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Oral Hearing:
26 July 2005

Mailed:
26 October 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Reebok International Limited.

Serial No. 78271326

Edward M. Prince of Alston & Bird LLP for Reebok
International Limited.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Holtzman, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 8, 2003, Reebok International Limited
(applicant) applied to register on the Principal Register
the mark J.W. FOSTER, in typed or standard character form,
for:

Footwear, headwear and clothing, namely, sportswear,
sweatpants, sweatshirts, shirts, shorts, sweaters,
slacks, socks, jackets, sweatsuits, jumpsuits, warm-up
suits, shooting shirts, fleece tops, tank tops, polo
shirts, pants, athletic bras, leggings, rainsuits,
turtlenecks, bathing suits, vests, parkas, dresses,
athletic uniforms, gloves, wrist bands, thermal
underwear, infantwear, coveralls, and running suits

in Class 25.¹

The examining attorney refused to register applicant's mark 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).

After the examining attorney made the refusal final, applicant filed a notice of appeal. Applicant and the examining attorney filed briefs and an oral hearing was held on July 26, 2005.

We reverse.

In cases involving the question of whether a term is primarily merely a surname, our case law sets out the following factors to consider:

- (i) whether the surname is rare;
- (ii) whether anyone connected with applicant has the involved term as a surname;
- (iii) whether the term has any other recognized meaning; and
- (iv) whether the term has the "look and feel" of a surname.

In re United Distillers plc, 56 USPQ2d 1220, 1221 (TTAB 2000).

¹ Serial No. 78271326. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce.

In this case, applicant's mark is not shown in stylized form or as part of a design mark. If there was an element of stylization, we would have considered that as a fifth factor. In re Benthin Management GmbH, 37 USPQ2d 1332, 1334 (TTAB 1995) ("Applicant does not seek to register BENTHIN per se. Rather, applicant seeks to register BENTHIN and design in a highly stylized form... [I]f the stylization were distinctive enough, this would cause the mark not to be perceived as primarily merely a surname"). Applicant has not presented evidence that its mark is used in a distinctive style and it certainly has not indicated that it is claiming any stylization as a feature of the mark in its drawing. Therefore, this factor is not relevant in this case.

We begin by quickly disposing of the first two factors. First, the examining attorney has submitted evidence that "Foster" is not a rare surname in the United States. Over 100,000 listings for the last name Foster were found in the LEXIS-NEXIS Finder database. Therefore, "Foster" could not be considered a rare surname. Second, applicant has submitted evidence to show that "Joseph William Foster and his older brother, Jeffrey William, founded Reebok in November 1958." See Amendment dated July 19, 2004 ("Inner View" attachment). Therefore, both of

applicant's founders were "J.W. Foster" and they obviously had the same surname "Foster." Thus, the resolution of the first two factors favors the examining attorney's position.

Regarding the third factor (whether the term has any recognized meaning), we cannot overlook the fact that "foster" is a common word in the English language. The term is defined as:

1. to promote the growth or development of; further:
to foster new ideas.
2. to bring up, raise, or rear, as a foster child.
3. to care for or cherish.

The Random House Dictionary of the English Language

(*unabridged*) (2d ed. 1987).² Interestingly, the same

dictionary also defines "Foster" as "a male given name."

Another dictionary defines "foster" as:

1. To bring up; nurture: *foster a child.*
 2. To promote the development or growth of; cultivate:
The teacher fostered the students' interest in writing.
- adj.* - Giving or receiving parental care or nurture to or from those not legally related: *a foster child; a foster parent.*

The American Heritage Student Dictionary (1998).

The fact that "foster" has a well-recognized, non-surname meaning in English is a factor that seriously

² We take judicial notice of this and the subsequent dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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undercuts the argument that the term is primarily merely a surname.

We also do not find that the last factor, whether the term, has the look and feel of a surname, strongly favors either applicant or the examining attorney. The term Foster has both a surname and non-surname significance in the United States.

