

From: Lavache, Robert

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/461678

APPLICANT: Lockton Companies, Inc.



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

CORRESPONDENT ADDRESS:

THAD N. LEACH
LEWIS, RICE & FINGERSH, L.C.
BOX IP DEPARTMENT
500 N. BROADWAY, SUITE 2000
ST. LOUIS, MO 63102

MARK: ABANTE

CORRESPONDENT'S REFERENCE/DOCKET NO: 305/LCI009

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CORRESPONDENT EMAIL ADDRESS:

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3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the final refusal to register the proposed mark “ABANTE” on the Principal Register for: “Human resources consultation; employee benefit plan account auditing services; conducting business research and surveys for human resources and employee benefits purposes” in International Class 35; “Employee benefits consultation, namely, employee benefit plan analysis services; employee benefit plan administration services; providing financial information, namely, financial data reporting in the field of employee benefit plans; and financial analysis, namely benchmarking in the nature of measuring the financial performance of employee benefit plans” in International Class 36; “Electronic data transmission for human resources and employee benefit professionals and employers” in International Class 38; and

“Compliance services, namely, reviewing standards and practices to assure compliance with employee benefit laws and regulations” in International Class 42. Registration was refused pursuant to Trademark Act Section 2(e)(4), 15 U.S.C. 1052(e)(4), on the ground that the proposed mark is primarily merely a surname.

FACTS

On August 4, 2004, the applicant submitted a trademark application to register on the Principal Register the mark “ABANTE” in standard character form for “Human resources and employee benefits data reporting, auditing, surveying, administration, communications, benchmarking and compliance services.”

On March 15, 2005, the examining attorney issued an Office Action refusing registration of the proposed mark under Trademark Act Section 2(e)(4), on the ground that the proposed mark is primarily merely a surname. The examining attorney also refused registration of the proposed mark under Trademark Act Section 2(d), on the ground that the proposed mark was confusingly similar to two previously registered marks. In addition to these refusals, the examining attorney issued requirements to submit an acceptable specimen of use, to clarify the recitation of services, and to specify the number of classes for which registration was sought.

On September 16, 2005, the applicant submitted a response arguing against the refusals under Trademark Act Sections 2(d) and 2(e)(4). In addition, the applicant’s response included an amended recitation of services, as well as an assertion that the originally submitted specimen of use was acceptable as evidence of service mark use.

On October 25, 2005, after carefully considering the applicant’s arguments, the examining attorney issued a final refusal under Section 2(e)(4), and made final the

requirements to clarify the recitation of services and submit an acceptable specimen of use for each class of services. The Section 2(d) refusal was withdrawn, as were the requirements to clarify the number of classes for which registration was sought and to submit a specimen showing actual service mark use.

On February 21, 2006, the applicant submitted a request for reconsideration of the final Office action, which contained arguments against the Section 2(e)(4) refusal and addressed the outstanding requirements.

On April 5, 2006, the examining attorney issued an Office Action withdrawing the outstanding requirements, but denying the applicant's request for reconsideration of the final refusal under Section 2(e)(4).

On April 24, 2006, the applicant filed a Notice of Appeal with the Trademark Trial and Appeal Board appealing the examining attorney's refusal.

On June 23, 2006, the appellant filed its appeal brief.

On July 13, 2006, the examining attorney was notified of the sixty (60) day deadline to submit his brief. The undersigned examining attorney now submits the brief within the stated deadline.

ARGUMENT

The proposed mark, "ABANTE," is primarily merely a surname under Section 2(e)(4) of the Trademark Act because the mark's primary significance to the purchasing public would be that of a surname.

PROPOSED MARK IS PRIMARILY MERELY A SURNAME

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing

of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975).

The following five factors are used to determine whether a mark is primarily merely a surname:

- the rareness of the surname;
- whether anyone connected with the applicant has the mark as his or her surname;
- whether the term has any recognized meaning other than as a surname;
- whether the mark has the structure and pronunciation of a surname; and
- whether the mark is sufficiently stylized to remove its primary significance from that of a surname.

TMEP §1211.01. See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) and cases cited therein.

The examining attorney has the initial burden to establish a *prima facie* case that a mark is primarily merely a surname. Once the *prima facie* case has been made, the burden is on the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

The question of whether a proposed mark is primarily merely a surname must be resolved on a case-by-case basis, and there is no set rule as to the nature or quantity of

evidence necessary to make out a *prima facie* showing that a mark's primary significance to the purchasing public would be that of a surname. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). The entire record must be examined to determine the surname significance of a term.

