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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Chiaro Networks, Inc.**

Serial No. 76/166,140

Linda M. Merritt of **Fulbright & Jaworski L.L.P.** for **Chiaro Networks, Inc.**

Amos Matthews, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before **Hohein, Holtzman and Rogers**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Chiaro Networks, Inc. has filed an application to register the mark "CHIARO" for "computer hardware and computer software for controlling and operating computer and telephony networks."¹

¹ Ser. No. 76/166,140, filed on November 16, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce.

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, but an oral hearing was not requested. We affirm the refusal to register.

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 amount of evidence apparently accepted in a prior proceeding. See *In re Etablissements*

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Darty et Fils, 759 F.2d 15, 225 USPQ 652,
653 (Fed. Cir. 1985).

Moreover, as set forth by the Board in *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000):

Among the factors to be considered in determining whether a term is primarily merely a surname are the following: (i) whether the surname is rare; (ii) whether anyone connected with applicant has the involved term as a surname; (iii) whether the term has any other recognized meaning; and (iv) whether the term has the "look and feel" of a surname. See *In re Benthin Management GmbH*, 37 USPQ2d 1332[, 1333] (TTAB 1995).

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 "CHIARO" to the purchasing public for applicant's goods is that of a surname and that such showing has not been rebutted by applicant. Specifically, the Examining Attorney has made of record the following evidence in support of his refusal: (i) a copy of the results of a search of the "infoU.S.A." (formerly "PhoneDisc") database, version 2002, which shows a total of 395 residential listings in the United States were found for individuals with the surname "CHIARO";² (ii) copies of the pertinent pages from Webster's New

² Applicant, we note, points out in its initial brief that, as part of its request for reconsideration of the final refusal, it submitted the results from an updated "InfoUSA search showing [that] a total of 431 consumers with the last name of 'Chiaro' are contained in the *InfoUSA*

Geographical Dictionary (1988) and The American Heritage Dictionary (2d coll. ed. 1982) which show an absence of any listing for the term "CHIARO"; and copies of portions from 29 stories retrieved from a search of the "NEXIS" database which refer to individuals in the United States with the surname "CHIARO."³

Applicant, in its initial brief, maintains that the above evidence, as well as the evidence which it has furnished in rebuttal thereto, including "genealogical information" obtained from "the U.S. Census Bureau's website" which shows "frequently occurring surnames based on the 1990 census," demonstrates that while a surname, the mark "CHIARO" is a rare surname. The rareness thereof, applicant urges, is a factor in its favor inasmuch as it weighs against a finding that the mark would be perceived as primarily merely a surname. See, e.g., In re Benthin Management GmbH, supra; and In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). Although, in his brief, the Examining Attorney "concedes that CHIARO is a rare surname in the United States," he correctly notes that "the fact

consumer database current as of July 18, 2002" and that such database "contains information for more than 250 million consumers."

³ Like applicant's analysis (discussed later in this opinion) of the results of its own searches of such database, we have not counted in the above total the six other stories included by the Examining Attorney in his search which mention individuals with the surnames "del Chiaro" and "de Chiaro" inasmuch as the mark applicant seeks to register is "CHIARO."

that a surname is rare does not necessarily mean that its primary significance is something other than that of a surname." See, e.g., *In re Etablissements Darty et Fils*, supra; *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314, 1315 (TTAB 1990); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79, 80 (TTAB 1986); and *In re Joseph Picone*, 221 USPQ 93, 95 (TTAB 1984). Likewise, while we concur that "CHIARO" is shown by the record to be a rare surname, we find as discussed below that the primary significance thereof to the purchasing public for applicant's goods is only that of a surname.

Admittedly, the surname "CHIARO" is not the surname of anyone associated with applicant. Applicant, in its response to the first Office action, "advise[d] the Examining Attorney that there is no one presently connected with Applicant or its predecessors or founders having the surname 'Chiaro'" and, in its request for reconsideration, reiterated that "[n]o founder, officer, board member or other individual connected with Applicant is shown to have 'Chiaro' as a surname." We agree with the Examining Attorney, however, that as argued in his brief, such fact "does not mean that the primary significance of such term to the purchasing public is other than that of a surname," given the other appreciable evidence of surname significance (e.g., the negative dictionary evidence showing an

absence of any listing--and hence a lack of non-surname meaning--for the term "chiaro" and the numerous "NEXIS" excerpts demonstrating use of such term as a surname) in the record. Clearly, therefore, the absence of any association with applicant's business of anyone with the surname "CHIARO" is not as probative with respect to demonstrating a lack of primary surname significance as the converse would be in establishing that such term has primary significance as a surname. Consequently, just as the surname "PETRIN," for example, was found in *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986), to have primary significance as a surname even though no one with such surname was associated with the applicant for registration therein, the same is true with respect to the surname "CHIARO" which applicant seeks to register.

