

DEC 16 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Berthold Types Limited : BEFORE THE
Trademark: WHITTINGHAM : TRADEMARK TRIAL
Serial No: 75/866912 : AND
Attorney: Mark Harrison : APPEAL BOARD
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals from the Trademark Examining Attorney's final refusal to register on the Principal Register under Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4).

FACTS

Applicant filed this application to register the designation WHITTINGHAM for "Typeface fonts, namely, alphabet symbols and graphic fonts, recorded on magnetic media for reproduction and duplication for the creation of texts using graphic techniques; digitally stored typefaces, in particular on electric and/or magnetic data carriers, magnetic discs, CD ROMS and diskettes; computer software in the field of desktop publishing; computer software downloadable from global computer information networks for generation of typefaces and fonts" in International Class 9. By an Amendment to Allege

use the applicant, an Illinois corporation, alleged first use of the mark anywhere and in commerce as March 18, 2000. Registration was refused because the designation sought for registration is primarily merely a surname. Trademark Act Section 2(e)(4). The Examining Attorney issued a final refusal on January 23, 2003. The applicant then filed a Notice of Appeal on July 23, 2003 and submitted an appeal brief August 28, 2003.

GENERAL RULE FOR SURNAME REFUSAL

Registration on the Principal Register is prohibited for a mark, which is primarily merely a surname. 15 U.S.C. Section 1052(e)(4). In determining whether a mark is primarily merely a surname, the Examining Attorney must consider the primary significance of the term to the purchasing public. If it is and it is only a surname, then it is primary merely a surname. If the designation has well known meaning, as a word in the language and the purchasing public, upon seeing it on the goods, may not attribute surname significance to it, it is not primarily merely a surname. *In re Kahan & Weiz Jewelry Mfg. Corp.*, 184 USPQ 421 (CCPA 1975). The general rule is found in the case *Ex parte Rivera Watch Corporation*. 106 USPQ 145, 149 (Com'r Pat. 1955), which states:

A trademark is a trademark only if it used in trade. When it is used in trade it must have some impact upon the purchasing public, and it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is of surname significance. If it is, and it is only that, then it is primarily merely a surname.

The Patent and Trademark Office has the burden to prove that the subject matter for registration is primarily merely a surname. The Examining Attorney must present

evidence in the first instance, which is at least sufficient to make out a prima facie showing in support of the contention that the designation is primarily merely a surname, thereby shifting to applicant the burden of rebutting such evidence. See: *In re Ciclo Tecnica Industrial, S.A.*, 194 USPQ 547 (TTAB 1977).

WHITTINGHAM IS PRIMARILY MERELY A SURNAME

The record consists of evidence that established a prima facie evidentiary showing that WHITTINGHAM is primarily merely a surname under Trademark Act Section 2(e)(4).

Of record are: a copy from **PhoneDisc**, version 2000 which show residential listings of individuals within the United States with the surname of WHITTINGHAM¹; copies of *Merriam-Webster's Collegiate Dictionary* and *Webster's New Geographical Dictionary*² which shows no listing of WHITTINGHAM. Evidence, which is relevant in considering whether or not a designation is primarily merely a surname, may consist of listings from computerized research database. See: *In re The Federated Department Stores, Inc.*, 3 USPQ2d 1541 (TTAB 1987).

Whether the term sought to be registered is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act must necessarily be resolved on a case by case basis and, as is the situation with any question of fact, no precedential value can

¹ The residential listing shows a total number of 300 individuals with the surname Whittingham in the United States.

² The examining attorney notes a listing for the designation Lake Whittingham as "Reservoir in Deerfield river, SW Windham co., S Vermont, formed by 220 ft. earthen **Har-ri-mam Dam**, completed 1924."

be given to the amount of evidence apparently accepted in a prior proceeding. See: *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

This record contains sufficient evidence to make out a prima facie showing that the primary significance of WHITTINGHAM to the general purchasing public of applicant's goods is that of a surname. See: *In re Pohang Iron & Steel Co., Ltd.* 230 USPQ 79 (TTAB 1986).

Applicant however asserts that the record is insufficient to support the refusal that WHITTINGHAM is primarily merely a surname. Applicant argues that WHITTINGHAM is a rare surname that the evidence of 300 residential listings should weight in its favor citing *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987) as support.

However, the rareness of Garan as a surname was not the only factor in the Trademark Trial and Appeal Board's determination. The record in Garan case consisting of evidence that applicant is the owner of four existing Principal Register registrations of GARAN without the benefit of Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Moreover, the Board states at page 1540:

The six (or seven) directory and NEXIS listings of "Garan" as a surname have limited persuasive impact in view of the fact these were the only ones found in an enormous Nexis database and some 43 directories of major population centers. In this context, we conclude that "Garan" is an extremely rare surname...

