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Paper No. 12

TJQ

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Group Health Service of Oklahoma, Inc.

Serial No. 78137840

Rachel Blue of Doerner, Saunders, Daniel & Anderson for
applicant.

Karla Perkins, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney)

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Group Health Service of
Oklahoma, Inc. to register the mark CHISHOLM ADMINISTRATIVE
SERVICES for "insurance services, namely, Medicare program
administration, and benefits administration."¹ The words
"Administrative Services" are disclaimed apart from the
mark.

¹ Application Serial No. 78137840, filed June 21, 2002, alleging
dates of first use and first use in commerce of March 1, 2002.

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

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

In urging that the refusal to register be reversed, applicant advances two main arguments, namely that the term "Chisholm" has geographic and historic significance, and, therefore, it is not primarily merely a surname; and that, even assuming *arguendo* that "Chisholm" has surname significance, the addition of the term "Administrative Services" takes the mark out of the category of being primarily merely a surname, and renders the mark as a whole registrable. In support of its position, applicant submitted excerpts retrieved from the Internet concerning the history of the Chisholm Trail, and a report generated by a search done at www.google.com.²

² In its response to the first Office action, applicant indicated that the response was accompanied by "attached evidence" relating to the geographic significance of "Chisholm." This evidence, however, is not in the application file, and the Examining Attorney, in the final refusal, stated that "the attachment was not found with the applicant's response." Applicant's brief is accompanied by evidence identified as Exhibit A and Exhibit B. Although Exhibit B was not previously submitted (the search done at the Google website), the Examining Attorney, in her brief (p.

The Examining Attorney maintains that the mark sought to be registered is primarily merely a surname. More specifically, the Examining Attorney argues that "Chisholm" is a surname, and that the addition of the generic designation "Administrative Services" to the surname does not detract from her view that the mark as a whole is primarily merely a surname. In support of the refusal, the Examining Attorney submitted 5,013 phone listings for "Chisholm" obtained from the PowerFinder database; excerpts from printed publications; a dictionary definition of "administrative"; and articles retrieved from the NEXIS database.

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

It is well settled that whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. The burden is upon the Examining Attorney, in the first instance, to present evidence sufficient to make out a

2, n. 2), made the following statement: "Although it is unclear whether this information was previously submitted and then misplaced by the Office, the examining attorney waives the right to object to this evidence and will consider it timely filed and part of the record." Accordingly, in reaching our decision, we have considered the evidence submitted with applicant's brief.

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prima facie showing in support of the contention that the mark is primarily merely a surname. 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. See: 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 Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994). The inclusion in a mark of a generic term does not preclude its surname significance if, when considered as a whole, the primary significance of the mark to the purchasing public is that of a surname. See: In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993); In re Woolley's Petite Suites, 18 USPQ2d 1810, 1812 (TTAB 1991); and In re E. Martinoni Co., 189 USPQ 589, 591 (TTAB 1975). See also: TMEP §1211.01(b)(vi).

With respect to the surname significance of the term "Chisholm," the Examining Attorney has made of record a printout retrieved from the PowerFinder database showing

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5,013 telephone listings for the surname "Chisholm." The Examining Attorney also introduced into the record a copy of the pertinent page from E. Smith, American Surnames (1972) at 246, which points out that "[m]any Scottish names that have become familiar American surnames are interesting and colorful, reminiscent of the honest, frugal sons of Caledonia," pointing out that "Chisholm" is taken from "Cheseholm" meaning "meadow where cheese was made." Also of record are several articles retrieved from the NEXIS database referring to individuals with the surname "Chisholm." The NEXIS search of "CHISHOLM BUT NOT TRAIL" resulted in over 25,000 hits. The Examining Attorney recognizes that the term "Chisholm" may have some geographic significance, but she contends that this significance is minor, and that this fact does not diminish the primary significance of "Chisholm" as a surname. The Examining Attorney submitted listings for "Chisholm" in Merriam-Webster's Geographical Dictionary (1997) [a city in Missouri, population 5290] and for "Chisholm Trail" ["A cattle trail leading north from near San Antonio, Texas, to Abilene, Kansas; used especially immediately after the Civil War when large herds of cattle were driven to markets in the north; fell into disuse with coming of railroads."]. The Examining Attorney also introduced the listing for

"Chisholm Trail" in The New Encyclopaedia Britannica (15th ed. 1988) which indicates, in part, that "the trail was probably named for Jesse Chisholm, a 19th-century trader." The listing indicates that "the trail's importance declined after 1871, as railheads were established, but increased again in the 1880s; the long cattle drives gradually declined as the railroads built branch lines in the late 19th century."

