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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mott's LLP

Serial No. 85374805
Serial No. 85436615

Michael Woods of Dr. Pepper Snapple Group for Mott's LLP.

Thomas M. Manor Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Holtzman, Bergsman and Lykos, Administrative Trademark Judge
Opinion by Bergsman, Administrative Trademark Judge:

Applicant, Mott's LLP, filed two applications to register on the Principal Register the mark MOTT'S in standard characters for "baby foods," in International Class 30,¹ and "packaged combinations consisting primarily of fresh fruit, namely, fresh fruit and fresh fruit packaged in combination with cheese, granola, yogurt, and/or caramels," as amended, in International Class 31.² In both applications,

¹ Application Serial No. 85374805, filed on July 19, 2011, based on an allegation of a bona fide intention to use the proposed mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant filed an amendment to allege use on August 15, 2012.

² Application Serial No. 85436615, filed on September 30, 2011, based on an allegation of bona fide intention to use the proposed mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

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applicant claimed ownership of Registration No. 0160454 for the mark MOTT'S (stylized), Registration No. 0802371 for the mark MOTT'S, in typed drawing form under Section 2(f), Registration No. 2272288 for the mark MOTT'S, in typed drawing form under Section 2(f), "and others."

Registration has been refused on the ground that MOTT'S is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C.

§ 1052(e)(1). The appeals are consolidated because they have common issues of fact and law. The references are to the record in Serial No. 85374805 unless indicated otherwise.

The Board must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Trademark Examining Attorney bears the initial burden to make a prima facie showing of surname significance. *Id.* If the Trademark Examining Attorney makes that showing, then the Board must weigh all of the evidence from the Trademark 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, the Board must resolve the doubt in favor of applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In analyzing the surname refusal, the Board must determine the impact MOTT'S has on the purchasing public because "it is the impact or impression which should be evaluated in determining whether or not the primary significance of a

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word when applied to a product is a [sic] surname significance. If it is, *and it is only that*, then it is primarily merely a surname.” *In re Giger*, 78 USPQ2d 1405, 1407 (TTAB 2006), quoting *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975), quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145 (Comm’r 1955) (emphasis in the original).

Our case law sets out the factors to determine if the term is primarily merely a surname:

1. Whether the surname is rare;
2. Whether anyone connected with the applicant has the term as a surname;
3. Whether the term has any other recognized meaning; and,
4. Whether the term has the “look and sound” of a surname.

In re Benthin Management GmbH, 37 USPQ2d at 1332-33.³

At the outset, surname significance of a term is not diminished by the fact that the term is presented in its plural or possessive form. *See In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (holding BINION and BINION’S primarily merely a surname); *In re Woolley’s Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (holding WOOLLEY’S PETITE SUITES for hotel and motel services primarily merely a surname); *In re McDonald’s Corp.*, 230 USPQ 304, 306 (TTAB 1986) (holding MCDONALD’S primarily merely a surname based on a showing of surname

³ The fifth *Benthin* factor, whether the manner in which the mark is displayed might negate any surname significance, is not relevant to our analysis inasmuch as applicant seeks registration of MOTT’S in standard character form.

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significance of “McDonald,” the Board noting that “it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades”); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) (holding BURDONS primarily merely a surname based in part on telephone listings showing surname significance of “Burdon”); *In re Directional Mktg. Corp.*, 204 USPQ 675 (TTAB 1979) (holding DRUMMONDS primarily merely a surname based on a showing of surname significance of “Drummond”).

The Trademark Examining Attorney submitted evidence from the LexisNexis database showing that MOTT appears 5,819 times as a surname in a nationwide directory of names.⁴ Applicant submitted evidence from the 2000 United States Census Data showing that there are 17,013 people with the surname MOTT, ranking it as the 1,941 most common surname.⁵ Although a surname is not among the most common, that does not automatically qualify it as a rare surname. We find that MOTT is not a rare surname. *See In re Binion*, 93 USPQ2d at 1537 (1416 listings of the surname “Binion,” “while hardly a common surname, ... is not so rare that it would not be recognized as a surname.”); *In re Champion International Corporation*, 229 USPQ 550, (TTAB 1985) (McKinley found to be primarily merely a surname in part because it was listed as the 1197th most common surname with an estimated 23,170 people with that surname).

⁴ November 21, 2011 Office action.

⁵ Genealogy Data: Frequently Occurring Surnames from Census 2000 (January 25, 2012 response to Office action and August 14, 2012 response to Office action).

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Although applicant claims that no “current individual with the surname MOTT is connected with Applicant,” applicant was founded in 1842 by Samuel R. Mott.⁶ In any event, that “a proposed mark is not applicant’s surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname.” *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004).

