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Paper No. 9
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **China Bluestar (USA) Group, Inc.**

Serial No. 75/762,329

David W. Lee, Esq. for **China Bluestar (USA) Group, Inc.**

David E. Yontef, Trademark Examining Attorney, Law Office
105 (**Thomas Howell**, Managing Attorney).

Before **Cissel, Bottorff and Holtzman**, Administrative
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark "malan" (depicted in special form, in all lower case letters, (without quotation marks)), for "coffee shops, cafes, Chinese restaurants, buffet restaurants, and fast food restaurants."¹

The Trademark Examining Attorney has refused registration under Trademark Act Section 2(e)(4), 15 U.S.C.

¹ Serial No. 75/762,329, filed July 28, 1999. The application is based on intent-to-use, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

§1052(e)(4), on the ground that the mark applicant seeks to register 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; applicant did not file a reply brief. No oral hearing was requested. We affirm the refusal to register.

The Trademark Examining Attorney has made the following evidence of record: the results of a search of the PHONEDISC POWERFINDER U.S.A. ONE database (1999, 2nd ed.) which retrieved 540 listings for the surname "Malan" (out of a total of 115,000,000 listings); the results of a search of the NEXIS database (NEWS library, US file) which retrieved 5,493 articles from periodicals which include references to "Malan," and printouts of excerpts from thirty-one of those articles, in each of which the term appears as a different person's surname;² and printouts of excerpts from the online versions of the American Heritage Dictionary of the English Language (1992), Merriam Webster's Collegiate Dictionary (2000) and the Columbia Encyclopedia (2000), each of which includes a biographical

² The Trademark Examining Attorney, in his final office action to which the NEXIS stories were attached, asserts that these thirty-one excerpts are a representative sample of the stories retrieved by the search. There is nothing in the record which contradicts the Trademark Examining Attorney's assertion.

entry for Daniel Francois Malan, who is identified as a South African politician who was the prime minister of South Africa from 1948-1954.

Applicant has submitted (for the first time, as attachments to its appeal brief) the following materials:³ applicant's Chinese trademark registration of the mark "malan and design"; applicant's Chinese trademark registration of a mark which consists of two Chinese-language ideogram characters; samples of applicant's advertisements and business stationery, and photographs of the signage for applicant's restaurants; and printouts from the Office's TESS database of various third-party registrations.

In deciding whether or not a term is primarily merely a surname and thus is unregistrable under Section 2(e)(4), we must determine the primary significance of the term to the purchasing public. *See In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The Office bears the initial burden of establishing, *prima facie*, that the primary significance of the term to the purchasing public

³ Because the Trademark Examining Attorney, in his brief, has not objected to applicant's untimely submission of these materials, we have not excluded them pursuant to Trademark Rule 2.142(d), but rather have considered them for whatever probative value they might have. (As discussed *infra*, we find that these materials in fact have little or no probative value.)

is merely that of a surname. If that *prima facie* showing is made, then the burden of rebutting that showing, i.e., the burden of showing that the primary significance of the term to the purchasing public is other than that of a surname, shifts to applicant. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Harris-Intertype Corp.*, *supra*; *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984).

The determination as to whether the mark's primary significance to the purchasing public is that of a surname takes into account various factors, such as: (i) the degree of a surname's rareness; (ii) whether anyone connected with applicant has the surname in question; (iii) whether the term in question has any recognized meaning other than that of a surname; (iv) whether the term has the "look and sound" of a surname; and (v) if the mark sought to be registered is depicted in special form, whether the degree of stylization of the mark is so great as to create a separate commercial impression which renders the mark, as a whole, not "primarily merely a surname." See *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

For the reasons discussed below, we find that the evidence made of record by the Trademark Examining Attorney suffices to establish, *prima facie*, that the primary significance of the mark to the purchasing public is that of a surname. We further find that applicant has failed to rebut that *prima facie* showing by demonstrating that the primary significance of the mark is other than that of a surname.

Applicant argues that the Trademark Examining Attorney's evidence establishes, at best, that "Malan" is a rare surname, inasmuch as the 540 PHONEDISC listings for that name comprise only .00000469 of the 115,000,000 total listings in that database.⁴ However, although the number of listings for the surname "Malan" retrieved from the PHONEDISC database perhaps is not particularly large as a

⁴ Applicant also argues that the Office has allowed many other much more common surnames, such as HUGHES, to be registered. However, the presence on the register of other surname marks, such as the HUGHES marks relied on by applicant, is not particularly relevant or probative evidence on the question of whether applicant's mark is registrable. A mark which is primarily merely a surname, and thus unregistrable under Trademark Act Section 2(e)(4), may nonetheless be registrable under Section 2(f) if the requisite claim and showing of acquired distinctiveness have been made. Review of the HUGHES registrations made of record by applicant shows that most of them, in fact, are registered pursuant to Section 2(f). Applicant has made no Section 2(f) claim or showing of acquired distinctiveness in this case. See *e.g.*, *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991); *In re McDonald's Corp.*, 230 USPQ 304 (TTAB 1986); and *In re Royal Overseas Traders, Inc.*, 184 USPQ 575 (TTAB 1974).

