

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 31, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Grand & Piano Parts Distribution B.V.
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Serial No. 85946217
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Cheryl L. Burbach of Hovey Williams LLP,
for Grand & Piano Parts Distribution B.V.

Gilbert M. Swift, Trademark Examining Attorney, Law Office 109,
Dan Vavonese, Managing Attorney.

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Before Quinn, Taylor and Shaw,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Grand & Piano Parts Distribution B.V. (“Applicant”) seeks registration on the
Principal Register of the mark BOLAN (in standard characters) 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 International Class 9;

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 International Class 15;

Piano benches in International 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 International Class 35; and

Repair and maintenance of grand pianos and pianos; installing of silent systems for pianos in International Class 37.¹

The Trademark Examining Attorney has finally refused registration of Applicant's mark under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that the mark is primarily merely a surname. Registration was also finally refused as to "speakers" identified in International Class 9 on the basis of Applicant's failure to satisfy the Examining Attorney's requirement for a definite identification of goods solely with respect to that term.

Applicant appealed to this Board, and both Applicant and the Examining Attorney filed briefs. We affirm in part and reverse in part.

Is Bolan Recognized as Being Primarily Merely a Surname?

¹ Application Serial No. 85946217 was filed on May 30, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, and priority based on Section 44(d) of the Trademark Act, on the basis of European Community Registration No. 011853728, filed May 29, 2013.

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 the applicant.” *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995). In *Benthin Management*, the Board identified five factors to be considered in determining whether a mark is primarily merely a surname: (1) the degree of the surname’s rareness; (2) whether anyone connected with the Applicant has the surname; (3) whether the mark has any recognized meaning other than as a surname; (4) whether the mark has the “look and feel” of a surname; and (5) whether the mark is presented in a stylized form distinctive enough to create a separate non-surname impression. Because Applicant seeks to register BOLAN in standard character form, the fifth *Benthin* factor is not relevant in this case and we consider the record in light of the first four factors.

(1) *The degree of the surname’s “rareness*

We turn to the first *Benthin* factor, which is the degree of the surname's rareness. Arguing that BOLAN is not a rare surname, the Examining Attorney, during prosecution of the application, made of record a portion of a "Public Records: Surname" search from the LexisNexis Public Record Database, showing the applied-for mark appearing 455 times as a surname in a nationwide telephone directory of names. The Examining Attorney points out that the listing identifies use of the surname BOLAN in geographically diverse areas comprising 43 of the 50 states as well as the District of Columbia. We recognize that there likely are duplicates among the listings given the instances where the same name is associated with the same address or city. However, the duplication does not appear to be substantial. The Examining Attorney also made of record webpages from the search "Surnames > Bolan data base showing use of BOLAN as a surname as well as a "Message Boards > Surnames > Bolan" page.² We find this evidence has somewhat limited probative value because many of the references are to individuals who we presume by their birth dates are long dead, leading us to question whether this information accurately reflects the current perception of "Bolan" in the United States. In addition, many of the references are responses to ancestor inquiries and merely duplicate the name of the same individuals and, with further regard to the requesting party, appear to duplicate some of the names listed in the LexisNexis database.

² <http://boards.ancestr.com/searchResults.aspx?db=mb&gss=ancMB&rank=0&adv=&p=surnames.Bolan&cst=board&gskw=&psrch=on&>, attachment to final Office action dated April 2, 2014.

The Examining Attorney also points to excerpted materials retrieved from the Internet showing use of BOLAN as a surname in various circumstances and across the United States,³ and maintains that this evidence demonstrates “[geographically] broad exposure of the name BOLAN to the public through routine appearances in the news media.” The examples include: the websites discussing four lawyers (one reference is to a maiden name), a library consultant, two university faculty members, an investment professional and a member of the band Skid Row; and an excerpt from IMDb (Internet Movie Database) discussing a film animator. These few examples do not convince us of the public significance of BOLAN as a surname principally because the subjects of the excerpts are not prominent personages. That is, while the individuals may reside in diverse geographical locations, there is no showing that they are the subject of wide media attention or publicity to the extent that the public perception of the term is affected, even in their distinct geographical locations. *But see In re Gregory*, 70 USPQ2d 1792 (TTAB 2004) (ROGAN primarily merely a surname based in part on broad exposure of public to politician, athletes, actor and author with that surname).

Accordingly, we base our finding of the degree of the surname’s rareness on the 455 listings for the name BOLAN from the LexisNexis data base. While we recognize that there is no minimum number of listings needed to prove that a mark is primarily merely a surname, we conclude, on this record, that BOLAN is an extremely rare surname. *See e.g., In re Joint-Stock Co. “Baik”*, 84 USPQ2d 1921

³ Attachments to the final Office action dated April 2, 2014.

(TTAB 2007) (The Board determined Baik to be an extremely rare surname with only 456 individuals with that name); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006) (The Board determined “Giger” was not a common surname since there were only 545 listings for the name).

(2) Whether the mark is a surname of anyone connected with applicant

The second factor that we look to is whether anyone connected with the Applicant has the mark as a surname. There is no evidence in this record of anyone connected to Applicant with the surname BOLAN. We accordingly treat this factor as neutral.

(3) Whether the mark has any recognized meaning other than as a surname.

