

Hearing:
December 7, 1999

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rohan Designs Limited

Serial No. 75/200,776

Harold L. Marquis and Ryan A. Schneider of Deveau, Colton & Marquis for applicant.

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

Before Simms, Seeherman, and McLeod, Administrative Trademark Judges.

Opinion by McLeod, Administrative Trademark Judge:

An application has been filed by Rohan Designs Limited to register the mark ROHAN for "leather and imitation leather, and the use therein in making goods, namely trunks and traveling bags; luggage; bags; backpacks; wallets; belts; umbrellas; parasols and walking sticks" in International Class 18 and "articles of outerclothing and underclothing, and waterproof articles of outerclothing, namely, rainwear; mackintoshes; coats; jackets; fleece jackets; waistcoats;

trousers; breeches; underbreeches; leggings; dresses; skirts; culottes; blouses; track suits; sweatshirts, sweaters; tops; shirts; polo shirts; T-shirts; undershirts; vests; shorts; pants; underwear; socks; headwear; hats; caps; scarves; gloves; mittens; footwear; boots; shoes; salopettes; slippers; belts" in International Class 25.¹

The Trademark Examining Attorney has finally refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that applicant's mark is primarily merely a surname.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was held.

In support of his surname refusal, the Examining Attorney has made of record approximately 1,170 ROHAN surname listings from PHONEDISC POWERFINDER USA ONE 1997 (3rd ed.). As additional evidence, the Examining Attorney relies upon pages from *Webster's Ninth New Collegiate Dictionary* and *Webster's New Geographical Dictionary*, which show no listing of the term "Rohan." According to the Examining Attorney, this evidence is sufficient to meet his burden of proving that the applied-

¹ Application Serial No. 75/200,776, filed November 20, 1996, based upon a bona fide intent to use the mark in commerce under Section 1(b), 15 U.S.C. § 1051(b). Applicant claims ownership of Registration No. 1,733,157 for the mark ROHAN for "articles of clothing; namely, underbreeches, T-shirts and under skirts."

for mark is primarily merely a surname. The Examining Attorney also argues, among other things, that the evidence submitted by applicant during prosecution is insufficient to show that ROHAN has another meaning which is well enough known to the public to rebut the Examining Attorney's prima facie surname case.

Applicant, on the other hand, contends that the Examining Attorney has failed to establish a prima facie surname case. Applicant challenges the Examining Attorney's PHONEDISC evidence on the ground that it represents a small fraction of the total U.S. population, and that a number of the listings are duplicative. As a result, applicant concludes that ROHAN is, at most, a rare surname. Applicant claims that there are only twelve listings of ROHAN in the *Greater Atlanta White Pages* (1995). According to applicant, the term ROHAN was selected by applicant because of its literary meaning of a fictional geographical area in J.R.R. Tolkien's novel "Lord of the Rings."² Applicant argues, among other things, that ROHAN is the name of a small town in France; that it does not have the look or sound of a surname; and that the name is not

² Although the copy of Tolkien's novel that accompanied applicant's brief is untimely, the Board has considered the evidence inasmuch as the Examining Attorney specifically stated that he does not object to its consideration during the oral hearing. See Trademark Rule 2.142(d).

associated with anyone in applicant's business. In support of its position, applicant has submitted affidavits, telephone directory listings, and a printout from the Internet of information on the San Diego State University's academic web server that is also named ROHAN after the geographical area in Tolkien's novel.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. *In re Hutchinson Technology Inc.*, 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), *citing In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Examining Attorney to establish a prima facie case that a mark is primarily merely a surname. *Hutchinson Technology*, 852 F.2d at 554, 7 UPQ2d at 1492; *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985).

