

Hearing:
April 6, 2006

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Xcaliber International Ltd., L.L.C.

Serial No. 78360389

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Before Walters, Rogers and Zervas,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Xcaliber International Ltd., L.L.C. has applied to register CHISHOLM, in standard character form, as a mark on the Principal Register for smokeless tobacco in Class 34. The application is based on applicant's assertions that the mark is now in use in commerce, was first used for the goods on August 1, 2003, and was first used in commerce for the goods on January 26, 2004.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(4) of the Trademark Act, 15 USC §1052(e)(4), on the basis that applicant's mark is primarily merely a surname. In both office actions issued by the examining attorney, it was noted that applicant could seek registration on the Supplemental Register. Applicant, however, has appealed from the refusal to allow the mark to be placed on the Principal Register. Both applicant and the Examining Attorney have filed briefs, and an oral hearing was held during which arguments were presented by the Office and applicant. We affirm the refusal to register.

The record includes the results of the examining attorney's search for CHISHOLM as a last name in the LEXIS-NEXIS USFIND database of individuals. The search retrieved 6,132 listings, of which the first 100 were made of record. The record also includes the results of the examining attorney's search of the LEXIS-NEXIS NEWS database, for articles mentioning the name CHISOLM. This search retrieved 9,206 stories, of which the examining attorney made excerpts of the first 25 of record. The records from the former search were attached to the examining attorney's first office action, while the records from the latter search were attached to the second office action.

Applicant has correctly noted in its brief that the second search was for the term CHISOLM, not CHISHOLM. Applicant asserts the two are not phonetic equivalents and has also challenged the probative value of the 25 article excerpts retrieved by the second search, because some are duplicates, some are articles from outside the United States, and one is a reference to a physical location, not a person.¹ The examining attorney, in his brief, argues that CHISHOLM and CHISOLM are mere variants of a single name, as "for example, Bush and Busch," and argues that both the terms for which searches were done have the look and feel of a surname.

Evidence of record from the applicant includes information on two localities, one in Maine (1990 population: 1,653) and the other in Minnesota (1990 population: 5,290), named Chisholm²; reprints of various

¹ We note that the article excerpt that appears to refer to a school or location by the name of "Chisolm" appeared in the Duluth News-Tribune and appears in a listing of the results of some curling matches held "at Chisholm." Applicant has separately noted the existence of a locality named Chisholm, Minnesota, and it appears that the Duluth News-Tribune article's spelling of Chisolm is a typographical error in a reference to Chisholm, Minnesota.

² Applicant included information on these localities (cities, according to applicant; small towns according to the examining attorney) in its response to the first office action. The response does not specify the source of the information, but the examining attorney did not contest the sufficiency of the evidence in the subsequent office action and discussed it in his

internet web pages discussing the Chisholm Trail, which pages explain that such trail was a route used to drive livestock from Texas to railheads in Kansas, during a nearly 20-year period beginning shortly after the conclusion of the Civil War, and derives its name from Jesse Chisholm; and reprints of various registrations issued by the USPTO, each of which includes the term CHISHOLM TRAIL, except for one that is on the Supplemental Register and is for the mark CHISHOLM CLUB, with a disclaimer of CLUB, registered for restaurant services.

The examining attorney attached to his appeal brief reprints of various internet web pages, and has requested that we take judicial notice of them, as the Board may do with dictionary definitions. While the pages all appear to be from online dictionaries or similar sources, the Board's practice is clearly to *not* take judicial notice of reference works that are available only online, when the request is first made in an examining attorney's brief. We will, however, take judicial notice of the two pages that reprint definitions from published volumes. Cf. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999) (The Board will not take judicial notice of definitions found

brief. Thus, we consider the evidence regarding the two localities to be properly of record.

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only in on-line dictionaries and "*not available in a printed format.*") (emphasis added). Thus, the record also includes a dictionary definition of CHISHOLM that reads "Shirley (Anita St. Hill), born 1924, U.S. politician; congresswoman 1969-83; first black woman elected to the House of Representatives." (Source: Random House Unabridged Dictionary, copyright 1997, retrieved December 19, 2005 from www.infoplease.com/dictionary/Chisholm.) And the record includes a definition of Chisholm Trail, reciting much the same information as we have already referenced herein, including that the trail was named for Jesse Chisholm. (Source: The Columbia Gazetteer of North America, 2000, retrieved December 19, 2005 from www.bartleby.com/69/10/C07010.html).

Whether a term is primarily merely a surname depends on the primary significance of the term to the purchasing public. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975); and In re Champion International Corp., 229 USPQ 550 (TTAB 1985). The Examining Attorney bears the burden of establishing a *prima facie* case in support of the conclusion that the primary significance of the term to the purchasing public would be that of a surname. If a *prima facie* case is presented, then the burden of rebutting that showing shifts to the applicant.

