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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re G R Lane Health Products Limited

Serial No. 85115445

Jordan A. Lavine of Flaster Greenberg PC for G R Lane Health Products Limited.

Kathleen Lorenzo, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Holtzman, Kuhlke and Hightower, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, G R Lane Health Products Limited, filed an application to register on the Principal Register the mark JAKEMANS in standard characters for goods ultimately identified as “medicated confectionery; medicated confectionery containing menthol; lozenges for pharmaceutical purposes; pastilles for pharmaceutical purposes; medicated throat pastilles, throat lozenges,” in International Class 5, and “non-medicated lozenges; confectionary, namely, pastilles; non-medicated throat pastilles; hard candies,” in International Class 30.¹

¹ Application Serial No. 85115445, filed on August 25, 2010, alleging a bona fide intention to use the mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The examining attorney has refused registration under Section 2(e)(4) of the Trademark Act (15 U.S.C. §1052(e)(4)) on the ground that JAKEMANS is primarily merely a surname. Applicant has appealed. Both applicant and the examining attorney have filed briefs.

A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance to the purchasing public is that of a surname. *See In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). The burden is on the examining attorney to establish a prima facie case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). 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.” *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995). Among the factors to be considered in determining whether a term is primarily merely a surname are (1) the degree of a surname’s rareness; (2) whether anyone connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; and (4) whether the term has the “look and sound” of a surname. *Benthin*, 37 USPQ2d at 1333. *See also In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). Because JAKEMANS is in standard character form, we need not consider the fifth *Benthin* factor here, that is, whether

the manner in which the mark is displayed might negate any surname significance. In addition, the plural or possessive form of a surname does not diminish possible surname significance. *In re Luis Caballero, S.A.*, 223 USPQ 355, 357 (TTAB 1984) (it “does not matter that the subject matter of the application is a plural (or possessive) form of the name. Businesses frequently use a possessive form of their names or marks without an apostrophe.”). *See also In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009).

We first look at the “rareness” of the surname. During prosecution, the examining attorney submitted search results from a LexisNexis nationwide telephone directory showing 87 as the total number of listings for individuals with the surname JAKEMAN in the United States.² The evidence of 87 entries is not substantial evidence that the term JAKEMAN is a common surname. In fact, it supports the conclusion that the surname JAKEMAN is a very rare surname in the United States. *See United Distillers*, 56 USPQ2d at 1221 (“Hackler” held to be a rare surname despite 1295 listings in phone directories). Applicant argues that 87 listings represent a tiny fraction of U.S. surnames.³ Based on the evidence, we find JAKEMAN to be an extremely rare surname.

However, the fact that a term is not a common surname does not *per se* mean that a surname would not be considered to be primarily merely a surname. *See In re Adrian Giger and Thomas Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006). *See also In re E. Martinoni Co.*, 189 USPQ 589, 590 (TTAB 1975); and *In re Industrie Pirelli*

² First Office Action (December 9, 2010).

³ App. Br. p. 3.

Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988). The examining attorney points out that the telephone listings are not concentrated in any one region, but identify individuals in geographically dispersed states. In addition, the examining attorney submitted printouts from Internet websites showing use of JAKEMAN as a surname. The examples in the record comprise: a list of recent real estate sales listed in the Washington Post that includes one person with the surname Jakeman; a reference in a newswire article to the editor of the Encyclopedia of Alabama whose surname is Jakeman; an article in the New York Times referencing a person with the last name Jakeman; a team roster that includes someone with the surname Jakeman; an obituary for a Jakeman from a Petersburg, Virginia paper;⁴ an excerpt from a website offering “Jakeman’s” Canadian maple syrup; the website of someone with the surname Jakeman; a faculty entry from Auburn University for the editor of the Encyclopedia of Alabama;⁵ the website of a law firm with a founding attorney with the surname Jakeman; a faculty entry from Ohio State University for a professor with the surname Jakeman; an article in AdAge referencing the same Jakeman discussed in the New York Times article. The examining attorney characterizes this evidence as showing “the routine appearance of the surname in articles and websites,” which she argues supports the contention that JAKEMAN “is used throughout the United States and is familiar to a geographically broad purchasing public.”⁶

⁴ The foregoing attached to the First Office Action (December 9, 2010).

