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Paper No. 11
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mars, Incorporated

Serial No. 75/665,489
Serial No. 75/665,491

Leslie K. Mitchell of Fitzpatrick, Cella, Harper & Scinto for Mars, Incorporated.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Seeherman, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Two applications have been filed by Mars, Incorporated to register two different marks on the Principal Register, consisting of or including the word KENMAN. Both applications are for goods identified as "confectionery, namely, candy"; and both were filed on March 22, 1999, based on applicant's assertion of a bona fide intention to use the mark in commerce.

In application Serial No. 75/665,489 applicant seeks to register the mark KENMAN (typed drawing); and in

application Serial No. 75/665,491 applicant seeks to register the mark shown below.

The Examining Attorney has refused registration in each application under Section 2(e)(4) of the Trademark Act on the basis that the mark (KENMAN or KENMAN and design) is primarily merely a surname.

When the refusals were made final, applicant appealed in each application. Both applicant and the Examining Attorney have filed briefs. No oral hearing was requested by applicant.

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

The Examining Attorney contends that although the mark KENMAN is a rare surname, the primary significance of the mark to the purchasing public remains that of a surname; that KENMAN has no other meaning; that KENMAN is similar in structure and pronunciation to other surnames with a suffix

ending of "—MAN" (that is, it "looks and sounds" like a surname); and that there is no fixed formula for the amount of evidence necessary for the Examining Attorney to establish a prima facie case that a term is primarily merely a surname. With regard to the mark which includes a design feature, the Examining Attorney contends that the oval and black border design is merely a background of basic geometric shapes; that it is not inherently distinctive and does not form a separate commercial impression from the word KENMAN; that it is not so uncommon or unusual that the purchasing public would rely on the design to differentiate applicant's goods from those of others; and that the purchasing public would still perceive the mark as primarily merely a surname.

In support of his position, the Examining Attorney submitted the following evidence: (1) a printout from the Phonedisc Powerfinder USA One 1998 (4th edition) database showing "5 hits for the name 'KENMAN'" (First Office action, p. 2) of the 115 million surnames in the Phonedisc; (2) ten excerpted stories retrieved from the Nexis database (from a total of 40 stories), all indicating "surname use of Kenman" (Final Office action, p. 2); and (3) photocopies of pages from Merriam-Webster's Collegiate Dictionary (Tenth Edition 1998) and Merriam-Webster's Geographical

Dictionary (Third Edition 1998) which lack any entry for the word KENMAN.

Applicant contends, on the other hand, that "KENMAN is an extremely rare surname" (brief, p. 3) as shown by the few instances of surname use submitted by the Examining Attorney; that the legislative history of the Trademark Act indicates that the degree of rarity of the surname is material to the determination of whether a term is primarily merely a surname; that many English words and geographical terms end in "—MAN" but are not regarded as surnames, such as fireman, Doberman, woman, German, snowman, chairman, human, Pitman in New Jersey, Quitman in Georgia, Boardman in Ohio, and Naaman in Delaware; that the Examining Attorney has not submitted any evidence which demonstrates how the public would perceive the mark; that the Examining Attorney has not met his burden of proof to establish that the term KENMAN is primarily merely a surname; that the records in the cases cited by the Examining Attorney generally contained a more substantial evidentiary record; and that doubt should be resolved in favor of applicant.

Applicant further contends, with specific regard to the mark which includes a design, that the Examining Attorney has improperly dissected that mark in considering

the question of registrability; that the design feature is distinctive; that there is not only a design but also stylized lettering; and that the entire mark, when considered as a whole, is not primarily merely a surname.

Applicant submitted photocopies of several third-party registrations, all of which are on the Principal Register, are not listed as registering under Section 2(f), and all of which are for marks ending in the suffix "—MAN," e. g., JOROMAN, BOTMAN, BARSAMAN, and ORTMAN FLUID POWER ("fluid power" disclaimed).

It is well established that the USPTO has the burden of establishing a prima facie case that a mark is primarily merely a surname, and that the test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public. See In re BDH Two Inc., 26 USPQ2d 1556 (TTAB 1993), and cases cited therein. We are of the opinion that the Examining Attorney has not met that burden here, and further, that applicant has rebutted the Office's evidence.

