

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85039227
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi 752447639-154436801 . Everard-RequestforReconsideration.pdf</u>
CONVERTED PDF FILE(S) (5 pages)	<u>\\TICRS\EXPORT11\IMAGEOUT11\850\392\85039227\xml6\RFR0002.JPG</u>
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SIGNATURE SECTION	
RESPONSE SIGNATURE	/Dana B. Robinson/
SIGNATORY'S NAME	Dana B. Robinson
SIGNATORY'S POSITION	Attorney of Record, CA Bar Member
DATE SIGNED	08/09/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Aug 09 16:50:01 EDT 2011
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**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85039227** has been amended as follows:

EVIDENCE

Original PDF file:

[evi_752447639-154436801_Everard-RequestforReconsideration.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Dana B. Robinson/ Date: 08/09/2011

Signatory's Name: Dana B. Robinson

Signatory's Position: Attorney of Record, CA Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85039227

Internet Transmission Date: Tue Aug 09 16:50:01 EDT 2011

TEAS Stamp: USPTO/RFR-75.244.76.39-20110809165001773
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This communication is in response to the Office Action dated February 9, 2011. In the Office Action, the Examining Attorney refused registration of Applicant's mark based on the belief that Applicant's mark is merely a surname. Applicant respectfully request reconsideration and responds to the Examining Attorney's arguments herein.

Examining Attorney has not established his prima facie.

The Examining Attorney has the initial burden of establishing the prima facie case that Everard is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F. 2d 15, 16 (Fed. Cir. 1985). Here, the Examining Attorney has not met that burden. In *Darty*, the Examining Attorney met this was burden by showing that Darty was the name of the company's president, the name appeared in a number of phone books and the word was not in any French or English dictionaries. *Id.* Here, the Examining Attorney has not provided a sufficient amount of evidence to establish a prima facie case that Everard is primarily merely a surname.

Even if Examining Attorney has met his burden, Everard is a not primarily merely a surname.

Applicant maintains that the proposed mark "EVERARD" is not merely a surname as it pertains to Applicant's services, because all of the *Benthin* factors are either in favor of registration or neutral and when there is doubt it should be resolved in favor of the Applicant. See *In re Benthin Mgmt. GmbH*, 37 U.S.P.Q. 2d 1332, 1334 (1995). The five factors used to determine whether a mark is primarily merely a surname include: 1) whether the surname is rare; 2) whether anyone connected with applicant uses the term as a surname; 3) whether the term has any recognized meaning other than as a surname; 4) whether the term has the structure and pronunciation of a surname; and 5) whether the term is sufficiently stylized to remove its primary significance from that of a surname. *In re Benthin*, 37 U.S.P.Q. 2d at 1333-32. Because three factors favor Applicant, and the other two are neutral or do not apply, registration of the proposed mark should be approved.

1) Whether the surname is rare.

Everard should be considered a rare surname because more common last names have been found rare, the mere 231 listings that the Examining Attorney points to does not adequately take into account the massive scope of the database used, there is not enough evidence of media attention to hurt surname's rarity and public policy demands the consistent treatment of trademarks. Though the Examining Attorney points to 231 listings in the LexisNexis nationwide telephone directory of names, even more common surnames have been found to be rare. The last name Hackler was considered to be rare when almost 1,300 entries were listed in the phone directory. *United Distillers*, 56 U.S.P.Q. 2d 1221 (TTAB 2000). Further, in *In re Giger*,

evidence of 545 entries was not substantial evidence that the surname was common, and it was determined that the surname was somewhat rare. *In re Giger*, 78 U.S.P.Q. 2d 1405, 1412-13 (2006). At only 231 listings, compared to almost 1,300 and 545, it is apparent that the surname Everard is a rare surname.

The Examining Attorney cites *In re Giger* in his final rejection as support for the proposition that there is no minimum number of listings required to show that a mark is primarily merely a surname. The Examining Attorney states that "GIGER refusal upheld with "a list of more than fifty phone listings." The opinion actually states: "The evidence of 545 entries is not substantial evidence that the term "Giger" is a common surname." *In re Giger*, 78 U.S.P.Q. 2d at 1407. The opinion actually found the first factor of the surname's rareness to be in favor of the Applicant but went on to find that other factors weighed against registration (for example Giger was the surname of both of the Applicants and that it had the "look and feel" of a surname). *Id.* at 1408-1410. While Applicant agrees that there is no "magic number" to ensure registration, the Examining Attorney's statement misrepresents the case and the board's analysis. *Giger* actually supports a finding that the first factor weighs in Applicants favor because in that case there was more listings and the name was not common.

The second consideration for finding that Everard is a rare surname is that the Lexis Nexis database from which the 231 listings were pulled is massive. *In re Benthin* discusses a similar situation, there the Examining Attorney had found 100 listings in PHONEDISC U.S.A., and the board found that the massive scope of the database actually weighed in favor of finding the surname to be rare. 37 U.S.P.Q. 2d at 1333. The board did the calculations and it turned out that there was one Benthin listing for every 750,000 names. *Id.* This is further evidence that supports finding the Everard because we have the same situation here. Lexis Nexis is a massive database. Unlike a phonebook with limited listings, Lexis Nexis is so large the mere 231 listings of Everard shows how rare the surname actually is. The Examining Attorney tries to down play this important fact but the size of the database also weighs in favor of finding Everard to be a rare surname.

