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

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

Applicant:	Reebok International Limited)	
)	
Serial No.:	78/271,326)	Examining Attorney:
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Filed:	July 8, 2003)	
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Mark:	J.W. FOSTER)	Law Office 110

APPLICANT'S APPEAL BRIEF

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Mark:	J.W. FOSTER)	
)	Date: April 19, 2005

APPLICANT'S APPEAL BRIEF

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I. BACKGROUND OF THE ACTION

On July 8, 2003, applicant, Reebok International Limited, filed an application to register the mark J.W. FOSTER for clothing, footwear and headwear. The application was assigned Ser. No. 78/271,326. On January 14, 2004, an office action issued rejecting the application because the mark was alleged to be primarily merely a surname under Section 2(e)(4) and requesting clarification of the goods.

Applicant responded to the official action on July 19, 2004, amending the definition of goods to specify the specific clothing items covered under the mark (hereinafter broadly referred to as "clothing") and arguing that the mark J.W. FOSTER was not primarily merely a surname.

On August 18, 2004, a final office action issued continuing the refusal under Section 2(e)(4). A request for reconsideration, submitting additional evidence, was filed on December 27, 2004, which request for reconsideration was denied on January 31, 2005. This ex parte appeal was then filed on March 3, 2005.

II. ISSUE PRESENTED

The issue presented by this appeal is whether the mark J.W. FOSTER for clothing, footwear and headwear is primarily merely a surname within the meaning of Section 2(e)(4) of the statute.

III. SUMMARY OF POSITIONS OF EXAMINING ATTORNEY AND APPLICANT

The examining attorney contends that the mark is primarily merely a surname, relying on the cases of In re I. Lewis Cigar Mfg. Co., 98 USPQ 265 (CCPA 1953) (S. SEIDENBERG & CO'S); In re Nelson Souto Major Piquet, 5 USPQ2d 1367 (TTAB 1987) (N. PIQUET); In re Taverniti, Sarl, 225 USPQ 1263 (TTAB 1985), recon. denied, 228 USPQ 975 (TTAB 1985) (J. TAVERNITI); and Ex parte Sears, Roebuck & Co., 87 USPQ 400 (P.O. Ex. Ch. 1950) (J C HIGGINS). While not mentioning the case of Michael S. Sachs, Inc., v. Cordon Art B.V., 56 USPQ2d 1132 (TTAB 2000) (MC. ESCHER), the examining attorney further contends that applicant's mark is not famous, thereby attempting to distinguish the Sachs case.

In contrast, it is the applicant's position that:

1. The mark must be viewed in its entirety, and when so viewed, it is a personal name rather than primarily merely a surname.

2. The Sears case is wrong and should not be followed, as suggested by Board Member Seeherman.

3. In any event, applicant's mark is sufficiently known to bring it within the holding of the Sachs case.

4. Further, the name Foster is both a given name and a surname, thus making the case of In re Oliver Bernd Freier GmbH & Co., KG, 20 USPQ2d 1878 (TTAB 1991), controlling.

5. Finally, the examining attorney erred in not accepting the mark on the Principal Register with a disclaimer of FOSTER if the examining attorney was correct that the mark is primarily merely a surname.

IV. ARGUMENT

1. Case Law

The Court of Appeals for the Federal Circuit has stated, "The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis." In re Etablissements Darty et Fils, 225 USPQ 652, 653 (Fed. Cir. 1985). The statute, Section 2(e)(3), now Section 2(e)(4), reflects the common law principle that exclusive rights in a surname cannot be established without evidence of long and exclusive use. Ibid. Since surnames are shared by more than one individual,

each individual may have an interest in using his/her surname in his/her business unless the name has become distinctive of another's business. Ibid.

This concept was apparently extended to surnames combined with a single initial, presumably because there would be many individuals of the same surname and a given name sharing the same letter. The argument presented was that the single initial simply emphasized the surname significance of the overall mark. In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1368 (TTAB 1987). Thus, the mark S. SEIDENBERG & CO'S was found to be primarily merely a surname. In re I. Lewis Cigar Mfg. Co., 98 USPQ 265 (CCPA 1953). Likewise, the mark N. PIQUET in signature form was found to be primarily merely a surname in a 2-1 decision. In re Nelson Souto Major Piquet, 5 USPQ2d 1367 (TTAB 1987). The dissenting opinion by Board Member Seeherman took strong exception to the majority opinion because the depiction of the mark left the impression that the mark was the name of a particular individual rather than being "primarily merely a surname."

