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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Berthold Types Limited

Serial No. 75866912

Mark Harrison and Jacqueline Levasseur Patt of Venable LLP
for applicant.

Amos Matthews, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Quinn, Hohein and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Berthold Types Limited to register the mark WHITTINGHAM for "typeface fonts, namely, alphabet symbols and graphic fonts, recorded on magnetic media for reproduction and duplication for the creation of texts using graphic techniques; digitally stored typefaces, in particular on electric and/or magnetic data carriers, magnetic discs, CD roms and diskettes; computer software in the field of desktop publishing; [and] computer software

downloadable from global computer information networks for generation of typefaces and fonts.”¹

The Trademark Examining Attorney refused registration under Section 2(e)(4) of the Trademark Act on the ground that the mark sought to be registered is primarily merely as surname.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.² An oral hearing was not requested.

Applicant asserts that the Examining Attorney’s evidence of only 300 telephone listings for “Whittingham” out of 115 million listings demonstrates the extreme rarity of this surname. Applicant contends that “Whittingham” is more likely to be recognized as a geographical term, pointing out that several geographical locations end in the suffix “-ham.”. In this connection, applicant submitted evidence retrieved from the Internet. Applicant also points out that the surname refusal was not raised in the

¹ Application Serial No. 75866912, filed December 9, 1999. The original application failed to set forth a basis for filing. Pursuant to the Examining Attorney’s inquiry on this point, applicant filed an amendment, setting forth a date of first use anywhere and a date of first use in commerce of March 18, 2000.

² The evidence attached to applicant’s reply brief is untimely. Trademark Rule 2.142(d). Accordingly, this evidence has not been considered in reaching our decision. Even if considered, however, this evidence does not compel a different result in this appeal.

first Office action. Rather, the refusal was not made until after the mark had been approved for publication. Applicant argues that "if the Examining Attorney, who is specifically looking for such things during the examination process, did not initially perceive the mark to have any surname significance, then consumers are not likely to perceive the mark to be 'primarily merely a surname.'" (reply brief, p. 2).

The Examining Attorney maintains that the evidence of record establishes that the primary significance of WHITTINGHAM to the general purchasing public in this country is that of a surname. Although he concedes that the surname is rare (brief, p. 5), the Examining Attorney points to the evidence in urging that the refusal be affirmed. The Examining Attorney introduced a printout from the PhoneDisc 2000 database showing 300 telephone listings of individuals with the surname "Whittingham"; a page from a general dictionary showing no listings for "Whittingham"; and geographical dictionary evidence showing no listing for the specific name, but rather only for "Whitingham" (one letter "T"). The Examining Attorney also asserts that the suffix "-ham" commonly appears in surnames.

Whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. In *re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The Office has the burden of establishing a prima facie case that a term is primarily merely a surname. In *re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985), *aff'g*, 222 USPQ 260 (TTAB 1984). Provided that the Examining Attorney establishes a prima facie case, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. In *re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975). Whether a term sought to be registered is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act must necessarily be resolved on a case by case basis, taking into account a number of factual considerations. In *re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

The first factor to be considered is the degree of a surname's rareness. In *re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987). As indicated above, a printout from the PhoneDisc data base shows telephone listings for 300 individuals with the surname "Whittingham." The Examining Attorney concedes that the surname at issue is rare, and,

given this evidence, we concur. Nevertheless, rarity in a surname does not, per se, preclude a finding that an admitted surname is "primarily merely a surname" within the contemplation of Section 2(e)(4). In re Etablissements Darty et Fils, supra; In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990); Societe Civile Des Domaines Dourthe Freres v. SA Consortium Vinicole De Bordeaux et De La Gironde, 6 USPQ2d 1205 (TTAB 1988); and In re Luis Caballero, S.A., 223 USPQ 355 (TTAB 1984).

A second factor to consider in determining whether WHITTINGHAM would be perceived as primarily merely a surname is whether there is anyone connected with applicant having the surname "Whittingham." In this regard, the record is silent; neither is there evidence on the point nor does applicant affirmatively state that there is no one connected with applicant having the surname "Whittingham."

Another factor in deciding this appeal is whether WHITTINGHAM has the structure and pronunciation of a surname, that is, whether the term has the look and sound of a surname. In re Industrie Pirelli, 9 USPQ2d 1564, 1566 (TTAB 1988). This factor is decidedly subjective in nature, but we find that WHITTINGHAM indeed has the look and sound of a surname. There are any number of surnames that end in "-ham" (for example, Cunningham and Gresham),

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and we find that WHITTINGHAM would be in this category of such surnames. Thus, although rare, we find that "Whittingham" falls within the category of rare surnames that look like and would be perceived as a surname. In re *Etablissements Darty et Fils*, supra.

Lastly, a factor, particularly significant in the present case, is whether WHITTINGHAM has any recognized meaning other than that of a surname. In re *BDH Two Inc.*, 26 USPQ2d 1556, 1558 (TTAB 1993). Of record is the pertinent page from a general dictionary showing no listing for the term at issue. Merriam-Webster's Collegiate Dictionary (10th ed. 1993). The Examining Attorney also made of record a page showing only a listing of "Whitingham" (none for "Whittingham") in Webster's New Geographical Dictionary (1997). This listing indicates that it is the name of a lake in Vermont. In this connection, applicant introduced materials that it pulled off of the Internet showing "Whittingham" as the name of a small town in Vermont, the name of a parish in the United Kingdom, and the name of a fish and wildlife management area in New Jersey.

We conclude that the factual considerations, on balance, weigh in favor a finding that WHITTINGHAM is primarily merely a surname. To the extent that

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"Whittingham" has any geographical significance, it is extremely minor when compared with the primary surname significance of the term. Unless there is a readily recognized meaning for a term apart from its surname significance, the fact that other meanings for the term exist does not necessarily indicate that the term would have a primary meaning to the purchasing public other than that of its ordinary surname significance. In re Nelson Souto Piquet, 5 USPQ2d 1367, 1367-68 (TTAB 1987). In the present case, we wonder how many consumers will even know about Whittingham, Vermont, Whittingham U.K. or Whittingham Fish and Wildlife Management Area in New Jersey. As evidenced by the lack of any listings for "Whittingham" in the geographical dictionary (Lake Whitingham is the only location cited), these locations are minor, and would be largely unknown to the general population in this country. In any event, it is common knowledge that places are named after individuals. In re Champion International Corp., 229 USPQ 550, 551 (TTAB 1985).

There simply is no indication that there is any significant consumer recognition of and association between the term "Whittingham" and any geographical significance. The fact that "Whittingham" may have some obscure significance as a geographical term does not dissipate its

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primary significance as a surname, albeit a rare surname. See, e.g., *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1988); and *In re Picone*, 221 USPQ 93, 95 (TTAB 1984).

In reaching our decision, we have not placed any probative value on the fact that the surname refusal was not raised until the second Office action, the issuance of which occurred after the mark was approved for publication. Although piecemeal prosecution is not to be commended, we see no reason to view this as a factor in deciding whether or not the term WHITTINGHAM is primarily merely a surname. Our decision must rest on the evidence of record as it relates to whether or not the consuming public will see that the primary significance of WHITTINGHAM is as a surname.

Decision: The refusal to register is affirmed.