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*Decision Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Max Rohr, Inc.

Serial No. 78764755

Charles W. Grimes and Jessica S. Rutherford of Smith, Grimes & Battersby LLP for Max Rohr, Inc.

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(Andrew Lawrence, Managing Attorney).

Before Hohein, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Max Rohr, Inc. has filed an application to register on the Principal Register in standard character form the mark "KAUFFMAN" for "cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco" in International Class 34.¹

Registration has been finally refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), on the

¹ Ser. No. 78764755, filed on December 1, 2005, which is based on an allegation of a bona fide intention to use such mark in commerce.

ground that the mark which applicant seeks to register is primarily merely a surname.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

As an appropriate starting point for analysis, we observe that as stated by the Board in *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993):

At the outset, 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 prima facie showing in support of the contention that a particular 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) and *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975). Whether a term sought to be registered is primarily merely a surname within the meaning of ... the Trademark Act must necessarily be resolved on a case by case basis and, as is the situation with any question of fact, no precedential value can be given to the amount of evidence apparently accepted in a prior proceeding. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

Moreover, as set forth by the Board in *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000):

Among the factors to be considered in determining whether a term is primarily merely a surname are the following: (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. See *In re Benthin Management GmbH*, 37 USPQ2d 1332[, 1333] (TTAB 1995).²

In the present case, we agree with the Examining Attorney that, contrary to applicant's contentions in its initial and reply briefs, the record contains sufficient evidence to make a prima facie case that the primary significance of the mark "KAUFFMAN" to the purchasing public for applicant's goods is that of a surname. Specifically, in order to establish the surname significance of the term "KAUFFMAN," the Examining Attorney in his brief relies upon in the following evidence which is of record in support of the refusal to register: (i) the results of a person locator search on January 18, 2007 of the "LexisNexis" database, using the search request "LAST-NAME (!N%KAUFFMAN)" to search the "P-FIND" file in the "FINDER" library, which found a total of 9,480 listings of individuals with the surname "KAUFFMAN" in the United States, with the first 100 of such results printed out in detail; (ii) an excerpt from the "lookwayup.com" website, located on or about January 18, 2007, which defines "Kauffman" as meaning "[l]ast name, frequency rank in the U.S. is 1732"; (iii) the results of a person locator search on June 5, 2006 of the Internet, using the "LYCOS" search engine to search for "White Pages" listings of "People" with the "Last Name: KAUFFMAN," which found a total of 8,328 listings of individuals with the surname "KAUFFMAN" in the United States,

² A fifth factor, which concerns whether a mark is in a stylized form distinctive enough to create a separate non-surname impression, is not present herein inasmuch as applicant seeks to register its mark in standard character form. See *In re Benthin Management GmbH*, supra at 1333-34.

with the first 130 of such results displayed in full;³ (iv) the results of a search on June 5, 2006, and repeated on or about January 18, 2007, of the "RhymeZone" website,⁴ using a search of "Word: Kauffman" to "Find definition" thereof, which retrieved

³ Applicant, in its reply brief, faults the Examining Attorney for having "attached only 100 listings from the LexisNexis® database and only 110 [sic] listings from the [LYCOS] PeopleSearch database" as part of the evidentiary record. However, as set forth in TMEP Section 710.01(a) (5th ed. 2007):

When evidence is obtained from a research database, the examining attorney does not have to make all stories of record. It is sufficient to include only a portion of the search results, as long as that portion is a representative sample of what the entire search revealed. *In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068, 1069 n.2 (TTAB 1992). See also *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

Here, it appears that representative samples were made of record by including, respectively, the first 100 and first 130 results obtained. While applicant, in its reply brief, also criticizes such evidence because two entries "in the [LYCOS] PeopleSearch database appear to be two listings for the same person" and, likewise, seven pairs of entries "from the LexisNexis® database appear to be for the same persons," some minor duplication of entries is to be expected in virtually any data compilation. Moreover, and aside from applicant's unexplained mathematical calculations (for us, 9,480 entries less seven pairs of duplicate names leaves 9,466 listings from the LexisNexis database and 8,328 entries minus two duplicate names equals 8,326 listings in the LYCOS "PeopleSearch" database), we find that even allowing for some duplication, applicant's further assertion in its reply brief (as set forth below) that there are "significantly fewer" discrete listings in each database than the results found simply is highly speculative and does not cast doubt as to the probative value of such evidence:

Given that the remaining 9,380 and 8,318 listings from the respective databases are likely to contain similarly duplicative listings, it is unclear from the Examining Attorney's evidence exactly how many discrete listings exist for people with the surname "KAUFFMAN." If any conclusion can be drawn from the Examining Attorney's partial evidence, it is that the actual number of discrete individuals with the surname "KAUFFMAN" is significantly fewer than the number of total results found in either the LexisNexis® or [LYCOS] PeopleSearch databases.

