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Subject: U.S. TRADEMARK APPLICATION NO. 86356569 - KIPLING - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICANT: Kipling Apparel Corp.

MARKS: KIPLING

KIPLING

U.S. APPLICATION SERIAL NOS.

86356608

86356569

CORRESPONDENT ADDRESS:

PAUL J KENNEDY

PEPPER HAMILTON LLP

EIGHTEENTH AND ARCH STREETS 3000 TWO LOG

AN SQUARE

PHILADELPHIA, PA 19103-2799

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

kennedyp@pepperlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Kipling Apparel Corp., a corporation (hereinafter referred to as "applicant) has appealed the trademark examining attorney's final refusal to register the proposed mark "KIPLING." Registration was refused on the Principal Register pursuant to Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4) on the ground that applicant's mark is primarily merely a surname.

FACTS

Applicant has applied for registration on the Principal Register for the mark KIPLING in standard character form, in Serial No. 86356608 for "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; bags for laptops; tablet sleeves; laptop sleeves; cases for cellphones; bicycle helmets," and KIPLING, in standard character form, in Serial No. 86356569 for "picture frames; mugs, tumblers, drinking bottles; trays for domestic purposes; coasters not of paper and other than table linen; leather coasters, plastic coasters."

The applications were filed on August 4, 2014 based on an allegation of applicant's bona fide intention to use the mark in commerce.[1]

[1] Application Serial No. 86356608; and Application Serial No. 86356569.

Registration was refused under Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052€(4) on the ground that applicant's mark is primarily merely a surname. This appeal follows the examining attorney's final refusal under Section 2(e)(4).

On May 12, 2016, the examining attorney filed a motion to consolidate the appeals in application Serial Nos. 86356608 and 86356569. In light of the similarity of records and issues in these cases, the motion was granted. The examining attorney is filing a single brief relating to both appeals. The evidentiary records of both applications are nearly identical. In this brief, all references to the record refer to Application Serial No. 86356608.

The issue on appeal is whether the Section 2(e)(4) refusal should be maintained because the mark is primarily merely a surname and because applicant's showing of acquired distinctiveness is insufficient to allow registration pursuant to Trademark Act Section 2(f).

ARGUMENT

(1) THE MARK IS PRIMARILY MERELY A SURNAME

Trademark Act Section 2(e)(4) states the following: "No Trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on

account of its nature unless it—[…] consists of a mark which is primarily merely a surname." 15 U.S.C. Section 1052(e)(4). The examining attorney must consider the primary significance of the mark to the purchasing public to determine whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.,* 508 F.2d 831, 184 USPQ 421 (CCPA 1975). 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. *See, e.g., In re Monotype Corp. PLC,* 14 USPQ2d 1070 (TTAB 1989). 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.

In re Benthin Mgmt. GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

The examining attorney has made of record sufficient evidence to establish that applicant's mark is primary merely a surname. In the Office action dated October 16, 2014, the examining attorney included evidence from www.whitepages.com, establishing the surname significance of the surname KIPLING. This evidence shows the applied-for mark appearing 100 times as a surname in a nationwide

telephone directory of names. Further, in the Office action dated June 1, 2015, the examining attorney included evidence from LexisNexis®, also establishing the surname significance of KIPLING. This evidence shows the applied-for mark appearing 363 times as a surname in the LexisNexis® surname database, which is a weekly updated directory of cell phone and other phone numbers (such as voice over IP) from various data providers.

The applicant argues that the surname KIPLING is rare. Assuming arguendo that the surname KIPLING is rare, a rare surname may be unregistrable under Trademark Act Section 2(e)(4) if its primary significance to purchasers is that of a surname. *E.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405, 1407-09 (TTAB 2006); *see* TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986).

As to the second factor, there is no evidence in the record regarding whether anyone associated with applicant has the surname KIPLING. However, the fact that no one connected with applicant has the surname KIPLING does not favor the applicant, but is neutral. *See In re Gregory,* 70 USPQ2d 1792 (TTAB 2004).

Evidence that a word has no meaning or significance other than 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). The attached evidence, from the October 16, 2014 Office action found at www.wikipedia.org and www.collinsdictionary.com, refers to KIPLING as a surname, as well as an entry

from the online dictionary www.yourdictionary.com which defines KIPLING as "a surname." Thus, this word appears to have no meaning or significance other than as a surname.

As to the fourth factor, the examining attorney maintains that the mark has the look, feel and sound 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. *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). It is a term with no meaning other than as a surname.

The final factor relates to whether the mark is sufficiently stylized to remove its primary significance from that of a surname. In the present case, the proposed mark is presented in standard character form, and, as such, no claim is made to any particular font, style, size, or color. *See* 37 C.F.R. §2.52(a); TMEP §807.03. Thus, the mark does not contain any stylization or design elements that would obviate the mark's surname significance.

