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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85946217 MARK: BOLAN	
CORRESPONDENT ADDRESS: CHERYL L BURBACH HOVEY WILLIAMS LLP 10801 MASTIN ST STE 1000 OVERLAND PARK, KS 66210-1697	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Grand & Piano Parts Distribution B.V.	
CORRESPONDENT'S REFERENCE/DOCKET NO: 45407/4658.0 CORRESPONDENT E-MAIL ADDRESS: tmdocketing.burbach@hoveywilliams.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant has appealed the examining attorney's refusal to register BOLAN for the following goods and services on the grounds that the proposed mark is primarily merely a surname, pursuant to

Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see TMEP §1211.

In addition, the examining attorney required a definite identification of goods with respect to the term, "speakers" in Class 009.

FACTS

Pursuant to its application filed on June 03, 2013, the applicant seeks registration of the standard character mark "BOLAN" for, as amended from the original recitation of goods and services, "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 009; "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 015; "Piano benches" in Class 020; "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 035; and "Repair and maintenance of grand pianos and pianos;

installing of silent systems for pianos" in Class 037. The filing basis of the application was and is now currently intent-to-use.

In the first office action dated September 14, 2013, the examining attorney refused registration under Section 2(e)(4) of the Trademark Act because the applicant's mark was primarily merely a surname and required clarification of the identification of goods and services.

In its Response of February 28, 2014, applicant traversed the Section 2(e)(4) surname refusal and proposed an amended identification of goods and services.

In the Final Office action dated April 02, 2014, the examining attorney maintained both (1) the surname refusal under Section 2(e)(4) and (2) the requirement for an acceptable identification of goods with respect to "speakers" in Class 009.

On July 18, 2014, applicant filed a timely notice of appeal.

FIRST ISSUE: THE MARK "BOLAN" IS PRIMARLY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *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 1531, 1537 (TTAB 2009); see TMEP §§1211, 1211.01.

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.

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).

A. RARENESS OF THE SURNAME

The rarity of a surname is an important factor to be considered in determining whether a term is primarily merely a surname. However, the fact that a surname is rare does not per se preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (holding DARTY primarily merely a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (holding REBO primarily merely a surname); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986) (holding POSTEN primarily merely a surname). Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname. An issue to be considered in determining how rarely a term is used is the media attention or publicity accorded to public personalities who have the surname. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, so as to be broadly exposed to the general public. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). TMEP §1211.01(a)(v).

The examining attorney attached to the initial Office action dated September 14, 2013, the results from the LexisNexis® P-FIND

database, showing 455 listings appearing in telephone books throughout the United States. These listings identify use of the surname BOLAN in in 43 geographically dispersed states as well as the District of Columbia, i.e. all 50 states except Maine, Montana, New Hampshire, North Dakota, Rhode Island, Vermont and West Virginia.

Specifically, evidence from the Ancestry.com website "Surnames > **Bolan**" database demonstrates use of the term BOLAN as a surname. For example:

- "Jeremiah **Bolan**, [...] Seeking parents, birthplace, etc. of Jeremiah **BOLAN**, born c 1850 in New York to parents born in Ireland[...]" Final Office action at p. 14 (emphasis added);
- "My maiden name was **Bolan**. My great-grandfather was a runaway from Ireland because he did not get along with his step-mother. He joined the navy when he was 17[...]" Final Office action at p. 14 (emphasis added);
- "Anna **Bolan** (1890's-1976) of Princeton, WV, [...] My Grandmother's maiden name was Anna **Bolan**, [...]" Final Office action at p. 14 (emphasis added);
- "Thomas **Bolan** b 1817, d Quebec 1885), [...] I have a Thomas **Bolan** b. abt 1817[...]" Final Office action at pp. 14-15 (emphasis added);
- "John Robert **BOLAN** of Alabama, [...] I am searching for any information on the following family: Robert E. **BOLAN** (no information) married to Callie PRUITT (no information) had one

known child: John Robert **BOLAN** [...]" Final Office action at p. 15 (emphasis added); and etc.

See generally, Final Office action at pp. 14-22.

The Ancestry.com website also includes a "Message Boards > Surnames > Bolan" page, containing 42 threads with 74 messages, all pertaining to the surname BOLAN. Please see Final Office action at pp. 23-25.

Additionally, evidence from the Internet shows the routine appearance of the surname in articles and websites. See Final Office action at pp. 2-11. The examining attorney refers to the evidence attached to the Final Office action, discussed here for convenience:

- Professional webpages from various individuals that carry the surname (maiden surname) BOLAN:
 - Erin **Bolan** Hines, Final Office action at p. 2;
 - Terence J **Bolan**, Esq., Final Office action at p. 3; and
 - James S. **Bolan**, Final Office action at p. 4.
 - Kevin M. **Bolan**, Final Office action at p. 7;
- IMDb (Internet Movie Database) entry for Jeremy **Bolan**, Visual Effects, Animation Department, known for such works as *Transformers* (2007), *King Kong* (2005), *Constantine* (2005) and *Garfield 2* (2006), Final Office action at p. 5.
- "Kimberly **Bolan** and Associates is about helping libraries survive and thrive in times of constant change. Kim and her associates are committed to working collaboratively libraries and their communities to rethink library services, facilities, and

operations. Our goal is to keep libraries growing and succeeding through excellent services and design that exceeds expectations." Final Office action at p. 6 (emphasis added).

