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**THIS DISPOSITION IS NOT
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OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rath

Serial No. 75753597

Roy S. Gordet, Esq. for Dr. Matthias Rath.

Bridget G. Smith, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Simms, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Dr. Matthias Rath, a German citizen, has filed an
application to register the mark "RATH" for the following goods
and services:¹

"nutritional supplements; nutritional
supplements primarily consisting of vitamins,
amino acids, minerals and trace elements;
dietary supplements consisting primarily of
amino acids and trace elements; [and] vitamin
and mineral supplements for medical purposes"
in International Class 5;

"books and newspapers and journals in
the field[s] of healthcare and nutritional
supplements" in International Class 16;

¹ Ser. No. 75753597, filed on July 19, 1999, which is based on both an
allegation of a bona fide intention to use the mark in commerce and,
by a subsequently filed amendment, a claim of ownership of Community
Trademark Reg. No. 000732990, issued on March 8, 2002.

"agricultural seeds, agricultural grains for planting, and wheat seeds for use in agricultural and horticulture containing vitamins, amino acids, minerals and trace elements" in International Class 31;

"educational services, namely, conducting instruction in the form of classes, seminars, conferences, [and] workshops, conducting correspondence courses, and conducting continuing education courses in the fields of healthcare and nutritional supplements; [and] publication of books, newspapers and journals" in International Class 41; and

"medical consultation services in the fields of healthcare and nutritional supplements" in International Class 42.

Registration has been finally refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), on the ground that the mark which applicant seeks to register is primarily merely a surname.

Applicant has appealed. Briefs have been filed, and an oral hearing was held as requested.² We affirm the refusal to register.

As an appropriate starting point for analysis, we observe that as stated by the Board in *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993):

At the outset, it is well settled that whether a mark is primarily merely a surname depends upon whether its primary significance

² Specifically, in light of applicant's requests in both this appeal and the appeal in his companion application, Ser. No. 75753445, that an "oral hearing be conducted through the Video Conference Center Facility," a consolidated oral hearing for the appeals was held by video teleconference, with applicant's counsel participating therein "from the Sunnyvale Center for Innovation, Invention and Ideas located at 465 Mathilda Avenue, Sunnyvale, CA 94068." However, due to certain factual differences, and because the appeals were briefed and argued by different Examining Attorneys, we find it more expeditious to issue a separate opinion in each appeal.

to the purchasing public is that of a surname. The burden is upon the Examining Attorney, in the first instance, to present evidence sufficient to make out a prima facie showing in support of the contention that a particular mark is primarily merely a surname. Provided that the Examining Attorney establishes a prima facie case, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975) and *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975). Whether a term sought to be registered is primarily merely a surname within the meaning of ... the Trademark Act must necessarily be resolved on a case by case basis and, as is the situation with any question of fact, no precedential value can be given to the amount of evidence apparently accepted in a prior proceeding. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

Moreover, as set forth by the Board in *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000):

Among the factors to be considered in determining whether a term is primarily merely a surname are the following: (i) whether the surname is rare; (ii) whether anyone connected with applicant has the involved term as a surname; (iii) whether the term has any other recognized meaning; and (iv) whether the term has the "look and feel" of a surname. See *In re Benthin Management GmbH*, 37 USPQ2d 1332[, 1333] (TTAB 1995).

In the present case, we agree with the Examining Attorney that the record contains sufficient evidence to make out a prima facie case that the primary significance of the mark "RATH" to the purchasing public for applicant's goods and services is that of a surname and that such showing has not been rebutted by applicant. Specifically, the record contains the following evidence in support of the refusal to register: (i) a

copy of the results of a search of the "PHONEDISC POWERFINDER USA ONE 1999, 2nd edition," database which indicates a total of 2,950 residential listings in the United States were found for individuals with the surname "RATH"; (ii) copies of the pertinent pages from Merriam Webster's Geographical Dictionary (3d ed. 1998) and Merriam Webster's Collegiate Dictionary (10th ed. 1998) which show an absence of any listing for the term "RATH"; (iii) copies of portions from a random sample of 22 out of 20,021 articles, retrieved from a search of the "NEXIS" database, which refer to individuals with the surname "RATH"; and (iv) a printout of the results of an Internet search in the "Yahoo! People Search" database which shows an additional 200 listings in the United States were found for individuals with the surname "RATH."

