

# TTAB

407-438

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

Applicant: Peter Schöttler GmbH

Examining Attorney:

Mark: SCHÖTTLER

Pamela Y. Willis

Serial No.: 79/092,036

Law Office 106

Filed: September 20, 2010

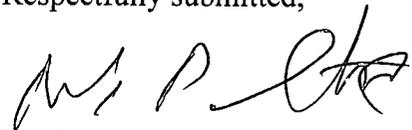
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APPOINTMENT OF ASSOCIATE ATTORNEY

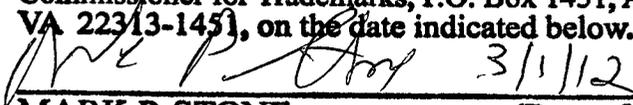
Mark P. Stone, Attorney of Record for the above identified Applicant, hereby appoints  
Amanda L. Stone, Attorney at Law, 400 Columbus Avenue, Valhalla, NY 10595, as an  
Associate Attorney in connection with the present Application.

Respectfully submitted,



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**MARK P. STONE**  
Reg. No. 27,954

**(Date of Deposit)**



**03-06-2012**

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

Applicant: Peter Schöttler GmbH

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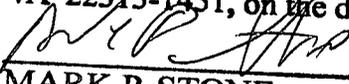
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MARK P. STONE  
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3/1/12

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**APPEAL BRIEF**

This is an appeal from the Examiner's Denial of Applicant's Request for Reconsideration, dated December 27, 2011, in reply to Applicant's Amendment In Response to Final Action, filed on November 9, 2011. A timely Notice of Appeal was filed on January 3, 2012. Applicant submits this Appeal Brief within 60 days from the filing of the Notice of Appeal.

**I. Description Of The Record**

The present Application, filed on September 20, 2010, is an Extension of Protection in the United States of International Registration number 1,063,656.

The U.S. Application was assigned Serial Number 79/092,036. The first Official Action in connection with this Application issued on February 9, 2011. Applicant filed an Amendment in response to the Official Action on May 18, 2011. The Examiner issued a Final Official Action

on July 1, 2011. Applicant filed its Amendment In Response To Final Action on November 9, 2011. The Examiner issued a Request for Reconsideration Denied on December 27, 2011. Applicant filed its Notice of Appeal on January 3, 2012.

## **II. Statement Of Issues**

### **a. Goods & Services**

In the Final Action dated July 1, 2011, the Trademark Examiner raised objections to Applicant's identification of goods and services. Applicant addressed and sought to overcome the Examiner's objections with a revised identification of goods and services in Applicant's Amendment In Response To Final Action filed on November 9, 2011. The Trademark Examiner made no further objections to Applicant's revised identification of goods and services in the Denial of the Request for Reconsideration dated December 27, 2011, which addressed only the substantive basis for refusing registration. Applicant therefore presumes that the revised identification of goods and services in the Amendment filed on November 9, 2011 overcame the prior objections raised by the Examiner. Therefore, the Examiner's prior objections to the identification of goods and services form no part of the issues presented for review in the present Appeal.

### **b. The Examiner's Refusal To Register Applicant's Mark As Primarily Merely A Surname Is Not Supported By The Evidence**

In Applicant's Amendment filed on November 9, 2011, Applicant set forth detailed legal and factual analysis in support of registration of its mark. The Trademark Examiner failed to present any reasoning for her denial of Applicant's Request for Reconsideration in the Request for Reconsideration Denied, dated December 27, 2011, but merely provided the following

conclusory statement, “In the present case, applicant’s request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant’s analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied”.

Applicant respectfully disagrees with the Examiner’s conclusion that the Amendment In Response to Final Action filed on November 9, 2011 did not raise any new issues or provide any new or compelling evidence with regard to the outstanding issues raised in the Final Action. As will be discussed below, Applicant presented significant arguments in support of registration of the mark and supporting caselaw authority, which the Examiner failed to consider or rebut. Applicant’s detailed legal and factual arguments are presented below.

The issue presented for review by the Board in the present Appeal is whether the Examiner’s refusal to register Applicant’s mark as primarily merely a surname meets the high burden of proof required to refuse registration on this ground.

