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

Proceeding	85946217
Applicant	Grand & Piano Parts Distribution B.V.
Applied for Mark	BOLAN
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Applicant: **Grand & Piano Parts Distribution B.V.**
Serial No.: **85/946217**
Filed: **May 30, 2013**
Mark: **BOLAN**
Examining Attorney: **Gilbert M. Swift**
Law Office: **109**
Docket No.: **45407**

APPLICANT'S APPEAL BRIEF

I. Introduction

Pursuant to a Notice of Appeal filed July 18, 2014, Applicant has appealed the Trademark Examining Attorney's final refusal to register Applicant's mark BOLAN for:

Apparatus for recording, transmitting, editing and reproduction of sound featuring piano sounds, silent systems for pianos; components for digital audio systems, namely, hygrometers, headphones, power supplies with cables, electronic piano key sensors, electronic piano pedal sensors, electronic control panels for silent piano systems, piano mute rail installations in the nature of dampers for pianos; amplifiers, speakers, in Class 09;

Musical instruments, especially pianos, grand pianos, digital pianos; piano chords, namely piano strings, piano keys, dampers for pianos, piano hammerheads, piano tuners, musical instrument tuning apparatus, namely, tuning hammers; pianos and piano structural parts, in Class 15;

Piano benches, in Class 20;

Business management featuring procurement, namely, purchasing silent systems for pianos, musical instruments, pianos, grand pianos, digital pianos, piano benches, piano chords, piano keys, dampers for pianos, hammerheads, piano action, piano tuners, head phones, control units for silent systems, all of the above for others, in Class 35; and

Repair and maintenance of grand pianos and pianos; installing of silent systems for pianos, in Class 37

The refusal to register was based on the basis the mark is merely a surname, and is thus not registrable under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4); 37 C.F.R. §2.64(a). Applicant respectfully disagrees with this conclusion and requests that the refusal be withdrawn.

II. Facts

This application for registration on the Principal Register was filed on May 30, 2013. An initial Office Action refusing registration of the mark was mailed on September 14, 2013, alleging that the mark is merely a surname. Applicant's response to this initial refusal was filed on February 28, 2014, pointing out that "Bolan" is an extremely rare surname. Further, Applicant also addressed the fact that there is no evidence that anyone connected to Applicant has the surname BOLAN, and that in light of the extreme rarity of Bolan as a surname, it is logical to conclude that consumers would view it simply as a fanciful term. Further, Applicant stated addresses the fact that there is no evidence that BOLAN has the structure and pronunciation of a surname. A final Office Action refusing registration on the basis that the mark was generic was mailed on April 2, 2014, including additional evidence in the form of ten excerpts of websites featuring persons with the surname BOLAN, as well as website threads concerning ancestors named BOLAN. However, Applicant notes that the Examining Attorney reiterates that, according to Lexis Nexis records, there are 500 persons identified with the surname BOLAN, as submitted as evidence with the initial Action. In response to this final refusal, Applicant filed a Notice of Appeal on July 18, 2014. The deadline for filing this brief is September 16, 2014, sixty days from the mailing date of the Notice of Appeal.

III. Applicant's Argument

The Examining Attorney has refused registration of the applied-for mark on the basis the mark is merely a surname.

The following five factors are used to determine whether a mark is "primarily merely a surname" within the meaning of Section 2(e)(4):

1. its rareness as a surname;
2. whether anyone connected with the applicant has the mark as his or her surname;
3. whether the mark has any recognized meaning other than as a surname;
4. whether the mark has the structure and pronunciation of a surname; and
5. whether the mark is sufficiently stylized such that its primary significance is not that of a surname.

T.M.E.P. § 1211.01. In this case, the fifth factor is inapplicable because Applicant's mark is in standard characters.

A. The Rareness Factor: “Bolan” Is An Extremely Rare Surname

The Examining Attorney’s evidence indicated that there are approximately **455** individuals in the United States with the surname Bolan. Applicant would point out that this listing likely contains some duplicates. *See.e.g., In re Amlin plc*, Serial No. 79011475 (T.T.A.B. September 30, 2008) (non-precedential) (noting six different surname estimates and choosing a midrange of 150). Putting the issue of duplicates aside, and assuming 455 different individuals with the Bolan surname, this fact actually establishes that Bolan is an extremely rare surname. *See In re Joint-Stock Company “Baik”*, 84 U.S.P.Q.2d 1921, 1923 (T.T.A.B. 2007) (“Baik is an extremely rare surname. In concluding so, we rely on the fact that only **456** examples of the Baik surname were located from a comprehensive directory of the entire United States.”). *See also In re Lorch Schweißtechnik GmbH*, Serial No. 85037839, (T.T.A.B. Nov. 29, 2012) (non-precedential).

Importantly, in recent years the Board has placed great weight on the rareness factor. In addition to *Baik*, in which the Board made a point of observing that “Baik is an extremely rare surname,” in another case the Board reversed a surname refusal of BERGFELD by explaining that it was giving the rareness factor “much more weight than the other three factors”:

We find, based on the evidence, that BERGFELD is an extremely rare surname. Although the examining attorney submitted evidence showing use of the surname “Bergfeld” in commerce by different individuals, she was only able to produce evidence indicating there are fewer than 300 individuals with that surname after searching two comprehensive databases.

(...)

