

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Gibson Piano Ventures, Inc.

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Serial No. 76409771

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Martha B. Allard of Waddey & Patterson for Gibson Piano Ventures, Inc.

Mary Boagni, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Hanak, Walters and Chapmann, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Gibson Piano Ventures, Inc. (applicant) seeks to register in typed drawing form MEHLIN & SONS for pianos. The intent-to-use application was filed on May 20, 2002.

Citing Trademark Act Section 2(e)(4) the Examining Attorney has refused registration because applicant's mark is primarily merely a surname. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

To begin with, we note that there is no dispute that Mehlin is a surname, and applicant does not contend to the

contrary. In this regard, reference is made to page 2 of applicant's brief where applicant states that "the issue is whether the additional terms combined with the surname [Mehlin] are capable of functioning as a mark." Moreover, during the examination process, the Examining Attorney conducted a NEXIS search for "Mehlin." The preface to this search revealed that there were 339 stories which contained "Mehlin." The Examining Attorney made of record the text of 41 of these 339 stories. These 41 stories clearly use Mehlin as a surname. One story appeared in the Omaha World Herald of March 12, 2003 and it reads, in part, as follows: "No bullets or bullet holes were found outside the range, which was closed July 15, said Police Chief Keith Mehlin." Applicant has not argued that the 41 stories made of record are not representative of the remaining 298 stories. That is to say, there is no suggestion that in any of these 298 stories Mehlin is used other than as a surname.

As previously noted, applicant has conceded that Mehlin is a surname. However, it is the contention of applicant "that the mark MEHLIN & SONS [taken in its entirety] should not be deemed primarily merely a surname for two reasons. First, the additional terms '& Sons' combined with the term 'MEHLIN' is capable of functioning as a mark, such that the mark should not be considered

primarily merely a surname under Section 2(e)(4). Second, the term has some historical significance, i.e., it identifies a historical person in the vintage piano industry, such that the surname is not primarily merely a surname." (Applicant's brief page 2).

Considering applicant's first argument, we are somewhat perplexed by applicant's statement that its mark MEHLIN & SONS "is capable of functioning as a trademark." (Applicant's brief page 2). There is no evidence that applicant has made use of its mark. Thus, applicant cannot show that MEHLIN & SONS has acquired a secondary meaning such that it is no longer primarily merely a surname. See Section 2(f) of the Trademark Act. Instead, we will interpret applicant's first argument as being that MEHLIN & SONS is inherently (i.e. from the very beginning) not primarily merely a surname. In other words, it is our understanding that applicant is arguing that the addition of & SONS to the surname MEHLIN causes applicant's mark in its entirety to be not primarily merely a surname.

The leading case concerning whether the addition to a surname of words (or abbreviations) indicating the business structure of applicant results in a composite mark which is not primarily merely a surname is In re I. Lewis Cigar Mfg. Co., 205 F.2d 204, 98 USPQ 265 (CCPA 1953). There a

predecessor Court to our primary reviewing Court held that the "mark" S. SEIDENBERG & CO'S for cigars was primarily merely a surname despite the fact that the "mark" in its entirety concluded with the wording & CO'S. The wording & CO'S like the wording & SONS merely indicates the legal nature of the business, and does not convert either SEIDENBERG or MEHLIN into something other than primarily merely a surname. Indeed, the present "mark" MEHLIN & SONS, if anything, is more likely to retain its status as primarily merely a surname. In the Lewis Cigar case the mark in question featured additional verbiage, namely, the letter "S" preceding the "mark" S. SEIDENBERG & CO'S. Here, there is no initial or other wording proceeding MEHLIN & SONS.

More recently, our primary reviewing Court held that DARTY was primarily merely a surname. In so doing, the Court noted that DARTY "is used in the company name in a manner which reveals its surname significance, at least to those with a modicum of familiarity with the French language (Darty et Fils translates as Darty and Son)." In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

In short, we find that the addition of & SONS to the surname Mehlin does not result in a "mark" (MEHLIN & SONS) which is other than primarily merely a surname.

We turn now to applicant's second argument as to why its "mark" is not primarily merely a surname, namely that it "has some historical significance, i.e., it identifies a historical person in the vintage piano industry."

(Applicant's brief page 2). To begin with, in an effort to establish that a purported person by the name of Paul G. Mehlin produced pianos in this country in the 1800's, applicant improperly attached to its brief for the first time excerpts from the Pierce Piano Atlas and the Bluebook of Pianos. To be clear, applicant never properly made this evidence of record during the examination process, but instead waited to attach such "evidence" to its appeal brief in violation of Trademark Rule 2.142(d). Such evidence is not properly of record, and it would be given no consideration by this Board unless the Examining Attorney in his or her brief did not object to the belated submission of said evidence. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1756 n.9 (TTAB 1991) and In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 n.2 (TTAB 1990). In this case the Examining Attorney clearly objected to this Board's consideration of applicant's belated evidence

attached for the first time to its brief in direct violation of Trademark Rule 2.142(d). (Examining Attorney's brief page 7).

However, even if we were to consider applicant's belated evidence, it would not help applicant's cause. Applicant concedes that the name Mehlin has at most "some historical significance." (Applicant's brief page 2). A surname is removed from the category of being primarily merely a surname pursuant to Section 2(e)(4) of the Trademark Act only if the surname is associated with an historical person of such great renown that that the surname is no longer primarily merely a surname but rather has as its "primary connotation ... [that] of the historical character." Lucien Piccard Watch v. Since 1868 Crescent Corp., 314 F. Supp. 329, 165 USPQ 459, 461 (SDNY 1970)(DA VINCI found to be not primarily merely a surname because its primary connotation is with the world famous historical figure Leonardo Da Vinci).

Thus, in order for a surname to lose its status as primarily merely a surname it must be the surname of an extremely famous historical figure. If a surname is also the surname of a lesser historical figure then it still remains primarily merely a surname. In re Pickett Hotel Co., 229 USPQ 760, 761-62 (TTAB 1986)(PICKETT SUITE HOTEL

Ser. No. 76409771

was held to be primarily merely a surname even though applicant properly made of record significant evidence showing that George Edward Pickett was a Confederate general of some renown).

In stark contrast, applicant's "evidence" not made of record (excerpts from the Pierce Piano Atlas and the Bluebook of Pianos) both merely have very brief listings for Paul G. Mehlin and Mehlin & Son which are surrounded by numerous other brief listings for other piano makers.

Decision: The refusal to register is affirmed.