**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In Re: | ) | |
| | ) | |
| U.S. Trademark Application for HOSTER | ) | Response to Office Action |
| Serial No. 88214562 | ) | issued on March 4, 2019 |
| Owner: Volstead Corporation | ) | |
| | ) | |
| | ) | |

To: Sara Anne Helmers
Trademark Examining Attorney
Law Office 126

In response to the Office Action dated March 4, 2019, Applicant hereby argues the followings:

**THE MARK IS NOT PRIMARILY MERELY A SURNAME**

Applicant notes that in support of the refusal, the Examining Attorney attached a printout from the Lexis-Nexis database of 425 listings of the name Hoster in the entire nationwide telephone directory of names. Applicant contends that its mark is not primarily a surname due to the fact that it does not convey the impression of a surname and the fact that the Examining Attorney's evidence does not meet the necessary burden. Accordingly, Applicant respectfully requests that the refusal be withdrawn.

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); TMEP § 1211.

The inquiry as to whether a mark is primarily merely a surname must look beyond the fact that the mark **may** be used as a surname. Rather, the focus is on whether the primary significance of the mark to the purchasing public is primarily as merely a surname. See In re Kahan & Weisz Jewelry Mfg. Corp., 184 U.S.P.Q. 421 (C.C.P.A. 1975); T.M.E.P. § 1211. Applicant also notes that the term "merely" means "only" and the term "primarily" was added so as **not** to exclude marks which have other significance. See Ex parte Rivera Watch Corp., 106 U.S.P.Q. 145, 149 (Comm'r Pats. 1955). The Trademark Trial and Appeal Board (the "Board") and its reviewing courts have consistently held that the burden is on the U.S. Patent and Trademark Office ("PTO") to prove that the trademark is **primarily** merely a surname. See In re United Distillers PLC, 56 U.S.P.Q.2d 1220 (T.T.A.B. 2000); In re Establissements Darty et Fils, 759 F.2d 15 (Fed. Cir. 1985).

As stated by the Examining Attorney, the T.M.E.P. § 1211.01 sets forth five considerations, which are used to determine whether a mark is primarily merely a surname:

1. Its rarity;
2. Whether anyone connected with the applicant has the mark as his or her surname;
3. Whether the term has any recognized meaning other than as a surname;
4. Whether the mark has the structure and pronunciation of a surname; and
5. Whether the mark is sufficiently stylized to remove its primary significance from that of a surname.

Applicant respectfully submits that its HOSTER mark is not primarily merely a surname, as discussed below.

**Rarity**

The evidence attached to the Office Action indicates that a nationwide search of telephone listings revealed only 425 hits with the surname "Hoster." Professor McCarthy writes that "the rarity of the surname should be relevant in assessing the probable reaction of the public in seeing the mark" and that "the 'telephone book test' must be applied with great care, for many people have surnames which the purchasing public would never recognize as such." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 13:30 (4th ed. 2006).

> The initial burden of proof is on the PTO Examiner to establish a prima facie case that the word is primarily merely a surname. The Examiner most often carries this burden by means of showing an "unusually large number" of telephone directory listings of the word as a surname. The number of phone directory listings is apparently crucial as to whether the PTO has established a prima facie showing.

Id.

The Board's holding in In re Benthin Mgmt. GmbH, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995) ("Benthin"), is likewise illuminating. In Benthin, the examining attorney made of record evidence from PHONEDISC indicating that slightly over 100 people in the United States had the surname Benthin (after eliminating duplicative listings). However, the Board observed that:

> Benthin is indeed a rare surname, and that this first factor weighs in favor of finding that BENTHIN and design would not be perceived as primarily merely a surname. In considering the approximately 100 Benthin listings found in the PHONEDISC U.S.A. data base, we have recognized – as we did in the *Sava* case – the massive scope of this data base. Indeed, this data base demonstrates the rarity of the surname Benthin by showing that there is but one Benthin for every 750,000 Listings. In other words, the surname Benthin is, if not one in a million, one in three quarters of a million.

Id. at 1333.

According to Lexis-Nexis, they provide access to more than 200 million adults. As a result, the numbers in this case are roughly similar to the Benthin case, in which it was determined that the surname was rare.

In In re Sava Research Corp., 32 U.S.P.Q.2d 1380 (T.T.A.B. 1994), the Board likewise reversed a surname refusal despite evidence from PHONEDISC indicating that more than 100 people in the United States had Sava as a surname. In light of this number, the Board found that "the uses of SAVA as a surname represent about only one ten-thousandth of one percent of the surnames in this data base." Id. at 1381.