Applicant relies heavily upon the argument that the term "chiaro" has a recognized meaning other than that of a surname. Specifically, applicant observes in its initial brief that, as shown by the excerpts from various online Internet dictionaries which it submitted in response to the first Office action, "the word 'chiaro' means 'light', 'clear', 'evident', or 'obvious' in Italian." Likewise, applicant notes, the "excerpts from seven hardcopy dictionaries containing Italian to English translations," which applicant furnished with its request for reconsideration, demonstrate that "the term 'chiaro' means

'light', 'clear', 'evident', or 'obvious' in Italian" and, in addition, "show that the term in the Italian language can also mean 'bright'." Applicant contends that such meaning would be apparent to customers for its goods because, as illustrated by the record:

Applicant's website (created in April-May 2000) ... shows that it emphasizes the meaning of the word "chiaro" as "clear", "bright", or "light" in its promotional efforts. First, the logo appearing with the mark consists of a "C" overlaying a background of light rays. Further, the website's homepage includes a translation of the word "chiaro" as "clear", "bright", or "light". Finally, the website information referring to career opportunities with Applicant uses the phrase "We're looking for people who see the light!" Nowhere does the website use the term "chiaro" as a surname. Therefore, Applicant's promotional efforts support [the] conclusion that "chiaro" has a recognized meaning other than as a surname.

The Examining Attorney, while acknowledging in his brief that if a "term has [a] well known meaning as a word in the language it is not primarily merely a surname," insists that applicant's "submission of a non-surname meaning in the Italian language is not persuasive and will not overcome the surname significance of [such] a term." Applicant, however, urges in its initial brief that "there is no basis in the case law" for the Examining Attorney's position that "only an English language meaning will suffice to establish that 'chiaro' has a recognized

meaning other than as a surname." In particular, "based on the doctrine of foreign equivalents," applicant asserts that:

[T]he Board has looked at foreign language meanings in assessing whether marks at issue in other cases were primarily merely surnames. For example, in *In re Industrie Pirelli [Societa per Azoni]*, the Board relied on evidence that the term 'pirelli' had no ordinary meaning in the Italian language, based on an excerpt from an Italian dictionary, to support its conclusion that PIRELLI was primarily merely a surname. 9 U.S.P.Q.2d 1564, 1566 (T.T.A.B. 1988). Furthermore, the Board has taken judicial notice that there are many people in the United States who speak and read Italian. *In re E. Martinoni Co.*, 189 U.S.P.Q.2d 589, 590 (T.T.A.B. 1976). Accordingly, the evidence on the record ... establishes that "chiaro" has a recognized meaning other than as a surname such that this factor should weigh in favor of a conclusion that the CHIARO mark should not be refused registration on the basis of being "primarily merely a surname."

While the Board in *Pirelli*, supra, did indeed state among other things that the term "'Pirelli' *has no ordinary meaning in the Italian language*, as the Italian dictionary excerpt, made of record by the Examining Attorney, shows" (italics added), nothing in the Board's decision indicates that its finding of the primary significance of the rare surname "PIRELLI" to be that of a surname would have been different if such surname had been demonstrated to have another meaning to those knowledgeable in the Italian language. Rather, as set forth in, for instance, *In re BDH Two Inc.*, 26 USPQ2d 1556, 1558

(TTAB 1993), "it is the surname significance of the term in the United States which is determinative of the registrability issue" and, thus, the fact that "*there are no other meanings of 'graingers' in the English language*" (italics added) was a relevant factor leading to the holding that the term "GRAINGERS," which was sought to be registered for crackers and snack chips made from one or more processed cereal grains, was "suggestive of the grain-based nature of the products" and not primarily merely a surname. Plainly, given that English is the predominant language in the United States, it is accordingly the case that, in order for another meaning of a surname to have a bearing upon whether the primary significance thereof is that of a surname, the other or alternative meaning generally must be that of an ordinary, readily recognizable (rather than obscure) English term as opposed to that of a foreign word. See, e.g., In re Hamilton Pharmaceuticals Ltd., supra at 1942; and In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1367-68 (TTAB 1987). It is evident that, in this case, the additional meaning asserted by applicant for the surname "CHIARO" is that of an Italian word which, while susceptible to translation into English, is nonetheless not an English term itself.