The applicant argues that KIPLING is not primarily a surname because its primary significance is the historical British author, Rudyard Kipling, 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.

In support of this contention applicant has made the following evidence of record:

1. An entry about Rudyard Kipling in Wikipedia;[2]
2. An entry about Rudyard Kipling's book, *The Jungle Book*, including references to adaptations such as film adaptations, comic book adaptations, movie adaptations and the like;[3]
3. An excerpt from the Kipling's Website (www.kipling-brand-usa.com) with applicant's evidence that KIPLING brand is inspired by Rudyard Kipling;[4]
4. Dictionary definitions of the word "kiplingesque" defined as "in the manner of Rudyard Kipling" (www.vocabulary.com)[5] and "in the style of Rudyard Kipling" (www.thefreedictionary.com); [6] and
5. A Google search strategy for the word KIPLING, comprising the first three pages of the search strategy, but no printed articles made of record from this search.[7]

The examining attorney has carefully reviewed applicant's evidence but has found it unpersuasive. The fact that a term is shown to have some significance as a historical figure generally will not dissipate its primary significance as a surname. *See* TMEP §1211.01(a)(iv). The Board has found that where an individual is notable in a particular field, the evidence must show that his or her achievements are "so remarkable" or "so significant" that the primary connotation of the term would be that of an historical individual. *In re Binion*, 93 USPQ2d at 1537-38. The evidence made of record by applicant, specifically, listings in dictionaries and in Wikipedia and a Google search engine strategy that does not include the actual articles are not evidence that the primary connotation of the term KIPLING would be that of a historical individual.

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[2] Applicant's April 16, 2015 Response, Exhibit A.
[3] Applicant's April 16, 2015 Response, Exhibit A.
[4] Applicant's April 16, 2015 Response, Exhibit B.
[5] Applicant's April 16, 2015 Response, Exhibit D.
[6] Applicant's April 16, 2015 Response, Exhibit D.
[7] Applicant's April 16, 2015 Response, Exhibit E.

Decisions concerning historical names generally draw a line between names which are so widely recognized that they are almost exclusively associated with a specific historical figure and are thus not considered primarily merely a surname. *e.g., Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci), and names which are only semi-historical in character and thus can be perceived as primarily merely a surname, *e.g., Frances Rothschild, Inc. v. U.S. Cosmetic Fragrance Marketing Corp.*, 223 USPQ 817 (N.D. Tex. 1983) (ROTHSCHILD held primarily merely a surname despite being the surname of a historical banking family); *In re Champion International Corp.,* 229 USPQ 550 (TTAB 1985) (MCKINLEY held primarily merely a surname despite being the surname of a deceased president). The surname "KIPLING" is not so exclusively associated with Rudyard Kipling, that it no longer is primarily merely a surname. Rather, "Kipling" is more akin to names such as Rothschild and McKinley, as discussed in *Frances Rothschild, Inc.,* and *In re Champion International Corp., supra.*

It seems clear from the record that KIPLING is primarily merely a surname. In applicant's prior registrations, applicant claimed acquired distinctiveness under Trademark Act Section 2(f) for KIPLING in the initial application or a subsequent amendment. Thus, applicant conceded that this wording was not inherently distinctive but was rather primarily merely a surname *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988)). Accordingly, applicant's prior registration(s) is probative to show that applicant's applied-for mark is not inherently distinctive in this case. *See In re Thomas Nelson, Inc.*, 97 USPQ2d at 1713. [8] See for examples, excerpts below.

[8] See attachment to final Office action December 17, 2015

- U.S. Registration No. 4816387, KIPLING {Principal Register – Section 2(f)} for "Metal locks for luggage," and "passport cases; pen or pencil holders."

- U.S. Registration No. 4537944, KIPLING {Principal Register – Section 2(f)} for "jackets."

According, the mark is primarily merely a surname.

(2) APPLICANT'S SECTION 2(f) EVIDENCE IS INSUFFICIENT

An intent-to-use applicant who has used the same mark on related goods and/or services may file a claim of acquired distinctiveness under Trademark Act Section 2(f) before filing an allegation of use, if applicant can establish that, as a result of applicant's use of the mark on other goods and/or services, the mark has become distinctive of the goods and/or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and/or services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

The Trademark Trial and Appeal Board has set forth the following two requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

(1) Applicant must establish that the same mark has acquired distinctiveness as to the other goods and/or services, by submitting evidence such as ownership of a prior registration for the same mark for related goods and/or services, a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark with related goods and/or services, or actual evidence of acquired distinctiveness for the same mark with respect to the other goods and/or services.

