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

Proceeding	77248231
Applicant	White Rock Distilleries, Inc.
Applied for Mark	TARLETON
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Submission	Appeal Brief
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Date	04/27/2009

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

In re Application of:	)	
White Rock Distilleries, Inc.	)	**Law Office 109**
Serial No.: 77/248,231	)	
Filed: August 6, 2007	)	**Examining Attorney:**
Trademark: TARLETON	)	**Sonya B. Stephens**
	)	

APPLICANT'S APPEAL BRIEF

TABLE OF CASES

In re Joint-Stock Co. "Baik," 84 U.S.P.Q.2d 1921, 2007 WL 2460997 (T.T.A.B. 2007)..... 4, 7

In re Benthin Management GmbH, 37 U.S.P.Q.2d 1332, 1333-34 (T.T.A.B. 1995)..... 4, 5

In re Kahan & Weisz Jewelry Mfg. Corp., 184 U.S.P.Q. 1421 (C.C.P.A. 1975). 5

In re Sava Research Corp., 32 U.S.P.Q.2d 1380, 1381 (T.T.A.B. 1994)..... 4

I. INTRODUCTION

This ex parte appeal is from a final refusal under Section 2(e)(4) to register Applicant's mark TARLETON for "gin; distilled sprits" (hereinafter "Applicant's Mark"). Applicant respectfully requests that the Board reverse the final refusal to register because Applicant's mark is not "primarily merely a surname" and is extremely unlikely to be perceived as such by consumers.

On November 19, 2007, the Examining Attorney in a First Office Action refused registration under Section 2(e)(4), citing 767 "hits" in a national telephone directory database listing "Tarleton" as a surname. The Examining Attorney further volunteered that "it appears that TARLETON is the name of an English village in Lancashire" and attached evidence to this effect, but hastened to add that "the fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname."

Applicant responded on May 16, 2008, noting that the small number of telephone references proffered by the Examining Attorney did not demonstrate that consumers would perceive the mark TARLETON as a surname. On August 4, 2008, the Examining Attorney issued a final refusal, updating the telephone database results to yield 793 results rather the original 767, and citing 80 mentions in news articles of people having the surname "Tarleton."

On February 4, 2009, Applicant filed a Notice of Appeal and a Request for Reconsideration, and made a number of evidentiary submissions, including the following: (1) a "P-Find" Lexis-Nexis telephone database search like the one searches proffered by the Examining Attorney, in which the name "Tarleton" generated hundreds of results in the telephone directory database as a first name rather than a surname; (2) a baby name database listing confirming that "Tarleton" is a given name

for boys; (3) more than 200 newspaper articles and other materials referring to or authored by Professor Tarleton Gillespie of Cornell University, who is the author of multiple published books and articles. The Examining Attorney denied the request for reconsideration on February 10, 2009, whereupon this appeal resumed.

II. ARGUMENT: THE EVIDENCE OF RECORD SHOWS REASONS FOR SIGNIFICANT DOUBT AS TO THE LIKELY PUBLIC PERCEPTION OF APPLICANT'S MARK, WHICH DOUBT MUST BE RESOLVED IN APPLICANT'S FAVOR

The Board must weigh all the evidence of record to determine whether the mark is primarily merely a surname[1], using the following applicable factors[2] in evaluating the likely significance of the mark to the public:

(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?

If there is any doubt after these factors have been considered, such doubt must be resolved in favor of Applicant. Id. at 1334; see also, In re Joint-Stock Co. "Baik," 84 U.S.P.Q.2d 1921, 2007 WL 2460997 (T.T.A.B. 2007). At the very least, the evidence of record demonstrates that there are ample grounds to doubt that the public will view the mark TARLETON as signifying primarily merely a surname.

[1] In re Sava Research Corp., 32 U.S.P.Q.2d 1380, 1381 (T.T.A.B. 1994).
[2] In re Benthin Management GmbH, 37 U.S.P.Q.2d 1332, 1333-34 (T.T.A.B. 1995).

Taking the relevant Benthin factors in turn:

(1) The Examining Attorney has mustered 793 telephone directory "hits" from a comprehensive nationwide database containing many millions of listings.[3] Thus, "Tarleton" is not a "common" surname by any objective measure and in fact is "rarely used";

(2) No one connected with Applicant has the surname "Tarleton";

(3) The Examining Attorney has made of record a Wikipedia entry indicating that a small village in the English countryside is called "Tarleton." Further, Applicant has made of record definitions of the phonetically similar words "tarlatan" and "tartan" that serve to enhance a general consumer perception that the mark TARLETON has something to do with the United Kingdom;

(4) Applicant has shown 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.

The significant evidence submitted by Applicant from the very same P-FIND telephone directory database used by the Examining Attorney showing "Tarleton" as a first name was

[3] In any event, Applicant notes that telephone directory evidence is not dispositive of the issue standing alone. See In re Kahan & Weisz Mfg. Corp., 184 U.S.P.Q. 421 (C.C.P.A. 1975).

barely mentioned by the Examining Attorney in denying Applicant's Request for Reconsideration. Similarly, the approximately 200 news article references to Professor Tarleton Gillespie were glossed over without explanation.

Instead, the Examining Attorney chose to submit evidence to the effect that various dictionaries had no entries for the word "tarleton," arguing in essence that the absence of dictionary entries should be viewed as dispositive on the issue of consumer perception of a rare surname. Applicant respectfully submits that this argument is inapposite.

It should be noted that the Examining Attorney has not disputed that the words "tarlatan" and "tartan" are phonetically very similar to TARLETON, and further that each of these words has some significant connection to the United Kingdom, as does the Examining Attorney's own geographic evidence accompanying the first Office Action. Taken together, these facts all reinforce Applicant's position that the mark TARLETON simply "sounds British" to the general public and that the term is not primarily merely a surname.

III. CONCLUSION

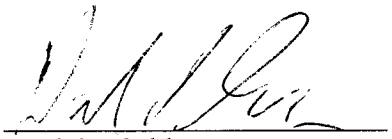
Applicant respectfully urges the Board to consider carefully all the evidence of record in light of the requirement that any doubts regarding the question of whether a mark is "primarily merely a surname" be resolved in Applicant's favor. It is clear that there is enough in the record of this application to establish ample doubt on this issue.

Finally, Applicant notes the policy purposes of Section 2(e)(4) would not be served by affirming the refusal of registration in this case. As Judge Seeherman has noted in her concurrence in In re Baik:

> The purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames, as though there were something offensive in viewing a surname. Rather, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses, in the same manner that merely descriptive terms are prohibited from registration because competitors should be able to use a descriptive term to describe their own goods or services. . . .
>
> If a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.[4]

In light of the foregoing, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register Applicant's Mark under Section 2(e)(4).

Respectfully submitted,



Dated: April 27, 2009 By:

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[4] In re Baik, 2007 WL 2460997 at * 4 (citations omitted).