### **III. Recitation Of Facts**

Applicant seeks to register the mark “SCHÖTLER” for the goods and services identified in its Amendment filed on November 9, 2011.

The Examiner has refused to register Applicant’s mark on the ground that she believes it is primarily merely a surname. The United States population exceeds 310 million people (*see* Applicant’s Amendment filed on May 18, 2011, pp. 4-5), yet the Examiner has located only 100 entries of the surname “Schöttler” in a nationwide telephone directory. *See* Official Action dated

July 1, 2011, p. 2. As discussed in footnote 2, certain of the telephone directory entries cited by the Examiner appear to be duplicative. (*See Infra* §IV.a.i)

The Examiner has submitted no further evidence of the use of the mark as primarily merely a surname in support of the refusal to register the mark.

Although the Examiner contends that the name “Schöttler” is a surname associated with Applicant, “Schöttler” is merely a part of Applicant’s overall corporate name.<sup>1</sup> Furthermore, “Schöttler” is a German name, and, as will be discussed below (*see Infra* §IV.c), is not likely to be recognized by the average American consumer as primarily merely a surname.

#### IV. Argument

##### a. The USPTO Has Not Met Its Burden Of Proof

The burden of proving that a mark’s significance is primarily merely a surname rests squarely on the U.S. Patent & Trademark Office (“USPTO”). *See e.g., In re Standard Elektrick Lorenz Aktiengesellschaft*, 371 F.2d 870, 873, 152 U.S.P.Q. 563 (C.C.P.A 1967).

##### i. The USPTO Has Shown Only De Minimus Telephone Directory Entries

Typically, 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. *See In re Harris-Intertype, Corp.*, 518 F.2d 629, 186 U.S.P.Q. 238 (C.C.P.A. 1975) (finding HARRIS to be primarily merely a surname where evidence included 1,100 listings in Applicant’s home city and 800 listings in Washington, D.C., and noting “[s]uch evidence of an unusually large number of listings of a surname . . . prima facie establishes that “HARRIS” is primarily merely a

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<sup>1</sup> Applicant has advised that although the Applicant corporation was first founded by an individual named Peter Schöttler in Germany in the year 1840, there are currently no individuals associated with the Applicant having the name Peter Schöttler, or having the term Schöttler as a surname.

· surname”); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §13.30 (4th Ed. 2011) (hereinafter “MCCARTHY”) (noting typical rule that “an ‘unusually large number’ of directory listings is needed for the Examiner to carry the burden of proof” and stating “[t]he number of phone directory listings is apparently *crucial* as to whether the PTO has established a prima facie showing, as indicated in cases finding that a term is not primarily merely a surname”) (emphasis added).

Applicant respectfully submits that the evidence garnered by the Examiner does not meet the requisite burden. The Examiner has failed to show an “unusually large” number of telephone directory listings of the mark as a surname. *See Official Action*, dated July 1, 2011, p. 2 (Examiner citing “at least 100” entries of the name “SCHÖTTLER” in a nationwide telephone directory)<sup>2</sup>; *see also Amendment*, filed on May 18, 2011, pp. 4-5 (providing evidence that United States population exceeds 310 million people, and submitting that 100 listings is therefore *de minimus*). In *In re Sava Research Corp.*, 32 U.S.P.Q.2d 1380 (T.T.A.B 1994), the Examiner’s citation to 100 listings in a national database was insufficient to meet the USPTO’s burden of showing significance of a mark as primarily merely a surname. Here, the Examiner’s citation to 100 listings in a national database is likewise insufficient.

**ii. The USPTO Has Not Provided Any Supplemental Evidence Of Use Of The Mark As A Surname**

While the USPTO has declined to hold that a minimum number of listings in telephone directories must be found to establish a prima facie showing that the mark is primarily merely a surname, the USPTO has only refused registration on this ground for a mark with *de minimus* telephone entries in cases where sufficient supplemental evidence existed to overcome the dearth

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<sup>2</sup> Applicant notes that at least some of the telephone directory entries cited by the Examiner appear to be duplicative. For example, the Examiner cited to two listings for an “Ann M. Schottler” in Kentucky, two listings for a “Doreen Schottler” in New Jersey, and two listings for a “Frederick Schottler” in White Plains, NY.

of telephone directory entries. No such supplemental evidence exists to overcome the dearth of telephone directory entries in the present case.

