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To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 79090855 - SWEDA - 1011-TM-1247 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 7

Attachment Information:

Count: 14

Files: ATTACHMENT PAGES_Page_01.jpg, pph-1.jpg, pph-2.jpg, ATTACHMENT PAGES_Page_02.jpg, Source Information Major US Newspapers n_Page_1.jpg, Source Information Major US Newspapers n_Page_2.jpg, ATTACHMENT PAGES_Page_03.jpg, BODY__caps__sweda__and_not__Page_01.jpg, BODY__caps__sweda__and_not__Page_02.jpg, BODY__caps__sweda__and_not__Page_03.jpg, BODY__caps__sweda__and_not__Page_04.jpg, BODY__caps__sweda__and_not__Page_05.jpg, BODY__caps__sweda__and_not__Page_06.jpg, 79090855.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 79090855

MARK: SWEDA



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APPLICANT: DITRON S.R.L.

CORRESPONDENT'S REFERENCE/DOCKET NO:

1011-TM-1247

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: **4/17/2012**

INTERNATIONAL REGISTRATION NO. 1060702

This Denial of the Request for Reconsideration responds to applicant's communication dated 03/22/2012 where applicant:

- (1) Amended the identification of goods;
- (2) Argued against the Section 2(d) Likelihood of Confusion Refusal; and
- (3) Argued against the Section 2(e)(4) Primarily Merely a Surname Refusal.

The examining attorney has reviewed the applicant's response and determined the following:

- (1) Applicant's amended identification of goods is *acceptable and made of record*;

- (2) Applicant's arguments against the Section 2(d) Likelihood of Confusion Refusal are persuasive and the refusal is *withdrawn*; and
- (3) Applicant's arguments against the Section 2(e)(4) Primarily Merely a Surname Refusal are not persuasive and *the final refusal is maintained and continued*.

SECTION 2(E)(4) – PRIMARILY MERELY A SURNAME FINAL REFUSAL MAINTAINED AND CONTINUED

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The Section 2(e)(4) Primarily Merely a Surname Refusal made final in the Office action dated 09/19/2011 is *maintained and continues to be final*. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved the outstanding refusal, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding refusal in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. **Accordingly, the request is denied.**

Specifically, as detailed in the final Office action, the surname **SWEDA** regularly appears in news media in the manner of a surname, the term has no other recognized meaning other than as a surname, the term has the structure and pronunciation of a surname and the mark has no stylization or design elements to change the primary significance of the mark. For those reasons, purchasers encountering applicant's goods bearing the mark **SWEDA** will immediately and primarily understand that term as a surname.

Applicant argues:

- (1) **The surname SWEDA is rare because 188 hits in the context of a population in excess of 300 million is insufficient proof of the primary significance of the mark;**

Initially, the examining attorney notes that the fact that a term is not a common surname does not mean that a surname would not be considered to be primarily merely a surname. *See In re Adrian Giger and Thomas Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006). *See also In re E. Martinoni Co.*, 189 USPQ 589, 590 (TTAB 1975); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988).

Applicant's argument that 188 hits is in the context of 300 million people is insufficient evidence of the surname significance of the mark is unpersuasive. As articulated in *In re*

Gregory, 70 USPQ2d 1792, 1795 (TTAB 2004) “[g]iven the large number of different surnames in the United States, even the most common surnames would represent but small fractions of such a database.” Ultimately, in order to sustain the Section 2(e)(4) refusal, the evidence of record must establish that the primary significance of the mark is as a surname.

Here, the surname evidence of record establishes that there are at least 188 **households** in the United States with the name **Sweda**. Given that an average American household includes 2.6 people, there are likely to be at least 487 people with the surname **SWEDA**. *See Attachment 1 – U.S. Census Bureau USA country quick facts*. Moreover, the surname search results included in the 02/11/2011 Office action show that these household are located all throughout the United States, including in Florida, Oregon, Pennsylvania, New York, Michigan, Iowa, Ohio, Texas, Illinois, Wisconsin and California. This combined with the fact that the term **SWEDA** has no other known meaning will lead purchasers to the conclusion that **SWEDA** is a surname.

(2) The eight newspaper and magazines articles submitted with the final Office action are insufficient to establish widespread and consistent use of the term SWEDA as a surname;

Applicant asserts that the newspaper and magazines articles of record are insufficient to establish widespread and consistent use of the term **SWEDA** as a surname. Moreover, applicant argues that even if all two hundred articles were of record, based on the number of publications in the United States, 200 is inconsequential and insufficient. This argument is unpersuasive.

First, the examining attorney did not conduct a search of the mark in the 1400 daily or 6000 weekly newspapers but in the Lexis database of Major US Newspaper, which includes 48 English language newspapers published in the United States and that appear in the top 50 in circulation in Editor & Publisher Year Book. *See Attachment 2 – LexisNexis® source information for Major US Newspapers database*. These newspapers should provide a representative sample of the nature and types of articles an average purchaser encounters.

These articles, which spotlight, reference or were written by people with the surname **SWEDA**, include obituaries, school news, law and order, editorials, local news, professional news and sports, all across the United States. *See Attachment 3 – additional LexisNexis® search results for SWEDA; see also Attachment 4 – LexisNexis® showing 1167 search results in 48 total publications*. The evidence attached previously and herein aptly demonstrates that an average American purchaser is likely to encounter the term **SWEDA** in the media, used as a surname on a regular and consistent basis.

Finally, based on all of the evidence of record – the surname search results, the negative dictionary, translation and geographic gazetteer results, and the term regularly appearing in the media used as a surname – the examining attorney has met the initial burden of

establishing a prima facie case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902, 902-03 (TTAB 1986). Applicant's evidence of the population of the United States and the first page of a Wikipedia list of US newspapers has failed to rebut this showing.

Ultimately, based on the evidence attached previously and herein, when purchasers encounter applicant's goods using the mark **SWEDA**, they will immediately understand the primary significance of the mark as that of a surname. Therefore, the final refusal to register pursuant to Section 2(e)(4) of the Trademark Act is ***maintained and continued***.

Advisory – Applicant May Amend to Principal Register Under Section 2(f)

If applicant believes that its mark has acquired distinctiveness in the United States, that is, that it has become a distinctive source indicator for the goods, applicant may seek registration on the Principal Register under Trademark Act Section 2(f). See 15 U.S.C. §1052(f); TMEP §§1010, 1212.08. The Office will decide each case on its own merits.

The following factors are generally considered when determining whether a mark has acquired distinctiveness based on extrinsic evidence: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212 *et seq.*

Evidence of acquired distinctiveness may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. See 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

To establish acquired distinctiveness, an applicant may rely only on use in commerce that may be regulated by the United States Congress. See 15 U.S.C. §§1052(f), 1127. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746-47 (TTAB 1999); TMEP §§1010, 1212.08.

Advisory – Amendment to Supplemental Register Not Available

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