The third factor is whether there is another recognized meaning for “Mott.” Words having significance other than as a surname are not “primarily merely a surname.” *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969)(BIRD is not primarily merely a surname); *Ex parte Omaha Cold Storage Co.*, 111 USPQ 189 (Comm’r Pat. 1956)(DOUGLAS is not primarily merely a surname); *In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989) (CALLISTO has no surname meaning from Greek mythology); *In re BDH, Inc.*, 26 USPQ2d 1556 (TTAB 1993)(GRAINGERS for crackers and chips is not a surname because it would be perceived as suggestive of the grain-based nature of the product). *See also* TMEP §1211.01(a) (8th ed. 2012).

The Trademark Examining Attorney submitted the entry from the Yahoo! Education dictionary (yahoo.com) listing Lucretia Coffin Mott and John Raleigh Mott,⁷ thus, demonstrating that “Mott” has no other significance than as a

⁶ “About Mott’s” (motts.com) attached to the January 25, 2012 response to Office action and August 14, 2012 request for reconsideration.

⁷ February 17, 2012 Office action. *See also* **MERRIAM-WEBSTER** dictionary (m-w.com) identifying Lucretia Coffin Mott and Dictionary.com derived from the **RANDOM HOUSE DICTIONARY** (2013) identifying John Raleigh Mott, Lucretia Coffin Mott and Sir Neville

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surname. However, applicant contends that “Mott” is a reference to Samuel R. Mott, a historical figure “so widely recognized, revered, and celebrated that use of the term MOTT has lost any surname significance.”⁸ A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. *See In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002). We do not agree that Samuel R. Mott is a historical figure for purposes of the Section 2(e)(4) analysis. *Compare Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (holding SOUSA for fireworks and production of events and shows featuring pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant’s goods and services were of a nature that “would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music.”). Applicant’s argument would have carried more weight had it been supported by a reference other than applicant’s website and had Samuel Mott been identified in any of the dictionaries noted above.

Francis Mott. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁸ January 25, 2012 response to Office action.

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The fourth factor, whether “Mott” has the look and feel of a surname, is very subjective. We find that “Mott” looks and sounds like a surname. The record shows that such term has no readily recognized meaning other than its surname significance. Further, on its face, “Mott” does not look like a coined term or an acronym, or like anything else but a surname. This is especially the case with the possessive form of the term, “Mott’s,” that serves to reinforce its impression as a surname.

Applicant also argues that it owns ten registrations “on the Principal Register for the MOTT’S mark, alone and in combination with other terms, none of which cite a § 2(f) claim to acquired distinctiveness.”⁹ The Section 2(e)(4) “primarily merely a surname” refusal refers to words that standing by themselves would be perceived only as a surname. For example, a combination of two surnames, a surname coupled with a distinctive stylization or design element, or a surname with two or more initials are not primarily merely surnames. *See* TMEP § 1211.01(b). Accordingly, applicant’s registrations for MOTT’S IN-A-MINUTE, MINI MOTT’S, MOTT’S MAGIC MIX-IN, etc., are not relevant. That leaves Registration No. 160454 for the mark MOTT’S (stylized) and Registration Nos. 3489891 and 3776242 for MOTT’S in standard character form. On the other hand, as noted above, applicant claimed ownership of Registration No. 0802371 for the mark MOTT’S, in typed drawing form under Section 2(f), and Registration No. 2272288 for the mark MOTT’S, in typed drawing form under Section 2(f).

⁹ Applicant’s Brief, p. 16.

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Applicant's prior registrations do not conclusively rebut the Trademark Examining Attorney's contention that MOTT'S is primarily merely a surname. The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985). Even if some prior registrations had some characteristics similar to the subject matter of this application, the PTO's allowance of such prior registrations does not bind the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Needless to say, while a uniform standard for assessing registrability of marks is an admirable goal, the Board must assess each mark on the record of public perception submitted with the application. Accordingly, the prior registrations owned by applicant have little probative value especially without their accompanying prosecution histories having been made of record.

We find that the examining attorney established a prima facie case that MOTT is primarily merely a surname. As to the mark in possessive form, MOTT'S, the surname significance of a term is not diminished by the fact that the term is presented in its possessive form. As noted above, applicant attempted to overcome the surname significance by arguing that Samuel R. Mott is a historical figure. Evidence that an individual is famous in a particular field does not necessarily establish that the person is a historical figure. *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285 (TTAB 2007). We do not find that Samuel Mott's personal history is in any way so extraordinary that he warrants treatment under the "historical person" exception to the surname refusal. That is to say, his notoriety is not so

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remarkable or so significant that he is a historical figure as contemplated by the case law. *Id.* at 1289.

Decision: The refusal to register under Section 2(e)(4) of the Trademark Act is affirmed.