Applicant takes the position that the term "Chisholm" is not primarily merely a surname inasmuch as such term has significance as a "readily known" geographical and historical designation. Applicant asserts the following:

[T]he term CHISHOLM has more connected to it than just the surname aspect. The Chisholm Trail is a key to understanding the westward expansion of the United States, and the trail is a Midwestern landmark....The Chisholm Trail was the primary commercial roadway of the area for many years, later developed as Highway 81 which even today functions as a main artery for the region running north/south from Texas, across the Red River through Oklahoma and north to Kansas.

[T]he trail was in fact named for the part that Jesse Chisholm played in its development. Jesse Chisholm is an historic figure, a legendary scout and diplomat who was involved in negotiating many of the treaties between the U.S. and various Native American tribes, the development of an important trade route and the

settlement of southwest Texas....The Chisholm Trail is as important to the midsection of the country as Civil War battlefields and early settlements are to the East Coast. Jesse Chisholm spoke over a dozen Indian languages, and was famous throughout the west as a scout, guide, interpreter, trader and mediator between the Whites and Native Americans. He was the guide for the famous 1834 Dodge-Leavenworth expedition into Indian Territory to negotiate a treaty with Comanche and Kiowa tribes and played the major role in convincing the Plains Indian tribes to negotiate the famous Medicine Lodge Treaty of 1867. It is understandable that the Examiner is not familiar with Old West history, but it is inexcusable to dismiss the significance of CHISHOLM as nothing more than "a defunct cattle trail."

In short, CHISHOLM is easily recognized for its historic significance by the buying public, viewed merely as an arbitrary use of that historic name as a distinctive trademark.

In support thereof, applicant submitted a printout of its search of "Chisholm + (street OR road OR village OR lake OR town OR county OR city)" on www.google.com. The search yielded 207,000 hits. There also is a printout from www.texhoma.net regarding the historical significance of the Chisholm trail.

Although we acknowledge that the term "Chisholm" may have some geographical and/or historical significance in the context of the Chisholm Trail (or other geographic

locations) and Jesse Chisholm, we agree with the Examining Attorney that this significance is relatively minor when compared with the primary surname significance of the term "Chisholm." 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 Major Piquet, 5 USPQ2d 1367, 1367-68 (TTAB 1987). In the present case, we wonder how many consumers will even know about Jesse Chisholm and/or the Chisholm Trail; this lack of knowledge would especially prevail outside of the Texas-Oklahoma area. As pointed out by the Examining Attorney, applicant is not seeking to register the term "Chisholm Trail Administrative Services." Further, the fact that there are a number of streets, villages, lakes, etc. throughout the country which bear the name "Chisholm" is not persuasive of a different result. As evidenced by the lack of listings in the geographical dictionary, the locations would appear to be minor, and largely unknown to the general population.³

³ 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 "Chisholm" and any geographical and/or historical significance. Cf.: In re Colt Industries Operating Corp., 195 USPQ 75 (TTAB 1978). The fact that "Chisholm" has been shown to have some minor significance as a geographical/historical term does not dissipate its primary significance as a surname. See, e.g., In re Possis Medical, Inc., 230 USPQ 72, 73 (TTAB 1988); and In re Picone, 221 USPQ 93, 95 (TTAB 1984). The record reflects that it is the surname significance of "Chisholm" which is far more common and which predominates.⁴

In sum, in view of the fact that "Chisholm" is a fairly common surname (certainly not rare), and that the other meanings proposed by applicant are relatively minor, we find that the term "Chisholm" is primarily merely a surname under Section 2(e)(4).

