

**This Opinion is not a  
Precedent of the TTAB**

Hearing: January 28, 2015

Mailed: February 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Okamoto Corp.*  
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Serial No. 85739429  
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Robert W. Adams of Nixon & Vanderhye PC,  
for Okamoto Corp.

Leigh A. Lowry, Trademark Examining Attorney, Law Office 115,  
John Lincoski, Managing Attorney.

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Before Zervas, Lykos and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Okamoto Corp. (“Applicant”) has filed an application to register on the Principal

Register the mark OKAMOTO (in standard characters) for

leggings; tights; socks; stockings; trousers; panties; shorts  
and briefs; sock suspenders; leg warmers; arm warmers;  
thermal underwear; neck warmers; spats; garters;  
waistbands; slippers; shoes; uniforms; wristbands in  
International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85739429 was filed on September 26, 2012, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that OKAMOTO is primarily merely a surname.

Applicant has appealed the refusal. We reverse.

#### I. Evidentiary Matters

The Examining Attorney has objected to Applicant's references in its brief to two third-party registrations that are not of record in this proceeding. As the Examining Attorney explained in the June 30, 2013 Office Action, merely referencing a registration in response to an office action does not make that registration of record in a Board proceeding. *See, e.g., In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief is insufficient to make them of record). Instead, an applicant must submit copies of the registration, or the electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73. Applicant could have done this in a request for reconsideration, but Applicant did not file one. Accordingly, we sustain the Examining Attorney's objection, and have not considered Applicant's references to the third-party registrations.

Applicant objected to the Examining Attorney's submission of samples of evidence from two Lexis databases, which will be discussed below. Applicant's objection is overruled. The Board generally does not require submission of all articles that a search of such databases retrieves, and, in fact, prefers not to receive every article when they are unnecessarily cumulative or not probative. *See In re*

*Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (unnecessary for an examining attorney to submit all stories found in the Lexis/Nexis database, particularly where there are a large number of them). *Cf. In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245-46 (TTAB 2010) (criticizing applicant for submitting more than 300 pages of Internet material, much of which was duplicative or not relevant).

## II. Applicable Law

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public. *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The burden is on the examining attorney to establish a *prima facie* case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). If the examining attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant to determine whether the mark is primarily merely a surname. *See In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994).

The factors to be considered in determining whether a term is primarily merely a surname are: (1) whether the surname is rare; (2) whether anyone connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the “look and feel” of a surname; and (5) whether the manner in which the mark is displayed might negate

any surname significance. *In re Benthin Management Gmbh*, 37 USPQ2d 1332, 1333 (TTAB 1995). *See also Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). Because OKAMOTO is in standard character form, we need not consider the fifth *Benthin* factor here. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

A. Whether “Okamoto” is a Rare Surname

With respect to the first factor, the Examining Attorney submitted the first 100 of 738 entries of the surname “Okamoto” from the Lexis Public Records database.<sup>2</sup> The evidence of 738 entries is not substantial evidence that the term “Okamoto” is a common surname. In fact, it supports the finding that the surname “Okamoto” is a fairly rare surname in the United States. *See In re United Distillers plc.*, 56 USPQ2d 1220, 21 (TTAB 2000) (“Hackler” held to be a rare surname despite 1295 listings in phone directories). Based on the number of listings, we find “Okamoto” to be a relatively rare surname.

However, the fact that a term is not a common surname does not *per se* mean that a surname would not be considered to be primarily merely a surname. *See In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006). *See also In re E. Martinoni Co.*, 189 USPQ 589, 5890 (TTAB 1975); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). As this Board explained a few years ago, “[r]egardless of the rarity of the surname, the test is whether the primary

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<sup>2</sup> February 15, 2013 and June 30, 2013 Office Actions.

significance of the term to the purchasing public is that of a surname.” *Binion*, 93 USPQ2d at 1537.

In addition, as an attachment to her brief, the Examining Attorney submitted pages from the *Dictionary of American Family Names* (2003) (“DAFN”) in which “Okamoto” is listed as an American surname of Japanese origin. The Examining Attorney has asked us to take judicial notice of this material. As the Board may take judicial notice of dictionary definitions, we grant this request. *See In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); *see also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The DAFN attachment contains the following entry:

Okamoto (772) Japanese: “(one who lives) at the base of a hill.” This is found mostly in western and central Japan, and the Ryuktu Islands.

The parenthetical number “772” provides further support for our finding that the surname “Okamoto” is relatively rare in the United States.

The Examining Attorney also submitted excerpts from 33 articles from the Lexis All News database showing use of “Okamoto” as a surname. As the Examining Attorney explained in the June 30, 2013 Office Action, she limited the Lexis search to a six month period because absent such a date restriction, the search would have returned too many hits and could not complete. With the date restriction, the search returned 2543 results. Of those, the Examining Attorney submitted 33 of the first 414 results, all of which are from June 2013.

