

Oral Hearing:  
No. 20  
August 30, 2001  
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Paper

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T T A R**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re **Baratti Cosmetics GmbH**  
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Serial No. 75/**360,949**  
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Joseph Jest, David Toren and Shifra N. Malina of Brown & Wood  
LLP for **Baratti Cosmetics GmbH**.

**Kimberly Krehely**, Senior Examining Attorney, Law Office 107  
(**Thomas Lamone**, Managing Attorney).  
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Before **Seeherman, Hohein and Wendel**, Administrative Trademark  
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

**Baratti Cosmetics GmbH**, by assignment from  
**Parfümerie Douglas GmbH**, is the owner of an application to

**Baratti**

register the mark "BARATTI," in the format shown below,

for the following goods:<sup>1</sup>

"essential oils for personal use; day cream, night cream, 24-hour cream, anti-wrinkle cream, moisturizing cream, nourishing cream, moisturizing liquid, eye cream, eye gel, skin serum, skin oil, face lotion, cleansing lotion, masks, cleansing foam, toning cream, décolleté cream, contour cream, cellulitis cream, lip nourishing stick, lip balsam, hand cream, leg cream, hair removing cream, hair removing wax, body oil, body cream, body lotion, peeling cream, personal deodorant spray, personal deodorant roll-on, personal deodorant sticks, deodorant cream, massage cream, bubble bath, shower bath, oil bath, cream bath, milk bath, liquid soap, soap, body powder, suntan milk, suntan oil, suntan cream, after sun cream, pre tan lotion, sun block stick, self tan cream, sun water, lipstick, nail polish, eye cosmetics, makeup, makeup remover, mascara, eye shadow, rouge, eye makeup remover pads, nail polish remover pads, eyebrow pencils, face powder, hair shampoo, setting lotion; hair cosmetics, namely, hair care preparations, hair bleaching preparations, hair cleaning preparations and hair relaxing preparations; hair color, hair gel, hair lotion, hair serum, hair dressing cream, hair oil, hair tints, hairspray; perfume, eau de parfum, parfum de toilette, eau de toilette, eau fraiche, eau de cologne, perfumed water, pomander, sachets; shaving cream, shaving foam, after shave balm, sport cream, after shave cream, after shave lotion, pre shave lotion; [and] dentifrices" in International Class 3;

"scented candles" in International Class 4;

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<sup>1</sup> Ser. No. 75/360,949, filed on September 22, 1997, which is based upon ownership by **Parfümerie Douglas GmbH** of German Registration No. 39709652, issued on June 22, 1997. See *In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1477-78 (Fed. Cir. 1993) and TMEP Section 1007.

"goods made of leather and imitation leather, namely, bags and other containers not adapted to the products they are intended to contain, small leather goods, namely, purses, wallets, key cases; animal skins and hides; trunks and travelling bags; umbrellas, parasols and walking sticks" in International Class 18; and

"clothing, namely, swimwear, lingerie, scarves, pareu, silk scarves, bathrobes, towels, kimonos; house apparel, namely, jackets and matching pants to be worn at home; t-shirts, nightgowns, dressing capes, shower caps; footwear and headwear" in International Class 25.

Registration has been finally refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), on the ground that the mark which applicant seeks to register is primarily merely a surname.

Applicant has appealed. Briefs have been filed,<sup>2</sup> and an oral hearing was held.<sup>3</sup> We affirm the refusal to register.

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<sup>2</sup> Applicant, with its appeal brief, has submitted a definition of the term "ratti" as excerpted from Webster's New International Dictionary (2d ed. unabridged 1958), a copy of a page from the Manhattan "White Pages" telephone directory for the period from September 1999 to August 2000 showing the absence of any listing of the term "Baratti," and printouts of its searches of the term "Baratti" in the electronic "msn White Pages" for the cities of Boston, Chicago and Los Angeles showing, in each instance, that "no matches were found." The Examining Attorney, in her brief, has objected "to the submission of the above[-]mentioned materials," correctly noting that "[n]one of these materials ... appear in the prior record of this case" and that such evidence is accordingly untimely under Trademark Rule 2.142(d). Moreover, while it is settled that the Board may nevertheless, in the case of dictionary definitions, take judicial notice thereof, see, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB

As an appropriate starting point for analysis, we observe that as stated by the Board in *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993):

At the outset, it is well settled that whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. The burden is upon the Examining Attorney, in the first instance, to present evidence sufficient to make out a prima facie showing in support of the contention that a particular mark is primarily merely a surname. Provided that the Examining Attorney establishes a prima facie case, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975) and *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975). Whether a term sought to be registered is primarily merely a surname within the meaning of ... the Trademark Act must necessarily be resolved on a case by case basis and, as is the situation with any question of fact, no precedential value can be given to the

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1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), it is plain that, since the term sought to be registered is "BARATTI" rather than "RATTI," the definition of the latter is irrelevant and immaterial. Accordingly, and while the result in this appeal would be the same in any event, none of the evidence submitted with applicant's appeal brief will be given further consideration.

