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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re R.J. Mears LLC
(by change of name from Nanovis LLC)¹

Serial No. 78273336

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Pickering Hale and Dorr LLP for R.J. Mears LLC.

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114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

R.J. Mears LLC seeks registration on the Principal
Register of the mark **MEARS** (standard character drawing) for
goods identified in the application, as amended, as
"semiconductor materials, namely group IV semiconductors,
group III-V semiconductors, group II-VI semiconductors and
compound, modified and enhanced semiconductors used in the

¹ This application was assigned from Nanovis LLC to R.J. Mears LLC as a result of a change of name executed one week after the filing date herein. This name change of July 18, 2003 was recorded with the Assignment Division of the United States Patent and Trademark Office on August 5, 2003, at Reel 2694, Frame 0936.

manufacture of semiconductor chips and semiconductor devices; semiconductor circuits," in International Class 9.²

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052(e)(4), because the proposed mark is primarily merely a surname.

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing.

We affirm the refusal to register.

In support of the surname refusal, the Trademark Examining Attorney has made of record the following: evidence from the Lexis/Nexis USFIND database showing surname significance of the term MEARS; portions of thirty articles found in a computerized search of the term MEARS; four third-party registrations in which the term MEARS is registered on the Supplemental Register, a webpage from www.RootsWeb.com showing that MEARS is a surname; and an excerpted webpage from www.yourdictionary.com showing no entry for the word MEARS.

² Application Serial No. 78273336 was filed on July 11, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname case. Applicant challenges the Trademark Examining Attorney's conclusion that the purchasing public would perceive the mark as primarily merely a surname. Applicant argues that the name MEARS is a rare surname, that it does not have the look and feel of a surname, that the best case for the Trademark Examining Attorney's position is that persons named MEARS "represents 0.00017461 or 0.01% of the total United States population," and that the third-party registrations on the Supplemental Register are not persuasive.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. See In re Hutchinson Technology Inc., 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), citing In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Trademark Examining Attorney to establish a *prima facie* case that a mark is primarily merely a surname. See In re Etablissements Darty et Fils, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the

Trademark Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut this finding.

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and feel" of the surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

There is no doubt but that the Trademark Examining Attorney has met his initial burden of establishing that MEARS is primarily merely a surname. In particular, the Trademark Examining Attorney has presented evidence of almost five thousand MEARS surname references from the Lexis/Nexis USFIND database, along with proof that the word "Mears" does not appear in a website known as www.yourdictionary.com, an online, English-language dictionary. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a *prima facie* surname case. See *Hutchinson Technology*, 852 F.2d at 554, 7 USPQ2d at 1492; *Darty*, 759 F.2d at 16, 225 USPQ at 653; see also 2 J. Thomas McCarthy,

MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §13.30, p. 13-50 (4th ed. 2001).

The Trademark Examining Attorney's Lexis/Nexis USFIND evidence is collected from telephone directories and address books across the country. There is no magic number of directory listings required to establish a *prima facie* surname case. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd unpublished decision* No. 89-1231, 883 F.2d 1026 (Fed. Cir. 1989). Based on the more than five thousand MEARS surname references in the USFIND database, we conclude that a significant number of people in the United States have the surname "Mears."³

We note that applicant dismisses the five thousand listings from the USFIND database as representing "... 0.00017461 or 0.01% of the total United States

³ We point out that the evidence in this case is far more extensive than that in cases where a surname was considered rare and therefore registrable. See e.g. *Kahan & Weisz*, 508 F.2d at 832, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994)(one hundred SAVA surname telephone directory listings); *Benthin Management*, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings); *In re Garan, Inc.*, 3 USPQ2d 1537 (TTAB 1987)(six GARAN telephone directory listings and one NEXIS listing). *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) [single listing of HACKLER in the Manhattan directory and three unique listings in Washington DC metro directories].

population." However, we find this "percentage-of-the-entire-population" argument to be a hollow reed. The rich diversity of surnames in this country is amply reflected in the USFIND computer database evidence. If one were to take a statistical measurement of this database for common names like "Smith" or "Jones," each would constitute a relatively small fraction of the total database content. Gregory, *supra* at 1795.

As to the second Benthin factor, there is no clear evidence in this record that someone with the surname MEARS is associated with applicant.⁴ Thus, based on the evidence currently in this record, this factor is neutral.

The third factor we consider is whether the term has a recognized meaning other than that of a surname. The Examining Attorney has submitted dictionary evidence to show that MEARS is not listed as a word in a dictionary, thus indicating that it has no non-surname meaning. Further, the Examining Attorney has made of record thirty articles found in the Trademark Examining Attorney's computerized search of the term "Mears." These excerpts show that people with the

⁴ In this regard, we do note that the instant application was assigned from Nanovis LLC, the originally named applicant, to R.J. Mears LLC, as a result of a change of name (executed on July 18, 2003, exactly one week after the filing date herein). Neither applicant nor the Trademark Examining Attorney has discussed whether this "R.J. Mears" trade name might be connected in any way to an actual person associated with R.J. Mears LLC.

surname "Mears" have been prominent in the world of automobile racing. For example, excerpts mention Casey Mears, a budding, top-tier NASCAR racer, who is emulating the success of his uncle, Rick Mears, a four-time Indianapolis 500 winner. The publicity regarding these individuals with the surname MEARS indicates that the public will view the term as a surname. *In re Gregory, supra.*

In the face of this showing, applicant has failed to demonstrate that the term MEARS has another non-surname meaning. At most, applicant has contended in its brief that the word "Mears" "appears to be an invented term, possibly derived from other terms." Appeal brief, pp. 4 and 7. However, applicant's counsel has not explained this argument further, and has certainly not given any terms from which MEARS might have been derived, and which would be apparent to consumers. Both the *Benthin* decision and our primary reviewing Court clearly require that any other meaning must be "recognized" by a significant number of people. See *Harris-Intertype, supra; Benthin, supra; see also In re United Distillers plc, supra* [the record shows that "hackler" also means someone who practices the hackler's trade]. As noted above, applicant herein has not even identified any remote or obscure meanings for this term.

Thus, on this point, applicant has failed to rebut the Trademark Examining Attorney's *prima facie* surname case.

We consider next whether MEARS has the structure and pronunciation - or the "look and feel" - of a surname. In re Industrie Pirelli, 9 USPQ2d at 1566. If a term does not have the look and feel of a surname, such that consumers are likely to view it as something other than a surname, it would not be primarily merely a surname. On this factor, contrary to applicant's contention, it is our view that "Mears" would be perceived only as a surname. It has the structure and pronunciation of such surnames as Meers, Miers or Myers. See Garan, 3 USPQ2d at 1538. This too contrasts with In re United Distillers plc, *supra*, cited by applicant [HACKLER used in connection with alcoholic beverages will not be perceived as primarily merely a surname because this term does not have the clear "look and feel" of a surname].

Decision: The refusal to register the term MEARS under Section 2(e)(4) of the Act is hereby affirmed.