The question of whether or not a term is primarily merely a surname within the meaning of the statute depends upon what is perceived by purchasers to be its primary significance. In re Kahan & Weisz Jewelry Mfg. Corp., 184 USPQ 421 (CCPA 1975); Michael S. Sachs, Inc. v. Cordon Art B.V., 56 USPQ2d 1132, 1136 (TTAB 2000); In re Nelson Souto Major Piquet, supra; In re Louis Caballero, S.A., 223 USPQ 355 (TTAB 1984). Does the mark have the look and feel of a surname? In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000) (HACKLER does not have the look and feel of a surname). Clearly, J.W.

FOSTER has the look and feel of a personal name, not a surname. If the principal significance of a term is that of a surname, it is prohibited from registration on the Principal Register without proof of secondary meaning. On the other hand, if there is a readily recognized meaning of the term apart from its surname significance, registration should be granted.

The TMEP recognizes that the rarity of a surname is a factor to be considered in determining whether a term is primarily merely a surname. TMEP § 1211.01(a)(v).

Marks such as LADY HILTON, In re Hilton Hotels Corp., 166 USPQ 216 (TTAB 1970), and LADY PENN, In re Penn Dairies, Inc., 137 USPQ 168 (TTAB 1963), have been held to be not primarily merely a surname.

It should be noted that the prohibition against registering a surname without proof of distinctiveness relates to surnames and not personal names. Thus, it has been held that where a given name is combined with a surname, the entire mark is not primarily merely a surname. See Ex parte Dallieux, 83 USPQ 262 (Com. Pat. 1949) (ANDREW DALLIOUX). Accordingly, a mark such as JOHN FOSTER would be considered a personal name and not a surname.

a. Cases Involving Two Initials and a Surname

A more difficult case arises when first and middle name initials are added to the surname. The two cases most applicable to the present situation are Ex parte Sears, Roebuck & Co., 87 USPQ 400 (P.O. Ex. Ch. 1950), and Michael S. Sachs, Inc. v. Cordon Art B.V., 56 USPQ2d 1132 (TTAB 2000). The former case

involved the mark J C HIGGINS for shotguns, with the mark being written in conventional type without periods and being asserted to be the name of a particular individual. The Examiner in Chief in the Sears case characterized the issue as follows at 402:

The only substantial question presented for decision is whether the surname in the combination "J C Higgins" is unduly emphasized or otherwise constitutes the only significant part of the mark so that the mark as a whole can still be characterized as primarily merely a surname.

The Examiner in Chief in Sears went on to observe at 402:

It is true that initials may be distinctive and may be subject to trademark use and registration in and of themselves, but when associated with a surname they become a subordinate and relatively unimportant part of the mark as a whole.

The Examiner in Chief cited infringement cases that suggested that little attention should be paid to the presence of initials and that they were not of any great significance in the trademark use of a name. Thus, he concluded that the mark could not be registered unless applicant disclaimed the surname Higgins apart from the mark as shown.

On the other hand, the Sachs case, decided 50 years later, involved the mark M.C. ESCHER for a variety of goods in International Classes 9, 14, 16, 24, 25, 27 and 28. M.C. ESCHER referred to a deceased Dutch artist, Maurits Cornelis Escher, who died in 1972. In Sachs, a contrary conclusion was reached because the primary significance of the mark was that of a particular Dutch artist and not simply an unknown surname. The court concluded at 1136:

The mark M.C. ESCHER would no more be perceived as primarily merely a surname than the personal

names P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle.

Did the Board reached this conclusion because M.C. Escher was well known to art aficionados, was the name of a particular individual, or because any member of the public, upon seeing a surname preceded by two initials, would perceive the same to be a personal name rather than "primarily merely a surname"?

In both cases, as in the present case, the marks referred to a particular individual. The only difference in the two cases is the notoriety of the individuals involved. If the initials and surname are known to some unspecified number of individuals, the mark can be registered to the presumed exclusion of others with the same surname.

The spectrum of protection afforded by current case law is thus quite confusing. Rare surnames may be registrable on the Principal Register; surnames with two initials that designate a well-known individual are registrable on the Principal Register; surnames with two initials that do not meet the appropriate level of notoriety or fame are prohibited from registration on the Principal Register without proof of distinctiveness; and surnames with only one initial are not registrable on the Principal Register, again without proof of secondary meaning. No case discusses the level of proof necessary to move double initial cases from one category to another or whether that proof can be in a niche market. Lost in this analysis is the meaning of the statutory language - namely, the meaning of the words "primarily" and "merely." What is the alternative to being primarily merely a surname? The mark can have another meaning such as "Prince," the mark can be a given name, or the mark can be a

personal name. Who makes this determination? The case law is clear that it is the purchaser who makes this determination.

