

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gibson Brands, Inc. :
: Request for Reconsideration
Serial No.: 87282523 :
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Filing Date: December 28, 2016 :
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Mark: OBERHEIM :

TRADEMARK ACT SECTION 2(e)(4) REQUEST FOR RECONSIDERATION

On October 16, 2018, the Examining Attorney issued a final refusal to register because the applied-for mark (OBERHEIM) is alleged to be primarily merely a surname under 15 U.S.C. § 1052(e)(4). Marks that are primarily a surname do not function as a trademark to identify goods from others and indicate the source of the applicant’s goods. Therefore, these marks are not registrable on the Primary Register. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see also TMEP §§1211. Applicant argues that the primary significance to the purchasing public is Applicant’s and its predecessors’ use of OBERHEIM as a trademark for use with musical keyboards, audio synthesizers and related goods since 1969, nearly fifty years. Applicant pleads the Examining Attorney review the argument and attached evidence proving the purchasing public would view OBERHEIM as a trademark for Applicant’s goods and reconsider the final refusal.

ARGUMENT

Applicant contends that the primary significance of OBERHEIM to the purchasing public is its trademark use for nearly fifty years by Applicant and its predecessors, not a surname. Whether or not a mark is primarily merely a surname depends on its primary significance to the purchasing public. TMEP 1211.01; *see also In Hutchinson Technology Inc.*, 852 F.2d 552, 554, 7 U.S.P.Q.2d

1490, 1492 (Fed. Cir. 1988); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 U.S.P.Q. 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 U.S.P.Q.2d 1531, 1537 (TTAB 2009); *In re Eximius Coffee, LLC*, 120 U.S.P.Q.2d 1276, 1277, 2016 WL 6819241 (TTAB 2016); *In re Integrated Embedded*, 2016 WL 7368696 (TTAB 2016).

The initial burden of proof to show that the purchasing public will recognize OBERHEIM is primarily a surname rests on the Examining Attorney. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 U.S.P.Q. 652, 653 (Fed. Cir. 1985). The following five factors are relevant in the determination whether the applied-for 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 Binion*, 93 U.S.P.Q.2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1333-34 (TTAB 1995). These factors are not exclusive and “any of these circumstances – singly or in combination – and **any other relevant circumstances** may shape the analysis in a particular case.” *In re Eximius Coffee*, 120 U.S.P.Q.2d at 1278 (emphasis added). Any doubt as to whether a term is primarily a surname will be resolved in favor of the applicant. *In re Yeley*, 85 U.S.P.Q.2d 1150, 1151 (TTAB 2007); *In re Benthin*, 37 U.S.P.Q.2d at 1334.

Applicant contends that the Examining Attorney has failed to carry the burden of proving that OBERHEIM is primarily a surname. At the very least, there is significant doubt as to whether OBERHEIM is primarily a surname. As evidence of the Examining Attorney’s conclusion that the OBERHEIM surname is not rare, the Examining Attorney provided a nationwide whitepages.com search that provided 236 results for the surname OBERHEIM. As the whitepages.com search supports OBERHEIM as being an extremely rare surname, the

Examining Attorney provided five press articles in the final rejection purportedly using OBERHEIM as a surname. Applicant contends that the lack of evidence submitted by the Examining Attorney supports the conclusion that OBERHEIM is an extremely rare surname in the United States. According to estimates at the census bureau, the United States had a population of nearly 330 million in 2018. www.census.gov, last visited April 16, 2019 (attached as **Exhibit A**). According to these numbers, .0000715% of the U.S. population has the surname OBERHEIM. Other national name databases support these numbers, including 226 instances in the 2010 census. See **Exhibit B**. The TTAB has found 456 instances of a surname in a national directory to be “an extremely rare surname.” *In re Joint-Stock Company Baik*, 84 U.S.P.Q.2d 1921, 2007 WL 2460997 (TTAB 2007). See also *United Distillers plc*, 56 U.S.P.Q.2d 1220, 1221 (TTAB 2000) (finding HACKLER a rare surname with 1,295 listings from a Phonedisc database); *In re Okamoto Corp.*, 2015 WL 910208 (TTAB 2015) (non-precedential) (738 entries for OKAMOTO in Lexis Public Records database supports OKAMOTO is a fairly rare surname in the United States). The TTAB has consistently held more that more than the 236 results entries can still result in finding an extremely rare surname.

