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

Proceeding	86356569
Applicant	Kipling Apparel Corp.
Applied for Mark	KIPLING
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re application of :	:	
Kipling Apparel Corp.	:	
	:	**Trademark Examining Attorney:**
Mark: KIPLING	:	**Priscilla Milton**
	:	**Law Office 110**
Serial No.: 86/356,569	:	
	:	
Filed: August 4, 2014	:	
	:	

APPLICANT'S BRIEF ON APPEAL

This is an appeal from the Trademark Examining Attorney's December 17, 2015 final refusal to register the mark KIPLING (Application Serial Number 86/356,569) for the following International Class 20 goods: Picture Frames, and the following International Class 21 goods: Mugs, tumblers, drinking bottles; trays for domestic purposes; coasters not of paper and other than table linen; leather coasters, plastic coasters.

The question presented in this appeal is whether the KIPLING mark, as used in connection with the above goods, is primarily merely a surname. Here, the record clearly demonstrates that KIPLING is not primarily a surname.

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I. DESCRIPTION OF RECORD

1. On August 4, 2014, Applicant filed an application for the KIPLING trademark and it was assigned Serial No. 86/356,569.

2. On October 16, 2014, an Office Action issued wherein the Trademark Examining Attorney refused registration of Applicant's mark because the mark was allegedly primarily merely a surname.

3. On April 16, 2015, Applicant filed a timely response (the "First Response").

4. On June 1, 2015, an Office Action issued wherein the Trademark Examining Attorney maintained her refusal to register Applicant's mark because the mark was allegedly primarily merely a surname.

5. On November 24, 2015, Applicant filed a timely response (the "Second Response").

6. On December 17, 2015, the Trademark Examining Attorney issued a final Office Action.

7. On February 19, 2016, Applicant filed a timely Notice of Appeal.

II. RECITATION OF FACTS

As noted above, an Office Action issued on October 16, 2014, that refused registration of Applicant's mark as being allegedly primarily merely a surname. The Trademark Examining Attorney's "Examiner" evidence consisted of www.whitepages.com listings showing 100 appearances of the mark. In addition, the Trademark Examining Attorney cited a Wikipedia

page referring to the mark as a surname, as well as an online dictionary entry from www.yourdictionary.com defining KIPLING as a surname.

On April 16, 2015, Applicant filed the First Response to the Office Action, providing the following primary rebuttal arguments that the mark is not primarily merely a surname:

1. Kipling is an extremely rare surname. Taking the Trademark Examining Attorney's evidence of 100 North American listings at face value, dividing those listings by the number of people estimated to be living in North America (530 million) shows that only 9 out of every 50 million people have Kipling as a surname, which weighs heavily against KIPLING being primarily merely a surname.

2. No officer or employee of Applicant, nor anyone connected with the design, development, manufacture, or production of Applicant's products, has Kipling as a surname.

3. The KIPLING mark identifies as its source the historical British author, Rudyard Kipling, who was one of the most popular English-language writers throughout the late 19th and 20th centuries. Applicant's marketing materials (as shown in *Exhibit B* of the First Response) show that Applicant's brand was inspired by one of Rudyard Kipling's most famous works, *The Jungle Book*. Moreover, the vast majority of references to Kipling refer to the author Rudyard Kipling.

Additionally, Applicant made the argument that even were Kipling to be considered primarily merely a surname, the KIPLING mark would still be entitled to registration because it has acquired distinctiveness under Section 2(f) of the Lanham Act due to Applicant's well-known brand that has been in operation in the United States and globally for over 30 years.

Applicant provided a list of the six other registrations it currently holds using the KIPLING name.

On June 1, 2015, a second Office Action was issued maintaining the rejection of the mark as being primarily merely a surname. The Trademark Examining Attorney provided further evidence showing an additional 263 listings of the Kipling surname, bringing the total white pages listings to 363. Additionally, the Trademark Examining Attorney rejected the arguments made by Applicant in the First Response, including the argument that the mark had acquired distinctiveness, as the Trademark Examining Attorney contended that Applicant had not shown ownership of prior U.S. registrations for the same mark for related goods.