⁵ The foregoing attached to the Second Office Action (July 20, 2011).

⁶ E.A. Br. p. 6.

This handful of examples do not reflect the type of uses that would outweigh the rareness of this surname to imbue it with primary surname significance. *See Gregory*, 70 USPQ2d at 1795 (ROGAN primarily merely a surname based in part on broad exposure of public to politician, athletes, actors and author with this surname); *see also Sava Research Corp.*, 32 USPQ2d at 1381; and *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

The second factor we consider is whether anyone associated with applicant has the surname JAKEMAN or JAKEMANS. In this case, there is nothing in the record to indicate that anyone associated with applicant has the surname JAKEMAN or JAKEMANS.

As to the third factor, the examining attorney submitted the online search results from the Merriam-Webster dictionary and The Columbia Gazetteer of the World showing no entry for JAKEMAN to establish that there is no other recognized meaning of the term JAKEMAN.⁷ Applicant does not dispute that there is no recognized meaning for JAKEMAN, but argues that does not make the word merely a surname.⁸

Finally, we consider whether JAKEMANS has the look and sound of a surname. In support of her contention that JAKEMAN has the look and feel of a surname, the examining attorney submitted: (1) search results from the LexisNexis nationwide telephone directory showing 2365 individuals with the surname JACKMAN; (2) a third-party registration for JACKMAN registered under Section

⁷ First Office Action (December 9, 2010).

⁸ App. Br. p. 5.

2(f) based on acquired distinctiveness; and (3) online references to a well-known individual, Hugh Jackman, with the surname JACKMAN and four other individuals with the surname Jackman. The examining attorney argues that JAKEMAN is similar in sound, appearance and structure to JACKMAN.

Applicant argues that, while JACKMAN “has gained some recognition due to the renown of the actor Hugh Jackman, the surname Jackman does not sound like the trademark ‘Jakemans.’” Applicant contends that its mark falls in the category of those surnames “that are so rare that they do not even have the appearance of surnames.”⁹

While it can hardly be disputed that surnames end with the suffix “man” the same could be said for first names (e.g., Herman, Norman, Sherman). This factor is highly subjective and based on the evidence and arguments we are unable to make any definitive determinations as to whether applicant’s mark has the “look and sound” of a surname, such that its primary significance is that “of a surname, or an arbitrary term.” *United Distillers*, 56 USPQ2d at 1222.

Finally, the mere fact that applicant’s mark has the same structure as another word that may have the primary significance of a surname, by itself, is not sufficient to support the refusal in this case. *See In re Joint-Stock Co. Baik*, 84 USPQ2d 1921, 1924 (TTAB 2007) (Seeherman, J., concurring) (without more, evidence of look and feel is not sufficient to support a refusal under Section 2(e)(4)).

The examining attorney points to *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d at 1566, noting that, in that case, there were fewer listings in telephone

⁹ App. Br. p. 6, citing, *United Distillers plc*, 56 USPQ2d 1220.

directories. However, in *Pirelli* the second factor also fell in favor of finding the primary significance of “Pirelli” as a surname in that it was the surname of the applicant’s chairman of applicant’s parent group. Here, factor two does not fall in favor of finding primary surname significance and factor one strongly weighs against finding surname significance. As to factor three, to the extent it serves to support surname significance, it is not sufficient to outweigh factor one.

In view of the above, we cannot say that the primary significance to the relevant purchasing public would be solely that of a surname. *United Distillers*, 56 USPQ2d at 1222. In cases where the proposed mark is 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.” *Joint-Stock Co. Baik* (in main opinion) at 1923-24, citing *In re Garan Inc.*, *supra* at 1540. Finally, as noted above, we resolve doubt in favor of an applicant. *Benthin*, 37 USPQ2d at 1334. Based on this record, we conclude that the Office has not satisfied its burden to establish that JAKEMANS is primarily merely a surname.

Decision: The refusal to register under Section 2(e)(4) of the Trademark Act on the ground that it is primarily merely a surname is reversed.