

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
June 22, 2010

Mailed:
September 28, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nick Bovis

Serial No. 77502609

Erik M. Pelton of Erik M. Pelton & Associates, PLLC for
Nick Bovis.

Jason F. Turner, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Holtzman and Mermelstein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Nick Bovis, an individual, has appealed from the final
refusal of the Trademark Examining Attorney to register
BOVIS FOODS, in standard character format, with FOODS
disclaimed, as a mark for "wholesale distributorship
services featuring food products."¹ Registration has been
refused pursuant to Section 2(e)(4) of the Trademark Act,

¹ Application Serial No. 77502609, filed June 19, 2008, based on
Section 1(b) of the Trademark Act (intent-to-use).

15 U.S.C. § 1052(e)(4), on the ground that BOVIS is primarily merely a surname.

There are four factors that the Board considers in determining whether a standard character mark is primarily merely a surname. They are: 1) whether the surname is rare; 2) whether anyone connected with the applicant has the surname; 3) whether the term has a recognized meaning other than that of a surname; and 4) whether the term has the look and sound of a surname. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).²

At the outset, we note that applicant and the examining attorney have concentrated their arguments on whether BOVIS is primarily merely a surname. Neither contends that the additional term FOODS in the mark, a descriptive term that has been disclaimed, affects the significance of BOVIS. We agree, and therefore address our comments to whether BOVIS is primarily merely a surname.

With respect to the first factor, the examining attorney submitted an excerpt from WhitePages.com which states that "197 Results matching 'Bovis, United States'" were found." The examining attorney submitted ten of these

² A fifth factor, whether the mark is so stylized that it would not be perceived as a surname, is not applicable because applicant has applied for a mark in standard character format.

listings. One is for a person in Canada, and there are two listings for Ali Bovis in Winter Park, FL; we cannot determine whether these two listings are for the same person. The examining attorney also submitted evidence taken from a Lexis-Nexis search of public records, which the examining attorney characterized as showing "the applied-for mark appearing over seventy times as a surname in a nationwide telephone directory of names." Office action mailed March 4, 2009. The list of 72 names includes what appears to be two businesses, Lend Lease Bovis in Haines City, FL, and Lend Bovis in Charlotte, NC, as well as applicant himself (N. Bovis, San Mateo, CA). The examining attorney also submitted several articles taken from the Nexis database in which the term "Bovis" appears. To the extent that the examining attorney intended, by submitting these articles, to provide further support for his position that additional people have the surname Bovis, that evidence is lacking. Most of the references in the articles appear to be company names, e.g., "Hunt-Bovis," ("The New York Post," Jan. 12, 2009); "Bovis Construction Corp." ("Daily Deal," Jan. 7, 2009 and "The Lexington Herald Leader," Sept. 10, 2008); and "Bovis Lend Lease" ("Daily Record," Jan. 7, 2009, "Modern Healthcare," Sept. 22, 2008 and "The New York Times," Sept. 16, 2008).

There is one hyphenated name that includes "Bovis," i.e., Natalie Bovis-Nelson ("The Houston Chronicle," Jan. 28, 2009), and an article in "Missouri Lawyers Weekly" lists the defendant's attorney, James E. Singer, as being with the law firm of Bovis, Kyle & Burch. The only article that clearly shows Bovis as a surname contains a reference to Tia Bovis, a student of Cheyenne Central High School who, at the high school's FFA youth organization chapter degree ceremony, was among the members who won the Greenhand degree level of membership. "Wyoming Tribune-Eagle," Nov. 23, 2008.