*In balancing the aforementioned factors, we make no secret that the first factor, rareness of the surname, has been given much more weight than the other three factors. And, in doing so, we find that any slight tilt toward finding the mark as being primarily a surname based on the other factors is outweighed by the fact that there are fewer than 300 persons with the surname “Bergfeld.” Ultimately, we conclude that applicant’s proposed mark, BERGFELD, is so rarely used as a surname, and that the remaining *Benthin* factors provide little additional support for a finding that it would be so perceived by consumers, that it is not primarily merely a surname.*

In re Hall Wines, LLC, Serial No. 78926151 (T.T.A.B. February 10, 2009) (non-precedential) (emphasis added).

Likewise, in another relatively-recent decision that involved approximately 150 surname listings, the Board found the applied-for mark AMLIN to be “an *extremely* rare surname” and reversed the refusal:

Applicant argues that “Amlin” is an *extremely* rare surname while the Trademark Examining Attorney contends that it is a *relatively* rare surname. Eliminating the unavoidable duplication in the databases and choosing a midrange of one hundred-fifty separate listings in the entire United States, we are looking at a surname for only one in every two million individuals in the U.S. population. Hence, we agree with applicant that “Amlin” is such an *extremely* rare surname that few prospective consumers are likely to perceive it as a surname, and substantially no one will be adversely affected by the registration of this term for the recited services.

Amlin, supra.

Given that there are only about 455 people in the entire United States with the surname Bolan—less than or nearly identical to the number cited in the cases above—substantially no one will be adversely affected by the registration of BOLAN, and this is especially true given that Applicant’s goods are goods and services in the musical instrument industry. The extreme rarity of the surname Bolan thus strongly favors Applicant’s position that BOLAN is not primarily merely a surname.

B. The Remaining Factors

The remaining three factors-whether anyone connected with Applicant has the mark as his or her surname, whether the mark has any recognized meaning other than as a surname, and whether the mark has the structure and pronunciation of a surname- provide little, if any, support to the refusal.

First, there is no evidence that anyone connected to Applicant has the surname Bolan, which makes this factor neutral. *See Amlin, supra* (“there is no evidence in this record that someone with the surname ‘Amlin’ is associated with applicant, making this factor, from applicant’s perspective, neutral at worst.”).

Second, the reliance on negative dictionary evidence is misplaced because it overlooks the fact that consumers are likely to view BOLAN as a fanciful trademark:

[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.

T.M.E.P. § 1211.01(a)(vi). In light of the extreme rarity of Bolan as a surname, it is logical to conclude that consumers would view it simply as a fanciful term. And in any event, the absence of a dictionary definition for “Bolan” does not provide any real support for the refusal because, as the Board has held:

While a significant non-surname meaning usually helps the position of an applicant, we find that the converse (i.e., a determination that the involved term does not have any non-surname meaning) does not help significantly the position of the Trademark Examining Attorney.

Amlin, supra. See also *In re Garan Inc.*, 3 U.S.P.Q.2d 1537, 1539 (T.T.A.B. 1987) (“That there are no other meanings of the name in the English language will not support refusal of registration of the surname under the ‘primarily merely a surname’ statutory language unless the average member of the purchasing public would, upon seeing it used as a trademark, recognize it as a surname.”). Indeed, “the Patent Office has the burden to show that [a term] is primarily merely a surname and unless it meets its burden, appellant need not demonstrate non-surname significance of its mark.” *In re Kahan & Weisz Jewelry Mfg. Corp.*, 184 U.S.P.Q. 421, 422 (C.C.P.A. 1975). See also *In re Sikorsky Aircraft Corp.*, Serial No. 78221800 (T.T.A.B. August 25, 2006) (non- precedential) (“it is not an applicant’s burden to make this showing unless and until the examining attorney first establishes a prima facie case that the term is primarily merely a surname.”).

Third, there is no evidence that BOLAN has the structure and pronunciation of a surname.

C. Conclusion

As a matter of law, it does not follow that the trademark is primarily merely a surname within the meaning of Section 2(e)(4) just because the mark is the surname of someone somewhere and which does not have a dictionary definition. The reliance on a handful of individuals of no particular repute does not show that BOLAN is primarily merely surname. The Board made precisely this point in reversing the surname refusal of AMLIN:

[T]he articles placed into the record by the Trademark Examining Attorney fall far short of supporting her contention that the surname “Amlin” commonly appears in newspapers and other media, or of supporting a finding that individuals having this surname have enjoyed broad exposure to the general public such that “Amlin” is well recognized as a surname.

Amlin, supra. See also *Curlin, supra* (reversing surname refusal of CURLIN and criticizing the examining attorney’s evidence because “[i]n the articles where there is some discussion of a person with the CURLIN surname there is no evidence of any person who has been the subject of media attention or publicity to the extent that the public perception of CURLIN would be affected.”). “[T]he word ‘primarily’ was added to ‘merely’ with the clear ‘intent . . . to draft a provision which would prevent a refusal to register only because a surname was found in a directory to be the name of somebody somewhere.’” *Garan*, 3 U.S.P.Q.2d at 1539 (quoting *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm’r Pats. 1955)).

WHEREFORE, in view of the above comments, Applicant requests that this Board reverse the refusal to register this mark, and pass the application to registration.

One copy of this Brief is filed pursuant to TBMP § 1203.01. It is not believed by Applicant that any additional fees are owed at this time, but the Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 19-0522.

Respectfully submitted,
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Attorney for Applicant