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In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); In re Harris-Intertype Corp., *supra*; In re Pyro-Spectaculars, Inc., 62 USPQ2d 355 (TTAB 2002); and In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990).

"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 various factual considerations. Darty, 225 USPQ at 653. 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, though applicant's specimens show use of the mark in a stylized form of lettering as part of a logo, there is no claim to the stylization or design; applicant seeks merely to register CHISHOLM in standard character form. Thus, the fifth factor is not a factor in this case and we examine the record in light of the first four factors.

As to the first factor, i.e., the rarity of CHISHOLM as a surname, applicant contends that approximately 6000 listings in the USFIND database "does not demonstrate that CHISOLM is more than a rare surname."³ We disagree and find the record sufficient to establish that the surname is not a rare one, even if it is not as common as, say, Smith or Jones or Brown. Moreover, even if we accept for the sake of argument that the number of listings of CHISHOLM is relatively low, the Board has previously explained that many terms that are primarily merely surnames may nonetheless constitute only a small percentage of individuals in the population of the United States, and

³ The examining attorney's search results in this database came from a search for CHISHOLM, not CHISOLM. We construe applicant's argument, however, as asserting that this evidence does not demonstrate that CHISHOLM is more than a rare surname.

that rarity is not determined solely on such percentages. See In re Gregory, 70 USPQ2d 1792 (TTAB 2004) ("We conclude that the question whether a surname is or is not rare is not to be determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database. Given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of such a database.").

In any case involving a surname refusal, the ultimate inquiry is whether the name in question would be perceived by consumers to be a surname or to not be a surname, and rarity is factor because it is probative of perception. However, as explained in Gregory, when there are well-known individuals with a surname that might otherwise not be widely used, that affects the likelihood that consumers will perceive a term to be a surname. Id. at 1795. In this case, the renown of Shirley Chisholm as the "first black woman elected to the House of Representatives" and a 14-year member of the Congress, indicates that consumers would be more likely than not to perceive CHISHOLM as a surname.

As for the second factor, i.e., whether any individual connected with applicant has the surname in question, there

is nothing in the record either way on this factor and we can assume that no individual connected with applicant is named CHISHOLM. As explained in Gregory, however, this does not aid applicant and only means that the factor is neutral. Gregory, 70 USPQ2d at 1795.

Applicant contends, in regard to the third factor, that the primary significance of CHISHOLM is as the name of the trail from Texas to Kansas used by cattle drivers from the mid-1860s through the mid-1880s. We agree with the examining attorney, however, that the question before us is not the significance of Chisholm Trail but of CHISHOLM alone. We disagree with applicant's essential contention that references to CHISHOLM alone would be taken by most consumers as references to the Chisholm Trail. There is certainly nothing in the record to suggest that the Chisholm Trail is referred to by the term CHISHOLM alone. Thus, when the term CHISHOLM alone is used, it is likely to be perceived as a surname and will only to be perceived as referencing the trail of that name when used in the combination Chisholm Trail. Moreover, even among consumers with a keen sense of history, who may think of the Chisholm Trail when confronted with the term CHISHOLM alone, these history buffs are also likely to know that the trail was named after an individual. Thus, even for those consumers

who would think of the Chisholm Trail when confronted with the term CHISHOLM alone, they would still perceive the term as a surname, albeit one bestowed by trail users upon a particular cattle-driving route.

In short, as to the third factor, we find that the term CHISHOLM alone has no non-surname significance. We are not persuaded otherwise by the existence of two localities that are named "Chisholm." Each is far removed from the route of the Chisholm Trail and there is nothing in the record that would indicate that either locality derived its name from the trail. Moreover, cities, counties, streets, lakes and other things often may derive their names from an individual's name. Harris-Intertype, 186 USPQ at 239 (CCPA 1975).

We come, then, to the last factor to be discussed, i.e., whether CHISHOLM has the look and sound of a surname. When a term does *not* have the look and sound of a surname, it clearly aids the applicant. On the other hand, when it does look and sound like a surname, such a finding merely tends to reinforce a conclusion that the term's primary significance is as a surname. CHISHOLM does not have the look or sound of an initialism or acronym; nor does it appear to be cobbled together from terms or parts of terms with separate meanings. The term appears to be a cohesive

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whole with no meaning other than as a surname. Further, we agree with the examining attorney that the existence of individuals with the name CHISOLM, a variant of CHISHOLM, tends to reinforce the conclusion that CHISHOLM has the look and feel of a surname.

Balancing the various factors, we find that CHISHOLM will not be perceived by consumers as a rare surname, has the look and sound of a surname, and its primary significance as a surname is not outweighed by other meanings which may be ascribed to the term. See Harris-Intertype, *supra*, and In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993).

Decision: The refusal of registration under Section 2(e)(4), on the ground that CHISHOLM is primarily merely a surname, is affirmed.