In its response, applicant argued against the determination that the mark is primarily merely a surname but also proposed amending the application to the Supplemental Register. Applicant also submitted an amended identification of goods.

In the second Office action, the examining attorney accepted the amended identification of goods but maintained the refusal under Section 2(e)(4) and rejected the proposed amendment to the Supplemental Register because no amendment to allege use had been filed. In response, applicant withdrew the amendment to the Supplemental Register and again traversed the surname refusal. Applicant also noted that the application had been assigned to the current owner.

In the third Office action, the examining attorney made the refusal under Section 2(e)(4) final. Applicant subsequently submitted an amendment to allege use. The application was then reassigned to the current examining attorney, who treated the amendment to allege use as a request for reconsideration of the final refusal. The examining attorney maintained the final refusal because the amendment to allege use sought registration on the Principal Register. Applicant then filed a Notice of Appeal and its appeal brief. The examining attorney then requested that the Board remand the application to supplement the evidentiary record and to address two informalities: withdrawing the requirement for a domestic representative^[2] and clarifying the applicant's country of incorporation.^[3] These issues have been resolved. Applicant also requested, and the Board granted, additional time in which to file a supplemental brief, but no such brief was filed.

ARGUMENT

I The Primary Significance of ROSCH is Merely That of a Surname

Trademark Act Section 2(e)(4) bars registration on the Principal Register of a mark if the mark is “primarily merely a surname.” absent a showing of acquired distinctiveness under Trademark Act Section 2(f). It is well-settled that, once the examining attorney has established a *prima facie* case that a mark is primarily merely a surname, the burden shifts to the applicant to rebut this showing. *See, e.g. In re Cazes*, 21 USPQ2d 1796 (TTAB 1991); *In re Industrie Pirelli S.p.A.*, 9 USPQ2d 1564 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). In this case, the evidence of record is more than sufficient to make a *prima facie* showing that ROSCH is primarily merely a surname. Applicant has submitted no evidence to the contrary, and its arguments fail to rebut the examining attorney’s showing.

The Trademark Trial and Appeal Board (“Board”) has identified several factors to be considered in determining whether a term’s primary significance to the purchasing public is that of a surname:

- (1) whether the surname is rare;
- (2) whether the term is the surname of anyone connected with the applicant;
- (3) whether the term has any recognized meaning other than as a surname; and
- (4) whether it has the “look and feel” of a surname;

- (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression.

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-1334 (TTAB 1995). The evidence of record shows that four of these five factors count against the applicant: ROSCH is not rare; it has no meaning other than that of a surname; it has the “look and feel” of a surname, such that its primary significance to the purchasing public is that of a surname; and there is no stylization that creates a separate commercial impression.

A. *ROSCH is Not a Rare Surname*

The evidence of record is more than sufficient to establish a *prima facie* case that the surname ROSCH is not rare. This evidence may be summarized as follows:

- 100 representative entries from a list of over 1,400 listings from the PHONEDISC® database of nationwide address lists and telephone directories, attached to the March 17, 1999 Office action;
- A listing of persons with the surname ROSCH from the examining attorney's search of the website www.switchboard.com, attached to the April 18, 2001 Office action;
- A listing of 366 persons with the surname ROSCH from the POWERFINDER® database of nationwide address lists and telephone directories, attached to the Office action that accompanied the examining attorney's Nov. 19, 2002 request for remand; and
- Approximately 100 excerpts, from the 788 stories retrieved after 1999 alone, mentioning persons with the surname ROSCH from the Lexis/Nexis® computerized database, also attached to the examining attorney's Nov. 19, 2002 request for remand.

The Board has held repeatedly that there is no minimum number of telephone listings necessary to establish a *prima facie* showing of surname significance. See, e.g., *In re Industrie Pirelli S.p.A.*, 9 USPQ2d 1564 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). Here, the evidence shows that ROSCH is in fact the surname of at least several hundred people. This number is many times greater than the number of listings that the Board has in the past found sufficient to establish the primary surname significance of a term. See, e.g., *Petrin, supra* (33 listings found sufficient to establish surname significance); *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983) (28 listings found sufficient to establish surname significance).

Moreover, several of the people surnamed ROSCH mentioned in the Nexis® articles attached to the

examining attorney's Nov. 19, 2002 request for remand are prominent members of their communities. These people are likely to be more widely known within their communities or professions, which increases the likelihood that others will perceive ROSCH as a surname. *See, e.g.*, story no. 1, from the Nov. 13, 2002 Times Union (Albany, N.Y.) (Rev. James Rosch, a parish priest); story no. 7, from the Oct. 31, 2002 Times-Picayune (New Orleans, La.) (Dr. Paul J. Rosch, President of the American Institute of Stress); and story no. 8, from the Oct. 30, 2002 Journal Sentinel (Milwaukee, Wisc.) (Hartland, Wisc. Police Chief Robert Rosch).

