

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87048342
LAW OFFICE ASSIGNED	LAW OFFICE 120
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87048342/large
LITERAL ELEMENT	SOMERTONS
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<u>ARGUMENT</u>	
<p>Applicant has amended the application to the Supplemental Register. The undersigned also notes in the <u>Advisory</u> section of the Office Action (page 5), that the application is erroneously referred as an intent-to-use application under Section 1(b). The application was filed under Section 1(a), a Use in Commerce Application. In the official Response filed on March 8, 2017, Applicant submitted a substitute specimen as well as a Declaration Under Section 2.20 showing direct association between the mark and the services. Therefore, the Application is eligible for registration under the Supplemental Register and amendment to the same is part of this official response.</p> <p>The Trademark Examining Attorney has refused registration of the mark under Section 2(e)(4) arguing that the mark is primarily merely a surname as the purchasing public would view the mark as a surname. The Trademark Examining Attorney has cited Lexis Nexis and pages from <i>Whitepages.com</i> arguing that this establishes the surname significance of SOMERTONS. The Trademark Examining Attorney argues that the evidence from the <i>Whitepages.com</i> shows the applied-for mark has appeared 237 times as a surname in a nationwide phone directory of names and "comprises the first 60 matches of the surname 'SOMETON' in the nation wide phone directory". Thus there are in actuality 177 alleges uses of "SOMERTONS". There are three hundred million people in the United States and the phone directory should represent at least one quarter of the population. This evidence as cited by the Trademark Examining Attorney shows that the use of the mark SOMERTONS as a surname is rare (00000024% of the names) and the mark would not be viewed as a surname.</p> <p>While the citations of <i>In re Eximius Coffee, LLC</i>, 120 USPQ2d 1276 (TTAB 2016) and <i>In re Petrin Corp.</i>, 231 USPQ 902, 903 (TTAB 1986) state that there is no minimum amount of evidence needed to establish that a mark is primarily a surname it stretches the imagination that rare usage would be sufficient usage. The references to SOMETON are not relevant to the surname argument. However, the number 237, even if representing surnames of different individuals in itself shows that the use of the mark as a surname is rare. The Trademark Examining Attorney has referenced the citation from <i>Collins English</i> dictionary showing that there is no listing for SOMERTONS and has come to the conclusion that "Somertons" must be a surname and has cited evidence showing use of the names Summarton, Sommerton, Summertin and Simerton appearing 413 times and has concluded that this shows that the applied for term has the structure and pronunciation of a surname. This argument has limited to no evidentiary value,</p> <p>Applicant would again note that a Section 2(e)(4) ground of rejection requires that a mark must be primarily merely a surname. <u>That the degree of rareness of the surname is material to the Examining Attorney's determination of registration is corroborated by the legislative history of this Section.</u> During the hearings on H.R. 4744, Representative Rogers made the following statement in support of retaining the word "primarily" in the language of what is now 15 USC §1052 Section 2(e)(4):</p>	

"Mr. Rogers. No; I do not think so at all. The difficulty about [Fenning's proposal which would have deleted 'primarily' from the draft] is that almost every word you can think of is somebody's surname, somewhere, and there has been a practice in the office of the Commissioner of Patents, which was born a number of years ago that any mark for which registration was applied, which was borne by some person, somewhere as a name such as Cotton, King, or whatnot, they would refuse registration on the ground that they were merely the names of individuals." (emphasis added).

A search of the top 2000 surnames most occurring surnames in the United States does not include SOMERTONS. A copy of the listing surnames where Somertons would appear if it was a common surname is taken from the *American Surnames* by Elsdon C. Smith, Genealogical Publishing Co., Inc. (2003) which was submitted in the previous response as Exhibit A.

The fact that a mark may be found a surname does not by itself mean that the mark is primarily merely a surname. The evidence submitted by the Trademark Examining Attorney (69 attachments) is mostly illegible and contains many pages from foreign sources and copious material which is not relevant to anything.