When a term has a non-surname meaning in the United States that is not obscure, we have frequently found that the term was not primarily merely a surname. Fisher Radio Corp. v. Bird Electronic Corp., 162 USPQ 265, 267 (TTAB 1969) (BIRD not primarily merely a surname); In re Monotype Corp., 14 USPQ2d 1070, 1071 (TTAB 1989) (CALISTO, a variant spelling of the Greek mythological nymph "Callisto" held to not be primarily merely a surname); United Distillers, 56 USPQ2d at 1221 (HACKLER not primarily merely a surname. Dictionary definition of "Hackler" as "one that hackles; esp.: a worker who hackles hemp, flax or broomcorn" considered); In re Isabella Fiore LLC, 75 USPQ2d 1564, 1570 (TTAB 2005) (FIORE, the Italian word for "Flower," not primarily merely a surname).

However, if the non-surname meaning of the term is obscure or derived from the surname, the term remains primarily merely a surname. Harris-Intertype, 186 USPQ

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239-240 (CCPA was "persuaded that such uses [of Harris] are either 'somewhat obscure,' as described by the board, or represent 'the normal naming of a place or other item after an individual,' as pointed out by the examiner, or both"); In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1368 (TTAB 1987) ("With regard to the dictionary meaning cited, the name of a relatively obscure card game is unlikely to be known to purchasers and is certainly not the ordinary meaning of the term"); In re Gregory, 70 USPQ2d 1792, 1796 (TTAB 2004) (ROGAN primarily merely a surname despite "some obscure association with minor localities and Indian food").

In this case, the term "Foster" is a term that has a common language meaning in the United States and it is also used as a surname. As such a term, we cannot hold that "Foster," by itself, is primarily merely a surname. Ex parte Gemex Co., 111 USPQ 443, 443 (Comm'r Pat. 1956) ("'WELLINGTON' is a surname; it is a geographical name, being the national capital of New Zealand and the name of a number of towns in the United States; it is a baptismal name; and it is the name of one of Great Britain's most important dukedoms. There is no way of knowing what the impact on the purchasing public is likely to be upon seeing

"WELLINGTON" watch bracelets and straps, or with what, if anything, purchasers are likely to associate the mark").

However, we must consider the mark as a whole and determine whether the addition of the letters "J.W." to "Foster" results in a mark that is primarily merely a surname. It "is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname." In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975), quoting, Ex parte Rivera Watch Corp., 106 USPQ 145 (Comm'r 1955) (emphasis in original).

Both applicant and the examining attorney discuss the case of Sears, Roebuck and Co. v. Watson, 204 F.2d 32, 96 USPQ 360, 362 (D.C. Cir. 1953). The examining attorney refers to it as a controlling case and relies on it to support her argument for affirmance. Brief at 5. Applicant, on the other hand, argues that "if the Sears case is not overruled,³ it should be distinguished along the lines" of the Michael S. Sachs, Inc. v. Cordon Art B.V. case (56 USPQ2d 1132 (TTAB 2000)). Brief at 13. However,

³ Applicant acknowledged at oral argument that the board cannot overrule precedent of the U.S. Courts of Appeals.

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when we apply the principles set out in Sears, Roebuck and other cases, it is clear that applicant's mark is not primarily merely a surname.

In surname cases, it has long been held that if "the mark has well known meanings as a word in the language and the purchasing public, upon seeing it on the goods, may not attribute surname significance to it, it is not primarily a surname. 'King,' Cotton,' and 'Boatman' fall in this category." Rivera Watch Corp., 106 USPQ at 149. See also Sears, Roebuck and Co. v. Watson, 204 F.2d 32, 96 USPQ 360, 362 (D.C. Cir. 1953) (The "word 'primarily' was added, undoubtedly to avoid exclusion from registration of a word which was primarily not a surname but which could be found as the name of an individual").