Moreover, even assuming that it would be proper to take into consideration the fact that the surname "CHIARO" also is an Italian term which has a meaning of "light," "clear,"

"evident," "obvious" or "bright," we disagree with applicant that such meaning would ordinarily be known to the average purchaser of goods of the kinds offered by applicant under the mark "CHIARO," so that the primary significance of the mark would not be that of a surname. Suffice it to say that, while some of applicant's customers may be fluent in Italian, most would not be knowledgeable of the non-surname significance of the term. Clearly, the term is not a cognate which would have an immediately apparent translatable meaning in English. Although the homepage for applicant's website does indeed feature, below the logo for its "CHIARO" mark, the slogan "setting information free" which is followed by the definition "chiaro: (ke r' o) adj. {It} clear or bright; light," the fact that applicant apparently finds it necessary to include such a definition in order for its customers to be aware of the meaning thereof in Italian would seem to belie applicant's assertion that the term "chiaro" has another readily and commonly understood meaning. Furthermore, inasmuch as the excerpts from applicant's website reveal that its principal products involve "a unique optical packet switching technology," it is obvious that the displays on its website, such as a reference to career opportunities with applicant through use of the phrase "We're looking for people who see the light!," or the rays emanating from a stylized letter "C" above the term "CHIARO," merely

underscore the fiber optic or light-based nature of its hardware and software for controlling and operating computer and telephony networks. Such displays, and their double entendres, consequently play up the association of applicant's goods with light and fiber optic networks, but they do not necessarily serve to convey the English meaning of the Italian term "chiaro" to those otherwise unfamiliar therewith. In any event, that it appears that applicant needs to coach its customers as to the English significance of the Italian word "chiaro" is indicative that, in the absence of such prompting, the word would primarily convey only its ordinary meaning as a surname.

Applicant further argues, however, that "[i]n addition to the dictionary and promotional evidence discussed above," the searches which it had conducted in the "NEXIS" database and made of record show "significant non-surname usage of 'chiaro'" and thus "support ... its contention that 'chiaro' has a recognized meaning other than as a surname." In particular, based upon the analysis thereof by a law clerk to applicant's counsel, of the "1,476 hits" from such searches, "approximately 268 relevant references to 'chiaro'" were found, "after eliminating duplicate references to the same individual or entity, foreign publications and usages of terms other than 'chiaro'" (e.g., "non-surname usages such as 'Chiaro's"), of which "221 used the term 'chiaro' as a surname and the remaining 47 used the term

'chiaro' in a non-surname sense."⁴ Applicant, in its initial brief, asserts in view thereof that:

As can be seen from the analysis performed . . . , 47 of the 268 relevant references used "chiaro" in its non-surname sense; *i.e.*, as meaning "light", "bright", or "clear". For example, there were numerous references to a restaurant in Little Italy in New York City, "Mare Chiaro", "mare" meaning "sea". HARPER COLLINS POCKET ITALIAN DICTIONARY 144 (3d ed. 1999). There were also numerous references to a ship called the Monte Chiaro, "monte" meaning "mountain". *Id.* at 153. There were also several references to "chiaro" in the name of Italian foods. . . . Based on the foregoing, it is Applicant's contention that the NEXIS evidence shows that "chiaro" has a recognized meaning other than as a surname such as this factor should

⁴ Declaration of Ms. Tiffini Smith-Peaches, ¶¶4 and 5. It is pointed out, however, that as set forth in TMEP Section 1211.01(b)(v) (3d ed. 2d rev. May 2003):

The surname significance of a term is not diminished by the fact that the term is presented in its plural or possessive form. See *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (MCDONALD'S held primarily merely a surname based on a showing of surname significance of "McDonald," the Board noting that "it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades"); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) (BURDONS held primarily merely a surname based in part on telephone listings showing surname significance of "Burdon"); *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979) (DRUMMONDS held primarily merely a surname based on a showing of surname significance of "Drummond").

