

This Opinion is Not
Citable As Precedent of
the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Club Monaco Corp.

Serial No. 76029774

Anthony F. Lo Cicero and Denise A. Lindenauer of Amster,
Rothstein & Ebenstein for Club Monaco Corp.

Regina C. Drummond, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).¹

Before Simms, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant seeks registration of the term CABAN (in
typed form) for stainless steel flatware, namely, knives,
forks and spoons in International Class 8; sofas, chairs,
beds and ottomans in International Class 20; glass stemware,
glass beverageware, glass bowls, dinnerware, namely, plates,

¹ Hellen M. Johnson handled examination of the application and issued both the initial and final refusals. Ms. Drummond briefed the appeal.

cups, saucers and bowls in International Class 21; and towels, sheets, pillow cases, pillow shams, bed skirts, comforters, blankets, comforter and blanket covers, shower curtains, linen table cloths and napkins, textile placemats and fabrics for house wares in International Class 24.² The application is based on applicant's statement that it has a bona fide intention to use CABAN in commerce as a mark for the identified goods.

The examining attorney has refused registration on the ground that CABAN is primarily merely a surname, under Section 2(e)(4) of the Lanham Act, 15 U.S.C. § 1052(e)(4), and therefore is unregistrable on the Principal Register.³ When the refusal of registration was made final, applicant appealed. Applicant included a request for reconsideration with its notice of appeal. That was considered by the examining attorney and denied. The appeal is fully

² The Office's computerized database of pending applications and issued registrations, as well as the Office's computerized search system for pending and registered marks, list only "linen table cloths and napkins" as goods in Class 24. It appears that applicant's request to amend the wording "table cloths and napkins" to "linen table cloths and napkins" inadvertently led to substitution of the latter for the entire Class 24 listing of goods. The Board has remedied the error by restoring to the listing all the other goods included in the original application.

³ Applicant was informed that it could amend the application to the Supplemental Register upon filing of an allegation of use of the term in commerce.

briefed. Applicant did not request an oral argument. We affirm the refusal of registration.

The record includes a reprint of 100 of 816 telephone listings for individuals with the surname CABAN, retrieved from the PhoneDisc computerized database⁴, and reprints of 54 excerpts from among 2000 retrieved from the NEXIS database of items published in newspapers and magazines, as well as items posted on wire services.⁵ Applicant, in turn, made of record (1) a declaration from its president and CEO, attesting that none of applicant's "officers, directors, or senior level personnel" have the name "Caban," and (2) a French dictionary definition of "Caban" as a "pea jacket," "(hooded) cloak (for rainy weather)," or "oilskins." Applicant has also made of record the following definition from the Oxford English Dictionary (1989): "cabaan, caban ... A white cloth worn by Arabs over their shoulders"; the following from The New Shorter Oxford English Dictionary (1993): "caban ... A type of coat or tunic

⁴ With the initial Office action, the examining attorney reported the results of her PhoneDisc search, stating that 816 residential listings were found for the name CABAN and that the 100 listings attached to the Office action were representative of the complete search results.

⁵ The examining attorney searched for CABAN in the NEXIS "News" library and "US" file. The search found 2000 stories, from which the introduced excerpts were selected.

worn esp. by Arab men"; and the following definition from a Russian-English dictionary: "ka? a?/kabán/ m. boar."

The examining attorney has asked that we take judicial notice of the absence of definitions for "caban" in four dictionaries published in the United States and in two on-line dictionaries. In support of this request, the examining attorney provided reprints of pages from the four published dictionaries, showing that "caban" does not appear, and reprints of the results from searches of the on-line dictionaries, showing that neither search returned a result for "caban."

In deciding whether a term is or is not primarily merely a surname, we must determine the primary significance of the term to the purchasing public. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The Office, through the examining attorney, bears the burden of establishing a prima facie case in support of the conclusion that the primary significance of the term to the purchasing public would be that of a surname. If the prima facie case is made, then the burden of rebutting that case, i.e., the burden of showing that the primary significance of the term to the purchasing public is other than as a surname, shifts to the applicant. See *In re*

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Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); In re Harris-Intertype Corp., supra; In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975); In re Pyro-Spectaculars, Inc., 62 USPQ2d 355 (TTAB 2002); In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990).