(2) Applicant must show sufficient relatedness of the goods and/or services in the intent-to-use application and those for which the mark has acquired distinctiveness to warrant the conclusion that the previously created distinctiveness will transfer to the goods and/or services in the application upon use. The showing necessary to establish relatedness will be decided on a case-by-case basis and will depend upon the nature of the goods and/or services involved and the language used to identify them in the application.

See Kellogg Co. v. Gen. Mills Inc., 82 USPQ2d 1766, 1770-71 (TTAB 2007).

It is applicant's contention that the following registrations owned by applicant create the same continuing commercial impression as the mark KIPLING (standing alone):

- U.S. Registration No. 1952994, KIPLING and Design for "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".

- U.S. Registration No. 3397799, KIPLING and Design for "retail store and wholesale store services in the field of handbags, luggage and related accessories; providing consumer product and dealer information via the Internet"

- U.S. Registration No. 2159124, KIPLING and Design for "clothing, namely, T shirts [and shoes]

- U.S. Registration No. 4537944, KIPLING {Principal Register – Section 2(f)} for "jackets."

- U.S. Registration No. 2945417 KIPLING, {Principal Register – Section 2(f)} for "(CANCELLED – Classes 9, 14, 16, 24, 25, and 28) [Leather and imitation leather sold in bulk;] travel cases; suitcases; school bags; bags, namely, all-purpose sport bags,[garment bags for travel,] bags for campers, bags for climbers, cosmetic bags sold empty, duffel bags, clutch bags, [net bags for shopping;] handbags, travel bags; backpacks [and umbrellas]" [9]

As to the three KIPLING and Design marks, these marks are not legally equivalent to KIPLING (standing alone) because of the addition of the design element. To be legal equivalents, the applied-for mark must be indistinguishable from the previously-registered mark or create the same, continuing commercial impression such that the consumer would consider them both to be the same mark. *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1423 (TTAB 2010).

[9] Applicant's April 16, 2015 Response, Exhibit F. Also note that in Exhibit F. Applicant also provided a copy of U.S. Registration No. 1889981, for the mark MINI-BLASTER ARROW which appears to be a result of a typographical error in the registration number is unrelated. Thus, U.S. Registration No. 1889891, for KIPLING KIPLING and Design while displayed in the chart in applicant's written response, it was not made of record.

Here, the composite marks, containing both words and a design, are not indistinguishable and certainly do not create the same, continuing commercial impression such that the consumer would consider these registered marks the same marks as the marks in the current applications. Thus, because the marks are not the same, the KIPLING and Design marks cannot be considered "the same" for purposes of transferring distinctiveness to the marks as used on the goods in these current intent to use applications.

As to U.S. Registration Nos. 4537944 and 2945417, the marks, KIPLING (standing alone), are identical to the marks in the current applications and thus meets the legal equivalence test.

Turning to the goods and services, the examining attorney maintains that the goods/services in the prior registrations in Classes 25, 18 and 35, primarily clothing. bags and luggage are unrelated to the goods in the current applications, specifically, cases for spectacles and sunglasses; chains for spectacles, 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; bags for laptops; tablet sleeves; laptop sleeves; cases for cellphones; bicycle helmets," in Serial No. 86356608 and "picture frames; mugs, tumblers, drinking bottles; trays for domestic purposes; coasters not of paper and other than table linen; leather coasters, plastic coasters" in Serial No. 86356569. In other words, the similarity or relatedness of the goods and/or services in the prior registrations and the instant application is not self-evident and therefore applicant's Section 2(f) claim is not acceptable. See TMEP §1212.04(c). Although an applicant's ownership of one or more active prior registrations

of the same mark may be sufficient for a prima facie showing of acquired distinctiveness, the prior registrations must be for sufficiently similar or related goods and/or services such that distinctiveness will transfer to the goods and/or services in the application. See In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999). Applicant has not provided any evidence and/or an explanation as to how the goods and/or services in the claimed active prior registrations are similar or related to the goods and/or services in the application such that distinctiveness will transfer to the goods and/or services in the application. *See Bausch & Lomb, Inc. v. Leupold & Stevens, Inc.*, 6 USPQ2d 1475, 1477-78 (TTAB 1988).

CONCLUSION

In conclusion, the evidence of record is sufficient to support the refusal under Trademark Act Section 2(e)(4). Thus, the mark KIPLING is primarily merely a surname and applicant's evidence of acquired distinctiveness is insufficient to avoid the refusal. Therefore, it is respectfully submitted that the refusal under Section 2(e)(4) of the Trademark Act be affirmed.

Respectfully submitted,

/Priscilla Milton/

Chris A. F. Pedersen

Managing Attorney

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