

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

Mailed:  
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Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Indian Industries, Inc.

Serial No. 76481665

Charles J. Meyer of Woodard Emhardt Moriarty McNett & Henry  
LLP for Indian Industries, Inc.

Martha L. Fromm, Trademark Examining Attorney, Law Office  
106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Indian Industries, Inc. seeks registration on the  
Principal Register of the mark MOSCONI for goods identified  
in the application, as amended, as "billiards, namely,  
billiard tables, billiard cues, billiard balls, billiard  
chalk, eight and nine ball racks, cue racks, cue cases and  
billiards game playing equipment," in International Class  
28.<sup>1</sup>

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<sup>1</sup> Application Serial No. 76481665 was filed on January 13, 2003  
based upon applicant's allegation of a *bona fide* intention to use  
the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that applicant's mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4).

When the refusal to register was made final, applicant appealed. Applicant and the Trademark Examining Attorney have filed briefs. An oral hearing was not requested.

We reverse the refusal to register.

In support of the surname refusal, the Trademark Examining Attorney has made of record the following: the results of a search of the LEXIS/NEXIS® USFIND Person Locator database, finding 181 listings of the "Mosconi" surname, as well as relevant excerpts from The American Heritage Dictionary of the English Language, the Cambridge Dictionary of American English and the Encarta World English Dictionary, none of which showed any entries for the word "Mosconi."

Applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname case. Applicant challenges the Trademark Examining Attorney's LEXIS/NEXIS® database evidence on the ground that the quantum of evidence submitted by the Trademark Examining

Attorney is indeterminate of the primary significance of the term to purchasers. While applicant concedes that MOSCONI may well be an extremely rare surname in the United States, applicant argues that the evidence it has placed into the record shows that the public for billiards equipment immediately associates the term MOSCONI with the late Willie Mosconi, a world champion fifteen times between 1941 and 1957, and who, to this day, likely remains the most famous pocket billiards player of all time.

The Trademark Examining Attorney concedes that Willie Mosconi may rise to the level of a "semi-historical figure" known to a substantial minority of billiards aficionados, but that this fact does not take away from the fact that under Lanham Act precedent, this term is still deemed to be primarily merely a surname.

Whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The Office, through the Trademark Examining Attorney, bears the burden of establishing a *prima facie* case that a term is primarily merely a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985), *aff'g*, 222

USPQ 260 (TTAB 1984). 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. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975). Whether a term sought to be registered is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act can only be resolved on a case by case basis, taking into account a number of factual considerations. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

There are five factors to be considered in the analysis:

- (1) Is the word a common or rarely used surname?
- (2) Does anyone connected with the applicant have that surname?
- (3) Does the word have meaning other than as a surname?
- (4) Does the word look and sound like a surname?
- (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression?

In re Benthin Management GmbH at 1333-34 [Trademark Examining Attorney's refusal to register BENTHIN reversed, because it was a rare surname, did not look and sound like a surname, and was set forth in a highly stylized oval design].

In this case, there is no stylization or design involved; applicant seeks merely to register MOSCONI in typed form. Accordingly, the degree of stylization is not a factor in this case.

The first factor to be considered is the degree of a surname's rareness. In re Garan Inc., 3 USPQ2d 1537, 1540 (TTAB 1987). As indicated above, the Trademark Examining Attorney and applicant seem to agree that MOSCONI is a rare surname, and we find it to be so. However, rarity in a surname is not determinative in concluding whether or not an admitted surname is "primarily merely a surname" within the contemplation of Section 2(e)(4) of the Trademark Act. In re Etablissements Darty et Fils, supra; In re Rebo High Definition Studio Inc., 15 USPQ2d 1314 (TTAB 1990); Societe Civile Des Domaines Dourthe Freres v. SA Consortium Vinicole De Bordeaux et De La Gironde, 6 USPQ2d 1205 (TTAB 1988); and In re Luis Caballero, S.A., 223 USPQ 355 (TTAB 1984). Accordingly, we proceed to look at the other relevant factors.

As to the second factor, the document entitled "Assignment of Trademarks and Rights of Publicity" that accompanied the original application papers was signed by Gloria Mosconi, the widow of the late Willie Mosconi. In

light of this document, the Trademark Examining Attorney argues that “[a]ccordingly, the proposed mark is the surname of both the person assigning rights in the mark to the applicant and of the person after whom the applicant’s goods are named.” (Trademark Examining Attorney’s appeal brief, p. 4).

