

Hearing:
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Paper No. 18
HRW

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Belvedere

Serial No. 75/277,213

Arthur Schwartz and Susan A. Richards of
Foley & Lardner for Belvedere.

Karen Marie Strzyz, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Simms, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Belvedere, a société anonyme under the laws of France,
has filed an application to register the mark SOBIESKI for
"vodka, brandy and other liquors."¹

Registration has been finally refused on the ground
that the proposed mark is primarily merely a surname under

¹ Serial No. 75/277,213, filed April 18, 1997 under Section
44(e), based on ownership of French Registration No. 94503524,
issued January 27, 1994.

Section 2(e)(4), 15 U.S.C. § 1052(e)(4), of the Trademark Act. Applicant and the Examining Attorney have filed briefs and both participated in the oral hearing.

The Examining Attorney maintains that the primary significance of the term SOBIESKI to the relevant purchasing public in the United States is that of a surname. As support for this position, she refers to the results obtained from a search in the PHONEDISC POWERFINDER USA ONE 1997 (2nd Ed.) database, in which a total of 596 listings for the surname "Sobieski" were found.² On the basis that this number of persons throughout the United States are known to have the surname, the Examining Attorney argues that "Sobieski" is not a rare surname and that consumers have had sufficient exposure to "Sobieski" to regard it as a surname. In addition, the Examining

² As attached to the first Office action, this evidence consisted of a cover sheet indicating that a total of 596 listings had been found and a copy provided of the first 100 listings (in fact only 90 listings were printed out). Applicant, in its brief, objected to this excerpted listing and contended that the remaining listings were not properly of record. In response, the Examining Attorney attached an updated search to her brief, indicating that in a search conducted on PHONEDISC POWERFINDER USA ONE 1998(4th ed.) a total of 591 listings were found and showing all of these listings. In its reply brief, applicant objected to this later search as untimely evidence.

We find the PHONEDISC search as initially introduced fully adequate to consider the entire 596 listings as being of record. The cover sheet indicated the full number of listings obtained and applicant made no objection to the completeness of the listings provided until its brief. If applicant had earlier raised such an objection, the Examining Attorney could have provided a complete listing.

Attorney points to two NEXIS database searches for references to the name "Sobieski," one conducted by an earlier Examining Attorney and one by the present Examining Attorney, the first yielding 514 articles (of which 7 were made of record) and the second 1531 articles³ (of which 200 were made of record). She also notes, as further evidence of the primary significance of the term as a surname, the pertinent page from *Webster's II New Riverside Dictionary* (1994), which has been made of record, showing the absence of any ordinary meaning for the term "sobieski."

Applicant contends that "Sobieski" is an extremely rare surname and that any potential surname significance is outweighed by the historical significance of SOBIESKI as a reference to the 17th century King of Poland, Jan III Sobieski. As evidence of this historical significance, applicant initially made of record printouts of information obtained from Internet editions of *Encyclopaedia Britannica* and *Encarta Online* detailing the reputed fame of Jan III Sobieski, who as a soldier drove back the Ottoman Turks and as elective king from 1674-96 was the "last great king" of Poland. When the Examining Attorney challenged public

³ The Examining Attorney notes that this second search initially yielded 2150 entries, but two names appeared frequently, namely, LeeLee Sobieski, an actress, and an individual by the name of

recognition in the United States of this Polish king by doing a NEXIS search for "King Sobieski" and obtaining only 12 articles, applicant introduced more extensive evidence, including 28 of the 66 articles which applicant obtained in a NEXIS search for references to Sobieski as a king or by his Christian name as well as numerous on-line references to King Sobieski, these mostly coming from encyclopedias. In addition, applicant argues that the term has geographic significance and has made of record limited evidence of such use, including an Internet printout about the community of Sobieski, Wisconsin. Applicant has also pointed out that certain of the NEXIS excerpts relied upon by the Examining Attorney are references to locations, rather than persons.

