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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Rogan S. Gregory

Serial No.: 76/277644

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Mark: ROGAN



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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #58

BRIEF FOR APPELLANT

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PRELIMINARY STATEMENT

This is an appeal by Rogan S. Gregory (the "Applicant") from a final decision of the Trademark Examining Attorney refusing registration of the trademark ROGAN.

STATEMENT OF FACTS

On or about June 28, 2001, the Applicant filed an application with the United States Patent and Trademark Office for the mark ROGAN in Classes 18 and 25.

On or about September 11, 2001, the Trademark Examining Attorney sent an Office Action indicating her refusal of registration. The refusal was based on a finding that the mark ROGAN is "primarily merely a surname" under the Trademark Act Section 2(e)(4) and TMEP Section 1211. In support of her opinion, the Trademark Examining Attorney attached only the following two pieces of evidence: (1) the results of a search conducted on the ReferenceUSA data base, setting forth the number of residential listings for the name ROGAN in the United States, and (2) the results of a search conducted on the Lexis/Nexis database, setting forth the number of stories containing ROGAN in the United States. The ReferenceUSA report demonstrated that a total of only 1,087 ROGAN residential listings, out of at least 90 million, existed in the United States. Although the Lexis/Nexis database report revealed 19,552 stories containing the word ROGAN, only 15 stories were attached to the Office Action indicating that ROGAN was used as a surname in the United States.

On or about January 31, 2002, the Applicant responded to the September 11, 2001 Office Action. In his response, the Applicant attached evidence from two Internet databases demonstrating that several words which the Trademark Trial and Appeal Board

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("TTAB") had previously found to be a rare surname, and were accepted for registration, were more frequently used than ROGAN. The Applicant also demonstrated that, when applying the four factor test to determine whether a mark will be perceived as primarily merely a surname, ROGAN could not be considered primarily merely a surname.

Specifically, the Applicant presented evidence and argument demonstrating that ROGAN is a rare surname, is not the surname of the Applicant and does not have the look and feel of a surname.

In a second Office Action dated June 12, 2002, the Trademark Examining Attorney again refused registration, taking the position that the rareness of the ROGAN surname does not operate in favor of the Applicant, but instead enforces the decision to refuse registration since, in her subjective opinion, the primary significance of the mark ROGAN to the purchasing public is that of a surname. The Trademark Examining Attorney also claimed that the name ROGAN lacks any meaning other than a surname. In a September 30, 2002 response, the Applicant stressed that the rarity of a surname is the first of the four factors applied in the inquiry, and should be viewed in the Applicant's favor. Additionally, the Applicant presented evidence in this response that ROGAN has several meanings in the English language, including as the root word for several cities and as the name for types of foods.

Despite the above, the Trademark Examining Attorney, by final Office Action dated November 26, 2002, maintained the refusal of registration, again rejecting the Applicant's argument as to the rarity of ROGAN as a surname as well as Applicant's references to other meanings for ROGAN. The Applicant filed a Notice of Appeal with the TTAB on or about May 28, 2003.

ARGUMENT

THE TRADEMARK EXAMINING ATTORNEY ERRONEOUSLY FOUND THAT ROGAN IS PRIMARILY MERELY A SURNAME

A rejection based on the mark being primarily merely a surname entails a finding that the primary significance of the mark to the purchasing public is that of a surname. 15 U.S.C. §1052(e)(4); *Lane Capital Management v. Lane Capital Management*, 192 F.3d 337, 345 (2nd Cir. 1999). In this context, “merely” is synonymous with “only,” meaning that the question is whether the significance of the mark is “primarily only” a surname. *Id.* The Trademark Examining Attorney has the burden of establishing a *prima facie* case that the trade name is primarily merely a surname. *In Re Benthin Management GmbH*, 37 U.S.P.Q. 2d 1332, 1995 TTAB LEXIS 10, *1 (T.T.A.B. 1995). Moreover, the question of whether a mark sought to be registered is primarily merely a surname within the meaning of a statute can be resolved only on a case by case basis, taking into account a number of factual considerations. *Id.* *2. When there is a question of whether a mark would be perceived as primarily merely a surname, the TTAB is inclined to resolve doubts in favor of the Applicant and pass the mark to publication with the knowledge that others who have the same surname and use it, or wish to use it for the same or similar goods or services, can file a notice of opposition. *Id.* *7

There are four factors which are relevant to the determination of whether a trademark name and design will be perceived as primarily merely a surname: (1) the degree of a surname’s rareness; (2) whether anyone connected with the applicant has the surname of the mark at issue; (3) whether or not the mark has a “recognized meaning”

