

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION**

In Re: Application of:

Applicant: Bleck, Thomas Zander
Mark: ZANDER
App. Serial No.: 85193348
Filing Date: 12/08/2010
Examining Attorney: Susan A. Richards
Law Office: 103
Office Action Date: March 15, 2011

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attention: Trademark Examining Operation

Transmitted via TEAS

RESPONSE TO OFFICE ACTION DATED 3/15/2011

Dear Ms. Richards:

The Applicant Thomas Zander Bleck (the "Applicant") hereby responds to the Office Action dated March 15, 2011, in which the Examiner made a non-final refusal of application Serial No. 85193348 (the "Applied-for Mark") on the grounds that it does not function as a mark and is primarily merely a surname. The Applicant respectfully requests that you consider the following, and after reviewing these matters, withdraw the refusal and permit the Application to proceed.

I. Applied-For Mark Does Function as a Mark; Substitute Specimens

The specimen previously submitted shows that Applicant uses its mark ZANDER in the advertising of its music entertainment services. The specimen consisted of an image of an album cover. When the specimen was analyzed, however, the Examiner found that the Applied-for Mark appeared only to identify the person depicted in the photograph, rather than to identify entertainment services. While the specimen might appear to be a photograph of a man with a name next to his picture, it is really an album cover that identifies the Applicant's services. The term ZANDER therefore functions as a service mark to identify and distinguish the Applicant's entertainment services from those of others and to indicate the source of the Applicant's services.

At your suggestion, the Applicant hereby submits additional and substitute specimens, along with the required statement. Specifically, the attached specimens show use of the Applied-for Mark to identify, sell, promote and advertise Applicant's entertainment services and consist of the following: (i) website screenshots from iTunes, including images of the album cover

previously submitted; (ii) a website screenshot from the record label Interscope Records; (iii) a website screenshot from Applicant's official website, (iv) a website screenshot from Applicant's Facebook page and (v) two posters publicizing Applicant's entertainment services. The substitute specimens were in use in commerce at least as early as the filing date of the application.

We submit that, upon your review of this material, the specimens will be deemed acceptable.

II. The Mark is Not Primarily Merely a Surname and is Protectable

The Examiner made a non-final refusal of the Application of the Applied-for Mark under Section 2(e)(4) of the Trademark Act, alleging that the Applied-for Mark is primarily merely a surname. For the reasons set forth below, Applicant submits that the Applied-for Mark is not primarily merely a surname, and thus the Application should be allowed, or in the alternative, that the Applied-for Mark has acquired distinctiveness under section 2(f) such that the Application should be allowed.

a. The Applied-For Mark is Not Primarily Merely a Surname

The test of whether a mark is primarily merely a surname is well known. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 345 (2d Cir. 1999); *In re Etablissements Darty et Fils*, 759 F.2d 15, 17-18 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832 (C.C.P.A. 1975); TMEP §§ 1211, 1211.01. The test asks "whether or not the primary significance of a word when applied to a product is a surname significance. If it is, and it is only that, then it is primarily merely a surname." *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d at 832; *see also Lane Capital Mgmt.*, 192 F.3d at 345 ("In this context, 'merely' is synonymous with 'only,' meaning that the question is whether the significance of the mark is 'primarily only a surname.'").

The following five factors are used to determine whether a mark is primarily merely a surname:

- (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;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

In re Benthin Mgmt. GmbH, 37 U.S.P.Q.2d 1332, 1333-34 (T.T.A.B. 1995). Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 U.S.P.Q.2d 1150 (T.T.A.B. 2007).

First, the surname "Zander" is rare and would not be perceived by the purchasing public as primarily merely a surname. The Examiner found that Zander appeared approximately 1,575 times as a surname in a nationwide telephone directory compiled by LexisNexis. Although there

is no minimum number of listings required to prove that a mark is primarily merely a surname, the Trademark Trial and Appeal Board recently found that a surname appearing 1,295 times in the PhoneDisc database was not a well recognized surname and concluded that the surname in question, “Hackler,” was in fact rare. *See In re United Distillers PLC*, 56 U.S.P.Q.2d 1220 (T.T.A.B. 2000); *see also In re Joint-Stock Co. “Baik”*, 84 U.S.P.Q.2d 1921 (T.T.A.B. 2007) (holding that “Baik” is an “extremely rare surname” despite the fact that the surname appeared 456 times in an online nationwide directory).

The quantity of the surname references submitted by the Examiner, when viewed in the context of the substantial scope of the LexisNexis Public Records database from which the entries were taken, only indicates that Zander is the surname of some persons in the United States. Moreover, the surname Zander does not appear in the list of top 1000 surnames or the compilation of surnames occurring 100 or more times from the 2000 census published by the U.S. Census Bureau. *See* U.S. Census Bureau, *Genealogy Data: Frequently Occurring Surnames from Census 2000*, <http://www.census.gov/genealogy/www/data/2000surnames/index.html> (follow “File A: Top 1000 Names” hyperlink and “File B: Surnames Occurring 100 or more times” hyperlink) (last visited July 26, 2011). The TMEP notes that the U.S. Census Bureau database reflects the number of individuals with a particular name, rather than the number of households, and that search results from the U.S. Census database “may be more persuasive evidence of surname frequency than results from telephone directory listings.” TMEP § 1211.02(b)(iii).

