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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bonnierforlagen Aktiebolag

Serial No. 86292577

Betsy D. Proffitt and Scott Havlick of Holland & Hart LLP,
for Bonnierforlagen Aktiebolag.

Margery A. Tierney, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Cataldo, Ritchie, and Hightower,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Applicant, Bonnierforlagen Aktiebolag, seeks registration of the mark KEPLER, in standard characters, on the Principal Register for the following goods and services:[1]

> International Class 9: computer game software; pre-recorded electronic media featuring electronic publications, namely, books, magazines and newspapers in the field of fiction; pre-recorded electronic media featuring motion picture films, cinematographic films, animated cartoons in the form of cinematographic films; CDs and DVDs featuring fiction movies; downloadable computer software for reading electronic

[1] Application Serial No. 86292577 was filed on May 27, 2014 under Section 1(b) of the Trademark Act, based on Applicant's assertion of a bona fide intent to use the mark in commerce in all classes of goods and services.

publications, namely, stories, magazines, newspapers, books and articles in the field of fiction; motion picture films, cinematographic films, animated cartoons in the form of cinematographic films; mobile electronic devices used for the reading of texts, images, audio and video; downloadable electronic publications, namely, newspapers and magazines featuring fiction, journals in the nature of fiction and books in the nature of fiction, all in electronic form or distributed online or via a multimedia network; none of the above including or being trade journals or publications intended for the pharmaceutical and packaging industry;

International Class 16: Printed matter, namely, books, magazines and newspapers in the field of fiction; books in the nature of fiction; collectible newspapers, magazines featuring fiction, posters and playing cards; printed instruction and educational materials in the field of fiction; photographs; binders; newspapers and magazines featuring fiction; none of the above including or being trade journals or publications intended for the pharmaceutical and packaging industry;

International Class 25: Clothing, namely, shirts, pants, socks, stockings, skirts, sweaters, suits, underwear, coats, swimming suits, bathing ropes, gloves, scarves, pajamas, footwear, headgear, namely, hats, caps, bandanas;

International Class 28: Games and playthings, namely, modeled plastic toy figurines; toys, namely, action figure toys, drawing toys, plastic character toys, toy figures, toy weapons, plush toys; puzzles; board games, card games, quiz games, hand held units for playing video games other than those adapted for use with an external display screen or monitor; and

International Class 41: Providing on-line non-downloadable publications in the nature of books, magazines, newspapers, and articles in the field of fiction; providing on-line electronic games; showing of films, namely, displaying a series of films; film production, other than advertising films; production of television and cinema films; theater productions.

The Trademark Examining Attorney 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

the mark is primarily merely a surname.[2] When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal was resumed. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

Section 2(e)(4) Surname Refusal

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f). "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). This expression of the test restates the rule set forth in *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) ("[A] correct resolution of the issue can be made only after the primary significance of the mark to the purchasing public is determined …"), and *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). On appeal, 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 Board's oft-cited "*Benthin* factors," *see In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995), are examples of inquiries that may lead to

[2] The refusal was made after the application was initially sent to publication.

evidence regarding the purchasing public's perception of a term's primary significance.[3] In *Etablissements Darty et Fils,* the Federal Circuit considered several factors in determining whether the purchasing public would perceive a proposed mark as primarily merely a surname, including: whether the applicant therein adopted a principal's name and used it in a way that revealed its surname significance; whether the term had a nonsurname "ordinary language" meaning; and the extent to which the term was used by others as a surname. 225 USPQ at 653. We consider these and any other relevant factors in turn. *Id.; see also In re Integrated Embedded,* 120 USPQ2d 1504, 1506 (TTAB 2016) (affirming refusal of BARR GROUP for various IT and other services as being primarily merely a surname).

The Examining Attorney submitted evidence that there are 100 entries for the surname Kepler in a nationwide directory of names.[4] The Examining Attorney also

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[3] In *Benthin*, the Board stated that inquiries or "factors" to be considered in determining whether a term is primarily merely a surname include (1) the degree of a surname's rareness; (2) whether anyone connected with that applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the "structure and pronunciation" of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression. Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007). These inquiries or factors are not exhaustive and are not presented in order of importance. We make our determination on a case-by-case basis, and any of the "*Benthin* factors" – singly or in combination – and any other relevant circumstances may shape the analysis in a particular case. *See Benthin*, 37 USPQ2d at 1333 (stating that notwithstanding the rareness of BENTHIN as a surname, panel "would find" that it "would be perceived as primarily merely a surname" because of lack of other meanings and because it is name of applicant's Managing Director, but the highly stylized form shifted the balancing of factors to a finding that BENTHIN is not primarily merely a surname).

