

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

In re Application of:

Applicant: Yurman Studios, Inc.

Examining Attorney: John M.C. Kelly

Serial No.: 76/512,936

Law Office: 112

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Mark: MERCER

Trademark Trial and Appeal Board
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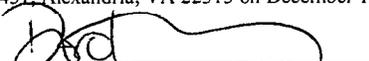
APPLICANT'S EX PARTE APPEAL BRIEF

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TABLE OF AUTHORITIES

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In re Allied Mills,
150 U.S.P.Q. 757 (TTAB 1966)11, 14

In re Benthin Mgmt. Gmbh,
37 U.S.P.Q. 2d 1332 (TTAB 1995)8, 12, 17, 18, 19

In re Colt Indus. Operating Corp.,
195 U.S.P.Q. 75 (TTAB 1977)14

Fisher Radio Corp. v. Bird Elec. Corp.,
162 U.S.P.Q. 265 (T.T.A.B. 1969)16

In re Kahan & Weisz Jewelry Mfg. Corp.,
408 F.2d 831, 184 U.S.P.Q. 421 (CCPA 1975).....3, 5, 18

Ex Parte Keuffel & Esser Co.,
96 U.S.P.Q. 216 (Ex'r-in-Chief 1953)17

Lane Capital Mgmt., Inc. v. Lane Capital Mgmt. Inc.,
192 F.3d 337, 52 U.S.P.Q. 2d 194 (2d Cir. 1999)10, 16

Lucien Piccard Watch Corp. v. 1868 Crescent Corp.,
165 U.S.P.Q. 459 (SDNY 1970).....17

Michael S. Sachs Inc. v. Cordon Art B.V.,
56 U.S.P.Q. 2d 1132 (TTAB 2000)17

In re Monotype Corp. PLC,
14 U.S.P.Q. 2d 1070 (T.T.A.B. 1989)19

Ex Parte Omaha Cold Storage Co.,
111 U.S.P.Q. 189 (CCPA 1956)11, 14

Ex Parte Rivera Watch Corp.,
106 U.S.P.Q. 145 (CCPA 1955)9

Ex Parte Stylofede Corp.,
92 U.S.P.Q. 388 (CCPAQ 1952)15

In re United Distillers PLC,
56 U.S.P.Q. 2d 1220 (TTAB 2000)18

FEDERAL STATUTES

15 U.S.C. §1051(b)2
15 U.S.C. §1052(e)(4).....1, 3, 5, 7, 9, 10

SECONDARY SOURCES

McCarthy on Trademarks and Unfair Competition (4th Ed.) §13:30.....10, 17
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Hawes)10, 11, 12

I. SUMMARY OF THE APPLICATION

Mark: MERCER

Goods and Services: Jewelry, clocks, watches and precious stones, in International Class 14

Register: Principal

II. INTRODUCTION

Applicant Yurman Studios, Inc. ("Yurman") appeals to the Trademark Trial and Appeal Board from the Examining Attorney's April 15, 2004 final refusal to register the above-referenced mark. Registration of the applied-for-mark was refused under Section 2(e)(4) of the Lanham Act, on the sole ground that the mark is primarily merely a surname. Applicant respectfully submits that the Examining Attorney's refusal to register the mark is in error, in that the evidence of record overwhelmingly demonstrated that the mark has several significant meanings to relevant consumers other than as a surname, and therefore the mark is not understood to be "primarily merely" a surname, and is registrable. Accordingly, Applicant respectfully requests that the Board reverse the Examiner's refusal and that the mark be approved for publication.

III. STATEMENT OF PRIOR PROCEEDINGS AND EVIDENCE OF RECORD

Applicant Yurman is one of the most prominent high-end jewelry and timepiece design companies in the U.S. Since its inception in 1988, Yurman has set new standards for designing and marketing jewelry, introducing the disciplines of art and fashion into jewelry-making. Yurman is currently the market leader in creating fine designer jewelry for sales at retail. Yurman products are marketed to sophisticated, fashion-conscious, and discerning consumers, and are sold only at specialty retail and high-end department stores. In 2003, Yurman products

were projected to exceed \$400 million in sales. Yurman is also one of the most prominent jewelry advertisers in the U.S. market, spending in excess of \$10 million in high-end print publications, strategic billboard advertising, and targeted direct mail and cooperative advertising programs (Declaration of Arlene Brickner, Yurman's Vice President of Marketing, ¶¶ 1-11, submitted in support of Applicant's First Office Action Response dated November 15, 2003, hereinafter the "Brickner Dec.")

