

THIS DECISION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: September 28, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**

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In re Peter Schöttler GmbH

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Serial No. 79092036  
Filed February 3, 2011

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Mark P. Stone, Esq.; Amanda L. Stone, Esq. on the brief,  
for applicant.

Pamela Y. Willis, Law Office 106, Mary I. Sparrow, Managing  
Attorney.

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**Before Mermelstein, Wellington, and Wolfson, Administrative  
Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Applicant requests extension of protection for the  
mark SCHÖTTLER (in standard characters) to be used on or in  
connection with a variety of metal products, metalworking  
and forging services, and engineering services in  
International Classes 6, 40, and 42.<sup>1</sup> The examining  
attorney issued a final refusal to register, alleging that  
the mark is primarily merely a surname. Trademark Act  
§ 2(e)(4); 15 U.S.C. § 1052(e)(4).

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<sup>1</sup> Pursuant to Trademark Act § 66(a); 15 U.S.C. § 1114f(a), and  
alleging a *bona fide* intent to use the mark in commerce.  
Applicant is the holder of International Registration No.  
1063656, issued September 20, 2010, claiming a priority date of  
March 25, 2010.

We will reverse the refusal to register.

**I. Applicable Law**

Section 2(e)(4) of the Trademark Act prohibits registration on the Principal Register if the proposed mark is "primarily merely a surname." The determination of whether the primary significance of the designation at issue is that of a surname is based on the facts made of record. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Examining Attorney has the initial burden to make a *prima facie* showing of surname significance. *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. *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve that doubt in favor of applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, we 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 the applicant has the involved term 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 1333. Because the mark at issue here is in standard character form, we need not consider the fifth *Benthin* factor, *i.e.*, whether the manner in which the mark is displayed might negate any surname significance.

## II. Discussion

### A. The Rareness of SCHÖTTLER

With her first Office action, the examining attorney made of record results of a search on the website [www.whitepages.com](http://www.whitepages.com). The results pages list – under the words "Over 100 Results," a number of people with the name Schottler,<sup>2</sup> as well as some vague information about each, including a range for the listee's age, and a street and city (presumably of the person's residence). According to the examining attorney,

[t]his evidence shows the applied-for mark appearing at least 100 times as a surname in a

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<sup>2</sup> Applicant points out that the examining attorney's evidence shows individuals with the last name "Schottler" and not "Schöttler," as in the applied-for mark. While we recognize the difference made by the umlaut in the spelling and German pronunciation of the name, it is unclear whether the relevant U.S. consumers would see this spelling variation as significant. We will assume, without deciding, that if Schottler is primarily merely a surname, so is SCHÖTTLER; our decision would be the same in either case.

nationwide telephone directory of names (the first 50 listings are attached). Given the amount of evidence showing mark [sic] used as a surname, consumers would immediately perceive that the term Schöttler as used in the mark is also used as a surname.

First Office action (Feb. 9, 2011).

In fact, this evidence shows only *forty* listings, and as applicant points out, several of the listings appear to be duplicates: there are two listings each for Ann M. Schottler in Kentucky, Doreen Schottler in New Jersey, and Frederick Schottler in White Plains, NY. In response to the listing, and again in its brief, applicant argued that the number of Schottlers listed in the examining attorney's evidence is insufficient to show that SCHÖTTLER is primarily merely a surname.<sup>3</sup>

While the examining attorney is correct that there is no minimum number of listings required to show surname significance, *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991), it is not the case that any number of listings will

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<sup>3</sup> Applicant argues that "[t]ypically, an Examiner is required to demonstrate an 'unusually large number' of telephone directory listings of the mark as a surname to carry the burden of proof." App. Br. at 4 (citing *In re Harris-Intertype, Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975)). Applicant is plainly incorrect. The court in *Harris-Intertype* found that the "unusually large number of listings" of record in that case was *sufficient* to establish that the applied-for mark was primarily merely a surname; the court did not say that an "unusually large number of listings" was *necessary* to sustain such a refusal in all cases. *Harris-Intertype*, 186 USPQ at 239.

do, no matter how small. The issue is whether the surname in question is common or rare, and in each case, the rareness of the surname must be considered as a part of all the record evidence pertaining to the *Benthin* factors. Nonetheless, it is fair to say that the rareness of the name at issue often plays an important role in determining whether the proposed mark is primarily merely a surname. *E.g.*, *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923-24 (TTAB 2007).

In this case, although the examining attorney states that individuals named Schottler appeared "at least 100 times" in the results of her whitepages.com search, only forty listings were submitted, even after applicant argued that the listings were too few to support the § 2(e)(4) refusal. (The estimate of "at least 100" listings appears to be based on the whitepages.com notation of "Over 100 Results," but we cannot tell whether that vague figure is reliable or how many listings there actually were – and one hundred listings is still a very small number resulting from a national search.<sup>4</sup>) We cannot affirm a refusal to

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<sup>4</sup> Some of our cases have affirmed refusals with evidence of only a very small number of listings. It should be kept in mind that in many of the older cases, the listings typically came from (paper) telephone directories for a few cities. While those cases are still good law, it seems clear that unless the name is

register based on evidence which is not of record, particularly in light of the small number of listings actually submitted and the fact that applicant has questioned the sufficiency of those listings.

