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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79156860

MARK: HECHTER



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Aulbach Lizenz AG

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

INTERNATIONAL REGISTRATION NO. 1227390

TABLE OF AUTHORITIES

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Aulbach Lizenz AG (hereinafter, "Applicant"), has appealed the trademark examining attorney's refusal to register the mark "HECHTER" for "Leather and imitation leather; moleskin being imitation leather; goods made of leather and imitation leather, namely backpacks, shopping bags, beach bags, traveling bags, garment bags for travel, sports bags, bags for campers, handbags, wheeled bags, school bags, traveling sets being luggage, suitcases; leather or leather-board boxes; trunks being luggage; leather straps; key cases being leather goods; wallets; suitcases, namely, carrying cases; card cases, namely credit card cases, calling card cases; handbags leather being goods; umbrellas; non-fitted vanity cases sold empty " in International Class 18 and "Clothing, namely, tops, bottoms, pants, shirts, skirts, dresses, blouses, shorts, tights, pullovers, jackets, coats, vests, sweaters, gloves, socks, rainwear and neckwear; footwear; headgear, namely hats, caps; bandanas being neckerchiefs; headbands; stockings; hosiery; caps being bonnets; mufflers; hoods; belts; dressing gowns being robes; hats; socks; bedroom slippers; slippers being underwear; suits; clothing of leather, namely, tops, bottoms, pants, shirts, skirts, dresses, blouses, shorts, tights, pullovers, jackets, coats, vests, sweaters, gloves, socks, rainwear and neckwear; headwear; clothing of imitation leather, namely, tops, bottoms, pants, shirts, skirts, dresses, blouses, shorts, tights, pullovers, jackets, coats, vests, sweaters, gloves, socks, rainwear and neckwear; outerclothing, namely jackets, coats; underclothing being underwear; scarves; women's lingerie; furs, namely hats, stoles, muffs, coats; girdles being underwear; vests; wearable garments, namely tops, bottoms, pants, shirts, skirts, dresses, blouses, shorts, tights, pullovers, jackets, coats, vests, sweaters,

gloves, socks, rainwear and neckwear; raincoats; skirts; petticoats; teddies being undergarments; coats; mittens; trousers; parkas; pullovers; dresses; saris; cocktail dresses; aprons; knitwear clothing, namely sweaters; uniforms; jackets; veils; tee-shirts; shorts; bermuda shorts; blousons; gabardines; clothing, namely pants, raincoats; overcoats; trench coats; pelerines; cross-over tops; shirts; cardigans; sweaters; sashes for wear; gloves; tights; drawers, including bathing suits; pajamas; nightwear; nightgowns; dressing gowns; bathing suits and beach suits, sportswear not for diving, namely sports bras, sports jerseys, sports tops, sports leggings; clothing of fur, namely hats, stoles, muffs, coats; footwear other than for orthopedic purposes, namely beach shoes; sports and ski footwear; boots; half-boots; esparto shoes or sandals; sandals; slippers; caps; berets; caps, including bathing caps; turbans; neckties” in International Class 25. Registration was refused under Trademark Act § 2(e)(4), 15 U.S.C. §1052(e)(4), because the proposed mark is primarily merely a surname.

STATEMENT OF THE CASE

On August 12, 2014, applicant filed the request for extension of protection at issue to register the above mark, with a Paris priority date of July 17, 2014. On December 23, 2014, the examining attorney refused registration of the mark on the ground that the proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. In addition, the following requirements were issued: Prior Registration Claim, Mark Description, and Amendment to Identification of Services. On January 28, 2015, applicant responded against the refusal by submitting a 2(f) Claim of acquired distinctiveness based on Active Prior Registration Nos. 3335525, 4016190, and 4033598 and claimed prior registrations, amended the description of the mark, and amended the identification. On February 18, 2015, the examining attorney refused applicant’s 2(f) Claim of acquired distinctiveness based on active prior registrations because the marks in the prior registration were not the legal equivalents of the subject mark and continued the Section 2(e)(4) refusal. Applicant’s amendments to the description of the mark and the identification were accepted and the requirements were satisfied. On August 18, 2015, applicant

responded to the continued refusal. On September 9, 2015 the Section 2(e)(4) refusal was made final. On April 27, 2016, applicant filed this appeal with the Trademark Trial and Appeal Board.

EVIDENCE OF RECORD

The evidence of record consists of:

- A print out of the Lexis Public Records Database showing 174 results for the last name search of HECHTER. The print out lists out 10 of the 174 results. *See* attachment to Office Action dated December 23, 2014.
- A print out from the Collins American English Dictionary showing no results for the word “HECTHER”. *See* attachment to Office Action dated September 9, 2015.
- A print out of a Wikipedia entry for “Daniel Hechter” the fashion designer associated with the present mark. *See* attachment to Office Action dated September 9, 2015.
- A printout from Applicant’s website identifying Daniel Hechter as a fashion designer and creator of the “Daniel Hechter” clothing line. *See* attachment to Office Action dated September 9, 2015.
- A print out of Google search results for “Daniel Hechter”. *See* attachment to Office Action dated September 9, 2015.
- An excerpt from a Warontherocks.com article entitled Empire of Confusion found at <http://warontherocks.com/2015/09/empire-of-confusion/> which mentions Michael Hechter. *See* attachment to Office Action dated September 9, 2015.

