

12/20/01

**THIS DISPOSITION
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Paper No.
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Durney Winery Corporation

Serial Nos. 75/704,360 and 75/570,906

John S. Hale of Hale & Gipple for applicant.

Zhaleh Sybil Delaney, Trademark Examining Attorney, Law
Office 101 (Jerry Price, Managing Attorney).

Before Quinn, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Durney Winery Corporation has filed two trademark
applications to register the marks HELLER VINEYARD¹ and
HELLER ESTATES² for "wine." The applications include
disclaimers of, respectively, VINEYARD and ESTATES.

The Trademark Examining Attorney has issued a final
refusal to register under Section 2(e)(4) of the

¹ Serial No. 75/704,360, in International Class 33, filed May 13, 1999,
based on an allegation of a bona fide intention to use the mark in
commerce.

² Serial No. 75/570,906, in International Class 33, filed October 14,
1998, based on an allegation of a bona fide intention to use the mark in
commerce.

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Trademark Act, 15 U.S.C. 1052(e)(4), on the ground that HELLER is a surname and each of applicant's marks is primarily merely a surname.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register in each application.

It is the Examining Attorney's position that the primary significance of each of applicant's marks is that of a surname. First, the Examining Attorney contends that "Heller" is primarily merely a surname. In support thereof, she has made of record surname listings of "Heller" from *Phonedisc Powerfinder USA One 1998* (4th edition), a nationwide computerized database of names and phone numbers, showing 12,645 individuals, out of approximately 115 million listings, with this surname. She has also submitted numerous excerpts of articles retrieved from the LEXIS/NEXIS database, all of which demonstrate use of the term "Heller" as a surname.

Regarding the mark HELLER VINEYARD, the Examining Attorney contends that VINEYARD is highly descriptive, if not generic, in connection with wine. As proof, she submitted a dictionary definition of "vineyard" as "land

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devoted to the growing of grapevines,"³ and excerpts of articles retrieved from the LEXIS/NEXIS database demonstrating use of the term "vineyard" in connection with wine and wineries. The Examining Attorney also submitted copies of six third-party registrations for marks identifying wines that include the term VINEYARD, and four of the marks precede the term VINEYARD with what the Examining Attorney contends is a surname.⁴ Each of these marks is registered on the Supplemental Register or on the Principal Register under Section 2(f), and each includes a disclaimer of VINEYARD.

Similarly, regarding the mark HELLER ESTATES, the Examining Attorney contends that ESTATES is highly descriptive, if not generic, in connection with wine. As proof, she submitted the following excerpt from *The Wines of America*, by Leon D. Adams (Houghton Mifflin Company, 1973):

What does "Estate Bottled" on wine labels mean? Originally this was the rare designation permitted only for use by the small wine-growing estates. ... But recent Federal rulings in individual cases have allowed certain vintners to label whole assortments of wines as "Estate Bottled" when the grapes came from vineyards they do not own ... [t]he rulings only limit

³ *The Complete Beverage Dictionary*, 2nd edition.

⁴ PHELPS VINEYARD, SHEA VINEYARD, PONZI VINEYARDS, and SANGIACOMO VINEYARD.

"Estate Bottled" to mean that the vineyards are in the same county as the winery and that the grapes are grown under the winery's control.

She also submitted excerpts of articles retrieved from the LEXIS/NEXIS database demonstrating use of the term "estate" and "estates" in connection with wine and wineries.

The Examining Attorney concludes that the primary significance of HELLER is as a surname, and that VINEYARD and ESTATES in the respective marks neither detract from that surname significance nor render the marks HELLER VINEYARD and HELLER ESTATES more than primarily merely surnames.

On the other hand, applicant contends that the primary significance of HELLER is not as a surname, stating that HELLER is not a common surname, it does not have the clear look and feel of a surname, and it has other meanings. Applicant submitted two separate dictionary definitions of "heller" as "a person who behaves recklessly"⁵ and "a small coin formerly current in Germany."⁶

Additionally, applicant contends that neither VINEYARD nor ESTATES is generic in connection with wines

⁵ *The American Heritage Dictionary*, 3rd ed., 1993.

⁶ *The Compact Edition of the Oxford English Dictionary*, vol. 1, 1971.

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and, thus, even if HELLER is a surname, the marks in their entireties are registrable. Applicant argues, further, that, regardless of whether the terms VINEYARD and ESTATES are generic or descriptive, the PTO has registered, for wines, marks that include disclaimers of those terms. In support of this statement, applicant submitted copies of third-party registrations of marks for wines that include the disclaimed terms VINEYARD and ESTATE, respectively. Many of these registrations are not pertinent because the marks clearly do not involve surnames, include design elements, or are on the Supplemental Register or on the Principal Register under Section 2(f). However, there are a small number of third-party registrations in this submission that are for marks that appear to be surnames followed by either VINEYARD or ESTATE.⁷ These marks are on the Principal Register and include a disclaimer of VINEYARD or ESTATE.

It is well established that the Office has the burden of establishing a *prima facie* case that a term is primarily merely a surname, and that the test for determining whether a mark is primarily merely a surname

⁷ For example, COLLINS VINEYARD, CUTRER VINEYARD, KENDON ESTATE, CRANSWICK ESTATE, MISCHLER ESTATES, PELLER ESTATES, LEETON ESTATE, and GAUER ESTATE VINEYARD.

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is the primary significance of the mark as a whole to the purchasing public. *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993) and cases cited therein. 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.⁸ *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Further, the inclusion in a mark of a generic or merely descriptive term does not preclude its surname significance if, when considered as a whole, the primary significance of the mark to the purchasing public is that of a surname. See *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *In re Woolley's Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991); and *In re E. Martinoni Co.*, 189 USPQ 589, 591 (TTAB 1975). See also *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1942-43 (TTAB 1993); and *In re Pickett Hotel Co.*, 229 USPQ 760, 761-62 (TTAB 1986).

⁸ The imperative to consider each case on its particular facts is readily apparent in this case where both the Examining Attorney and applicant have cited third-party registrations, which would appear to be contradictory in support of their respective positions. Clearly, we do not know the facts in those cases and, thus, we rely on the facts herein.

The Examining Attorney has clearly established, prima facie, that the primary significance of HELLER is as a surname. Applicant's evidence of obscure meanings of the term "heller" does not persuade us otherwise. Further, it is not necessary for us to determine that HELLER is a "common" surname.

We disagree with applicant's assertions that the addition to HELLER of VINEYARD and ESTATES, respectively, renders the marks in their entireties not primarily merely surnames. As the evidence establishes, the terms VINEYARD and ESTATES are at least merely descriptive of wine. As applicant is undoubtedly aware, numerous wineries and other wine-makers use these terms, in both the singular and plural, as essentially generic designations for the place or establishment where wine is produced. Additionally, with respect to ESTATE, wineries and wine-makers use this term to signify that they control or own the vineyards which are the source of the grapes for the identified wine. Thus, as a synonym for winery, it clearly cannot be disputed that any wine producer, including applicant, has the right to use the words VINEYARD or ESTATES to denote the place, establishment and/or entity where its wine is produced. Similarly, as a synonym for vineyards under the control

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of the winery or wine-maker, any wine producer has the right to use the word ESTATE. As such, the addition of the highly descriptive, if not generic, terms VINEYARD and ESTATES to the term "HELLER," which the Examining Attorney has shown has primarily merely a surname connotation, simply does not create marks with other than surname significance when each is designation is considered as a whole. The primary significance of each such designation, in its entirety, is only that of a surname rather than any other meaning asserted by applicant.

Decision: The refusal under Section 2(e)(4) of the Act is affirmed in each application.