Specifically, the Examiner cites to TMEP § 1211.02(b)(i) and *In re Petrin Corp.*, 231 U.S.P.Q. 902 (T.T.A.B. 1986) to support the proposition that she has met her burden notwithstanding a small number of telephone directory listings. The case at hand is readily distinguishable from the cited authority. In *In re Petrin*, the Board was “satisfied that the evidentiary ‘package’ before [it] [was] an adequate basis for a prima facie showing”. *In re Petrin*, 231 U.S.P.Q. at 903. The “package” included numerous hits for the surname in the LEXIS/NEXIS database. The Board was specifically impressed with the fact that *all* LEXIS/NEXIS hits for the term were surname references. Therefore, the Board found that the term was primarily merely a surname, notwithstanding only a small number of telephone directory entries.

The Examiner also relied on TMEP § 1211.02(b)(i), which cites to *In re Petrin* (described above) and *In re Wickuler-Kupper-Brauerei KGaA*, 221 U.S.P.Q. 469 (T.T.A.B 1983). Similar to *In re Petrin*, the Board in *In re Wickuler* was impressed with the number of excerpts from magazines and newspaper stories obtained from LEXIS/NEXIS which referred to persons with the surname at issue. No such supplemental evidence is of record in the instant Appeal.

Here, the Examiner has not supplemented the low number of telephone directory entries with *any* evidence of LEXIS/NEXIS hits showing use of the mark as a surname. Accordingly, the Examiner has not overcome the dearth of telephone directory entries and has therefore not met the burden of proof to establish significance of the mark as primarily merely a surname.

**b. “SCHÖTTLER” Is An Undisputedly Rare Surname And Does Not Meet The Exceptions For Barring Registration Of Rare Surnames**

The Examiner acknowledges that the mark “SCHÖTTLER” appears to be a rare surname, but fails to give sufficient weight to this factor. *See Official Action*, dated July 1, 2011 p. 3 (“Although ‘SCHÖTTLER’ appears to be a relatively rare surname, a rare surname may be unregistrable . . .”). Further, the Examiner’s reliance on the cited caselaw is misplaced, as the facts here are inapposite to those in the caselaw.

The TMEP § 1201.01(a)(v) provides that “[t]he rarity of a surname is an important factor to be considered in determining whether a term is primarily merely a surname”; *see also In re Garan, Inc.*, 3 U.S.P.Q.2d 1537 (T.T.A.B. 1987) (“[T]he degree of a surname’s rareness should have a material impact on the weight given the directory evidence.”). This is because, “if the name is rare, purchasers are not likely to regard the word as a surname, because they have never seen the word so used.” MCCARTHY § 13.30. Here, the rarity of “SCHÖTTLER” as a surname is undisputed. *See Official Action*, dated July 1, 2011, p. 3.

In three small subsets of cases, registration has been barred for rare surnames. The Examiner relies on cases within these subsets in refusing registration here. The cited caselaw is readily distinguishable from the facts of this case, as described further below.

**i. Applicant Does Not Use Additional Terms That Emphasize Surname Significance**

The first subset of cases barring registration for rare surnames consists of surnames that are used with additional terms that emphasize the surname significance. The Examiner cites to *In re Establishments Darty et Fils*, 759 F.2d 15, 225 U.S.P.Q. 652 (Fed. Cir. 1985), and *In re Giger*, 78 U.S.P.Q.2d 1405 (T.T.A.B. 2006), to support her conclusion that “SCHÖTTLER” is

unregistrable in spite of its rarity as a surname. Applicant respectfully submits that these cases are inapposite here. In particular, in *In re Establissements Darty et Fils*, the mark at issue was used in the company name in a manner that revealed its surname significance. Specifically, the company name was “Darty et Fils”, which translates to “Darty and sons”. 759 F.2d at 17. In *In re Giger*, the mark was combined with “MD”, which similarly elucidates the surname significance of the mark. Here, “SCHÖTTLER” is used alone, and therefore includes no additional terms that indicate significance as a surname. Accordingly, reliance on *In re Establissements Darty et Fils* and *In re Giger* is misplaced.