As aptly stated by the Board in reversing a surname refusal of GARAN, "the word 'primarily' was added to 'merely' with the clear 'intent . . . to draft a provision which would prevent a refusal to register only because a surname was found in a directory to be the name of somebody somewhere." In re Garan Inc., 3 U.S.P.Q.2d 1537, 1539 (T.T.A.B. 1987) (quoting Ex Parte Rivera Watch Corp., 106 U.S.P.Q. 145, 149 (Comm'r Pats. 1955)).

Even more recently, in In re Joint-Stock Co, 84 U.S.P.Q.2d 1921 (T.T.A.B. 2007), the Board found that evidence of **456** listings of BAIK as a surname showed extremely rare use, which supported Applicant's contention that BAIK was not primarily merely a surname. In fact, in this decision, the Board noted that ("the examining attorney's own evidence only suggests that the extremely rare surname Baik is similar to surnames that are almost as rare, i.e., fewer than 3,000 other people in this country. Thus, we are not convinced that the similarity of Baik to other obscure surnames somehow results in Baik having the "look and feel" of a surname." Likewise, given the extreme rarity of "Vivier" as a surname, the refusal should be withdrawn.

Based on the case law in this area, it is extremely clear that the term HOSTER is rare as a surname.

**No one Associated with Applicant has the Surname HOSTER**

The term is not used as an indicator of a surname, and no one associated with Applicant has the surname Hoster.

**Applicant's use of HOSTER Does Not Have the "Look And Feel" of a Surname**

Applicant submits that the mark YADA does not have the "structure and pronunciation" or "the look and sound" of a surname. In re Sava Research Corp., 32 U.S.P.Q. 2d 1380, 1381 (T.T.A.B. 1994); In re Industrie Pirelli, 9 U.S.P.Q. 2d 1564, 1566 (T.T.A.B. 1988). As stated in this decision, "certain rare surnames look like surnames, and certain rare surnames do not and that 'Pirelli' falls into the former category, while 'Kodak' falls into the latter." Id. In addition to the fact that "HOSTER" is not a common surname, there is no evidence that HOSTER follows a common or recognized structure or format for a surname.

**HOSTER Has No Surname Significance**

T.M.E.P. §1211.01(a)(i) states that [i]f there is a readily recognized meaning of a term, apart from its surname significance, the term is not primarily merely a surname. The term Hoster is a

term that means a web host or, in other words, a business that provides the services needed for a website to be viewed online (See attached Exhibit A).

In support of this position, Applicant directs the Examining Attorney to In re United Distillers plc, 56 U.S.P.Q.2d 1220 (T.T.A.B. 2000) (Board held that HACKLER was not primarily merely a surname, in light of dictionary meaning). See also Fisher Radio Corp. v. Bird Elec. Corp., 162 U.S.P.Q. 265 (TTAB 1969) (Board held that BIRD was not primarily merely a surname despite the surname significance) and In re Hunt Elecs. Co., 155 U.S.P.Q. 606 (T.T.A.B 1967) (Board held that HUNT was not primarily merely a surname despite the surname significance).

The Examining Attorney points out that the HOSTER mark originated with Louis Hoster in 1836 for a brewery. Hoster beer was a popular beer in the late 1800's and early 1900's, and at one time the Hoster brewery was one of the largest in central Ohio. The present mark celebrates that history. The Applicant also owns two existing federal trademark registrations for the HOSTER mark, Registration No. 5,169,479 for HOSTER and Registration No. 5,144810 for HOSTER GOLD TOP. Both of these registration are for similar goods. Due to the historic use of the HOSTER mark for beer and breweries, and these prior registrations, when consumers and potential consumers see the mark associated with the services in the present application, consumers and potential consumers will recognize that such services are affiliated with the marks and the goods in these prior registrations. In other words, the mark and the services identified in the present application are highly related and would be associated with Applicant and its prior registrations.

**The PTO Has Not Met its Burden of Proof**

It should also be noted that "the PTO [has] the burden of establishing a prima facie case that [an applied-for mark] is 'primarily merely a surname.'" In re Etablissements Darty et Fils, 225 U.S.P.Q. 652, 653 (Fed. Cir. 1985). In this case, Applicant respectfully submits that the Examining Attorney has not met the burden of establishing a prima facie case that HOSTER is primarily merely a surname.

To support the refusal, the Examining Attorney relies on Lexis-Nexis which shows 425 people with the surname Hoster in the entire United States. 425 people nationwide does not rise to the level of a prima facie case for a finding of a mark being primarily merely a surname, especially when the Examiner has ignored several other meanings of the term that are readily available in any search of the term.

**Doubt is to be Resolved in Favor of Applicant**

As with questions of descriptiveness under Section 2(e)(1), "on the question of whether a mark would be perceived as primarily merely a surname, we are inclined to resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods or services can file a notice of opposition." Benthin, 37 U.S.P.Q.2d at 1334.