The above evidence shows that the term "RATH" is a surname; that its surname significance is not rare or uncommon; and that such term has no readily recognizable meaning other than that of its surname significance. Moreover, the term "RATH" is the surname of applicant, Dr. Matthias Rath, and to us it has the look and feel of a surname, although such a determination concededly is highly subjective. The sole countervailing evidence offered by applicant is dictionary definitions of the following two words which, he notes, are phonetic equivalents of the surname "RATH": (i) "rathe," which The American Heritage College Dictionary (1997) defines as "appearing or ripening early in the year, as flowers or fruit"; and (ii) "wrath," which the same dictionary lists as "forceful, often vindictive anger; punishment or vengeance as a manifestation of anger."

However, as the Examining Attorney accurately observes in her brief, "no evidence has been provided [by applicant] to show that the proposed mark RATH has any other significance" and thus, as set forth in TMEP Section 1211.01(a)(ii) (3d ed. 2d rev. May 2003), it remains the case that:

A term may be primarily merely a surname even if it is the phonetic equivalent of a word that has an ordinary meaning (e.g., Byrne/burn; Knott/not or knot; Chappell/chapel). See *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant's argument that PICKETT is the phonetic equivalent of the word "picket").

Moreover, as to the word "rathe," it is pointed out that unless there is a readily recognized meaning for a term apart from its surname significance, the fact that another meaning for the term exists does not necessarily indicate that the term would have a primary meaning to the purchasing public other than that of its ordinary surname significance. See, e.g., *In re Hamilton Pharmaceuticals Ltd.*, supra at 1942; and *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1367-68 (TTAB 1987). We judicially notice in this regard that, for example, while defining the word "rathe" in a manner similar to that shown by applicant, The Random House Dictionary of the English Language (2d ed. 1987) at 1602 also indicates that such word is "archaic" and hence is now rarely used: "rathe ... *adj.* *Archaic.* growing, blooming or ripening early in the year or season."³ Thus, as indicated above, the

³ It is well established that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217

record establishes prima facie that the primary significance of the term "RATH" to the purchasing public for applicant's goods and services is that of a surname. The mark "RATH" is therefore primarily merely a surname within the meaning of Section 2(e)(4) of the statute and, absent proof of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f),⁴ it is not registrable on the Principal Register.

Applicant, while essentially conceding that the record shows that registration is barred by Section 2(e)(4), nonetheless requests in his initial brief that his "application for the mark RATH be passed to publication for opposition notwithstanding that it is 'primarily merely a surname'." As the basis therefor, applicant argues that imposing such a refusal "is inappropriate because such ... is not permissible against an application filed by a citizen of a member nation under the Paris Convention [for the Protection of Industrial Property]" (hereinafter "Paris Treaty" or "Paris Convention"). In support of his argument, which is discussed in detail below, applicant relies upon copies

USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

⁴ While it is noted that applicant, with his initial response to the refusal to register, submitted a declaration from Aleksandra Niewiecki, who is stated to be "Vice-President" of Matthias Rath, Inc. (although the relationship of such entity to applicant is not indicated), which attests to advertising expenditures made and revenues received with respect to sales of applicant's goods and services in the United States, applicant specifically states in his initial brief that, as set forth below, he is not seeking registration of the mark "RATH" based upon a claim of acquired distinctiveness:

Although Applicant had earlier tentatively expressed a desire to seek registration under Section 2(f) (secondary meaning), Applicant never did amend his application to seek registration under Section 2(f). Applicant does not seek to register his mark under Section 2(f).

