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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aristocrat Technologies Australia Pty Ltd

Serial No. 76123722

D. Bruce Prout of Christie, Parker & Hale LLP for
Aristocrat Technologies Australia Pty Ltd.

Amos Matthews, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Simms, Hanak and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

On September 6, 2000 Aristocrat Technologies Australia Pty Ltd (applicant) filed an application pursuant to Section 44(e) of the Trademark Act seeking to register MR CASHMAN for "machines for playing games of chance and parts thereof." Applicant claimed ownership of Australian Trade Mark Number 755,405 for the identical mark for "gaming machines, including poker machines, and parts and accessories therefor." This Australian registration issued on February 18, 1998.

Citing Trademark Act Section 2(e)(4), the Examining Attorney has refused registration on the basis that

applicant's mark is primarily merely a surname. When the refusal to register was made final, applicant filed a main brief and a reply brief. The Examining Attorney filed a brief. Neither party requested a hearing.

To begin with, we note that "the PTO [has] the burden of establishing a prima facie case that [MR CASHMAN] is 'primarily merely a surname.'" In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Moreover, "the question of whether a [mark] sought to be registered is primarily merely a surname within the meaning of the statute can only be resolved on a case by case basis," taking into account a number of various factual considerations. Darty et Fils, 225 USPQ at 653.

In this case, we find that there are two primary factual considerations (factors) which lead us to conclude that as applied to "machines for playing games of chance and parts thereof," the mark MR CASHMAN is not primarily merely a surname. Accordingly, we reverse the refusal to register.

To be clear, in past cases this Board has identified at least five different factors that, depending on the facts of a particular case, could have a bearing on determining whether a particular mark is primarily merely a surname. See In re Benthin Management, 37 USPQ2d 1332,

1333 (TTAB 1995) and the numerous Board cases cited therein. For example, in Benthin, the Board noted that one factor to be considered was "the degree of a surname's rareness." See also In re Garan Inc., 3 USPQ2d 1537, 1540 (TTAB 1987) and In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). The theory is that a rare¹⁶⁹ surname is generally less likely to be perceived as primarily merely a surname.

The parties have addressed this first factual consideration. In this regard, the Examining Attorney has made of record a printout from a nation-wide phone directory - namely infoU.S.A. Version 2001 - showing that in various phone directories covering virtually the entire United States there are 2,457 individuals with the surname Cashman. In response, applicant properly made of record a report from the United States Census Bureau showing that "the United States was home to 284,796,887 residents on July 1, 2001." Thus, according to applicant, there is but one individual with the surname Cashman for every 114,000 United States residents.

However, while applicant and the Examining Attorney have presented evidence on whether Cashman is or is not a rare surname, we elect not to consider this factor because,

as previously noted, there are two other factors which are of primary significance in this case.

First, and of lesser importance, is whether there is "anyone connected with applicant" having the surname Cashman. Benthin, 37 USPQ2d at 1333; In re Monotype Corp., 14 USPQ2d 1070, 1071 (TTAB 1989); and Sava, 32 USPQ2d at 1381. In this regard, applicant has made of record the declaration of its Secretary (Fine Bush) stating that he has "checked the employee records [of applicant] and there are no employees or officers or ... anyone else connected with [applicant] with the name Cashman." The Examining Attorney has not challenged the declaration of Mr. Bush.

In short, this is not a situation where a company founder or other high ranking official chose to have his or her surname used in connection with machines for playing games of chance and parts thereof. Indeed, the Bush declaration demonstrates that there is not even a low ranking employee of applicant with the surname Cashman.

Second, and of far greater importance, is whether MR CASHMAN, when used in connection with machines for playing games of chance and parts thereof, has the "structure and pronunciation" of a surname, or stated somewhat differently, the "look and sound" of a surname. In re

Industrie Pirelli, 9 USPQ2d 1564, 1566 (TTAB 1988); Sava, 32 USPQ2d at 1381; and Benthin, 37 USPQ2d at 1333.

There is no dispute that applicant's machines for playing games of chance are also known as gambling machines or gaming machines, and the Examining Attorney does not contend to the contrary. Indeed, at page 7 of his brief, the Examining Attorney even refers to applicant's machine for playing games of chance as a "gaming machine."

Obviously, a gambling or gaming machine takes in from patrons cash, and to winners, dispenses cash. In this regard, we note that the word "cash" is defined to include both "bills and coins." Webster's New World Dictionary, (2d ed. 1974). When used in connection with a machine for playing games of chance, it is our firm view that patrons would not view applicant's mark MR CASHMAN as referring to an individual with the surname Cashman, but instead would view applicant's mark as suggesting that applicant's machines for playing games of chance involve the receipt of, and in some cases, the dispensing of cash.

We note that at page 6 of his brief, the Examining Attorney argues that "the test for whether a mark is primarily merely a surname is not determined in relation with the goods sought for registration." We simply disagree. Consumers do not view marks in the abstract.

Rather, they view marks in connection with the goods or services with which they are used. If applicant had sought to register MR CASHMAN for, as an example, men's apparel, then depending upon the record, MR CASHMAN may perhaps have been found to be primarily merely a surname. However, when used in connection with gambling machines or, as another example, automatic teller machines (ATMs), we find that consumers would view the mark not primarily merely as a surname, but rather as a suggestive term indicating that the machines (gambling machines or ATMs) accept and/or dispense cash.

By way of analogy, in determining whether a mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act, the mark's mere descriptiveness is never judged in the abstract, but rather is judged in relationship to the goods or services for which registration is sought. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 216 (CCPA 1978). We find that the same reasoning applies when the issue is whether a mark is primarily merely a surname. That is to say, the determination of whether a mark is primarily merely a surname should not be made in the abstract, but rather must be made in relation to the goods or services for which registration is sought.

One final comment is in order. In Benthin this Board held that in determining whether a mark is primarily merely a surname, it would "resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods or services can file a Notice of Opposition." Benthin, 37 USPQ2d at 1334. In so holding, this Board cited In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972) where the Board held that in determining whether a mark was merely descriptive of applicant's goods, it would resolve doubts in favor of the applicant.

Decision: The refusal to register is reversed.