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PHARMACEUTICALS - E2337-00003

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/496761

APPLICANT: Ruxton Pharmaceuticals, Inc.

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: RUXTON PHARMACEUTICALS

CORRESPONDENT'S REFERENCE/DOCKET NO: E2337-00003

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EXAMINING ATTORNEY'S APPEAL BRIEF

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

Applicant: Ruxton Pharmaceuticals, Inc. : BEFORE THE
Trademark: RUXTON : TRADEMARK TRIAL
PHARMACEUTICALS
Serial No: 78496761 : AND
Attorney: NICOLE K. MCLAUGHLIN : APPEAL BOARD
Address: DUANE MORRIS LLP : ON APPEAL
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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's refusal to register the mark "RUXTON PHARMACEUTICALS" for "pharmaceutical products and preparations for the treatment and prevention of central nervous system diseases, namely, neurodegenerative, cognitive, psychiatric and pain disorders; cardiovascular, anti-inflammatory and anti-infective pharmaceuticals and preparations" in Class 5. Registration was refused under Trademark Act § 2(e)(4), 15 U.S.C. §1052(e)(4), because the proposed mark is primarily merely a surname.

FACTS

On November 8, 2004, applicant filed the application at issue to register the above mark, alleging a bona fide intention to use the mark in commerce. On May 19,

2005, the Examining Attorney refused registration of the mark on the ground that the proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. In addition, the Examining Attorney required the applicant to amend the identification of goods and provide a disclaimer of PHARMACEUTICALS. On October 12, 2005, applicant filed a response in which applicant disclaimed the wording PHARMACEUTICALS and amended the identification of goods, which the examiner accepted. On November 15, 2005, the Section 2(e)(4) refusal was made final. The applicant filed a request for reconsideration on March 16, 2006, which the Examining Attorney denied on May 10, 2006. Applicant filed this appeal on May 15, 2006.

ARGUMENT

I. APPLICANT’S MARK, “RUXTON PHARMACEUTICALS,” IS PRIMARILY MERELY A SURNAME UNDER TRADEMARK ACT SECTION 2(e)(4).

Under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1051(e)(4), a mark which is primarily merely a surname is not registrable on the Principal Register, absent a showing of acquired distinctiveness under Section 2(f), 15 U.S.C. Section 1052(f). Section 2(e)(4) of the Trademark Act reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use of the surname, which, therefore, changes the significance of the surname from that of a surname to that of a mark for particular goods or services. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed.Cir. 1985).

The question of whether a term is primarily merely a surname depends on the primary significance to the purchasing public. *See, e.g. Ex parte Rivera Watch Corp.*,

106 USPQ 145, 149 (Comm'r Pats. 1955); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975). Each case must be decided on its own facts, based upon the evidence in the record. TMEP §1211.01.

The burden of proof is initially on the Examining Attorney to establish a prima facie case that a mark is primarily merely a surname. The burden then shifts to Applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). There is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely as surname. The question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986).

In this case, Applicant seeks to register the mark RUXTON PHARMACEUTICALS in standard character form. The Examining Attorney submits that the evidence of record establishes a prima facie case that RUXTON is primarily merely a surname. As evidence of the primary meaning of this term to the purchasing public, the Examining Attorney submitted, along with the first Office action, evidence from the Lexis USFIND database comprised of address lists and telephone directories including approximately 117 listings from the United States. This evidence counts only those persons on the list, often only the head of a household, and the actual number of persons with the surname (including spouses, children, and those who remain unlisted) is presumed to be much higher.¹ Also attached to the first Office action were two prior trademark registrations for the mark RUXTON, both of which are on the Principal Register under Section 2(f).

¹ The Examining Attorney later attached 115 listings from the USFIND database, in response to applicant's argument that the number of listings was actually closer to 100.

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