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and

sound" of the surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

Turning to the first factor to be considered, the degree of a surname's rareness, the Examining Attorney has demonstrated that there are over 1,100 ROHAN surname listings from the PHONEDISC database. We recognize, however, that some of the PHONEDISC listings are duplicative³ and that, in reality, there are relatively few ROHAN surnames scattered throughout several cities in the United States.⁴ Indeed, applicant has shown that there only twelve ROHAN surnames listed in the *Greater Atlanta White Pages*. While ROHAN is not as rare as BENTHIN or SAVA, on the evidence of record we find that it is a relatively rare surname.⁵ *See Benthin, supra; In*

³ The dissent was unable to find any duplicate ROHAN listings in the PHONEDISC evidence. However, a cursory review of the evidence reveals that there are a number of duplicate ROHAN listings. For example: Annemarie Rohan, 100 Westwood Oaks Ct., Kankakee, IL; Brendon Rohan, 1341 Harrison Ave., Butte, MT; Charles Rohan, 6508 Fenske Lane, Needville, TX; Daniel M. Rohan, 915 Cary Rd., Algonquin, IL; David J. Rohan, 664 Forest Ridge Lane, Pacific, MO; Emanuel Rohan, 6320 Lyndon B. Johnson Fwy, Dallas, TX; Howard E Rohan, 1311 Hampton Hall Drive NE, Atlanta, GA; and Joseph Rohan, 26 Denby, Marthasville, MO.

⁴ Applicant's evidence concerning the degree of rareness of the ROHAN surname in London, England is irrelevant because we are concerned with whether consumers in the United States perceive the applied-for mark as primarily merely a surname.

⁵ The dissent relies upon evidence that he acknowledges is not part of the record. Our decision, of course, must be based on the evidence of record, not any additional information which the dissenting judge may have obtained from his review of other files and his own search of the NEXIS database. It is the Examining Attorney's burden to submit sufficient evidence to prove the basis for refusing registration. If the Examining Attorney had in fact

re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994)(one hundred SAVA surname telephone directory listings).

The second factor in determining whether ROHAN would be perceived as primarily merely a surname is whether "anyone connected with applicant" has the name. *In re Monotype Corp.*, 14 USPQ2d 1070, 1071 (TTAB 1989). Applicant has presented an affidavit from Mr. Freeman, chairman and managing director of applicant, attesting that no one associated with applicant has the ROHAN surname.

The third factor to be considered is whether ROHAN has recognized meanings other than that of a surname. Applicant's evidence that ROHAN is the name of a small town in France is unpersuasive on the third factor. There is simply no evidence that consumers in the United States are familiar with this small, obscure town in France. *See Harris-Intertype*, 518 F.2d at 631 n.4, 186 USPQ at 239 n.4 (Harris, Missouri, population 174, and Harris, Minnesota, population 559, held obscure); *cf. In re Colt Indus. Operating Corp.*, 195 USPQ 75 (TTAB)(FAIRBANKS (Alaska) so well known as a geographical term that it was not deemed primarily merely a surname).

On the other hand, applicant has proven that ROHAN is the name of a geographical area in T.R.R. Tolkien's novel "Lord of

made of record the additional evidence discussed by the dissent, the majority may have reached a different result in this case.

the Rings.” According to the evidence of record, Tolkien’s novel was first published in 1965, and reprinted sixty-five times. In addition, there is evidence that a major university in the United States named its academic web server after the ROHAN geographical area described in Tolkien’s novel.⁶ Based upon this evidence, we conclude that ROHAN has a recognized, well-known meaning other than that of a surname.

As to the remaining factor, namely, whether ROHAN has the structure and pronunciation of a surname, we acknowledge that this is a somewhat subjective factor. Simply put, we find that ROHAN does not necessarily have the “look or sound” of a surname. See *In re Garan*, 3 USPQ2d 1537 (TTAB 1997)(GARAN does not have look or sound of surname).

Decision: The refusal to register the mark ROHAN under Section 2(e)(4) is reversed.