The five Phonedisc listings submitted by the Examining Attorney actually consist of the following: three residential listings for the surname KENMAN (Dennis in Tucson, AZ, and L.S. and Leon F., both at the same address in Glendale, AZ); one listing for a business, "Kenman

Management Svc" (in FL); and one listing for "Kenmanivong, Bounthazy" (in FL). Thus, there are only three surname listings for KENMAN out of a database of 115 million listings.

One of the ten excerpted stories retrieved from the Nexis database refers to Leon F. Kenman in Glendale, AZ. Thus, that is a repeat of one of the listings from Phonedisc. The remaining nine entries from Nexis refer to individuals with the surname KENMAN in the context of lists of names from obituaries, bankruptcies, players of sports contests, winners of ribbons at fairs, election ballots, and the like.

In the past, and specifically prior to the availability of Phonedisc, when an Examining Attorney refused registration based on a finding that the term was primarily merely a surname, the Examining Attorney generally had to utilize telephone books, and extrapolate that if there were a certain number of residential listings for a particular surname in one book then there would be more in the other telephone books which were not checked. However, since the advent of Phonedisc, it is presumed that checking that database is the equivalent of checking virtually all phone books.

Likewise, the Nexis database is a massive electronic library, and in this case, the Examining Attorney's search of the term "KENMAN" retrieved a total of 40 stories, ten of which the Examining Attorney submitted into the record, and one of which was a repeat of an individual listed in the Phonedisc report. Thus, there are nine stories from Nexis, showing additional individuals named KENMAN, again a minimal number considering the size of the electronic database being searched. Of course, we can only speculate as to why individuals whose names were shown in the nine stories retrieved from Nexis were not listed in the Phonedisc report (for example, perhaps the individuals did not have telephones, or the individuals died prior to the date of the Phonedisc compilation, or perhaps, as in one story, the Nexis story was published subsequent to the date of the Phonedisc search report).

In any event, with a combined total of twelve KENMAN listings from these two massive electronic databases, it is very clear that KENMAN is an extremely rare surname. The rarity of the surname is material to our decision because the more rare the surname, the less likely the purchasing public will be aware that the term is a surname, and thus, the less likely the term is "primarily merely" a surname and prohibited from registration by the Trademark Act. See

Ex parte Rivera Watch Corporation, 106 USPQ 145 (Comm. 1955); and In re Garan, 3 USPQ2d 1537 (TTAB 1987). See also, In re The Monotype Corp. PLC, 14 USPQ2d 1070 (TTAB 1989); and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§13:27-13:30 (4th ed. 2001).

Next, we consider whether KENMAN has the "structure and pronunciation" of a surname, a decidedly subjective matter. See In re Industrie Pirelli, 9 USPQ2d 1564 (TTAB 1988). Although it is obvious that surnames can end in "—MAN,"[1] applicant has provided evidence that numerous English words and geographic words which end in "—MAN" are not surnames. Moreover, there is no evidence showing that surnames are typically constructed by combining a first name with the suffix "—MAN." As a result, we cannot conclude that the word KENMAN has the "look and sound" of a surname.

The Examining Attorney did not inquire and applicant offers no information as to whether KENMAN is the surname of anyone connected with applicant. The individual who executed the applications is not named KENMAN. Therefore, there is no information of record on this point.

[1] Indeed, this panel of judges could scarcely contend otherwise.

We have considered the Examining Attorney's evidence to show that the word KENMAN does not appear in a dictionary or a geographical dictionary, but in the overall circumstances and record of these applications, especially relating to the extreme rarity of uses of the word KENMAN as a surname, the evidence offered to prove a negative is simply not persuasive of a different result.

Inasmuch as we find that the evidence does not support a prima facie case the word KENMAN is primarily merely a surname, certainly the word presented in stylized lettering and with a design feature would likewise not be primarily merely a surname.

Decision: The refusal to register under Section 2(e)(4) is reversed in each application.