

TTAB

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

_____)
In re Trademark Application of:)
Gibson Piano Ventures, Inc.)
Serial No. 76/411,174)
Filed: May 20, 2002)
Mark: FRANKE)
_____)

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

**BRIEF OF APPELLANT UNDER SECTION 2.142(b) OF THE U.S.
TRADEMARK ACT**

Introduction

Applicant hereby appeals the Examiner's final refusal to register the above-identified mark and respectfully requests that Trademark Trial and Appeal Board reverse the Examiner's decision.

Appellant's Notice of Appeal was timely filed on November 19, 2003. Therefore, this brief, filed within sixty (60) days of the Notice of Appeal, has been timely filed.

Statement of the Facts

Appellant seeks registration on the Principal Register of its mark FRANKE for "pianos" in International Class 15.

The Examining Attorney has refused registration of Appellant's mark asserting that the mark is primarily merely a surname and that its registration is precluded under Section 2(e)(4) of the U.S. Trademark Act.



01-20-2004

Argument

Appellant maintains that the mark FRANKE should not be deemed primarily merely a surname for two reasons. First, there is insufficient evidence that the term is “primarily” merely a surname. Second, the term has some historical significance, i.e., it identifies a historical person in the vintage piano industry, such that the surname is not primarily merely a surname.

A. The Examiner Has Not Provided Enough Proof to Establish a *Prima Facie* Case that the Mark is Primarily Merely a Surname

In the first Official Action, mailed on September 6, 2002, the Examining Attorney provided a printout from PowerFinder indicating that the term "Franke" appeared as a surname in the telephone directory. The search results indicated that there were about 3,500 persons who have the surname “franke.” There is no indication of whether this search was of the entire US citizenry or one particular geographical area, such as a city. Applicant admits that the term “franke” has *some* significance as a surname but contends that evidence of about 3,500 persons having this surname, particularly if this number constitutes the entire US citizenry, does not render the term “primarily” merely a surname as required by the statute.

Later, in the second Official Action, mailed on May 30, 2003, the Examiner repeated the refusal to register the mark and attached as evidence selected stories from a LEXIS/NEXIS search. The search that the Examiner conducted indicated that there were 14,675 stories containing the term

"Franke." However, the Examiner only printed out excerpts from seven (7) of the stories.

It is presumed that the Examiner has provided the best evidence to support the refusal to register the mark. *See In re Federated Department Stores, Inc.*, 3 U.S.P.Q.2d 1541, 1542 n.2 (TTAB 1987). Therefore, Appellant is led to believe that the 14,668 stories *not* made of record do not support the position that FRANKE is a surname and, indeed may even show that FRANKE has non-surname meanings. *See In re Monotype Corp.*, 14 U.S.P.Q.2d 1070, 1071 (TTAB 1989) ("We must conclude that, because the Examining Attorney is presumed to have made the best case possible, the 46 stories not made of record [the search yielded 48 stories] do not support the position that CALISTO is a surname and, indeed, show that CALISTO has non-surname meanings.").

Appellant concedes that the FRANKE mark obviously has some surname significance; however, Appellant contends that the term's use as a surname is rare and that the evidence submitted by the Examiner does not prove that the mark is "primarily" merely a surname.

B. The Term "FRANKE" Signifies a Historical Person

Appellant further contends that the term "FRANKE" identifies a historical person and that the refusal to register the mark under Section 2(e)(4) should be withdrawn on this ground also.

Firmant Arthur Franke was a Polish piano maker. Pianos bearing his name were made for many years as indicated in the excerpt "Pierce Piano Atlas 10th Edition," which was attached as an exhibit to Applicant's Response to [the First] Office Action (mailed on March 4, 2003).

Because the mark FRANKE identifies a historical person, the term is not primarily merely a surname. See *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F.Supp. 329, 165 U.S.P.Q. 459 (S.D.N.Y. 1970) (DA VINCI found not primarily merely a surname because it primarily connotes Leonardo DaVinci); *In re Pyro-Spectaculars, Inc.*, 63 U.S.P.Q.2d 2022, 2024 (T.T.A.B. 2002) (SOUSA for fireworks and production of events and shows featuring pyrotechnics held not primarily merely a surname, where the evidence showed present day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant's goods and services were of such a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music"); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 U.S.P.Q.2d 1132 (T.T.A.B. 2000) (primary significance of M.C. Escher is that of famous deceased Dutch artist). Thus, Appellant contends that because the term "FRANKE" primarily connotes Mr. Firmant Arthur Franke, a famous piano maker, the term has historical significance and should not be deemed to be primarily merely a surname.

Mark: FRANKE
Serial No.: 76/411,174
Page 5

CONCLUSION

For the reasons set forth above, Appellant respectfully submits that its mark should not be deemed primarily merely a surname. The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's mark.

Respectfully submitted,



Lucian Wayne Beavers, Esq.
Martha B. Allard, Esq.
WADDEY & PATTERSON, PC
414 Union Street, Suite 2020
Bank of America Plaza
Nashville, TN 37219
Telephone: (615) 242-2400

CERTIFICATE OF MAILING

I hereby certify that the foregoing BRIEF OF APPELLANT UNDER SECTION 2.142(b) OF THE U.S. TRADEMARK ACT is being deposited with the United States Postal Service with sufficient postage as First Class mail on 16th day of January 2004 in an envelope addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