- An excerpt from an article in BlouinArtInfo entitled *Nicolas Cage's 101 is One of Two Bugattis Offered Bonhams' Chantilly Sale*, found at <http://www.blouinartinfo.com/news/story/1228680/nicolas-cages-101-is-one-of-two-bugattis-offered-bonhams>, which mentions Daniel Hechter's second fashion show in the 1960's. *See* attachment to Office Action dated September 9, 2015.
- An excerpt from an article in the Financial Express entitled *HiLITE Mall Enters Limelight*, found at <http://www.financialexpress.com/article/companies/hilite-mall-enters-limelight/123215/>, which mentions the Daniel Hechter brand.
- An excerpt from PRWeb found at <http://ww1.prweb.com/prfiles/2015/08/18/12904315/pr-8-18-15.pdf> mentioning Daniel Hechter as the name of a publication. *See* attachment to Office Action dated September 9, 2015.
- An excerpt from an article entitled, *Banker Sentenced to 3 Years for Bribery in Mortgage Scheme*, in the Times of San Diego, found at <http://timesofsandiego.com/business/2015/09/08/banker-sentenced-to-3-years-for-bribery-in-mortgage-scheme/>, mentioning San Diego businessman Israel Hechter. *See* attachment to Office Action dated September 9, 2015.
- An excerpt from an article entitled *MIT website reports death of medical student*, in the Boston Globe found at <https://www.bostonglobe.com/metro/2014/04/19/mit-website-reports-death-medical-student/zlhNLepFJ4twPMX168oI00/story.html>, mentions the death of Eliana Hechter.

ARGUMENTS

SUBSTANTIVE REFUSAL -- MARK IS PRIMARILY MERELY A SURNAME

Registration is refused because the proposed mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); TMEP §§1211 *et seq.* The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975).

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.

Rareness

The examining attorney believes that the evidence of record establishes the surname significance of the surname HECHTER. The evidence as a whole shows the applied-for mark appearing solely as a surname and/or used in a manner associated with a person with that surname.

The evidence from the Lexis Public Records Database shows the applied for mark appearing 174 times as a surname in a nationwide directory of names. *See* attachment to Office Action dated December 23, 2014 at page 2. The web evidence consisting of a variety of articles show the applied for mark referring to four individuals with the surname HECHTER. *See id.*

Applicant's arguments against the Lexis Public Records Database and the web evidence not establishing that the primary significance of the mark as a whole to the purchasing public is that of a surname are unconvincing. Applicant argues that only 10 individuals were actually identified in the Database, with the possibility of duplicative entries, in addition to the two individuals mentioned in the web evidence, "at most, a total of 12 individuals currently living in the United States have the surname Hechter".

However, this line of thinking is inappropriate because it is common practice for examining attorney's to attach as evidence only the first page of the Lexis Public Records Database. "The Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action. *See In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew's Theatres, Inc.*, 769 F2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Florists' Transworld Delivery, Inc.*, 106 USPQ2d 1784, 1786 (TTAB 2013); TBMP §1208.

Additionally, "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 *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986). In this case, the evidence is clear in establishing that there are 174 people with the surname HECHTER. The overall search results show a sufficient number of uses as a surname such that the purchasing public would perceive this term primarily merely as a surname. See *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d at 1537; TMEP §§1211, 1211.01. Applicant argues that the database shows duplicative entries because two individuals are identified by an initial. Even in this were enough to give rise to an appearance of duplicative entries, it is minor since it is possible for two different individuals with the same name may reside in a different residence and have a different phone number.

Applicant then states that if 174 people with the surname HECHTER is the correct amount “174 people out of a total population in excess of 315 million represents that only a miniscule fraction of population share the surname HECHTER.” See Applicant’s brief dated April 27, 2016 at page. 5. Although “HECHTER” appears to be a relatively rare surname, a rare surname may still be unregistrable under Trademark Act Section 2(e)(4) if its primary significance to purchasers is that of a surname. See *In re Etablissements Darty et Fils*, *supra*; *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); see TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. See TMEP §1211.02(b)(i); see, e.g., *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

The website excerpts of record indicate that the term HECHTER is the surname of a number of individuals found on an Internet search of the term and thus would be perceived as a surname by the general public. Although not an actual requirement, applicant claims that “[t]he record does not contain any evidence that the individuals identified with the surname HECHTER have received any notoriety in the United States” and that they were reported in “relatively obscure sources for news and information.” See Applicant’s brief dated April 27, 2016 at pg.6. However, the purchasing public is

familiar with the designer Daniel Hechter and his international fashion label of the same name. Four of the website excerpts refer to Daniel Hechter as the fashion designer, establishing the surname significance and value of HECHTER. Wikipedia and the designer's clothing line website are hardly obscure sources for information for a well-known designer.