Another consideration in assessing the rarity of a surname is the media attention or publicity accorded public personalities with the name. *In re Gregory*, 70 U.S.P.Q. 2d 1792, 1798 (2004). The Examining Attorney seems to be directly quoting *In re Gregory* in discussion of this factor but fails to miss how significant the media attention was in that case. In that case, Rogan was the last name of the Director of the USPTO, who had also served in the California Assembly and the U.S. House of Representatives. *Id.* This evidence was provided in addition to also cited a Baseball Hall of Famer, a popular author and two popular actors bearing the same last name. *Id.* In that case, the media coverage of all of those famous Rogans made the surname less rare in the mind of the public. Now compare that with *In re Giger*, where that board also examined the issue of media coverage. There the board determined that since there was no evidence that Giger

had reached even modest fame and then concluded that Giger was a rare surname. *In re Giger*, 78 U.S.P.Q. 2d at 1408.

The case at present is far more similar to *Giger* than it is to *Gregory*. The very few examples of "famous" people with the last name of Everard do not overcome, or even weigh against finding the surname to be rare. First "Everard Clothing," seems to be a small boutique store in the DC area with only two locations. The second, is an example of an attorney that is practicing in Washington State, who seems to have received no acclaim during his 20 year career. The third, is an obscure film maker. The fourth is a Link-in profile page of a self-employed "artist." The final one is the only one that seems to show any sort of media coverage of an Everard and it is a small article about an Everard becoming president of a company. None of this evidence provided near the level of media coverage reached in *Gregory*, none of these people are elected officials, famous athletes, prodigious authors, nor popular actors. This is clearly a case where the extremely limited media shows the rarity of the surname.

Finally, it is important to treat trademarks consistently, and because marks in the past have been allowed with many more directory listings than have been shown for the name Everard, the Examiner should be assured that Everard is a very rare surname which should be approved for registration. *See In re Waverly Inc.*, 27 U.S.P.Q. 2d 1620, 1623 (1993). This policy with the additional considerations of the small number of listings in a massive database and the virtually nonexistent media coverage of the surname means that the first factor should be found in favor of the Applicant.

2) Whether anyone connected with applicant uses the term as a surname.

This factor clearly weighs in favor of Applicant registration. Applicant is a large telecommunications service, and has no connection to anyone named Everard. Although the Examining Attorney seems to have reservations about the proper test for this factor, we are in accord that this factor is clearly in favor of the Applicant's registration because it tends to show that Everard is not merely primarily a surname.

3) Whether the term has any recognized meaning other than as a surname.

Under this factor, not only must there be another meaning for the surname but it also must be commonly known among the consuming public to supplant the surname meaning. *See Benthin*, 37 U.S.P.Q. 2d at 1333; *Harris-Intertype*, 518 F. 2d 629, 630 (CCPA 1975). There is a disagreement between Applicant and Examining Attorney whether the other meaning would be recognized by the consuming public. While this evidence may not rebut the Examining

Attorney's prima facie case but it does not defeat Applicant's case for registration of the mark. If anything this factor is neutral.

4) Whether the term has the structure and pronunciation of a surname.

The proposed mark "EVERARD" does not have the structure and pronunciation of a surname. "When a term does not have the look and sound of a surname, it clearly aids the applicant." *In re Gregory*, 70 U.S.P.Q. 2d 1792, 1806. Everard is admittedly a surname that is rarely found in the United States. At first glance, one might even see the word and think "Ever Hard," rather than "Everard." *In re Gregory*, the board discusses that a mark does not have the look and feel of a surname if it has "the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix." *Id.*

The Examining Attorney rejects Applicant's argument as unpersuasive but fails to consider that Everard could easily be an example of the type of mark discussed in *Gregory*. The root element that is readily understood is "Ever" with a suffix of "-ard." It is not enough for the Examining Attorney to merely list other surnames with similar elements and reject the idea that the consuming public would perceive the mark "Ever Hard." Thus, the mark does not have the structure and pronunciation of a surname, especially when marketed towards a risqué telephone chat service. *In re Giger*, 78 U.S.P.Q. 2d 1405, 1417 (2006). This factor also favors Applicant.

5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

In this case, the fifth factor, whether the term is sufficiently stylized to remove its primary significance from that of a surname, is not applicable, because Applicant is merely registering "EVERARD" in simple, typed form. *In re Gregory*, 70 U.S.P.Q. 2d 1792, 1797-98 (2004). Since there is no stylization or design involved, the fifth factor is not considered and the Examiner should only evaluate the first four factors. *Id.* See also *United Distillers*, 56 U.S.P.Q. 2d at 1221 (considering only the first four *Benthin* factors). Or at the very least should be considered neutral. *In re Masco Builder Cabinet Group*, 2009 WL 1896053 (T.T.A.B 2009).

Resolve doubts in favor of Applicant.

The Examining Attorney cites *In re Benthin* but fails to consider the boards concluding language. After finding that only two of the five factors weighed in favor of the Applicant and one was "neutral" the board states:

Moreover, on the question of whether a mark would be perceived as primarily merely a surname, we are inclined to resolve doubts in favor of the applicant and pass the mark to

publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods or services can file a notice of opposition. 37 USPQ 2d at 1334.

Applicant encourages the Examining Attorney to follow this precedent because Applicant has a stronger case than *Benthin* because four factors weigh in favor of registration and the fifth one is inapplicable or at least neutral.

Conclusion

As the test to be applied in determining whether a mark is primary merely a surname is its primary significance to the purchasing public, it is apparent that the mark "EVERARD" should be approved for registration. *In re Petrin Corp.*, 231 U.S.P.Q. 902, 903 (1986). The primary market for the mark "EVERARD" is gay men. These men will be unlikely to make any connection of the word "Everard" as a surname, and those who get its historical inference will be reminded of the Everard Baths as an "insider's reference." Each of the first four factors favor Applicant, because the surname is rare, nobody connected with Applicant has the surname Everard, the term has other recognized meanings, and the term does not have the structure and pronunciation of a surname. The last factor should not be considered, and the mark should be approved.