In or prior to May, 2003, Yurman adopted the mark MERCER for articles of jewelry, clocks, watches and precious stones (Applicant's Application to Register dated May 9, 2003). In adopting the MERCER mark for high-end jewelry and timepiece products, Yurman sought to communicate the style and trendiness associated with Mercer Street, located in the famous SoHo neighborhood of New York City. SoHo is an area in New York City, south of Houston Street, that is known as a fashion center. Many exclusive boutiques and flagship stores for global luxury designer brands are located in SoHo, and Mercer Street is a well-known central shopping location there. In selecting the MERCER mark, Yurman sought to appeal to its fashion-conscious, sophisticated consumers, many of whom shop in SoHo, and to conjure up the style, trendiness and fashion aesthetic associated with SoHo. Yurman further intended that its consumers would identify Yurman's MERCER line of goods with the distinctive, cutting-edge and sophisticated style specifically associated with SoHo and the Mercer Street area (Brickner Dec. ¶¶ 12 - 14.)

On May 9, 2003, Yurman filed an application to register the mark MERCER in Class 14, for "jewelry, clocks, watches and precious stones", pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b).

On September 25, 2003, the Examining Attorney issued an Office Action (the "Office Action") refusing Yurman's application to register MERCER based on Section 2(e)(4) of the Lanham Act, 15 U.S.C. §1052(e)(4), asserting that "Mercer" was "primarily merely a surname." In particular, the Examining Attorney stated that he had determined that the primary significance of the mark to the purchasing public was that of a surname. In support of his conclusion, the Examining Attorney attached one piece of evidence: a Lexis-Nexis USFIND Database search yielding 16,000 residential listings nationally for the surname "Mercer." The Examining Attorney stated that this was "highly conclusive evidence that "Mercer" is primarily merely a surname," citing the case of In re Kahan & Weisz Jewelry Mfg. Corp., 408 F.2d 831, 184 USPQ 421 (CCPA 1975.)

On November 24, 2003, Applicant filed a Response to the September 25, 2003 Office Action (the "Response"), arguing that the Section 2(e)(4) refusal was unfounded because the primary significance of Applicant's mark in the eyes of the relevant purchasing public was not that of a surname. In support of its position, Applicant submitted several compelling pieces of evidence, including: (i) the Brickner Declaration, clearly setting forth that Applicant adopted the MERCER mark to refer to Mercer Street, the famous geographic location for the fashion-conscious; (ii) copies of 31 registrations for marks containing the word MERCER, seven consisting of the word MERCER alone, and seven others clearly referring to the geographical location Mercer Street in SoHo. All such marks had been registered without a Section 2(f) showing, which would have been required for marks that were primarily merely surnames under Section 2(e)(4). Such registered marks were:

Mark	Serial No.	Class
55 MERCER STREET	76086473	41
BURKE MERCER	2598053	27
MERCER	2753987	30

MERCER	76095151	36
MERCER	2638066	35
MERCER	2188779	34
MERCER	1736792	28
MERCER	933939	9
MERCER	79954	23
MERCER 100% NATURAL TOBACCO	2233377	34
MERCER AND BRATT	1832778	24
MERCER AND MADISON	76407853	25
MERCER EVALUE FRAMEWORK	2451406	35
MERCER FRICTION GRIP	861475	19
MERCER GLOBAL ADVISORS	2005792	36
MERCER HEALTH PLAN SOLUTIONS	2635835	36
MERCER INSITE	76329646	42
MERCER LIGHTS 100% NATURAL TOBACCO	2235663	34
MERCER ST. BUTTON CO.	1853156	25
MERCER STREET STUDIO	78139760	25
MERCER TRANSPORTATION CO.	1461357	39
MERCER, A GLOBAL ABRASIVE COMPANY	2705287	3, 7, 8, 9
MERCERMERGE	2624861	35
MERCERPRISM	2662551	9
MGA MERCER GLOBAL ADVISORS	2043130	36
MP MERCER	1810789	19
MPACT MERCER PURCHASE ASSISTANCE FOR CONTRACTOR TRUCKS	2128207	36, 42
MSE MERCER STREET EXPRESS	1236447	25
SPRING & MERCER	78975166	25
SPRING & MERCER	78136488	25
THE MERCER	2362759	35, 42

and; (iii) a reference to the Merriam-Webster Dictionary definition of the word “mercer” as a noun meaning “a dealer in unusually expensive fabrics.”