Factors to be considered in determining whether a term is primarily merely a surname include: (i) the rarity of use of the term as a surname; (ii) whether anyone connected with applicant has the surname in question; (iii) whether the term in question has any recognized meaning other than that of a surname; (iv) whether the term has the "look and sound" of a surname; and, if applicable, (v) whether the stylization of the term is so great as to create a separate commercial impression sufficient to render the term more than merely a surname. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

The examining attorney bases her argument in support of the refusal on the PhoneDisc evidence, the NEXIS evidence, and her inability to find dictionary definitions for the term "caban." She also argues that possible meanings for the term in languages other than English are irrelevant, that the Oxford English dictionaries' definitions are obscure, and that applicant has not

provided any explanation of the creation or adoption of the term so as to establish that is coined rather than a surname.

The applicant, on the other hand, argues that the PhoneDisc listings are "negligible" when compared to the total number of listings in that database, that the term has been shown to have another meaning in English, has still additional meanings in other languages, is not the name of any officer, director or senior level personnel of applicant, and does not have the "look and sound" of a surname. Applicant also argues that, because of the nature of applicant's goods, "caban" would "conjure up" the term "cabana."

We find that the examining attorney has carried her burden of making out a prima facie case for refusal. The PhoneDisc and NEXIS evidence show that Caban is a surname in use throughout the United States. The PhoneDisc listings made of record show individuals with the name Caban from New England and Mid-Atlantic states, in Florida and other southern states, in Oklahoma, Texas and Arizona, and in California, Washington and Hawaii. Likewise, the NEXIS evidence shows the surname appearing in articles in publications throughout the United States, including Boston, Worcester, Quincy (Mass.), Manchester (N.H.),

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Hartford, Albany (N.Y.), Buffalo, New York, Neptune (N.J.), Allentown, Lancaster (Penn.), Fort Lauderdale, Orlando, Sarasota, St. Petersburg, Tampa, Vero Beach, Atlanta, Louisville, South Bend, Chicago, Milwaukee, Dallas, San Antonio, and Los Angeles. That the PhoneDisc references may be a very small percentage of that database, or that the NEXIS references may be a very small percentage of the population of the United States, is not very significant. A great many surnames might, when compared to a database of nearly 100 million (by applicant's estimate) or the population of the United States, be used by only very small percentages of the larger groups.

In regard to the dictionary evidence of record, the meaning of "caban" in French or Russian is of little relevance to our inquiry, for our focus is on the significance of the term to purchasers in the United States, not in France or Russia. Even assuming that these definitions would have significance for our inquiry, we note that the Russian definition applicant relies on is actually for the term "kaban" not "caban" and that the French definition is qualified with the designation "(Naut.)" which, we presume, signifies a nautical term that may not be widely known even to those who speak French. In addition, we agree with the examining attorney's

characterization of the definition of "caban" in the Oxford English dictionaries as obscure, in view of the absence of any definition for the term whatsoever in numerous other dictionaries published in the United States, or available here via the Internet.

That no officers, directors or senior employees of applicant have the surname Caban is certainly a factor in applicant's favor. However, it is the only factor we find to favor applicant. While applicant argues that Caban does not have the "look and sound" of a surname, we disagree. It is not presented in any form of stylization, so it does not have the look of a symbol or design mark, and would not be perceived as an acronym. Compare *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) (SAVA found to have the "look and sound" of an acronym). Nor is there anything in the record from which we could find that Caban would routinely be pronounced in such a manner as to possess non-surname significance. Finally, we are not persuaded by applicant's argument that prospective purchasers of its goods would consider Caban to be a shortened form of Cabana, an argument which, we note, runs counter to applicant's argument that Caban would be perceived as a coined term.

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In short, we find that the examining attorney has established a prima facie case for refusal and that applicant has not rebutted that case. Had we any doubt on the matter, we would resolve doubt in favor of applicant, *Benthin Management*, supra, but we have no doubt that Caban would be perceived primarily as a surname.

Decision: The refusal of registration under Section 2(e)(4) of the Lanham Act is affirmed.