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other than that of a surname; and (4) whether the mark has the “structure and pronunciation” of a surname or the “look and sound” of a surname. *In Re United Distillers*, 56 U.S.P.Q. 2d 1220, 2000 TTAB LEXIS 414, *4 (T.T.A.B. 2000); J. Thomas McCarthy, *On Trademarks and Unfair Competition* (4th Ed., 2003), Section 13:30, p. 13-51. There is no magic number that will determine if a name is primarily merely a surname. *Id.*

A. ROGAN is A Rare Surname

The more rare the surname is, the less likely it will be perceived by the public as a surname. McCarthy, Section 13:30, p.13-51. To meet its burden under this prong, the Trademark Examining Attorney must establish that an “unusually large number” of telephone directory listings exist for the mark as a surname. *Id.* Rarity of the mark as a surname is extremely relevant to the four part inquiry. As the TTAB has stated: “The degree of a surname’s rareness should have material impact on the weight given to directory evidence.” *In Re Garan, Inc.*, 3 U.S.P.Q.2d 1537, 1987 TTAB LEXIS 48, *9 (T.T.A.B. 1987). *See also* McCarthy, Section 13:30, p. 13:54 (“...the rarity of the surname should be relevant in assessing the probable reaction of the public in seeing the mark”).

In *United Distillers*, the TTAB held that the mark, HACKLER, which had 1,295 surname listings in the Phone-Disc database and numerous articles from the Nexis database, was a rare surname. *United Distillers*, 56 U.S.P.Q. 2d 1220, 2000 TTAB LEXIS 414, *4 -5. In that case, the TTAB, in considering the Phone-Disc evidence offered by the Trademark Examining Attorney, recognized the massive scope of the database, which contained approximately 80 million entries. *Id.* Additionally, the TTAB

of 1,295 surname listings in the United States and as such, is a more common surname than ROGAN.

The Trademark Examining Attorney's reliance on its Lexis/Nexis search was also misplaced. The results of that search indicated a total of 19,552 stories containing the word ROGAN, but only 15 stories attached to the Trademark Examining Attorney's Office Action of September 11, 2001, indicated that ROGAN was used as a surname in the United States. 15 out of at least 90 million surnames in the United States cannot be considered persuasive evidence that ROGAN is a common surname.

Most importantly, the Applicant submitted evidence, and the Trademark Examining Attorney did not dispute this evidence, demonstrating that ROGAN is a rare surname in the United States. The Applicant submitted a chart with its January 31, 2002 response, illustrating the infrequency of the surname ROGAN within each of the 50 states. This data was obtained from the Hamrick software website (www.hamrick.com/names). The source of Hamrick.com's data is all US phone books in 1990. This chart establishes that in 41 of the 50 states the frequency of the surname ROGAN is less than 1 in 8,500 names, and in many cases ROGAN is found in less than 1 of every 10,000 last names. The Applicant also attached to his January 31, 2002 response a chart, also generated through Hamrick.com, illustrating the frequency of the name HACKLER in the United States, which name was previously found by the TTAB to be a rare surname and was accepted for registration in *United Distillers, supra*. This evidence submitted by the Applicant established that in 40 of the 50 states, HACKLER, like ROGAN, was found in less than 1 out of every 8,500 names.

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For the above reasons, the Trademark Examining Attorney should have found that ROGAN is rare surname and that this factor weighs heavily in favor of acceptance.

B. The Applicant Does Not Use ROGAN As His Surname

The second factor used to determine whether a mark is primarily merely a surname, is whether anyone connected with the applicant has the surname of the mark sought to be registered. Where the name is not the surname of the applicant, the likelihood is that the mark is not primarily merely a surname. *In Re Monotype Corp., PLC*, 14 U.S.P.Q.2d 1070, 1989 TTAB LEXIS 51, *4 (T.T.A.B. 1989). SAVA was not the surname of anyone connected with the applicant and was subsequently accepted for registration. *Sava*, 32 U.S.P.Q. 2d 1380, 1994 TTAB LEXIS 13, *6.

Here, as demonstrated in the Applicant's January 31, 2002 response, neither the Applicant, nor anyone connected with him, has the surname ROGAN. ROGAN is the first name of the Applicant.¹ Despite this, the Trademark Examining Attorney did not mention this prong in rendering her decision.