In the present case, we must consider, of course, the mark as a whole. Having determined that the term

⁴ As discussed in In re Pickett Hotel Co., 229 USPQ 760, 761-62 (TTAB 1986), "[t]he decisions concerning historical names draw a line between names which are so widely recognized that they are almost exclusively associated with the historical figures...and names which are semihistorical in character." Here, the record fails to establish that "Chisholm" is exclusively associated with the historical figure Jesse Chisholm. Cf.: In re Pyro-Spectaculars Inc., 63 USPQ2d 2022 (TTAB 2002).

"Chisholm" is primarily merely a surname, we direct our attention to the fact that this surname has been combined with the term "Administrative Services." Thus, the ultimate issue in this case is whether the entire mark sought to be registered, CHISHOLM ADMINISTRATIVE SERVICES, is primarily merely a surname.

Applicant, on the one hand, argues that the term "administrative services" is too vague to give any concrete idea of what types of services applicant offers, and that, therefore, the term is not generic. In the original application, applicant proffered a disclaimer of the words "Administrative Services," and states that its mark is registrable with said disclaimer. Thus, applicant contends, its addition to "Chisholm" removes the mark, when considered as a whole, from the primarily merely a surname category, citing to *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1985) [HUTCHINSON TECHNOLOGY not primarily merely a surname because "technology" is not merely descriptive as being too vague for electronic goods]. On the other hand, the Examining Attorney contends that the term "administrative services" is generic and that, accordingly, the combination of this term with the surname "Chisholm" results in a mark which, as a whole, is primarily merely a surname.

As indicated earlier, the Board has held in the past that a surname, when combined with a generic term, is still primarily merely a surname. In re Hamilton Pharmaceuticals Ltd., supra. In the present case, we find that the term "Administrative Services," as used in connection with applicant's services, is generic.

The term "administrative" is defined as "concerning or relating to the management of affairs." The Oxford Dictionary and Thesaurus (American ed. 1996). The term "affairs" means, in pertinent part, "business transactions." Webster's II New College Dictionary (1995).⁵ The Examining Attorney also submitted excerpts of articles retrieved from the NEXIS database showing the usage of the term "administrative services" in the medical insurance claims and benefits field:

Olympic Health Management Systems, a 20,000-member health plan in Bellingham, WA, and Medicare administrative services provider for a number of national insurers, has become Synertech's newest ASP customer and its first focused exclusively on the Medicare niche.
(*Health Management Technology*, January 2003)

Medical management firm: Also called an MSO, or medical services

⁵ The Examining Attorney's request in her brief to take judicial notice of these definitions is granted. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

organization. These companies provide mostly administrative services, such as billing and claims payment, for providers. They often act as the contract middleman between health plans and providers.

(The Orange County Register, November 7, 1999)

Resource Management, which provides administrative services such as payroll, benefits, human resources and risk management....

(The Salt Lake Tribune, January 32, 2003)

HumanaOne members will have access to a secure Web page with personalized health insurance information, including benefit details, claims information and health reference

materials....Administrative services--application and claims processing--will be done at offices in Madison and De Pere.

(Green Bay Press-Gazette, January 22, 2003)

However, Mr. Tighe ruled out keeping Blue Cross as an administrative services organization, which would process claims while the state assumes the risk.

(Chattanooga Times/Chattanooga Free Press, January 25, 2000)

Based on the evidence of record, we find that the term "administrative Services" is generic when used in connection with applicant's "insurance services, namely Medicare program administration, and benefits administration." The term "administrative services" names

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a type or category of services in the medical insurance claims and benefits field, and the primary significance of the term to those in the field would be as such. See: In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Given the generic nature of the term, we find that the addition of "Administrative Services" to the surname "Chisholm" does not remove the mark from being a surname. Thus, we conclude that CHISHOLM ADMINISTRATIVE SERVICES is primarily merely a surname under Section 2(e)(4) of the Trademark Act.

Decision: The refusal to register is affirmed.