⁴ As shown by the screenprint thereof, such website invites users to "[t]ype in a word ... to find its rhymes, synonyms, definitions, and more."

as "Definitions of *Kauffman*:" only the following: "name: A surname (common: 1 in 14285 families; popularity rank in the U.S.: #1732)"; and (v) the results of a search on or about January 18, 2007 of Merriam-Webster's Online Dictionary, which for the word "Kauffman" stated that "[t]he word you've entered isn't in the dictionary."

Applicant argues in its initial brief that the evidence of record with respect to the term "KAUFFMAN" "confirms that the term's use as a surname is exceedingly rare" and that, "[a]ccordingly, the purchasing public is unlikely to consider the term's surname significance to be its primary significance." We agree with the Examining Attorney, however, that such evidence suffices to demonstrate that the surname "KAUFFMAN" is not rare. As to applicant's assertion, among other things, that the number of individual listings located in the computerized databases is quite small in both instances, the Examining Attorney, citing *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004), correctly notes that in any comparison of "the number of listings of the surname in a computerized database with the total number of listings in that database" for all surnames, "even the most common surname would represent only a small fraction of such a database." Moreover, in this case, two other sources indicate that despite its rank of 1732 in frequency, the surname "KAUFFMAN" is not only considered common enough to be ranked, but is still regarded as being a "common" surname in the United States. Consequently, while we find that, at a minimum, the surname "KAUFFMAN" is not rare, the Examining Attorney also properly points out that even

if such surname were considered to be rare in the United States, "that fact would not per se preclude a finding that a term is primarily merely a surname" inasmuch as:

Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1986) (DARTY held primarily merely a surname); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (POSTEN held primarily merely a surname).

Applicant next faults the Examining Attorney for having "failed completely to proffer any evidence with regard to the ... factors" of whether anyone connected with applicant has the surname "KAUFFMAN" and whether such term has the "look and feel" of a surname. Although, to be sure, the Examining Attorney has the burden of ascertaining, typically pursuant to an inquiry pursuant to Trademark Rule 2.61(b),⁵ whether anyone connected with applicant organizationally or in the design, manufacture or production of its goods has the surname "KAUFFMAN," the absence on this record of any information that an officer or employee of applicant has such a surname, unlike the contrary situation, is neutral inasmuch as it does not tend to establish one way or the other whether the surname would be perceived as primarily merely a surname. See *In re Gregory*, supra.

⁵ Such rule specifies that: "The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." While applicant could, of course, have simply laid the matter to rest by indicating in either of its briefs whether anyone of significance in its corporate structure has the surname "KAUFFMAN," applicant has not done so.

As to whether the term "KAUFFMAN" has the "look and feel" of a surname, applicant contends in its initial brief that, in addition to the asserted lack of any evidence from the Examining Attorney tending to support such factor, it is obvious that there are many words in the English language that end in "-MAN" but which are not regarded as surnames. The Examining Attorney, in response, persuasively maintains, however, that:

Although it is true that there are many English words ending in "-MAN" that are not primarily, merely surnames, it is likely that these words have recognized meanings in dictionaries and/or other recognized and well accepted English language references. Where the term ending with "-MAN" does not have any recognized meaning, [including] geographic meaning, and is shown to be a surname with numerous listings nationwide, the examining attorney contends that [such] term has the "look and feel" of a surname. In the instant case, the evidence shows that the term "KAUFFMAN" has no meaning in English dictionaries, and has ... [instead numerous] listings in [two] national databases of surnames. This evidence from Merriam-Webster Online [Dictionary, LYCOS] and LEXIS-NEXIS ... supports the position that the mark has the look and feel of a surname, and rebuts applicant's contention that the examining attorney provided no evidence with respect to the "look and feel of a surname" factor in determining if the term "KAUFFMAN" is primarily, merely a surname.

