

**THIS OPINION  
IS NOT  
A PRECEDENT OF  
THE TTAB**

Hearing:  
15 November 2006

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1 February 2007  
AD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Tommy Bahama Group, Inc.

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Serial No. 78482456

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Edward M. Prince of Alston & Bird LLP for Tommy Bahama Group, Inc.

Geoffrey Fosdick, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

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Before Hairston, Bucher, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 13, 2004, Tommy Bahama Group, Inc. (applicant) applied to register the mark CAMPOLO, in standard character form, on the Principal Register for "men's shirts" in Class 25. Serial No. 78482456. The intent to use application was subsequently amended to contain an allegation of dates of first use anywhere and in commerce of January 2005.

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 and denied applicant's request for reconsideration, this appeal was briefed and an oral argument was held November 15, 2006.<sup>1</sup>

The only issue in this appeal is whether applicant's mark "is primarily merely a surname." 15 U.S.C. § 1052(e)(4). When we are faced with this type of refusal, consideration must be given to the impact a term has or would have on the purchasing public because "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). In the Harris-Intertype case, the term HARRIS was held to be primarily merely a surname despite the evidence that HARRIS also had

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<sup>1</sup> Applicant also filed a paper entitled "Alternative Amendment to Supplemental Register" that sought (page 1) registration on the Supplemental Register if "applicant's concurrently filed appeal [is] unsuccessful."

numerous secondary geographic meanings and that it was also a common English given name. Id. at 239-240 (The CCPA pointed out that these names were either obscure or related to a named individual or the surname, HARRIS).

We normally look to four factors in our surname analysis.

1. Whether the surname is rare;
2. Whether anyone connected with applicant has the involved term as a surname;
3. Whether the term has any other recognized meaning; and
4. Whether the term has the "look and feel" of a surname?.

In re United Distillers plc, 56 USPQ2d 1220, 1221 (TTAB 2000).<sup>2</sup> See also In re Gregory, 70 USPQ2d 1792, 1794 (TTAB 2004).

The examining attorney must present evidence to show that a mark is primarily merely a surname. In re Raivico, 9 USPQ2d 2006, 2007 (TTAB 1988) ("[T]here is no evidence whatsoever showing that DE TAVERNAY or TAVERNAY are actually being used as surnames. Indeed, given the fact that there is not even one single listing for DE TAVERNAY

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<sup>2</sup> If applicant's mark included a stylization feature, we would also consider whether the stylization is "distinctive enough" to cause the mark not to be perceived as primarily merely a surname. See In re Benthin Management GmbH, 37 USPQ2d 1332, 1334 (TTAB 1995).

in the telephone directories of Manhattan, Los Angeles, New Orleans, Baton Rouge, Denver and six other major cities, it would appear that DE TAVERNAY is not being used as a surname"). In this case, the examining attorney submitted the following evidence to support the surname refusal.

1. A page from Microsoft Bookshelf Basics that did not reveal any entries for the term "Campolo" in *The American Heritage Dictionary*, *The Original Roget's Thesaurus*, or *The Columbia Dictionary of Quotations*.

2. A page from *WhitePages.com* showing that there were 99 entries for the name Campolo. The examining attorney attached examples of these entries that revealed "Campolos" in New Jersey, New York, Connecticut, Ohio, Illinois, and Florida.

3. A page from the *namestatistics.com* database that indicated that: "Around 1250 US last names are Campolo."

4. A page from *Ancestry.com* that included a search for Campolo that revealed more than 2000 entries.

5. An Internet search revealed the names of Carmen Campolo, a Hollywood special effects technician, whose screen credits include *The Stepford Wives* (2004), *Unfaithful* (2002), *Double Whammy* (2001), *One True Thing* (1998), and *Great Expectations* (1998).

6. Even more significantly, a Google Internet search showed that there were 306,000 hits for "Tony Campolo" aka Anthony Campolo. An attached website describes Tony Campolo and his association (The Evangelical Association for the Promotion of Education (EAPE))<sup>3</sup> as follows:

For more that 30 Years we have been committed to what God is doing through Christian people in inner-city America and around the world. Join us, because as Tony says... "It's Friday But, Sunday's Coming!"

Featured EAPE Ministry  
Urban Promise

Urban Promise is headquartered in Camden, NJ, and reaches hundreds of children and teenagers through a variety of daily activities that include Bible Study, evangelism, tutoring, sports, music and drama.

Other entries indicate that Tony Campolo is: an "Eastern College Sociology professor. Tony Campolo, President of EAPE, has authored 30 books," [www.tonycampolo.com](http://www.tonycampolo.com), and "a ferocious critic of Christians left and right." [www.christianitytoday.com](http://www.christianitytoday.com).