of the following: (i) an article from the International Review of Industrial Property and Copyright Law "summarizing and translating a German court's interpretation of the *telle quelle* provision of the Paris Treaty"; (ii) an excerpt from the German Industrial Property, Copyright and Antitrust Laws demonstrating that, "under German law, there is nothing corresponding to the arbitrary provision of the U.S. law in Section 2(e)(4) prohibiting the registration of a term because it appears to be 'primarily merely a surname'"; and (iii) a European Community Council Regulation showing that, "under the established European Community trademark laws, there [likewise] is no restriction on the registration of names, including surnames."⁵

Specifically, based upon such evidence, and relying upon *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 918 (TTAB 1984), applicant contends as the underlying premise to his argument that, as set forth in such decision, the English translation of the relevant portions of Article 6 of the Paris Treaty provides, among other things, that:

A. Every trade-mark registered in the country of origin shall be admitted for registration and protected in the form

⁵ The above documents, however, were submitted for the first time with applicant's initial brief. Although applicant, in such brief, asserts that "[e]very argument presented ..., as well as all of the ... evidence relied upon, was presented to the Examining Attorney ... prior to the following [sic] of the Notice of Appeal," we note that while applicant, beginning with his initial response to the refusal to register, has advanced an argument under the Paris Treaty, the documents furnished in support thereof technically are untimely under Trademark Rule 2.142(d). Nevertheless, inasmuch as such documents are properly the subject of judicial notice, and since in any event it is obvious from the Examining Attorney's brief that she has treated the evidence as forming part of the record and has not objected thereto, we have considered the documents submitted with applicant's initial brief.

originally registered in the other countries of the Union under the reservations indicated below

B. (1) Nevertheless, the following marks may be refused or canceled:

1. Those which are of such a nature as to prejudice rights acquired by third parties in the country where protection is applied for.
2. Those which have no distinctive character
3. Those which are contrary to morality or public order

(2) Trade-marks cannot be refused in the other countries of the Union on the sole ground that they differ from the marks protected in the country of origin only by elements not altering the distinctive character and not affecting the identity of the marks in the form under which they have been registered in the aforesaid country of origin.

Applicant additionally notes that *Crocker Bank*, supra at 918-19, contains the following statement which, we observe, is actually a quote from *In re Societe Fromageries Bel*, 105 USPQ 392, 398 (Comm'r Pats. 1955):

Reduced to its simplest form, Article 6 merely means that when a registration of a mark has issued in an applicant's home country ("country of origin") in accordance with the law of that country, the United States Patent [and Trademark] Office will, upon receipt of a properly executed application, a copy of the home registration, a drawing of the mark, and the filing of the fee, accept the foreign registration at face value and issue a registration in the United States, unless the mark infringes rights previously acquired by another, or it has no distinctive character, or is contrary to morality or public order.

In view thereof, applicant in his initial brief "concedes that the Trademark Office is within its rights under the Lanham Act in juxtaposition with the Paris Treaty to deny registration if the Trademark Office deems a mark to be 'merely descriptive'." Applicant further asserts, however, that it is clear that a refusal on the ground that a mark is "'primarily merely a surname' does not fall within any permissible prohibition set forth in the Paris Convention as quoted in any of the above paragraphs from the *Crocker Bank* decision" inasmuch as such a refusal "cannot be characterized as 'infring[ing] rights previously acquired by another, or [having] no distinctive character, or [being] contrary to morality or public order.'" Thus, according to applicant:

The language of the Lanham Act, supported by implication in the discussion in T.M.E.P. § 1211, makes plain that the refusal for reason of being "primarily merely a surname" is distinguishable from any of the permissible reasons under Section 6 of the Paris Convention for denying registration to a foreign applicant under Section 44(e). For example, it cannot be said that the mark "RATH" has "no distinctive character", and indeed the "surname" objection is admittedly different in character from an objection that a mark is "merely descriptive."