Six of the excerpts are from articles that mention the actress Tao Okamoto, who costarred with the actor Hugh Jackman in the movie *Wolverine*, which was due to be released in July 2013; two excerpts are from an article that mentions Sandra Okamoto, a reporter for the *Columbus Ledger Enquirer (Georgia)* who hosted a Ronald McDonald House fundraising event in Georgia, and from an article that she authored about Miss Georgia; a few excerpts are from articles that mention Yoichi Okamoto, who was the personal photographer to President Lyndon B. Johnson; several excerpts are from articles that mention a golfer from the 1980s named Ayako Okamoto; several excerpts are from articles from specialized new sources such as *Alzheimer's Weekly*, *Science International*, and *Journal of Animal and Plant Sciences* that mention individuals with the surname "Okamoto"; several excerpts are from articles from local papers concerning local news, such as the excerpt from the *San Jose Mercury News (California)* that mentions 9-year old Ryan Okamoto, who was a member of the Willow Glen all-star team, and one excerpt from the *Bellevue Reporter (Washington)* that mentions Tyler Okamoto of Interlake High School near Seattle, who received a Washington Federal STEM Scholarship; and several other excerpts are from articles that mention other individuals with the surname "Okamoto."

The Examining Attorney relies on *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004), and characterizes this evidence as showing "the routine usage of the surname in the media" which, she argues, supports the contention that "Okamoto" "is not considered rare and would be perceived by the public as primarily merely a

surname.”<sup>3</sup> We do not agree. Most of the excerpts are overly truncated, and do not provide sufficient context for us to determine whether the article is about a particular individual with the surname “Okamoto,” or whether that individual’s name is just mentioned as one of many in a list of graduating students or members of a school team, for example, and would not be noticed. In addition, while six excerpts mention the actress Tao Okamoto, we cannot determine whether she is an actress of particular note with other articles written about her in the previous five month period, or whether there were an unusual number of articles that mentioned her name in June 2013 as part of the media hype surrounding the anticipated release of the *Wolverine* movie in July 2013. Moreover, five of the six excerpts appear to be from blogs with unknown exposure (*Future News-Media Planner*, *411mania.com*, *stupidDOPE*, *AdMedia* and *Styleite*). Several others, such as *DC Daybook* and *Business Wire*, mention professors or business people surnamed “Okamoto”, but it is unclear whether the readership for any of these excerpts is widespread, or more limited due to the subject matter. In short, taken as a whole, the 33 excerpts do not reflect the type of uses that would outweigh the relative rareness of this surname.

B. Whether “Okamoto” is the Surname of Anyone Connected with Applicant

Applicant acknowledges, and the Examining Attorney emphasizes, that “the application signatory and Applicant’s President is Mr. Tetsuji Okamoto.”<sup>4</sup> We note

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<sup>3</sup> Ex. Atty. Br. at 6.

<sup>4</sup> App. Br. at 9.

Applicant's argument that "there is no evidence whatsoever in the record that the normal U.S. customer will ever know or ever see the name of Applicant's President."<sup>5</sup> However, our primary reviewing court teaches that a term that is the surname of an individual who is associated with the applicant, such as an officer or founder of the applicant, is evidence of the surname significance of the term. *See Darty et Fils*, 225 USPQ at 653. That Tetsuji Okamoto is Applicant's president suggests that the public may recognize "Okamoto" as a surname. *Miller*, 105 USPQ2d at 1620-21.

C. Whether "Okamoto" has any Recognized Non-Surname Significance

The Examining Attorney submitted online search results from the *Merriam-Webster* and *American Heritage* dictionaries to establish that there is no recognized meaning of the term "Okamoto" in English. *See, e.g., Darty et Fils*, 225 USPQ at 653 (evidence that DARTY did not appear in dictionaries as a French or English word supported *prima facie* case of surname significance). We recognize that the DAFN entry discussed above suggests that "Okamoto" might mean something to Japanese speakers, namely, "'(one who lives)' at the base of a hill." However, it is unclear whether the DAFN entry is a direct translation of the word "Okamoto" or whether, as the Examining Attorney argues, it is simply the etymological origin of the name "Okamoto."<sup>6</sup> The "Translation Statement" in Registration No. 3783093 for OKAMOTO and Design, of which Applicant claims ownership, suggests the latter:

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<sup>5</sup> *Id.*

<sup>6</sup> Ex. Atty. Br. at 11.



“The term ‘OKAMOTO’ has no official Japanese translation as a word. However, the term ‘oka’ means a ‘hill,’ and the term ‘moto’ means a ‘base.’”<sup>7</sup> On this record, it is not clear whether there is a recognized meaning of the term “Okamoto.”

D. Whether “Okamoto” has the “Look and Feel” of a Surname

While “Okamoto” looks like a Japanese word, on this record, we cannot determine whether “Okamoto” has a clear “look and feel” as either that of a surname, or an arbitrary term.

III. Conclusion

In view of the above, the Examining Attorney has not established that the primary significance of OKAMOTO to the relevant purchasing public is that of a surname. *United Distillers*, 56 USPQ2d at 1222. Although *Benthin* sets forth a multi-factor test, the rarity of the surname is of particular importance in our weighing of the factors. Accordingly, we conclude that the Office has not satisfied its burden to establish that OKAMOTO is primarily merely a surname.

**Decision:** The refusal to register Applicant’s mark OKAMOTO is reversed.

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<sup>7</sup> There is no “Translation Statement” in the involved application.