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Subject: U.S. TRADEMARK APPLICATION NO. 79092036 - SCHÖTTLER - 407-438
- EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 79092036

MARK: SCHÖTTLER



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Peter Schöttler GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

407-438

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1063656

INTRODUCTION

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark SCHÖTTLER for "Metal castings and metal forgings; worked and unworked castings and forgings, in particular forgings of unalloyed, alloyed, rust and/or acid resistant metal materials, worked and unworked castings and forgings made of steel; metal forgings made by drop forging; chain tensioners made of metal, rope tensioners made of metal, belt tensioners made of metal; metal guidance for guiding chains, ropes, and belts, namely, metal guide bars, metal guide rails, metal guide rods, metal guide conducts; metal shorteners for adjusting the length of a chain, rope and belt, namely, shortening claws, shortening hooks, shortening clutches and shortening couplers, metal

connectors and connecting links for chains, rope and belts; metal connectors and connecting links for chains, ropes and belts; metal chain connectors; metal chain joints and chain links; metal lifting chains and ropes, thin metal bands, belts of metal for handling loads, metal slings for loading, wire rope slings, cargo slings of metal; mechanical fastening elements of metal, metal bars, metal chains, wire nets, metal beams, metal hooks, metal catch hooks, metal single hooks, metal double hooks, metal fork head hocks, metal eye hooks, metal sliding hooks, metal wide-mouth hooks, metal eyes, long swivel eyes of metal, swivels, grabs and claws, eyes, claws, shackles and spreader struts of metal; metal securing elements for lifting, lashing and fastening means, namely, hook catches, cotter pins, pins, rings bolts, screws,” in International Class 6 and “Treatment of materials, namely, metalworking and forging, in particular abrading, deburring, blasting, sandblasting, dyeing, lacquering, coating, electroplating, punching, forging, drop forging, annealing and tempering, hardening, plating, polishing, grinding, welding, rolling to the order and specification of others; finishing of materials, in particular metals, for others; manufacture of tools to the order and specification of others,” in International Class 40 and “Engineering services, namely, conducting technical project studies and technical product planning in the field of metalworking and forging; material testing; development of new products, for others,” in International Class 42. Registration was refused on the Principal Register pursuant to Trademark Act Section (e)(4), 15 U.S.C. §1052(e)(4) on the ground that applicant’s mark is primarily merely a surname.

STATEMENT OF FACTS

On February 3, 2011, applicant filed application serial number 79092036 to register the mark SCHÖTTLER for the goods and services specified above in International Classes 6, 40, and 42.

On February 9, 2011, the examining attorney refused registration on the Principal Register based upon Trademark Act Section 2(e)(4) because the proposed mark is primarily merely a surname. In addition, applicant was also required, in the same Office action to amend the identification of goods and amend the recitation of services.

In applicant's response dated May 18, 2011, the identification of goods and recitation of services were amended, and arguments were made in objection to the refusal to register based upon Trademark Act Section 2(e)(4).

On July 1, 2011, the examining attorney withdrew the requirement to amend the recitation of services as applicant satisfied the issues raised in the first Office action with regard to that requirement. However, the refusal to register based upon Trademark Act Section 2(e)(4) and the requirement to amend the identification of goods were maintained and made final because applicant's response did not persuade the examining attorney that the proposed mark is not primarily merely a surname, and because the identification of goods was not amended to resolve the issues raised in the previous Office action.

On November 9, 2011, applicant filed a request for reconsideration of the final refusal and the final requirement made on July 1, 2011. In the request for reconsideration,

applicant amended the identification of goods as required in the July 20, 2011 final Office action, and presented further arguments in favor of registration of the mark.

On December 23, 2011, the examining attorney denied applicant's request for reconsideration regarding the refusal to register based upon Trademark Act Section 2(e)(4) on the grounds that the request did not raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. It should be noted that applicant's request for reconsideration did satisfy the requirement to amend the identification of goods. As a result, that requirement is herein withdrawn.

The sole issue on appeal is whether the mark SCHÖTTLER is primarily merely a surname, under Section 2(e)(4) of the Trademark Act.

ARGUMENTS

Under Trademark Act Section 2(e)(4) "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which . . . (4) is primarily merely a surname. 15 U.S.C. Section 1052(e)(4). Each case must be decided on its own facts, based upon the evidence in the record. *See* TMEP Section 1211. There is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. TMEP §1211.02(a); *see, e.g., In re Monotype Corp. PLC*, 14

USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986). The following five factors are used to determine whether a mark is primarily merely a surname:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname;
and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

See In re Binion, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

The applicant has applied to register the mark SCHÖTTLER for various goods in International Class 6, and services in International Classes 40 and 42. The examining

attorney, in previous Office actions, provided evidence and analysis establishing that the proposed mark is primarily merely a surname. Applicant's arguments, in the responses to Office actions and in its appeal brief refute the evidence and analysis provided by the examining attorney to establish the surname significance of the mark.

First, applicant argues that telephone directory evidence attached by the examining attorney to the first Office action is not adequate to establish that the proposed mark SCHÖTTLER is primarily merely a surname. Applicant specifically states 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.

