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Paper No. 12
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manhattan Scientifics, Inc.

Serial No. 75/580,055

James C. Wray for Manhattan Scientifics, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Manhattan Scientifics, Inc. seeks to register the mark
HOCKADAY FUEL CELL (with the words "FUEL CELL" disclaimed
apart from the mark as shown) for goods identified after
amendment as "fuel cells and fuel cell tanks for producing
electrical energy; fuel cell chemical fuel provided as a
unit with the foregoing," in International Class 9.¹

¹ Application Serial No. 75/580,055, filed October 30, 1998,
based upon a claim that applicant possesses a *bona fide* intention
to use the mark in commerce, under Section 1(b) of the Trademark
Act, 15 U.S.C. §1051(b).

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.

When the refusal to register was made final, applicant appealed. Applicant and the Trademark Examining Attorney have filed briefs and applicant has filed a reply brief. Applicant did not request an oral hearing.

We affirm the refusal to register.

In support of her surname refusal, the Trademark Examining Attorney has made of record the results of her search of a database containing over 115 million names, finding 778 "Hockaday" surname listings from PHONEDISC POWERFINDER USA ONE 1998 (4th ed.), as well as a page from *Merriam-Webster's Collegiate Dictionary* (10th ed.) 1998, showing that there is no listing of the term "Hockaday" in that dictionary. Along with the refusal to register, the Trademark Examining Attorney made of record excerpts from the LEXIS/NEXIS® database of periodical publications. The representative results of the search of that database show that HOCKADAY is the surname of a variety of individuals. The record also shows from repeated entries that it is the

name of a funeral home and a school.² Finally, the Trademark Examining Attorney submitted the results of a search of the U.S. Census Bureau's surname database.

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 "Hockaday" is a common English language word. In support of its position, applicant has submitted a dictionary entry from *Webster's Third New International Dictionary* (1981), where "hock day" is defined as "the second Tuesday after Easter celebrated in England before the 18th century..." Applicant also argues that the Trademark Examining Attorney has improperly dissected the mark rather than looking at the mark in its entirety.

² We note in this regard that surnames are routinely used as key parts of the names of businesses, schools and so forth, indicating the surnames of the people for whom they are named. See *Harris-Intertype, supra; In re Champion International Corp.*, 229 USPQ 550, 551 (TTAB 1985). Given that it is a common practice to name enterprises after individuals, it would be surprising if these institutions did not also trace the origin of these names to the surname of an entrepreneur, educator, *et al.*

The sole issue before us in this appeal is whether the mark applicant intends to use, HOCKADAY FUEL CELL, is primarily merely a surname within the meaning of Section 2(e)(4) of the Lanham Act. 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); In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975); and In re BDH Two, Inc., 26 USPQ2d 1556 (TTAB 1993). 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 her initial burden of establishing that "Hockaday" would be perceived by consumers as primarily merely a surname. In particular, the Trademark Examining Attorney has cited almost eight hundred HOCKADAY surname references from the PHONEDISC database, along with proof that the word "Hockaday" does not appear in an English-language dictionary. 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 HOCKADAY, while obviously not as common as some other surnames, has had measurable public exposure.³ Even if HOCKADAY is an uncommon surname, it is by no means a decidedly rare surname.⁴ From almost eight hundred HOCKADAY surname references in the PHONEDISC database, we conclude that HOCKADAY is a surname even if there are relatively few people in the United States having this name.

Applicant dismisses the hundreds of listings from the PHONEDISC database as representing "less than seven in one million" from among the American population. However, we find this "percentage-of-the-entire-population" argument to be a hollow reed. The rich diversity of surnames in this country is amply reflected in the PHONEDISC computer

³ To the extent applicant contends that HOCKADAY 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.

⁴ 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 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 that 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*.

database evidence. If one were to take a statistical measurement of this database for common names like "Smith" or "Johnson," each would constitute a relatively small fraction of the total database content.

As to the second Benthin factor, the Trademark Examining Attorney has demonstrated from applicant's own Web page that "Robert G. Hockaday, inventor of the Micro Fuel Cell™, incorporated Energy Related Devices in 1997 in order to facilitate the development of his micro fuel cell idea..." The text goes on to show that applicant has entered into an exclusive contract with Mr. Hockaday's ERD corporation and that Mr. Hockaday is now the largest single shareholder of applicant. Hence, that someone having the surname Hockaday is behind this critical fuel cell technology and continues to be associated with applicant supports the position of the Trademark Examining Attorney that members of the public will recognize this term as a surname.

In weighing the third Benthin factor, we note applicant's contention that "Hockaday" has recognized meanings other than that of a surname. However, as correctly pointed out by the Trademark Examining Attorney, because this entry was an exhibit attached to applicant's

appeal brief, its submission was manifestly untimely. The record must be complete prior to the time of the appeal. See 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, we have not considered this evidence in reaching our decision. We hasten to add that even if we were to consider this submission, it would not change the result herein. The only entries submitted by applicant to support this contention shows a different term, "hock day." The *Benthin* decision and our primary reviewing court clearly require that other meanings be "recognized" by a significant number of people. See *Harris-Intertype*, *supra*; *Benthin Management*, *supra*. Because applicant has actually found a different word, even if we considered this submission, it could not possibly rebut the Trademark Examining Attorney's *prima facie* surname case.

As to the fourth *Benthin* factor, contrary to applicant's contention, it is the view of the Board that HOCKADAY 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. In fact, judging this matter simply by its look and feel, HOCKADAY seems to fit the archetype of British surnames, such as Holliday, Holladay, Canaday, Faraday, Doubleday, *et al.*

Finally, as noted earlier, the entirety of the mark sought to be registered is HOCKADAY FUEL CELL. We must consider what the purchasing public would think when confronted with this mark as a whole.⁵ The entire record herein, beginning with the identification of goods, shows that "Fuel Cell" is a generic designation for these goods, and applicant has correctly agreed to disclaim this term. The term "Fuel Cell" adds nothing to the registrability of a mark applied to fuel cells, fuel cell tanks and fuel cell chemical fuels. Hence, when placing a surname in front of a generic designation for the goods, the primary significance of the resulting composite is still merely that of a surname. See In re Pickett Hotel Co., 229 USPQ 760 (TTAB 1986).

Decision: The refusal to register the mark HOCKADAY FUEL CELL under Section 2(e)(4) is affirmed.

⁵ In re Standard Elektrik Lorenz Aktiengesellschaft, 371 F.2d 870, 873, 152 USPQ 563, 566 (CCPA 1967).