E. J. Seeherman

L. K. McLeod
Administrative Trademark

⁶ The dissent is unimpressed with this evidence because there is no indication of how often the Web site is visited by users. However, the mere fact that a major university selected the term because of its use in Tolkien’s novel demonstrates that ROHAN has a recognized meaning other than that of a surname.

Ser No. 75/200,776

Judges, Trademark
Trial and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

I strongly disagree with the conclusion of the majority that the mark ROHAN is not primarily merely a surname and that this refusal should be reversed.

As the majority acknowledges, the test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. Upon a careful review of this record, it is clear that the primary significance of the mark ROHAN is that of a surname.

First, it is interesting to note that, while the majority mentions that applicant has claimed ownership of a registration for the mark ROHAN for certain articles of clothing, the majority fails to mention that that registration issued pursuant to the provisions of Section 2(f) of the Act, 15 USC §1052(f). A review of the Office database of registrations reveals that that registration was cancelled pursuant to the provisions of Section 8, 15 USC §1058.⁷

⁷ A review of that registration file, which is not of record herein, reveals a surname refusal as well as the kind of evidence from the NEXIS database which the majority seems to have desired from the Examining Attorney in this case. The numerous NEXIS printouts in the registration file show use of the name "Rohan" as a surname, including that of a dean of a law school as well as a college basketball coach. Also, during the pendency of that application, applicant was advised of a prior pending application for the mark ANDREW ROHAN for certain items of clothing. That application eventually became abandoned.

In surname cases, even a small number of listings has been sufficient to establish a *prima facie* case of surname significance. See, for example, *In re Lewis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984). Even rare surnames have been found to be barred under the Lanham Act. See *In re Rebo High Definition Studio, Inc.*, 15 USPQ2d 1314 (TTAB 1990). In the *Benthin* and *Sava* cases, cited by the majority, there were around one hundred listings from computerized telephone directory databases. As the Examining Attorney has pointed out, even the relatively common surname Lopez comprises only .00055% of the Phonedisc database listings.

In the instant case, the Phonedisc database printouts of record reveal, by my count, 1275 listings of the surname Rohan.⁸ In addition, there are no listings of this word in a geographical dictionary or in an ordinary dictionary. The majority states that:

[S]ome of the PHONEDISC listings are duplicative and that, in reality, there are relatively few ROHAN surnames scattered throughout several cities in the United States.

The statement that there are relatively few listings "scattered throughout several cities in the United

⁸ While the Examining Attorney states (brief, 4) that there are "approximately 1170" listings of record, my count reveals 1275 Rohan surname listings from Phonedisc.

States" is simply incorrect. A review of the 1275 listings reveals that individuals with the surname Rohan are located in literally hundreds of towns and cities throughout every state except Delaware. And I can find only 26 apparent duplicate listings, bringing the total down to 1249 surname listings.

Even applicant's own evidence in this case shows use of Rohan as a surname. That evidence consists of a copy of an Internet search wherein the following links to Web pages are discovered:

Rohan vs. American Bar Ass'n

C4 Filing -- Bob Rohan for City Council -- In-Kind Contributions

Despite the evidence of surname significance, the majority, relying upon the reference to "Rohan" in Tolkien's "The Lord of the Rings" trilogy, concludes that this term has a "recognized, well-known meaning other than that of a surname." That is, "Rohan" is the "recognized, well-known" name of a mythical geographic area mentioned in that novel. This conclusion is simply absurd. An informal poll of over half a dozen of my colleagues, while revealing unanimous awareness of Tolkien's "The Lord of the Rings," shows absolutely no awareness whatsoever of the term "Rohan" from that novel. While there is no question that the book

(trilogy) is a well-known piece of literature, it is another matter to say that various words, real and invented, from that series of books are also "recognized [and] well-known."

Tolkien was apparently a master of inventing names and a casual review of the second in the trilogy, "The Two Towers," reveals a great many.