Applicant cited *In re Harris-Intertype, Corp.*, 518 F.2d 629, 186 U.S.P.Q. 238 (C.C.P.A. 1975) as the standard for the amount of telephone directory evidence necessary establish the surname significance of a mark. In response to applicant's assertion regarding the amount of telephone directory evidence provided, the examining attorney argues that there is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. TMEP §1211.02(a); *see, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that is generally considered to be relevant: telephone directory listings, excerpted articles from computerized research databases, evidence in the record that the term is a surname, the manner of use on specimens,

dictionary definitions of the term and evidence from dictionaries showing no definition of the term. TMEP §1211.02(a).

In this case, the previously attached telephone directory evidence does show the proposed mark used as a surname. Though the listings do not show thousands of usages of SCHÖTTLER used as a surname, the evidence clearly shows that the mark *is* used a surname. As stated above, there is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname. It should be noted that the telephone directory listings were not the sole basis for the surname refusal. The examining attorney provided various pieces of analysis and evidence to establish the surname refusal.

Applicant next argues that no “supplemental evidence” was provided to show the proposed mark as surname. The examining attorney respectfully disagrees with this claim. In each of the previous Office actions, the examining attorney applied the five relevant factors that are used to determine the surname significance of a mark. The “supplemental evidence” that applicant mentions came in the form of negative dictionary evidence,ⁱ evidence of “real world” usage of the mark as a surname was provided,ⁱⁱ and evidence that the proposed mark has no other meaning than as surname was attached to further bolster the examining attorney’s assertion that the proposed mark is primarily merely a surname.

Applicant also argues that the proposed mark SCHÖTTLER is a “rare” surname. While the proposed mark may be a relatively “rare” surname, it does not mean that the SCHÖTTLER is not primarily merely a surname. The primary significance of the term SCHÖTTLER is that of a surname, as shown by the evidence of record. Although applicant’s arguments seek to distinguish the case law regarding “rare” surnames, applicant has not provided any evidence to establish that the mark is *not* a “rare” surname. As stated above, the proposed mark is primarily used as a surname, and the fact that it may be rare does not obviate the fact that the primary use for the term SCHÖTTLER is as a surname.

Further evidence that proposed mark is primarily merely a surname is the fact according to the record, the name “Peter Schöttler” appears within applicant’s name. Applicant acknowledges that the name “Peter Schöttler” refers to the founder of applicant’s corporation. However, applicant attempts to minimize one of the relevant surname factors that places significant importance on the fact that the term in the proposed mark is associated with the name of person connected to applicant’s company. Despite the fact that according to applicant, there are “currently no individuals associated with the applicant having the name Peter Schöttler...,” (See Applicant’s brief page 4) the fact is, Peter Schöttler is connected with the company, in that he was its founder. Given that the founder’s surname is the same as the proposed mark, consumers would perceive that the mark SCHÖTTLER, as it identifies goods and services emanating from a company that uses this term as a surname, is itself a surname.

Further, a term that is the surname of an individual applicant or that of an officer, owner, or principal of applicant's business is probative evidence of the term's surname significance. See TMEP §1211.02(b)(iv); *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985) (holding DARTY primarily merely a surname where "Darty" was the surname of applicant's president); *In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006) (holding GIGER MD primarily merely a surname where "Giger" was the surname of two joint applicants); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname where "Lipp" was the surname of the restaurant's founder and the term "brasserie" (translated as "brewery") was found merely descriptive and disclaimed); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314, 1315 (TTAB 1990) (holding REBO primarily merely a surname where "Rebo" was the surname of applicant's corporate president). *In re Cazes* is particularly on point in this instance, as the circumstances of the surname significance of the mark appear to be the same as in the instant case. In both instances the name of the founder appears in the mark. As the refusal to register was affirmed in *In re Cazes*, under similar circumstances as in the instant case, then it is clear that the proposed mark SCHÖTTLER would be seen by consumers as a surname as well.

Applicant also argues that the "American public" will not perceive SCHÖTTLER as a surname because it is German in origin. The examining attorney asserts that the case law pertinent to Trademark Act Section 2(e)(4) makes no geographic limitations on the origin of the surname that appears in marks. The telephone directory evidence of record shows the term SCHÖTTLER used as the surname of individuals living in the United States.

Since the proposed mark is a surname of individuals living in the U.S., the American public would perceive it as a surname.

Finally, applicant argues that the mark does not have the look and feel of a surname.

Determining whether a mark has the look and feel of a surname is a subjective determination. Applicant states that the combination of letters that comprise the mark and the accent above the letter “O” in the mark does not give the appearance 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.

The evidence of record, the facts of record, and the characteristics of the mark all establish the surname significance of the term SCHÖTTLER. First, there are telephone directory listings in which the term SCHÖTTLER is used as a surname. Second, Peter Schöttler is the founder of applicant’s corporation. Third, evidence of record in the form negative dictionary definitions from both English and German language dictionariesⁱⁱⁱ shows that there are no other meanings of the term SCHÖTTLER other than a surname. Fourth, SCHÖTTLER has the look and feel of a surname. Finally, there is no stylization of the mark that removes any surname significance of the mark.

CONCLUSION

In conclusion, the evidence of record, the characteristics of the mark, and the relevant case law all support the refusal under Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4). The record reflects that primary usage of the term SCHÖTTLER is as a surname. Thus, the mark is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act. Based upon the foregoing, the refusal to register is proper and should be affirmed.

Respectfully submitted,

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ⁱ See attachments to Office action mailed 07/01/2011, pages 2-3

ⁱⁱ See attachment to Office action mailed 07/01/2011, page 5-7

ⁱⁱⁱ See attachments to Office action mailed 07/01/2011 pages 2-3