It is respectfully contended that the examining attorney has offered no proof that a purchaser would conclude that J.W. FOSTER is merely a surname, used by many, with no reference to a particular individual. It is not a question of whether that individual is known or not; rather, the issue is whether the purchaser will think the mark references a particular individual with the initials J.W. or whether this mark designates all individuals by the name of Foster. The latter scenario is not believable.

If one goes back to the basic common law principle that surnames or even surnames accompanied by a single initial are shared by more than one individual and thus should be available for use in his/her business, does that hold true when you add two initials? In other words, when does a mark cease to be primarily merely a surname and become a personal name? When you add two letters to the surname, the possibility that an individual having the same surname and the same first two initials, all used in the same or related business, is simply too rare and farfetched to prevent a legitimate business owner from registering its mark.

2. The Sears Case is Bad Law and Is Contrary to Common Sense

This Board has not considered the precise issue presented by the Sears case, nor has this issue been considered by the Court of Customs and Patent Appeals and its successor, the Court of Appeals for the Federal Circuit. Sears,

Roebuck & Co. did appeal the case to the District Court and subsequently to the Court of Appeals for the District of Columbia. The Court of Appeals agreed with the view of the Examiner in Chief that the initials were not sufficient to prevent the mark from consisting of “primarily merely a surname.” The basis for this conclusion was the contention that the dominating feature of the mark was the surname Higgins and thus “the mark should be characterized as primarily merely a surname notwithstanding the initials.” As to the suggestion that the mark was not merely a surname, the court stated at 96 USPQ 363: “It is principally merely a surname and, therefore, primarily merely so.”

The period of time when this case was decided and its influence on those hearing the Sears appeal need to be considered. For more than 40 years, the Trademark Act of 1905 prohibited registration of a mark if it “consists merely in the name of an individual . . . not written, printed, impressed or woven in some particular or distinctive manner. . . .” Section 5, 33 Stat. 726 (1905). In 1942, the Court of Customs and Patent Appeals canceled another registration of Sears for the mark THRIFTILY YOURS BOB BURNHAM. In re Sears, Roebuck & Co., 56 USPQ 166, 169 (1942). The basis of the opinion was that the last name of the individual was the mark’s dominating feature and thus was unregistrable because it was not written, printed, impressed or woven in some particular or distinctive manner. It has been suggested by at least one member of this Board that the general reluctance to register individual names under the 1905 Act had a residual influence on both the Examiner in Chief and the Court of Appeals. See

In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1368 (TTAB 1987)

(Seeherman dissenting opinion).

When the ESCHER case was decided 50 years later, the Board found a convenient way to distinguish the 1950 Sears case. Michael S. Sachs, Inc. v. Cordon Art B.V., supra. As previously quoted at 1136, "The mark M.C. ESCHER would no more be perceived as primarily merely a surname than the personal names P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle." Yet, it cannot be ignored that the mark was still dominated by the surname Escher. Common sense required the Sears case to be ignored with the result that the correct decision was reached in the Sachs case.

Both the Examiner and Chief and the Court of Appeals were wrong in their reliance upon the "dominance" theory. This theory was derived from the reasoning in Thaddeus Davids Co. v. Davids, 233 U.S. 461 (1914), where the mark C.I. DAVIDS was held to be a simulation of the mark DAVIDS. The issue of whether a surname preceded by two initials is likely to cause confusion with a mark consisting of the same surname is totally irrelevant to the issue of whether the mark is primarily merely a surname or a personal name. Likelihood of confusion issues require one to look at the dominant portions of conflicting marks. That issue is not relevant in surname cases. Rather, the issue is whether the mark, viewed in its entirety, will be perceived by the purchasing public as "primarily merely a surname" or something else. Here that "something else" is a personal name designating a particular individual, even if unknown.

The suggestion by the Patent Office Examiner in Chief in Ex parte Sears, Roebuck & Co. that little attention should be paid to the presence of initials and that they are not of any great significance in the trademark use of a name is simply wrong and clearly contrary to the law today. Thus, the Sears case should be overruled.