C. ROGAN has Meanings Other Than As A Surname

Marks which have meanings other than as a surname are likely not to be found primarily merely a surname. *Monotype Corp., PLC*, 14 U.S.P.Q.2d 1070, 1989 TTAB LEXIS 51, *3-4. However, the fact that there are no other meanings of a name in the English language will not alone support the refusal of registration of the surname under the "primarily merely a surname" statutory language, unless the average member of the purchasing public would, upon seeing it used as a trademark, recognize it as a surname.

¹ The fact that "ROGAN" is the Applicant's first name should not have any impact on this inquiry. In fact, in *Lane Capital, supra*, "Lane" was the applicant's father's nickname and middle name, and was also the applicant's son's middle name. *Lane* 192 F.3d at 341. Nevertheless, the court found the "Lane" mark valid and protectable.

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The Trademark Examining Attorney rejected the above evidence of other meanings, arguing, without citing to any authority, that the definitions submitted by the Applicant are not relevant since they are geographical terms or foreign words. As set forth in the evidence attached to the Applicant's September 30, 2002 response, ROGAN is a word recognized in the English language and has more than one meaning. The TTAB has found on several occasions, that evidence of geographical and foreign meanings recognized in the English language is acceptable to establish that a mark is not merely a surname. *In Re Colt Industries operating Corp.*, 195 U.S.P.Q.75 (T.T.A.B. 1977) (evidence that FAIRBANKS had geographical significance weighed in favor of finding that marks is not primarily merely a surname); *Gemex*, 111 U.S.P.Q. 443; *Monotype Corp.*, 14 U.S.P.Q.2d 1070, 1989 TTAB LEXIS 51, *3-4 (CALLISTO has meaning in Greek mythology). Thus, the Trademark Examining Attorney's finding here was in error, as this prong should have weighed in favor of acceptance.

D. The ROGAN Mark Does Not Have the Structure and Pronunciation or the Look and Sound of a Surname

The Applicant submits that the name ROGAN does not have the structure and pronunciation or the look and sound of a surname. *See Benthin*, 37 U.S.P.Q. 2d 1332, 1995 TTAB LEXIS 10, *1. The word looks and sounds like an arbitrary term in relation to the clothing and accessories the name is used in connection with. Indeed, the fact that ROGAN is a rare surname (see Point A above), tends to indicate that it is not likely to be perceived by the public as a surname. *Sava*, 32 U.S.P.Q. 2d 1380, 1994 TTAB LEXIS 13, *5-6 (fact that SAVA is a rare surname weighs in favor of a finding that it would not be perceived as primarily merely a surname); McCarthy, Section 13:30, p. 13:30.

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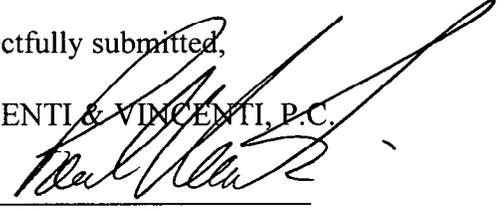
The Trademark Examining Attorney, without citing to any supporting facts or evidence, made a subjective finding that the name ROGAN would be perceived by the purchasing public as primarily merely a surname. We submit that this finding was in error. In determining surname perception, or "look and sound", the Trademark Examining Attorney failed to accord any weight to the evidence presented by the Applicant that ROGAN is a rare surname, as mandated by the TTAB in *Sava*.

However, assuming, *arguendo*, that this factor should be weighed against acceptance for registration, it is only one of the factors applied. The Trademark Examining Attorney appears to have found that this finding *per se* precludes acceptance of the mark for registration, regardless of an examination of the other three prongs of the analysis. The law is clear that no one factor in the analysis is determinative, and that a decision must be made by taking all factors into account as a whole. As set forth above, the Applicant demonstrated that at least three of the four factors should have been weighed in his favor. As such, the ROGAN mark should have been accepted for registration.

CONCLUSION

Based on the foregoing, the Appellant respectfully requests that the Trademark Examining Attorney's decision refusing registration of the ROGAN mark be reversed, and that the mark be accepted for registration.

Dated: July 21, 2003

Respectfully submitted,
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Applicant: Rogan S. Gregory
Serial No.: 76/277644
Filing Date: June 28, 2001

CG 7/23/03
7/23/03
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Dear Sir/Madam:

Enclosed please find the Appellant's brief in connection with the above referenced matter.

Please contact me with any questions.

Very truly yours,

Vincenti & Vincenti, P.C.

Paul J. Vincenti

PJV/FMK

Enclosure