**ii. No Media Attention Has Raised Public Awareness Of The Surname Significance Of Applicant’s Mark**

In addition to the cases described above, rare surnames have been found to be unregistrable where the surname has received media attention or publicity that have brought to light the mark’s significance as a surname to consumers. For example, in *In re Gregory*, 70 U.S.P.Q.2d 1792 (T.T.A.B. 2004), although few telephone directory listings were found for the surname “Rogan”, the Board held that the mark was recognized by consumers as primarily merely a surname in light of the number of high profile individuals with the name. Here, the mark “SCHÖTTLER” has not received media attention.

**iii. The Structure Of Applicant’s Mark Does Not Reveal Surname Significance**

Finally, registration has been refused for rare surnames where the name, by its very structure, would be recognized as only a surname (e.g., “Seidenberg”, although rare, would be recognized only as a surname). See MCCARTHY § 13.30. For the reasons described below (*infra*

§ IV), the structure of the mark “SCHÖTTLER” will not be perceived by the American consumer as primarily merely a surname.

The Examiner acknowledges that the surname “SCHÖTTLER” is rare, but contends that the mark is nonetheless unregistrable because its primary significance is merely as a surname. Applicant has distinguished the facts of this case from the legal authorities relied upon by the Examiner in support of her position that the mark is unregistrable notwithstanding its rarity. Because Applicant does not combine the *rare* surname “SCHÖTTLER” with other terms that indicate surname significance, because the mark has not come to be understood by the public as a surname through media attention or publicity, and because the mark’s surname significance is not revealed by its very structure, this case does not fall under any of the exceptions for barring registration of rare surnames. Therefore, the Examiner has not met the burden to refuse registration of the rare surname “SCHÖTTLER” as primarily merely a surname.

**c. The American Public Will Not Perceive “SCHÖTTLER” As  
Primarily Merely A Surname**

American consumers are unfamiliar with the surname “SCHÖTTLER”, and with surnames with similar structures, and will therefore not perceive the mark as primarily merely a surname. In determining significance of a mark as primarily merely a surname, it is the American public’s perception that must serve as the guiding light. *In re Kahan & Weisz Jewelry Mfg.*, 508 F.2d 831, 184 U.S.P.Q. 421 (C.C.P.A. 1975) (“... the correct resolution of the issue can be made only after the primary significance of the mark to the purchasing public is determined...”).

**i. The American Public Is Unfamiliar With The German Surname "SCHÖTTLER" And Therefore Will Not Perceive Applicant's Mark As Primarily Merely A Surname**

Here, the Examiner contends that a person associated with the Applicant has the mark as a surname, and places undue weight on this factor, while placing insufficient weight on the German origin of the surname.<sup>3</sup> Specifically, the Examiner contends that "[d]espite the fact that the surname is of German origin does not diminish the surname significance of the mark". *Official Action*, dated July 1, 2011, p. 3. Applicant respectfully disagrees with the Examiner's weighing of these elements, and submits that the surname is unfamiliar to the American public and will therefore not be perceived as primarily merely a surname. Further, there is no evidence of record that the mark SCHÖTTLER by itself, the form in which registration is sought, is associated with Peter Schöttler GmbH by the relevant consuming public in the United States.

Here, Applicant's mark is not a common surname and is therefore unfamiliar to the American public, as demonstrated by the dearth of telephone directory entries. Further, it does not have the look and feel of a surname, as described below. Therefore, this factor does not render the mark primarily merely a surname to the American public, who will not perceive it as such.

**ii. Applicant's Mark Does Not Have The Look And Feel Of a Surname**

The Examiner summarily asserts that "SCHÖTTLER" has the look and sounds of a surname, without providing any analysis or reasoning. *Official Action*, dated July 1, 2011, p. 3.

