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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Piano Ventures, Inc.

Serial No. 76411174

Lucian Wayne Beavers of Waddey & Patterson, PC for Gibson Piano Ventures, Inc.

Khanh M. Le, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hairston, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On May 20, 2002, applicant filed the above-captioned intent-to-use application by which it seeks to register the mark FRANKE (in typed form) for "pianos."

At issue in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground that it is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4). Applicant and the

Trademark Examining Attorney filed main appeal briefs. Applicant did not file a reply brief, and did not request an oral hearing. We affirm the refusal to register.

The burden is initially on the Trademark Examining Attorney to establish a *prima facie* case that applicant's mark is primarily merely a surname. If a *prima facie* case is established, the burden then shifts to the applicant to rebut it with evidence sufficient to establish that the primary significance of the mark is other than that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). "The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can only be resolved on a case by case basis," taking into account a number of factual considerations. *In re Etablissements Darty et Fils, supra*, 225 USPQ at 653; *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). These considerations include:

- (1) The degree of a surname's rareness;
- (2) Whether anyone connected with the applicant has that surname;
- (3) Whether the word has any recognized meaning other than that of a surname;
- (4) Whether the word has the look and sound of a surname; and

- (5) Whether the mark is presented in a stylized form distinctive enough to create a separate non-surname impression.

In re Gregory, supra; In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

The fifth factor is not relevant to this case, because applicant seeks to register the mark in typed form, without any special stylization or display. See *In re Gregory*, 72 USPQ2d 1792, 1794 (TTAB 2004). Likewise, the fact that there apparently is no one connected with applicant who has the surname FRANKE renders the second evidentiary factor essentially neutral in this case. See *In re Gregory, supra*, 72 USPQ2d at 1795.

As to the first factor, i.e., the degree of the surname's rareness, the Trademark Examining Attorney has introduced the results of a search of the PowerFinder (also known as PhoneDisc) electronic database, which reveals that there are 3,564 residential telephone listings in the United States for the surname FRANKE. A printout of the (alphabetical) first one hundred of those listings is of record, including listings for households in thirty-one different states, including at least one listing in each of the following major population centers: Chicago, St. Louis, Washington, D.C., Seattle, Miami, Houston and

Honolulu. The Trademark Examining Attorney also has made of record the results of a search of the term FRANKE in the NEXIS database (NEWS library, US file), which retrieved 14,675 articles or entries containing references to FRANKE. Excerpts from seven of those articles (from newspapers from around the country) have been printed out and made of record, each of which refers to a person with the FRANKE surname.¹

It is settled that "there is no minimum number of directory listings required to establish a prima facie case" in support of a surname refusal. *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). See also *In re Gregory supra*, (no "per se

¹ The seven excerpts are from story nos. 2-6, 8 and 12. The Trademark Examining Attorney has not stated that these seven are representative of the remaining 14,668 articles. Although we cannot expect the Trademark Examining Attorney to have examined all of the over 14,000 articles, a larger sampling obviously would have been more helpful, as well as a statement that the excerpts made of record are representative of those examined. See *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717 (TTAB 1992); *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 n.2 (TTAB 1989); and *In re Federated Department Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987). Accordingly, we do not presume that the remaining 14,000-plus NEXIS articles support the Trademark Examining Attorney's *prima facie* case, i.e., that they show surname use of FRANKE. Rather, the seven NEXIS articles made of record show only that the seven people identified therein are reported to have the surname FRANKE. (These seven persons presumably are among the inhabitants of the 3,564 FRANKE households identified in the PowerFinder search results). By the same token, however, we will not presume, as applicant would have us presume, that the remaining 14,000-plus articles do not show surname use of FRANKE, much less that they in fact show non-surname significance of the term. See discussion *infra*.

benchmark" as to minimum number of listings); and *In re Petrin Corp., supra.* Moreover,

the question of whether a surname is or is not rare is not to be determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database. Given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of such a database.

In re Gregory, supra, 70 USPQ2d at 1795.