On November 24, 2015, Applicant filed the Second Response to the second Office Action, providing additional authority and evidence in support of each of the arguments made in the First Response.

On December 17, 2015, the Trademark Examining Attorney issued a Final Office Action rejecting the arguments of Applicant. On February 19, 2016, Applicant timely filed its Notice of Appeal in response.

III. ARGUMENT

A. KIPLING is not primarily merely a surname.

The following five (5) factors are used to determine whether a mark is "primarily merely a surname" within the meaning of Section 2(e)(4):

1. Whether the surname is rare;

2. Whether the term is the surname of anyone connected with the applicant;

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 stylization of lettering is distinctive enough to create a separate commercial impression.

15 U.S.C. §1052(e)(4). *See also TMEP* §1211.01. "If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant." *Id.* (citing *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); *In re Benthin Mgmt. GmgH*, 37 USPQ2d 1332, 1334 (TTAB 1995)). Applicant maintains that there is no doubt that the KIPLING mark is not primarily merely a surname. To the extent any doubt exists, Applicant respectfully requests this Board to overturn the Trademark Examining Attorney's refusal to register the mark in Applicant's favor.

1. **KIPLING is an Extremely Rare Surname**

As noted above, the Trademark Examining Attorney has repeatedly rejected Applicant's argument that KIPLING is an extremely rare surname. However, Applicant respectfully submits that the Trademark Examining Attorney's evidence is insufficient to demonstrate that KIPLING is not a rare surname. In fact, the evidence is to the contrary. There are numerous cases which have concluded that a surname is deemed rare even though there are many listings for the surname. *See, e.g., In re Okamoto Corp.*, 2015 LEXIS 301 (TTAB 2015) (reversing a refusal to register OKAMOTO, the Examining Attorney's submission of 739 Lexis listings for the surname "Okamoto" and 33 Internet excerpts referencing others with that surname was deemed insufficient in showing that the surname is not rare); *In re GR Lane Health Products Limited*, Serial No. 85/115,445 (July 10, 2013) [not precedential] (JAKEMANS for throat lozenges and candies not primarily merely a surname despite evidence of 2,365 Jakemans in nationwide directory); *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 (TTAB 2007) (holding that BAIK is an extremely rare surname based on the fact that only 456 listings of the

surname were found); and *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER rare surname despite 1,295 telephone directory listings).

The foregoing cases clearly establish that the Trademark Office will indeed objectively evaluate the quantity of evidence supporting the rarity of a surname. Even on a case-by-case basis, if the Trademark Office has refused evidence that a surname was not rare based on up to at least 2,365 listings of a particular surname, clearly, the Trademark Examining Attorney's combined evidence of 363 entries for the surname KIPLING is insufficient evidence that the surname is not extremely rare here. Although the quantum of evidence necessary to support a rarity argument varies, the situation where only 9 out of every 50 million people share the surname Kipling should be convincing evidence that the surname is extremely rare and its primary significance to purchasers is not that of a surname.

2. **No One Connected with the Applicant Uses KIPLING as a Surname**

As indicated in the First and Second Responses, no one connected with the design, development, manufacture or production of Applicant's products (including any officer or other employee of Applicant) bears the name Kipling. See *First Response*, p. 3; *Second Response*, p. 3.

3. **KIPLING Has Recognized Meaning Other than as a Surname**

"A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person." *TMEP* §1211.01(a)(iv). *See also Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (holding that DA VINCI is not primarily merely a surname because it primarily refers to Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (SOUSA for fireworks and production of events featuring pyrotechnics held not primarily merely

a surname, where evidence showed present day recognition and fame of composer John Philip Sousa); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (holding that the primary significance of M.C. ESCHER is that of famous deceased Dutch author).