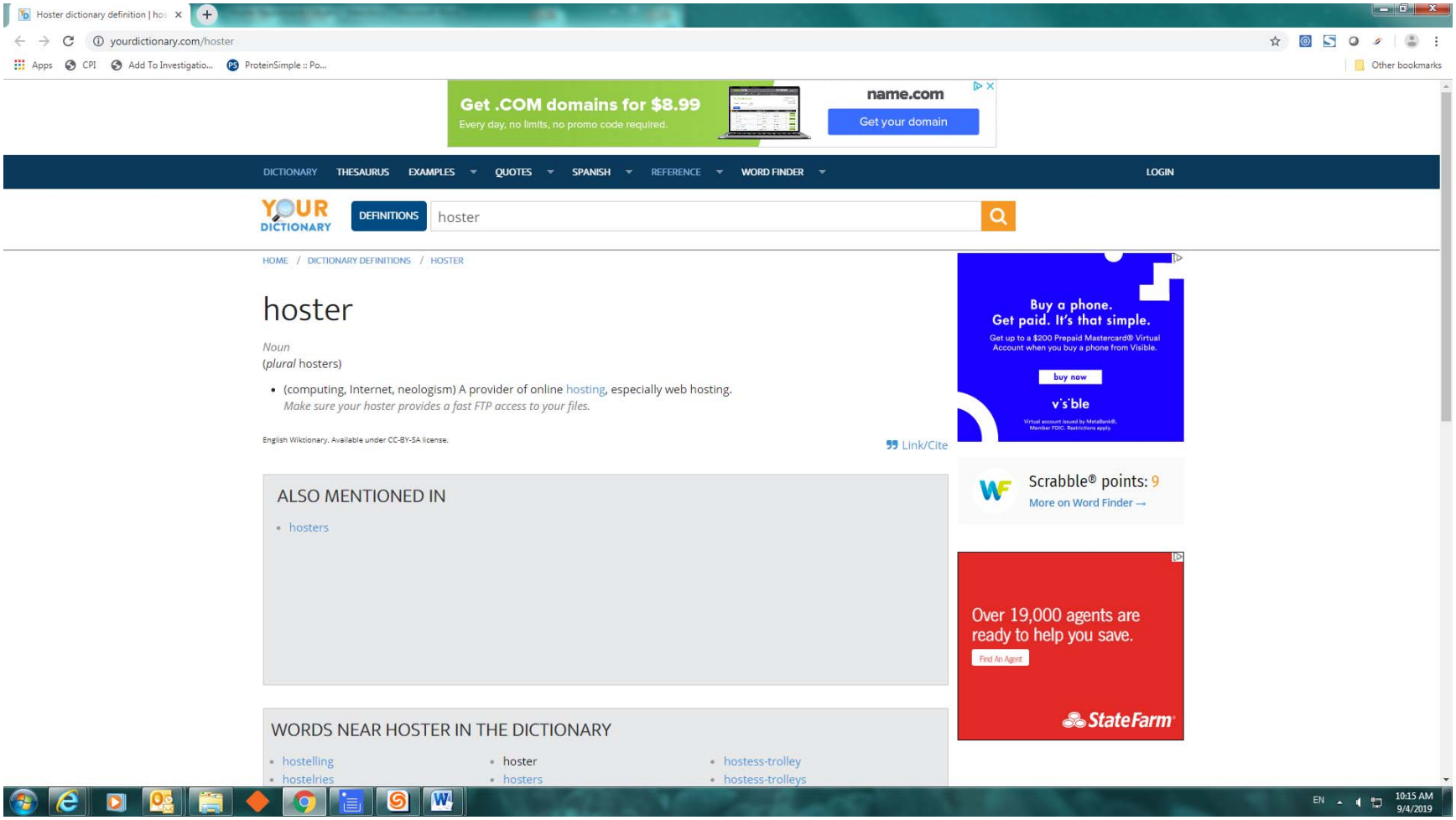
Because HOSTER is not primarily viewed by the purchasing public as a surname; any surname significance is extremely rare; and it has a meaning aside from any surname significance, Applicant respectfully requests the Examining Attorney to withdraw the refusal to register under Trademark Act Section 2(e)(4).

Respectfully Submitted,

_____ Dated: September 4, 2019

David West
Attorney of Record

# EXHIBIT A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WORD FINDER
LOGIN
YOUR DICTIONARY
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hoster
Noun
(plural hosters)
• (computing, Internet, neologism) A provider of online hosting, especially web hosting.
Make sure your hoster provides a fast FTP access to your files.
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v'sible
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More on Word Finder →
Over 19,000 agents are ready to help you save.
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