

IN RE OKAMOTO CORP., Serial No. 85739429 (TTAB February 6, 2015). Before Zervas, Lykos, and Greenbaum.

Background:

Okamoto Corp. applied for registration of the mark “OKAMOTO” in standard characters for various articles of clothing in International Class 25. The Examining Attorney refused registration on the basis that “OKAMOTO” is primarily merely a surname. Okamoto Corp. appealed to the TTAB.

Issue/Holding:

Was the Examining Attorney’s finding that “OKAMOTO” was primarily merely a surname correct? No, reversed.

Discussion:

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 Benthin Management GmbH provides five factors to be considered: (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. 37 USPQ2d 1332, 1333 (TTAB 1995). The Examining Attorney must establish a *prima facie* case that a term is primarily merely a surname.

In reversing the Examining Attorney’s refusal, the TTAB noted that the rarity of a surname is a particularly important Benthin factor and focused its analysis on the Examining Attorney’s evidence in this regard. Such evidence consisted of 738 entries of the surname “Okamoto” from the Lexis Public Records database, a dictionary listing describing “Okamoto” as an American surname of Japanese origin, and excerpts from 33 articles in the Lexis All News database showing use of “Okamoto” as a surname, including articles referencing an actress, a reporter, a professional golfer, and a presidential photographer with the surname Okamoto.

The TTAB found that evidence of 738 public record entries supports the finding that Okamoto is, in fact, a fairly rare surname in the United States. As to the 33 excerpts of news articles, the TTAB disagreed with the Examining Attorney’s contention that these showed the routine usage of the surname in the media because it was not clear from the evidence whether the articles focused on the individuals surnamed Okamoto or simply referenced such individuals, or whether the excerpted news sources were widely-read. The TTAB found that these excerpts, therefore, “did not reflect the type of uses that would outweigh the relative rareness of this surname.”

As to other Benthin factors, the TTAB noted that Okamoto Corp.’s president is surnamed Okamoto and found the record unclear as to whether “OKAMOTO” has any non-surname significance. However, the TTAB could not determine on the record whether “OKAMOTO” has the “look and feel” of a surname, and concluded that the Examining Attorney had not carried its burden of establishing that the primary significance of “OKAMOTO” to the relevant purchasing public is that of a surname.