[4] Attached to April 20, 2015 Office Action, at 2.

submitted evidence to show that Kepler is perceived as a surname. This includes an entry from HouseofNames.com, which reads, in relevant part:[5]

> The name Kepler, which is a local surname, reveals that the original bearer of the name once lived, held land, or was born in the beautiful region of Bohemia, which is now part of Czechoslovakia. . . .
> Spelling variations of this family name include: Keppler, Kaepller, Kaepler, Kaeppel, Keppel, Kepel, Kepele, Keppner and many more.

The Examining Attorney also submitted evidence of 115,899 historical documents on Ancestry.com, including 22,151 listings of births, marriages and deaths.[6]

Applicant argues that KEPLER would not be recognized as a surname because it is rare. Applicant further argues that even if it is a surname, the primary significance of KEPLER to consumers of its goods would be as referring to a historical figure, the astronomer Johannes Kepler.[7] In this regard, the record contains the following dictionary definitions of KEPLER:

> Kepler: 1. Johann [sic], 1571-1630, German astronomer. 2. A crater in the second quadrant of the face of the moon having an extensive ray system; about 22 miles (35 km) in diameter.[8]
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> Kepler: 1. A small crater in the NW quadrant of the moon, centre of a large bright ray system.
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> Kepler in Science: German astronomer and mathematician who is considered the founder of celestial mechanics. He was first to accurately describe the elliptical orbits of Earth and the planets around the Sun and demonstrated that planets move fastest when they are closest to the Sun. He also established that a planet's distance from the Sun can be calculated if its period of revolution is known.[9]

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[5] Attached to April 24, 2016 Denial of Request for Reconsideration, at 20.
[6] Attached to April 20, 2015 Office Action, at 5.
[7] 8 TTABVUE 9.
[8] *Dictionary.com*; Attached to April 20, 2015 Office Action, at 7.
[9] *Dictionaryreference.com*; Attached to April 20, 2015 Office Action, at 8.

A Wikipedia entry for Johannes Kepler includes the following:

> Johannes Kepler (German December 27, 1571-November 15, 1630) was a German mathematician, astronomer, and astrologer. A key figure in the 17th century scientific revolution, he is best known for his laws of planetary motion . . . . These works also provided one of the foundations for Isaac Newton's theory of universal gravitation.[10]

The Wikipedia entry (corroborated by other evidence from Applicant) also refers to several things that are named in honor of Johannes Kepler, including the NASA Kepler mission, as well as "a crater on the moon."[11]

Relying on this evidence, Applicant argues that consumers would perceive the term KEPLER not as primarily merely a surname, but as referring to the historical figure, Johannes Kepler. Applicant refers to *In re Pyro-Spectaculars Inc.*, 63 USPQ2d 2022 (TTAB 2002) (SOUSA for fireworks not primarily merely a surname). In that case, the Board found that "[t]he primary significance of the term SOUSA, as used in connection with these goods and services, is as the name of a specific person well known in history for his patriotic music," specifically John Philip Sousa. *Id.* at 2024. Thus, although Sousa is a surname, such is "secondary in significance when consideration is given to the particular nature of applicant's goods and services." *Id.* A similar result was reached in *Lucien Picccard Watch Corp. v. Since 1868 Crescent Corp.,* 314 F.Supp. 329, 165 USPQ 459, 461 (SDNY 1970) (DA VINCI not primarily merely a surname as registered for personal jewelry, clothing and "boutique items").

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[10] http://en.wikipedia.org; attached to April 20, 2015 Office Action, at 10.

[11] Although Applicant argues that the latter dictionary definition presents an ordinary, non-surname meaning, it appears, rather, to be associated with Johannes Kepler, after whom the crater was named. See also evidence presented by Applicant in its September 17, 2015 Response to Office Action, at 11-30.

In that case, the Court noted that "names of historical characters or noted persons are registrable, provided the primary connotation of the mark is of the historical character." *Id.* The Court explained that

> [T]he name Da Vinci, even without the given name Leonardo, comes very near having as its *exclusive* connotation the world-renowned [sic] 15th century artist, sculptor, architect, musician, engineer and philosopher . . . and hardly suggests that he personally had something to do with the designing of plaintiff's luggage.

Id. Indeed the Court took note of only two telephone directory listings in the record for the surname Da Vinci.

By contrast, the Board has distinguished what it terms figures which are "semi-historical." *See Pyro-Spectaculars,* 63 USPQ2d at 2023 (citing *In re Champion Int'l Corp.,* 229 USPQ 550, 551 (TTAB 1985) (affirming refusal of MCKINLEY for decorative paneling as primarily merely a surname)). In *Champion,* the Board found that although McKinley was the historical name of a U.S. president, with several places named after him, including a mountain, "19 cities and towns," and "149 schools, 1 bay, 1 hospital, etc.," there was insufficient evidence of public exposure to the term as uniquely pointing to the historical figure rather than as being primarily merely a surname. *Id.* A similar result was reached in *In re Thermo LabSystems Inc.* 85 USPQ2d 1285 (TTAB 2007) (affirming refusal of WATSON for laboratory information management software as being primarily merely a surname). Applicant in *Thermo LabSystems* asserted that consumers would associate its goods with historical figure James Dewey Watson, who was awarded a Nobel Prize for his work

in helping to discover the helical structure of the DNA molecule. The Board, however, noted that any association by the public with this past figure was by no means clear:

> All we have is applicant's argument on this point. We have no direct evidence that either the broader class of prospective purchasers indicated by applicant's identification or the specific class of asserted actual purchasers would make such an association.

