

TTAB

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



Applicant: Rogan S. Gregory

Serial No.: 76/277644 ⁶⁶⁴

Filing Date: June 28, 2001

Mark: ROGAN

11-25-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

ORAL HEARING REQUESTED

Pursuant to 37 CFR Sect. 2.142(e)(1), the Applicant respectfully requests an oral hearing in connection with the above referenced appeal.

Dated: November 21, 2003

Respectfully submitted,

VINCENTI & VINCENTI, P.C.

By

A handwritten signature in cursive script, appearing to read "Paul Vincenti", is written over a horizontal line.

Paul J. Vincenti

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

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2900 Crystal Drive
Arlington, Virginia 22202-35313

on November 21, 2003

A handwritten signature in black ink, appearing to read "Paul J. Vincenti", written over a horizontal line.

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Re: Mark: ROGAN
Applicant: Rogan S. Gregory
Serial No.: 76/277644
Filing Date: June 28, 2001

Dear Sir/Madam:

Enclosed please find Appellant's Reply 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

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

Applicant: Rogan S. Gregory
Serial No.: 76/2776⁶⁴⁴~~44~~
Filing Date: June 28, 2001
Mark: ROGAN

REPLY BRIEF FOR APPELLANT

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PRELIMINARY STATEMENT

Rogan S. Gregory (the "Applicant") submits this reply brief in further support of his appeal from a final decision of the Trademark Examining Attorney refusing registration of the trademark ROGAN.

ARGUMENT

A. ROGAN is A Rare Surname

In his brief, the Examining Attorney completely ignores the evidence submitted by the Applicant for purposes of establishing that ROGAN is a rare surname. This evidence included a chart (attached to the Applicant's January 31, 2002 response) prepared by the Hamrick.com software database, illustrating the infrequency of the surname ROGAN - less than 1 in 8,500 *first or last names*, and, most importantly, *less than 1 of every 10,000 last names*. ROGAN is therefore a *less frequent* surname than HACKLER, which name was previously found by the TTAB to be a rare surname and was accepted for registration in *United Distillers*, 56 U.S.P.Q. 2d 1220, 2000 TTAB LEXIS 414, *4 (T.T.A.B. 2000).

The Examining Attorney's evidence 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 in some form, *only 15 stories definitively indicated that ROGAN was used as a surname*. The remaining 19,537 cases did not indicate whether ROGAN is used as surname or as a company name or other name. See *Sava*, 32 U.S.P.Q. 2d 1380 (database cases submitted by examining attorney did not reveal whether SAVA was used as a surname or as a company name - refusal to register was reversed). By pointing *only to*

proof of only 15 surname listings of ROGAN as a surname, the Examining Attorney has failed to meet its burden for purposes of establishing that ROGAN is not a rare surname.

Notwithstanding the Examining Attorney's argument that even rare surnames have been found to be barred under the Lanham Act, the law is clear that the more rare the surname is, the less likely it will be perceived by the public as a surname. McCarthy, *On Trademarks and Unfair Competition* (4th Ed., 2003), Section 13:30, p.13-51. The Examining Attorney must establish that an "unusually large number" of telephone directory listings exist for the mark as a surname. *Id.* 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). The cases cited by the Examining Attorney in support of its position that even rare surnames can be barred from registration are distinguishable. In *Luis Caballero*, 223 U.S.P.Q. (T.T.A.B. 1984), the refusal was based largely upon the applicant's admission that the name BURDONS was taken from the surname of a fictitious character, and that the name appeared on labels in such a manner as to indicate or stress its significance as a surname to the purchaser. *In Rebo High Definition Studio*, 15 U.S.P.Q.2d 1314 (T.T.A.B. 1990), REBO was the surname of the applicant's president and the applicant emphasized the significance as a surname in a news article. As set forth in Point B below, ROGAN is the first name of the Applicant and is not used in a way which conveys or stresses meaning as a surname to the purchaser.

This prong should favor the Applicant.

B. ROGAN Is Not The Applicant's Surname

The Examining Attorney concedes that the second prong, whether anyone connected with the applicant has the surname of the mark at issue, favors the Applicant. ROGAN is not the Applicant's surname. Where the mark 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) (emphasis added). This factor weighs heavily in favor of the Applicant. *Id.*; *Sava* 32 U.S.P.Q.2d 1360.

