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THIS DISPOSITION IS NOT  
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Paper No. 12  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peter L. Reynolds

Serial No. 75/540,216

Andrew R. Basile and Denise M. Glassmeyer of Young & Basile,  
P.C. for Peter L. Reynolds.

Elizabeth A. Hughitt, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney).

Before Hairston, Bucher and Holtzman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

An intent-to-use application has been filed by Peter L. Reynolds to register the mark OAKLEY for "beverages, namely, caffeinated and non-caffeinated tea" in International Class 30, and "beverages, namely, flavored and non-flavored sparkling water, spring water, caffeinated and non-caffeinated fruit flavored drinks and smoothies," in International Class 32.<sup>1</sup>

<sup>1</sup> Application Serial No. 75/540,216, filed August 21, 1998, based upon a *bona fide* intention to use the mark in commerce under Section 1(b), 15 U.S.C. §1051(b).

The Trademark Examining Attorney has refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C.

§1052(e)(4), on the ground that applicant's mark is primarily merely a surname.

When the refusal to register was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We affirm the refusal to register.

In support of her surname refusal, the Trademark Examining Attorney has made of record the results of her search of a database containing more than one-hundred million names, finding 7,402 OAKLEY surname listings from PHONEDISC POWERFINDER USA ONE 1998 (4<sup>th</sup> ed.).

Applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname case. Applicant challenges the Trademark Examining Attorney's conclusions on the ground that no one associated with applicant possesses the surname OAKLEY, and that because the term "is the name of several cities in the United States" (brief, p. 1), it has other non-surname significance, and has been publicized in recent years as a trademark for trendy sunglasses, for instance.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to

the purchasing public. See In re Hutchinson Technology Inc., 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), citing In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Trademark Examining Attorney to establish a *prima facie* case that a mark is primarily merely a surname. See In re Etablissements Darty et Fils, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the Trademark Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut this finding.

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and sound" of the surname. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

There is no doubt that the Trademark Examining Attorney has met her initial burden of establishing that OAKLEY would be perceived by consumers as primarily merely a surname. In particular, the Trademark Examining Attorney has referenced over seven thousand OAKLEY surname entries from the PHONEDISC

database. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a *prima facie* surname case. See Hutchinson Technology, 852 F.2d at 554, 7 USPQ2d at 1492; Darty, 759 F.2d at 16, 225 USPQ at 653; see also 2 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, §13.30, p. 13-50 (4<sup>th</sup> ed. 1999).

The Trademark Examining Attorney's PHONEDISC evidence is collected from telephone directories and address books across the country. There is no magic number of directory listings required to establish a *prima facie* surname case. In re Cazes, 21 USPQ2d 1796, 1797 (TTAB 1991); In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd unpublished decision*, No. 89-1231 (Fed. Cir. 1989). It is reasonable to conclude from these submissions that OAKLEY has had measurable public exposure.<sup>2</sup> Even applicant concedes from the PHONEDISC evidence that "Oakley appears to be a surname in telephone directories." Furthermore, from this demonstrated level of surname frequency, OAKLEY is by no means a decidedly rare surname.<sup>3</sup> From more than seven thousand

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<sup>2</sup> To the extent applicant contends that OAKLEY is an uncommon surname, we would point out that even uncommon surnames may not be registrable on the Principal Register. See Industrie Pirelli, 9 USPQ2d at 1566.

<sup>3</sup> This evidence is far more significant than the number of listings presented in other cases where the surname has been categorized as "rare." See e.g. Kahan & Weisz, 508 F.2d at 832, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994)(one hundred SAVA

OAKLEY surname references in the PHONEDISC database, we conclude that OAKLEY is a surname in the United States.

As to the second Benthin factor, we recognize that no one connected to applicant has been shown to have the "Oakley" surname. If an Oakley were associated in some way with applicant, it could well indicate the public's recognition of the term as a surname. However, logic tells us that the converse is not necessarily true, i.e., the mere fact that this query comes up negative herein cannot compel the conclusion that consumers will perceive the term as a non-surname.

In weighing the third Benthin factor, we have considered applicant's contention that "Oakley" has recognized meanings other than that of a surname. While applicant argued that the term "is the name of several cities in the United States," no such evidence was ever proffered. Rather, the Trademark Examining Attorney placed into the record a geographical dictionary entry showing Oakley, Kansas to be a small town having a population of two-thousand people. However, both the

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surname telephone directory listings); Benthin Management, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings); In re Garan, Inc., 3 USPQ2d 1537 (TTAB 1987)(six GARAN telephone directory listings and one NEXIS listing). This is one of four factors. Hence, the quantum of PHONEDISC evidence which may be persuasive for finding surname significance in one case may be insufficient in another because of differences in the surnames themselves and/or consideration of the other relevant surname factors. Darty, supra.

Benthin decision and our primary reviewing court clearly require that the other meanings be "recognized" by a significant number of people. See Harris-Intertype, *supra*; Benthin Management, *supra*. The mere fact that the word Oakley has a relatively obscure or remote meanings is insufficient to show that it will not be perceived as "primarily merely a surname." See Harris-Intertype, *supra*; In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939, 1942 (TTAB 1993). Applicant certainly has not demonstrated that a significant number of consumers throughout the United States would recognize that "Oakley" is the name of a small town in Logan County, Kansas. Thus, applicant has not been able to rebut the Examining Attorney's *prima facie* surname case.

Finally, as to the fourth Benthin factor, it is the view of the Board that OAKLEY has the structure and pronunciation of a surname, not of an arbitrary designation. See Garan, 3 USPQ2d at 1538; Industrie Pirelli, 9 USPQ2d at 1566; and In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). In fact, judging this matter simply by its "look and sound," OAKLEY seems to fit the archetype of British surnames having an "-ley" suffix, such as OWSLEY and OXLEY.

Decision: The refusal to register the mark OAKLEY under Section 2(e)(4) is affirmed.