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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Moen Incorporated

Serial No. 78/039,367

Daniel C. McEachran of Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd. for Moen Incorporated.

Steven R. Berk, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Simms, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An intent-to-use application has been filed by Moen
Incorporated to register HAWTHORNE for "bath accessories,
namely towel bars, towel rings, robe hooks, toothbrush
holders, toilet tissue holders, soap dishes and cup
holders."¹

¹ Serial No. 78/039,367 filed December 14, 2000.

Registration has been refused under Section 2(e)(4) of the Trademark Act on the ground that HAWTHORNE is primarily merely a surname.

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

The Examining Attorney maintains that the primary significance of HAWTHORNE to the purchasing public is that of a surname. In support of the refusal, the Examining Attorney made of record evidence from the REFERENCE ONE data base showing that there are a total of 9,696 residential directory listings for persons whose surname is "Hawthorne." In addition, the Examining Attorney made of record an excerpt from Eldon C. Smith, American Surnames 3 (1972), which characterizes "Hawthorne" as a "particularly American surname;" an excerpt from the Random House Unabridged Dictionary (2d ed. 1993) wherein the first definition of "**Hawthorne**" is: "*Nathaniel. 1804-64, U.S. Novelist and short-story writer,*" and the other two definitions are for geographic places; and a "representative sample" of sixteen stories out of 48,935

² The current Examining Attorney was not the original Examining Attorney in this case.

excerpts from the Nexis data base showing usage of "Hawthorne" as a surname in current news and magazine articles distributed to the general public. These articles refer to a banker, a doctor, a football player, a police officer and an actress, among others, who bear this surname.

Applicant, in urging reversal of the refusal to register, argues that HAWTHORNE has a recognizable non-surname meaning or significance. It is applicant's position that the purchasing public would consider HAWTHORNE to be a variation of the word "hawthorn" which is the name of a spring-flowering shrub or tree. Because of this meaning of "hawthorn," applicant argues that purchasers would associate the mark HAWTHORNE with the "hawthorn" flower pattern, which appears on china. In addition, applicant points out that no one associated with it has the surname "Hawthorne," and argues that HAWTHORNE does not have the look and sound of a surname. Finally, applicant maintains that the Office has registered three other marks consisting of HAWTHORNE.

A term is primarily merely a surname if its primary significance to the purchasing public is that of a surname. In re Hutchison Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); In re Industrie Pirelli Societa per

Azioni, 9 USPQ2d 1564 (TTAB 1988). The initial burden is on the Patent and Trademark Office to establish a *prima facie* case that the term is primarily a surname. In re Establishments Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). If that *prima facie* showing is made, then the burden of rebutting that showing, i.e., the burden of showing that the primary significance of the term to the purchasing public is other than that of a surname, shifts to applicant. See In re Etablissements Darty et Fils, *supra*.

The determination as to whether a mark's primary significance to the purchasing public is that of a surname takes into account various factors, such as (i) the degree of a surname's rareness; (ii) whether anyone connected with applicant has the surname in question; (iii) whether the term in question has any recognized meaning other than that of a surname; and (iv) whether the term has the "look and sound" of a surname. See In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

In this case, we find that the evidence made of record by the Examining Attorney is sufficient to establish, *prima facie*, that the primary significance of HAWTHORNE to the purchasing public is that of a surname. In addition, we find that applicant has failed to rebut that *prima facie*

showing by demonstrating that the primary significance of HAWTHORNE is other than of a surname.

The 9,696 residential directory listings (spread throughout the United States); the book and dictionary excerpts; and the Nexis evidence submitted by the Examining Attorney constitute a strong evidentiary showing that the primary significance of HAWTHORNE to the purchasing public is that of a surname.

We are not persuaded by applicant's argument that the purchasing public would consider HAWTHORNE to be a variation of the word "hawthorn," and thus not a surname. Applicant offered no evidence in support of this argument, and as the Examining Attorney pointed out in his brief, a similar argument was rejected by this Board in *In re Pickett Hotel Co.*, 229 USPQ 76061 (TTAB 1986) ["We reject the appellant's argument that because the surname PICKETT is the phonetic equivalent of the word "picket," a word describing a type of fence or a labor demonstrator, a prima facie case has not been made out."]

We recognize that "Hawthorne" is not the surname of anyone connected to applicant. Of course, if "Hawthorne" were the name of someone associated with applicant, it could well indicate the public recognition of the term as a surname. It is not the case, however, that because no one

associated with applicant has been shown to have the "Hawthorne" surname, purchasers will perceive the term as a non-surname.

Finally, despite applicant's argument to the contrary, we are of the view that HAWTHORNE has surname-like characteristics; that is, the "look and sound" of a surname. In this respect, it is similar to the more frequently encountered surname of Hawkins. In short, by the "look and sound," HAWTHORNE has the structure and pronunciation of a surname, not of an arbitrary designation. *Compare* In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994) [SAVA, for secure communications systems, has the "look and sound" of an arbitrary acronym, not a surname].

With respect to applicant's contention that the Office has allowed three other HAWTHORNE marks to register, it has often been stated that the Board must decide each case on its own set of facts. See In re Nett Designs, Inc., 263 F.3d 1379, 57 USPQ2d 1564 (Fed. Cir. 2001). We are not privy to the file records of the three third-party registrations relied upon by applicant and have no way of knowing the reasons for their allowance. We note, however, that one of the third-party registrations issued on the Supplemental Register and another one issued on the

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Principal Register under the provisions of Section 2(f).
This would appear to indicate that, at least with respect
to these registrations, the Office considered HAWTHORNE to
be primarily merely a surname.

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