- "Rachel **Bolan** [...] realized that he wanted to be a performer at a very young age when he went to see Liberace with his parents and Grandmother. 'I was only 5 years old, but was taken aback by the energy that filled the venue' Rachel said. It was after that moment he began listening to all the records that his brother and sisters owned. [...] His first band was called Magic[...]." Final Office action at p. 8.
- Garry **Bolan**, Lecturer: "Professor **Bolan** specializes in public relations, advertising and corporate communication[...]" Final Office action at p. 9 (emphasis added).
- Patrick **Bolan**, "an Assistant Professor at the Center for Magnetic Resonance Research in the Department of Radiology at the University of Minnesota..." Final Office action at p. 10.
- "Brian **Bolan** has been an investment professional for more than 15 years holding roles in equity research, investment banking and private equity investment and analysis." Final Office action at p. 11 (emphasis added).

Thus, the surname BOLAN is used throughout the United States and is familiar to a geographically broad purchasing public. In other words, broad exposure of the name BOLAN to the public through routine appearances in the news media supports the conclusion that the term BOLAN is primarily merely a surname, and the purchasing public would view it as such.

In its Response, applicant refers to decisions have held that less than 300 listings of a surname results in a conclusion that a trademark is not primarily merely a surname. See e.g. *In re Joint-Stock Company "Baik"*, 84 U.S.P.Q.2d 1921, 1923 (T.T.A.B. 2007); *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).

Given that the name the listings evidence for BOLAN is greater than 450, applicant's evidence referencing less than 300 instances of a surname is inapposite here.

Further, other cases have stated that some names, by their very nature, have only a surname significance even though they are rare surnames. In *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), aff'd, 883 F.2d 1026 (Fed. Cir. 1989) (holding PIRELLI to be primarily merely a surname). In that case, the examining attorney found only nine (9) listings of the surname Pirelli in telephone directories, and two (2) Lexis/Nexis database entries. The Board reasoned that "certain rare surnames look like surnames and certain rare surnames do not... 'PIRELLI' falls into the former category..." See also, *In re Petrin Corp.*, 231 USPQ 902 (TTAB) (1986) (holding PETRIN primarily merely a surname on the basis of 24 listings of Petrin as individual surnames from 13 telephone directories and 9 excerpts from the Lexis/Nexis database library).

B. CONNECTION WITH APPLICANT

There is no evidence in the record regarding this factor.

C. RECOGNIZED MEANING OTHER THAN A SURNAME

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 evidence attached to the Final Office action from *The Collins American English Dictionary* shows that the word BOLAN does not appear in the dictionary. See entry attached to Final Office action at pp. 12-13. Thus, this word appears to have no meaning or significance other than as a surname.

In its Response, applicant argues that consumers are likely to view BOLAN not as a surname but as a fanciful term.

Applicant's argument fails, because the evidence of record clearly shows that Bolan has no meaning other than a surname and there is no evidence that the word Bolan would be viewed as fanciful, particularly in light of the evidence of surname use.

D. STRUCTURE AND PRONUNCIATION OF A SURNAME

The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. See *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli*

Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); see TMEP §1211.01(a)(vi).

Here, the two syllable term BOLAN has no apparent dictionary meaning, and as demonstrated above there is substantial evidence that hundreds of people carry the name BOLAN as a surname (or maiden name). Bolan has the structure of a surname, because it is similar in appearance to other surnames on genealogy websites such as Ancestry.com referencing the terms Bolan and Boland as surnames. Thus, considering the widespread recognition of the name BOLAN as a surname, purchasers will readily conclude the term BOLAN is a surname.

E. STYLIZATION OF TERM

Applicant's mark is presented in standard character form and as such is not sufficiently stylized to remove the primary significance from that of a surname.

CONCLUSION: THE MARK "BOLAN" IS PRIMARLY MERELY A SURNAME

Accordingly, the proposed mark, BOLAN, is primarily merely a surname.

For the foregoing reasons, the refusal to register on the basis of § 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), should be affirmed.

SECOND ISSUE: ACCEPTABLE IDENTIFICATION OF GOODS REQUIRED

As noted in the Final Office action, the wording "speakers" in the identification of goods for Class 009 remains indefinite and needs

clarification to specify the goods by common commercial name, e.g. "audio speakers, bass speakers, loudspeakers" TMEP §1402.01. An applicant may amend an identification of goods and services only to clarify or limit the goods and services; adding to or broadening the scope of the goods and services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 et seq., 1402.07 et seq.

To assist the applicant with identifying and classifying goods and services, the examining attorney directed applicant's attention to the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04. The examining attorney attached excerpts from the ID Manual to aid the applicant. Please see attachments to the September 14, 2013 Office action at pages 2 through 5; and attachments to the April 02, 2014 Final action at pages 26 and 27.

In the Final action, the examining attorney proposed the following identification of goods for Class 009 only. Applicant may adopt the following formulation for drafting an acceptable identification for Class 009 only. The suggested language has been bolded for applicant's convenience. "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, **audio speakers, bass speakers, loudspeakers.**"

Accordingly, the requirement for an acceptable identification of goods and services should be affirmed.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of § 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), should be affirmed. Similarly, the requirement for an acceptable identification of goods and services should be affirmed.

Respectfully submitted,

/Gilbert M. Swift/

Trademark Examining Attorney

Law Office 109

Tel. 1+(571) 272-9028

Gilbert.Swift@uspto.gov

Dan Vavonese

Managing Attorney

Law Office 109