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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re White Rock Distilleries, Inc.

Serial No. 77248231

Daniel I. Schloss of Greenberg Traurig, LLP for White Rock Distilleries Inc.

Gina M. Fink[1], Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Walters, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

White Rock Distilleries, Inc. (applicant) has filed an application to register on the Principal Register the mark TARLETON (in standard character form) for goods identified as "gin; distilled spirits" in International Class 33.[2]

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[1] The above application originally was examined by another examining attorney, but subsequently was reassigned to the attorney whose name is shown to prepare the appeal brief.

[2] Serial No. 77248231, filed August 6, 2007, and alleging a bona fide intention to use the mark in commerce.

Registration has been finally refused pursuant to Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that the mark is primarily merely a surname.

Applicant appealed and requested reconsideration of the refusal. The request for reconsideration was denied on February 10, 2009 and this appeal was resumed on February 24, 2009. Both applicant and the examining attorney filed briefs and applicant filed a reply brief.

After careful consideration of the evidence of record and the arguments of counsel and the examining attorney, we affirm the refusal to register.

Section 2(e)(4) of the Trademark Act precludes registration of a mark on the Principal Register which is "primarily merely a surname." Whether a term is primarily merely a surname depends on the primary significance of the term to the purchasing public. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975); and In re Champion International Corp., 229 USPQ 550 (TTAB 1985). The Office bears the initial burden to make a prima facie showing that the mark is primarily merely a surname. In re BDH Tow Inc., 26 USPQ2d 1556 (TTAB 1993) and the cases cited therein. In re Establissments Darty et Fils, 222 USPQ 260 (TTAB 1984), aff'd 759 F.2d 15, 225 USPQ 652 (Fed.

Cir. 1985). If that prima facie showing is made, then the burden of rebutting that showing shifts to the applicant. *In re Harris-Intertype Corp., supra*. If there is any doubt, we resolve the doubt in favor of applicant. In re Yeley, 85 USPQ2d 1150 (TTAB 2007); and In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

In the case of *In re Benthin Management GmbH, supra*, the Board identified five factors to be considered in determining whether a mark is primarily merely a surname:

(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?

(5) Is the word presented in use in a stylized form distinctive enough to create separate non-surname significance?

Because applicant seeks to register TARLETON in standard character form, the fifth factor is not factor in this case and we consider the record in light of the first four factors.

Considering first the rareness of the surname, we find the record sufficient to establish that TARLETON is not a rare surname. In this regard, the prior examining attorney made of record results of a search of the LEXIS/NEXIS® P-

FIND database showing a listing of 793 individuals with the surname TARLETON. She also made of record approximately eighty (80) excerpts of articles from LEXIS/NEXIS and the Internet that show individuals throughout the United States who have the surname TARLETON. The individuals include an artist, a candidate for political office, actors, a scientist, a meteorologist, a musician, a clown and a former news and sports reporter.

Applicant, citing In re Kahan & Weisz Mfg. Corp., 184 USPQ 421 (CCPA 1975), contends that "telephone directory evidence is not dispositive of the issue [of whether a mark is primarily merely a surname] standing alone." (Br. p. 5, n.3). However, as noted above, in addition to the telephone directory evidence, the examining attorney submitted excerpts of articles from the Lexix/Nexis® database as well as Internet excerpts showing TARLETON used as a surname.

Applicant further contends that 793 telephone directory "hits" from a comprehensive nationwide date base demonstrates that TARLETON is not a "common" surname and, in fact, is rarely used. While we agree that TARLETON is not a common surname, there is sufficient evidence to find that it is not rare. Moreover, even if we had found TARLETON to be a rare surname, a mark may be found to be

primarily merely a surname even though it is not a common surname. See In re Giger, 78 USPQ2d 1405 (TTAB 2006). See also In re E. Martoni Co., 78 USPQ2d 589 (TTAB 1975); and In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564 (TTAB 1988). In any event, there is no minimum number of listings needed to prove that a mark is primarily merely a surname.

Considering next the second *Benthin* factor, there is no evidence in this record that anyone connected with applicant has the surname TARLETON. The fact, however, that "a proposed mark is not 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, 70 USPQ2d 1792, 1795 (TTAB 2004). The absence of anyone associated with applicant who has the surname TARLETON is therefore neutral in assessing whether TARLETON would be perceived as a surname to the general public.

The third factor we consider is whether TARLETON has non-surname significance. Evidence that a word has no meaning or significance other than as a surname is relevant to determining whether the word would be perceived as primarily merely a surname. In re Petrin Corp., 231 USPQ 902, 903 (TTAB 1986). In connection with this factor, the

examining attorney has submitted excerpts from fifteen dictionaries showing that the word "Tarleton" has no identified meaning in these dictionaries.

Applicant, on the other hand, notes the *Wikipedia* entry made of record by the examining attorney indicating that a small village in the English countryside is called "Tarleton." We do not find the reference to a small village in England dispels the primary significance of TARLETON as a surname. See In re Hamilton Pharmaceuticals, Ltd., 27 USPQ2d 1939, 1943 (TTAB 1993) (The fact that a term is shown to have some minor significance as a geographic term will not dispel its primary significance as a surname.).