A. Rareness of the Surname

One of the factors to be considered in determining whether a term is primarily merely a surname is the rareness of the surname in question. *Benthin*, 37 USPQ2d at 1333. In the present case, the mark is not a rare surname. In support of this contention, the examining attorney has included in the record evidence from LexisNexis® showing the mark appearing more than 300 times as a surname in a nationwide public records database, as well as additional evidence from other Internet databases showing that the term "ABANTE" appears in the public record as a surname. In addition, the record includes a sample of excerpts from news articles demonstrating that "ABANTE" commonly appears in American news reports.

The applicant argues that "ABANTE" is a rare surname, noting that the evidence provided by the examining attorney "only shows use of a surname by 82 distinct individuals" in "a massive nationwide public records database." [Please see appellant's brief, pg. 7]. The examining attorney disputes the applicant's contention that the materials from LexisNexis® show evidence of only 82 distinct individuals. The applicant seems to have arrived at this number by eliminating identical names from the list, but, given that some of the individuals have different addresses, it is not clear from the record that an identical name on the list necessarily identifies the same individual.

While it appears that some of the names shown in the database are redundant, there is no support for the conclusion that every additional occurrence of the same name should be excluded from consideration. Furthermore, the issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database, because it is unlikely that every individual with a particular surname will be listed in a given database and even the most common surname would represent only a small fraction of such a database. *See In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). In this case, it is reasonable to conclude that the actual number of distinct individuals with the surname “ABANTE” is much higher than the 82 claimed by the applicant and, thus, “ABANTE” is not a rare surname.

If a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare and would be perceived by the public as primarily merely a surname. *Gregory*, 70 USPQ2d at 1795. Here, the applicant asserts that the sample of excerpts from seven distinct news articles mentioning individuals with the surname “ABANTE” is not sufficient to establish that the surname appears routinely in news reports, articles and other media. However, while the evidence may not necessarily establish that the name “ABANTE” appears *frequently* in various forms of media, given that the articles in question are excerpted from American newspapers presumably having a very large circulation (e.g., Los Angeles Times, Chicago Tribune, Houston Chronicle), it is reasonable to conclude that the articles do show that the name “ABANTE” has been broadly exposed to the general public.

In support of its contention that “ABANTE” is a rare surname, the applicant cites a number of prior cases where a finding that a surname is rare (based, at least in part, on the relatively low number of listings in a database of surnames) led to the conclusion that the proposed mark in question was not primarily merely a surname. [Please see appellant’s brief, at pg. 7]. While these cases provide some guidance for determining whether a surname is rare, it is noted that the determination of whether the primary significance of a mark to the purchasing public is as a surname must be decided on a case-by-case basis after a careful consideration of the entire record. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). Furthermore, the rareness of a surname is but one factor in determining a mark’s surname significance. *See Benthin*, 37 USPQ2d at 1333-1334.

Finally, even if the applicant has shown that “ABANTE” is a rare surname, that fact would not per se preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (REBO held primarily merely a surname); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (POSTEN held primarily merely a surname).

B. Surname of Individuals Connected With Applicant

The fact that a term is the surname of an individual connected with the applicant is another factor to be considered in determining the surname significance of the term.

See Darty, 225 USPQ at 653; *Rebo*, 15 USPQ2d at 1314. In this case, the applicant asserts that “‘ABANTE’ is not the surname of anyone currently connected with the Applicant.” [Please see appellant’s brief, at pg. 9]. The examining attorney can find no evidence to the contrary. It should be noted, however, that the mere fact that no one associated with the applicant has been shown to have the “ABANTE” surname does not, by itself, require the conclusion that the consuming public will perceive the mark as something other than a surname.

C. Recognized Meaning Other Than as a Surname

The third factor to be considered is whether or not “ABANTE” has any *recognized* meaning other than as a surname. *Benthin*, 37 USPQ2d at 1333. The examining attorney has included evidence in the record consisting of four excerpts from authoritative on-line dictionaries showing where the word “ABANTE” would appear if, indeed, it were a defined English term. The absence of the term from these dictionary excerpts supports the finding that the term has no other recognized English meaning and thus is primarily merely a surname. *See Petrin*, 231 USPQ at 903-904.