We consider next the decidedly subjective factor of whether MOSCONI has the structure and pronunciation of a surname, that is, whether the term has the look and sound of a surname. In re Industrie Pirelli, 9 USPQ2d 1564, 1566 (TTAB 1988), aff’d unpub’d, 883 F.2d 1026 (Fed. Cir. 1989). We conclude that MOSCONI indeed does have the look and feel of an Italian heritage surname.

Hence, three of the four relevant factors herein (factors one, two and four) clearly support the Trademark Examining Attorney’s *prima facie* case under Section 2(e)(4).

We turn then to the critical third factor, where applicant and the Trademark Examining Attorney obviously differ in their estimation of whether the term MOSCONI has significance to the relevant purchasers for anything other than as a surname. The Trademark Examining Attorney relies upon the absence of the word MOSCONI from the listings of three different online dictionaries to conclude that the

word has no meaning other than as a surname. In spite of applicant's arguments to the contrary, we find that the term MOSCONI, *per se*, will be viewed by most members of the public in the United States as primarily merely a surname.

However, we also agree with applicant that, in this case, such a sweeping conclusion is not the end of the inquiry. The gravamen of applicant's argument against our finding that the term MOSCONI is primarily merely a surname is its own showing that Willie Mosconi was of such historical significance in the field of billiards that MOSCONI should not be refused registration under Section 2(e)(4) of the Lanham Act. Applicant argues that this case is analogous to a prior Board decision finding that an applicant was entitled to registration of the mark SOUSA for fireworks and entertainment services because potential purchasers would associate patriotic events with an historic figure well known in our history for his patriotic music. *In re Pyro-Spectaculars Inc.*, 63 USPQ2d 2022 (TTAB 2002). In that case, the Board found that the Trademark Examining Attorney had indeed made out a *prima facie* case that SOUSA is primarily merely a surname, but that applicant had successfully rebutted it with its own showing:

... present day recognition of John Philip Sousa is not the only factor to be considered

in determining the primary significance of the term SOUSA. Even more important under the present circumstances is the specific nature of applicant's goods and services and the significance of the term SOUSA when used therewith. Applicant intends to use the term SOUSA in connection with fireworks and with shows featuring pyrotechnics. Clearly these are goods and services which would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music. Thus, we agree with applicant that when the relevant purchasing public encounters the term SOUSA, as it is intended to be used in connection with applicant's fireworks and fireworks displays, the immediate association of the term SOUSA will be with the famous "March King," John Philip Sousa. The 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 American history for his patriotic music. Although "Sousa" may also be a surname in current use in the United States, any such connotation of the term would clearly be secondary in significance when consideration is given to the particular nature of applicant's goods and services.

Accordingly, we find that applicant has adequately rebutted the *prima facie* case established by the Examining Attorney that SOUSA is primarily merely a surname. We find the evidence demonstrates that SOUSA would be viewed by the relevant purchasing public as a reference to John Philip Sousa when used in connection with applicant's goods and services.

*In re Pyro-Spectaculars Inc.*, 63 USPQ2d at 2024.

Similarly, while the Trademark Examining Attorney herein has successfully made out a *prima facie* case for

MOSCONI being primarily merely a surname, we find that the present applicant has successfully rebutted this case with its showing. The record is replete with references to the legendary Willie Mosconi as being so famous at billiards during the last fifty years of his life that his name is synonymous with the game. In a survey of members of the relevant purchasing public,<sup>2</sup> at least 21% of the respondents associated Willie Mosconi with the game of pool.<sup>3</sup> It is this showing that demonstrates that MOSCONI would be viewed by the relevant purchasing public as a reference to Willie Mosconi when used in connection with applicant's goods. This effectively rebuts the *prima facie* showing made by the Trademark Examining Attorney herein.

In conclusion, we find that MOSCONI is a relative rare surname, that individuals connected with applicant have this surname, that the word MOSCONI looks and sounds like a surname, and that for the public at large, the ordinary meaning of the term MOSCONI is merely as a surname. Nonetheless, we also find that this evidence is outweighed

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<sup>2</sup> Heads of households who were interested in sports, had household incomes of \$50,000 per year or higher, who had purchased a pool table or intended to do so within the next five years, conducted for Escalade Sports in September 2002.

<sup>3</sup> Consistent with much of this record, we are using "billiards" and "pool" as interchangeable terms.

by the strong association between the involved goods and the late Willie Mosconi.

*Decision:* The refusal of registration under Section 2(e)(4), on the ground that MOSCONI, when used, will be perceived as primarily merely a surname, is reversed.