Based on the Trademark Examining Attorney's showing that there are 3,564 residential listings in the United States for households having the FRANKE surname, including households in at least thirty-one different states and in many of the nation's major population centers, we find that FRANKE is not an especially rare surname. We certainly cannot conclude that the surname is so rare that this factor, i.e., the degree of the surname's rareness, should weigh in applicant's favor, or weigh only slightly in support of the Office's position. Rather, we find that the evidence on this factor fully supports the Trademark Examining Attorney's *prima facie* case that FRANKE would be primarily perceived by the relevant purchasing public as a surname.

As to the third evidentiary factor, i.e., whether FRANKE has any recognized meaning other than that of a surname, the Trademark Examining Attorney has submitted a photocopy of an excerpt (page 400) from Merriam-Webster's Geographical Dictionary (3rd ed. 1997), which shows that there is no listing or entry for "Franke" in that dictionary. For its part, applicant makes two arguments with respect to this factor, which we shall address in turn.

First, we are not persuaded by applicant's contention that FRANKE would be perceived by the relevant purchasing public as referring primarily to "Firmant Arthur Franke," who, applicant asserts, was a famous Polish piano maker. Applicant has presented absolutely no evidence to support this contention, nor its contention that pianos bearing this alleged historical person's name were made for many years. The excerpt from Pierce Piano Atlas (10th ed.), made of record and cited by applicant in support of its argument, contains no reference to a Polish piano maker named "Firmant Arthur Franke." Under an entry for "ACROSONIC, by Baldwin Piano,"² the following text appears: "The following serial numbers are for vertical pianos made

² Applicant asserts that it is the successor in interest to Baldwin Piano.

by Baldwin with the names: Acrosonic, Baldwin, Ellington, Franke, Howard (prior to 1959, see Howard for 1959 to 1968), Kremlin, Manuello, Modello, Monarch, St. Regis, Sargent, Schroeder, Valley Gem and Winton." There follows a list of serial numbers for the years 1895 to 1996, without, however, any breakdown of the serial numbers or model years by brand name. At most, this evidence shows only that "Franke" was one of numerous brand names for pianos sold by Baldwin Piano at some indefinite period of time prior to 1996.

In any event, even assuming that applicant had presented evidence showing that there in fact was a Polish piano maker named Firmant Arthur Franke, there is no basis in the record for concluding that he was famous, much less that his fame is of such magnitude that, like the designations DA VINCI, SOUSA, and M.C. ESCHER, the designation FRANKE primarily would be viewed by purchasers not for its significance as a surname, but rather as a reference to a particular, renowned historical personage. This case thus is readily distinguishable from the cases which involved the names of those famous historical personages, i.e., *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022 (TTAB 2002)(SOUSA); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000)(M.C. ESCHER); and

Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.,
314 F.Supp. 329, 165 USPQ 459 (SDNY 1970)(DA VINCI).

Second, we reject applicant's argument that we should presume that the 14,000-plus NEXIS stories which were retrieved by the Trademark Examining Attorney's search of the term FRANKE but not made of record are themselves evidence that FRANKE has non-surname significance. As applicant notes, there is language in the Board's decision in *In re Monotype Corp. PLC, supra*, which, at first glance, could be construed as supporting applicant's argument:

We must conclude that, because the Examining Attorney is presumed to have made the best case possible, the 46 stories [out of 48 articles retrieved by the search] not made of record do not support the position that CALISTO is a surname and, indeed, show that CALISTO has nonsurname meanings. *In re Federated Department Stores, Inc.*, 3 USPQ2d 1541, 1542 (TTAB 1987).

In re Monotype Corp., 14 USPQ2d at 1071. However, when we consider this quoted language in the context of the rest of the Board's discussion and findings in the *In re Monotype* case, and in the context of the *In re Federated Department Stores* case cited by the Board as its authority for the quoted language, we conclude that the quoted language is merely dicta. That is, for the reasons discussed below, we do not read the quoted language as creating or imposing an

evidentiary rule which would require us to make any presumptions about the contents of the 14,000-plus NEXIS excerpts which were not made of record in this case.

