

To: THOMAS DIETRICH(tom@smcarthurlaw.com)
Subject: U.S. Trademark Application Serial No. 97738815 - ABRAMS - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 97738815

Mark: ABRAMS

Correspondence Address:

THOMAS DIETRICH
THE MCARTHUR LAW FIRM, PC
9465 WILSHIRE BLVD., SUITE 300
BEVERLY HILLS CA 90212
UNITED STATES

Applicant: Pro Eagle LLC

Reference/Docket No. N/A

Correspondence Email Address: tom@smcarthurlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the examining attorney's refusal to register the applied-for mark ABRAMS because it is primarily merely a surname under §2(e)(4) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(e)(4).

STATEMENT OF THE FACTS

On January 2, 2023, applicant filed an intent-to-use application under §1(b) of the Trademark Act

other than hand-operated; pneumatic jacks; power-operated jacks” in International Class 7, and "hand jacks; hand operated lifting jacks; manually-operated jacks” in International Class 8. On February 23, 2023, the examining attorney refused registration on the Principal Register under §2(e)(4) of the Trademark Act because the applied-for mark is primarily merely a surname. On March 9, 2023, applicant submitted a response arguing in favor of registration on the Principal Register. On April 6, 2023, the examining attorney continued and made final his refusal under §2(e)(4). On June 5, 2023, applicant submitted a request for reconsideration arguing in favor of registration on the Principal Register. On July 5, 2023, applicant filed a notice of appeal, and the application was remanded to the examining attorney to address applicant's request for reconsideration. On July 11, 2023, the examining attorney denied applicant's request for reconsideration, continuing the final refusal under §2(e)(4) and notifying the Board to resume the appeal. On July 12, 2023, the Board resumed the appeal, and on August 4, 2023, applicant filed its appeal brief, which was forwarded to the examining attorney the following day.

ISSUE

The sole issue presented on appeal is whether applicant's applied-for mark ABRAMS is primarily merely a surname under §2(e)(4) of the Trademark Act.

ARGUMENT

APPLYING THE *BENTHIN* INQUIRIES, THE EXAMINING ATTORNEY HAS SUBMITTED SUBSTANTIAL EVIDENCE DEMONSTRATING THAT ABRAMS IS PRIMARILY MERELY A SURNAME UNDER §2(E)(4) OF THE TRADEMARK ACT

It is well established that an applicant's mark is primarily merely a surname if the surname, when viewed in connection with applicant's recited goods, ““is the primary significance of the mark as a whole to the purchasing public.”” *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (quoting *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)); TMEP §1211.01. For standard character marks such as applicant's, the following inquiries are often used to determine the public's perception of a term's primary significance:

- (1) Whether the surname is rare;

- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname; and
- (4) Whether the term has the structure and pronunciation of a surname

In re Colors in Optics, Ltd., 2020 USPQ2d 53784, at *1-2 (TTAB 2020) (citing *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995) for the *Benthin* inquiries); TMEP §1211.01; *see also In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985).

These inquiries are not exclusive, and any of these circumstances – singly or in combination – and any other relevant circumstances may be considered when making this determination. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *5 (TTAB 2022) (citing *In re tapio GmbH*, 2020 USPQ2d 11387, at *9 (TTAB 2020); *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017); *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016)); TMEP §1211.01. In short, there is "no rule as to the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a surname." *In re tapio GmbH*, 2020 USPQ2d 11387 at *8.

1. The Evidence of Record Shows That Abrams is a Common Surname

The evidence of record clearly demonstrates that Abrams is a common surname, not a rare surname. One of the ways an examining attorney may show surname significance is by providing evidence of the total number of occurrences of a particular surname in the LexisNexis® surname database, which is a regularly updated nationwide directory of mobile phone numbers and other numbers (such VOIP numbers) and the names with which they are associated. *See* TMEP §111.02(b)(ii). In this case, the examining attorney has submitted evidence showing the surname Abrams appearing 59,411 times in the LexisNexis® surname database, clearly indicating that Abrams is a common surname, not a rare surname. *See* February 23, 2023 Non-Final Action, TSDR p. 5.

