

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: March 10, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bonert's Inc.

Serial No. 76627189

Jill M. Pietrini of Manat, Phelps & Philips, LLP for
Bonert's Inc.

S. Michael Gaafar, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney).

Before Quinn, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On January 6, 2005, Bonert's Inc. (applicant) filed an application to register the mark BONERT'S RUSTIC PIES in standard character form on the Principal Register for "pies" in International Class 30. Applicant asserts a bona fide intention to use the mark in commerce as its basis for registration. In addition, applicant asserts ownership of prior Registration Nos. 2329922 for the mark BONERTS and

2387512 for the mark BONERTS SLICE OF PIE and design both for bakery products and pies.

The examining attorney refused registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4). In an attempt to traverse the refusal, applicant amended its mark to BONERTS RUSTIC PIES. When the refusal was made final, applicant appealed.

Issues Not Before the Board

A clarification regarding the issue before us in this proceeding is believed necessary at this time.

Acquired Distinctiveness

We begin by observing that applicant raised the following argument in its response to the examining attorney's August 12, 2005 Office action:

Applicant is the owner of two other trademark registrations that include the word BONERT: BONERTS (Reg. No. 2,329,922) and BONERTS SLICE OF PIE & design (Reg. No. 2,387,512) ("Applicant's Registrations"), both for bakery goods and pies.¹ Both of Applicant's registrations have been in use in commerce since October of 1993. As such, Applicant's consumers will already be familiar with Applicant and its goods and services in connection with these other marks. Accordingly, the primary significance to the purchasing public of the mark BONERT'S RUSTIC PIES will be of baked goods, and not that of a surname.

¹ Applicant did not introduce into the record copies of these asserted registrations.

(February 14, 2006 response to Office action, p. 2, emphasis in original.) We note, however, that applicant did not, at any time during the examination of the subject application, submit a claim that the name BONERT or BONERTS in the mark BONERTS RUSTIC PIES mark had acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f) on the basis of applicant's ownership of its asserted prior registrations. Nor do we construe applicant's above-referenced arguments as comprising such a Section 2(f) claim. Furthermore, the examining attorney makes the following statement in his brief (p. 1-2):

On March 14, 2006, the examining attorney attempted to contact the applicant to discuss the applicant's options regarding registration on the Principal Register pursuant to Section 2(f) of the Trademark Act, as well as to discuss a disclaimer of the wording "rustic pies." However, no agreement could be reached, and therefore, no action was taken by the examining attorney at such time.

Thus, while applicant and the examining attorney discussed amendment of the instant application to claim acquired distinctiveness pursuant to Section 2(f), no such amendment was filed. Accordingly, the issue of acquired distinctiveness is not before us in this case.

Disclaimer

We observe in addition that the examining attorney suggested in both his August 12, 2005 and March 23, 2006

Office actions that applicant could overcome the Section 2(e)(4) refusal by amending the application to seek registration on the Supplemental Register after filing an acceptable allegation of use. The examining attorney further advised applicant that in the event of an amendment to the Supplemental Register it would be necessary to disclaim the wording "RUSTIC PIES" because such term "is generic for a certain type of pie" (August 12, 2005 Office action, p. 3). Excerpts of evidence made of record by the examining attorney to support such a requirement follow (emphasis added):

RUSTIC AS HE WANTS TO BE

...For dessert, try the compellingly gritty yet soft bittersweet-chocolate polenta pudding cake. A barely sweet ricotta torta with chestnut honey and a sprinkling of bee pollen has a monastic spareness to it. Peach and blueberry crostada is a cute small **rustic pie** with a sturdy, buttery crust and the surprising crunch of chopped nuts added to the fruit.

LA Weekly (California) October 3, 2003

FINAL WORDS FOR THE SOLO DINER

To bake a pie, bake the recipe in a small fluted tart pan. Or instead of using a pie or tart pan at all, make a small **rustic pie**. Those are the ones that just flop the dough over the filling on a cookie sheet, and size is not very important.

