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

Proceeding	78461678
Applicant	Lockton Companies, Inc.
Applied for Mark	ABANTE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:
Lockton Companies, Inc.
Serial No: 78/461,678
Filed: August 4, 2004
Mark: ABANTE

Law Office 108

Trademark Attorney:
Robert J. Lavache

REPLY BRIEF FOR APPLICANT

Lockton Companies, Inc. (the "Applicant") submits this Reply Brief in reply to the Examining Attorney's Appeal Brief mailed to Thad N. Leach of the Lewis, Rice and Fingersh, L.C. law firm on August 29, 2006 (the "Examiner's Brief"). This Reply Brief is timely filed within twenty (20) days of the date that the Examiner's Brief was mailed. For the reasons cited herein and in the Brief for Applicant filed on June 23, 2006 (the "Applicant's Brief"), the Applicant respectfully requests that the Trademark Trial and Appeal Board (the "TTAB") reverse the Examiner's final refusal to register the Applicant's mark ABANTE (Ser. No. 78/461,678) (the "Mark") on the grounds that the Mark is not primarily merely a surname under Section 2(e)(4) of the Trademark Act.

CHANGE IN ATTORNEY OF RECORD AND CORRESPONDENCE ADDRESS

The Applicant requests that the TTAB and the United States Patent and Trademark Office update its records for the above-referenced application to show that Chad W. Brigham is the Applicant's attorney of record. Please note that Thad N. Leach, the Applicant's previous attorney of record, is no longer associated with this law firm. All future communications with respect to the Mark should be directed to:

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ARGUMENTS IN REPLY TO THE EXAMINER'S BRIEF

The Applicant submits this Reply Brief in order to comment upon certain arguments and points made by the Examiner in the Examiner's Brief. The Applicant has not addressed any of the Examiner's arguments that have already been adequately addressed in the Applicant's Brief. For ease of reference, this Reply Brief is divided along the same categories as set forth in the Examiner's Brief.

A. Rareness of Surname

The Examiner has disputed the Applicant's evidence that the materials from the massive LexisNexis® database made of record by the Examiner show evidence of only 82 distinct individuals with the alleged surname "Abante". See Examiner's Brief, p. 5. Although the Examiner alleged that the Applicant merely eliminated identical names from the list, the Applicant came to this conclusion by analyzing the identical names in connection with other personally identifiable information associated with the listed names, such as social security numbers (or portions thereof), addresses, dates of birth and/or listed states of residence. The evidence of redundant names submitted by Applicant are supported by logical analysis and conclusions and are based on all the personally identifiable information made of record by the Examiner and available to the Applicant. The Examiner has acknowledged the redundancy of

some of the names on the lists made of record by the Examiner, but the Examiner has not alleged who may be distinct individuals that were marked as redundant by the Applicant.

The Examiner also noted that “it is unlikely that every individual with a particular surname will be listed in a given database[;]” accordingly, “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[.]” See Examiner’s Brief, p. 5. For that reason, the Examiner concludes that “Abante” is not a rare surname. The Applicant respectfully requests that the decision in this matter be based upon the record, and not on “assumptions” that there may be more actual instances of the surname “Abante” than offered by the Examiner. Making such assumptions are against the clear authority in this area of law. Indeed, United Distillers and Benthin Management clearly provide that to the extent that there is any doubt on the questions of whether ABANTE would be perceived as primarily merely a surname, such doubt must be resolved in favor of the Applicant, and not in favor of assumptions unsupported by the record that there may be many more instances of use of ABANTE as a surname. See, In re United Distiller plc, 56 U.S.P.Q.2d 1220 (T.T.A.B. 2000); In re Benthin Management GmbH, 37 U.S.P.Q.2d 1332 (T.T.A.B. 1995); see also In re The Monotype Corporation PLC, 14 U.S.P.Q.2d 1070) (finding that the trademark attorney is presumed to have made the best case possible in support of an allegation that a mark is primarily merely a surname; therefore, the other records not made of record are presumed not to support the position that applicant’s mark is a surname).

The Examiner further alleges that if a surname appears routinely in news reports, articles and other media so as to be broadly exposed to the general public, then such surname is not rare and would be perceived as primarily merely a surname, and cites In re Gregory, 70 U.S.P.Q.2d