In addition to proffering the above evidentiary references, Applicant argued that such references clearly demonstrated that MERCER was not understood primarily as a surname reference, as the law required for a Section 2(e)(4) showing. Indeed, Applicant pointed to case law and other precedent indicating that in the context of Section 2(e)(4), "primarily merely a surname" meant "only" or "virtually only" a surname -- that is, unless there was evidence that the term in question was understood virtually only as a surname, it was not primarily merely a surname under Section 2(e)(4). Accordingly, evidence of other significant meanings, such as geographical references, would be sufficient to undermine a Section 2(e)(4) refusal. Applicant further argued that under established law, in determining whether a mark is primarily merely a surname, one looks to the relevant purchaser group, here the typical Yurman consumer that understands MERCER to refer to a geographical location in SoHo. Finally, Yurman argued that the Examining Attorney's lone piece of evidence, a mere telephone listing, was not sufficient to satisfy the Trademark Office's burden of proof on a Section 2(e)(4) refusal. In particular, Applicant pointed out that the In re Kahan case cited by the Examiner specifically held that evidence consisting solely of telephone directory listings was not sufficient to sustain a 2(e)(4) refusal.

On April 15, 2004, the Examining Attorney responded to Yurman's Response and issued a final refusal of Applicant's application to register, once again based on Section 2(e)(4). The Examining Attorney reiterated that the residential telephone listings appended to the Office Action were sufficient to establish the primary surname significance of the term "Mercer." The Examining Attorney also argued that: (i) the evidence proffered by Applicant did not demonstrate that the relevant consuming public would understand MERCER to refer to a well-known geographic area, namely Mercer Street; (ii) there was nothing inherent in Applicant's

identification of goods that indicated that the relevant purchasing public would perceive “Mercer” to have non-surname significance; (iii) Applicant had not presented any dictionary or encyclopedic evidence to support the assertion that “Mercer” designated a well-known geographic area or some other meaning; (iv) Applicant’s narrative evidence about Mercer Street was not sufficient; and (v) Applicant’s goods were not distributed in trade channels where the majority of the relevant purchasing public could perceive the mark to have geographical significance. The Examining Attorney submitted not a single piece of additional evidence to support any of these assertions, continuing to rely exclusively on the telephone listings set forth in the Office Action.

The Examining Attorney also responded to Applicant’s evidence that “Mercer” had been registered on numerous occasions without a Section 2(f) showing, arguing that previous decisions by examining attorneys were not binding on him. In addition, the Examining Attorney stated that most of the MERCER marks cited by Applicant included additional matter that rendered the marks registrable.

In response to Applicant’s argument that he had not satisfied the Trademark Office’s burden of proof that the term “mercer” was understood to be primarily merely a surname, the Examining Attorney submitted dictionary evidence from rhymezone.com, relying on the third listed definition of Mercer as “a common surname.” However, the dictionary evidence submitted by the Examining Attorney supported Applicant’s argument, because the first and second definitions for the word “mercer” in rhymezone.com were nouns meaning (i) “a dealer in textiles” and (ii) “a British maker of printed calico cloth who invented mercenzing.” In other words, according to the Examining Attorney’s own evidence, there were two more significant meanings of the term “mercer” in the English language than its meaning as a surname.

Finally, the Examining Attorney made final his Section 2(e)(4) refusal to register Applicant's mark MERCER.

On July 16, 2004, Applicant filed a Request for Reconsideration of the Examining Attorney's final 2(e)(4) refusal. In the Request for Reconsideration, Applicant made of record numerous additional exhibits demonstrating that the term "Mercer" had several additional meanings among the purchasing public other than as a surname. Such evidence included:

- (i) a Google search of the word "Mercer" which only yielded six "hits" relating to individuals with the surname "Mercer" out of the first forty hits retrieved. (See Exhibit A to Request for Reconsideration.) Several of the other "hits" were references to geographical locations.
- (ii) To show the relatively small number of individuals in the United States with the surname "Mercer", Applicant compared the Examining Attorney's figures to the July 2003 U.S. Census Report to calculate that only .006% of U.S. population has the surname "Mercer."
- (iii) To show the geographical significance of the term "Mercer", and in particular the tremendous renown of "Mercer Street" among fashion-conscious consumers, Applicant submitted articles with references to Mercer Street and the SoHo fashion district from In Style Magazine, Town & Country Magazine, and Los Angeles Magazine. (See Exhibits B and C to Request for Reconsideration.)
- (iv) To show that the term "Mercer" is a common geographic designation, Applicant submitted internet website references to "Mercer" counties in Pennsylvania, Illinois, West Virginia, New Jersey, Wisconsin and Kentucky; "Mercer Island" in Washington state; "Mercer" towns in Maine, Missouri and North Dakota; "Mercer Caverns in California; "Mercer University" in Georgia. (See Exhibits D - H in Request for Reconsideration.)
- (v) To demonstrate that the term "Mercer" has historical significance, Applicant submitted internet website evidence consisting of a biography of Hugh Mercer, a famous Revolutionary War General. (See Exhibits I and J to Request for Reconsideration.)
- (vi) To demonstrate that other famous fashion design houses use the term "Mercer" to connote Mercer Street and all it represents to their fashion-conscious consumers, Applicant submitted internet evidence of third party use of "Mercer" by the world's most famous fashion house, Polo Ralph Lauren, and the fashion-forward retail chain Pottery Barn, for products

ranging from \$75 jeans to a variety of home furnishings. (See Exhibit K to Request for Reconsideration.)

In addition to proffering the above evidence conclusively establishing that the term “Mercer” had several other meanings besides a surname (namely as nouns in the English language, as a geographical reference, as a term with historical meaning, and as a term with significance to the fashion-conscious,) Applicant presented further legal precedent for the proposition that the “Mercer” term was not primarily merely a surname. In particular, Applicant applied the five factor test for determining whether a mark is primarily merely a surname set forth in In re Benthin Mgmt. GmbH, 37 U.S.P.Q. 2d 1332 (TTAB 1995), and painstakingly showed that under each of Benthin factors, the only conclusion could be that its MERCER mark does not primarily connote a surname to the relevant purchasing public. In particular, Applicant focused on the third Benthin factor, namely, whether the term in question had considerable meaning other than as a surname, and, applying all the evidence of record, showed that the term “Mercer” has several other meanings and signified many things to consumers other than a surname. Further, Applicant made additional arguments, and cited additional precedent, for the proposition that the consuming public was not likely to believe that the primary significance of its MERCER mark was as a surname, and also argued that, under Benthin, doubts were to be resolved in Applicant’s favor.

On September 1, 2004, the Examining Attorney denied Applicant’s Request for Reconsideration, stating simply that “[a]fter careful consideration of the law and the facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.” The Examining Attorney did not address any of Applicant’s evidence or additional arguments.

On October 12, 2004, Applicant filed a Notice of Appeal to the Board from the decision of the Examining Attorney finally refusing registration of the applied-for mark. This brief is respectfully submitted in support of Applicant's appeal.

IV. SUMMARY OF ARGUMENT

Under Section 2(e)(4) of the Trademark Act, marks that are "primarily merely a surname" cannot be registered without a Section 2(f) showing. However, the case law and commentators, as well as the TMEP, have clearly stated that in this context, "primarily merely" means only, or virtually only. In other words, if the evidence shows that the term in question has other significant meanings or connotations, or signifies things other than a surname to the relevant purchaser, then the term is not "primarily merely a surname" and is registrable without a further showing.

In its various submissions, Applicant presented compelling evidence that MERCER has significant meanings beyond that of a surname, such that the surname meaning is of secondary significance at best. Further, when Applicant's evidence is measured against the factors set out in Benthin, there can only be one conclusion, namely that MERCER is anything but "primarily merely a surname."

V. ARGUMENT

A. "Primarily Merely" a Surname" Has Been Interpreted to Mean "Only" or "Virtually Only" a Surname.

Section 2(e)(4) prohibits registration of a term that is "primarily merely a surname". However, under established law, "primarily merely" in this context has been interpreted to mean "only" or "virtually only" a surname.

As early as 1955, this Board interpreted the term "primarily" to mean "only." In Ex Parte Rivera Watch Corp., 106 U.S.P.Q. 145 (CCPA 1955), the Commissioner stated:

The terms "primary and secondary" have well understood meanings in trademark law. In construing "primarily" in Section 2(e) of the statute, we should, it seems to me, draw on that meaning. A trademark is a trademark only if it is 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 a surname significance. If it is, *and it is only that*, then it is primarily merely a surname. *Id.* at 149 (emphasis in original).