<sup>3</sup> Applicant, at the oral hearing, proffered a printout from the electronic version of The Collins Italian Dictionary (1995) indicating that the Italian word "baratto" is a masculine noun meaning "barter" or "exchange" in English. While, as noted previously, the Board may take judicial notice of dictionary definitions, the definition of the word "baratto" is without probative value, insofar as establishing an alternative meaning for the term which applicant seeks to register, inasmuch as such term is "BARATTI" rather than "BARATTO."

amount of evidence apparently accepted in a prior proceeding. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). ....

In the present case, we agree with the Examining Attorney that, contrary to applicant's contentions, the record contains sufficient evidence to make out a prima facie case that the primary significance of the mark "BARATTI" to the general purchasing public for various cosmetics, candles, leather goods and clothing items is that of a surname. Specifically, while each of the declarations submitted by applicant from two of its managers (both of whom claim to be "the manager of applicant") states that applicant "is not managed by and does not employ anyone who uses the term BARATTI as a surname" and that "BARATTI is a fanciful term coined by the applicant that is indicative of the applicant," the Examining Attorney in support of her position has submitted a report from a search of the PHONEDISC POWERFINDER USA ONE 1998 database (4th ed.) showing a total of 54 listings for individuals having the surname "BARATTI."<sup>4</sup> Applicant criticizes such evidence by noting that, "[d]ue to duplicate

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<sup>4</sup> The preface thereto states that:

The listings making up the data base were gathered from address lists and telephone directories, and contain over 115 million names, addresses, and phone numbers. The listings may contain a small number of duplicate listings for the same individual when the individual maintained two addresses or moved.

listings[,] the number should have been forty-nine instead of fifty-four"<sup>5</sup> and asserts that "[t]he fact that only .0000004% of the individuals listed in the Phonedisc database have the surname BARATTI shows that this number is *de minimis* and should not be given any weight in light of the massive scope of the data base and the United States' population of two hundred and sixty-five million." We find, however, that even though the term "BARATTI," as conceded by the Examining Attorney in her brief, appears to be "an uncommon surname" in the United States, the evidence furnished by the Examining Attorney demonstrates that the term "BARATTI" plainly has surname significance and that such, on this record, is its sole significance inasmuch as there are no alternative meanings. This evidence alone suffices to meet the burden of establishing a prima facie case of surname significance. See, e.g., *In re Etablissements Darty et Fils*, 222 USPQ 260, 261-62 (TTAB 1984), *aff'd, supra* at 653-54 [on the basis of 32 listings of surname "DARTY" gathered from telephone directories across the nation and absence of any non-surname significance, found that "this combination, i.e., telephone listings plus evidence of no non-surname significance, is

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<sup>5</sup> While not relied upon by the Examining Attorney in her brief, we concur with applicant that, although of record, an additional five

sufficient to meet the agency's burden of proof for a refusal to register"].<sup>6</sup>

Furthermore, we agree with the Examining Attorney that, while admittedly a subjective determination, the term "BARATTI" has the clear look and sound of a surname. In particular, given the well known fact that Italian surnames often end with a vowel, see, e.g., In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1565 (TTAB 1988), the term

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listings for the surname "BARRATTI" should not be considered because such term "is not Applicant's mark."

<sup>6</sup> That a surname is rare does not necessarily mean that its primary significance is something other than that of a surname. As the Board additionally pointed out in *Darty*, 222 USPQ at 262 (footnote omitted):

In the foregoing regard, it is important to keep in mind that rarity in a surname does not, per se, preclude a finding that an admitted surname is "primarily merely a surname" within the contemplation of the Trademark Act. The Board expressed this conclusion in *In re Joseph Picone*, 221 USPQ 93 (TTAB 1984) ("PICONE" for after shave lotion) and *In re Martinoni Co.*, 189 USPQ 589 (TTAB 1975) (stylized "LIQUORE MARTINONI" for liqueur), two cases which relied on directory evidence to establish surname significance. ....

There is, of course, a category of surnames that are so rare that they do not even have the appearance of surnames. Where these are involved, even in the absence of non-surname significance, a reasonable application of the test of "primary significance to the purchasing public" could result in a finding that such a surname, when used as a mark, would be perceived as arbitrary or fanciful. .... However, the Board does not believe that "DARTY" falls within this category of rare names that do not look like and would not be perceived as a surname.

As will be discussed next in this opinion, the same is true of the surname "BARATTI."

