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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VITAFLEX Dr. Walter Mauch GmbH

Serial No. 75/615,858

Charles L. Gagnebin III of Weingarten, Schurgin, Gagnebin & Lebovici LLP for VITAFLEX Dr. Walter Mauch GmbH.

Amos T. Matthews, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

VITAFLEX Dr. Walter Mauch GmbH, a German corporation, has filed an application to register the mark BY DR. MAUCH for "footwear, boots, gymnastic shoes, half-boots, inner

soles, sandals, shoes, slippers, soles for footwear, sport shoes."¹

Registration has been finally refused under Section 2(c) on the ground that the mark includes the name of a living individual, namely, Dr. Mauch, whose written consent to the use and registration of the mark has not been made of record.

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs.² An oral hearing was not requested.

Applicant has acknowledged that Dr. Mauch is a living individual. Applicant has also stated that applicant attempted to locate Dr. Mauch to obtain his specific written consent, but was unable to determine his whereabouts. Applicant contends, however, that by the provisions of the marital property settlement agreement entered into by Dr. Mauch and his wife Margit Mauch, a copy of which applicant has made of record, written consent has implicitly been given to the registration of his name.

¹ Serial No. 75/615,858, filed January 5, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

² The Examining Attorney has objected to applicant's untimely submission of marketing documents with its brief. Pursuant to Trademark Rule 2.142(d) the record in the application should be complete prior to the filing of an appeal. Accordingly, we have given no consideration to this newly filed evidence.

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By the first provision in this agreement Dr. Mauch conveyed to his wife his business interest in the corporation registered under the name VITAFLEX Dr. Walter Mauch GmbH, the applicant herein, so that Mrs. Mauch became the sole associate of the company. By the second provision, Dr. Mauch conveyed his share in all "protective rights and protective rights applications which are listed in enclosure 1 ... so that she is now the sole owner/proprietor of any and all rights in ... 4. trademarks, and any rights for their utilization... ." Thus, Mrs. Mauch became the "sole owner of any and all protective rights listed in enclosure 1."

Looking to enclosure 1, the rights conveyed with respect to trademarks include, inter alia, the following marks:

1,166,676	German trademark "by Dr. Mauch"
IR 613,103	International registration "by Dr. Mauch" countries named: Austria Benelux countries Italy Switzerland
74/521,165	USA trademark application "by Dr. Mauch"

Applicant maintains that by the plain meaning of this agreement, Dr. Mauch has parted with all his trademark rights in the designation BY DR. MAUCH. By signing over to Margit Mauch all of the trademark rights of the corporation and the various BY DR. MAUCH applications and registrations, applicant insists it cannot be contended that Dr. Mauch has retained any rights to use of the mark in the future. The agreement is relied upon as sufficient written consent to the use and registration of the mark BY DR. MAUCH by applicant, the corporation of which Margit Mauch became the sole associate.

The Examining Attorney takes the position that the provisions of the settlement agreement are insufficient to constitute written consent for applicant to register the involved mark which includes the name Dr. Mauch. He argues that a reasonable reading of the document provides evidence that Dr. Mauch conveyed his rights in one particular United States application to Mrs. Mauch, namely, 74/521,165, an application which was later abandoned. He claims that this document does not establish that Dr. Mauch has either given written consent or that consent can be implied to applicant's use and registration of Dr. Mauch's name in the mark involved in the present application. He argues that the marital settlement was directed to the division of

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property accrued during the marriage, conveys ownership in protective rights and the protective right applications listed in the agreement, and does not contain any wording as to future use of Dr. Mauch's name.

Section 2(c) of the Trademark Act prohibits registration of a mark that

consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent... .

The facts are clear that DR. MAUCH identifies a particular living individual and that his written consent per se to the registration of his name as presented in the involved mark is not of record. The issue for our determination is whether the marital property settlement agreement entered into by Dr. Mauch and his wife Margit Mauch can reasonably be interpreted as Dr. Mauch's implied consent to the use and registration of his name in the mark here sought to be registered, BY DR. MAUCH.

By this agreement Dr. Mauch conveyed to his wife "all protective rights and protective rights applications" specifically listed in the agreement. The "protective rights and protective right applications" cover not only various patents or patent applications, "utility models," and "design models" and but also specific trademarks in registration or application form. The trademark relevant

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to our present inquiry, namely, BY DR. MAUCH, was listed as the subject matter of a German registration, an international registration and a United States application.

A reasonable interpretation of the rights conveyed in the mark BY DR. MAUCH, as represented by these two registrations and one application, would include Dr. Mauch's consent to the use and registration of his name in this mark. In particular, the conveyance to his wife of the earlier United States application for the same mark as involved here is sufficient evidence that Dr. Mauch fully consented to the registration of the mark, consisting for the most part of his name, in this country. We find no reason to conclude that the abandonment of the earlier application eliminated this consent; instead we find it only reasonable that the consent would carry over to the present application, which is for the same rendering of his name in the mark BY DR. MAUCH.

As stated by the Board in *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 344 (TTAB 1985):

The logical rationale for the proscription of registration in Section 2(c) of the Act is to protect living individuals ... from the commercial exploitation of their names, whether it be their full name, shortened name, nickname, etc., except where those living individuals ... agree to such exploitation as evidenced by the written consent of the individual... to the use and registration of the name by the applicant seeking to register a mark

which consists of or comprises said name.

Here Dr. Mauch conveyed to his wife by written document his share in the trademark rights listed in the agreement. These rights include the right to register the mark BY DR. MAUCH in the United States, which necessarily implies his consent to the use and registration of his name as a part of this mark. We find that Dr. Mauch has agreed to the exploitation of his name in this manner by his wife, and thus by applicant, which is wholly owned by his wife.

The Examining Attorney has raised the issue that the agreement contains no provisions with respect to future use by Dr. Mauch of his name. Thus, the Examining Attorney finds the agreement to distinctly differ from the buy-out agreement involved in the *D. B. Kaplan* case wherein the provisions were found to constitute written consent by Donald Kaplan to the registration of the mark D.B. KAPLAN DELICATESSEN by the applicant corporation. There, Donald Kaplan had not only given up all rights in the mark which included his name, but also had agreed that he could not use the mark in any subsequent business.

We do not find the failure of Dr. Mauch to explicitly relinquish any future rights to the use of his name in this or any other mark in any subsequent business a prerequisite to consent to the present registration by applicant of the

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mark BY DR. MAUCH in the United States. Dr. Mauch conveyed a United States application for the mark BY DR. MAUCH to his wife and thus gave up all rights to use and registration of the mark which includes his name in the United States. Whether or not Dr. Mauch may potentially use his name in this mark or other similar marks in other parts of the world is irrelevant. His consent to use and registration by his wife, or applicant as her corporation, in the United States is implicit in the agreement as it stands.

Accordingly, we find that Dr. Mauch has given his written consent to the use and registration of the mark BY DR. MAUCH as required by Section 2(c).

Decision: The refusal to register is reversed.

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