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

Proceeding	86262060
Applicant	Eximius Coffee, L.L.C.
Applied for Mark	ALDECOA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPLICANT: Eximius Coffee, L.L.C.

SERIAL NO.: 86/262,060

CLASS: 30

FILED: April 24, 2014

EXAMINER: Charles H Hiser IV

MARK: ALDECOA

LAW OFFICE: 112

REPLY BRIEF OF APPLICANT

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark "ALDECOA" on the Principal Register under Trademark Act § 2(e)(4) which claims that Applicant's mark is primarily merely a surname. Applicant hereby files this Reply Brief in accordance with Trademark Rule 2.142(b)(1).

ARGUMENT

The Board has been asked to determine in this *ex parte* appeal whether the term "ALDECOA" is primarily merely a surname. Applicant's attorneys believe that this decision also has the potential to offer much needed guidance to future trademark Examiners when surname refusals arise. Indeed, the response of the Examiner in this proceeding shows exactly why more guidance should come from the Board.

First, Applicant respectfully requests that the Board consider the public policy reasoning behind Congress's creation of restrictions to obtaining registration of a mark that is also a surname. Unlike other types of rejections - likelihood of confusion, misdescriptiveness, scandalous - a surname refusal does not exist to protect the consumer. Instead, it is there to ensure that other U.S. businesses or individuals can use their surnames in the marketplace. If there are only 100 to 300 persons with a particular surname in the U.S., who exactly does the law created by Congress protect

if such rare surnames are refused registration on the Principal Register if the surname has not acquired distinctiveness? If a term is considered rare, having Examiner's go through the remaining factors only ensures that more appeals to this Board must be made, while doing nothing whatsoever to advance the stated policy goals of Congress. The mark is still rare when looking at the additional factors. It does not matter if someone connected with Applicant has the surname at issue, if there is a recognized meaning other than a surname, or if the term has the "look and feel" of a surname. That information does not change the fact that there are virtually no other businesses or individuals that would need to use the rare surname in the marketplace. The other factors should only be relevant to those surnames that are determined by the evidence to be quite common. Common surnames create a unique issue that Congress wished to address - the assurance that other U.S. businesses or individuals can use their surnames in the marketplace.

The Examiner has gone out of his way during the prosecution of this mark to insist that this particular surname is not rare. After seeing that 233 people had the name "ALDECOA" in the 2000 U.S. Census, he searched other sites to see if he could find a bigger number, attaching only the last page of the results. As far as credible evidence goes in this proceeding, the number of persons having the surname "ALDECOA" would have to be approximately 233. With that number in mind, Applicant must ask what purpose the Examiner has in making the rareness factor an issue in this appeal?

Is it because the name "ALDECOA" came up 271 times in a search of newspaper articles (of which only 31 instances were submitted during the prosecution of the mark)? The Examiner cites *In re Gregory* to show that these types of searches are helpful in making a determination of rareness of a surname. See *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). A closer look at *In re*

Gregory reveals that the "examining attorney's search in the database for ROGAN reportedly retrieved 19,552 articles including the term." *Id.* That is a far cry from the 271 articles found in the present Examiner's newspaper searches. Further, in the *In re Gregory* decision, the Board had evidence showing that there were 1,087 instances of the surname "ROGAN" in residential listings. *Id.* These other facts in the *In re Rogan* discussion were left out of the TMEP, leading to instances such as this one where an Examiner submits a few hundred articles containing a surname to somehow show that a clearly rare surname is somehow actually not rare.

Perhaps the discussion in *In re Gregory* as to using appearances of a surname in newspapers or periodicals to make determinations as to whether a surname is rare in the U.S. should be reconsidered? How exactly does such information show whether a surname is rare in the U.S.? The term "ALDECOA" could show up hundreds of thousands of times in newspapers and periodicals across the United States, but that would not change the fact that there are only 233 persons having the name "ALDECOA" in the United States. Regardless, in this case the term "ALDECOA" apparently showed up only 271 times in the Examiner's search for articles (31 of which were attached to Official Actions and most of which consist of repeat occurrences, foreign persons, or insignificant articles that were likely read by a handful of people).

Attorney for Applicant urges the Board to determine that the term "ALDECOA" is an extremely rare surname that should be allowed to register on the Principal Register and to, in effect, stop the analysis as to the remaining factors. As a matter of public policy and judicial efficiency, it would seem to be in the best interests of the Board to also make a hard and fast rule on this issue since it would create less need for Applicant's to appeal adverse surname decisions. At this time, it completely depends on which set of opinions from the Board an Examiner decides to base his or

her decision on as to whether an appeal will be necessary. Applicant argues that stopping the analysis on the first factor for rare surnames or extremely rare surnames would meet the public policy reason for having such a refusal in the first place, namely, to ensure that other U.S. businesses or individuals can use their surnames in the marketplace.

With that being said, Applicant refers the Board to its arguments in the Appeal Brief as to why the remaining factors of the primarily merely a surname test should favor a decision for Applicant in this proceeding. In the unlikely event that the arguments contained in the Appeal Brief and this Reply Brief do not lead the Board to a finding that the "ALDECOA" mark is not primarily merely a surname, Applicant respectfully requests that the present application is remanded to the Examiner for registration on the Supplemental Register.

Respectfully submitted,

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Date

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