"BARATTI" appears to us to have the structure and pronunciation of a surname of Italian heritage and would be so recognized. Applicant in effect has acknowledged the Italian air or ring thereof since, in an unpersuasive attempt to establish a non-surname significance for the term "BARATTI," it proffered at the oral hearing an excerpt from the electronic version of The Collins Italian Dictionary (1995) and it asserted in its brief, although notably without any evidentiary support, that such term "has a meaning in the Italian language."<sup>7</sup>

As noted in *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955):

There are some names which by their very nature have only a surname significance even though they are rare

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<sup>7</sup> Although still maintaining, as stated in the previously mentioned declarations from its managers, that "BARATTI is a fanciful coined word that has no meaning," applicant nevertheless offers the unsubstantiated assertions that (footnote omitted):

[D]ue to the Examiner's inability to find alternative meanings, Applicant conducted its own research and established through information provided by native speakers that the term baratti has a meaning in the Italian language. The English translation means to swap and/or change and to cheat and/or trick. Since the term is not very common and possibly used in declination, it seems impossible to find the term in a dictionary. ....

In any event, it should be added that even if applicant had submitted proof of its assertions, the primary significance of the term "BARATTI" would still be that of a surname rather than that of an uncommon meaning, the use of which is possibly in declination among native speakers of Italian.

surnames. "Seidenberg," if rare, would be in this class. And there are others which have no meaning--well known or otherwise--and are in fact surnames which do not, when applied to goods as trademarks, create the impression of being surnames.

Likewise, as stated in *In re Industrie Pirelli Societa per Azioni*, supra at 1566:<sup>8</sup>

The Examining Attorney correctly argues that certain rare surnames look like surnames and certain rare surnames do not and that "Pirelli" falls into the former category, while "Kodak" falls into the latter.

Here, we concur with the Examining Attorney that, while a rare surname, the term "BARATTI," like the term "PIRELLI," plainly has the look and sound of a surname of Italian derivation and would be so regarded by the purchasing public.<sup>9</sup>

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<sup>8</sup> The Board, besides noting in such case that "'PIRELLI' is, in fact, a surname" and that "'Pirelli' has no ordinary meaning in the Italian language, as the Italian dictionary excerpt ... shows," also stated that while "applicant complains that the Examining Attorney has not offered sufficient proof that 'Pirelli' looks like a surname, we agree with the Examining Attorney that some of the common surnames contained in the *American Surnames* book, in their structure and pronunciation, resemble applicant's mark 'PIRELLI.'"

<sup>9</sup> The Examining Attorney, in this respect, also made of record third-party registrations for the marks "BUGATTI," "MINOTTI," "BROCATO," "DUCATI" and "MORABITO" and design, characterizing such as the results of "a limited search based on variations of the last four letters in 'BARATTI' [which] revealed that there are at least five active registrations for surnames associated with the particular types of goods provided by the applicant under the proposed mark." While it can indeed be inferred that the marks "BUGATTI," "MINOTTI" and "BROCATO," the first two of which are similar in suffix to applicant's mark, are surnames inasmuch as the copies thereof which are of record indicate that the respective registrations issued either on the Principal Register pursuant to the provisions of

Accordingly, we find that the Examining Attorney has established a prima facie case that the primary significance of the mark "BARATTI" is that of a surname. As applicant points out and the Examining Attorney admits, such mark is an uncommon surname, but the evidence offered by applicant, consisting chiefly of the declarations from two of its managers, is insufficient to rebut the Examining Attorney's prima facie showing that "BARATTI" would be viewed as a surname by the purchasing public for applicant's goods. In particular, such evidence fails to show that such term has any significance other than that of a surname. See, e.g., In re Rebo High Definition Studio Inc., 15 USPQ2d 1314, 1315 (TTAB 1990) [mark "REPO" for high resolution television equipment held primarily merely a surname, with the Board noting that, "even if ... a rare surname, this does not mean that its surname significance would not be recognized by a substantial number of persons" and that "[w]hile ... the evidence of surname significance provided by the Examining Attorney is not extensive, we cannot say that applicant has overcome even this relatively modest showing by the unsubstantiated speculation that it might have a nonsurname significance to the public"].

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Section 2{f) of the Trademark Act, 15 U.S.C. §1052(f), or on the Supplemental Register, we are constrained to agree with applicant that, in the case of the registrations for the remaining two marks, "there is nothing in those documents from which one can reasonably conclude that the marks are in fact surnames."

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Moreover, unlike the converse situation, which would be strong evidence of surname significance, the fact that the term "BARATTI" is not the surname of anyone connected with applicant does not mean that the primary significance of such term to the purchasing public is other than that of a surname. Instead, it is simply a factor to be considered which, in the circumstances of this case, is outweighed by the fact that the term "BARATTI" has been shown to have surname significance, it lacks any other ordinary meaning and it has the structure and pronunciation of a surname.

**Decision:** The refusal under Section 2(e)(4) is affirmed.