We find that the forty<sup>5</sup> listings of record put SCHÖTTLER in the category of very rare surnames, particularly in the absence of any other evidence showing that the public would recognize it as a surname notwithstanding its rareness.<sup>6</sup> See e.g., *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) (only 1100 directory listings, but evidence of "publicity accorded to public personalities with the name").

This factor weighs strongly in applicant's favor.

**B. Applicant's Connection with SCHÖTTLER**

Applicant admits that its firm was founded in 1840 by

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extremely rare, the search of a national database will likely turn up more listings than the search of the phone books of a few cities. See *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000).

<sup>5</sup> While the submission of cumulative evidence is discouraged, the value of this evidence lies not in the listed names, but in their *number*. Although every single listing need not be submitted, it remains the examining attorney's burden to demonstrate that the evidence supports the refusal of registration, and submission of a very small number of listings may prove inadequate to demonstrate that the name at issue is not rare.

<sup>6</sup> Although the examining attorney submitted a profile from the Xing website of a person named Jan Schöttler, a graphic designer and art director, this Mr. Schöttler apparently resides in Munich, Germany, and there is no evidence that he is well-known (or known at all) in the United States.

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a man named Peter Schöttler, but states that there is nobody named Schöttler currently associated with the firm. App. Br. at 4. The mere fact that applicant's founder is long gone is not necessarily a factor in applicant's favor, but there is no indication in this case that Mr. Schöttler was a famous figure (or still is), or that the U.S. public is even aware of him or the history of the firm. Nor does it appear that those dealing with the firm would come into contact with anyone named Schöttler.

Of course, applicant's corporate name is Peter Schöttler GmbH, and it seems likely that in that context – preceded by the given name Peter – that the relevant public would be somewhat more likely to view Schöttler as a surname, but there is no evidence that applicant currently does any business in or with the United States,<sup>7</sup> or that the firm is otherwise known in this country. In any event, we must base our determination on the applied-for mark, which is SCHÖTTLER, not Peter Schöttler.

While applicant's firm was founded by someone named SCHÖTTLER, we find that under the circumstances of this case, this factor does not weigh heavily in our analysis.

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<sup>7</sup> As noted, applicant seeks registration under Trademark Act § 66(a). Such applicants need not show use in U.S. commerce prior to registration. *Id.*

**C. Other Recognized Meanings**

The examining attorney submitted two searches of online dictionaries (one English, one German) for the term "Schöttler." Final Office Action (July 1, 2011). Inasmuch as neither search found a definition for Schöttler, the examining attorney argues that the term has no recognized meaning other than that of a surname. Applicant does not contend that Schöttler has some significance other than as a surname, but argues that this evidence is somehow "duplicative." Reply Br. at 3-4. We are puzzled by applicant's argument – this evidence is clearly probative of the third *Benthin* factor, and we agree with the examining attorney that this factor weighs in favor of affirmance.

**D. Whether SCHÖTTLER has the Look and Sound of a Surname**

The examining attorney argues that SCHÖTTLER has the look and sound of a surname:

The examining attorney submits that there are a number of surnames used in the United States that begin with the letters "Sch." In addition, many surnames used and heard in the United States contain accent marks. Given that many surnames used in the United States contain similar letter sequences as the proposed mark, and also contain accents, the American public would in fact perceive SCHÖTTLER as a surname.

Ex. Att. Br. at 10 (unnumbered).

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This *Benthin* factor is somewhat subjective. *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). However, even subjective determinations must be based on some evidence. As applicant points out, the examining attorney has submitted no evidence in support of her argument about common surnames in the United States. *See e.g., Baik*, 84 USPQ2d 1921, 1924 (TTAB 2007) (evidence from Yahoo People Search "to show that 'more common' surnames ... are similar in appearance and sound"); *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285 (TTAB 2007) ("examining attorney's evidence from about.com shows that ... many surnames end with 'son'"); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988) (PIRELLI, though rare, resembles common surnames in the *American Surnames* book).

While we agree that SCHÖTTLER could *possibly* be perceived as a surname, that conclusion is not inevitable. Applicant argues that "the American consumer is fairly unfamiliar with words and names containing the letters 'SCH' and 'Ö', which are uncommon in the English language. Accordingly, the American consumer is unlikely to recognize the mark 'SCHÖTTLER' at all, let alone as a surname." App. Br. at 11. We conclude that in the absence of evidence to support it, we are not able to give the examining attorney's unsupported opinion on this factor any weight.

We conclude that this factor is essentially neutral.

### III. Conclusion

In summary, we have found that SCHÖTTLER is a very rare surname and that applicant's founder was named Peter Schöttler, although in this case, that latter factor is not entitled to substantial weight. And while SCHÖTTLER has no other apparent meaning, we are unable to conclude on this record that the mark has the "look and sound" of a surname.

On balance, we find the degree of rareness of the surname SCHÖTTLER to be a factor which weighs heavily in favor of reversal,<sup>8</sup> outweighing the fact that the mark has no other meaning and that applicant's founder was named Schöttler. On this record, we conclude that the Office has not met its burden to show that the mark is primarily merely a surname.

**Decision:** The refusal to register on the ground that the mark is primarily merely a surname is reversed.

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<sup>8</sup> In addition to our earlier discussion, we note Judge Seeherman's observation that "[i]f a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant." *Baik*, 84 USPQ2d at 1924 (Judge Seeherman, concurring).