In addition to the 236 results in whitepages.com, the Examining Attorney submitted five press articles where OBERHEIM was purportedly used as a surname. The first article is from the Herald & Review, a local newspaper based in Decatur, Illinois that mentions Oberheim as the surname of a local police officer. The second article is from sentinelsource.com and provides commentary on the local high school football game in Keene, New Hampshire. The quarterback of the opposing team, Mike Oberheim, is mentioned once in the article. The third article is from mlive.com and provides commentary on the local high school soccer game in Portage, Michigan. Central’s senior striker, mentioned once, was Justin Oberheim. The fourth article is from

reverb.com, a well-known online musical instrument marketplace. The article, named “The Synth Sounds Of...”, describes Prince’s synthesizer sounds in his famous party song, “1999.” The synthesizer used in the song was an Oberheim OB-X, designed by Tom Oberheim. The fifth article is from altchar.com that appears to be a blog about a video game player and twitter user, Roland Oberheim, displaying a picture of the No Man’s Sky video game developer, Sean Murray, inside the video game. The attached articles further support Applicant’s contention that OBERHEIM is an extremely rare surname. One article is an interview with a local police officer, two articles are about local high school sports, and one article appears to be a blog about a video game that is indecipherable to anyone not familiar with the video game. The only significant article is about Applicant’s Oberheim OB-X synthesizer that further supports the purchasing public will not view OBERHEIM as primarily a surname. This evidence is certainly not the routine usage of the surname in the media allowing one to conclude OBERHEIM is not considered rare and would be perceived by the public as primarily merely a surname. *See In re Gregory*, 70 U.S.P.Q.2d 1792, 1795 (TTAB 2004). As the evidence shows OBERHEIM is an extremely rare surname in the United States, this factor weighs strongly against the purchasing public recognizing OBERHEIM primarily a surname.

The Examining Attorney is correct that Tom Oberheim, Applicant’s predecessor founded Oberheim Electronics in 1969. Applicant does not argue that OBERHEIM did not arise from use as a surname, rather Applicant argues the purchasing public does not recognize OBERHEIM as primarily merely a surname. The reason the purchasing public will recognize OBERHEIM as a trademark and not primarily merely a surname is a direct result of Tom Oberheim and Oberheim Electronics. Applicant concedes that this factor, if viewed in a vacuum without all the other unique evidence and facts, would support finding OBERHEIM as primarily merely a surname.

However, one cannot ignore the nearly 50 years of history of Applicant and its predecessors using OBERHEIM as a trademark for musical instruments. The purchasing public will not have its mind wiped of this trademark use solely because a federal registration was allowed to lapse. Tom Oberheim sold the trademark rights in OBERHEIM to the Gibson Guitar Company in 1988. *See **Exhibit C***. For nearly 30 years, Tom Oberheim has not been associated with the use of OBERHEIM as a trademark on musical instruments. For these reasons, this factor is neutral.

The Examining Attorney provided evidence that OBERHEIM does not appear in a dictionary and therefore concluded that the OBERHEIM term has no recognized meaning or significance other than as a surname. This is a very narrow view of this factor and again ignores the evidence and facts presented. To the contrary, OBERHEIM has an enormous significance other than a surname, as a trademark for use with musical instruments. Applicant and its predecessors have used the OBERHEIM mark on electronic synthesizers since 1970.

Applicant's first trademark registration for OBERHEIM registered on December 13, 1977. *See **Exhibit D***. This registration lapsed on June 23, 1998. With 2 small gaps in coverage, Applicant and its predecessors have had a trademark registration active for OBERHEIM until October 14, 2016. *See **Exhibit D-E***. Even if, as the Examining Attorney suggests, cancelled or expired registrations have no probative value other than evidence that the registrations were issued, the fact that they were issued and active gave Applicant and its predecessors the right to exclude others from using the OBERHEIM term on the listed goods for nearly 50 years. This removes the concern that others would not be able to use their surname as, because of Applicant's registrations, they have not been able to more or less since 1970. There is also Applicant's extended use of the OBERHEIM mark as a trademark to signify the origin of its electronic synthesizers and related goods. A Google search for the "Oberheim" term does not return

surnames but rather every entry of the first three pages of results are press articles or advertisements for Applicant's electronic synthesizers or Tom Oberheim, the founder of Oberheim Electronics. *See Exhibit F*. Because of the significance the purchasing public has put on the OBERHEIM term as a trademark signifying Applicant as the origin of the electronic synthesizer, this factor weighs strongly against the purchasing public recognizing OBERHEIM as primarily merely a surname.

The Examining Attorney claims Ober is a common prefix for a surname. However, the evidence to support this is fatally flawed. The Examining Attorney attaches a Wikipedia page for German toponymy in which Ober is listed under the heading "German names from prehistoric and medieval times." There is an issue with the geographical area covered in the Wikipedia article. While there are plenty of names with German origin in the United States, it is not believable evidence that the purchasing public in the United States would recognize Ober as a common surname prefix because it is used as a surname in Germany. Additionally, there is an issue with the time period addressed in the Wikipedia article. It is highly unlikely that the purchasing public in the United States would recognize Ober as a surname because it was a common prefix for a surname in prehistoric and medieval Germany. Because of the insufficiency of evidence provided by the Examining Attorney, this factor is, at best, neutral.