percentage of the total number of listings in that database, we find that it nonetheless represents a not insubstantial or de minimis number of households of persons bearing this surname. See *In re Etablissements Darty et Fils, supra*, 225 USPQ at 653 ("Nor can the interests of those having the surname DARTY be discounted as de minimis"). Additionally, the NEXIS evidence of record shows that numerous articles, published in periodicals of national circulation, have referred to many different persons having the surname "Malan," and thereby have exposed the surname significance of the term to readers around the country. See *In re Rebo High Definition Studio Inc., supra*. Finally, the surname significance of "Malan" is evidenced by the fact that there is an historical personage bearing the surname "Malan", i.e., Daniel Francois Malan, who is of sufficient notoriety that biographical references to him appear in three different standard reference works.

Thus, on this record, we find that "Malan" is not so rare a surname as to preclude a finding that its primary significance to the purchasing public is, in fact, that of a surname. See also *In re Etablissements Darty et Fils, supra*, 225 USPQ at 653 ("Thus, as a surname, DARTY is not so unusual that such significance would not be recognized

by a substantial number of persons"). In any event, even a rare surname is unregistrable under Section 2(e)(4) if it can be concluded from the evidence of record that the surname significance of the term is its primary significance to the purchasing public. See *In re Etablissements Darty et Fils, supra*; *In re Rebo High Definition Studio Inc., supra*; and *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988).

In this case, there is no evidence that "malan" has any recognizable non-surname meaning or significance, much less any non-surname significance which would be the term's primary significance to the purchasing public. There is no dictionary or other evidence which discloses a non-surname meaning for "malan," and applicant has conceded that the term has no non-surname meaning or significance in English. (See Applicant's May 15, 2000 Response to Office Action.)

However, applicant asserts (without submitting any corroborative evidence) that Chinese-speaking members of the purchasing public are aware that "malan" is not a Chinese surname, but rather is a transliteration of two Chinese-language ideogram characters which translate, in English, to the arbitrary and fanciful term "horse staple." Applicant also asserts that, in its advertisements and

signage, etc., applicant always uses "malan" in conjunction with those Chinese ideogram characters.

Even assuming *arguendo* that applicant's unsupported assertions are accurate, we are not persuaded that the primary significance of "malan" to the purchasing public would be "horse staple," rather than its surname significance. The fact that it is not a Chinese surname is not dispositive. There is no evidence from which we might conclude that non-Chinese-speaking persons in the United States, who must be presumed to make up a substantial portion of the relevant purchasing public for the recited services, would understand or know that "malan" means "horse staple." Nor is there any basis in the record for concluding that such purchasers would understand the meaning or significance of the Chinese ideogram characters (which, in any event, are not included in the drawing of the mark applicant seeks to register). On this record, we find that "malan" has no recognizable non-surname significance.

Finally, we are not persuaded by applicant's argument that the mark will not be viewed as a surname because it is a special form mark depicted in all lower-case letters rather than, as is usual for a surname, a capital letter followed by lower-case letters. This minimal degree of

stylization does not suffice to change the commercial impression of the mark from that of a surname to that of a service mark. See *In re The Directional Marketing Corporation*, 204 USPQ 675 (TTAB 1979)(mark's significance as primarily merely a surname not negated by its depiction in all lower-case letters). Furthermore, we find that there is nothing about the term itself which, when it is used in connection with the recited services, detracts from its surname significance. Compare *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994)(SAVA, for secure communications systems, has "the look and sound" of an acronym, not a surname); *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993)(GRAINGERS, for crackers and snack chips made from grain, more likely to be perceived as suggestive of the grain-based nature of the goods than as a surname).

In summary, in view of the evidence of record which clearly establishes the surname significance of "malan," i.e., the PHONEDISC listings, the NEXIS articles, and the dictionary and encyclopedia biographical entries, and in view of the absence of any evidence showing that "malan" has any recognizable non-surname significance to the purchasing public, we find that the Trademark Examining Attorney has made out a *prima facie* case that the primary significance of "malan" to the purchasing public is that of

a surname. We also find that applicant has failed to rebut that prima facie showing. Although "malan" is not the surname of anyone associated with applicant, and perhaps is not the most common of surnames, we cannot conclude on this record that the surname is so rare, or that the mark looks and sounds so unlike a surname, that its clearly-established surname significance is not also its primary significance to the purchasing public.

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