

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: February 10, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hall Wines, LLC

Serial No. 78926151

Tsan Abrahamson of Cobalt LLP for Hall Wines, LLC.

Chrisie Brightmire King, Trademark Examining Attorney, Law
Office 109 (Dan Vavonese, Managing Attorney).

Before Kuhlke, Cataldo, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Hall Wines, LLC (applicant) has filed an application
to register the mark BERGFELD on the Principal Register in
standard character form for "wine" in International Class
33.¹

The examining attorney refused registration on the
ground that the mark is primarily merely a surname under
Section 2(e)(4) of the Trademark Act, 15 U.S.C.

¹ Serial No. 78926151, filed July, 7, 2006, based on a statement
of first use anywhere and in commerce on September 30, 2006.

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§1052(e)(4). When the refusal was made final, applicant filed a request for reconsideration which the examining attorney rejected. Applicant then appealed; both applicant and the examining attorney have filed briefs on the case, including a reply brief filed by applicant.

We reverse the refusal.

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. §1052(f). We must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The examining attorney bears the initial burden to make a prima facie showing of surname significance. See *Id.* If the examining attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant, to determine ultimately whether the mark is primarily merely a surname. See *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we "are inclined to resolve such doubts in favor of applicant." See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, the Board identified five factors, four of which are relevant here, to consider in determining whether a mark is primarily merely a surname: (1) the degree of the surname's "rareness"; (2) whether anyone connected with applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; and (4) whether the mark has the "look and sound" of a surname.

Id. at 1332-33.²

We first look at the "rareness" of the surname. During the prosecution, the examining attorney submitted search results from Lycos People and Lexis/Nexis P-Find databases indicating, respectively, 280 and 300 telephone book listings for individuals with the surname BERGFELD in the United States.³ The examining attorney points out that the listings are not concentrated in any one region, but identify individuals in nineteen geographically dispersed states. The examining attorney also submitted printouts from internet websites showing commercial use of "Bergfeld" as a surname. For example, there is a website advertising

² The fifth *Benthin* factor, whether the manner in which the mark is displayed might negate any surname significance, is not relevant to our analysis inasmuch as applicant seeks registration of BERGFELD in standard character form.

³ Only the first ten listings from the Lycos People search were attached to Office Action dated December 7, 2006. The first one hundred listings from the Lexis/Nexis P-Find search were attached to the Office Action dated October 15, 2007.

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"Bill Bergfeld Companies...for Success...", a consulting company involved in "teach[ing] teachers to teach teachers to teach";⁴ a "Bergfeld Realty Co." website stating that "Andy Bergfeld has represented a wide variety of clients in virtually all fields of commercial real estate";⁵ a website identifying an actress "Laura Bergfeld";⁶ and a website advertising "Bergfeld Recreation, Inc.," described as a "family owned and operated" playground equipment company with "Chuck Bergfeld" as its president and CEO.⁷

The examining attorney ultimately concedes that "Bergfeld" is rare surname. Brief, (unnumbered) p. 3.

Applicant, on the other hand, contends that "Bergfeld" is an "extremely rare surname." Brief, p. 6. Applicant correctly points out that the number of individuals with this surname presented by this record is even lower in that a perusal of the Lexis/Nexis P-Find database list provided by the examining attorney contains duplicate entries, i.e., there are several individuals listed with the same first name and living at the same address.⁸ Applicant also

⁴ Attached to Office Action dated May 6, 2008.

⁵ *Id.*

⁶ *Id.*

⁷ Attached to Office Action dated October 15, 2007.

⁸ Compare listings nos.: 1 with 2; 9 with 10; and 67 with 68. We further note, that because the examining attorney only provided a partial listing (for the first one hundred), there is certainly the possibility that more duplicative entries exist.

submitted evidence putting the rarity of the surname into perspective. Specifically, applicant submitted U.S. Census Bureau statistics showing that the surname "Bergfeld" ranks 20391st in the United States in frequency.⁹

We find, based on the evidence, that BERGFELD is an extremely rare surname. Although the examining attorney submitted evidence showing use of the surname "Bergfeld" in commerce by different individuals, she was only able to produce evidence indicating there are fewer than 300 individuals with that surname after searching two comprehensive databases. See *In re Sava Research Corp.*, *supra* at 1381; and *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

Before leaving this factor, we acknowledge the history of the Board's treatment of surname refusals and take into account the number of listings before us for the surname "Bergfeld." There are many Board decisions where we found a term to be a rare surname, yet unregistrable, based on fewer surname listings than we have here. Conversely, there are many Board decisions allowing a term to be registered despite more surname listings than what we have here. In other words, there remains no threshold number of

⁹ From printouts obtained from U.S. Census Bureau; attached to applicant's response dated July 24, 2007.

surname listings upon which we base our decisions.¹⁰ However, we believe it is important to accord the proper weight to the "rareness" of the surname factor while keeping in mind the purpose of Section 2(e)(4) of the Act. As explained by Judge Seeherman in her concurrence in *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 at 1924 (TTAB 2007), the "purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames,... 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..." Moreover, "in a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use." *Id.* (in main opinion) at 1923-4, citing *In re Garan Inc.*, *supra* at 1540.

