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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Polytechnic University

Serial No. 76090924

John C. Pokotylo of Straub & Pokotylo for Polytechnic University.

Russ Herman, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Seeherman, Hairston and Drost, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Polytechnic University to register the mark THE OTHMER INSTITUTE FOR INTERDISCIPLINARY STUDIES for "educational services, namely providing courses of instruction in the field of engineering and how scientific and technological methods affect and influence such instruction; providing courses of instruction on the impact that science and technology have on society and business; all such instruction to be

provided by a college, university, or facility for higher learning, for undergraduate students, graduate students, post graduate students and faculty fellows.”¹

The Trademark Examining Attorney has refused registration under Section 2(e)(4) of the Trademark Act on the ground that the mark sought to be registered is primarily merely a surname.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

We must first discuss an evidentiary matter. Applicant, with its brief on the case, submitted the results of a search of “Yahoo!” for persons with the surname “Othmer”; and printouts of excerpts retrieved from the U.S. Census Bureau database for the frequency of certain surnames, including surnames with the “-HMER” and “-MER” suffixes.

¹ Application Serial No. 76090924, filed July 17, 2000, alleging a date of first use anywhere of September 14, 1998 and a date of first use in commerce of April 1999.

Although the Examining Attorney noted in his appeal brief that applicant submitted this evidence for the first time on appeal, he did not specifically object to the evidence as being untimely. Further, the Examining Attorney, with his appeal brief, submitted the results of a "Google" search of the phrase "Institute for Interdisciplinary Studies." In this regard, the Examining Attorney stated:

Because applicant submitted for the first time on appeal evidence from a Yahoo search to support his argument that the term OTHMER is not a surname (see Exhibits D and E), the examining attorney has attached his own Google search showing that the term INSTITUTE FOR INTERDISCIPLINARY STUDIES has meaning to the relevant public... (Brief, p. 7).

Trademark Rule 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of the appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." There is no "quid pro quo" with respect to late-filed evidence. In other words, an Examining Attorney is not allowed to submit evidence for the first time with his or her appeal brief merely because an applicant has done so.

As indicated, the Examining Attorney did not object to applicant's evidence, and thus we consider the Examining Attorney to have stipulated this evidence into the record. However, because the evidence submitted with the Examining Attorney's appeal brief is untimely, we have given it no consideration in reaching our determination herein. We also note that such evidence goes to a different point from the evidence submitted by applicant; thus, it is not designed to rebut applicant's evidence regarding the surname significance of "Othmer."

We turn then to the refusal to register under Section 2(e)(4). The Examining Attorney maintains that the mark sought to be registered is primarily merely a surname. More specifically, the Examining Attorney argues that OTHMER is a surname, and that the addition of the assertedly generic designation INSTITUTE FOR INTERDISCIPLINARY STUDIES to the surname does not keep the mark as a whole from being primarily merely a surname.

In urging that the refusal to register be reversed, applicant argues that "Othmer" is a rare surname, and thus not primarily merely a surname; and that even assuming that "Othmer" has surname significance, the addition of the phrase "Institute for Interdisciplinary Studies" takes the

mark as a whole out of the category of being primarily merely a surname.

The burden is upon the Examining Attorney, in the first instance, to present evidence sufficient to make out a prima facie case in support of the contention that the mark is primarily merely a surname. Provided that the Examining Attorney establishes a prima facie case, the burden shifts to applicant to rebut the showing made by the Examining Attorney. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 23-240 (CCPA 1975). Further, in determining whether a mark is primarily merely a surname, the mark must be considered as a whole. In *re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988).

With respect to the surname significance of the term "Othmer," the Examining Attorney has made of record a printout retrieved from the "ReferenceUSA" database showing a sampling of the 140 listings for the surname "Othmer;" and excerpts from several articles retrieved from the NEXIS database referring to individuals with the surname "Othmer." The NEXIS search of "Othmer" resulted in 986 hits.

Also, we note from the brochure specimen of record that Donald F. Othmer was a longtime professor with

applicant and that applicant recently received a \$175 million bequest from the estates of Mr. Othmer and his wife, Mildred T. Othmer.