In its brief, applicant states that it "does not dispute that Abrams is a surname of some frequency in the U.S. Indeed, it is the country's 1,387th most common surname, between the surnames Gregg and Smart." 6 TTABVUE 10. Although applicant seems to concede that Abrams is a common surname,

the examining attorney nonetheless notes that the determination of whether Abrams is a common or rare surname is not done solely by comparing its 59,411 listings in the LexisNexis® surname database to the total number of listings in that database, or by its numerical ranking among other surnames in the country, because even common surnames frequently represent only a small fraction of those total numbers. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). Rather, if a surname appears routinely in news reports or articles and receives media publicity so as to be broadly exposed to the general public, then such a surname is not rare and its primary significance to purchasers would be that of a surname. *See In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017); *In re Gregory*, 70 USPQ2d at 1795; TMEP §1211.01(a)(v).

In this case, the examining attorney has established with abundant evidence from news articles that Abrams is a common surname well known to the purchasing public. First, to give a general sense of how broadly exposed the general public is to the surname Abrams, the examining attorney submitted an entry from *Wikipedia* that provides a list of many prominent people with this surname. *See* July 11, 2023 Request for Reconsideration Denied, TSDR pp. 5-6. But more specifically, this evidence includes the following 12 publications:

- An online article from *yahoo! news* entitled "*J.J. Abrams, Disney shooting in, around Albuquerque,*" which discusses J.J. Abrams, "the director behind 2000s television mainstays *Alias* and *Lost* and more recently the movie, *Star Wars: The Rise of Skywalker...*" <http://news-yahoo-com-j-j-abrams-disney-shooting-033200911-html>. *See* July 11, 2023 Request for Reconsideration Denied, TSDR pp. 7-13.
- An online article from *The Hollywood Reporter* entitled "*J.J. Abrams, Warner Bros. Team for Adaptation of Stephen King Crime Novel 'Billy Summers,'*" which discusses J.J. Abrams and his film project partnership with Warner Bros. studio. <http://www.hollywoodreporter-com-movies-movie-news-jj-abrams-returns-to-movies-billy-summers-1235304213/>. *See* July 11, 2023 Request for Reconsideration Denied, TSDR pp. 14-20.
- An online article from *The New York Times* entitled "*Eager to Grab National Spotlight, Abrams Falls Again on Georgia Stage,*" which discusses Stacey Abrams and her second campaign for

governor of Georgia. <http://www-nytimes-com-2022-11-10-us-politics-stacey-abrams-georgia-governor-election-html>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 30-46.

- An online article from *Politico* entitled "*Stacey Abrams says she'll be president by 2040*," which discusses Stacey Abrams and how her "name has been floated as a possible Democratic vice presidential pick..." <http://www-politico-com-news-2020-01-31-stacey-abrams-president-2040-109869>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 66-68.
- An online article from *The Washington Post* entitled "*Stacey Abrams to join Howard University in role focused on race, politics*," which discusses Stacey Abrams and how "she was considered a likely vice-presidential candidate for Joe Biden." <http://www-washingtonpost-com-education-2023-04-05-stacey-abrams-joins-howard-university/>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 21-29.
- An online article from *yahoo! entertainment* entitled "*Dan Abrams Mocks 'Woke' ESPN Purge Theories...*," which discusses the cable news anchor Dan Abrams and a particular topic on his nightly news show "Dan Abrams Live." <http://www-yahoo-com-entertainment-dan-abrams-mocks-woke-espn-151138816-html>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 47-52.
- An online article from *The New York Times* entitled "*The Doting Dad Side of Dan Abrams*," which discusses Dan Abrams, describing him as a "fast talking legal expert, new-media mogul and restaurant maven." <http://www-nytimes-com-2015-07-16-style-the-doting-dad-side-of-dan-abrams-html>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 53-65.
- An online article from *The Washington Post* entitled "*CJ Abrams is set on learning from his struggles at the plate*," which discusses CJ Abrams, who plays shortstop for the Washington Nationals in Major League Baseball. <http://www-washingtonpost-com-sports-2023-06-23-cj-abrams-struggles-nationals>. See July 11, 2023 Request for Reconsideration Denied, TSDR pp. 69-77.
- An online article from the *Duke Law* website entitled "*First Amendment legend Abrams urges broad protections for free speech*," which discusses Floyd Abrams, describing him as "one of the

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