

**This Opinion is Not
Citable as Precedent
of the TTAB**

Mailed:
March 26, 2004

Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re H. Lundbeck A/S

Serial No. 76268930

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Morris LLP for H. Lundbeck A/S.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Walters and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

H. Lundbeck A/S, a corporation of Denmark, has applied to register LUNDBECK as a mark for goods identified, following amendment, as "pharmaceutical preparations for use in the treatment of diseases of the central nervous system," in International Class 5; "printed instructional and teaching materials in the field of diseases of the central nervous system," in International Class 16; "educational services, namely, seminars, symposia and

course of instruction in the field of medicine," in International Class 41; and "medical services," in International Class 42.

The application is based on applicant's stated intention to use LUNDBECK as a mark "in international and in interstate commerce within the United States" and claims a priority filing date based on its filing of a European Community Trademark (CTM) application for registration of LUNDBECK in the same four classes, such application having been filed February 1, 2001. The instant application was filed within six months of the filing of the CTM application.

It is clear that applicant seeks registration under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), in addition to the implied basis under Section 44(e), 15 U.S.C. §1126(e).¹ Specific reference has been made to both Section 1(b) and Section 44(d) in the application. We note, however, in regard to the Section 44(d) claim of priority, that such a claim is available only in regard to the "first-filed" application in a "country of origin."

¹ Because a claim of priority under Section 44(d) provides a basis for filing but not a basis for registration, the Office presumes that an applicant relying on Section 44(d) for filing will rely on Section 44(e) for registration, in addition to any separate reliance on use or intent-to-use. See TMEP Section 1003.03.

Ser No. 76268930

See Section 44(d)(1) of the Trademark Act and TMEP Section 1003.01, as to the "first-filed" requirement, and TMEP Section 1002.04 and Appendix B as to the "country of origin" issue and applicant's reliance on a CTM application.

Concurrently pending before this panel of the Board is applicant's appeal of a refusal to register LUNDBECK as a mark solely in International Class 5, Serial No. 76268929.² That application is based on Section 44(e) and applicant's ownership of a Danish registration that issued July 1, 1950. Thus, it appears clear that applicant's CTM application is not the "first-filed" application to register LUNDBECK for these Class 5 goods. Therefore, it appears that applicant's claim of priority should be limited to its Class 16 goods and its Class 41 and 42 services. If applicant is ultimately successful in this appeal, it will obtain a Notice of Allowance, because the one basis for the application, as to all involved classes, is applicant's intent to use the mark in commerce. If applicant ultimately obtains its Notice of Allowance, it should thereafter file an amendment to its application deleting the claim of priority as to its Class 5 goods.

² The Class 5 goods in the single class application are identical to the Class 5 goods in the four class application involved in

Unrelated to the basis or bases of the application, the examining attorney has refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4) on the ground that LUNDBECK is primarily merely a surname. Applicant was offered the opportunity to pursue registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), with various options outlined for establishing acquired distinctiveness. Applicant did not amend to seek registration under Section 2(f). When the refusal of registration was then made final, applicant appealed. Applicant and the examining attorney filed briefs, but applicant did not request an oral hearing. We affirm the refusal of registration.

As a preliminary matter, we note the examining attorney's objection to exhibit E to applicant's appeal brief. While the other exhibits to the brief all are items that were submitted during prosecution of the application, exhibit E was not. Accordingly, we sustain the examining attorney's objection to this exhibit and have not considered it. See 37 C.F.R. §2.142(d).

The record in this case otherwise includes 56 listings of individuals with the surname LUNDBECK, retrieved by the

this appeal, i.e., "pharmaceutical preparations for use in the treatment of diseases of the central nervous system."

examining attorney from a computerized database of telephone listings; three article excerpts retrieved by the examining attorney from the NEXIS database each of which refers to an individual with the surname LUNDBECK; a printout from the electronic version of The American Heritage Dictionary of the English Language, showing that LUNDBECK does not appear between the listings of LUND and LUNDEBERG; photocopies of certain pages from the Manhattan (NY) telephone directory, showing no listings for LUNDBECK; photocopied pages from three dictionaries of names and surnames, none of which includes a listing for LUNDBECK; a list of the "hits" or "search results" obtained by applicant when LUNDBECK was entered into a web browser to search for web pages featuring the word, but the pages themselves were not provided; 50 excerpts retrieved by applicant from the NEXIS database showing use of LUNDBECK or H LUNDBECK A/S, primarily in wire service reports but also in some articles; and reprints of various web pages from the applicant's web site.

The Office has the burden of establishing a prima facie case that a term is primarily merely a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Moreover, "[t]he question of whether a word 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. Id.

There are five accepted factors to be considered in the analysis:

- (1) Is the word a common or rarely used surname?
- (2) Does anyone connected with the applicant have that surname?
- (3) Does the word have meaning other than as a surname?
- (4) Does the word look and sound like a surname?
- (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression?