We turn next to the second factor and look to whether anyone associated with applicant has the surname "Bergfeld." There is no dispute that applicant's proposed mark ultimately derives from Robert Bergfeld who, according

¹⁰ We do note, however, that the electronic databases available to examining attorneys today are far more comprehensive and current than the reference materials available in the past; thus, we can presume that the number of persons listed (absent duplicative entries) is a fairly accurate estimation of the number of individuals with the surname in the entire United States.

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to applicant's website, was a "pioneering wine grower who owned our historic winery from 1894 until 1910."¹¹ However, applicant has submitted several advertisements for its wine indicating that the mark's significance derives from the historic winery building on the property, known as the "Bergfeld" building. Applicant further uses a wine label (affixed to the wine bottle) containing a depiction of the "Bergfeld" building. Thus, even taking into consideration that applicant's mark historically derives from the surname of the person who owned the property nearly one hundred years ago, we find that consumers may be just as likely to attribute non-surname significance to the mark. Further, no one presently (or ever) associated with applicant has the surname "Bergfeld" and applicant has stated unequivocally that there is no such connection. Thus, to the extent that there is no one associated with applicant bearing the name "Bergfeld," we do not weigh this factor in favor of a finding that the mark is primarily a surname.

The third factor is whether there is another recognized meaning for "Bergfeld." The relevant question is whether the term has another recognized significance

¹¹ Attached as exhibit C to applicant's response dated July 24, 2007. Other evidence regarding Mr. Bergfeld is contained in applicant's response dated April 15, 2008.

other than as a surname. As noted above, applicant contends that "Bergfeld" will be understood as referencing the historic building called the "Bergfeld" that is located on its property. However, we have little evidence indicating the extent of the "Bergfeld" building's recognition. Thus, while applicant has shown that "Bergfeld" may be used to reference the historic winery building, there is no evidence as to the degree of familiarity of the building. Applicant has also argued that "Bergfeld" has non-surname meaning because the terms "berg" and "feld" have meaning in German ("hill" and "field," respectively). This argument is less persuasive because there is no indication that the term "Bergfeld", as a whole, has an understood meaning in German that can be translated into English. Cf., *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1569 (TTAB 2005) (Board concluded that "there is no question of whether the term [FIORE] would be recognized in its current form as the Italian word for 'flower.'")

Finally, as to the fourth factor, namely, whether the proposed mark has the "structure and pronunciation" (or, stated differently, the "look and sound") of a surname, the examining attorney argues that it does and submitted evidence of other surnames that either begin with "berg" or

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end with "feld," and a one-page printout from a website ("alt.gossip.royalty") containing a posting, "How to recognize Jewish names," and listing "names ending '-feld'." Applicant, on the other hand, contends that its mark is "reminiscent of a city name..., e.g., Hatfeld, Heidelberg, Hardfeld, Bonfeld and Heimfeld." Brief, p. 8. Based on the evidence and arguments on this very subjective factor, we are unable to make any definitive determinations as to whether applicant's mark has the "look and sound" of a surname. Instead, we believe that while some may perceive applicant's mark as a surname, it is perhaps just as likely that others will view the mark as identifying a city or town or ascribe some other geographic significance thereto.

In balancing the aforementioned factors, we make no secret that the first factor, rareness of the surname, has been given much more weight than the other three factors. And, in doing so, we find that any slight tilt toward finding the mark as being primarily a surname based on the other factors is outweighed by the fact that there are fewer than 300 persons with the surname "Bergfeld." Ultimately, we conclude that applicant's proposed mark, BERGFELD, is so rarely used as a surname, and that the remaining *Benthin* factors provide little additional support

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for a finding that it would be so perceived by consumers, that it is not primarily merely a surname. Furthermore, to the extent we had any doubt in our decision and weighing these factors, we resolve such doubt in favor of applicant. See *In re Benthin Management GmbH*, 37 USPQ2d at 1334.

Decision: The refusal to register applicant's mark on the ground that it is primarily merely a surname is reversed.