

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant:	Gibson Brands, Inc.	:	
		:	Office Action Response
Serial No.:	87282523	:	
		:	
Filing Date:	December 28, 2016	:	
		:	
Mark:	OBERHEIM	:	

INTRODUCTION

On February 2, 2017, the Examining Attorney issued a refusal for registration on the Principal 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 does not argue that OBERHEIM is not a surname but rather 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.

ARGUMENT

The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *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). See also TMEP §§1211, 1211.01. Applicant contends that 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). See **Exhibit A** for the history of the Oberheim Electronics.

Five factors are used to determine 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). *See also* TMEP § 1211.01. The Examining Attorney provides evidence of the applied-for mark appearing 236 times as a surname in a nationwide telephone directory. According to estimates at the census bureau, the United States has a population of over 315 million. Certainly only 236 of these 315 million people having the applied-for mark as a surname would be considered extremely rare. 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). The consumer purchasing musical keyboards, audio synthesizers, and related goods is unquestionably well versed in identifying surnames used as trademarks to indicate the origin of the instrument. **Exhibit B** lists only a few of the registered trademarks for musical keyboards that appear to be surnames.

Section 2(f) Distinctiveness Evidence of Acquired Distinctiveness

The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *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). *See also* TMEP §§1211, 1211.01. Applicant contends that 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).

Even if the Examining Attorney is not persuaded and believes the applied-for mark is a surname, 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 applied-for mark and the Applicant as the origin of the piano. Applicant contends the mark OBERHEIM, if determined to be primarily merely a surname, has acquired distinctiveness allowing it to be registered on the Principal Register. Trademark Act Section 2(f), 15 U.S.C. 1052(f); see TMEP §1212.06. 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.

In addition, Applicant's synthesizers bearing the OBERHEIM mark are valued antiques and remain well-known throughout the music instrument industry. Attached as **Exhibit C** are some examples of resellers using the OBERHEIM mark on keyboards and other instances of the OBERHEIM mark being used to describe Applicant as the origin of the keyboards.

While OBERHEIM may have been viewed as a surname in the early 20th century, the extensive use by Applicant and its predecessors has established acquired distinctiveness when OBERHEIM is used with musical keyboards, audio synthesizers and related goods. As shown in **Exhibit A**, Applicant's predecessor, Tom Oberheim founded the Oberheim Electronics in 1969. Throughout the last half-century, potential consumers have viewed the OBERHEIM keyboards in the marketplace. Many famous musicians and bands are known for playing OBERHEIM synthesizers

including Rush, Nena, Styx, Queen, and Prince. See **Exhibit D**. Applicant was unable to locate a decision that held half a century's length of use was not enough to establish acquired distinctiveness. Applicant and its predecessors also owned U.S. Registration No. 1079353 for OBERHEIM and U.S. Registration No. 2374612 for OBERHEIM. These registrations, summaries attached as **Exhibit E** were issued on December 13, 1977 and August 8, 2000 with a first use on commerce of 1970. The listed goods 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. While these registrations are no longer in force, they are evidence of Applicant and its predecessors owning OBERHEIM as a trademark for the applied-for goods from 1977 to 2007 with a two-year gap from 1998-2000. Additional evidence of the fame of OBERHEIM synthesizers and related goods can be provided at the examining attorney's request.

CONCLUSION

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