The fact that Zander does not appear in the U.S. Census list of top 1000 surnames or the list of surnames appearing more than 100 times demonstrates the rarity of the surname Zander. Zander is clearly not in the same category as a surname such as Smith, Johnson or McDonald. The Examiner’s evidence does not require a finding that the purchasing public, when viewing Applicant’s services, is likely to perceive the mark ZANDER as being primarily *merely* a surname. This first factor weighs in favor of finding that the Applied-for Mark would not be perceived as primarily merely a surname.

Second, neither the Applicant, nor anyone connected with the Applicant, use the term Zander as a surname. In the United States, a surname is defined as a person’s last name and refers to a person’s family name as opposed to a first name or given name. Zander is part of the Applicant’s given name but is not his surname. Accordingly, this second factor also favors a finding that the Applied-for Mark would not be perceived as primarily merely a surname.

Third, the term zander is defined as “a pike perch . . . of central Europe related to the walleyed pike.” *See* attached Exhibit A, Webster’s Third New International Dictionary of the English Language, Unabridged 2656 (2002); *see also* attached Exhibit B, Wikipedia, <http://en.wikipedia.org/wiki/Zander> (last visited July 25, 2011) and Exhibit C, Dictionary.com, <http://dictionary.reference.com/browse/zander> (last visited July 25, 2011). The TMEP makes clear that “[i]f there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness.” TMEP § 1211.01(a)(i); *see also In re Isabella Fiore, LLC*, 75 U.S.P.Q.2d 1564 (T.T.A.B. 2005) (FIORE is not primarily merely a surname where it is also the Italian translation of the English

word “flower”); *In re Monotype Corp.*, 14 U.S.P.Q.2d 1070, 1071 (T.T.A.B. 1989) (finding that the term CALISTO is a variant spelling of the Greek mythological figure “Callisto” and is not primarily merely a surname).

In addition to the common definition of the term zander as a type of fish, Applicant respectfully submits that the Applicant has been performing under the Applied-for Mark since at least as early as 2006 and has developed a considerable fan base under that brand. Given the common definition of zander and Applicant’s use of the Applied-for Mark in connection with promoting and advertising Applicant’s entertainment services, it is clear that this third factor weighs in favor of finding that the Applied-for Mark would not be perceived as primarily merely a surname.

The Applicant notes that the burden of proof in establishing the surname significance of a term is on the Examiner, and respectfully reminds the Examiner that any doubt as to the surname significance of a mark must be resolved in favor of the Applicant. *See In re Benthin Mgmt.*, 37 U.S.P.Q.2d at 1334. Based on the relative rarity of the surname Zander and the non-surname significance of the ZANDER mark, the Applicant respectfully submits that the primary significance of the term ZANDER to the purchasing public is not primarily merely a surname and that the Applied-for Mark is protectable. In the alternative, the Applicant contends that sufficient doubt has been raised as to whether the purchasing public perceives the mark ZANDER as primarily merely a surname and that such doubt should be resolved in favor of the Applicant. Therefore, the Applicant requests that the Examiner withdraw the non-final refusal to register and approve the Applied-for Mark for publication and eventual registration.

b. In the Alternative, the Applied-For Mark Has Acquired Distinctiveness

Although the Applicant does not concede that the Applied-for Mark is primarily merely a surname, in the alternative to the arguments set forth above, the Applicant is filing evidence herewith that the Applied-for Mark has become distinctive, as used in connection with the Applicant’s services, by virtue of the Applicant’s substantially exclusive and continuous use as a mark in commerce for at least the five (5) years before the date on which the claim of distinctiveness is made. Namely, the Applicant is providing a sworn statement to this effect as part of this response.

III. Recitation of Services

The Applicant adopts the recitation of services proposed by the Trademark Office in the Office Action, in part, and amends the Application to adopt the following recitation of services in Class 41:

“ENTERTAINMENT SERVICES, NAMELY, LIVE MUSICAL AND VOCAL PERFORMANCES BY A RECORDING ARTIST, MUSICAL ARTIST, MUSICAL BAND OR MUSICAL GROUP; ENTERTAINMENT SERVICES IN THE NATURE OF VISUAL AND AUDIO PERFORMANCES BY A RECORDING ARTIST, MUSICAL ARTIST, MUSICAL BAND OR MUSICAL GROUP; ENTERTAINMENT SERVICES, NAMELY, LIVE MUSIC CONCERTS; ENTERTAINMENT SERVICES, NAMELY, PERSONAL APPEARANCES BY A RECORDING ARTIST, MUSICAL

ARTIST, MUSICAL BAND OR MUSICAL GROUP; PRODUCTION OF SOUND RECORDINGS IN THE NATURE OF MUSICAL AND VOCAL RECORDINGS; ENTERTAINMENT SERVICES, NAMELY, PROVIDING A WEBSITE FEATURING INFORMATION ABOUT MUSICAL PERFORMANCES AND OTHER ENTERTAINMENT INFORMATION RELATING TO A RECORDING ARTIST, MUSICAL ARTIST, MUSICAL BAND OR MUSICAL GROUP.”

Please do not hesitate to contact me if you have any comments or questions.

Date: August 26, 2011

Respectfully submitted,

/Coe W. Ramsey/
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