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995) (Examining attorney's refusal to register BENTHIN reversed, because it was a rare surname, did not look and sound like a surname, and was set forth in a highly stylized oval design).

In this case, there is no stylization or design involved; applicant seeks merely to register LUNDBECK in typed form. Thus, the fifth factor is not a factor in this case.

The examining attorney has conceded that LUNDBECK is a rare surname. Final refusal, unnumbered p. 2 ("Moreover, though only '56' LUNDBECK references were listed, the term may in fact be a rare surname.") Even if the examining attorney had not conceded the point, we would find LUNDBECK to be a rare surname.

As to the second factor, applicant asserts that LUNDBECK is not the surname of anyone within applicant's corporate management or supervisory board. Nonetheless, as applicant's web pages readily reveal, applicant's company name and mark are derived from the name of its founder "Hans Lundbeck." Any visitor to applicant's web pages would be exposed to this information on applicant's company history and realize that LUNDBECK is a surname.

Applicant's reliance on In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994) and In re Monotype Corp., 14 USPQ2d 1070 (TTAB 1989), is misplaced. It is not necessary that a current employee, supervisor or corporate manager of applicant have the surname LUNDBECK for the "connected with" factor to weigh in favor of finding the word a surname. We find particularly significant the fact that the founder of applicant, an individual prominently discussed on applicant's website, was named LUNDBECK.

While employees and even managers or directors may come and go, applicant will always have the same founder.

Applicant and the examining attorney obviously differ in their estimation of whether LUNDBECK has significance other than as a surname. The examining attorney relies on the absence of LUNDBECK from the listings of an electronic dictionary to conclude that the word has no meaning other than as a surname. While applicant concedes "LUNDBECK may not have other recognized meanings," based on its "Google" search results, and its NEXIS excerpts, applicant argues that "the relevant purchasing public will recognize the mark as being associated with products and services relating to the treatment of the central nervous system and not as primarily merely a surname." Brief, p. 11. The examining attorney, citing In re McDonald's Corp., 230 USPQ 304 (TTAB 1986), argues that this evidence is only relevant in establishing distinctiveness under Section 2(f) and cannot provide support for registration on the Principal Register without a claim of acquired distinctiveness.

We agree with the examining attorney and find the *McDonald's* case on point. In that case, the "McDonald's" restaurant chain was denied registration of its mark on the Principal Register, despite a survey which showed 85 percent of respondents thought of hamburgers, golden arches

or a restaurant when they think of the word "McDonald's."
Id. In affirming the examining attorney's refusal of registration, the Board held that the section of the Trademark Act prohibiting registration of surnames requires focus on the ordinary meaning of a word, without regard to what secondary meaning the word may have acquired as the result of promotion or advertising, absent a claim of acquired distinctiveness. Id. Accordingly, we agree with the examining attorney that LUNDBECK's ordinary meaning is as a surname and nothing else.

Moreover, even if we were to consider the web page search results and NEXIS excerpts evidence applicant has proffered, we note that much of it provides little support for the stated proposition that prospective purchasers of applicant's products would associate LUNDBECK with particular types of pharmaceutical products. As for the "Google" search results, the record reveals only the number of web pages retrieved, not the contents of the web pages themselves. Thus, we have no way of determining whether the pages would demonstrate the asserted connection. In addition, the majority of the web pages listed in the results appear to be in languages other than English. As for the NEXIS excerpts, the vast majority are wire service reports and publications outside the United States; and

many are merely stock listings reporting the increase or decrease in applicant's stock price, without reference to any particular products.

We come, then, to the last factor to be discussed, i.e., whether LUNDBECK has the look and sound of a surname. We conclude that it does. Many of the NEXIS excerpts applicant has submitted use not merely LUNDBECK, but applicant's full name, H. LUNDBECK A/S. Presenting LUNDBECK with a leading initial certainly makes it look like a surname. In re I. Lewis Cigar Mfg. Co., 205 F.2d 204, 98 USPQ 265 (CCPA 1953), and Sears, Roebuck and Co. v. Watson, Comr. Pats., 204 F.2d 32, 96 USPQ 360 (CA DC 1953). We also note the Manhattan (NY) telephone directory pages and surname dictionary references applicant has put into the record. While none of these lists LUNDBECK, they list such surnames as LUND, LUNDBERG, LUNDBLAD, LUNDGREN, LUNDQUIST, and LUNDSTROM. We conclude that LUNDBECK has the look and sound of a surname because it will be perceived as another LUND-formative surname.

Balancing the various factors, we find that the relative rareness of LUNDBECK as a surname is outweighed by the strong identification of applicant with its founder "Hans Lundbeck," the fact that the ordinary meaning of LUNDBECK is merely as a surname, and by virtue of it having

Ser No. 76268930

the look and sound of a surname, being quite similar in construction to other two-syllable surnames beginning with LUND.

Decision: The refusal of registration under Section 2(e)(4), on the ground that LUNDBECK, when used, will be perceived as primarily merely a surname, is affirmed.