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ESTTA Tracking number: **ESTTA34705**

Filing date: **06/02/2005**

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

Proceeding	78271326
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Submission	Reply Brief
Attachments	Applicant's Reply Brief.pdf (10 pages)
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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
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APPLICANT'S REPLY BRIEF

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TABLE OF CONTENTS

	<u>Page</u>
1. Burden of Proof.....	1
2. It is Immaterial Whether J.W. FOSTER Is a Famous Historical Figure.....	2
3. Use of Two Initials Emphasizes the Personal Name Significance of the Mark	3
4.. Disclaimer of Surname	6
5. The Sears Case.....	8
Conclusion.....	8

TABLE OF CASES

	<u>Page</u>
<u>Ex parte Continental Distilling Corp.</u> , 61 USPQ 30 (Com Pat. 1944)	6
<u>Ex parte Dallieux</u> , 83 USPQ 262 (Com. Pat. 1949)	5
<u>Ex parte Northwest Products, Inc.</u> , 109 USPQ 399 (Com Pat. 1956)	7
<u>Ex parte Sears, Roebuck & Co.</u> , 87 USPQ 400 (P.O. Ex. Ch. 1950).....	7
<u>In re Etablissements Darty et Fils</u> , 225 USPQ 652, (Fed. Cir. 1985).....	2
<u>In re I. Lewis Cigar Mfg. Co.</u> , 98 USPQ 265 (CCPA 1953).....	4
<u>In re Piquet</u> , 5 USPQ2d 1367 (TTAB 1987).....	4
<u>In re United Distillers plc</u> , 56 USPQ2d 1220 (TTAB 2000)	6
<u>Sears, Roebuck & Co. v. Watson</u> , 96 USPQ 360 (D.C. Cir. 1953), <u>cert. denied</u> , 99 USPQ 491 (1953)	4
<u>Thaddeus Davids Co. v. Davids</u> , 233 U.S. 461 (1914)	4, 5

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Applicant responds to the various points raised by the examining attorney in her Appeal Brief as follows.

1. Burden of Proof

The examining attorney correctly points out that "the burden is initially on the examining attorney to establish a *prima facie* case that a mark is primarily merely a surname." The examining attorney contends that she has "established a *prima facie* showing that 'FOSTER' is primarily merely a surname." She also contends that the addition of the initials "J.W." to "FOSTER" "only further enhances its surname significance." The issue in this case is not whether "FOSTER" is primarily merely a surname. That is not the mark sought to be registered. The examining attorney must show that the mark J.W. FOSTER is primarily merely a surname - and not a personal name.

2. **It Is Immaterial Whether J.W. FOSTER Is a Famous Historical Figure**

Section 2(e)(4) of the Trademark Act makes no reference to fame or historical names. The only issue is whether the mark is primarily merely a surname since others with the same surname should be entitled to register their mark in the absence of acquired distinctiveness by the prior user of a surname. In re Etablissements Darty et Fils, 225 USPQ 652, 653 (Fed. Cir. 1985).

The examining attorney attempts to analyze the evidence in terms of whether applicant has supplied sufficient evidence to establish fame or historical significance in the name J.W. FOSTER. The examining attorney concludes that applicant failed in this task because it has not shown significant use outside its own use in advertising or in promoting its line of shoes. The examining attorney also ignores the existence of a street by the name of J.W. Foster.

Applicant believes that the examining attorney overanalyzes the mark while at the same time ignoring the broader issue presented by Section 2(e)(4). As stated in the TMEP, § 1121, Section 2(e)(4) “reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods and services.” Ibid. This was necessary because there might be others with the same surname who might want to use that surname in a similar business. Ibid. It is suggested that the addition of a single initial to a surname, without anything further, may fall under the same prohibition for the reason that there are numerous individuals with the same surname and a given name beginning with the same initial. The limitation

“primarily” was added to the phrase “merely a surname” to prevent the rejection of surnames such as Prince, King and Cotton that also had other meanings. TMEP, § 1211.01. On the other hand, the addition of two initials, like the addition of a given name, cloaks the mark with the appearance of a personal name.

Applicant’s evidence relating to the significance of J.W. FOSTER, historically and as the name of a street, simply enforces the correctness of the perception that J.W. FOSTER is a personal name rather than being primarily merely a surname.

The examining attorney refers to uncovering over 110,000 hits for the surname “FOSTER.” Of course, the examining attorney does not explain why she concludes that each and every one of these hits was for the surname “FOSTER.” It is respectfully contended that the electronic database searched by the examining attorney probably only showed hits of the word “FOSTER.” Those hits might have been a given name or a surname. When the examining attorney conducted an Internet search for J.W. FOSTER, she combined that research with either “sneakers” or “running” and came up with a total of only 11 Web pages. Yet, what purchaser is going to go through the same type of analysis conducted by the examining attorney?

3. Use of Two Initials Emphasizes the Personal Name Significance of the Mark

The examining attorney contends in its heading for this section of her brief that the use of initials emphasizes the surname significance of J.W. FOSTER. In

support of this statement, the examining attorney cites Sears, Roebuck & Co. v. Watson, 96 USPQ 360 (D.C. Cir. 1953), cert. denied, 99 USPQ 491 (1953) (J.C. HIGGINS); In re I. Lewis Cigar Mfg. Co., 98 USPQ 265 (CCPA 1953) (S. SEIDENBERG & CO'S.); and In re Piquet, 5 USPQ2d 1367 (TTAB 1987) (N. PIQUET). The Lewis Cigar and Piquet cases involved the use of a single initial with a surname. As has been suggested above, the use of a single initial may present a different situation than one involving two initials. Only the Sears case involved two initials with a surname. That case, however, did not state that the use of the two initials emphasized the surname significance of the mark J.C. HIGGINS.