A term is primarily merely a surname if its primary significance to the purchasing public is that of a surname. In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); In re Industrie Pirelli, 9 USPQ2d 1564 (TTAB 1988). The initial burden is on the Patent and Trademark Office to establish a prima facie case that the term is primarily merely a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985).

Daniel John Sobieski. Upon narrowing the search to exclude these two persons, the present 1531 entries were obtained.

As stated by our principal reviewing court, the question of whether a mark is primarily merely a surname can only be made on a case-by-case basis. In re *Etablissements Darty et Fils*, 225 USPQ at 653. Here, applicant has set forth four factors which it considers determinative under the present circumstances. These are:

- (1) the rareness of the surname;
- (2) whether the mark has other meanings;
- (3) whether the mark is the surname of anyone connected with applicant; and
- (4) whether the mark has the structure and pronunciation or look and sound of a surname.

Thus, we turn our consideration to these factors, which are identical to those relied upon by the Board in *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

The Examining Attorney argues that the 596 PHONEDISC listings for the surname "Sobieski," which come from all across the United States, is ample evidence that the surname is not one which would be classified as rare. If this evidence alone is insufficient, however, she points to the number of articles containing references to "Sobieski" obtained in the two NEXIS database searches, of which a representative sampling has been made of record. Applicant, on the other hand, asserts that 596 listings represents a minimal percentage of the United States

population. Applicant also contends that since the Examining Attorney has only made a portion of the NEXIS results of record, we must assume that the remainder would support non-surname usage, rather than the contrary.

Furthermore, from applicant's viewpoint, even those made of record confirm that the surname is at most a rare surname, since of the 200 articles from the second search, 66 contain non-surname references, including ones to schools, cities, streets, as well as to the Polish king.

On the evidence before us, we can only conclude that "Sobieski" falls within the category of being a relatively rare surname. We fail to see how a total of 596 PHONEDISC listings can be viewed otherwise, regardless of the fact that these listings represent persons living throughout the United States. Whether or not we adopt applicant's calculations as to number of different individuals actually identified by the NEXIS articles relied upon by the Examining Attorney (60 by applicant's count), we find nothing of record to raise the level of frequency of usage to that of a common surname or even close thereto.

We would hasten to add, however, that even rare surnames are not registrable, if the primary significance of the term to the public is that of a surname. See *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB

1990); In re Industrie Pirelli, *supra*. The fact that there is not widespread usage of "Sobieski" as a surname does not establish that it will not be recognized as a surname by a substantial number of persons. See In re Etablissements Darty et Fils, *supra*.

Thus, we next look to whether the term "Sobieski" has any recognized meanings other than that of a surname. Applicant strongly contends that there is such a meaning; that SOBIESKI would be viewed as a reference to the 17th century King of Poland Jan III Sobieski; and that, as a result, the primary connotation of the term would be as a reference to this historical figure, not as a surname. The Examining Attorney argues that while King Sobieski may have been a Polish king, the evidence of record does not demonstrate that the relevant consuming public would even be aware of this personage, much less perceive SOBIESKI as a reference to this "long deceased Polish king."

It is true that if the primary connotation of the term SOBIESKI were that of the person in history known as King Sobieski, any significance as a surname would be secondary. The Board specifically addressed this situation in In re Champion International Corp., 229 USPQ 550 (TTAB 1985), although finding in that case that the significance of the term MCKINLEY as a reference to a deceased president was

not sufficient to equate the primary connotation of the term with the historical figure, as opposed to its significance as a surname per se. Here we are in total agreement with the Examining Attorney that the evidence provided by applicant fails to establish that the term SOBIESKI would be perceived by the consuming public in the United States as a reference to this Polish king. Much of applicant's evidence comes from on-line encyclopedia sources, and cannot be assumed to be information within the general knowledge of the average purchaser. The NEXIS articles made of record by applicant were, to a great extent, disseminated by foreign sources and cannot be assumed to have been readily available to the U. S. public. While persons of Polish background in the United States, or perhaps U. S. visitors to Poland, might be aware of King Sobieski and his status in Polish history, we do not believe a substantial proportion of persons in the United States would perceive the term SOBIESKI primarily as a reference to this Polish king.⁴