Applicant, on the other hand, submitted the results of a search of "Yahoo!" for persons with the surname "Othmer." The search resulted in 84 hits; ten separate names are listed.² Further, applicant submitted printouts of excerpts retrieved from the U.S. Census Bureau database for the frequency of certain surnames, including surnames with the "-HMER" suffix and "-MER" suffix. It appears from these printouts that surnames ending in "-HMER" and "-MER" rank low in terms of frequency.

Considering all of this evidence, we find that "Othmer" is a rare surname. Moreover, OTHMER has been combined with the term INSTITUTE FOR INTERDISCIPLINARY STUDIES. Thus, the ultimate issue in this case is whether the entire mark sought to be registered, THE OTHMER INSTITUTE FOR INTERDISCIPLINARY STUDIES, is primarily merely a surname.

² Three of these names also appear in the sampling of listings from the ReferenceUSA database.

Applicant argues that the phrase INSTITUTE FOR INTERDISCIPLINARY STUDIES does not immediately and unequivocally describe applicant's type of services and that, therefore, the term is not generic. Relying on *In re American Fertility Society*, 188 F.2d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), applicant argues that the evidence submitted by the Examining Attorney fails to establish that the composite phrase INSTITUTE FOR INTERDISCIPLINARY STUDIES is understood by the public to refer primarily to applicant's type of services. Thus, applicant contends, its addition to OTHMER removes the mark, when considered as a whole, from the primarily merely a surname category.

The Examining Attorney, on the other hand, contends that the phrase INSTITUTE FOR INTERDISCIPLINARY STUDIES is generic and that, accordingly, the combination of this term with the surname OTHMER results in a mark which, as a whole, is primarily merely a surname.

The Examining Attorney has submitted the following definitions from the The American Heritage Dictionary of the English Language (3rd ed. 1992):

institute: An educational institution, especially one for the instruction of technical subjects.

interdisciplinary: Of, relating to, or involving two or more academic disciplines that are usually considered distinct.

study: plural studies. A branch or department of learning.

In addition, the Examining Attorney submitted several excerpts of articles retrieved from the NEXIS database showing usage of the term "interdisciplinary studies." The following are examples:

Dennard, 22, already has his degree from Arizona State, a bachelor's in interdisciplinary studies earned last May.
(Albuquerque Tribune; October 25, 2001);

"... but I am excited about going and doing something for the community," said Almaya Wadley, a senior Interdisciplinary studies major at UTA.
(The Dallas Morning News; October 24, 2001); and

... Dyer, 34, an interdisciplinary studies major at Eastern Washington University, wanted to reach out to those who lost someone on the four crashed passenger jets.
(The Spokesman Review; October 20, 2001).

In this case, INSTITUTE FOR INTERDISCIPLINARY STUDIES is a phrase, and not a single or compound word. Thus, dictionary definitions of the individual words and descriptive/generic uses of constituent terms of the phrase are insufficient to establish genericness. See *American Fertility Society*, 51 USPQ2d at 1836. The Examining Attorney has failed to provide evidence showing that INSTITUTE FOR INTERDISCIPLINARY STUDIES is a generic phrase for applicant's type of educational services. Thus, we

find that this record does not establish that said phrase is generic as used in connection with applicant's services.

In view of the rareness of the surname OTHMER, and considering that it has been combined with INSTITUTE FOR INTERDISCIPLINARY STUDIES and this phrase has not been established to be generic, we find that the mark as a whole, THE OTHMER INSTITUTE FOR INTERDISCIPLINARY STUDIES, is not primarily merely a surname.

We note, however, that the evidence of record clearly establishes that INSTITUTE FOR INTERDISCIPLINARY STUDIES is merely descriptive of applicant's educational services.³ The phrase immediately conveys information about the nature of applicant's services, i.e., applicant is an educational institution with a department offering instruction in two or more usually distinct academic disciplines. Thus, applicant is required to disclaim the phrase INSTITUTE FOR INTERDISCIPLINARY STUDIES apart from the mark as shown.

Decision: The refusal to register under Section 2(e)(4) is affirmed in the absence of a disclaimer of INSTITUTE FOR INTERDISCIPLINARY STUDIES. However, in the

³ The refusal to register the mark absent a disclaimer of INSTITUTE FOR INTERDISCIPLINARY STUDIES is encompassed within the Examining Attorney's statement that this phrase is generic.

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event that applicant submits the required disclaimer within thirty days of the date of this decision, the refusal to register will be set aside, the disclaimer will be entered, and the application will proceed to publication.