The applicant asserts that the term “ABANTE” has meanings other than that of a surname. Specifically, the applicant notes that “ABANTE” is “the Latin root for the English term ‘advance,’” and contends that “even if consumers do not immediately know the English equivalent of the Latin term, such consumers would perceive the mark as a non-English word rather than a surname.” [Please see appellant’s brief, at pg. 8]. First, although the doctrine of foreign equivalents does apply to Section 2(e)(4) refusals, it has no application where the term is in an obscure or arcane language. *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1569 (TTAB 2005). In other words, the doctrine of foreign

equivalents should only be applied when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689 (Fed. Cir. 2005). In this case, the applicant states that the term “ABANTE” is Latin. Because Latin is generally considered to be a dead language, the foreign equivalents doctrine should not be applied to a Latin term, unless there is evidence that the Latin term is still in use by the purchasing public. *See* TMEP §1207(b)(vi). The applicant here has not provided any evidence that the Latin term “ABANTE” is in use by the American purchasing public or that the term is otherwise recognized by the purchasing public as having an English meaning.

The applicant indicates that consumers would recognize the word “ABANTE” as something other than a surname because it appears in various on-line dictionaries. However, there is no evidence that the word appears as an entry in any English dictionaries, and the evidence provided shows the word appearing only in the etymology section of the entries for the English words “advance” and “vanguard.” Thus, the applicant’s argument that the average relevant consumer would not perceive the mark as a surname rests on the assumption that the average consumer has an awareness and knowledge of the Latin roots of English words in general and of the word “advance” in particular. This assumption is not supported by any evidence in the record.

It is entirely possible that, as the applicant believes, consumers would view the word “ABANTE” as foreign in origin. However, it does not follow, and there is no corresponding rule, that a word perceived as possibly having a foreign meaning cannot also be perceived as primarily merely a surname. Foreign-sounding words and words

that are surnames are not mutually exclusive categories, especially in a marketplace as diverse as the United States. In support of its contention that a mark is not primarily merely a surname if the average consumer has some inkling that the mark may have significance as a non-English term, the applicant cites *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994). However, *Sava* has little bearing here. In that case, it was determined that consumers would not attach surname significance to the mark SAVA because it looks and sounds more like an acronym than a surname, which is clearly not the case here.

D. Structure and Pronunciation of a Surname

The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *Benthin*, 37 USPQ2d at 1333. See also *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). Here, the term “ABANTE” has a structure and pronunciation commonly associated with that of a surname. In support of this assertion, the examining attorney properly included as evidence in the record excerpts from a nationwide database of names, demonstrating the existence of other common surnames that have a structure and suffix (i.e., “-ANTE”) similar to that of the proposed mark (e.g., Amante, Assante, Adante, Afante, etc.).

The applicant argues that “ABANTE” “does not appear like commonly recognized surnames such as ‘Jones,’ ‘Smith,’ ‘Jackson’ or ‘Johnson’” and, as such, “looks more like at least an arbitrary mark.” [Please see appellant’s brief, at pg. 9]. The examining attorney is not aware of, nor has the applicant provided any citation to, any

bright-line rule requiring that a mark be “American” in sound or appearance in order to have surname significance. Rather, it is sufficient that the proposed mark be similar in structure and pronunciation to other surnames commonly encountered in the United States. *See Pirelli*, 9 USPQ2d at 1566.

The applicant asserts that the records of other surnames ending in “-ANTE” are irrelevant to the present case and states that there is no “authority that would support a rejection of Applicant’s Mark on the grounds that the mark ABANTE ends with, or essentially rhymes, the same suffix that appear [sic] in a limited number of names.” [Please see appellant’s brief, at pg. 10]. The examining attorney agrees with the applicant’s implication that it would be “absurd” to refuse registration of all marks ending in “-ANTE,” but respectfully disagrees with the applicant’s contention that the evidence of other “-ANTE” surnames is irrelevant to the case at hand. The evidence is pertinent here and appears to be one of a very few types of evidence that one could provide to demonstrate that names ending in “-ANTE” are commonly encountered in the United States and that the mark here has a structure and pronunciation similar to such names. *See Pirelli*, 9 USPQ2d at 1565-1566 (noting that the fact that the mark PIRELLI is similar in terms of structure and pronunciation to other common surnames Antonelli, Mancinelli, Pacelli, etc., was a factor in determining surname significance). The applicant argues that the evidence provided by the examining attorney is insufficient to show that the surnames ending in “-ANTE” are common. However, given the number of search results retrieved for the names, as well as the variety of “-ANTE” names included, the evidence is sufficient to establish that names ending in “-ANTE” commonly appear in the public record.