See also, *In re Benthin Management GmbH*, 37 USPQ 1332 (TTAB 1995) where BENTHIN was found to be a rare surname (100+ persons out of a PHONEDISC U.S.A. data base of 76 million listings) and thus would not be perceived as primarily merely a surname and *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994), one ten-thousandth of one percent of surnames in data base showed SAVA to be a rare surname. Such holdings have been followed in numerous other decisions.

Applicant had previously submitted a copy of the pertinent pages from the website <http://www.americansurnames.us/surname/Somertons>, showing that Somertons is not a listed surname. Not only does Somertons not appear in the list of the most common surnames, it does not even appear in this website, with website stating "If this really is your surname, then congratulations - you are a genuine rarity, at least in the USA." Clearly the subject mark is not primarily merely a surname.

Thus, the mark SOMERTONS is not primarily merely as surname which is required by Section 2(e)(4). The mark is a rare usage and would not be perceived as primarily merely a surname.

The following five inquiries are often used to determine that public's perception of a terms primary significance:

1. Whether a surname is rare?

Answer: Yes

2. Whether anyone connected with Applicant uses the term as a surname?

Answer: No

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

Answer: The French word SOMMER means "to summon; to call upon". Furthermore, under this criteria, any coined word with no meaning indicating source of origin with the goods/services would have to be considered a surname.

4. Whether the term has the structure of a surname?

Answer: No

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

Answer: Not Applicable

The Trademark Examining Attorney has searched the Office database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d).

Filed concurrently with this Amendment is a Notice of Appeal with official fee. If any additional fee or credit is required, please charge or credit our Deposit Account No. 07-1340. If any additional information or documentation is required, please so instruct the undersigned.

In view of the above arguments, it is requested that the refusal to register be withdrawn and passage to publication is respectfully requested.

ADDITIONAL STATEMENTS SECTION

SUPPLEMENTAL REGISTER	The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').
------------------------------	--

SIGNATURE SECTION

RESPONSE SIGNATURE	/John S. Hale/
SIGNATORY'S NAME	John S. Hale
SIGNATORY'S POSITION	Attorney of Record, Virginia Bar Member
SIGNATORY'S PHONE NUMBER	7034481770 ext 301
DATE SIGNED	09/25/2017
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Sep 25 13:34:39 EDT 2017
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XXX-2 0170925133439192341-87048 342-5106740d55ac4d06948ea ae4dce9f3aa4b8f95e1f904b5 979f6d35f4b66fe78e-N/A-N/ A-20170925131715479336

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **87048342** SOMERTONS(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87048342/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

ARGUMENT

Applicant has amended the application to the Supplemental Register. The undersigned also notes in the Advisory section of the Office Action (page 5), that the application is erroneously referred as an intent-to-use application under Section 1(b). The application was filed under Section 1(a), a Use in Commerce Application. In the official Response filed on March 8, 2017, Applicant submitted a substitute specimen as well as a

Declaration Under Section 2.20 showing direct association between the mark and the services. Therefore, the Application is eligible for registration under the Supplemental Register and amendment to the same is part of this official response.

The Trademark Examining Attorney has refused registration of the mark under Section 2(e)(4) arguing that the mark is primarily merely a surname as the purchasing public would view the mark as a surname. The Trademark Examining Attorney has cited Lexis Nexis and pages from *Whitepages.com* arguing that this establishes the surname significance of SOMERTONS. The Trademark Examining Attorney argues that the evidence from the *Whitepages.com* shows the applied-for mark has appeared 237 times as a surname in a nationwide phone directory of names and "comprises the first 60 matches of the surname 'SOMETON' in the nationwide phone directory". Thus there are in actuality 177 alleged uses of "SOMERTONS". There are three hundred million people in the United States and the phone directory should represent at least one quarter of the population. This evidence as cited by the Trademark Examining Attorney shows that the use of the mark SOMERTONS as a surname is rare (00000024% of the names) and the mark would not be viewed as a surname.