Both the reported decision in the Trademark Office, Ex parte Sears, Roebuck & Co., 87 USPQ 400 (P.O. Ex. Ch. 1950), and the Court of Appeal decision in the D.C. Circuit concluded that adding initials to the surname did not change the mark as a whole from being primarily merely a surname. It is with this conclusion that applicant takes exception. Both cases relied upon the Supreme Court case of 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. This infringement action is of little significance in determining whether the mark J.W. FOSTER is primarily merely a surname. The Supreme Court case simply found that the mark C.I. DAVIDS was dominated by the word "DAVIDS" which was held to be a simulation or colorable imitation of the registered mark DAVIDS. The Patent Office Examiner in Chief phrased the issued raised in the Sears case to be:

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.

In answering this question in the affirmative, the Patent Office Examiner in Chief pointed to the Thaddeus Davids case as supporting the fact 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 the name. In other words, like the mark DAVIDS, the word “HIGGINS” is the dominant portion of the mark. This conclusion is contrary to basic trademark principles that a mark must be considered in its entirety.

It may well be that the use of initials emphasizes the surname significance of the word “FOSTER,” but the issue is not whether “FOSTER” is a surname. Rather, the issue presented in this case is whether the mark J.W. FOSTER is primarily merely a surname, and that depends on the mark’s primary significance to the purchasing public.

If, as argued by the examining attorney, the use of initials emphasizes the surname significance of J.W. FOSTER (as a whole), is it not also true that the use of the given name “ANDREW” emphasizes the surname significance of ANDREW DALLIOUX? See Ex parte Dallieux, 83 USPQ 262 (Com. Pat. 1949). Yet, that is not the holding in the Dallieux case. What is the difference then to a rational prospective purchaser between the marks J.W. FOSTER and ANDREW DALLIOUX? The examining attorney would contend that in one case a prospective purchase would simply look at the mark and conclude that it is

primarily merely a surname, and in the other case the prospective purchaser would conclude that the mark is a personal name. There is no logical basis for this conclusion. The Court of Appeals for the D.C. Circuit threw up its hands and tried to explain this illogical conclusion by stating that if J C HIGGINS was “not merely a surname, it is principally merely a surname and, therefore, primarily merely so.” Is it principally merely a surname because the surname has more letters than the preceding initials? If the marks in question had been AL HIGGINS or AL FOSTER, would these marks have been principally merely a surname and therefore primarily merely so? Why is the word “ANDREW” different than the letters “J.C.” or, in the instant case, “J.W.”?

It is applicant’s contention that to a prospective purchaser, there is no difference. In each instance, the purchaser would regard the term serving as a mark to be a personal name, indicating a particular individual and not a genus of individuals having the surname “FOSTER,” “HIGGINS,” “DALLIOUX” or the like. Where there is a reasonable basis for assuming that a mark comprises a personal name rather than primarily merely a surname, the Office must register the mark on the Principal Register. See In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000); Ex parte Continental Distilling Corp., 61 USPQ 30 (Com. Pat. 1944).

4. Disclaimer of Surname

Applicant is pleased that the examining attorney finally recognized and acknowledged applicant’s arguments that the proposed mark must be perceived

in its entirety, that the commercial impression of a mark is derived from it as a whole, and further that the mark should not be dissected for examination purposes. Yes, this is precisely the point that applicant is making. When the examining attorney follows those basic tenets, it will be seen that the subject mark is indeed a personal name rather than primarily merely a surname.

The examining attorney states that "Office practice does not require or allow disclaimer of a surname." It is not known when the Office practice changed, but a disclaimer was required in Ex parte Sears, Roebuck & Co., 87 USPQ 400 (P.O. Ex. Ch. 1950). The case of Ex parte Northwest Products, Inc., 109 USPQ 399 (Com Pat. 1956), cited by the examining attorney, simply held that it was not necessary to disclaim "NORQUIST" in the combination mark NORQUIST CORONET because the mark was not considered to be primarily merely a surname. Applicant submits that neither J C HIGGINS nor J.W. FOSTER is primarily merely a surname, but if for unsupportable reasons the examining attorney holds to the contrary, the disclaimer of "FOSTER" should be permitted.

There is no prohibition against registering a single letter or , for that matter, two letters as a trademark. The examining attorney argues that "FOSTER" is primarily merely a surname. Applicant submits that the combination mark is not primarily merely a surname, that when a surname constitutes an integral part of a composite mark, it does not have to be disclaimed. The only explanation for finding that the mark J.W. FOSTER is not registrable on the Principal Register is to conclude that the examining attorney

did not find the mark J.W. FOSTER to be an integral mark. For that reason, applicant offered to disclaim the word "FOSTER" apart from the mark as shown even though it strongly contends that it does not have to do so.

5. The Sears Case

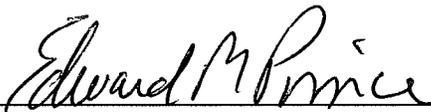
It may be inappropriate for the applicant to ask the Board to overrule the Sears case. However, applicant submits that the Sears case should not be followed by the Board because it is simply wrong.

Conclusion

Applicant has shown that there is sufficient doubt as to whether the mark J.W. FOSTER is primarily merely a surname or a personal name. That doubt should be resolved in applicant's favor with the result that the mark should be registrable on the Principal Register. The examining attorney's refusal to register the mark should be reversed.

Respectfully submitted,

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