On analysis, we find all of the other factors either, neutral or supportive of appellant's position that GARAN would be perceived by purchasers as an

arbitrary term or as the trademark and trade name of appellant. Virtually no exposure of "GARAN" as a surname has been demonstrated (the sole exception being a single passing reference in a single television news programs). The appearance and use of GARAN by appellant, i.e. the above labels, is not in form akin to that of a surname. No individuals are associated with appellant who bear the surname "GARAN". The name was independently created by appellant as an arbitrary term rather than because of its surname significance.³

This record supports the refusal that the primary significance of WHITTINGHAM is that of a surname. It consists of evidence, which shows at least 300 individuals with the last name of WHITTINGHAM in the United States; copies of dictionaries with no listing of WHITTINGHAM. The listing in *Webster's New Geographical Dictionary* is of WHITTINGHAM. The record is devoid of any evidence that applicant owns registrations on the Principal Register of the designation or that the proposed mark was independently created by applicant as an arbitrary term.

The Examining Attorney does not dispute that WHITTINGHAM is a rare surname in the United States; the record supports such a conclusion. The fact that a surname is rare does not necessarily mean that its primary significance is something other than that of a

³ Compare Administrative Trademark Judge G.D. Krugman dissent at page 1541

While the showing made by the Examining Attorney as to the surname significance of GARAN coupled with the evidence of the lack of significance of the term as an ordinary word is hardly overwhelming, I believe the Examining Attorney's evidentiary showing sufficient, under the relevant case law, to shift the burden to the applicant to rebut that evidence. That the existence of GARAN surnames in the United States is extremely small is not necessarily determinative since even a rare surname is unregistrable if its primary significance to purchasers is that of a surname.

... In short, I conclude that the record supports a conclusion that GARAN is recognized as a surname, albeit an uncommon one; that the evidentiary showing is sufficient to make out a prima facie case that GARAN is primarily merely a surname, thus shifting the evidentiary burden to applicant and that applicant has failed to rebut the prima facie showing made by the Examining Attorney.

surname. The rarity of a surname is not the issue, rather it is the significance the designation will have to the purchasing public significance. *Ex Parte Rivera Watch Corp.*, supra.

Indeed, in the case of *In re Etablissements Darty et Fils*, 222 USPQ 260 (TTAB 1984), the Trademark Trial and Appeal Board found DARTY to be primarily merely a surname on the basis of 32 listing from telephone directories from across the United States. The Board states at page 262:

In the foregoing regard, it is important to keep in mind that rarity in a surname does not, per se, precludes a finding that an admitted surname is “primarily merely a surname” within the contemplation of the Trademark Act. The Board expressed this conclusion in *In re Joseph Picone*, 221 USPQ 93 (TTAB 1984) and *In re Martinoni Co.*, 111189 USPQ 589 (TTAB 1975), two cases which relied on directory evidence to establish surname significance...

There is, of course, a category of surnames that are so rare that they do not even have the appearance of surnames. Where these are involved, even in the absence of non-surname significance, a reasonable application of the test of “primary significance to the purchasing public” could result in a finding that such a surname, when used as a mark, would be perceived as arbitrary or fanciful. ... However, the Board does not believe that “DARTY” falls within this category of rare names that do not look like and would not be perceived as a surname.

Applicant also argues that the proposed mark has other meanings and as such is not primarily merely a surname. Applicant points to *Webster's New Geographic Dictionary* and states that it “shows a reference for Lake Whittingham in Vermont...that the term “Whittingham” has a “readily recognized meaning apart from its surname significance.”⁴ This argument is unpersuasive. The listing in the Geographic Dictionary refers to

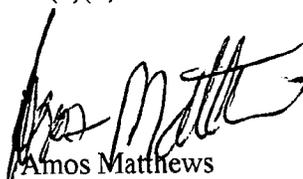
⁴ Applicant's brief page 3

WHITINGHAM not WHITTINGHAM, they are not the same term. The listing indicates that Lake Whitingham is a “reservoir in Deerfield river, SW Winndham co., S Vermont.” If a term has well known meaning as a word in the language it is not primarily merely a surname, the fact that the designation Lake Whitingham is a reservoir in S. Vermont would not be known to a large portion of the citizens in the United States. Moreover, the test to be applied in determining whether or not a designation is primarily merely a surname is its primary significance to the purchasing public. See: *In re Harris-Intertype Corporation*, 186 USPQ 238 (CCPA 1975). The average purchasers of applicant’s goods would not view WHITTINGHAM as a reservoir in Deerfield river in Vermont, but in light of the look, pronunciation and structure would believe that it is a surname.

Applicant argues that because “ham” is a common suffix for geographic locations, consumers are likely to believe that the designation sought for registration is a geographic location rather than a surname. While applicant’s position that it is a suffix of geographic locations may have some merit, it is also a suffix for surnames: Cunningham, Chatham, Dunham, Evernham, Forthingham, Graham, Gresham, Latcham, Markham, Needham, Oldham, and Wickersham to name a few. The average purchasers of applicant’s goods would not view WHITTINGHAM as a geographic location, rather it is highly likely that its impact or impression would be of a surname.

CONCLUSION

Based upon the foregoing, the Examining Attorney submit that WITTINGHAM is primarily merely a surname which applicant has failed to show that the primary significance of the mark is other than as a surname and respectfully request that the refusal under Trademark Act Section 2(e)(4) be affirmed.



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