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Mailed: April 7, 2009
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jaguar Cars Limited

Serial No. 77035168

Hope V. Shovein of Brooks Kushman P.C. for Jaguar Cars Limited.

Eli J. Hellman, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Hairston, Walters and Zervas, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Jaguar Cars Limited has filed an application to register the mark DAIMLER (in standard character form) for "land vehicles" in International Class 12.¹ Registration has been finally refused pursuant to Section 2(e)(4) of the

¹ Application Serial No. 77035168, filed on November 2, 2006. The application is based on applicant's claim of ownership of United Kingdom Registration No. 363521, under Trademark Section 44(e).

Trademark Act, 15 U.S.C. 1052(e)(4), on the ground that the mark is primarily merely a surname.²

Applicant has appealed; applicant and the trademark examining attorney have filed briefs.

Before turning to the merits of the surname refusal, we must address an evidentiary issue. The examining attorney submitted with his final office action the results of a search of Daimler in Whitepages.com, and with his denial of applicant's request for reconsideration the results of a second search of Daimler in the same database. Applicant objects to the results of the second Whitepages.com search as untimely because they were submitted after the filing of the Notice of Appeal. Applicant maintains that while TBMP §1207.04 (2d ed. rev. 2004) permits an examining attorney to submit new evidence with a denial of a request for reconsideration, in this case, the results of the second Whitepages.com search are not new evidence, but rather the same evidence, with increased results.

Applicant's argument is unfounded. An examining attorney is permitted, in connection with a denial of a

² The examining attorney also initially refused registration under Section 2(d) of the Trademark Act in view of several prior registrations owned by DaimlerChrysler AG. The refusal was withdrawn after applicant submitted a consent agreement.

request for reconsideration, to submit the same type of evidence that was previously submitted during examination with updated results. Thus, in this case, the results of the second Whitepages.com search are not untimely.

Applicant's objection thereto is accordingly overruled.

We turn then to the merits of the surname refusal. Whether a term is primarily merely a surname depends on the primary significance of the term to the purchasing public. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975); and In re Champion International Corp., 229 USPQ 550 (TTAB 1985). The examining attorney bears the burden of establishing a prima facie case in support of the conclusion that the primary significance of the term to the purchasing public would be that of a surname. In re BDH Two Inc., 26 USPQ2d 1556 (TTAB 1993) and cases cited therein. If a prima facie case is presented, then the burden of rebutting that showing shifts to the applicant. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); and In re Harris-Intertype Corp., supra.

"The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can only be resolved on a case by case basis," taking into account various factual considerations.

Darty, 225 USPQ at 653. There are five accepted factors to be considered in the analysis:

- (1) Is the word a common or rarely used surname?
- (2) Does anyone connected with the applicant have that surname?
- (3) Does the word have meaning other than as a surname?
- (4) Does the word look and sound like a surname?
- (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-surname significance?

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995) [BENTHIN held not primarily merely a surname because it was a rare surname, did not look and sound like a surname, and was set forth in a highly stylized oval design].

Because applicant seeks to register DAIMLER in standard character form, the fifth factor is not a factor in this case and we consider the record in light of the first four factors.³

³ Contrary to the examining attorney's contention, the fact that applicant seeks to register its mark in standard character form does not weigh in favor of finding that DAIMLER is primarily merely a surname.

We consider first the rareness of the surname. With his first office action, the examining attorney submitted the results of a search of what he characterized as a nationwide telephone directory of names from the Lexis/Nexis database. This search returned 77 entries for the surname Daimler.

With his final office action, the examining attorney submitted the results of a search of the Lexis/Nexis EZFIND database which indicated that there were 744 entries for the surname Daimler and 100 were made of record; and the results of a search of WhitePages.com which returned 54 entries for the surname Daimler and ten were made of record.

Finally, in his denial of applicant's request for reconsideration, the examining attorney submitted the results of a second search of WhitePages.com which returned 89 entries for the surname Daimler and ten were made of record.

The examining attorney argues that "[the] record contains competent, admissible, and timely evidence that DAIMLER is a surname. Although DAIMLER appears to be a relatively rare surname, a rare surname may be unregistrable under Section 2(e)(4) if its primary

significance to purchases (sic) is that of a surname."

(Brief, unnumbered p. 6).

Applicant maintains that the search results submitted by the examining attorney vary widely in terms of the number of Daimler listings. Specifically, applicant states that the examining attorney "cannot be permitted to rely on new, conflicting and inaccurate evidence in each communication. In this case, the Examining Attorney's evidence ranges from a possible 54 to 744 individuals having DAMLIER as a surname." (Brief, p. 3).