Pittsburgh Post-Gazette (Pennsylvania) March 24, 2005

EASIER THAN PIE; RICH BUTTERY CROSTATA USES FRESH BERRIES OF THE SEASON

Chef Tim Cushman, a restaurant and hotel consultant, has created a simple **rustic pie** made with fresh berries of the season - strawberries, raspberries and blueberries...
The Post-Standard (Syracuse, NY) August 18, 2004

LET SUMMER PROVIDE FRUIT FILLINGS
If you're baking for two, make a small **rustic pie**, one sheet of pie dough fitted into a 7- or 8-inch pan...
The Star Press (Muncie, Indiana) July 14, 2005

We note, however, that the examining attorney's requirement for a disclaimer of "RUSTIC PIES" was conditional upon applicant's amendment of the application to the Supplemental Register. At no time did the examining attorney issue a requirement that applicant disclaim "RUSTIC PIES" aside from the context of his suggested amendment to the Supplemental Register. Further, in his brief the examining attorney does not argue, or even discuss, such a requirement except in the statement quoted from his brief above.² Accordingly, the requirement that applicant disclaim any portion of its applied-for mark is not an issue on appeal.

As a result, the sole issue on appeal is the examining attorney's refusal to register the mark BONERTS RUSTIC PIES

² Applicant asserts in its brief that it agreed by telephone to a disclaimer of "PIES" but not "RUSTIC" and presents arguments against such a requirement.

pursuant to Section 2(e)(4) of the Trademark Act.

Applicant and the examining attorney have filed briefs on the issue under appeal.

We reverse.

In addition, pursuant to Trademark Rule 2.142(g) we will address the disclaimer of certain wording in applicant's mark at the end of this decision.

Evidentiary Matters

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with its brief. These exhibits consist of printed copies of third-party registrations. We agree with the examining attorney that these exhibits are untimely and, accordingly, they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

Surname Refusal

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Act, 15 U.S.C. §1052(f). We must decide on the facts of each case whether

the mark at issue is "primarily merely a surname" under the Act. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The examining attorney bears the initial burden to make a prima facie showing of surname significance. See *Id.* If the examining attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant to determine ultimately whether the mark is primarily merely a surname. See *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of applicant. See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, the Board identified five factors, four of which are relevant here, to consider in determining whether a mark is primarily merely a surname: (1) the degree of the surname's "rareness"; (2) whether anyone connected with applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; and (4) whether the mark has the "look and feel" of a surname. *Id.* at 1332-33. Because BONERTS RUSTIC PIES is in standard character form, we need not consider the fifth *Benthin* factor here, that is, whether the manner in which the mark is displayed might negate any surname significance.

Rareness

With his final Office action, the examining attorney provided a listing of 566 individuals having "Bonert" as a surname, retrieved by a search of the Lexis/Nexis USFIND computer database. With his first Office action, the examining attorney submitted a listing from the same database of 34 individuals having "Bonert" as a surname. However, even if these are 34 different individuals from the 566 listed in the final Office action, the total number of persons with "Bonert" as a surname is 600.

As a result, on this record, we conclude that Bonert is an extremely rare surname. In concluding so, we rely on the fact that only 600 examples of the "Bonert" surname were located from a comprehensive directory of the entire United States. See *In re Sava Research Corp.*, *supra* at 1381; and *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

Applicant's Surname Use

Applicant acknowledges that "the name of the person signing Applicant's application was its president, Michael Bonert" (brief, p. 5). As a result, we find that "Bonert" is the surname of someone connected with applicant.

Other Meanings

The examining attorney argues that BONERT has no meaning other than as a surname and offers with his Office

actions dictionary and encyclopedia evidence from Dictionary.com, Microsoft Encarta, Merriam-Webster, One Looks, Bartleby, and several other sources in support of this position. Applicant asserts that "BONERTS RUSTIC PIES will be synonymous to the purchasing public with Applicant's bakery goods, namely, pies, by virtue of its use of the marks BONERTS and BONERTS SLICE OF PIE for pies since 1993." (brief, p. 5). However, and as noted above, applicant has not submitted a claim of acquired distinctiveness based either upon its ownership of its prior registrations or upon any other basis. Nor has applicant introduced any evidence that "BONERT" has any other significance than that of a surname. We note nonetheless the absence of evidence that any person with the "Bonert" surname has achieved any notoriety. *Cf. In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) (evidence of public figures with surname Rogan found supported conclusion that public would perceive Rogan as a surname). Weighing all of the facts and the absence of evidence of other meanings, we find that "Bonert" has no recognized meaning or significance other than surname significance.