1792 (TTAB 2004) as support for such proposition. See Examiner's Brief, p. 5. The Applicant respectfully disagrees with the Examiner's reading of, and analysis under, In re Gregory. In re Gregory provides that "[a]nother issue to be considered, in assessing how rarely is a name used, is the media attention or publicity accorded public personalities with the name. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, articles and the like, so as to be broadly exposed to the general public." In re Gregory, 70 U.S.P.Q.2d 1792 (TTAB 2004) (emphasis added). The Examiner, however, has eliminated the material word "routinely" and the material phrase "public personalities with the name" from the holding of In re Gregory on this issue. On page six of the Examiner's Brief, the Examiner admitted that the seven news articles dating back from 2001 that he made of record did not "establish that the name 'ABANTE' appears *frequently* in various forms of media," yet the Examiner still concludes that these articles show common surname usage of the Mark. Further, the Examiner has disregarded that the TTAB's decision in Gregory on this issue hinged entirely upon the fact that the "Rogan" name analyzed therein was shared by various public personalities, namely, James Rogan (former Director of the PTO, majority leading of the California State Assembly, member of the U.S. House District in Southern California, and impeachment manager during the impeachment trial of former President Clinton), Tom Rogan (Sale Lake City councilman), Wilber Rogan (enshrined in the National Baseball Hall of Fame), Barbara Rogan (author and instructor at Hofstra University), Joe Rogan (actor and comedian appearing on the television series "News Radio" and "Fear Factor"), and Seth Rogan (actor and comedian). Id. In this instance, none of the seven news articles made of record by the Examiner were public personalities. Rather, these individuals were a high school student from Chicago, a member of the U.S. Army, a fugitive, a deceased former construction worker (reported in the "Obituaries"

section of “The Honolulu Advertiser”) and a new mother (reported in the “Births” section of “The Houston Chronicle”). Under the Examiner’s reading of In re Gregory and his arguments, if a new mother gave birth to a child in Chicago with the last name “Astf”, or there was a high school student in Chicago with the last name “Astf”, and such event was reported in a well-known periodical in that major metropolitan area, then “Astf” could be considered primarily merely a surname. The Applicant does not believe that this is the law.

The Applicant contends that the assumptions and presumptions made by the Examiner in the Examiner’s Brief are insufficient to show that the Mark would be perceived as a surname, and are unsupported and improper under applicable law. To the contrary, the evidence of record, and the cases cited by the Applicant herein and in Applicant’s Brief, show that the Mark is a rare surname, which supports a finding that the public would not perceive it as primarily merely a surname.

B. Surname of Individuals Connected With Applicant.

From a review of the Examiner’s Brief, it appears that the Applicant and the Examiner agree that this factor weighs in favor of the Applicant. See Examiner’s Brief, p. 7.

C. Recognized Meaning Other Than as a Surname.

The Examiner failed to find “abante” in any on-line dictionaries, and therefore, the Examiner concludes that this “supports the finding that the term has no other recognized English meaning and thus is primarily merely a surname.” See Examiner’s Brief, p. 7. The Applicant disagrees that the fact that the Examiner did not locate any dictionary uses of “abante” automatically leads to the conclusion that the public would perceive the Mark as primarily merely a surname.

First, the term “abante” has meanings other than that of a surname as evidenced by the inclusion of the term in English dictionaries (in the Etymology section) that were made of record by the Applicant. Second, even if the Etymology section of English dictionaries are not as widely read as the “Obituaries” section of “The Honolulu Advertiser” or the “Births” section of “The Houston Chronicle,” the public will still correctly view this term as a non-English word rather than as a surname. The Applicant cited In re Sava Research Corp., 32 U.S.P.Q.2d 1380 (TTAB 1994) in support of this contention; however, the Examiner believes it has no bearing on this matter because that case dealt with a mark that would be perceived as an acronym. The Applicant disagrees. In Sava Research, the TTAB found that the mark SAVA would not be perceived by the purchasing public as a surname, but rather, as an acronym. The mark was alleged to be an acronym for “Securing America’s Valuable Assets.” The TTAB found that the perceived acronym significance of this mark gave it a meaning other than that of a surname. In re Sava Research Corp., 32 U.S.P.Q.2d 1380 (TTAB 1994). It would be absurd to believe that the TTAB found that all purchasers would immediately recognize SAVA to be the acronym for “Securing America’s Valuable Assets;” therefore, it must be assumed that the TTAB found that the mark did not have surname significance because it looked liked an acronym to the purchasing public, even if some or most of the purchasing public had no idea of what the acronym stood for.

Clearly, the facts of Sava Research are distinguishable from the instant case, as we are not dealing with a mark that would likely be perceived as an acronym, as the Examiner points out. However, the legal analysis and conclusions set forth in Sava Research are instructive to the resolution of the instant matter. Although some members of the purchasing public may not immediately recognize the mark ABANTE as the Latin root of a common English word, such purchasers would still correctly conclude that it is a non-English term rather than a surname

(similarly, although the majority of the public would not correctly conclude that SAVA stands for "Securing America's Valuable Assets," they would still be more likely to correctly recognize that it is an acronym rather than a surname).

For the reasons cited herein, the Applicant believes that consumers would recognize the mark ABANTE as having a meaning other than that of a surname. Similarly, the Applicant contends that the Mark has the look and feel (or structure and pronunciation) of a non-English word (which it is) rather than that of a surname.

CONCLUSION

The balance of the arguments set forth in the Examiner's Brief have been adequately addressed in Applicant's Brief. Accordingly, for the reasons set forth herein and in Applicant's Brief, the Applicant respectfully requests that the TTAB reverse the Examining Attorney's refusal and approve its application to register the mark ABANTE on the Principal Register and permit the Mark to be published for opposition.

Respectfully submitted,

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