Because of the inclusion of someone from outside the United States, and the possible duplication of names even in the ten excerpted from the WhitePages.com search, we cannot assume that the 197 results reportedly retrieved by that search represent 197 people in the United States with the surname Bovis. Nor can we view the WhitePages.com and the Lexis-Nexis excerpts as being mutually exclusive, such that we should add the 72 listings from the Lexis-Nexis search to the 197 results from the WhitePages.com search. Although we generally encourage examining attorneys and applicants, when there is a large amount of evidence, to provide a representative sample, this does not mean that if an examining attorney searches multiple databases that

essentially contain the same information, we can treat the results of each search to represent different individuals. Even with just the ten listings from the WhitePages.com search that have been made of record, we note that there may be a duplication, in that a Karen Bovis, with an address in Dallas, TX is listed by her job title and company in the WhitePages.com excerpt, while a Karen Bovis is listed in the Lexis-Nexis search with an address on Rainbow Drive in Forney, TX. It appears that some of the listings in the WhitePages.com excerpt may be the same people listed in the Lexis-Nexis search. Thus, we have considered the WhitePages.com search results and the Lexis-Nexis search results to total 82 listings.

We recognize that some of the listings may be for heads of households, and that other people with the same surname may live at the same address. However, even assuming that there may be some additional people with the surname Bovis other than the 72 listings retrieved from the "nationwide telephone directory of names," and the 10 listings from WhitePages.com, and not even taking into consideration the business listing and duplications that we have discussed, it is clear that Bovis is an extremely rare surname. See *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921 (TTAB 2007), in which the surname "Baik" was found to be an

"extremely rare surname" based on a listing of 456 individuals with that surname in the Verizon superpages.com database. We recognize that in the past much smaller numbers of listings from telephone directories were found sufficient to demonstrate that a mark was primarily merely a surname (see, for example, *In re Etablissements Darty et Fils*, 222 USPQ 260 (TTAB 1984), *aff'd* 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985), with a total of 32 listings found in nine telephone directories). However, in those cases the assumption was that the telephone directory evidence was a representative sample, and that there were many other people with that surname listed in other telephone directories. Here, however, it must be remembered that the databases used by the examining attorney contain the listings for what would be the equivalent of every telephone directory in the United States, as well as other public records. Thus, it is reasonable to conclude that the evidence submitted by the examining attorney gives us a fairly accurate picture of the number of telephone listings in the entire United States that include the name Bovis.

The second factor we consider is whether anyone connected with applicant has the surname in question. Here, BOVIS is the surname of the applicant himself, Nick Bovis.

The third factor is whether Bovis has a recognized meaning other than that of a surname. The examining attorney has submitted dictionary evidence showing that "bovis" is not listed as an entry in the Merriam-Webster Online Dictionary.

Applicant, on the other hand, asserts that "bovis" is "the singular genitive form of the Latin root BOV-, which means 'ox, cow,'" and that cows themselves can be referred to as "bos bovis." Response filed Feb. 10, 2009.

Applicant has also submitted evidence that "bovis" is an adjective used in medical language to indicate that something is related to cows or oxen, e.g., the bacterium *Mycobacterium bovis*, and that many words beginning with "bovi" relate to cows, e.g., boviculture (raising cattle), boviform (resembling an ox in form), bovicide (a slayer of oxen or other cattle) and bovine (oxen, cows, buffaloes).

Although some Latin scholars may recognize "bovis" as the singular genitive form of the Latin root "bov," and some medical personnel may be aware, when they see bovis in relation to a particular bacterium, that it causes disease in cows or oxen, the majority of Americans would not be aware of these meanings. This is not to say, however, that the public would be unaware of the word "bovine," or that they might view BOVIS as somehow related to this word,

especially in a mark used in connection with applicant's services featuring food products which could, of course, include dairy products and beef.

In considering whether the public would perceive BOVIS as a surname, we have given no weight to the articles from the Nexis database submitted by the examining attorney. With all due respect to the award given the student at the Cheyenne, WY high school, the articles do not show that any person with the surname Bovis has achieved any significant notoriety. Cf. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) (evidence of public figures with surname Rogan supported conclusion that public would perceive Rogan as a surname).

