

ExHS

BLU220.01569

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

SERIAL NO.: 78/137840
FILED: June 21, 2002
MARK: **CHISHOLM ADMINISTRATIVE SERVICES**
APPLICANT: GROUP HEALTH SERVICE OF OKLAHOMA, INC.
d/b/a BLUE CROSS and BLUE SHIELD OF OKLAHOMA
EXAMINING ATTORNEY: Karla Perkins
LAW OFFICE: 102

Box TTAB NO FEE
The Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

BRIEF FOR APPELLANT

I. INTRODUCTION

Appellant hereby appeals from the Examining Attorney's February 19, 2003 final refusal to register the above-identified mark, and respectfully requests that the Trademark Trial and Appeal Board reverse the Examiner's decision.

II. FACTS

On June 21, 2002 Applicant filed an application to register its mark **CHISHOLM**

ADMINISTRATIVE SERVICES for Insurance Services, Namely, Medicare Program Administration And Benefits Administration. Examining Attorney Karla Perkins mailed a first Office Action on November 8, 2002, in which registration was refused under Section 2(e)(4). In order to support her refusal, the Examiner simply cited to a list of electronic phone book printouts as evidence that, in her mind, the appearance of “Chisholm” in these phone listings “establish[ed] the surname significance of the mark.” *First Office Action*, p.2, 11/8/2002.

The Appellant responded to this objection on December 4, 2002 and offered arguments that urged the Examiner’s reconsideration of her initial refusal. The Appellant’s arguments were as follows:¹

1. Section 1211.01 of the T.M.E.P. provides that it is only appropriate to refuse registration if a mark consists of primarily *merely* a surname; this Section was not intended to exclude the registration of names that have a primary significance other than as a surname.²
2. Section 1211.01(a) delineates some of the considerations in determining whether a mark is merely a surname; in particular, if a term has geographical significance, it should not be held as primarily merely a surname.
3. Section 1211.01(b) provides that if a surname is combined with wording as it is here, the term’s treatment as a surname should depend upon the significance of the non-surname wording.
4. Only if the wording combined with the surname is *incapable* of functioning as a mark should registration be refused on the grounds that the entire mark is primarily a surname within the meaning of Section 2(e)(4). In contrast: if the

¹ See Applicant’s *Response to First Office Action*, filed December 4, 2002.

additional wording is merely descriptive – i.e. “ADMINISTRATIVE SERVICES” - then the Examining Attorney should require a disclaimer of the additional wording and the mark cannot be considered primarily merely a surname.³

In response, the Examining Attorney filed a second *Office Action* on February 19, 2003 which made final her refusal to register the mark under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4). The Examiner remained unpersuaded by Applicant’s assertions that the term “CHISHOLM” has other non-surname meanings. The Examiner diminished the significance of Applicant’s evidence concerning the geographic significance of the term, i.e., the Chisholm Trail and the city of Chisholm, Minnesota (despite the Examiner’s claim that Applicant’s evidence submitted to support the same was “not found with the Applicant’s response”). Additionally, the Examining Attorney disagreed with Applicant’s contention that the addition of “ADMINISTRATIVE SERVICES” rendered the mark as registrable. The Applicant’s inclusion of terms which the Examiner felt to be generic did not, in her opinion, overcome the significance that should be accorded to the [putative] surname.

III. ISSUE

The issue presented in this appeal is whether the Examining Attorney’s refusal to register the Appellant’s mark under Section 2(e)(4) of the Lanham Act was indeed proper.

² See *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. 145; *Sears Roebuck & Co. v. Watson*, 96 U.S.P.Q. 360.
³ See *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 U.S.P.Q.2d 1490 (5th Cir. 1988).

IV. ARGUMENT

A. THE TERM "CHISHOLM" HAS GEOGRAPHIC AND HISTORIC SIGNIFICANCE, AND THEREFORE CANNOT BE MERELY PRIMARILY A SURNAME.

Section 2(e)(4) of the Lanham Act, § 15 U.S.C. 1052(e) states in pertinent part:

"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 –

...(e) Consists of a mark which(4) is primarily merely a surname....

Decisions on whether a mark is "primarily merely a surname" under Section 2(e)(4) are diverse and not easily reconcilable.⁴ However, the question in each case is whether the public would be likely to regard the mark as primarily *merely* a surname. **If the mark has non-surname meaning, and the public would not be likely to regard it as a surname, it is not primarily merely a surname.** For instance, the mark **BIRD and DESIGN** was held not primarily merely a surname for radio apparatus,⁵ even though Bird was the name of the applicant's president. Similarly, **DOUGLAS** for buttermilk and poultry and livestock feeds was held not primarily merely a surname, because it was the name of a Scottish clan, a geographical name, a surname, a species of fir tree, a species of squirrel, and a baptismal name. (In that case, no person named "Douglas" was even connected with applicant.)