In addition, the examining attorney notes that the POWERFINDER® listings in particular show that persons surnamed ROSCH are not limited to or concentrated in one region of the country, but may be found from Vermont to Florida, across the Midwest in Indiana and Wisconsin, and farther west in Colorado and California.

As noted above, once the examining attorney has made a *prima facie* showing of the primary surname significance of a mark, the burden then shifts to the applicant to rebut this showing. *See, e.g., In re Cazes, supra.* In this case, applicant has produced no evidence to rebut the examining attorney's evidence of the surname significance of the mark. Applicant refers in its Appeal Brief to "a Yahoo People Search of New York City, Los Angeles, Chicago and Houston" and to a search of the website "surnamesite.com."^[4] but it has not made these search results of record. Accordingly, applicant's claim is entitled to little or no weight.

Applicant's argument that ROSCH is rare because the number of listings for persons with that surname represents only a small percentage of the total number of listings is unpersuasive; the same could be said of any surname. Even the most common, indisputable surnames necessarily represent only a tiny percentage of a computerized database, such as PHONEDISC® or POWERFINDER®, that may consist of 120 million or more listings.

B. *The Fact that ROSCH is Not the Surname of Anyone Connected with Applicant is of Relatively Little Weight*

While applicant contends that ROSCH is not the surname of anyone connected with it, this factor is greatly outweighed by the evidence showing that ROSCH is the actual surname of at least several hundred people.

C. *ROSCH Has No Recognized Meaning other than as a Surname*

Applicant's argument that ROSCH is not primarily merely a surname because it was formed from letters from the first and last names of the inventor most closely associated with applicant's goods – Roman SCHreck – is unpersuasive. Applicant cites *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) in support, but that case is clearly distinguishable. In examining whether SAVA had any meaning other than that of a surname, the Board noted that SAVA was an acronym for "Securing America's Valuable Assets" and reasoned that, because the identified goods were secure communication systems, purchasers of such goods would be likely to perceive SAVA as an acronym. The more relevant precedent is *In re Petrin, supra*, in which the Board found PETRIN to be primarily a surname despite the argument that it was coined from "petroleum" and "insulation." The Board found the evidence insufficient to show consumer perception of any non-surname significance or to outweigh evidence of surname significance. The same principles apply here: the goods at issue are toilets and toilet seats, and the term ROSCH has no connection whatsoever to such goods. Nothing in the record suggests that the derivation claimed by applicant would be recognized or that consumers would even be aware of the origins of the term as anything other than a surname.

Applicant does not contend, and has made no evidence of record to show, that ROSCH has any meaning, such as an ordinary language meaning (in English or any foreign language) or geographical significance, other than that of a surname. The attached evidence from an online German-English

dictionary shows that ROSCH (or its close variant, ROESCH) has no meaning in German.^[5]

D. *ROSCH has the "Look and Feel" of a Surname*

As the Board recognized in *In re Industrie Pirelli, supra* at 1566, certain surnames look and sound like surnames. The examining attorney submits that ROSCH looks and sounds like a surname of German origin. The fact that ROSCH has no dictionary meaning in the German language would lead consumers with any familiarity with German to conclude that the term must be a surname, similar in sound and structure to many other German surnames that end with –SCH. As in *Petrin, supra* at 904, the surname ROSCH is “not so unusual as to preclude a primary impression of surname significance.”

E. *There is No Stylization in the Mark to Create a Separate Commercial Impression*

This factor weighs clearly against applicant. Applicant has applied to register its mark in typed form. There is no stylization that creates any sort of impression that would alter the primary surname significance of the mark.

CONCLUSION

For the foregoing reasons, the Board should affirm the final refusal under Trademark Act Section 2(e) (4) on the ground that ROSCH is primarily merely a surname.

Respectfully submitted,

/Andrew Benzmiller/

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[1] The application was filed by Rosch Technologies I.L.C., a Delaware limited liability company, but was subsequently assigned to Rosch Holdings S. A., a corporation of Panama.

[2] The Trademark Act was amended effective Nov. 2, 2002, to eliminate the requirement that an applicant or registrant who is not domiciled in the United States designate the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. The change applied to all applications then pending.

[3] Applicant-assignee Rosch Holdings S. A. was identified in the Oct. 18, 2001 amendment to allege use as a corporation of Panama but in applicant's Nov. 16, 2000 response as a Swiss corporation. Applicant has confirmed in its May 27, 2003 response that it is a corporation of Panama.

[4] Applicant's Appeal Brief at 5, 6.

[5] The examining attorney respectfully submits that the Board may properly take judicial notice of this definition because it comes from a standard reference work. TBMP 712.01; *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).