In addition, the CCPA has explained that the focus is on the term alleged to be a surname. "It seems to us that "Seidenberg" is clearly a surname which can have no other meaning or significance than that of a surname. Nor do we believe that the addition of the single initial is sufficient to remove it from that category." In re I. Lewis Cigar Mfg. Co., 205 F.2d 204, 98 USPQ 265, 267 (CCPA 1953). See also Sears, Roebuck, 96 USPQ at 362 ("'Higgins,' without the initials, is thus primarily a surname"). The board in In re J. Taverniti, SARL, 225 USPQ

1263, 1264 (TTAB 1985) (emphasis added) summarized these cases as follows:

Further, both the Court of Appeals for the District of Columbia and our reviewing court, the Court of Customs and Patent Appeals (now merged into the Court of Appeals for the Federal Circuit), have held that *the addition of initials to a term which is primarily merely a surname* cannot serve to remove the term from the category.

Finally, the Federal Circuit, when it affirmed a surname refusal, used similar language to describe when a word can be properly refused registration under this section. "Even though a mark may have been adopted because it is the surname of one connected with the business, it may not be primarily merely a surname under the statute because it is also a word having ordinary language meaning." In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). In that case, however, applicant "submitted no evidence that the expression DARTY has any non-surname significance." Id.

Thus, the purpose of the surname refusal under Section 2(e)(4) is not to prevent trademark owners from appropriating ordinary language words that also happen to be surnames. Rather the surname refusal prevents the registration of words that are primarily only a surname from registration without a claim of acquired distinctiveness. In other words, terms that are not

primarily only or merely a surname do not become surnames simply because they are combined with initials. Otherwise, many common words such as "King," "Cotton," and "Boatman" would then become surnames if the trademark owner included an initial before the word and the examining attorney submitted evidence that individuals have this word as a surname. Clearly, the Lewis Cigar analysis begins with "a surname that can have no other meaning or significance," before concluding that the addition of an initial would not change the result. In the present case, we have the flip side of the coin presented in Lewis Cigar and Sears, Roebuck, i.e., "Foster" is not a term that has no other significance. Quite simply, it has other significant, non-surname meanings. These meanings are not obscure nor are they meanings that are derived from the surname.

Therefore, when we consider the term as a whole, we cannot hold that FOSTER is primarily merely a surname, and adding the letters "J.W." to it does not change it into a surname.

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

Dissenting opinion, Holtzman.

I respectfully dissent. If applicant were seeking registration of FOSTER alone, it is clear that registration would not be prohibited under Section 2(e)(4) of the Trademark Act because the term "FOSTER" has other significant meanings. However, FOSTER is not the mark at issue here. Applicant is seeking to register J.W. FOSTER. And, in that context, FOSTER does not have another meaning; it would be perceived only as a surname.

It is a fundamental principle of trademark law that marks must be considered in their entirety. The question is always what the purchasing public would think when confronted with the mark as a whole. See *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). As stated by Assistant Commissioner Leeds in *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pat. 1955):

"A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, *and it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance.*" (Emphasis added.)

See also *In re Hutchinson Technology Inc.*, supra at 1492 (Fed. Cir. 1988) ("The test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public"). The majority has disregarded this principle in its analysis of

the mark. The majority has evaluated only one of the two components that form this mark and, based on its findings as to that one component, concluded that J.W. FOSTER is not primarily merely a surname.

The majority relied on the four factors enumerated in *In re United Distillers plc*, 56 USPQ 1220 (TTAB 2000) to evaluate the meaning and likely perception of the term FOSTER. Applying those factors, the majority found that FOSTER, while a common surname, also has significant dictionary meanings, such as, "to bring up, raise or rear, as a foster child," or "to cultivate," as an interest in a particular subject. The majority determined that as a result of these other meanings, the term FOSTER is not primarily merely a surname.

But that is where the analysis ended. The majority then simply concluded that because FOSTER, itself, is not primarily merely a surname, adding initials to FOSTER does not change it into a surname. This analysis clearly does not take into account the effect of the initials added to FOSTER or the impact of the combination on the purchasing public. The Board was criticized by the Federal Circuit for just such an analysis in *Hutchinson Technology*: "[T]he fatal flaw in the board's analysis is that the mark sought to be registered is not HUTCHINSON or TECHNOLOGY, but HUTCHINSON TECHNOLOGY. The board never considered what the purchasing

public would think when confronted with the mark as a whole."