Here, no one connected with Applicant is named "Chisholm." Like the "Douglas" case above that hints at Scottish derivations, the Examiner included evidence from

⁴ *Ex parte Gemex Co.*, 111 U.S.P.Q. 443 (Comm'r 1956) ; *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. 145 (Comm'r 1955).

⁵ *Fisher Radio Corp. v. Bird Elec. Corp.*, 162 U.S.P.Q. 265 (T.T.A.B. 1969) . See also *WLWC Centers, Inc. v. Winners Corp.*, 563 F. Supp. 717 (M.D. Tenn. 1983) (MRS. WINNER'S not primarily merely a surname, because of non-surname meaning).

Elsdon Smith's 1969 publication entitled "American Surnames" that postulates that "Chisholm" is derived from the Scottish given name "Cheseholm," meaning "meadow where cheese was made." The Examiner also submitted evidence that suggests that the Chisholm Trail was "probably named for Jesse Chisholm," according to the 15th Edition of The New Encyclopædia Britannica (©1988). However, all of these connections to some remote given names are really incidental, as the term CHISHOLM has more connected to it than just the surname aspect. The Chisholm Trail is a key to understanding the westward expansion of the United States, and the trail is a midwestern landmark. By the end of the Civil War, Union and Confederate forces had consumed most cattle east of the Mississippi. Despite high cattle prices on the East Coast, Texas ranchers remained "cattle poor" for want of an effective distribution system. Promoter. Joseph McCoy, saw promise in a shorter, more direct route through Indian Territory to the new railheads slowly moving west through Kansas Territory. Working a deal with the Railroad, McCoy built cattle pens and a new hotel at the railhead in Abilene, Kansas, then hired surveyors to mark a new route back south to Texas. With a safe, easy route from Texas across Indian Territory to Abilene now marked, McCoy invited cattlemen to bring their herds to Abilene. The Chisholm Trail was the primary commercial roadway of the area for many years, later developed as Highway 81 which even today functions as a main travel artery for the region running north/south from Texas, across the Red River through Oklahoma and north to Kansas.

As the Examiner points out, the trail was in fact named for the part that Jesse Chisholm played in its development. Jesse Chisholm is an historic figure, a legendary scout and diplomat who was involved in negotiating many of the treaties between the U.S. and various Native American tribes, the development of an important trade route and the

settlement of southwest Texas. In her final refusal, Examiner Perkins merely countered that there is little merit in demonstrating the existence of a town in Minnesota and a “defunct cattle trail.” *Second Office Action*, p. 2, February 19, 2003. In fact, the Applicant finds this dismissive attitude more than a little insulting. The Chisholm Trail is as important to the midsection of the country as Civil War battlefields and early settlements are to the East Coast. Jesse Chisholm spoke over a dozen Indian languages, and was famous throughout the west as a scout, guide, interpreter, trader, and mediator between the Whites and Native Americans. He was the guide for the famous 1834 Dodge-Leavenworth expedition into Indian Territory to negotiate a treaty with the Comanche and Kiowa tribes and played the major role in convincing the Plains Indian tribes to negotiate the famous Medicine Lodge Treaty of 1867. It is understandable that the Examiner is not familiar with Old West history, but it is inexcusable to dismiss the significance of CHISHOLM as nothing more than “a defunct cattle trail.”

In short, CHISHOLM is easily recognized for its historic significance by the buying public, viewed merely as an arbitrary use of that historic name as a distinctive trademark. Just as no reasonable person is likely to believe Julius Caesar sells CAESAR cigarettes, it is highly unlikely that anyone will believe that the legendary scout Jesse Chisholm is involved in insurance administration. It is well settled that historical names are protectable if they are recognized as symbols of origin. See *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.* 116 USPQ 122 (D.N.Y. 1958) and *Ex parte Crockett Seafood, Inc.* 114 USPQ 508 (Comm’r Pat. 1957)

A GOOGLE™ search of the term CHISHOLM appearing on the web in connection with cities, schools, villages, counties, lakes and streets yielded in excess of

207,000 results.⁶ (A report of these listings is attached as *Exhibit A.*)

B. EVEN ASSUMING *ARGUENDO* THAT “CHISHOLM” HAS SOME SURNAME SIGNIFICANCE, THE ADDITION OF THE TERMS “ADMINISTRATIVE SERVICES” RENDER THE ENTIRE MARK REGISTRABLE.