Id. at 1289.

In line with these cases, we find that the evidence here indicates that Johannes Kepler, while well known as an astronomer, would fall within the realm of a "semi-historical" figure.[12] Although his renown rises to the level of having a dictionary definition and several things named for him, KEPLER is analogous to MCKINLEY as discussed in *Champion*, 229 USPQ at 551. This is particularly so given the facts of Applicant's use. Specifically, Applicant and the Examining Attorney argue as to whether anyone affiliated with Applicant uses the surname Kepler. Applicant admits that "Applicant uses the mark KEPLER within the pseudonym it invented, Lars Kepler, to represent a husband and wife writing team who together author a series of books about a Chief Inspector from Stockholm. See Exhibit 5."[13] Exhibit 5, which is Applicant's website, further states that "[t]o date, the Kepler books have sold five million copies worldwide."[14] It is immaterial that Lars Kepler is a pseudonym rather than the actual name of the authors, since it is the name by which Applicant is known

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[12] The facts are also distinguishable from another case cited by Applicant, *Michael S. Sachs Inc. v. Cordon Art B.V.,* 56 USPQ2d 1132, 1136 (TTAB 2000) (M.C. ESCHER not primarily merely a surname). As the Board noted there, the mark at issue was a full name, "which would be no more perceived as primarily merely a surname than the personal names P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle."
[13] September 17, 2015 Response to Office Action, at 4.
[14] *Id.* at 10.

to millions of consumers. Furthermore, although Applicant states on its website that it chose the surname Kepler as an homage to Johannes Kepler,[15] there is no evidence that consumers would themselves make this association, given that none of the goods or services identified appear to be related to astronomy and the laws of planetary motion, for which Johannes Kepler is best known.

The record thus establishes that Applicant uses the surname Kepler as part of a pseudonym for a series of books that has sold millions of copies. This is not an obscure usage. Furthermore, with this level of consumer exposure, it cannot be presumed that, whatever Applicant's intentions, consumers who encounter the term KEPLER will associate it with the past figure of Johannes Kepler, rather than with the present, bestselling author, Lars Kepler. On this record, it is apparent that KEPLER would be perceived as primarily merely a surname, with perhaps a few well-known bearers.[16]

Applicant finally argues that there are live, third-party registrations with the term "KEPLER" which have been allowed to register on the Principal Register without a showing of acquired distinctiveness. These include KEPLER (Registration No. 2,157,319) for computer software for creating fonts, and for users manuals;[17] AMVILAB KEPLER (Registration No. 4,805,359) for dietary and nutritional supplements;[18] and KEPLER CHEUVREUX (Registration No. 4,611,886) for

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[15] *Id.*

[16] While we note that Applicant has filed an intent to use application, nothing in this decision is intended to preclude Applicant from seeking a registration based on acquired distinctiveness, if and when appropriate.

[17] Owned by Adobe Systems, Inc. Registered May 12, 1998. Renewed.

[18] Owned by Amvilab, LLC (Georgia). Registered September 1, 2015.

financial services.[19] Besides being few in number, these registrations are unavailing in our analysis. The USPTO must examine each application on its own merits based on the record in the application under consideration and neither the USPTO's examining attorneys nor the Board are bound by the decisions of other examining attorneys in other applications. *See In re Cordua Restaurants, Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . ."); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) ("Even if all of the third-party registrations should have been refused registration . . . , such errors do not bind the USPTO to improperly register Applicant's marks.") (citation omitted); *In re Nett Designs, Inc.,* 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.").

Rather, we find that the Examining Attorney has carried the Office's burden of showing that KEPLER would be perceived as primarily merely a surname, which Applicant has not rebutted. There is sufficient evidence of record that Kepler is a surname, including being the surname of a semi-historical figure, Johannes Kepler. Although dictionaries define the term KEPLER as referring to Johannes Kepler, and there are several things named for him, these are mainly in the field of astronomy. There is no indication that consumers of Applicant's identified goods would make an

[19] Owned by Kepler Cheuvreux (France). Registered September 30, 2014. This is not a use-based registration, but is based on a foreign registration.

association with Johannes Kepler. This is particularly so, since Applicant itself writes a bestselling series under the pen name Lars Kepler, which would instead lead consumers to a different association with the Kepler name. Overall, the record shows that consumers will perceive the term KEPLER to be primarily merely a surname.

Decision: The refusal to register Applicant's mark is affirmed under Section 2(e)(4) of the Trademark Act.