Further, the death of medical student, Eliana Hechter, was reported in the Boston Globe, a well-known and award winning news source. Additionally, Eliana Hechter herself was a recipient of a Rhodes Scholarship, one of the oldest and most celebrated international fellowship awards in the world, that publishes the names of recipients on their website. Similarly, the article about San Diego business man, Israel Hechter, was reported on the Times of San Diego, a news website that reaches an average of 40,000 readers a week.

The evidence of record does show the mark HECHTER being used as a surname by individuals who have received notoriety in the United States in widely circulated and known news and information sources. Thus, the purchasing public is likely to view HECHTER as a surname given that it is primarily encountered in that format in the media.

Applicant's Surname Use

Applicant concedes that the designer, Daniel Hechter is affiliated with applicant. Specifically, applicant has claimed ownership of several prior registrations for marks comprised in part of DANIEL HECHTER, each of which the consent of Daniel Hechter was made of record.

While this affiliation is not dispositive of the primary significance of HECHTER as a surname, it is probative evidence of the term's surname significance. TMEP §1211.02(b)(iv); *see, e.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985) (holding DARTY primarily merely a surname where "Darty" was the surname of applicant's corporate president); *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013) (holding MILLER LAW GROUP

primarily merely a surname where “Miller” was the surname of the applicant and the term “law group” was found generic and disclaimed); *In re Cazes*, 21 USPQ2d 1796, 1796-97 (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).

The fact that HECHTER is currently in active use by an individual associated with applicant and that websites continue to associate the designer and the label, weighs against registrability of the applied-for mark. *See* September 9, 2015 Final Office Action

Other Meaning

Evidence that a word has no meaning or significance other than as a surname is relevant to determining whether the word would be perceived as primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986); TMEP §1211.02(b)(vi).

The website evidence from Collins Dictionary shows that the word HECHTER does not appear in the dictionary. *See* attachments to office action dated September 9, 2015 at pages 2.

While applicant claims that HECHTER in the form of “DANIEL HECHTER” is “just as frequently identified as a brand as it is the name of a person” the notoriety of DANIEL HECHTER as an international fashion brand is due in large part to the efforts of the actual person, Daniel Hechter. *See* attachments to office action dated September 9, 2015 at pages 3-4. Yet, evidence of a term’s recognition and fame (e.g., consumer surveys, promotional expenditures) is only relevant to prove acquired distinctiveness under Trademark Act Section 2(f), and is not pertinent to a determination of surname significance. *See In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname despite applicant’s evidence of the mark’s fame, noting that applicant did not make a Section 2(f) claim and, without a formal claim of distinctiveness, “evidence of fame [could not] serve as the basis for allowing registration of applicant’s mark”); *In re McDonald’s Corp.*, 230 USPQ 304, 307 (TTAB 1986) (holding

McDONALD'S primarily merely a surname despite applicant's evidence of secondary meaning, noting that, absent a claim of secondary meaning under Section 2(f), "registration must be refused"); TMEP §1211.02(b)(vii).

Applicant did make a 2(f) acquired distinctiveness claim in their January 28, 2015 response, however it was based on prior registration nos. 3335525, 4016190, and 4033598. As explained in the February 18, 2015 Office action, that claim was insufficient as the registered marks were not the legal equivalents of the mark at issue.

Thus, the word "HECHTER" appears to have no meaning or significance other than as a surname.

Look and Feel

Applicant submits that there is no evidence of record that would support a finding that the applied-for mark is primarily merely a surname. However, the record shows that the term has no readily recognized meaning other than its surname significance. Applicant has not provided any evidence of their own to the contrary and applicant's assertions by themselves are not recognized as evidence. *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 71 (TTAB 1983); *see also Spin Physics, Inc. v. Matsushita Electric Co.*, 168 USPQ 605, 607 (TTAB 1970) (the arguments and opinion of counsel are insufficient to overcome the facts).

Further, on its face, "HECHTER" "would not be perceived as an initialism or acronym, see Sava, supra, and does not have the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix." *In re Gregory* 70 USPQ2d 1792, 1805 (TTAB 2004). HECHTER merely appears to be term with no other meaning than that of a surname.

Sufficiently Stylized

As the final *Benthin* factor addresses stylization, applicant notes that this factor is relevant because the applied-for mark has been filed in a stylized manner.

While true that the applied-for mark was filed in a stylized manner, the description of the mark reads as follows, "The mark consists of the navy blue stylized wording "HECHTER." The navy blue color of the letters is the only form of stylization that the mark has and thus does not rise to the level of being sufficiently stylized to remove the primary significance from that of a surname. Adding a non-distinctive design element or letter stylization to a term that is primarily merely a surname does not change the surname significance of the term. The primary significance of such a mark would still be that of a surname. TMEP §1211.01(b)(ii); see *In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (holding PICKETT a surname despite use of stylized lettering); cf. *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995).

CONCLUSION

As shown by the evidence of record, the proposed mark "HECHTER" is primarily merely a surname. For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal to register applicant's mark under Section 2(e)(4) be affirmed.

Respectfully submitted,

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