3. The Mark J.W. FOSTER Must Be Perceived in Its Entirety

The basic concept that a mark must be perceived in its entirety is fundamental to likelihood of confusion cases. As stated by the Supreme Court in Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920):

The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.

Thus, attention must be paid to initials when they are present.

The Federal Circuit echoed this principle in In re Hearst Corp., 982 F.2d 493, 494, 25 USPQ2d 1238, 1239 (Fed Cir. 1992): “[M]arks tend to be perceived in their entireties, and all components must be given appropriate weight.” While these statements were made in likelihood of confusion cases, this basic principle should also apply to a determination of whether a mark will be perceived by the purchasing public as a personal name or surname. The primary significance of a mark must be determined from the mark as a whole.

The examining attorney can take judicial notice of the fact that many individuals have given names comprising initials. Thus, the term "J.W." is the full equivalent of a given name and would be clearly recognized as such by the purchasing public. The examples given in the Sachs case of P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle clearly illustrate individuals using initials as a given name. The general trend is to use double initials, the one current exception being a reference to President Bush as simply "W."

It really comes down to basic common sense. What will purchasers perceive the primary significance of J.W. FOSTER to be when seeing this mark used on the goods recited in this application? Purchasers do not overanalyze marks to determine whether they are primarily merely a surname or a personal name. No purchaser is going to say that this mark is primarily merely a surname because there must be a lot of individuals in the world with the surname Foster and given and middle names beginning with the initials "J" and "W." Rather, they are going to look at the mark and think this refers to a particular individual. Thus, it would be perceived as a personal name rather than a mere surname, even if the individual is unknown. That may not be the only significance of the mark, but it certainly must be the primary significance of the mark upon seeing the letters "J.W." combined with "FOSTER." Obviously, the primary significance is not just "merely a surname." Put another way, the use of initials takes this mark out of the category of being just "primarily merely" a surname. It becomes a personal name or, as discussed hereinafter, it can be a given name preceded by a double initial.

The purchaser will be right when he/she assumes that the mark designates a particular individual as discussed below. In summary, for the examining attorney's position to prevail, it must be shown that the primary significance of "J.W. FOSTER" is just merely a surname without any suggestion of a particular individual by the personal name of J.W. Foster, whether that individual is known to the purchaser or not. That is clearly not the case.

4. If The Sears Case Is Not Overruled, It Should Be Distinguished Along the Lines of the Sachs Case

J.W. Foster was the name of a manufacturing company that began in 1895 by Joseph William Foster, a British runner who fabricated running shoes. By 1908, Foster shoes gained popularity by athletes, and thus the company J.W. Foster & Sons Company was formed as makers of quality athletic shoes. J. W. Foster created running spikes. J. W. Foster running spikes were worn by runners who competed in the 1924 Olympic Games and were the subject of the movie "Chariots of Fire." See www.collegeresearch.us/show_essay/38170.html. In 1958, Jeffrey and Joseph William Foster established their own company, calling it Reebok. It is respectfully contended that in the track world, J.W. FOSTER has a significant meaning as the name of a company and is not simply "primarily merely a surname." Furthermore, J.W. Foster is a street name in Canton, Massachusetts, where Reebok is located. J.W. Foster Boulevard has been in existence for approximately five years.

To a runner, the name J.W. FOSTER has far greater fame and significance than the name/mark M.C. ESCHER. It is a name reinforced by

history and by the naming of a street in Canton, Massachusetts. Purchasers will not perceive that the street is named after all Fosters in the country. There is no other significance to this street than the fact that it is named after a particular individual, even if the consuming public does not know who that individual is. Just as the Sachs case found the mark M.C. ESCHER to be something more than just “primarily merely a surname,” this case is likewise distinguishable from Sears because J.W. FOSTER is something more than primarily merely a surname. It is at least a personal name like M.C. ESCHER. Accordingly, even if the Sears case is not overruled, it should be clearly distinguished in this case.

**5. J.W. FOSTER Is a Personal Name, Not
Primarily Merely a Surname**

The present application does not seek to register just the word “FOSTER” or the word “FOSTER” with a single initial. It may well be that there are too many individuals in the world having the same surname and a given name with a single initial. Thus, a mark such as J. FOSTER might maintain the mantra of a surname rather than a personal name. However, when two initials are added (i.e., J.W. FOSTER), the mark is more likely to be perceived in its entirety as designating a particular personal name rather than some broad category of common surnames. This is true with respect to any surname combined with two initials. The dissenting opinion by Board Member Seeherman in In re Nelson Souto Major Piquet, supra, took this position even though a single initial was used. The fact that the single initial was in the form of a signature was thought to be sufficient to render the name a personal name rather than primarily merely

a surname. When a double initial is used, the mark clearly is a personal name, designating a particular individual, and not a surname designating a broad category of individuals having FOSTER as a surname.