⁴ We find applicant's further argument that the present mark would be viewed by the public as another of its "family" of marks of international military figures, pointing to its applications for the marks GONG JING GONG JIU and HETMAN, to be wholly without merit. These totally different marks are irrelevant to the question of the primary significance to the public of the term SOBIESKI.

Applicant also argues that the term SOBIESKI has other recognized non-surname meanings, most particularly geographic significance as the name of a city in Minnesota, a mountain peak in Washington, a town in Wisconsin, and the name of several streets and schools. Applicant has failed, however, to introduce any evidence that these locations are so well known to the general public that there would be any real geographic significance attached to the term SOBIESKI. In other words, there is no evidence of any significant consumer recognition of and association between SOBIESKI and any of these geographic locations. Any minor significance of SOBIESKI as a geographical term is insufficient to dissipate its primary significance as a surname. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) [geographical meaning of the term HAMILTON is relatively minor compared to surname significance].

As far as the third factor is concerned, there is no question that there is no person with the surname "Sobieski" associated with applicant. The Examining Attorney has not relied upon any such association as support for her assertions of public perception of the term SOBIESKI as a surname.

It is the fourth factor, whether SOBIESKI has the structure and pronunciation of a surname, or as otherwise stated, whether it looks or sounds like a surname, which plays a major role our determination of the primary significance of the term SOBIESKI. The Examining Attorney argues that Polish surnames often end in "-ski" and, as support for this argument, has attached to her brief a copy of pages from the reference book entitled *People's Names* (1997) illustrating the use in Polish of the ending "-ski" for family names and listing various Polish family names including, as a few examples, Adamowski, Dembinski, Konarski and Stojowski.⁵ Applicant, in rebuttal, has introduced evidence of the use of the suffix "-ski" as the masculine form of adjectives in the Polish language and as the suffix used in the names of several Polish cities or towns.

We find the circumstances here to be similar to those in *In re Industrie Pirelli, supra*. In the *Pirelli* case, the fact that the term PIRELLI, although admittedly a rare surname, had the look of an Italian surname and was similar in structure and pronunciation to more common surnames was

⁵ We find it proper to take judicial notice of this reference work, not earlier relied upon by the Examining Attorney. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

highly instrumental in the Board's determination that the primary significance of the term was that of a surname. Here we have concrete evidence of the presence of the suffix "-ski" in many Polish family names.⁶ In addition, we have NEXIS evidence that the surname "Sobieski" itself is not without exposure before the U. S. public. Even more significant, however, is the fact that there is an actress named LeeLee Sobieski whose name has appeared frequently in NEXIS articles, an indication that even though the surname may be rare, there has been a specific opportunity for widespread public recognition of "Sobieski" as a surname. All of this evidence clearly outweighs any potential perception by the U. S. public of the suffix "-ski" as a masculine ending or as a suffix used in connection in the names of Polish towns or cities. Applicant's further argument that since the term is being used in connection with vodka, a beverage often associated with Russia and Eastern Europe, purchasers might well believe that SOBIESKI identifies a place associated with the production of the vodka is equally unpersuasive.

Accordingly, we find that, although SOBIESKI may be a relatively rare surname, the Examining Attorney has met the

⁶ As an aside, we note that the general manager of applicant who signed the application has the surname Trylinski.

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burden of establishing prima facie that the primary significance of the term would be that of a surname. We find applicant's evidence of other meanings for the term, particularly as a reference to King Sobieski of Poland, insufficient to rebut the primary significance of SOBIESKI as a surname when encountered by U. S. purchasers on applicant's goods.

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

R. L. Simms

G. D. Hohein

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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