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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Applied Materials, Inc.

Serial No. 76/249,601

Robert W. Mulcahy for Applied Materials, Inc.

Scott M. Oslick, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 7, 2001, applicant, a corporation organized and existing under the laws of the state of Delaware, filed the above-referenced application to register the mark HART on the Principal Register for "equipment and machines for processing, manufacture and production, of semiconductor substrates, thin films, silicon discs and wafers; namely, plasma generating equipment and machines," in International Class 9. As the basis for filing the application, applicant asserted that it possessed a bona fide intention

to use the mark in commerce in connection with these products.

The original Examining Attorney assigned to this application refused registration under Section 2(e)(4) of the Lanham Act, 15 U.S.C. Section 1052(e)(4), on the ground that the proposed mark is primarily merely a surname.

Attached in support of the refusal to register were the results of a search the Examining Attorney had conducted on the infoUSA electronic database, formerly known as Phonedisc. The search identified 82,774 individuals in the United States who have the surname "Hart." A representative sampling giving complete names, addresses and telephone numbers was included. The Examining Attorney also held the wording in the identification-of-goods clause to be unacceptably indefinite, and suggested an amended version thereof which applicant could adopt if it were accurate. Additionally, applicant was asked to submit samples of advertisements or promotional materials for goods of the type with which it intends to use the mark.

Applicant responded to the first Office Action by amending the application to identify its goods as "plasma generating equipment and machines for the processing and production of semiconductor substrates, thin films, silicon discs and wafers; namely epitaxial reactors, chemical vapor

deposition reactors, physical vapor deposition reactors, plasma etchers, ion implanters, and chemical mechanical polishers," in Class 9, and submitted applicant's product information report in response to the request of the Examining Attorney for promotional materials.

With respect to the refusal to register, applicant asserted that "while 'HART' is a recognized personal name, is not likely to be perceived by the general public or customers in the semiconductor processing business as a personal name when used, as in the case of the instant mark, in connection with semiconductor fabrication equipment." Furthermore, argued applicant, in connection with applicant's products, the mark sought to be registered would likely be perceived as "HEART," rather than being associated with the name "HART."

The Examining Attorney accepted the proposed amendment to the identification-of-goods clause in the application, but was not persuaded to withdraw the refusal to register. Citing TMEP Section 1211.01(a)(ii) and *In Re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986), he pointed out that a term may have as its primary significance that of the surname even if a phonetic equivalent of the term has an ordinary meaning in our language. The refusal to register was made final.

Applicant responded to the final refusal with more argument against it, and submitted copies of three third-party registrations for marks consisting of or including the name "HART" for, inter alia, health club services, television production services and videotapes featuring adult drama.¹ Applicant contended that these registrations demonstrate that in addition to its surname significance, "'HART' can be a trademark... as prospectively used herein..." in connection with semiconductor processing equipment. Concurrently with this response, applicant timely filed a Notice of Appeal.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's request. Finding that no new facts or arguments were presented therein, the Examining Attorney maintained the final refusal and returned the application to the Board for resumption of action on the appeal.

Applicant filed its appeal brief and the Examining Attorney designated above, to whom this application had been reassigned, filed his brief on appeal. Applicant did not request an oral hearing before the Board. Accordingly,

¹ Reg. Nos. 2,471,756, 2,144,137 and 2,115,188, issued to three different entities.

we have resolved this appeal based on the written materials made of record in this application and the written arguments presented in the briefs.

The sole issue before us in this appeal is whether the refusal to register HART under Section 2(e)(4) of the Lanham Act is proper. Because the Examining Attorney has met his burden of establishing that the primary significance of the term sought to be registered is that of a surname, the refusal to register is appropriate.

The test for registrability under this section of the Act is well settled. The issue is whether the primary significance of the term to the purchasing public is that of a surname. In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975). The initial burden is on the Examining Attorney to present evidence sufficient to make a prima facie showing of the surname significance of the word. Once this is accomplished, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993).

Plainly, the Examining Attorney has met his burden by submitting the results of the search of the infoUSA database, which establish that "Hart" is the surname of almost 83,000 individuals in this country. It is

significant applicant does not dispute this fact. As noted above, applicant concedes that the evidence made of record by the Examining Attorney "demonstrates that HART is commonly used as a surname." (brief, p. 1) Applicant's argument, to the extent that we understand it, is that even though the Examining Attorney has demonstrated the surname significance of HART, the primary significance it would have to the people purchasing applicant's semiconductor processing equipment is not that of the surname, but instead, these people would attribute the source-identifying significance of a trademark to the word. Applicant seems to be arguing that because the word "heart" is the phonetic equivalent of the name "HART," the meaning of the former term, which has neither descriptive significance nor surname significance in connection with the goods specified in this application, would be the primary significance attributed to the name by prospective purchasers. The second prong of applicant's argument is that because no one named Hart is connected to or associated with applicant's business, as applied to semiconductor processing equipment, HART does not have the look or feel of the surname, especially in view of the third-party registrations of the name.

None of applicant's arguments is persuasive. An obscure surname or one that is unlike a surname in appearance or connotation may not fall within the prescription of Section 2(e)(4) of the Act. See *In re Bentin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995); and *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994). In the instant case, however, applicant has presented absolutely no evidence upon which the Board could base the conclusion that the primary significance of HART is anything other than that of a surname. Without any such evidence, we simply cannot adopt applicant's argument.

With regard to the three third-party registrations argued by applicant to support withdrawal of the refusal to register, it is unclear from the evidence submitted by applicant whether these registrations issued under the provisions of Section 2(f) of the Act based on acquired distinctiveness, but in any event, even if these registrations had been issued in error, the Board would not thereby be bound to repeat such mistakes.

In its brief, applicant refers to additional third-party registrations, but as the Examining Attorney points out, proper copies of these registrations were never submitted. Moreover, the submission of evidence with applicant's appeal brief was untimely under Trademark Rule

2.141(d), so we would not have considered them even if applicant had submitted appropriate copies of Office records, and even if we did, their probative value would have necessarily been limited without information as to whether such registrations were issued based on claims of acquired distinctiveness.

In summary, the Examining Attorney has satisfied his burden of establishing that the primary significance of HART is that of a surname, and applicant has not introduced any evidence which rebuts this conclusion.

DECISION: The refusal to register under Section 2(e)(4) of the Act is affirmed.