

9/23/02

Paper No. 15
Bottorff

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rosen Hotels & Resorts, Inc.

Serial No. 76/013,339

David L. Sigalow of Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A. for Rosen Hotels & Resorts, Inc.

Jason E. Lott, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ROSEN HOTELS & RESORTS (in typed form; HOTELS & RESORTS has been disclaimed) for "providing facilities for business meetings" in Class 35, and "hotel, motel and

resort services; and providing facilities for banquets and social facilities" in Class 42.¹

The Trademark Examining Attorney has refused registration under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4), on the ground that applicant's mark is primarily merely a surname. When the refusal was made final, applicant filed this appeal. The appeal has been fully briefed, but 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 USA electronic database (1999-2000) which retrieved 62,320 listings for the surname ROSEN; forty excerpts of articles obtained from the NEXIS database which refer to persons with the surname ROSEN; an excerpt from Webster's New World Dictionary of the English Language which shows no entry for ROSEN; and dictionary definitions of "hotel" and "resort."² For its part, applicant has made

¹ Serial No. 76/013,339, filed as an intent-to-use application on March 3, 2000. Applicant filed an Amendment to Allege Use on August 25, 2000, in which it alleged July 1, 2000 as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

² These last definitions were attached to the Trademark Examining Attorney's brief, and he has requested that we take judicial notice thereof. The request is granted. The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ

of record printouts of fifteen third-party Principal Register registrations of marks which include the term ROSEN.

In deciding whether or not a mark 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 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). Finally, it is well-settled that if the mark sought to be registered includes a

594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01.

term which, standing by itself, is primarily merely a surname, the Section 2(e)(4) refusal may not be avoided or overcome merely by adding wording which is generic for the goods or services or otherwise incapable of functioning as a mark. See, e.g., *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993); see also TMEP §1211.01(b)(vi)(3d ed. 2002).

The Office bears the initial burden of establishing, prima facie, that the primary significance of the term to the purchasing public 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).

Applying these principles in the present case, we find as follows. First, we reject applicant's argument (raised for the first time in its appeal brief) that the presence in its mark of the wording HOTELS & RESORTS precludes a

finding that the mark, considered as a whole, is primarily merely a surname. HOTELS & RESORTS is generic wording as applied to applicant's services, which include hotel and resort services. Applicant's arguments to the contrary are without merit. Because the wording HOTELS & RESORTS is generic and lacks any source indicating capability as applied to applicant's services, the inclusion of that wording in applicant's mark will not overcome a Section 2(e)(4) basis for refusal, if such refusal is otherwise warranted. *In re Hamilton Pharmaceuticals, supra.*

Thus, we turn to the key issue in this case, i.e., whether the primary significance of ROSEN is its surname significance. There is no evidence that anyone associated with applicant bears the surname ROSEN, a fact which weighs in applicant's favor. However, the remaining *Benthin* factors clearly weigh in favor of a finding that the primary significance of ROSEN is its surname significance. Applicant's mark is not depicted in any special form which would negate or detract from the surname significance of the mark. Further, ROSEN is not a rare surname; the Trademark Examining Attorney's evidence establishes that there are 62,320 telephone listings for the surname ROSEN. We find that this is a quite substantial number of persons in this country with the surname ROSEN. 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 ROSEN, and thereby have exposed the surname significance of the term to readers around the country. See *In re Rebo High Definition Studio Inc.*, *supra*. ROSEN indisputably has the "look and sound" of a surname. Finally, there is no dictionary or other evidence which establishes that ROSEN 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.

Based on this evidence, we find that the Trademark Examining Attorney has established, *prima facie*, that the primary significance of ROSEN is its surname significance. We further find that applicant has failed to rebut that *prima facie* showing by establishing that the primary significance of ROSEN is other than that of a surname. First, as discussed above, the 62,320 telephone listings for ROSEN made of record by the Trademark Examining Attorney belie applicant's contention that ROSEN is a such a rare surname that its primary significance must be other than as a surname.

Applicant also argues, however, that the presence of the term ROSEN in the fifteen third-party registrations

applicant has submitted establishes that the primary significance of the term ROSEN to the purchasing public is that of a trademark or service mark, rather than that of a surname. We are not persuaded. That these marks are registered on the Principal Register does not establish that the primary significance of ROSEN is other than that of a surname; it establishes only that marks which include the surname ROSEN may be registered on the Principal Register in certain special circumstances, i.e., where the registrant has made the requisite showing that ROSEN has acquired secondary meaning as a trademark or service mark for the registrant's goods or services in addition to its primary significance as surname, or where the mark includes additional distinctive wording or design elements which insulate the mark from a Section 2(e)(4) refusal. None of those special circumstances is present in this case.

In summary, and for the reasons discussed above, we find that the evidence of record establishes, prima facie, that the primary significance of applicant's mark 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.

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