C. ROGAN Has Meanings Other Than As A Surname

The Examining Attorney's "quick" dismissal of the Applicant's argument regarding other meanings is unwarranted. As demonstrated by evidence submitted with the Applicant's September 30, 2002 response, ROGAN means "red" in Indian. It is also part of the name of at least two Indian dishes, "Rogan Josh" and "Chicken Rogan." The Examining Attorney's statement that the Applicant's evidence does not refer to the meaning of the words "Rogan Josh" is in error. The Applicant's evidence, submitted with its September 30, 2002 response, clearly states that "Rogan josh literally means 'red meat,'" and that "Rogan means red." For this reason alone, the factor should be weighed in favor of the Applicant.¹

Even so, the fact that there are no other meanings of a word in the English language will not alone support the refusal of registration of a mark as "primarily merely a surname," unless the average member of the purchasing public would, upon seeing it

¹ Additionally, without citing to any supporting authority, the Examining Attorney subjectively argues that the Applicant's evidence of ROGAN as meaning red in Indian and as part of the name of two Indian dishes should not be afforded any weight since it may not be a popular dish. Indeed, there are an abundance of Indian speaking people and several popular Indian restaurants in the United States.

used as a trademark, recognize it as a surname. *Garan*, 3 U.S.P.Q.2d 1537. We submit that ROGAN will not be perceived by the average purchaser as primarily a surname.

The Applicant also submitted evidence with its September 30, 2002 response establishing that ROGAN has significance as a geographical name of cities in Utah, Tennessee, Texas and Australia. The TTAB has found that a mark's geographical significance is a fact which favors the applicant. *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 mark is not primarily merely a surname). The Examining Attorney's reliance on *Harris-Intertype Corporation*, 186 USPQ at 239 (C.C.P.A. 1975), and *Sava Research*, 32 USPQ2d at 1381, is misplaced. HARRIS is an overwhelmingly common surname and any geographical significance could not outweigh the public's view of HARRIS as primarily merely a surname. ROGAN can certainly not be considered in the class of common surnames like HARRIS. HARRIS also had no other meanings, unlike ROGAN which means "red" in Indian. SAVA's geographical significance was only in relation to foreign locations, unlike ROGAN which has geographical significance respecting three U.S. cities. The Applicant also notes that SAVA was ultimately found not primarily merely a surname and the examining attorney's refusal to register was reversed.

Since ROGAN means "red" in Indian and has significance in connection with geographical locations, the factor should also favor a reversal.

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

The Applicant submits that the mark ROGAN appears on labels (submitted as specimens of use in connection with its application) as an arbitrary or fanciful term, and

does not convey any significance as a surname to the purchaser. Indeed, it is not the surname of the Applicant.

The Examining Attorney's belated attempt to submit additional evidence for first time on this appeal, namely pages of a biographical names dictionary, should be denied. 37 CFR Sect. 2.142(d) ("The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board . . . by the examiner after the appeal is filed"); *In Re Gagliardi Bros., Inc.*, 218 U.S.P.Q. 181, 1983 TTAB LEXIS 201, *4-5 (attempted submission of excerpts of dictionary referenced on appeal denied as it was against policy of Board and "far too late to be considered"); *In Re Jos. Schlitz Brewing Company*, 223 U.S.P.Q. 45, 1983 TTAB LEXIS 235, *4 (T.T.A.B. 1983) (proper procedure when seeking to introduce new evidence is to request the Board to suspend the appeal and remand for further examination).

Moreover, the Examining Attorney's position that the name ROGAN would be perceived by the purchasing public as primarily merely a surname is unpersuasive. Its argument that words ending in "an" have the look and sound of a surname is a gross generalization which should not be given any weight (e.g. in *Garan*, 3 U.S.P.Q.2d 1537, the name GARAN, which has the suffix "an," was not found to have the look and sound of a surname). Most importantly, the Examining Attorney failed to accord any weight to the evidence presented by the Applicant that ROGAN is a rare surname in determining look and sound.

Likewise, the Examining Attorney's subjective statement, made for the first time on this appeal, that "it is a well-known fact amongst the general public that clothing is often sold under the name (or surname) of the designer or maker . . ." is wholly without

merit and is devoid of any evidence or other supporting authority. Moreover, it is not relevant. The names cited are full names, not surnames. The use of full names or first names as trademarks is not relevant to an examination under Section 2(e)(4) of the Trademark Act. The only issue is whether the mark is primarily merely a surname. The full names cited by the Examining Attorney do not demonstrate that consumers are likely to perceive ROGAN, which is not the last name of the Applicant, as primarily merely a surname.

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.

ORAL HEARING REQUESTED

The Applicant respectfully requests an oral hearing. In this connection with this request, the Applicant is filing a separate notice simultaneously with the filing of this reply brief.

Dated: November 21, 2003

Respectfully submitted,

VINCENTI & VINCENTI, P.C.

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