7. A Lexis/Nexis search revealed 536 stories for various people name Campolo.

We look at this evidence to determine if the examining attorney has established a prima facie case that the term is primarily merely a surname. The first factor we

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<sup>3</sup> The website also contained the following information under "News and Updates": "03.02.06 - Tony Campolo's appearance on Comedy Central's The Colbert Report."

consider is whether the term is a rare surname. We note that there are 99 entries for Campolo in the telephone directory and more than one thousand entries in the www.namestatistics.com and Ancestry.com databases. While the evidence shows that "Campolo" is not a common surname, it is not a very rare surname. More importantly, we must consider evidence of how the name would be encountered as a surname in the United States.

In the case at hand, the record reveals that the (now former) Director of the United States Patent and Trademark Office is James Rogan. Moreover, the record reveals that Mr. Rogan was the majority leader of the California State Assembly before being elected to represent a U.S. House district in Southern California; that he received press attention for his role as an impeachment manager during the impeachment trial of former President Clinton; and that he subsequently received additional press attention for his role as a candidate for re-election in what was reported to be, at that time, the most expensive race ever for a seat in the U.S. House of Representatives. In addition, the record reveals that a Salt Lake City councilman is named Tom Rogan. We think it is fair to conclude that large numbers of individuals in the Southern California and Salt Lake City areas would be exposed to the names of these elected officials, whether during an election campaign, in a polling place, or in news reports on government activities.

Gregory, 70 USPQ2d at 1795. The "existence of these individuals with the surname ROGAN leads us to conclude that the name may be rare when viewed in terms of frequency of use as a surname in the general population, but not at all rare when viewed as a name repeated in the media and in

terms of public perception. Accordingly, we conclude that ROGAN is not a rare surname." Id.

Here, the evidence shows that Tony Campolo is a theologian, a prolific author, and a minister with a national organization. See, e.g., The Ledger (Lakeland, FL), October 23, 2004 ("Notable evangelical writers Tony Campolo and Philip Yancey"); Arkansas Democrat-Gazette, July 5, 2003 ("Tony Campolo left no toe unstomped and threw in a couple of verbal right hooks..."); and Atlanta Constitution, September 2, 2003 ("The article was not written by Episcopalians but by Tony and Peggy Campolo"). The examining attorney's evidence convinces us that the term CAMPOLO would ultimately not be considered a rare surname. We add that even if it is considered somewhat rare, it would not mean that it was not primarily merely a surname. In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988) ("Applicant's evidence proves that 'Pirelli' is a rare surname but fails to rebut the Examining Attorney's prima facie showing that 'Pirelli' would be viewed as a surname by the relevant public"). See also In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); Gregory, 70 USPQ2d at 1795; and In re E. Martinoni Co., 189 USPQ 589, 590 (TTAB 1975).

The second factor we consider is whether anyone associated with applicant has the surname "Campolo." The examining attorney has presented no evidence on this factor and applicant has indicated that "there is no person associated with the applicant having Campolo as a surname." Easton declaration at 1.

Third, we look to see if there is any evidence to indicate that the name has another recognized meaning. In this case, the examining attorney has submitted evidence that there is no recognized meaning for the name Campolo.

The last relevant factor we must consider is whether the term has the "look and feel" of a surname. The examining attorney's evidence concerning the rareness of the surname also supports the examining attorney's argument that Campolo has the "look and feel" of a surname. First, there are numerous individuals with the surname "Campolo." Second, the author and minister, Tony Campolo, has received significant exposure as a public figure. Third, the examining attorney's evidence indicates that there is no other recognized meaning for the term.

At this point, we must conclude that the examining attorney has made out a prima facie case that the term CAMPOLO is primarily merely a surname. Once the examining attorney has made out a prima facie case, we look to

applicant's evidence to see if applicant has rebutted the examining attorney's prima facie case.

Applicant begins by arguing that the name CAMPOLO is a very rare surname. Applicant points out that Campolo ranks 44,336 in surname frequency. However, the board has noted that: "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."

Gregory, 70 USPQ2d at 1795. As previously discussed, the sheer number of listings in a phone database is not conclusive in determining whether a surname is rare.

Another issue to be considered, in assessing how rarely is a name used, is the media attention or publicity accorded public personalities with the name. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, articles and the like, so as to be broadly exposed to the general public.

Id.

Here, the evidence shows that the name Campolo is commonly associated with Tony Campolo, the minister, and this evidence reinforces the conclusion that the term CAMPOLO is not a rare surname.

We have already acknowledged that there is no one associated with applicant that has the surname CAMPOLO, however, "that a proposed mark is not the applicant's surname, or the surname of an officer or employee, does not

tend to establish one way or the other whether the proposed mark would be perceived as a surname." Id.