As noted in the First Response:

> "KIPLING identifies the historical British author, Rudyard Kipling, who was one of the most popular English-language writers throughout the late 19th and 20th centuries and whose classic, celebrated children's book *The Jungle Book* is still popular among children around the world today . . . The author and book actually inspired Applicant's own brand name and long-tailed monkey logos [which are subject of numerous registrations noted below]." *First Response*, p. 2.

Applicant has even provided actual evidence that Applicant's KIPLING brand is inspired by Rudyard Kipling. As included as *Exhibit B* of the First Response, Applicant reiterates that its website explains that the brand was named "after the well-known and well-travelled author Rudyard Kipling."

Applicant also indicates that "*kiplingesque*" is defined to mean "in the manner or style of Rudyard Kipling" and continues to be used in modern day language. *Id.* at p.3. Finally, it is worth repeating that both the Trademark Examining Attorney's own evidence of web references for KIPLING, as well as Applicant's evidence in the form of *Exhibit E* of the First Response, demonstrate that "the dominant significance of Kipling is of the historical author Rudyard Kipling." *Id.* at p. 4. Indeed, Kipling's legacy and works are so timeless that they continue to be re-told and re-envisioned to this day, such as in Disney's upcoming motion picture version of Kipling's *The Jungle Book* in April 2016. *See* http://movies.disney.com/the-jungle-book-2016. Clearly, this evidence also demonstrates that Rudyard Kipling's "achievements are 'so remarkable' or 'so significant' that the primary connotation of the term would be that of an

historical individual." Accordingly, Kipling's legacy "remain[s] strong in the minds of the American public." *See In re Pyro-Spectaculars, Inc.*, supra, 63 USPQ2d at 2024.

Applicant therefore urges that, similar to Leonardo Da Vinci, John Philip Sousa, and M.C. Escher, Rudyard Kipling is a historical person who continues to enjoy present day recognition and fame, and therefore KIPLING is not recognized as primarily merely a surname.

4. **The Structure and Pronunciation of KIPLING Does Not Suggest that KIPLING has the Look and Feel of a Surname**

While the Trademark Examining Attorney, in passing, has raised the issue, there is no evidence provided that KIPLING has the look, feel and sound of a surname, only an unsubstantiated conclusory statement. Simply stating that the term has the look and feel of a surname is not sufficient, especially where it already has been determined above that KIPLING is an extremely rare surname. It cannot be assumed, therefore, that if there is little exposure to the surname, the mark could have the "look and feel" of one.

5. **Stylization is Irrelevant**

Because Applicant's Mark is a word mark, the stylization factor is irrelevant.

Looking at the totality of the factors, it is clear that KIPLING is not primarily merely a surname and thus registrable on the Principal Register. To the extent any doubt exists, Applicant respectfully requests this Board rule in Applicant's favor.

B. Even assuming KIPLING is Primarily Merely a Surname, the Mark has Acquired Distinctiveness under Section 2(f) Due to Applicant's Prior Registrations for the Same and Similar Marks for Related Goods

In its First Response, Applicant noted that assuming *arguendo* that KIPLING is primarily merely a surname, Applicant's mark is still entitled to registration on the Principal Register pursuant to Section 2(f) of the Lanham Act. *See First Response*, p. 5. The Trademark

Examining Attorney argues the claim of acquired distinctiveness will only transfer to the relevant goods in this case if the Applicant demonstrates "sufficient relatedness of the goods and/or services in the intent-to-use application and those for which the mark has acquired distinctiveness." Applicant maintains that based on the registrations submitted as part of *Exhibit F* of the First Response, these goods are sufficiently related to the instant goods.