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<sup>3</sup> As noted above, "Schöttler" is merely a part of Applicant's overall corporate name, and Applicant has advised that although the Applicant corporation was first founded by an individual named Peter Schöttler in Germany in the year 1840, there are currently no individuals associated with the Applicant having the name Peter Schöttler, or having the term Schöttler as a surname. *See supra* § III.

Applicant respectfully disagrees. “[C]ertain surnames are so rare that they do not even have the appearance of surnames. In such cases, even in the absence of non-surname significance, a reasonable application of the ‘primary significance to the purchasing public’ test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful.” TMEP § 1211.01(a)(vi). “SCHÖTTLER” falls under the category of rare surname, which, even without non-surname significance, would be perceived by the American purchasing public as merely arbitrary or fanciful. There is no evidence that “SCHÖ\_\_\_” is a common or recognized structure for a surname (*e.g.*, \_\_\_berg as in Steinberg, \_\_\_man as in Bergsman, \_\_\_lov as in Orlov, etc.). *See In re Spumador S.P.A.*, Serial No. 79/056,027 (T.T.A.B. 2010). In particular, 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. Applicant submits that the American consumer will instead view the mark “SCHÖTTLER” as a fanciful/arbitrary term used in a trademark sense in connection with the identified goods and services.

**d. USPTO Policy Requires Doubt To Be Resolved In Favor Of Applicant**

Finally, Applicant respectfully notes that USPTO policy requires that any doubt as to whether a mark is primarily merely a surname be *resolved in favor of the Applicant*, and that the mark be published for opposition. TMEP § 1211.01; *see also In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995).

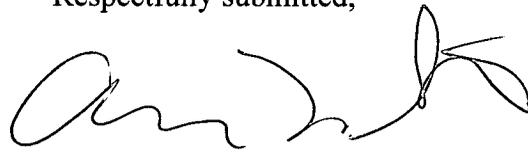
Although Applicant submits that there can be no reasonable doubt that the mark “SCHÖTTLER” will not be perceived to be primarily merely a surname by the relevant American consuming public, trade, and industry, it is nonetheless entitled to registration on the Principal Register under the rule of doubt assuming, arguendo, that any doubt exists.

**V. Conclusion**

Applicant respectfully submits that the evidence of record relied upon by the Examiner is insufficient to meet the Examiner's high burden of proof to establish that the primary significance of the term "SCHÖTTLER" to the purchasing public in the United States is that of primarily merely a surname, and respectfully requests that the refusal to register the mark on the Principal Register under Trademark Action, Section 2(e)(4) be reversed.

Applicant respectfully submits that this Application is in condition for registration on the Principal Register, and respectfully request that it be approved for publication for opposition purposes.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Amanda L. Stone". The signature is fluid and cursive, with a large initial "A" and a stylized "S".

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## TABLE OF AUTHORITIES

### Cases

*In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995)

*In re Establissements Darty et Fils*, 759 F.2d 15, 225 U.S.P.Q. 652 (Fed. Cir. 1985)

*In re Garan, Inc.*, 3 U.S.P.Q.2d 1537 (T.T.A.B. 1987)

*In re Giger*, 78 U.S.P.Q.2d 1405 (T.T.A.B. 2006)

*In re Harris-Intertype, Corp.*, 518 F.2d 629, 186 U.S.P.Q. 238 (C.C.P.A. 1975)

*In re Kahan & Weisz Jewelry Mfg.*, 508 F.2d 831, 184 U.S.P.Q. 421 (C.C.P.A. 1975)

*In re Petrin Corp.*, 231 U.S.P.Q. 902 (T.T.A.B. 1986)

*In re Sava Research Corp.*, 32 U.S.P.Q.2d 1380 (T.T.A.B. 1994)

*In re Spumador S.P.A.*, Serial No. 79/056,027 (T.T.A.B. 2010)

*In re Standard Elektrick Lorenz Aktiengesellschaft*, 371 F.2d 870, 873, 152 U.S.P.Q. 563 (C.C.P.A. 1967)

*In re Wickuler-Kupper-Brauerei KGaA*, 221 U.S.P.Q. 469 (T.T.A.B. 1983)

### Other Authorities

J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION §13.30 (4th Ed. 2011)

TMEP § 1211.01