The Commissioner then found that the term RIVERA for watches was not primarily merely a surname, because the term had another significant meaning, namely a dictionary meaning in Spanish. Accordingly, the Commissioner held that an average watch consumer would not likely think of the term primarily merely as a surname, even though it had no other meaning in English.

Similarly, in Lane Capital Management, Inc. v. Lane Capital Management Inc., 192 F. 3d 337, 52 U.S.P.Q. 2d 194 (2d Cir. 1999), the Second Circuit Court of Appeals interpreted the term "primarily merely a surname" to mean "primarily only a surname", and held that since the word "Lane" did not only connote a surname, but had a dictionary meaning in English, it could be afforded full-fledged trademark protection without a Section 2(f) showing.

Professor McCarthy considered the same issue, and came out the same way, in his treatise McCarthy on Trademarks and Unfair Competition (4th Ed.), § 13:30. In posing the question "does the term have significance other than as a surname?" when conducting a "primarily merely a surname" analysis, McCarthy stated:

"...a mark is barred...only if purchasers, upon seeing the mark, will only recognize it as a surname and not as signifying some other meaning. Generally, marks having significance other than as a surname have been held not "primarily merely" a surname, and allowed registration..." [Emphasis added to word "only."]

Continuing the theme that "primarily merely" a surname means "only" or "virtually only" a surname, the Trademark Manual of Examining Procedure (3rd Edition, James E. Hawes Annotation)(hereinafter the "TMEP") recognizes that the issue of whether there are alternatives

to surname significance is determinative in a Section 2(e)(4) analysis. Section 1211.01(a)(i) of the TMEP states, “[i]f there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted....” See also In re Allied Mills, 150 U.S.P.Q. 757, 757 (TTAB 1966)(“[I]t appears...to be a significant factor in determining the issue before the Board whether a term which has surname significance may also be a baptismal name or have geographic or historic significance. In line with the rationale of these decisions, it is our conclusion that ‘WAYNE’, while grantedly a surname, has sufficient significance in its other meanings to take it outside the category of constituting primarily a surname.”); Ex Parte Omaha Cold Storage Co., 111 U.S.P.Q. 189 (CCPA 1956)(reversing a 2(e)(4) refusal with respect to the mark DOUGLAS and finding that DOUGLAS was the name of a Scottish clan, a surname, a geographical name for streets and localities, a species of fir tree, a species of squirrel, and a baptismal name.)

Thus, long established precedent makes it clear that for this Board to find that the term “Mercer” is a primarily merely a surname, it must accept the evidence proffered by the Examining Attorney to the exclusion of that proffered by Applicant, i.e. it must find that the relatively few number of telephone listings showing that “Mercer” is a surname support the proposition that this is the only significant connotation of the term. In other words, this Board must reject all the other evidence proffered by Applicant that MERCER means many other things, including, to Applicant’s fashion-conscious consumers, a reference to the famous Mercer Street shopping district in New York. As shown in greater detail below, clearly the surname significance of MERCER is not close to being its only significance to relevant consumers, and the mark is therefore not “primarily merely a surname.”

B. Under the Benthin Test, Applicant's Mark is Not Primarily Merely a Surname.

As argued to the Examining Attorney below in Applicant's Request for Reconsideration, the accepted test for determining whether a term is primarily merely a surname was established by this Board in In re Benthin Mgmt. GmbH, 37 U.S.P.Q. 2d 1332 (TTAB 1995). Under the Benthin test, Examining Attorneys are to consider five factors with respect to the mark: (1) is the word a common or rarely used surname; (2) does anyone connected with the applicant have that surname; (3) does the word have meaning other than as a surname; (4) does the word look and sound like a surname; and (5) is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression. Id. at 1333-34. For purposes of this appeal, clearly factor (3), i.e., whether MERCER has meaning in addition to its surname meaning, is most important to the analysis, and will be considered first.¹

1. The Evidence of Record Clearly Demonstrates that the "Mercer" Term Has Significant Meanings Other Than as a Surname.

As discussed above, Applicant presented considerable evidence that MERCER has several meanings and connotations to the relevant consuming public aside from its surname significance. For the most part, the Examining Attorney failed to even address this evidence or to present any evidence to the contrary.

a. The term MERCER Has Cultural Significance and Connotes Fashion to the Relevant Purchasing Public.