Applicant's most significant argument concerns whether applicant's mark has any other meaning. Applicant argues (Brief at 7) that its "shirt is a variation between a camp shirt and a polo shirt. Thus, applicant has adopted the suggestive mark CAMPOLO as a telescoped word derived from 'camp' and 'polo.'" Applicant has included evidence that there is a type of shirt known as a camp shirt. See Request for Reconsideration, Ex. A ("Camp Shirt Bonanza" and "Cherokee Boy Olive Camp Shirt and Short Canvas Set"). There are also shirts known as polo shirts. Request for Reconsideration, Ex. B. Applicant's goods are "styled after the Tommy Bahama campshirt but in a knit for a more relaxed feel." Request for Reconsideration, Ex. C.

When we consider this evidence and argument, we are not persuaded that the term CAMPOLO is not primarily merely a surname. First, applicant's identification of goods reads simply "men's shirts" so nothing would prevent applicant from using its mark on T-Shirts, dress shirts, flannel shirts, and other non-combination camp and polo shirts. Clearly, even with applicant's argument, there would be no non-surname significance for the term CAMPOLO on these types of shirts. Second, applicant's mark is

CAMPOLO and not CAMP POLO or even CAMPPOLO. The board has held that the mark PICKETT SUITE HOTEL was still a surname despite that fact that it is phonetic equivalent of the common term "Pickett."

To accept appellant's argument would automatically excuse from the proscription of Section 2(e)(3) [now 2(e)(4)] all surnames that sound like words having other ordinary meanings, a result which would emasculate the purpose of the statute to preclude registration of signs which are primarily merely surnames, except where secondary meaning has been established, in the interest of preserving as far as is reasonable the personal rights in names which identify particular individuals.

In re Pickett Hotel Company, 229 USPQ 760, 761 (TTAB 1986).<sup>4</sup>

See also In re Woolley's Petite Suites, 18 USPQ2d 1810, 1812 (TTAB 1991) ("Nor are WOOLLEY'S and "wooly" interchangeable words").

In this case, the terms CAMPOLO or even CAMPPOLO do not exist as recognized terms to describe a type of shirt. Even if the terms "Camp Polo" or "Camppolo" might refer to a type of shirt, we could not conclude that these terms would be interchangeable with the name CAMPOLO. Therefore, it is even less likely that prospective purchasers would conclude that applicant has invented a new word for its shirts. Applicant's own advertisement does not make the

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<sup>4</sup> We note that the "Tony Campolo/EAPE website has a link for: "Store."

connection between a camp shirt and a polo shirt. Request for Reconsideration, Ex. C. Therefore, the term CAMPOLO does not have any other recognized meaning that would detract from the surname significance of the term.

Applicant also argues that the mark does not have the "look and feel" of a trademark because the word "polo" "creates a suggestive mark for a shirt." Brief at 8. In applicant's mark, the term "polo" is buried in the term CAMPOLO. However, it is not clear why potential purchasers would dissect the mark and remove the "polo" part of the mark and conclude that the term is not a surname. The mere fact that a surname can include part of a common word that may have some significance to the goods or services does not mean that the term is not primarily merely a surname. In re Petrin Corp., 231 USPQ 902, 904 (TTAB 1986) ("We have carefully considered applicant's claim that PETRIN is actually derived from and represents an abbreviated contraction of 'petroleum' and 'insulation.' This is legitimate evidence as to perceptions of nonsurname significance but we are not persuaded that such perceptions would actually result or would displace the primary surname import of the mark") (parenthetical omitted). However, if the evidence of surname significance is weak and there is a direct connection between a part of a surname and the goods

or services, our case law has recognized that this fact may show that the term is not primarily merely a surname. In re BDH Two Inc., 26 USPQ2d 1556, 1558 (TTAB 1993) ("The telephone directory listings [21 entries] do show individuals with 'Grainger' as a surname, but that surname significance is apt to lose out to the suggestive significance of GRAINGERS when that term is used in connection with grain-based products"). Unlike the BDH case, the evidence of surname significance is not weak and the buried term "polo" is unlikely to distract from the surname significance of the mark. See Gregory, 70 USPQ2d at 1796 ("We conclude that ROGAN has the look and sound of a surname. It would not be perceived as an initialism or acronym, and does not have the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix. Rather, ROGAN appears to be a cohesive term with no meaning other than as a surname") (footnote omitted).

After considering all the record, we conclude that applicant has not rebutted the examining attorney's prima facie case that the term CAMPOLO is primarily merely a surname.

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

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is affirmed. In view of applicant's alternative amendment to the Supplemental Register, the application will be forwarded to the examining attorney for further processing to accommodate applicant's request.