The third *Benthin* factor we consider is whether BOLAN has a recognized meaning other than that of 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. *In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986). In connection with this factor, the Examining Attorney has submitted a single excerpt from *Collins American English Dictionary*⁴ showing that the term “Bolan” has no identified meaning in this dictionary. The lack of an entry for “Bolan” in a single dictionary is hardly conclusive of whether that term has any non-surname meaning. Applicant argues that the reliance on negative dictionary evidence is misplaced because it overlooks the fact that consumers “are likely” to

⁴ <http://www.collinsdictionary.com/spellcheck/american/bolan?showCookiePolicy=true>, attached to the final Office action dated April 2, 2014.

view BOLAN as a fanciful mark. This argument is unsupported and, with no contradictory evidence having been produced by Applicant, we are constrained to find that that this factor very slightly favors the Examining Attorney's position.

(4) Whether the mark has the "look and feel" of a surname

Last, we consider the fourth *Bentlin* factor, i.e., whether BOLAN has the "look and feel" of a surname, the determination of which is concededly subjective in nature. When a term does not have the look and feel of a surname, this factor clearly favors the applicant. On the other hand, when it looks and feels like a surname, such a finding merely tends to reinforce a conclusion that the term's primary significance is a surname. The Examining Attorney argues that BOLAN has the structure of a surname, because there are numerous individuals with the surname, it does not have any non-surname significance, and it is similar in appearance to other surnames on the genealogy website, Ancestry.com. In support of his third contention, the Examining Attorney points to evidence from Ancestry.com⁵ showing a reference to the surname "Boland." A review of this evidence shows only a single reference to the name "Boland," and a single reference to each of the names "Boling," "Bolin" and "Boylan," the final three names being less similar in structure to "Bolan." Applicant, on the hand, argues that there is no evidence that BOLAN has the structure and pronunciation of a surname. While we agree that there are at least 455 individuals with the "Bolan" surname, as

⁵ <http://boards.ancestr.com/searchResults.aspx?db=mb&gss=ancMB&rank=0&adv=&p=surnames.Bolan&cst=board&gskw=&psrch=on&>, attachment to final Office action dated April 2, 2014.

discussed, that surname is extremely rare and, thus, we cannot say that there has been sufficient public exposure to lend to it the “look and feel” of a surname. Nor is the lack of non-name significance convincing. Based on the dearth of evidence, combined with the subjective nature of this factor, we are unable to make a definitive determination that Applicant’s mark has the “look and feel” of a surname. Instead, we find that while some may perceive BOLAN as surname, it is as likely that others may perceive it as an arbitrary indicator of the source of Applicant’s goods and services.

After weighing all of the elements in the *Benthin* test, and keeping in mind that we must resolve any doubt as to whether the mark is primarily merely a surname in Applicant’s favor, see *In re Joint-Stock Co. “Baik”*, 84 USPQ2d at 1922; *Benthin Management*, 37 USPQ2d at 1334, we find, largely due to its rareness, that BOLAN is not primarily merely a surname.

Requirement for a More Definite Identification

We turn then to the Examining Attorney’s final requirement for an acceptable identification of goods. By way of background, the Examining Attorney, in his initial Office action, found indefinite the recitations of goods and services in International Classes 9, 15 and 35.⁶ As amended, the Class 9 identification reads as follows (emphasis added):

Apparatus for recording, transmitting, editing and reproduction of sound featuring piano sounds, silent

⁶ Applicant, in its response to the first Office action satisfied the requirement with regard to Classes 9 (other than as to the term “speakers”), 15 and 37.

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**

The Examining Attorney indicated in his final Office Action that the word “speakers” in the amended identification of the Class 9 goods remained indefinite, and specifically stated (emphasis in original): “The wording ‘**speakers**’ in the identification of goods for International Class 009 remains indefinite and needs clarification to specify the goods by common commercial name, e.g. ‘audio speakers, bass speakers, loudspeakers.’”⁷

An applicant must identify the goods specifically to provide public notice and to enable the United States Patent and Trademark Office (“USPTO”) to classify the goods properly and to reach informed judgments concerning likelihood of confusion under 15 U.S.C. § 1052(d). The identification of goods must be specific, definite, clear, accurate, and concise. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev’d on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974).

We agree with the Examining Attorney that the current language does not clearly identify Applicant’s speakers. The problem is that speakers fall into multiple

⁷ We note that the Examining Attorney expressly limited its requirement to the term “speakers” and, accordingly, the requirement pertains to only that particular good within the Class 9 recitation. *See generally* Section 1402.13 of the *Trademark Manual of Examining Procedure* (2015).

categories, and Applicant's failure to specify the particular type (or types) of speakers in connection with which the mark is used fails to provide adequate public notice or to allow the USPTO to reach informed decisions concerning likelihood of confusion. Accordingly, the refusal to register "speakers" based on Applicant's failure to clarify the type of speakers is affirmed. Notably, Applicant did not address this requirement in its brief.

Decision: The refusal to register Applicant's mark BOLAN under Section 2(e)(4) of the Trademark Act is reversed. The requirement for a more definite identification to clarify the word "speakers" in International Class 9 goods is affirmed and registration to Applicant is refused solely as to "speakers."