Most importantly, Applicant demonstrated that the "Mercer" term has a distinct cultural significance to the very consumer Applicant seeks to reach. This is the most important non-surname connotation for purposes of this analysis, since it is the connotation of MERCER to Applicant's consumer base that is determinative. As stated in the TMEP, "the determination

must relate to the relevant public, or to the subgroup of the public at large which constitutes the market for the goods or services identified in the subject application.” Id. at 488.

Applicant has amply demonstrated that, to its consumer, MERCER connotes Mercer Street in New York, which is synonymous with high fashion. As stated in the Brickner Dec., Applicant’s consumer is intended to and will immediately recognize MERCER as a reference to the Mercer Street area in New York’s fashionable SoHo district, where numerous chic, upscale boutiques and flagship designer name stores are located. Brickner further states that Applicant’s consumers are sensitive to fashion trends and are highly likely to be familiar with Mercer Street and the surrounding SoHo area. Indeed, Brickner states, the MERCER mark was specifically selected by Applicant to convey to its consumers the style and fashion-consciousness of the Mercer Street area.

Applicant submitted further evidence that numerous renowned designer brands maintain their flagship retail stores in or around Mercer Street in SoHo. Further, Applicant demonstrated that fashion-forward companies use the term MERCER in reference to apparel and home furnishing products, obviously to connote Mercer Street and fashion. Further, Applicant provided evidence of references to Mercer and Mercer Street in style and fashion magazines. Such references further demonstrate that the term MERCER connotes Mercer Street and fashion to fashion-conscious consumers.

Given the renown of Mercer Street among fashion-conscious consumers like those who purchase Yurman products, the primary significance of the MERCER mark to the relevant purchasing public, here Applicant’s high-end, fashion-conscious consumer, will be as a reference

¹ Applicant seeks to register MERCER in its typed form, no stylization or design is involved, and therefore the fifth factor is not considered in this decision.

to the Mercer Street area, with the clear connotation being that of style and high fashion. These consumers will not recognize MERCER as primarily merely a surname.

b. The Term “Mercer” has Geographic Significance.

In its Office Action Response and Request for Reconsideration, Applicant presented extensive evidence that the term “Mercer” has a variety of geographic connotations. In addition to connoting Mercer Street, Applicant demonstrated that an Internet search disclosed that many of the top 40 “hits” referred to “Mercer” as the name of a county or other geographical location in the United States (at least as many as referred to “Mercer” as a surname.) In particular, Applicant submitted Internet evidence that “Mercer” was a common geographic indicator, to wit, Internet references to Mercer Counties in six states, reference to a Mercer Island in Washington state, and reference to Mercer as the name of several towns and cities in the United States.

In cases where terms having surname significance have also been found to have geographic significance, courts have found the term to be registrable, and not primarily merely a surname. See In re Colt Indus. Operating Corp., 195 U.S.P.Q. 75, 78 (TTAB 1977) (“[A]ssuming arguendo that ...the term ‘FAIRBANKS’ is primarily a surname, we are of the opinion that the geographical significance of said term...is just as dominant in character as the surname significance”); In re Allied Mills, *supra*, (finding WAYNE not a surname in part because it has geographic meaning); Ex Parte Omaha Cold Storage, *supra*, (finding DOUGLAS not primarily merely a surname in part because it has geographic meaning.)

It may be argued that the term “Mercer” started out as a surname, and only gained geographical significance because streets (like Mercer Street), counties, cities and towns were named after people with the surname “Mercer.” This, however, is of no moment to the discussion here, because the issue is what “Mercer” connotes to consumers today. If, as the

result of the widespread use of Mercer, the term has shed its surname significance in the minds of consumers, and acquired a separate and independent meaning as a geographic reference, it is no longer primarily merely a surname. See Ex parte Stylofede Corp., 92 U.S.P.Q. 388 (CCPAQ 1952)(finding WINDSOR for knitting needles registrable because “Windsor” no longer connotes a surname name but instead is primarily a geographical name, as indicated by evidence that Windsor is a well-known castle in England, and there are numerous “Windsor” place names in England, Canada, and the United States.)