When reviewing the enumerated factors, it is clear that the Examining Attorney has not met the burden of showing the purchasing public would recognize OBERHEIM as primarily a surname. The case law additionally provides for "**any other relevant circumstances** [that] may shape the analysis in a particular case." *In re Eximius Coffee*, 120 U.S.P.Q.2d at 1278 (emphasis added). Applicant has provided evidence of 50 years of trademark use of the OBERHEIM mark. Applicant not only considers this use as relevant, it is determinative of whether the purchasing

public recognizes OBERHEIM as primarily merely a surname. The OBERHEIM trademark has become famous when used on electric synthesizers. OBERHEIM synthesizers are featured in many musical history books. For example, the Oberheim SEM Module is featured in “Vintage Synthesizers: Pioneering Designers, Groundbreaking Instruments, Collecting Tips, Mutants of Technology” by Mark Vail on pages 167-172. Synthmuseum.com provides many webpages of history on the Oberheim synthesizers. See **Exhibit G**. Reverb.com has a page dedicated to Oberheim Electronics with 90 listings for used Oberheim synthesizers. See **Exhibit H**. The goods listed in the refused application include computer software for creating and editing music and sounds; digital sound processors; sound recording and sound reproducing apparatus and instruments; electronic musical keyboards; and keyboard instruments. Again, 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). A potential purchaser of these goods will instantly recognize OBERHEIM, not as a surname but rather as a famous trademark for electronic synthesizers. Any doubt as to whether a term is primarily a surname will be resolved in favor of the applicant. *In re Yeley*, 85 U.S.P.Q.2d 1150, 1151 (TTAB 2007); *In re Benthin*, 37 U.S.P.Q.2d at 1334. Applicant maintains that there is, at the very least, doubt on whether the purchasing public will view OBERHEIM as primarily merely a surname.

**Section 2(f) Distinctiveness
Evidence of Acquired Distinctiveness**

Applicant contends that, even if the Examining Attorney has met the burden showing OBERHEIM is primarily merely a surname, Oberheim has acquired distinctiveness through its trademark use for nearly fifty years and is therefore registrable on the Principal Register under Section 2(f), 15 U.S.C. §1052(f).

The Trademark Trial and Appeal Board has set forth the following two requirements for showing the mark in an intent-to-use application has acquired distinctiveness:

- (1) Applicant must establish that the same mark has acquired distinctiveness as to the other goods, by submitting evidence **such as** ownership of an active prior registration for the same mark for sufficiently similar or related goods, a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark with related goods, or actual evidence of acquired distinctiveness for the same mark with respect to the other goods; and
- (2) Applicant must show sufficient relatedness of the goods in the intent-to-use application and those for which the mark has acquired distinctiveness to warrant the conclusion that the previously created distinctiveness will transfer to the goods in the application upon use. The showing necessary to establish relatedness will be decided on a case-by-case basis and will depend upon the nature of the goods involved and the language used to identify them in the application.

TMEP §1212.09 (emphasis added); *see also Kellogg Co. v. Gen. Mills Inc.*, 82 U.S.P.Q.2d 1766, 1770-71 (TTAB 2007).

The extensive use by Applicant and its predecessors over the last 48 years has created a strong link in the minds of the average consumer between the OBERHEIM and the Applicant as the origin of the synthesizer. Long use of the mark is one relevant factor to consider in determining whether a mark has acquired distinctiveness. TMEP 1212.06(a); *see also In re Uncle Sam Chemical Co., Inc.* 229 USPQ 233 (TTAB 1986). In Uncle Sam, the TTAB found it persuasive that the applied-for mark has been used substantially exclusively and continuously for 18 years. While there may have been a few gaps in continuous use, Applicant and its predecessors has been using the applied-for mark substantially exclusively since 1969.

Applicant and its predecessors owned U.S. Registration No. 1079353 for OBERHEIM and U.S. Registration No. 2374612 for OBERHEIM, and U.S. Registration 3756653 for OBERHEIM. These registrations, summaries attached as **Exhibit I** were issued on December 13, 1977, August 8,

2000, and March 9, 2010 with a first use on commerce of 1970. The last registration for OBERHEIM was cancelled on October 14, 2016 for failure to file an acceptable declaration under Section 8. There current intent-to-use application was filed December 28, 2016; just over two months after the last OBERHEIM registration went out of force. The listed goods in these registrations, *inter alia*, are electronic synthesizers, sequencers, filters, phase shifters and amplifiers for modifying the sounds produced by electrified musical instruments comprising electric guitars, wind instruments with pickups, and electric keyboard instruments and pianos. The goods covered by these expired registrations are identical or related to the goods in the applied-for application. These registrations cover nearly fifty years of Applicant and its predecessors owning OBERHEIM as a trademark for the applied-for goods. Over this time, Applicant and its predecessors sold millions of dollars in goods and many of the vintage OBERHEIM synthesizers reached a level of fame by being used in songs like Prince's 1999. Even without the presumption, there is no doubt that OBERHEIM had acquired distinctiveness as of the time the last OBERHEIM mark went out of force. Applicant finds it difficult to accept the Examining Attorney's argument that in the two months where Applicant did not own the OBERHEIM trademark, the immense goodwill built up in the OBERHEIM trademark disappeared and suddenly the purchasing public would completely forget OBERHEIM was used as a trademark.

CONCLUSION

In view of the foregoing remarks, it is respectfully requested that the final refusal be withdrawn and trademark application identified above should be passed to publication on the Principal Register.