The *du Pont* case⁷ makes it quite evident that in comparing two or more marks, they must be viewed in their entirety; their appearance, sound, connotation, and commercial impression all must be taken into account. Marks must be considered in the way they are used and perceived.⁸ Since marks tend to be perceived in their entireties, all components must be given appropriate weight.⁹ Thus, simply discounting the presence of the “ADMINISTRATIVE SERVICES” portions of this mark appears to wholly disregard these long-standing doctrines, to the disservice of this Appellant.

Surname marks may not be dissected for purpose of applying Section 2(e)(4). Thus, the composite mark SCHAUB-LORENZ was held not primarily merely a surname, even though the two components taken singly might have been considered primarily merely surnames.¹⁰ Similarly, ANDRE DALLIOUX was found not to have such surname properties

⁶ See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 U.S.P.Q. 238 (C.C.P.A. 1975).

⁷ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

⁸ *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

⁹ *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

¹⁰ *Application of Standard Elektrik*, 371 F.2d 870, 152 U.S.P.Q. 563 (C.C.P.A. 1967). See *In re Winegard Co.*, 162 U.S.P.Q. 261 (T.T.A.B. 1969). Cf. *Kimberly-Clark Corp. v. Marzall*, 196 F.2d 772, 93 U.S.P.Q. 191 (D.C. Cir. 1952).

because it was the entire name of an individual.¹¹

The Examiner has chosen to rely heavily upon *In re Hamilton Pharmaceuticals Ltd.*¹² claiming that the term ADMINISTRATIVE SERVICES is generic, and thus incapable of registration. However, this position erroneously dissects the composite mark. The issue is what the purchasing public would think when confronted with the mark as a whole. In *In re Hutchinson Technology, Inc.*, 7 USPQ 2d 1490 (Fed. Cir. 1988), “technology” was found not to be descriptive used in connection with electronic components, as the term was too vague to give any concrete idea of the characteristics or qualities of those components. Similarly, “administrative services” is too vague to give any concrete idea of what types of administration the applicant offers. Even if CHISHOLM had no other significance than as a surname, which is not the case, this mark would still be eligible for registration, as ADMINISTRATIVE SERVICES is not incapable of registration on its own. Section 1211.01(b)(6) of the T.M.E.P. clearly states as follows: “*If the wording combined with the surname is capable of functioning as a mark (i.e. matter which is arbitrary, suggestive or merely descriptive of the goods or services), the mark is not considered to be primarily merely a surname under Section 2(e)(3)*”.

The Applicant would argue that term ADMINISTRATIVE SERVICES does not even meet the any of the tests for descriptiveness, since it offers no clear understanding of what those services might be. Administrative tasks encompass a wide variety of activities, from data entry to financial oversight. Moreover, even if the term is descriptive, the mark as a whole is still not to be refused as “primarily merely a surname” under Section 1211 of the TMPEP.

¹¹ *Ex parte Dallioux*, 83 U.S.P.Q. 262 (Comm'r 1949). See *Jack Winter, Inc. v. Lancer of California, Inc.*, 183 U.S.P.Q. 445 (T.T.A.B. 1974) (DAVID WINTER in entirety not primarily merely a surname).

¹² *In re Hamilton Pharmaceuticals Ltd* 27 USPQ2d (BNA) 1939 (TTAB 1993).

C. THE EXAMINER HAS APPLIED THE INCORRECT STANDARD IN THE ANALYSIS OF WHETHER A TERM IS “PRIMARILY MERELY A SURNAME”:

Given the arguments made by the Examiner in her final refusal to register the Appellant’s mark, it would appear that she has erroneously applied the “merely” component of the “primarily a surname” analysis, rather than the appropriate legal standard.

The Examining Attorney failed to fully address the probative value of Applicant’s evidence that the “CHISHOLM” term indeed holds geographic and historic meaning.

The Appellant respectfully contends that the value of Applicant’s evidence was improperly discarded and has not been given the appropriate consideration.

The Examiner indicated that the evidence submitted with the Applicant’s response to the initial office action was “not found”. The applicant’s return postcard, however, indicates that the evidence was included with the submission. The Examiner attempted to recreate the search results by citing to entries in a geographic encyclopedia; however, the Examiner never took Applicant’s web search results into consideration, for the same were never apparently located, nor were they reproduced. The Applicant submits herewith those web search results – which centered on the presence of CHISHOLM in connection with historical and/or geographic contexts. (A report of these listings is attached as *Exhibit B*.)

The applicable standard to be applied to the mark in issue here is not whether the mark has ever been used as a surname but rather whether that is its primary significance. The Appellant has taken great pains to bring this to the Examining Attorney’s attention, but to apparently no avail. In its *Response to First Office Action* (mailed December 4, 2002) ...

TTAB

06-24-2003

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U.S. Trademark Trial and Appeal Board

2900 Crystal Drive

Washington, D.C. 20231

On the 18th day of June 2003.


RHONDA LEEDS