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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kellogg North America Company

Serial No. 76610903

Patricia S. Smart of Smart & Bostjancich for Kellogg North America Company.

Anne Farrell, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Bucher and Mermelstein, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Kellogg North America Company has filed an application to register the mark KEEBLER (standard character form) for "snack packs consisting of a combination of crackers and cheese or cookies and pudding."¹

¹ Serial No. 76610903, filed September 7, 2004, alleging first use dates of July 14, 2004.

Registration has been finally refused under Section 2(e)(4) of the Trademark Act on the ground that the mark applicant seeks to register is primarily merely a surname.

Applicant has appealed. Applicant and the trademark examining attorney have filed briefs, and applicant filed a reply brief. We affirm the refusal to register.

The initial burden is on the examining attorney to establish a prima facie case that a mark is primarily merely a surname. If a prima facie case is established, the burden then shifts to the applicant to rebut the showing made by the examining attorney. The question of whether a term sought to be registered is primarily merely a surname may only be resolved on a case by case basis. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993).

The factors to be considered in determining whether a term is primarily merely a surname are the following:

- (1) The degree of a surname's rareness;
- (2) Whether anyone connected with the applicant has that surname;
- (3) Whether the word has any recognized meaning other than that of a surname; and

- (4) Whether the word has the look and sound of a surname.²

See In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

In this case, we agree with the examining attorney that the record contains sufficient evidence to make a prima facie case that the primary significance of the mark KEEBLER to the purchasing public for applicant's goods is that of a surname and that such showing has not been rebutted by applicant. Specifically, the examining attorney furnished evidence that a search of the LexisNexis ("USFIND Person Locator-Nationwide") database returned 492 residential listings of individuals with the surname "Keebler" (a printout of 100 of the retrieved listings was included); the results of a "Google" search (conducted August 19, 2005) for "keebler surname" which returned "hits" or website links for the homepages of the "Keebler family";³ "Surnames Forums Beginning with K" which lists "Keebler"; and "ancestors.com" which states that it will provide the coat of arms for persons with the "Keebler";⁴

² A fifth factor, not present in this case, concerns whether a mark which is presented in a stylized form is distinctive enough to create a separate non-surname impression.

³ <http://freepages.genealogy.rootsweb.com/>

⁴ <http://www.genforum.genealogy.com/keebler/>

surname. In addition, the examining attorney submitted an excerpt from The American Heritage Dictionary of the English Language (Fourth Edition 2000) that shows no entry for the word "keebler"; and the results of a search (also conducted on August 19, 2005) of the homepage of "FamilyHistory.com" for "KEEBLER" which indicates that the surname appears in census records and historical newspaper archives.

Applicant, with respect to its position, submitted a printout from the U.S. Census Bureau website estimating the 2004 U.S. population at approximately 293 million. Applicant argues that the evidence of record shows that "Keebler" is only very rarely used as a surname. Further, applicant argues that there is no evidence that any persons with the surname "Keebler" have received significant media coverage such that there is a public recognition of the surname. Applicant maintains that this case is unlike *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004), where the surname "Rogan" was rare in terms of frequency in the U.S. population, but there were repeated uses of the surname in the media, and the Board therefore concluded that "Rogan" was not a rare surname.

We recognize that unlike Gregory there is no evidence in this case of significant media coverage of any persons

with the surname "Keebler" such that we may conclude that "Keebler" is not a rare surname because of public recognition of "Keebler." Although KEEBLER may be a rare surname, it is nonetheless the case that even a rare surname is unregistrable (absent a showing of acquired distinctiveness) if its primary significance to purchasers is that of a surname. See, e.g., *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Further, this Board has held that "there is no minimum number of directory listings required to establish a prima facie case" in support of a surname refusal. *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). See also *In re Gregory*, supra at 1795 (no "per se benchmark" as to minimum number of listings); and *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

We find, therefore, that the results of the searches of the LexisNexis database and "Google," when combined with the "negative" dictionary evidence, are sufficient to establish the surname significance of the mark KEEBLER to the relevant purchasing public. In other words, the Board finds that the examining attorney's evidence is sufficient to support a prima facie case that the mark is primarily merely a surname.

Insofar as the second factor is concerned, applicant argues that no one associated with it has the surname "Keebler" and therefore this fact favors applicant. However, contrary to applicant's contention, the Board has stated that the fact that "a proposed mark is not the applicant's surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname." In re Gregory, supra at 1795. Thus, the fact that no one associated with applicant has the surname "Keebler" does not favor applicant, but rather is a neutral factor in this case.

With respect to the third factor, there is no evidence that KEEBLER has another recognized meaning, and in the absence thereof, this factor favors a finding that the mark KEEBLER is primarily merely a surname.

Despite applicant's argument to the contrary, we are of the opinion that KEEBLER looks and sounds like a surname. We cannot say that it does not have the look and sound of a surname. It is not an acronym, initialism or in the nature of a coined term. Also, we observe that "Keebler" is not unlike other surnames ending in "-ler" such as Miller, Butler, Wheeler, Fuller or Fowler. This

factor favors a finding that the mark KEEBLER is primarily merely a surname.

Finally, as evidence that it is entitled to registration of its mark in the absence of a showing of acquired distinctiveness, applicant relies on a prior registration which it owns, namely, Registration No. 0221594 for the mark KEEBLER (standard character form) for cookies, crackers, and biscuits. This registration issued on December 7, 1926, under the Trademark Act of 1905. According to applicant, surnames were prohibited from registration under this Act, and no provision existed for registration on the basis of acquired distinctiveness. Applicant, however, is not totally correct concerning the Trademark Act of 1905. Under this Act, a surname was not registrable unless it was shown that it had been used exclusively by the applicant as a trademark for the period of ten years prior to February 20, 1905, or was in special form. See Daphne Robert, The New Trade-Mark Manual: A Handbook on Protection of Trade-Marks in Interstate Commerce (1947) at p. 52. ("Names which had acquired secondary significance were not registrable unless they were used during the ten-year period or were printed, written, impressed or woven in some particular manner. In the latter case, even after registration, protection was

limited to the distinctive manner of display, and no rights were recognized in the name as such."). Thus, we are not persuaded that this registration supports applicant's position that it is entitled to registration without a showing of acquired distinctiveness. Moreover, in order to counter applicant's argument, we note that the examining attorney made of record a more recently issued registration owned by applicant, namely, Registration No. 1713496 for the mark KEEBLER (standard character form) for cookies, crackers, etc., issued September 8, 1999 under the provisions of Section 2(f) of the Lanham Act. This registration tends to support the examining attorney's position that applicant is not entitled to registration in the absence of a showing of acquired distinctiveness.

Balancing the factors, three of the four factors bearing upon the issue herein favor a determination that the primary significance of the mark KEEBLER to the purchasing public for applicant's snack packs is that of a surname, while the other factor is neutral. We find, therefore, that the examining attorney has presented evidence sufficient to establish that applicant's mark is primarily merely a surname and that applicant has failed to rebut the showing.

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Decision: The refusal to register applicant's mark under Section 2(e)(4) is affirmed.