The majority also appears to be applying a double standard in this case. On the one hand, the Examining Attorney is apparently being told that he needed to place in the record evidence that the name "Rohan" appears as a surname in the Nexis or some other database of newspapers or magazines, even though there is evidence of over 1200 listings from the Phonedisc database. On the other hand, applicant is not being required to submit any evidence of recognition of Rohan as a geographical term from "The Lord of the Rings." That is to say, the type of evidence of purchaser recognition which the majority seems to demand of the Examining Attorney is being presumed from applicant -- awareness of "Rohan" as the name of a mythical kingdom from Tolkien's work. To the same extent that the novel may be said to be "in circulation" amongst the general public, so too are the telephone directories (and the people bearing the surname Rohan, for that matter). Indeed, a Nexis search of the term "Rohan" discussed in the same articles in which Tolkien's "The Lord of

the Rings" is also discussed reveals only five references in U.S. publications in over twenty years. Two of those references deal with a relatively recent video game called "Riders of Rohan" based upon Tolkien's book and two of the articles discuss "Riders of Rohan," not "Rohan" per se. Suffice it to say that "Rohan" as a fictional geographic place is rarely mentioned in the vast Nexis database. Yet, despite this fact, the majority comes to the incredible conclusion that "Rohan" is "recognized [and] well-known" as the name of a fictional geographic place. The Examining Attorney is absolutely correct that the evidence is insufficient to show that "Rohan" has another meaning which is well enough known to the public to rebut his *prima facie* case. See *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986).

While this record is sufficient to establish a *prima facie* case of surname significance, I also note that searching the term "Rohan" in the News Library of the Nexis database, even just the "Last 90 days," retrieves a message that this search found over 1,000 stories where this name appeared. A review of hundreds of those "hits" shows, as expected, not one reference to Rohan as the mythical geographic area from "The Lord of the Rings."⁹

⁹ The name "Rohan" appears in these stories as both a surname and as a given name. I note that applicant never argued or presented any

With respect to the use of this term as the name of the Web server of San Diego State University, there is also no evidence of how often that Web site is visited, especially by others than the faculty, staff and students at that institution.

Also, the name "Rohan" has the look or sound of a surname, at least to me. There are certainly a number of surnames which end in the suffix "han", such as Callahan and Houlihan, and this name also brings to mind such other perhaps more common surnames as Rowan and Cohan (as in George M. Cohan). Applicant argues, brief, 4, that the name Rohan is similar to surnames like Cotton and King. However, those names have obvious and well-recognized dictionary meanings which detract from any possible surname significance.

Finally, I note that applicant intends to use its mark in connection with a variety of articles of clothing as well as such goods as luggage, wallets and belts. In this connection, I believe that it is a well-known fact amongst the general public that clothing is often sold under the name (or surname) of the designer or maker. Such well-known designer names include Oleg Cassini, Yves Saint Laurent, Evan Picone, Valentino, Liz Claiborne, Ralph Lauren, Versace, Bill Blass,

evidence on the only reasonable basis for reversal here -- that Rohan is not primarily merely a surname because it is also used and

Tommy Hilfiger, Donna Karan, Calvin Klein, Giorgio Armani and Geoffrey Beene. Suffice it to say that the general public, accustomed to the use of such names in connection with clothing and related merchandise, is all the more likely to perceive applicant's asserted mark as a surname used as a brand for clothing and other goods.

Because I believe that the Examining Attorney has established a *prima facie* case that the primary significance of the term "ROHAN" is that of a surname, and that applicant has not rebutted this showing with sufficiently probative evidence, I would affirm the refusal.¹⁰

R. L. Simms
Administrative Trademark Judge,
Trademark Trial and Appeal Board

recognized as a given name.

¹⁰ Although I have referred to matters outside the record in this opinion, let me make it clear that the record in the application file is sufficient to make out a *prima facie* case that the primary significance of "Rohan" is that of a surname.

Ser No. 75/200,776

Ser No. 75/200,776