The final factor relevant to our inquiry is whether BOVIS has the look and feel of a surname. The examining attorney argues that census data furnished by applicant show that BOVIS has the look and feel of a surname because surnames listed in that data end in the same last three letters, e.g., Davis, Jarvis and Travis, or the same last two letters, e.g., Harris and Willis, while others begin with "Bo," e.g., Boyer, Boone and Boyle. We consider the examining attorney's argument to show how nonsensical the interpretation of this factor has become. Using the examining attorney's approach, we could say that BOVIS has

the look and feel of a common noun because "book" and "bone" begin with the letters "Bo," or because "trellis" and "clematis" end in "is." The evidence on which the examining attorney relies does not support his conclusion that BOVIS has the look and feel of a surname.

The four factors we have discussed weigh different concerns. The second through fourth factor deal with whether the mark will be perceived as primarily merely a surname. That is, after the Office has demonstrated that the mark is a surname, the inquiry turns to whether people are likely to view it as one. Both the legislative history and the statutory language make it clear that the fact that a term may be someone's surname, even applicant's own surname, is not sufficient to bar its registration; it must be primarily merely a surname.

In the present case, the third factor, whether Bovis is the surname of anyone connected with the applicant, favors a finding that the mark is primarily merely a surname, since Bovis is, in fact, applicant's surname. Certainly anyone who knows that the mark is used by Nick Bovis would readily understand that BOVIS is a surname. However, because a trademark identifies the source of goods or services, and therefore can substitute for a trademark

owner's providing his actual name as the source,³ we consider the factor of whether the mark is the surname of someone connected with the applicant, in terms of supporting a refusal of registration, to have less weight in the overall analysis.

Thus, because BOVIS does not have the look and feel of a surname, and because the evidence shows that BOVIS has some relationship to and suggests the word "bovine," such that BOVIS could be perceived as a coined word perhaps derived from "bovine," but with no particular meaning in itself, people who are unaware of applicant's personal name are not likely to regard BOVIS in the mark BOVIS FOODS as a surname.

Even if we were to find that, based on the facts that BOVIS is applicant's surname and that it does not have a clearly recognized alternative meaning, the mark would be perceived as primarily merely a surname, the inquiry does not end there. The first factor, the rareness of the surname, is not concerned with whether the term is "primarily merely" a surname or, put another way, whether

³ The statute specifically recognizes that a mark can identify an unknown source of goods or services. See the definition of "trademark" in Section 45 of the Act, 15 U.S.C. § 1127, which states that a mark is used to identify and distinguish a person's goods from those manufactured or sold by others and to indicate the source of the goods, *even if that source is unknown.*

it has significance other than as a surname. Rather, it addresses the basic reason why marks that are primarily merely surnames are prohibited from registration. The statute reflects the common law recognition that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business. In re *Etablissements Darty et Fils*, 225 at 653. See also *Kimberly-Clark Corp. v. Marball*, Comr. Pats., 94 F. Supp 254, 88 USPQ 277, 279 (D.D.C. 1950): "The spirit and the intent of the entire Act indicate that Congress intended to codify the law of unfair competition in regard to the use of personal names as it has been developed by the courts... . At common law it was held that every man had an absolute right to use his own name."

However, during the hearings on the bills that eventually became the Lanham Act, the testimony shows that Congress was not trying to prevent the registration of surnames per se; one witness pointed out that "almost every word you can think of is somebody's surname, somewhere" and to refuse the registration of a term because "it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice." Hearings

on H.R. 4744 Before the Subcomm. Trade-marks of the House Comm. On Patents, 76th Cong., 1st Sess. (1939) at 40.

If a surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname as a mark. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. In determining a refusal based on likelihood of confusion, the law protects against the likelihood of confusion, not the theoretical possibility of it. The same consideration should apply when surnames are at issue. Here, the number of people shown to have the surname BOVIS—fewer than 100—is simply too low for it to be more than a theoretical possibility that one of them would want to use his or her name for goods or services related to wholesale distributorship services featuring food products. Thus, the purpose of the statute prohibiting the registration of marks that are primarily merely surnames would not be served by refusing registration here.

Because, in this case, we give greater weight to the rareness of the surname BOVIS than to the other factors used in determining whether a mark is primarily merely a

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surname, we find that the Office has not met its burden of proving that the mark is primarily merely a surname.

Decision: The refusal of registration is reversed.