Thus, it is not sufficient to analyze the mark J.W. FOSTER on the basis of the four factors delineated in *United Distillers* alone. Those factors are useful for analyzing a mark consisting solely of a surname or for analyzing the surname component of a composite mark, as the majority has applied them here. However, the *United* factors do not take into consideration the presence of any other matter in the mark.

The Board in *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) recognized the limitations of these four factors in analyzing a composite mark. The mark in *Benthin* consisted of the surname BENTHIN and also a "design" component. After applying the factors to the BENTHIN portion of the mark, the Board stated: "Were we to stop our analysis here, we would find that the service mark BENTHIN *per se* would be perceived as primarily merely a surname..." The Board went on to point out: "Applicant does not seek to register BENTHIN *per se*. Rather, applicant seeks to register BENTHIN and design in a highly stylized form featuring, among other things, an enlarged "T" which overhangs the first "N" and "H." Recognizing that the design component may affect consumers'

perception of the mark, the Board devised a "fifth factor" to consider in evaluating the mark. This factor required an analysis of the impact of the design in determining whether the mark as a whole would be perceived as primarily merely a surname.

As in *Benthin*, in the present case, applicant is not seeking to register the surname *per se* but rather the surname with an additional component, in this case, the two initials preceding the term FOSTER. Obviously this mark contains no stylization or design elements, as the majority points out. But because there is another component in the mark to consider, the principle of *Benthin* is equally applicable here. Whether such additional matter consists of a design (as in *Benthin*), initials (N. PIQUET), a courtesy title (MLLE. REVILLON), a company designation (S. SEIDENBERG & CO.'S), or another word element (HUTCHINSON TECHNOLOGY),⁴ the surname itself, along with the additional matter, must be considered in determining whether the mark as a whole would be perceived as primarily merely a surname under Section 2(e)(4) of the Act.

⁴ Respectively, *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985); *In re Revillon*, 154 USPQ 494 (TTAB 1967); *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (CCPA 1953); and *In re Hutchinson Technology Inc.*, *supra*.

The question here is the effect of the addition of the initials J.W. to the word FOSTER. It has been held that the addition of initials to a surname reinforces the surname significance of the term. See *In re Nelson Souto Major Piquet*, supra (N. PIQUET primarily merely a surname; using first name initial followed by a surname reinforces the surname significance of the term PIQUET); *In re Protek AG*, 229 USPQ 1018, 1020 (TTAB 1986) ("the letters 'M.E.' would be perceived as initials preceding the surname [MULLER]"); and *In re Taverniti, SARL*, supra (finding J. TAVERNITI primarily merely a surname and noting in particular "the inclusion in applicant's mark of the first initial 'J.'"). See also *Sears, Roebuck and Co. v. Watson*, 204 F.2d 32, 96 USPQ 360 (CA DC 1953) (J C HIGGINS primarily merely a surname); and *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (CCPA 1953) (S. SEIDENBERG & CO.'S primarily merely a surname).

As the majority correctly notes, FOSTER is a common surname and also an ordinary dictionary word. Combine the initials J.W. with FOSTER, however, and the surname meaning becomes its primary meaning. The ordinary dictionary meaning of FOSTER would be lost on purchasers in the context of the mark as a whole.

Further, the surname meaning would be the only meaning the purchasing public would associate with J.W. FOSTER in

relation to the identified goods.⁵ It is clear that J.W. FOSTER would not be perceived in the context of applicant's footwear and apparel items as connoting a foster child, or as having any of the other ordinary language meanings the majority ascribes to the mark. While the majority's position might be more persuasive if applicant were seeking registration of J.W. FOSTER for foster care services or some other goods or services relating to the ordinary language meanings of "foster," it is not believable that purchasers would think of any of those dictionary meanings when they view the mark on applicant's shoes and coveralls. Rather, when viewed in the context of the mark as a whole, and in relation to the identified goods, FOSTER, preceded by the initials J.W., would be perceived by the purchasing public as nothing more than a surname.

For the reasons set forth above, I would affirm the refusal to register.

⁵ As we know, this mark would not, under existing case law, be considered a person's entire name. See *Sears, Roebuck and Co. v. Watson*, supra; and compare *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000).