In the same regard, it is noted that, in 2002, the mark MADISON for leather goods, was registered in the name of Coach Industries, a high-end leather goods designer, Reg. No. 2,657,457. “Madison”, like “Mercer”, is the surname of an important historical figure, James Madison, for whom many streets, cities and counties in the United States have been named. Obviously, however, it was Madison Avenue in New York City, one of the premier shopping streets in the world, that Coach was referring to, not James Madison. Coach’s fashion-conscious consumers know Madison Avenue for its significance as a trendy shopping area, just as Applicant’s consumers will know MERCER to refer to Mercer Street, not Hugh Mercer for which it was named (see (d) below.)

c. The Word “Mercer” Has Dictionary Definitions That Establish Its Several Meanings in the English Language.

In the record below, Applicant demonstrated that MERCER has significant meanings in the English Language other than as a surname. First, in its Office Action Response, Applicant cited the Merriam-Webster Dictionary’s (“Webster”) definition of the word “merc-.” Webster defines “merc-” as “a dealer in usually expensive fabrics,” and explains that the word derives from the French word for merchant, “mercier.” Webster further indicates that the English words “merchant” and “mercantile” derive from the same root as “merc-”, i.e., “merc-.”

Moreover, evidence presented by the Examining Attorney from rhymezone.com supports Applicant's position that the term "mercer" has several dictionary meanings. Rhymezone.com defines "mercer" first as "a dealer in textiles", similar to Webster, and second, as "a British maker of printed calico cloth who invented mercenzing". Only after that does Rhymezone define "mercer" as "a common surname."

Dictionary evidence is considered strong evidence that a term has independent meaning in addition to surname significance. Several cases have found terms with surname significance to be registrable where their dictionary definitions indicate they also have meaning as words in English or other languages. In these instances, because of their dictionary meanings, the terms are not primarily merely surnames. See Fisher Radio Corp. v. Bird Elec. Corp., 162 U.S.P.Q. 265 (T.T.A.B. 1969)(finding BIRD for radios not primarily merely a surname even though "Bird" is the name of the Applicant's president); Lane Capital Management, Inc., supra, (finding LANE for an investment fund not a primarily merely a surname because "lane" has a meaning in English); Rivera, supra (holding RIVERA not primarily merely a surname because the word means a small stream or rivulet in Spanish.)

d. The Term "Mercer" Has Historical Significance.

In addition to all the other connotations, the term "Mercer" has historical significance. In its Request for Reconsideration, Applicant made of record evidence showing that Hugh Mercer was a well-known general in the Revolutionary War who died during the Battle of Princeton. Indeed, the evidence indicates that Mercer Street in New York was named after Hugh Mercer.

It is well-established that a term that has surname significance is not primarily merely a surname if that term also has recognized historical significance, e.g., where the surname is that of a famous person in history. See Michael S. Sachs Inc. v. Cordon Art B.V., 56 U.S.P.Q. 2d 1132

(TTAB 2000)(M.C. ESCHER, the name of a well-known, deceased Dutch artist registered for use on goods including computers, precious metals, costume jewelry, clothing, and games); Lucien Piccard Watch Corp. v. 1868 Crescent Corp., 165 U.S.P.Q. 459 (SDNY 1970)(DA VINCI mark for luggage registrable as Da Vinci, the surname of the famous 15th century artist Leonardo, has historical character and is no longer primarily merely a surname); Ex Parte Keuffel & Esser Co., 96 U.S.P.Q. 216 (Ex'r-in-Chief 1953)(holding SAMSON mark for measuring tapes registrable, as the word "Samson" has significance, importance and popular understanding as a well-known biblical character in addition to its significance as a surname.)

In light of the evidence of record, it is not surprising that the term MERCER alone, or in combination with other words having little or no trademark significance, has repeatedly been registered by the Trademark Office without a 2(f) showing. While, as the Examining Attorney indicated, this is not binding on him or the Trademark Office, it does indicate that other Examiners have been convinced that MERCER is not primarily merely a surname when used in other product categories.

Considering all of the evidence made of record showing that the term MERCER has many other connotations than its significance as a surname, including the connotation of fashion and style to the relevant consumer, as well as geographic, dictionary and historical significance, this Benthin factor overwhelmingly favors Applicant.

