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Hearing:
April 12, 2000
DEB

10/4/00

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arrowsmith International, Inc.

Serial No. 75/299,225

Michael R. Dinnin of Dinnin & Dunn, P.C. for Arrowsmith International, Inc.

David H. Stine, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Arrowsmith International, Inc., a corporation of Michigan, has filed an intent to use application to register the word "ARROWSMITH" for "metal dies, jigs, and fixtures for use with machine tools," in International Class 6.¹

The Trademark Examining Attorney has 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.

¹ Application Serial No. 75/299,225, filed May 28, 1997, based upon a *bona fide* intention to use the mark in commerce under Section 1(b), 15 U.S.C. §1051(b).

When the refusal to register was made final, applicant appealed. Applicant and the Trademark Examining Attorney have filed briefs. Applicant requested an oral hearing before the Board, and the applicant and the Trademark Examining Attorney participated in this hearing.

We affirm the refusal to register.

In support of his surname refusal, the Trademark Examining Attorney has made of record the results of a search of a database containing ninety million names, finding 554 "Arrowsmith" surname listings from PHONEDISC POWERFINDER USA ONE 1997 (3rd ed.).

Applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname case. Applicant challenges the Trademark Examining Attorney's PHONEDISC evidence on the ground that the quantum of evidence submitted by the Examining Attorney is indeterminate of the primary significance of the term to purchasers. Applicant asserts that "Arrowsmith" was registered in six federal registrations now cancelled or abandoned. Finally, applicant has also argued that the word "Arrowsmith" has numerous other uses or meanings based upon an Internet search it conducted.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to

the purchasing public. See 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 Trademark Examining Attorney to establish a *prima facie* case that a mark is primarily merely a surname. See In re Etablissements Darty et Fils, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the Trademark Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut this finding.

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).

There is no doubt that the Trademark Examining Attorney has met his initial burden of establishing that "ARROWSMITH" would be perceived by consumers as primarily merely a surname. In particular, the Trademark Examining Attorney has presented evidence of over five hundred "ARROWSMITH"

surname references from the PHONEDISC database. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a *prima facie* surname case. See Hutchinson Technology, 852 F.2d at 554, 7 USPQ2d at 1492; Darty, 759 F.2d at 16, 225 USPQ at 653; see also 2 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, §13.30, p. 13-50 (4th ed. 1999).

The Trademark Examining Attorney's PHONEDISC evidence is collected from telephone directories and address books across the country. There is no magic number of directory listings required to establish a *prima facie* surname case. In re Cazes, 21 USPQ2d 1796, 1797 (TTAB 1991); In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd unpublished decision*, No. 89-1231 (Fed. Cir. 1989). It is reasonable to conclude from these submissions that "ARROWSMITH," while obviously not as common as some other surnames, has had measurable public exposure.² Even if "ARROWSMITH" is an uncommon surname, it is by no means a decidedly rare surname.³

² To the extent applicant contends that ARROWSMITH is an uncommon surname, we would point out that even uncommon surnames may not be registrable on the Principal Register. See Industrie Pirelli, 9 USPQ2d at 1566.

³ This evidence is far more significant than the number of listings presented in other cases where the surname has been categorized as "rare." See e.g. Kahan & Weisz, 508 F.2d at 832, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); In re Sava Research Corp., 32 USPQ2d 1380 (TTAB

Applicant dismisses more than five hundred "Arrowsmith" listings from the PHONEDISC database as representing only "0.0006%" of the American population. However, we find this "percentage-of-the-entire-population" argument to be a hollow reed. Given the rich diversity of surnames in this country, if one were to take a statistical measurement of this database, even a common surname like "Jones" would constitute a relatively small fraction of the total database content.

As to the second Benthin factor, we recognize that no one connected to applicant's organization, past or present, has been shown to have the "Arrowsmith" surname. If an Arrowsmith were associated in some way with applicant, it could well indicate the public's recognition of the term as a surname. However, logic tells us that the converse is not necessarily true, i.e., the mere fact that this query comes up negative herein cannot compel the conclusion that consumers will not perceive the term as a surname.

1994)(one hundred SAVA surname telephone directory listings); Benthin Management, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings); In re Garan, Inc., 3 USPQ2d 1537 (TTAB 1987)(six GARAN telephone directory listings and one NEXIS listing). This is one of four factors. Hence, the quantum of PHONEDISC evidence which may be persuasive for finding surname significance in one case may be insufficient in another because of differences in the surnames themselves and/or consideration of the other relevant surname factors. Darty, supra.

In weighing the third Benthin factor, we have considered applicant's contention that "Arrowsmith" has meanings other than that of a surname. However, both the Benthin decision and our primary reviewing court clearly require that the other meanings be "recognized" by a significant number of people. See Harris-Intertype, *supra*; Benthin Management, *supra*. We do not believe that a significant number of people would recognize the other meanings proffered by applicant from its Internet search in this case because they are remote or obscure (e.g., for several other small enterprises including an antique shop in New Mexico or the name of a small town and auction center in Illinois). The mere fact that the word "Arrowsmith" has nine obscure or remote meanings is insufficient to show that it will not be perceived as "primarily merely a surname." See Harris-Intertype, *supra*; In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939, 1942 (TTAB 1993).

Finally, as to the fourth Benthin factor, it is the view of the Board that "ARROWSMITH" has the structure and pronunciation of a surname, not of an arbitrary designation. See Garan, 3 USPQ2d at 1538; Industrie Pirelli, 9 USPQ2d at 1566.⁴ In fact, judging this matter simply by its look and

⁴ The Trademark Examining Attorney has also pointed out that three of the prior federal registrations for "ARROWSMITH" issued

feel, "ARROWSMITH" seems to fit the archetype of surnames having a "-smith" suffix, such as Goldsmith, Hammersmith and Coopersmith.

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

E. J. Seeherman

P. T. Hairston

D. E. Bucher

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under Section 2(f) of the Act. The others are "Arrowsmith" coupled with a distinctive design element. Such a composite is not considered primarily merely a surname. See *Benthin Management, supra*, and TMEP §1211.01(b). Accordingly, these cancelled and expired registrations reflect a consistent approach by the U.S. Patent & Trademark Office over several decades that "ARROWSMITH," without more, is primarily merely a surname.