

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
Sept. 28, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Bongrain S.A.**

Serial No. 78174023

Robert V. Vickers of Fay, Sharpe, Fagan, Minnich & McKee,
LLC for **Bongrain S.A.**

Zhaleh Delaney, Trademark Examining Attorney, Law Office
116 (**Meryl Hershkowitz**, Managing Attorney).

Before **Simms, Quinn and Bottorff**, Administrative Trademark
Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark HOLSBERG (in typed form) for "milk, cheese, and
dairy products, excluding ice cream, ice milk, and frozen
yogurt," in Class 29.¹ At issue in this appeal is the
Trademark Examining Attorney's final refusal to register

¹ Serial No. 78174023, filed on October 14, 2002. The
application is based on intent-to-use under Trademark Act Section
1(b), 15 U.S.C. §1051(b).

the mark on the ground that it is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4). The appeal has been fully briefed, but no oral hearing was requested. We affirm the refusal to register.

The burden is initially on the Trademark Examining Attorney to establish a *prima facie* case that applicant's mark is primarily merely a surname. If a *prima facie* case is established, the burden then shifts to the applicant to rebut it with evidence sufficient to establish that the primary significance of the mark is other than that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). "The 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 factual considerations. *In re Etablissements Darty et Fils, supra*, 225 USPQ at 653; *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). These considerations include:

- (1) The degree of a surname's rareness;
- (2) Whether anyone connected with the applicant has that surname;
- (3) Whether the word has any recognized meaning other

than that of a surname;

- (4) Whether the word has the look and sound of a surname; and
- (5) Whether the mark is presented in a stylized form distinctive enough to create a separate non-surname impression.

In re Gregory, supra; In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

The fifth factor is not relevant to this case, because applicant seeks to register the mark in typed form, without any special stylization or display. See *In re Gregory*, 72 USPQ2d 1792, 1794 (TTAB 2004). Likewise, the fact that there apparently is no one connected with applicant who has the surname HOLSBURG renders the second evidentiary factor essentially neutral in this case. See *In re Gregory, supra*, 72 USPQ2d at 1795.

As to the first factor, i.e., the degree of the surname's rareness, the evidence of record (submitted by both the Trademark Examining Attorney and by applicant) shows that there are approximately ninety persons in the United States who have the surname HOLSBURG.² Applicant

² This evidence consists of printouts from the PowerFinder electronic database, articles excerpted from the NEXIS database, and listings in the USSearch, SuperPages and Bigfoot websites. Cumulatively, these sources include over one hundred fifty listings or entries for persons with the HOLSBURG surname. However, the Board's review of these listings reveals that many of the identified individuals are listed multiple times. When

also submitted an excerpt from the Cleveland, Ohio directory which shows no listings for HOLSBURG.³ We conclude from this evidence that HOLSBURG is indeed a surname, albeit a rare one. The rarity of this surname weighs in applicant's favor in our analysis under Section 2(e)(4). However, the rarity of the surname is not dispositive; even a rare surname may be held to be primarily merely a surname if its primary significance to the purchasing public is that of a surname. *See In re Etablissements Darty et Fils, supra.*

As for the third factor, i.e., whether the word has any recognized meaning other than that of a surname, the Trademark Examining Attorney has submitted an excerpt from Merriam Webster's Collegiate Dictionary (10th ed.) which shows that there is no entry for HOLSBURG. Nor has applicant submitted any evidence which shows that the term

these multiple listings are taken into account, the actual number of individual persons identified in the various lists who have the surname HOLSBURG is approximately ninety, by the Board's count.

³ Applicant also has submitted printouts from the SuperPages website which show that there are over one thousand listings each for the surnames HOLSTON and HOLT. We are not persuaded that this evidence contributes much to our analysis under the "degree of the surname's rareness" factor. Although HOLSBURG is more rare than HOLSTON or HOLT (or SMITH or JONES), it undoubtedly is less rare than other surnames in the United States. As discussed *infra*, we find that the more relevant and helpful comparisons are to surnames which are similarly constructed vis-à-vis applicant's mark, i.e., surnames with the suffix -BURG.

has any recognized significance other than as a surname. This factor therefore supports the Office's *prima facie* case.

Finally, we turn to the fourth factor, i.e., whether the matter sought to be registered has the "look and sound" of a surname. We find that it does. HOLSBURG looks and sounds like a surname because it ends in -BURG, which is not an uncommon surname suffix. Purchasers familiar with surnames such as Feinberg, Goldberg, Greenberg, Heisenberg and Rosenberg,⁴ upon encountering the similarly constructed designation HOLSBURG, are more likely than not to view it as another surname.

We are not persuaded by applicant's argument that "the consumer will at most believe that HOLSBURG, like Pittsburgh, is a place and not a surname." (Brief at 6.) It is true that many place names have the suffix -BURGH or -BURG, but applicant's mark does not have those suffixes. Instead, it ends in -BURG, a suffix which is more commonly found in surnames than in place names. We reject as particularly unpersuasive applicant's argument that "the mark is suggestive of a fanciful place HOLSB...BURG for making

⁴ Consider also a "Rube Goldberg" device, the Heisenberg Uncertainty Principle, the spy trials of Julius and Ethel Rosenberg, the composer Arnold Schönberg, the professional tennis player Stefan Edberg and the longtime network sportscaster Dick Enberg. *Cf. In re Gregory, supra.*

cheese which is recited in this application. These holes relate to the many cheese products which include holes.”

In summary, we find that the primary significance of the term HOLSBERG to the purchasing public is its surname significance. Although it is a statistically rare surname, it nonetheless is in fact a surname. More importantly, it has the obvious look and sound of a surname due to the presence of the -BERG surname suffix. Finally, there is no evidence that the term has any significance at all other than its surname significance. For these reasons, we conclude that the Trademark Examining Attorney has established a *prima facie* case that HOLSBERG is primarily merely a surname. We also find that applicant has failed to rebut that *prima facie* case.

Decision: The refusal to register is affirmed.