Therefore, while the failure to consider "usages such as 'Chiaro's'" to be surname rather than "non-surname" usages was error and the totals for relevant references and surname references should be higher than those stated by the declarant, we have for the sake of simplicity considered the figures as submitted by applicant.

weigh in favor of a conclusion that CHIARO as a trademark is not primarily merely a surname.

We disagree with applicant's contention. Among other things, applicant's analysis is clearly skewed towards maximizing the number of non-surname instances in which the term "chiaro" appears. While we have no problem with its eliminating from consideration those usages "that did not constitute the usage of 'chiaro' itself as a surname,"⁵ by the same token it should have also eliminated from analysis those usages, such as "Mare Chiaro" and "Monte Chiaro," that did not involve usage of "chiaro" *per se* in a non-surname manner. Furthermore, as the Examining Attorney observes in his brief, "what applicant's ... [analysis has] failed to indicate is that a majority of the non-surname stories refers to applicant, Chiaro Networks."⁶ Even more importantly, the non-surname instances of usage of "chiaro" by itself are relatively minor or obscure, while those instances in which such term is clearly utilized as a surname, comprising 221 instances out of a total of 268 by applicant's analysis, constitute nearly 83% of the relevant references located by

⁵ Declaration of Ms. Tiffini Smith-Peaches, ¶13.

⁶ Although applicant, in its reply brief, indicates that "[i]n making the assessment that, of the 268 relevant references in the Nexis search[es] that remained after eliminating duplicates, 221 consisted of surnames and 46 showed non-surname usage, the occurrence of Applicant itself was counted as one non-surname usage," it is still the case that the most common non-surname usage shown is that of references to applicant.

applicant. In light thereof, it is plain that the primary significance of the term "CHIARO" is its surname significance, and that the various other usages thereof do not detract from such significance.

As a final factor for consideration, applicant asserts that the term "CHIARO" does not have the "look and feel" of a surname. Again, relying on an analysis performed by a law clerk to its counsel, applicant notes in its initial brief that, of "607 other Italian family names" taken from "a complete list of Italian surnames excerpted from the genealogical reference book *People's Names*," "only 7 ... end with the suffix 'aro'." Based on such analysis, which is of record, applicant maintains that "'Chiaro' does not have the look and feel that one associates with Italian surnames."

The Examining Attorney, on the other hand, urges in his brief that "it is likely that CHIARO would be viewed as a surname," "given the well-known fact that Italian surnames often end with a vowel." Consequently, according to the Examining Attorney, "the term CHIARO would appear to have the structure and pronunciation of [a surname of] Italian heritage and would be so recognized by the purchasing public." Applicant's rejoinder, as set forth in its reply brief, that the Examining Attorney's "statement is of no more relevance than a statement that non-Italian surnames often end with a consonant" because

"[t]he last letter of any word must necessarily be either a consonant or a vowel" misses the mark. Applicant's own evidence not only confirms the Examining Attorney's statement, but shows that almost invariably, Italian surnames end with a vowel. Indeed, of the 607 Italian surnames listed in the excerpt of record from the genealogical reference book *People's Names*, all but seventeen of such names, that is, a total of 590 or 97%, end with a vowel.

In view thereof, there is support in the record for finding that the term "CHIARO" has the look and feel of a surname of Italian origin and, perhaps more importantly, we cannot say that, as urged by applicant, it is clearly the case that it does not. While to us, such term has the look and feel of an Italian heritage surname, we nevertheless realize that, given the highly subjective nature of the determination to be made, others may regard the term as one which looks and/or sounds like an Italian word but which is not necessarily a surname. This latter point of view concededly finds some support in the record inasmuch as "Chiaro," as noted by applicant, is not among the surnames listed in the excerpt from *People's Names* and only seven of the 607 names which do appear, or just over 1%, end in the suffix "-aro." Consequently, we agree with applicant's alternative conclusion, as set forth in

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its initial brief, that "[t]he most that can be said is that this 'look and feel' factor is neutral as applied to 'chiaro'."

We accordingly conclude that, while a rare surname and one which is not the surname of anyone connected with applicant, the mark "CHIARO" is nevertheless primarily merely a surname inasmuch as it is unlikely to have any readily recognizable meaning other than its surname significance.

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