2. The MERCER Mark Does Not Look or Sound Like a Surname.

Another Benthin factor is whether the proposed mark looks or sounds like a surname. This is a subjective factor, and attempts to estimate the consumer's visceral reaction to the term. McCarthy on Trademarks §13:30. If the structure and pronunciation of the term has the look and sound of a surname, the more likely it is to be perceived by the public as a surname. See In re

United Distillers PLC, 56 U.S.P.Q. 2d 1220 (TTAB 2000) (the term HACKLER as used for alcoholic beverages would not be perceived as primarily merely a surname because the term did not have the look and feel of a surname).

As Applicant argued in its Request for Reconsideration, the term MERCER has neither the structure nor the pronunciation of a surname. The “-er” suffix is commonly added to words in the English language to create nouns out of verbs, such as “skier” or “rider”. The perception, therefore, of the word “mercer” is likely to be more in the nature of a word in the vernacular, as opposed to “Goldberg” or “Koslowski”, which are immediately recognized as surnames.

Accordingly, this Benthin factor favors Applicant.

3. The Evidence does not Establish that Applicant’s Mark is a Common Surname.

Another Benthin factor is the prominence of the mark as a surname. This is more a quantitative, or objective test. In the September 25, 2003 Office Action, the Examining Attorney attached residential telephone listings showing 16,000 references to Mercer as a surname nationwide. The Examining Attorney stated that such evidence was “highly conclusive” that the mark was primarily merely a surname.

While evidence of residential listings is often used in surname analyses, such evidence, standing alone, is not determinative. This Board has held that while telephone book evidence is a factor in determining a term’s surname significance, such evidence is not dispositive. In re Kahan & Weisz Jewelry Mfg. Corp., *supra*.

In its Office Action Response, Applicant showed that the 16,000 residential listings represented only .006% of the entire United States population, and many were duplicates. Applicant also presented Internet evidence revealing that “Mercer” appeared infrequently as a

surname in the results of a general search of the term. By no means did the Examiner conclusively establish by this evidence that Mercer is a common surname.

4. MERCER Is Not the Surname of Any Individual Connected With Applicant.

Another factor under Benthin is whether anyone connected with Applicant has the surname "Mercer." In its Request for Reconsideration, Applicant indicated that "Mercer" is not the surname of anyone associated with Applicant. This factor, therefore also favors Applicant. See In re Monotype Corp. PLC, 14 U.S.P.Q.2d 1070 (T.T.A.B. 1989)(holding CALISTO not primarily merely a surname, in part because it was not the surname of anyone connected with the applicant company.)

Accordingly, an examination of all the Benthin factors indicates that the analysis tips overwhelmingly in Applicant's favor. According to the evidence, the term MERCER has been shown to have several other significant meanings and connotations than as a surname, which is by far the most important factor. Further, MERCER does not look or sound like a surname, and the evidence fails to conclusively establish that it is a common surname. Finally, no one connected with Applicant has the surname MERCER. A fair consideration of the Benthin factors, therefore, results in the unmistakable conclusion that MERCER is not primarily merely a surname.

C. Doubt is to be Resolved in Favor of Applicant.

Finally, in determining whether a term is primarily merely a surname, doubt should be resolved in favor of the applicant. In re Benthin, supra, at 1334. Applicant believes that it has conclusively demonstrated that MERCER mark is not primarily merely a surname, but, at minimum, Applicant has raised substantial doubt that it is.

VI. CONCLUSION

For the reasons set forth above, Applicant submits that its mark is not primarily merely a surname. Accordingly, Applicant's mark is entitled to registration. The Board is therefore respectfully requested to overturn the Examining Attorney's decision refusing registration of Applicant's mark.

Respectfully submitted,

TORYS LLP

Dated: New York, New York
December 13, 2004

By:



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December 13, 2004

FIRST CLASS MAIL

Commissioner of Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Re: Ex Parte Appeal Brief
Applicant: Yurman Studios, Inc.
Mark: MERCER
Ser. No.: 76/512,936

Dear Sir or Madam:

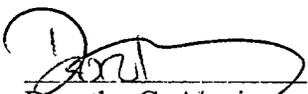
Enclosed please find the Ex Parte Appeal Brief of Yurman Studios, Inc. in support of its Application for Registering the Mark MERCER.

The Trademark Trial and Appeal Board is authorized to withdraw necessary funds to cover the filing fee from U.S.P.T.O. Deposit Account Number 502793.

Respectfully submitted,

TORYS LLP

By:


Dorothy C. Alevizatos, Esq.

Encl.



12-17-2004

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