

10/22/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 9  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Baldwin Hardware Corporation

Serial No. 75/620,714

Edgar A. Zarins, Esq. of Masco Corporation for Baldwin Hardware Corporation.

John S. Yard, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark FENWICK (in typed form) for "metal door hardware, namely, locks, latches, handles, knobs and levers," in Class 6.<sup>1</sup> The Trademark Examining Attorney has refused registration under Trademark Act Section 2(e)(4),

<sup>1</sup> Serial No. 75/620,714, filed January 14, 1999. The application is based on intent-to-use, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

15 U.S.C. §1052(e)(4), on the ground that FENWICK is primarily merely a surname.

When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have filed main briefs on appeal. Applicant did not file a reply brief, nor did applicant request an oral hearing. We affirm the refusal to register.

A term is deemed to be "primarily merely a surname," and thus unregistrable under Trademark Act Section 2(e)(4), if its primary significance to the purchasing public is that of a surname. The initial burden is on the Office to establish, *prima facie*, that the matter sought to be registered is primarily merely a surname. If that *prima facie* case is made by the Office, the burden then is on the applicant to rebut that showing with evidence establishing that the primary significance of the term is other than that of a surname. See *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).

In support of the refusal, the Trademark Examining Attorney has submitted evidence showing that 1,811 residential listings for FENWICK were retrieved from a search of the PHONEDISC POWERFINDER USA ONE database (4<sup>th</sup> ed. 1998), a database which includes 115 million names, addresses and phone numbers gathered from address lists and

telephone directories. The first one hundred of these listings were printed out and made of record. The Trademark Examining Attorney also has submitted excerpts of the first fifty (of 38,153) stories retrieved from the NEXIS database in response to the search request FENWICK.<sup>2</sup> The designation appears in these excerpts nine times as the surname of an individual or family, and variously otherwise as a street name, the name of a high school, and the name of a town. Finally, the Trademark Examining Attorney has submitted an excerpt from Webster's II New Riverside University Dictionary (1994), showing that there is no entry therein for FENWICK.

Applicant has not submitted any evidence in support of its opposition to the refusal of registration.<sup>3</sup> Instead, applicant argues that the 1,811 PHONEDISC listings for FENWICK made of record by the Trademark Examining Attorney

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<sup>2</sup> Of the fifty printed excerpts, eighteen are derived from articles appearing in newswire reports or in foreign publications. Inasmuch as the issue to be determined in this case is the primary significance of the term FENWICK to purchasers in the United States, and because those purchasers cannot be deemed to have been exposed to these (presumably unpublished) newswire reports or to articles from foreign publications, we have given those eighteen excerpts no consideration. Cf. TMEP §1211.02(b)(1)(listings from foreign telephone directories not probative evidence).

<sup>3</sup> Applicant asserts in its appeal brief that it has submitted evidentiary materials with its brief, but no such materials are attached to the brief. In any event, such materials would be untimely and entitled to no consideration. Trademark Rule 2.142(d), 37 CFR §2.142(d).

are but a "minute ratio" of the 115 million total listings in that database, and that the Trademark Examining Attorney therefore has failed to make out a *prima facie* case that FENWICK is primarily merely a surname. Applicant also argues that FENWICK would be perceived as a fanciful term rather than a surname.<sup>4</sup>

We are not persuaded by applicant's arguments. The evidence of record shows that there are 1,811 residential listings under the surname FENWICK in the United States, representing a substantial number of households and persons bearing that surname. Even if these FENWICK listings comprise only a small percentage of the total listings in the PHONEDISC database, we nonetheless find that they are sufficiently numerous to establish that the purchasing public would readily recognize the surname significance of the term. This evidence also leads us to conclude, albeit necessarily somewhat subjectively, that FENWICK has more the "look and sound" of a surname than that of an arbitrary or fanciful term. Applicant has proffered no evidence, nor

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<sup>4</sup> Applicant also argues that the Trademark Examining Attorney's refusal is improper because FENWICK is "capable" of functioning as a trademark to distinguish applicant's goods from similar goods of others. Such capability is not the issue to be determined in this case, inasmuch as applicant seeks registration on the Principal Register, not on the Supplemental Register.

any reasoning, to support its contention that FENWICK would likely be perceived by purchasers to be a fanciful term.

Likewise, there is no basis in the record for concluding that this surname significance of FENWICK is not its primary significance. The NEXIS evidence submitted by the Trademark Examining Attorney shows that, in addition to surname usage of FENWICK, there are streets or avenues named "Fenwick" in Augusta, Georgia, Tampa, Florida, and Memphis, Tennessee, a "Fenwick High School" in Oak Park, Illinois and another in Middletown, Ohio, and a neighborhood or town in or near Charleston, South Carolina called "Fenwick." However, we agree with the Trademark Examining Attorney's contention that these obscure geographic uses of FENWICK are likely to be perceived as being derived from the primary surname significance of the term. See *In re Harris-Intertype Corporation*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975).

In short, we find that the Trademark Examining Attorney has made the requisite *prima facie* showing that FENWICK is primarily merely a surname, and that applicant has failed to rebut that showing by showing that the primary significance of the term is other than that of a surname. In view thereof, we conclude that the Section

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2(e)(4) refusal to register FENWICK on the Principal Register is proper.

Decision: The refusal to register is affirmed.