While, to us, applicant's reliance on TMEP Section 1211 (3d ed. 2d rev. May 2003) is plainly misplaced,⁶ applicant

⁶ Such section, which makes clear that a mark which is primarily merely a surname lacks inherent distinctiveness and is thus registrable on the Principal Register only in the event of a showing of acquired distinctiveness, provides in pertinent part that:

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing of acquired distinctiveness under §2(f), 15 U.S.C.

nonetheless insists that the refusal of his mark, although admittedly primarily merely a surname, is impermissible:

In conclusion, the denial of registration on the ground that the mark is "primarily merely a surname", when the mark is duly registered on Applicant's home trademark register, constitutes a violation of Section 6 of the Paris Convention. Under *Crocker Bank, supra* [at 920-21], such a violation of the Paris Convention is not to be countenanced. The objection raised by the Examiner is therefore not a proper ground for objection to an application filed by a citizen of a Paris Convention member under Section 44(e) of the Lanham Act. Accordingly, Applicant submits that the objection on this ground be withdrawn.

Applicant, in addition, urges that its position is supported by the copy which he has furnished of "a decision of the German

§1052(f). See TMEP §§1212 et seq. regarding acquired distinctiveness.

The Trademark Act, in §2(e)(4), reflects the common law that exclusive rights in a surname per se cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name. In re *Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

Likewise, as applicant has conceded, a merely descriptive mark is not registrable on the Principal Register. The reason therefor, obviously, is that such a mark, like a mark which is primarily merely a surname, is considered to lack inherent distinctiveness and, consequently, is registrable on the Principal Register only with a showing of acquired distinctiveness. TMEP Section 1209 (3d ed. 2d rev. May 2003), which in relevant part parallels TMEP Section 1211, accordingly provides that:

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C. §1052(f). See TMEP §1209.01(b) regarding merely descriptive marks, and TMEP §§1212 et seq. regarding acquired distinctiveness.

Federal Supreme Court (Bundesgerichtshof), Case No. 1ZB 7/89 as published in a leading German law review entitled International Review of Industrial Property and Copyright Law." In particular, applicant points out that:

As noted therein, a trademark registered in a member of the Paris Treaty cannot be refused registration in the Federal Republic of Germany by virtue of a restriction under German law prohibiting the registration of "letter trademarks" The reasoning of the German high court is identical to the reasoning provided by Applicant in this appeal brief and in communications to the Examining Attorney during the prosecution of this application. As noted in that German high court decision, protection and registration may be refused only under the circumstances set forth in the Paris Treaty.
....

Lastly, applicant points out that the evidence he has submitted demonstrates that, under both German and European Community law, there is no prohibition or restriction with respect to the registration of personal names, including those of the type which, under Section 2(e)(4) of the Trademark Act of 1946, would be considered to be primarily merely a surname. It is therefore inequitable, he maintains, for applicant "to be subject to conflicting standards, a result [which is] prohibited under the Paris Treaty."

We agree with the Examining Attorney, however, that applicant's argument that, under the Paris Convention, his "application for the mark RATH [should] be passed to publication for opposition notwithstanding that it is 'primarily merely a surname'" is without merit. Generally speaking, as pointed out

in what applicant, in his initial brief, acknowledges is "a leading treatise on American trademark law," it has long been the accepted view that (footnotes omitted):

The Paris Convention is essentially a compact between the various member nations to accord in their own countries to citizens of the other member nations trademark and other rights comparable to those accorded their own citizens by their domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens. The [Paris] Convention is not premised upon the idea that the trademark laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation's law shall have only territorial application. Thus, the Paris Convention creates nothing that even remotely resembles a "world mark" or an "international registration." Rather, it recognizes the principle of the territoriality of trademarks: a mark exists only under the laws of each sovereign nation.

4 J. McCarthy, McCarthy on Trademarks & Unfair Competition §29:25 (4th ed. 2003).

Moreover, as to the *Crocker Bank* case relied upon by applicant, such case specifically held only that because certain *requirements* are inconsistent with the Paris Convention, an applicant seeking registration of a mark solely pursuant to the provisions of Section 44 of the Trademark Act of 1946, 15 U.S.C. §1126, need not comply with the requirements of (i) alleging use of the mark somewhere on or before the filing date of the U.S. application and (ii) providing specimens demonstrating such use. 223 USPQ at 909. Here, not only is applicant seeking registration on the originally asserted basis of a bona fide intention to use the mark "RATH" in commerce and not just on the

subsequently added basis of his ownership of a European Community trademark registration,⁷ but in any event it is clear from the Board's discussion of the "*telle quelle*" principle in the *Crocker Bank* case that the statutory prohibitions to registration are as applicable to an application which is based on a foreign application or registration under Section 44 as they are to an application which is based on use in commerce under Section 1. In particular, the Board in this regard stated in *Crocker Bank*, supra at 919, that:

This is best illustrated by the very first ground of refusal under paragraph B of Article 6 [of the Paris Convention,] which is akin to section 2(d) of our Trademark Act. It goes without saying that the likelihood of confusion of purchasers due to a mark's similarity with the mark of another which is registered or has been previously used is an extrinsic ground having nothing to do with the mark's intrinsic form or nature.

Similarly, we observe that under paragraph B of Article 6 of the Paris Convention, "marks [which] may be refused" include "[t]hose which have no distinctive character." Such marks plainly are akin to marks which, under the Trademark Act of 1946, are lacking in inherent distinctiveness and, thus, include a mark which is primarily merely a surname and, as applicant has admitted, a mark which is merely descriptive.

Accordingly, even if applicant were basing his application solely upon Section 44, the Examining Attorney is correct in her brief in noting that, as set forth in TMEP Section

⁷ We find nothing in applicant's reply brief or elsewhere in his prosecution of the application which indicates that applicant has withdrawn the initial basis of his application and is thus seeking registration on the basis of Section 44 alone.

1007 (3d ed. 2d rev. May 2003), the standards for registration thereunder are as follows:⁸

Although §44 exempts qualified applicants from the use requirements of §1 of the Trademark Act, §44 applicants must meet all other requirements for registration set forth in the Trademark Act and relevant rules. Registration in a foreign country does not automatically ensure eligibility for registration in the United States. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); Order Sons of Italy in America v. Marofa S.A., 38 USPQ2d 1602 (TTAB 1996).

The foreign registration that is the basis for the United States application may include disclaimers or may be on a secondary register, equivalent to the Supplemental Register. The United States application will be reviewed according to the standards for registrability in the United States, and the examining attorney will not require a disclaimer, amendment to the Supplemental Register or any other amendment unless it is required under United States law and Office policy.

As a final consideration, it is pointed out that, with respect to an application based on Section 44(d)(2) to register the mark "DARTY," our principal reviewing court, in upholding a refusal to register such mark on the ground that it is primarily merely a surname and thus is not registrable on the Principal Register in the absence of proof of acquired distinctiveness,

⁸ While, technically, we note that the case of Order Sons of Italy in America v. Marofa S.A., 38 USPQ2d 1602 (TTAB 1996), which is cited in such section is "[u]npublished" and thus "is not binding precedent," the case is nonetheless interesting in accurately stating that "international treaties do not bestow any absolute right of registration upon a foreign applicant, but rather all normal bars to United States registration ... are applicable." 38 USPQ2d at 1603-04.

stated in *In re Etablissements Darty et Fils*, supra at 654, that (footnotes omitted):

Nor can we accept appellant's further argument that, because the application is based on foreign priority, proof of distinctiveness cannot be required. Section 44(d)(2) merely excuses certain foreign applicants from alleging use in commerce to secure a registration under the statute. The section does not require that registration be afforded on the Principal Register, as opposed to the Supplemental Register, in the absence of a showing of secondary meaning acquired by use in this country. Indeed, Section 44(e) specifically directs issuance of a registration on the Principal Register only "if eligible."

Accordingly, and because for present purposes, there is no significant difference between an application filed pursuant to Section 44(d)(2), as in *Darty*, and an application filed pursuant to Section 44(e), as is partially the case herein,⁹ applicant's application for the mark "RATH" is not eligible for registration on the Principal Register inasmuch as such mark is primarily merely a surname which has not been shown to have acquired distinctiveness.

Decision: The refusal under Section 2(e)(4) is affirmed.

⁹ Plainly, in either instance, a certified copy of the foreign registration must be submitted before the mark sought to be registered may be published for opposition or a registration may be issued. See TMEP Sections 1003.03 and 1004.01 (3d ed. 2d rev. May 2003).