E. Stylization of Proposed Mark

The final factor under *Benthin* is whether the mark is sufficiently stylized to remove its primary significance from that of a surname. *Benthin*, 37 USPQ2d at 1333-1334. In the present case, the proposed mark is presented in standard character form, and, as such, no claim is made to any particular font, style, size, or color. *See* 37 C.F.R. §2.52(a); TMEP §807.03. Thus, the mark does not contain any stylization or design elements that would obviate the mark's surname significance.

F. Other Considerations

The applicant states that it chose the Latin term "ABANTE" as its service mark because "the phonetically pleasing pronunciation [conveys] a sense of sophistication and refinement, and serves as a better brand designator than its English counterpart in distinguishing Applicant's services." [Please see appellant's brief, at pg. 9]. Accordingly, the applicant argues, the proposed mark would not be considered primarily merely a surname. While it is entirely plausible that the applicant chose the proposed mark for the stated reasons, it is noted that the manner in which the applicant would like the mark to be perceived and the manner in which the mark is *actually* perceived by the consuming public is not always the same. In this case, considering that the average consumer is not necessarily privy to the applicant's motivations for choosing the proposed mark, and given that the applicant's mark has the characteristics of a surname, it is more likely that consumers would perceive the mark's significance primarily as that of a surname, rather than as the arbitrary, coined, fanciful, or suggestive mark that the applicant may have intended.

The applicant correctly states that the manner of use of a mark on the specimens of record is relevant evidence to determine the surname significance of a proposed mark, and argues that a “logical consumer confronted with Applicant’s specimen of record . . . could only conclude that the ABANTE mark is being used as a service mark” and that “it would be virtually impossible for a logical consumer to conclude that Applicant’s specimen conveys surname significance . . . as the mark is not accompanied by initials, names, human pictures or any other biographical information that would suggest the mark is a surname.” On the first point, it is respectfully noted that whether the proposed mark functions as a *service mark* is not at issue here. After all, surnames can, and commonly do, function as service marks. The relevant consideration is whether the proposed service mark is primarily merely a surname. As to the second point, while the existence of initials, names, human pictures, and other biographical information accompanying the mark on the specimen would certainly provide support for the conclusion that a mark’s primary significance would be that of a surname, the absence of such matter from the specimen does not per se obviate a mark’s surname significance. It is sufficient that the characteristics of the proposed mark are such that the public would view the mark’s primary significance as being that of a surname. *See Benthin, 37 USPQ2d at 1332.* Here, there is nothing in the manner in which the mark is presented on the specimens that would diminish the mark’s surname significance.

Finally, the applicant argues that two prior registrations containing the word “ABANTE” “show that the public and the PTO have appropriately given the mark . . . trademark significance in the past” and this is “undoubtedly a factor that weighs heavily against the . . . argument that the public would perceive the mark . . . as primarily merely

a surname.” [Please see appellant’s brief, at pg. 11]. First, please note that U.S. Registration No. 2306488 (ABANTE PROGRESSION) contains other non-generic wording (“PROGRESSION”), which would allow the mark to be registered on the Principal Register without relying on Trademark Act Section 2(f). TMEP §§1211.01(b) and (b)(vi). Thus, a Section 2(e)(4) refusal would not have been appropriate in that case. Furthermore, each case must be decided on its own merits. *See In re Nett Designs, Inc.*, 263 F.3d 1379, 57 USPQ2d 1564 (Fed. Cir. 2001). Given that there is no way of knowing the reasons for the allowance of prior registrations, previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984). Lastly, the mere fact that two prior marks containing the word “ABANTE” have been registered with the Office, would not necessarily diminish the mark’s surname significance. It is highly unlikely that the average consumer consults the USPTO records when forming his or her perception of a given mark, and there is no reason to believe that a consumer possessing the knowledge that two “ABANTE” marks had previously registered with the Office would conclude that the mark is therefore not primarily merely a surname.

CONCLUSION

Based on the foregoing, the facts as applied to the factors outlined in *Benthin* support the conclusion that the proposed mark, “ABANTE,” is primarily merely a surname. Therefore, the undersigned examining attorney respectfully requests that the Trademark Trial and Appeal Board uphold the examining attorney’s refusal to register

the mark "ABANTE" pursuant to Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4).

Respectfully submitted,

/Robert J. Lavache/
Examining Attorney
Law Office 108
Phone: 571-272-5881
Official Fax: 571-273-9108

ANDREW LAWRENCE
Managing Attorney
Law Office - 108