

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Voith GmbH
Mark : VOITH
Serial Number : 86/193,706
Filing Date : Feb. 14, 2014

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 2231301451

RESPONSE TO OFFICE ACTION

Dear Examining Attorney:

This communication is in response to the Examining Attorney's *Office Action* dated May 22, 2014 regarding the above-referenced trademark application. The period set for response is 6 months from the *Office Action* date, ending on November 22, 2014. Applicant herein respectfully requests favorable consideration based on the following response.

REMARKS

I. REFUSAL TO REGISTER – MARK IS PRIMARILY MERELY A SURNAME

The Examining Attorney has refused registration because the applied-for mark is “primarily merely a surname.” The Examining Attorney has cited a telephone directory showing the mark appearing approximately 100 times as a surname.

TMEP § 1211 states that “the question of whether a mark is primarily merely a surname depends on the mark's *primary* significance to the purchasing public.” *See, e.g., Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955). Each case must be decided on its own facts, based upon the evidence in the record. Based on the following arguments, Applicant respectfully asserts that its mark is not primarily merely a surname, but has trademark significance to the purchasing public.

When making a determination of whether a mark is primarily merely a surname, the Trademark Trial and Appeal Board considers the following five factors, among others:

- (1) Whether the surname is rare;
- (2) Whether the term is the surname of anyone connected with the applicant;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether it has the “look and feel” of a surname; and
- (5) Whether the stylization of lettering is distinctive enough to create a separate commercial impression.

If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant. *In re Yeley*, 85 USPQ2d 1150, 1334 (TTAB 2007).

Regarding the first factor, the Examining Attorney has stated that “‘VOITH’ appears to be a relatively rare surname.” The rarity of a surname is an important factor to be considered in determining whether a term is primarily merely a surname. *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007) (finding the extreme rarity of BAIK weighed against surname refusal). While even a rare surname may be held unregistrable if its primary significance to purchasers is that of a surname, in this case, the primary significance is actually that of Applicant and its related companies. An issue to be considered in determining how rarely a term is used is the media attention or publicity accorded to public personalities who have the surname. TMEP 1211.01(a)(v). A Google or Wikipedia search for the term will show no such publicity to public personalities. Rather, these searches result in more information about Applicant, weighing in favor of the mark not being primarily merely a surname.

Regarding the third factor, while there may not be any dictionary entries for the word “VOITH,” a quick Google search shows that the term has significance other than as a surname. The first three pages of a Google search shows primarily entries for Applicant, its subsidiaries, and its mark as used in commerce. Similarly, a Wikipedia search for the term “VOITH” only brings up information regarding Applicant.

Evidence that can sometimes be presented to determine whether a term is primarily merely a surname is LexisNexis® research database articles. The burden to present such evidence is initially on the Examining Attorney. The Examining Attorney in this case has not presented any LexisNexis® articles, however, a quick search shows that there are some articles referencing Applicant, thereby showing that the primary significance of the term is not that of a surname. One article is attached as an example to this Office Action Response.

Applicant is well known among consumers and as such, consumers readily associate the term VOITH with Applicant. In North America, Applicant employs approximately 6,000 people and has revenues up to \$1 billion per fiscal year.

Finally, Applicant and its related companies own more than one US Registration for the mark VOITH. See Reg. Nos. 1347212, 1219400, 0625785. As a result, the Examining Attorney should allow this new application to proceed to registration as well.

For the reasons stated above, Applicant respectfully requests that the Examining Attorney remove its rejection of the application based on Section 2(e)(4). Applicant believes that the term VOITH has significance in the marketplace other than as primarily merely a surname, and as a result, the application should proceed to registration.