Specifically, based on the registrations submitted as part of *Exhibit F* of the First Response, Applicant's KIPLING mark is registered in connection with the following goods (goods from various registrations combined for purposes of demonstration here):

- Class 6: Metal locks for luggage.
- Class 16: Passport cases, pen or pencil holders.
- Class 18: Women's and girl's handbags, wallets, purses, clutches, and cosmetic bags sold empty; bags for campers, bags for climbers, cosmetic bags sold empty, duffel bags, clutch bags, handbags, travel bags; backpacks; traveling trunks and traveling bags, net bags for shopping, handbags, garment bags for travel, school bags, athletic sport bags, make-up bags sold empty, toilet cases sold empty, suitcases, attaché cases, book bags, rucksacks, backpacks, waist packs, hunters' game bags, key cases, pocket wallets, purses, and umbrellas; handbags, suitcases and wallets; traveling bags; handbags; schoolbags; all-purpose sport bags; cosmetic bags sold empty; vanity cases sold empty; suitcases; carrying cases for books, stationery, clothing and shoes; rucksacks; backpacks; waist packs; bags for board games and card games; key cases; pocket wallets and purses.
- Class 24: Towels.
- Class 25: Jackets; clothing, namely, t-shirts.
- Class 35: Retail store services featuring bags and related accessories; online retails store services and mail order retail store services featuring bags and related accessories.

Furthermore, Applicant notes that the Trademark Office already has and had approved the KIPLING mark for registration in connection with the following goods/services:

- Class 3: After shave lotions; aftershave preparations; Antiperspirants and deodorants for personal use; non-medicated skin creams with essential oils for use in aromatherapy; non-medicated foot cream with essential oils for use in aromatherapy; essential oils for use in aromatherapy; non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; sprays, namely, body sprays; Bath and shower gels and salts not for medical purposes; Bath beads, Bath crystals; Bath gels; Bath pearls; body powder; Bubble bath;

Cologne; Essential oils for personal use; Fragrance sachets; Fragrances for personal use; Hair gels; Hair lotions; Hair shampoos and conditioners; Perfume; Perfume oils; Room fragrances; Shaving cream; Shaving gels; Shaving lotions; Shower and bath foam; Shower and bath gel; Skin creams; Skin lotions; Soaps for personal use; Talcum powders.

- Class 6: Metal key chains; key fobs of common metal.
- Class 9: Cases for spectacles and sunglasses; Chains for spectacles and for sunglasses; Eye glasses; Eyeglass cases; Eyeglass chains and cords; Eyeglass frames; Eyeglass lenses; Eyeglasses; Eyewear; Eyewear cases; Frames for spectacles and sunglasses; Sunglasses and spectacles. [previously allowed]
- Class 14: Jewelry, watches; key chains of precious metal; key ring, namely, trinkets or fobs, of precious metal.
- Class 18: Traveling trunks and traveling bags, net bags for shopping, handbags, garment bags for travel, school bags, athletic sport bags, make-up bags sold empty, toilet cases sold empty, suitcases, attaché cases, book bags, rucksacks, backpacks, waist packs, key cases, pocket wallets, purses, and umbrellas.
- Class 25: Clothes, namely, tops, bottoms, scarves, jackets, and shoes.

Applicant has previously attached as *Exhibit 1* of the Second Response true copies of these application details.

Applicant maintains that based on ownership of these registrations and allowed applications, for the same mark, the goods applied for in the instant application, namely, picture frames, mugs and related products such as drinking bottles and coasters, are in this context sufficiently related to goods already registered under the KIPLING mark, including without limitation: wallets, purses, clutches, and cosmetic bags sold empty, cosmetic bags sold empty, handbags, key cases, handbags. It is common for trademark owners to own registrations of many types of products, including similar types of goods, and consumers can expect that in this vein, mugs and coasters can surely be regarded to be collateral merchandise emanating from the same course. This is made more striking when considering that all of the products are sold under the identical mark.

Based on this overwhelming evidence that the goods in the instant application are sufficiently related to those in existing registrations and allowed applications, Applicant

respectfully submits that its KIPLING mark has acquired distinctiveness under Section 2(f) even if KIPLING was primarily merely a surname.

For these reasons, Applicant respectfully requests that this Board overturn the Office Actions of the Trademark Examining Attorney and allow its Application on the Principal Register.

Respectfully submitted,

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