While the citations of *In re Eximius Coffee, LLC*, 120 USPQ2d 1276 (TTAB 2016) and *In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986) state that there is no minimum amount of evidence needed to establish that a mark is primarily a surname it stretches the imagination that rare usage would be sufficient usage. The references to SOMETON are not relevant to the surname argument. However, the number 237, even if representing surnames of different individuals in itself shows that the use of the mark as a surname is rare. The Trademark Examining Attorney has referenced the citation from *Collins English* dictionary showing that there is no listing for SOMERTONS and has come to the conclusion that "Somertons" must be a surname and has cited evidence showing use of the names Summarton, Sommerton, Summertin and Simerton appearing 413 times and has concluded that this shows that the applied for term has the structure and pronunciation of a surname. This argument has limited to no evidentiary value,

Applicant would again note that a Section 2(e)(4) ground of rejection requires that a mark must be **primarily** merely a surname. That the degree of rareness of the surname is material to the Examining Attorney's determination of registration is corroborated by the legislative history of this Section. During the hearings on H.R. 4744, Representative Rogers made the following statement in support of retaining the word "primarily" in the language of what is now 15 USC §1052 Section 2(e)(4):

"Mr. Rogers. No; I do not think so at all. The difficulty about [Fenning's proposal which would have deleted 'primarily' from the draft] is that almost every word you can think of is somebody's surname, somewhere, and there has been a practice in the office of the Commissioner of Patents, which was born a number of years ago that any mark for which registration was applied, which was borne by some person, somewhere as a name such as Cotton, King, or whatnot, they would refuse registration on the ground that they were merely the names of individuals." (emphasis added).

A search of the top 2000 surnames most occurring surnames in the United States does not include SOMERTONS. A copy of the listing surnames where Somertons would appear if it was a common surname is taken from the *American Surnames* by Elsdon C. Smith, Genealogical Publishing Co., Inc. (2003) which was submitted in the previous response as Exhibit A.

The fact that a mark may be found a surname does not by itself mean that the mark is primarily merely a surname. The evidence submitted by the Trademark Examining Attorney (69 attachments) is mostly illegible and contains many pages from foreign sources and copious material which is not relevant to anything.

See also, *In re Benthin Management GmbH*, 37 USPQ 1332 (TTAB 1995) where BENTHIN was found to be a rare surname (100+ persons out of a PHONEDISC U.S.A. data base of 76 million listings) and thus would not be perceived as primarily merely a surname and *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994), one ten-thousandth of one percent of surnames in data base showed SAVA to be a rare surname. Such holdings have been followed in numerous other decisions.

Applicant had previously submitted a copy of the pertinent pages from the website <http://www.americansurnames.us/surname/Somertons>, showing that Somertons is not a listed surname. Not only does Somertons not appear in the list of the most common surnames, it does not even appear in this website, with website stating "If this really is your surname, then congratulations - you are a genuine rarity, at least in the USA." Clearly the subject mark is not primarily merely a surname.

Thus, the mark SOMERTONS is not primarily merely as surname which is required by Section 2(e)(4). The mark is a rare usage and would not be perceived as primarily merely a surname.

The following five inquiries are often used to determine that public's perception of a terms primary significance:

1. Whether a surname is rare?

Answer: Yes

2. Whether anyone connected with Applicant uses the term as a surname?

Answer: No

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

Answer: The French word SOMMER means "to summon; to call upon". Furthermore, under this criteria, any coined word with no meaning indicating source of origin with the goods/services would have to be considered a surname.

4. Whether the term has the structure of a surname?

Answer: No

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

Answer: Not Applicable

The Trademark Examining Attorney has searched the Office database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d).

Filed concurrently with this Amendment is a Notice of Appeal with official fee. If any additional fee or credit is required, please charge or credit our Deposit Account No. 07-1340. If any additional information or documentation is required, please so instruct the undersigned.

In view of the above arguments, it is requested that the refusal to register be withdrawn and passage to publication is respectfully requested.

ADDITIONAL STATEMENTS

Supplemental Register

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /John S. Hale/ Date: 09/25/2017

Signatory's Name: John S. Hale

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

Signatory's Phone Number: 7034481770 ext 301

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 87048342

Internet Transmission Date: Mon Sep 25 13:34:39 EDT 2017

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XXX-2017092513343919

2341-87048342-5106740d55ac4d06948eaae4dc

e9f3aa4b8f95e1f904b5979f6d35f4b66fe78e-N

/A-N/A-20170925131715479336