First, the quoted language in *In re Monotype Corp.* is immediately followed by this statement in footnote 2 of that case: "While we do not suggest that all 48 articles need to have been made of record, we think that, if there were additional stories demonstrating the surname significance of CALISTO, the Examining Attorney should have submitted a larger number and indicated whether or not they were representative of the rest." This observation (that not all of the retrieved stories need to be made of record) applies *a fortiori* in the present case, in which the NEXIS search retrieved not forty-eight stories but over 14,000. Moreover, we have already noted (*supra* at footnote 1) that the Trademark Examining Attorney could have made a more persuasive showing with regard to the NEXIS evidence in this case and that, because she did not, the NEXIS evidence is entitled to very little weight as evidence in support of the Office's *prima facie* case.

Second, and more significantly, we note that in *In re Monotype Corp.*, there was affirmative evidence in the record showing that CALISTO, the mark at issue, in fact had a recognized non-surname significance. It is that

affirmative evidence of such non-surname significance, and not any presumption about the contents of the forty-six non-introduced NEXIS stories, that was the evidentiary basis of the Board's finding that CALISTO had a recognized non-surname significance.

Finally, the *In re Federated Stores* case, cited by the Board in *In re Monotype Corp.* as the authority for the quoted language relied on by applicant in the case at bar, does not support or warrant recognition of the "presumption" for which applicant argues, i.e., that the contents of the non-introduced NEXIS stories should be deemed to be affirmative evidence in the applicant's favor. Indeed, the Board in *In re Federated Stores* essentially rejected the argument that such a "presumption" should be recognized:

It appears that these are three of eighteen stories found. Applicant objects to not having been provided with the remaining fifteen stories, as well, saying that they may have been supportive of applicant's position. With regard thereto, the Examining Attorney has the option of providing whatever material he or she feels is helpful in proving the point he or she is attempting to make. It is up to the applicant to rebut that evidence. Thus, while it may provide a more complete picture, the Examining Attorney is not obliged to file every story found in a Lexis/Nexis search. By the same token, we must assume that the three excerpts selected provide the best support of

the Examining Attorney's refusal to register available from that source.

In re Federated Stores, supra, 3 USPQ2d at 1542 n.2. Thus, the presumption or conclusion to be drawn from a Trademark Examining Attorney's failure to submit all of the retrieved NEXIS stories (or what is affirmatively stated to be a representative sample of such stories) is limited to a finding that the evidence actually submitted is "the best support of the Examining Attorney's refusal to register available from that source." There is no presumption, positive or negative, as to the contents of the NEXIS stories which were not introduced by the Trademark Examining Attorney. If any of those other stories do not support the refusal, or in fact rebut the Office's *prima facie* case, it is up to the applicant to make them of record in response to the Office's showing.

In sum, the "presumption" for which applicant argues in this case is not legally cognizable. Instead, we conclude that we have no basis for making any finding at all as to the manner in which FRANKE is used in the 14,000-plus articles retrieved by the Trademark Examining Attorney's search but not made of record, and we therefore make no such finding. These other, non-introduced articles are not evidence which supports the Office's *prima facie*

case that FRANKE is primarily merely a surname, and we have not treated them as such. See *supra* at footnote 1. However, we also decline to treat these articles as evidence that FRANKE has any recognized non-surname significance. The non-introduced articles have no evidentiary value at all in this case.

For the reasons discussed above, we find that there is no evidence which establishes that the primary significance of the term FRANKE is other than that of a surname. The evidence (or lack thereof) pertaining to this factor supports the Office's *prima facie* case that FRANKE is primarily merely a surname.

Under the fourth (and obviously somewhat subjective) factor, we find that FRANKE indeed has the "look and sound" of a surname. We certainly cannot conclude that it does not look and sound like a surname.

For the reasons discussed above, we find that the Office has made out a *prima facie* case that FRANKE is primarily merely a surname. We also find that applicant has failed to present evidence sufficient to rebut that *prima facie* case.

Decision: The refusal to register under Trademark Act Section 2(e)(4) is affirmed.