6. The Present Case Is Distinguishable Because FOSTER Is Also a Given Name

The cases relied upon by the examining attorney as well as those discussed above including the Sachs, Lewis Cigar, Nelson, and Sears cases involve marks that had no other meaning except as a surname - namely, respectively, ESCHER, SEIDENBERG, PIQUET, and HIGGINS. In this case, however, FOSTER is both a given name and a surname. In support of the contention that FOSTER is also a given name, please note the following registrations attached as Exhibit A to applicant's Request for Reconsideration.

Mark	Reg. No./Ser. No.
FOSTER GRANT	703,527
FOSTER GRANT	761,405
FOSTER GRANT	731,333
FOSTER WHEELER	1,244,800
FOSTER HIGGINS	1,698,007
FOSTER CLARK'S	74/429,285 abandoned - no SOU filed
FOSTER RAINEY	1,918,878

Who is to say whether the given name or surname significance is the greater?

This situation is similar to In re S. Oliver Bernd Freier GmbH & Co., KG, 20 USPQ2d 1878 (TTAB 1991), involving the mark S. OLIVER for handbags, umbrellas and parasols. The examining attorney took the position that OLIVER was a surname. The examining attorney submitted extensive telephone directory evidence that conclusively established that OLIVER was a surname, and the applicant did not dispute that fact. However, the applicant argued that OLIVER was also a given name. In reversing the examiner, the Board stated:

As we have said in the cases of other alleged marks which consist of a term which is primarily merely a surname and a preceding initial, the presence of an initial before a surname normally would be viewed as reinforcing the surname significance thereof. However, in this case it has been noted that OLIVER is a given name as well as a surname and it appears that the given name significance is as well known as the surname meaning. In this case, an initial before the name OLIVER may well be perceived as indicating two given names as in S. Oliver (Bowles) or S. Oliver (Lane). There is, therefore, a certain ambiguity present in this mark so that it cannot be predicted whether the perception of the consuming public would be as a surname or a given name. In view thereof, we will resolve that doubt in favor of the applicant.

Board member Seeherman concurred in the reasoning and result of the majority opinion, but she also indicated that she would reverse the refusal for an additional reason. She stated at 1879:

The only way the addition of "S." to OLIVER could transform the term OLIVER into having surname significance is by making it appear that S. OLIVER is the name of an individual with a first name represented by the initial "S" and the surname of OLIVER. However, when the mark is viewed in this manner the mark as a whole is not primarily the surname OLIVER; rather, it would be perceived as the name of a person. To treat S. OLIVER as primarily merely a surname would result in the anomalous situation of allowing registration of what is arguably the "surname" portion of the

mark when the term is used alone, but when an initial is added to the non-surname term so that it appears to be a person's name, the name is refused registration because the surname significance of one portion of the mark becomes evident. Such a result is not mandated by the Statute, case law or common sense.

7. Doubt Should Be Decided in Applicant's Favor

Certainly there is doubt as to the perception of the purchaser concerning the mark's surname significance as compared to its personal name significance. As in descriptiveness cases (in contrast to likelihood of confusion cases), doubt should be resolved in favor of the applicant. In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000); Ex parte Continental Distilling Corp., 61 USPQ 30 (Com Pat. 1944).

8. Disclaimer

If J.W. FOSTER is primarily merely a surname, should the mark be rejected under Section 2(e)(4) or should the examining attorney simply require a disclaimer of "FOSTER"? The examining attorney cites the Sears case in support of her position but then does not reach the same conclusion that the Examiner in Chief reached in that case - namely, that the mark J C HIGGINS is barred by the statute from registration (without proof under Section 2(f)) unless applicant disclaimed the surname "HIGGINS" apart from the mark as shown. No disclaimer of "FOSTER" has been requested. The letters "J.W." could support registration on the Principal Register. Of course, if "FOSTER" is also a given name, no disclaimer would be appropriate.

* * *

In view of the above, applicant respectfully requests that the rejection under Section 2(e)(4) be reversed and that applicant's application be remanded to the examining attorney with instructions that it be published for opposition.

Respectfully submitted,

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