Thus, while the absence of any evidence in this record as to the factor of whether anyone connected with applicant has the surname "KAUFFMAN" is neutral rather than in applicant's favor, the evidence which is properly of record herein favors a finding, as urged by the Examining Attorney, in the affirmative with respect to the factor of whether the term "KAUFFMAN" has the "look and feel" of a surname.

Finally, as to the factor of whether such term has any other recognized meaning, applicant--for the first time--contends in its initial brief that the term "KAUFFMAN" has non-surname significance which is its primary significance to the American consumer. Specifically, citing attachments to its initial brief consisting of (i) an excerpt from "Wikipedia" for the term "Kaufmann" which states, *inter alia*, that "**Kaufmann** is a surname, with many variants such as **Kauffmann**, **Kaufman**, and **Kauffman**. In German, the name means *merchant*" and lists various individuals with such surnames (emphasis in original) and (ii) a German language excerpt from an online "Deutsch-Englisch" dictionary at "<http://dict.leo.org>" which translates "Kaufmann" from the German "der Kaufmann" into English as variously meaning "dealer," "merchandiser," "merchant," "trader" and "tradesman," applicant insists that:

In light of the type of goods Applicant intends to associate with its mark, the primary significance of Applicant's KAUFFMAN mark is not a surname. Rather, the mark is most likely to be perceived by the purchasing public as a misspelling or variant of the German term "Kaufmann" meaning merchant, dealer, merchandiser, trader or tradesman. As the attached evidence demonstrates, the term KAUFFMAN is a common misspelling of the term "Kaufmann." In German, a "Kaufmann" refers to a business person, merchant or one involved in trade. In this way, the mark is suggestive of the type of person likely to purchase Applicant's cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco, namely, a business person.

The Examining Attorney, however, has objected to consideration of such evidence, requesting in his brief that the

Board "disregard the evidence submitted with and attached to Applicant's Appeal Brief ... since it was not made of record prior to appeal." Citing, *inter alia*, Trademark Rule 2.142(d) in support of his objection, the Examining Attorney maintains that "[i]t is well settled that the record in any application must be complete prior to appeal."⁶ Nonetheless, in the event that the objection is overruled, the Examining Attorney has discussed the merits of applicant's evidence and the argument presented with respect thereto. Although applicant, citing TBMP §1207.03 (2d ed. rev. 2004),⁷ contends in its reply brief that, in view thereof, such evidence should be considered to be of record because "the Examining Attorney discusses the evidence and treats it as being of record," the cited section of the TBMP plainly is not applicable in situations where, as here, the Examining Attorney has interposed an objection to the timeliness of the evidence.

We concur with the Examining Attorney that the evidence accompanying applicant's initial brief is indeed untimely and, therefore, sustain the objection to further consideration thereof. Trademark Rule 2.142(d) and TBMP §1207.03 (2d ed. rev.

⁶ Such rule, which states that "[t]he record in the application should be complete prior to the filing of an appeal," also provides in relevant part that the Board "will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed."

⁷ Specifically, such section indicates in pertinent part that: "Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record."

2004). We hasten to add, however, that even if we were to consider such evidence, it would not make any difference in the result of this appeal.

Having sustained the Examining Attorney's objection, the sole evidence which we may properly consider with respect to the factor of whether the term "KAUFFMAN" has any other recognized meaning consists of the results of a search on or about January 18, 2007 of Merriam-Webster's Online Dictionary, which stated for the word "Kauffman" that "[t]he word you've entered isn't in the dictionary." Such negative dictionary evidence supports the Examining Attorney's position that the term "KAUFFMAN" has no recognized English meaning other than its surname significance. The sole and hence primary significance of the term "KAUFFMAN" is thus its surname significance.

Based on consideration of the factors discussed above, of which three favor the refusal to register and the fourth is neutral, a prima facie case has been shown that the term "KAUFFMAN" is primarily merely a surname. Applicant, moreover, has failed to rebut such showing. We accordingly conclude that because the term "KAUFFMAN" is a surname which (i) is not rare, (ii) has the "look and feel" of a surname and (iii) has no recognized meaning other than its surname significance, the primary significance of such term to the purchasing public for applicant's goods is that of a surname.

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