Look and Feel

Lastly we must consider whether "BONERTS" has the "look and feel" of a surname. As to this factor, the

examining attorney argues that BONERTS has the look and feel of a surname because the evidence of record established that the proposed mark does not have any recognition other than that of a surname. Applicant argues, instead, that "the word BONERTS in Applicant's mark BONERTS RUSTIC PIES does not have the structure or pronunciation of a surname, especially given the addition of the words RUSTIC PIES" (brief, p. 6).

We agree with the examining attorney that neither the pluralization nor possessive form of "Bonerts" diminishes its surname significance. See *In re Woolley's Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991). See also *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986); and *In re Luis Caballero, S.A.*, 223 USPQ 355, 357 (TTAB 1984). We further agree that the addition of the wording RUSTIC PIES does not appreciably diminish the surname significance of the mark. The term "PIES" clearly is generic for applicant's goods, identified in its application as "pies." In addition, based upon the examining attorney's evidence of record, the term "RUSTIC" appears to describe a type of pie. Thus, taken together, the wording "RUSTIC PIES" is, at best, descriptive of applicant's goods.

However, we reject the examining attorney's argument that the mere fact that a term in a mark may not have any

recognized meaning other than that of a surname imbues the mark with the "look and feel" of a surname. As discussed above, "Bonert" may not have a defined meaning; nonetheless in a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use. See *In re Garan Inc.*, *supra* at 1540. It is in the case of a rare surname that we need to weigh "look and feel" carefully. See *In re Joint-Stock Company "Baik,"* 84 USPQ2d 1921 (TTAB 2007). For example, certain surnames, though rare, resemble common surnames "in their structure and pronunciation." See *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). However, we see insufficient evidence that such is the case with "Bonert." Cf. *In re United Distillers plc*, *supra* at 1221.

The examining attorney introduced evidence with the final Office action from the Superpages.com computer database to show that surnames such as "Bonner," "Bonar," "Bonnet," "Conner" and "Donner," are similar in appearance and sound to "Bonert." We note, however, that such evidence does not indicate the number of individuals with such surnames. As such, we cannot determine from the examining attorney's evidence whether the extremely rare surname "Bonert" is similar to surnames that are almost as

rare, or more common. In addition, evidence from OneLook.com submitted by the examining attorney with the same Office action demonstrates that "Bonert" also is similar in appearance and sound to such words as "boner," "bonnet," "banter," "burnet," and "brunet." Thus, we are not convinced that the similarity of "Bonert" to other surnames of unknown rarity somehow results in that term having the "look and feel" of a surname, especially given that "Bonert" also resembles a number of words in the English language. In this case, there simply is insufficient evidence that relevant purchasers would perceive "Bonert" as a surname.

In sum, based on the record in this case, we conclude that the examining attorney has failed to meet the burden of establishing a prima facie case that "Bonerts" is primarily merely a surname. Accordingly, we conclude that BONERTS RUSTIC PIES is not primarily merely a surname. Furthermore, and as noted above, we must resolve any doubt in favor of applicant. See *In re Benthin Management GmbH*, 37 USPQ2d at 1334.

Decision: The refusal to register applicant's mark on the ground that it is primarily merely a surname is reversed.

Disclaimer

As noted above, the examining attorney submitted evidence that the wording "RUSTIC PIES" in the applied-for mark merely describes the identified goods. In addition, both applicant and the examining attorney acknowledge that they discussed disclaiming the wording "RUSTIC PIES" or "PIES" over the telephone during prosecution of this application, but were unable to reach agreement with regard thereto.

It is settled that once an application has been considered and decided by the Board on appeal, such application generally may not be "reopened" for further examination, except for the entry of a disclaimer under Section 6 of the Trademark Act. See Trademark Rule 2.142(g); *In re Petite Suites Inc.*, 21 USPQ2d 1708, 1710 (Comm'r 1991); and *In re S.D. Fabrics, Inc.* 223 USPQ 56, 57 n.1 (TTAB 1984). See also TBMP §1218 (2d ed. rev. 2004) and the authorities cited therein. In this case, we find that, based upon the evidence of record, the wording "RUSTIC PIES" merely describes the applied-for goods and must be disclaimed apart from the mark as shown. Such a disclaimer will put the involved application in condition for publication without further examination. See *In re S.D. Fabrics, Inc.*, *supra*.

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Accordingly, the involved application is hereby **remanded** to the examining attorney for entry of the disclaimer of "RUSTIC PIES" apart from the mark as shown.