

Hearing:

January 6, 2000

Paper No. 16

BAC

THIS DISPOSITION IS NOT CITABLE

AS PRECEDENT OF THE TTAB JULY 18, 00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re United Distillers plc

Serial No. 75/213,352

Albert Robin of Robin, Blecker & Daley for United Distillers plc.

Sarah A. Otte, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Seeherman, Hanak and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 16, 1996 United Distillers plc filed an intent-to-use application to register the mark HACKLER on the Principal Register for "alcoholic beverages, namely, distilled spirits, except Scotch whisky, and liqueurs." Applicant filed an amendment to allege use, accepted by the Office, in which applicant asserts a date of first use of July 21, 1997.

Registration has been finally refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), on the basis that the term HACKLER is primarily merely a surname.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, and an oral hearing was held on January 6, 2000.

Applicant essentially contends that HACKLER is a rare surname (e.g., with only one listing in the Manhattan telephone directory); that the word "hackler" has a dictionary meaning and is used in applicant's promotional materials referring to "The Hackler" and a poem titled "The Hackler from Grousehall"; that "hackler" is not an obscure English word and even if it were, it is also a rare surname; and that this word does not have the structure and pronunciation of a surname and thus it does not have the "look and feel" of a surname to the public (that is, the addition of "er" to a word generally results in a word meaning "one who ___ ", e.g., golfer, bottler, hackler). Further, applicant contends that the Examining Attorney has not established a prima facie case that this term is primarily merely a surname, or if she has, then applicant has either rebutted that showing, or has at the very least raised doubt about the public perception of the term; and

that doubt would be resolved in favor of applicant to allow publication.

The Examining Attorney essentially argues that HACKLER is not a rare surname (with 1,295 listings from the Phonedisc database and numerous representative excerpts from Nexis articles showing "Hackler" as a person's surname); that the dictionary definition of the term "hackler" submitted by applicant is an obscure English language meaning and does not obviate the surname significance of the term (with dictionaries submitted by the Examining Attorney showing no entry for "hackler"; that the term "Hackler" has the "look and feel" of a surname (like names such as Cooper, Turner, Parker, Weaver); and that the impact on the purchasing public is that of primarily merely a surname. The Examining Attorney specifically argues that the Office has met its burden of establishing a prima facie showing to support refusal; and that the burden to rebut that showing, having shifted to applicant, has not been met.

Clearly, the issue presented to the Board is whether the term "HACKLER" is *primarily merely* a surname, in terms of what the word means to the relevant purchasers of applicant's goods. A term is primarily merely a surname if, when applied to a particular product (or used in

connection with a particular service), its primary significance to the purchasing public is that of a surname. The burden is on the Patent and Trademark Office to establish a prima facie case that the involved term is primarily merely a surname. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975); and *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993). Further, the question of whether the term sought to be registered is primarily merely a surname can be resolved only on a case by case basis. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). See generally, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§13:29 and 13:30 (4th ed. 1999).

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 (TTAB 1995).

Based on this record, we find that the term HACKLER is a rare surname with only one listing in the Manhattan

telephone directory and four total listings (one of which appears to be a repeat) in the Washington, D.C. and the Northern Virginia telephone directories. As we have noted before, when considering Phonedisc evidence, we recognize the massive scope of that database. (According to the Phonedisc prefatory comment appearing in the submission from the Examining Attorney, there are approximately 80 million entries in the database.) See *In re Benthin Management GmbH*, supra, at 1333.

Applicant submitted Webster's Third New International Dictionary (1993) definition of "hackler" as "one that hackles; esp.: a worker who hackles hemp, flax or broomcorn"; and, in the same dictionary, "hackle" has several definitions, including "n. 1. A comb or board with long metal teeth for dressing flax, hemp, or jute"; and "hackle" or "hackles" as "v. To separate the long fibers of (flax, hemp, or jute) from waste material and from each other by combing with a hackle."

In addition, applicant submitted (i) a copy of the poem "The Hackler from Grousehall," in which the opening line is "I am a roving hackler that loves the Shamrock shore,...."; and (ii) some of applicant's own promotional materials, used in connection with the involved goods, which include the following statements:

The Hackler was a distiller of high quality Irish Poitin in 19th century Ireland; and

What or Who is the HACKLER?

The HACKLER brand name is based on a real person - The HACKLER of Grouse Hall, who lived in 19th Century Ireland and was a weaver and distiller of highest quality Poitin.¹

While the term HACKLER certainly can be a surname, nonetheless, the word has another significance or meaning. "Hackler" is defined in a 1993 edition of Webster's dictionary as a person who hackles (separates the long fibers of flax, hemp or jute from waste materials and each other). Moreover, the record shows that applicant promotes the term HACKLER for its goods (distilled spirits) as relating to "The Hackler of Grouse Hall," a person who was a hackler by trade in the 19th century.

Further, there is no evidence that HACKLER is the surname of anyone connected with applicant.

We next consider the question of whether the word HACKLER has the "look and feel" of a surname. Obviously, surnames are sometimes derived from occupation names, e.g., "Weaver." This factor is a close question in this case because we cannot say that HACKLER has a clear "look and

¹ Also in these promotional materials, it states "Poitin (pronounced potcheen) is Ireland's infamous white spirit which has been banned since 1661."

feel" as either that of a surname, or an arbitrary term. Thus, this factor is neutral.

In light of the dictionary meaning of the word "hackler," and applicant's promotion of its products making an association with the word used in connection with a person who was a "hackler," we find that this relatively rare surname will not be perceived as primarily merely a surname. That is, it cannot be said that the primary significance to the relevant purchasing public, i.e., purchasers and prospective purchasers of applicant's distilled spirits, would be solely that of a surname. See *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994); *In re The Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); and *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977).

To the extent there is any doubt on the question of whether the mark would be perceived as primarily merely a surname, we resolve such doubt in favor of the applicant. See *In re Benthin Management GmbH*, supra, at 1334.

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

E. J. Seeherman

E. W. Hanak

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board