In addition, applicant contends that TARLETON is the phonetic equivalent of the term "tarlatan" which is defined as "a sheer cotton fabric…"[3] associated with Victorian clothing. The record contains no evidence, and we think it unlikely, that the ordinary U.S. purchaser of gin and/or distilled spirits is unlikely to be aware of the existence and meaning of the word "tarlatan" associated with Victorian clothing. Thus, whether or not TARLETON is the phonetic equivalent of "tarlatan" does not alter the

[3] Merriam-Webster Online Dictionary (2009).

surname significance of the term. See In re Pickett Hotel Co., 229 USPQ 760 (TTAB 1986) (The Board found the term PICKETT a surname, even though phonically equivalent to the word "picket."). We find applicant's additional arguments regarding any associations engendered by similarities between TARLETON and "tarlatan" or "tartan" unpersuasive.

Applicant also contends that "a search of 'Tarleton' in the same P-FIND database used by the Examining Attorney yields hundreds of results in which the term appears **as a first name rather than a surname**; and also that approximately **200 news articles** (as well as published books and articles) reference Tarleton Gillespie, a high profile professor at Cornell University who has also worked as a critic and journalist." (Br. p. 5)(emphasis supplied). While applicant has offered evidence of use of TARLETON as a first name, we nonetheless find such first-name use insufficient to overcome the surname significance of the term. First, as pointed out by the examining attorney, "[t]he current practice of adopting last names for use as first names often does not change the way the public views a name. A surname used as a first name will often be first and foremost perceived as a surname and then understood, in context, as being a 'unique' or 'creative' first name." (Br. p. 6).

Further, we do not find the webpage taken from Baby Names World (http://babynamesworld.parentsconnect.com) indicating "Tarleton" is a boy's name of English origin warrants a different conclusion as to the surname significance of TARLETON.

In addition, although applicant contends that its P-FIND search resulted in a listing of 650 individuals with the first name of TARLETON, a review of those results shows that there are a substantial number of duplicates. Moreover, even if the listing identified 650 discrete individuals, we cannot say that the term is so commonly used as a given name that it will be readily perceived by the public as both a given name and a surname. See e.g., Hamilton Pharmaceuticals, *supra* (The primary significance of HAMILTON to the purchasing public is as a surname, despite the assertion that the term has meaning as a given name.).

Last, the record does not support applicant's contention that Tarleton Gillespie is so well known that the consuming public perceives the term "Tarleton" as both a first name and a surname. While Mr. Gillespie's name appears in 198 newspaper articles that either reference him or are written by him, 184 of those articles were reviews written or co-written by Mr. Gillespie, or discussions of

those reviews, and appeared in The San Diego Union-Tribune. From these excerpts, we can at best presume that persons in and around the San Diego area may be familiar with Tarleton Gillespie, but this hardly makes him well known by the public at large such that they readily perceive TARLETON as something other than a surname. Notably, another five articles referencing Mr. Gillespie appear in the University Wire – a publication apparently associated with Cornell University. Here again, the public's familiarity, if any, with Mr. Gillespie appears to be geographically limited. We accordingly find that the evidence fails to demonstrate any degree of renown of Tarleton Gillespie such that average members of the purchasing public readily perceive TARLETON as a given name.

We similarly find applicant's submission of a webpage of a biography for Brigadier General Tarleton H. Watkins and an except from the My Space page of Tarleton H. Watkins II unpersuasive.

We thus find that the evidence submitted by applicant fails to overcome the surname significance of TARLETON.

Finally, we consider whether TARLETON has the "look and feel" of a surname, the determination of which is concededly somewhat subjective in nature. When a term does not have the look and feel of a surname, this factor

clearly favors the applicant. On the other hand, when it looks and feels like a surname, such a finding merely tends to reinforce a conclusion that the term's primary significance is as a surname. In this case, TARLETON, on its face, does not look like a coined term or an acronym, or anything else but a surname. Indeed, it seems to fit the archetype of surnames having a "-ton" suffix, such as Washington, Benton, Pennington and Covington. Further, and as stated above, although there is evidence that TARLETON has some significance as a given name, contrary to applicant's contention, we do not find that it is so common a first name, or that the general public has been so exposed to it as the given name of a well-known person, that it no longer looks or feels like a surname.

In sum, although applicant has demonstrated that TARLETON has some given-name significance, the record establishes TARLETON is primarily merely a surname. Thus, when we view the term under the factors set out in *Benthin*, we conclude that the examining attorney has met her initial burden of showing that TARLETON would primarily be viewed as a surname and applicant has not rebutted this prima facie case. While applicant correctly points out that any doubt as to whether its mark is primarily merely a surname

should be resolved in its favor, the record leaves us no doubt to be resolved.

Decision: The refusal under Section 2(e)(4) of the Trademark Act is affirmed.