In response to this criticism, the examining attorney states that "it is inconsequential that the database searches resulted in a wide range of results." (Brief, unnumbered p. 7). We disagree. It appears that many of the 744 Daimler listings retrieved from the Lexis/Nexis EZFIND database are duplicative because this database is a group file containing nine types of person locator files. Thus, we are not convinced that the Daimler listings from this database are representative of anywhere close to 744 different individuals. Under the circumstances, and inasmuch as the results from the first Lexis/Nexis search and the two searches of Whitepages.com are more consistent with one another, i.e., 77, 54 and 89 listings, respectively, we will rely on such listings in determining

the rareness of the Daimler surname. This evidence shows fewer than 100 persons whose surname is Daimler, and the examining attorney submitted no news articles evidencing media attention or publicity given to persons with the Daimler surname. We conclude, therefore, that Daimler is a rare surname.

We note, however, that a mark may be found to be primarily merely a surname even though it is not a common surname. See *In re Giger*, 78 USPQ2d 1405 (TTAB 2006). See also *In re E. Martoni Co.*, 78 USPQ2d 589 (TTAB 1975); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988). Furthermore, there is no minimum number of listings needed to prove that a mark is primarily merely a surname.

We turn to the second factor, i.e., whether any individual connected with applicant has the surname in question. Evidence that an individual associated with applicant has the surname Daimler could well indicate the public recognition of the term as a surname. The examining attorney submitted entries for Daimler from the Dictionary.com website which indicate that Gottlieb Daimler (1834-1900) was a German automotive engineer, inventor and manufacturer who produced the first high-speed internal-combustion engine. In addition, the examining attorney

introduced Wikipedia entries for Daimler Motor Company and Daimler Motoren Gesellschaft. The Wikipedia information indicates that Gottlieb Daimler founded the German company, Daimler Motoren Gesellschaft in 1890; that Gottlieb Daimler licensed the Daimler name in a number of countries, including the United Kingdom, where the British motor vehicle manufacturing company known as Daimler Motor Company was formed in 1896; and that Daimler Motor Company was acquired by applicant in 1960. However, there is no evidence that anyone with the surname Daimler is currently associated with applicant, and we are unable to conclude that this evidence reflects current perception of the term DAIMLER as a surname.

The third factor we consider is whether the term DAIMLER has non-surname significance. The examining attorney relies on the Dictionary.com entries for Daimler which show the only meaning of the term as the surname of Gottlieb Daimler. Applicant, on the other hand, argues that the term DAIMLER has historical significance in that it identifies Gottlieb Daimler. Applicant maintains that Gottlieb Daimler is a historical figure as evidenced by the information in the Dictionary.com entries and Wikipedia excerpt. Applicant also states that Gottlieb Daimler's contributions to the automobile industry have been well

documented in several publications. However, applicant never made copies of this material of record, and therefore, we can give it no consideration.

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 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]; and *In re Champion International Corp.*, supra [MCKINLEY held primarily merely a surname despite being the surname of a deceased president].

In this case, we are not persuaded that Gottlieb Daimler is a historical figure. While we recognize that he is listed in dictionaries and Wikipedia, that is hardly evidence that he is widely-known. Clearly, not everyone listed in a dictionary and/or Wikipedia is widely-known.

We find that Gottlieb Daimler is at best a semi-historical figure and, therefore, the significance of such name is not so great as to eclipse the surname significance of the term.

We turn, then, to the fourth and final factor to be discussed, i.e., whether DAIMLER has the look and feel of a surname. When a term does not have the look and feel of a surname, it clearly favors the applicant. On the other hand, when it does look and feel like a surname, such a finding merely tends to reinforce a conclusion that the term's primary significance is as a surname. DAIMLER does not have the look or sound of an initialism or acronym; nor does it appear to be a coined term. Rather, the term DAIMLER "appears to be a cohesive term with no meaning other than as a surname." In re Gregory, supra at 1796. Further, the existence of individuals with the name Daimler tends to reinforce the conclusion that DAIMLER has the look and feel of a surname. Also, the evidence submitted by the examining attorney concerning Gottlieb Daimler indicates that the surname significance of Daimler will be reinforced because of its association with him. Furthermore, we note that applicant's goods are land vehicles, and surnames (e.g., Ford, Chrysler, and Buick) are frequently used as

marks for such goods. Therefore, we conclude that the term DAIMLER has the look and feel of a surname.

An additional argument made by applicant requires comment. Applicant maintains that it is entitled to registration of the mark DAIMLER because the USPTO previously approved for publication its Application Serial No. 75594759 for the mark DAIMLER for motor vehicles. The USPTO's action in connection with a different application owned by applicant does not entitle it to registration in this case. The Board's task in this appeal is to determine, based on the record before us, whether applicant's mark DAIMLER is primarily merely a surname. Each case must be decided on its own merits and we are not privy to the facts involved with that application. Moreover, the determination of registrability of a particular mark by an examining attorney cannot control our decision in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to (applicant's application), the PTO's allowance of such prior registrations does not bind the Board or this court."]

In sum, when we consider the evidence as a whole, we find that the USPTO has made out a prima facie case that

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DAIMLER is primarily merely a surname and that applicant has not rebutted this prima facie case.

Decision: The refusal to register is affirmed.