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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Messrs. Picchiotti S.r.l.

Serial No. 76476489

John F. Volpe of Hedman & Costigan, P.C. for Messrs.
Picchiotti S.r.l.

Hannah Fisher, Trademark Examining Attorney, Law Office 111
(Craig D. Taylor, Managing Attorney).

Before Hairston, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Messrs. Picchiotti
S.r.l. (an Italian corporation) to register the mark
PICCHIOTTI for jewelry; precious metals; precious stones,
cuff links, tie pins, timepieces and jewelry cases.¹

The trademark examining attorney has refused
registration under Section 2(e)(4) of the Trademark Act on

¹ Application Serial No. 76476489, filed December 18, 2002. The application was filed pursuant to Section 44(d); applicant later submitted a certified copy of its Italian Registration No. 880375.

the ground that the mark sought to be registered is primarily merely a surname.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

In support of her surname refusal, the examining attorney has made of record the results of searches of the PowerFinder and Metacrawler electronic databases, which reveal that there are 36 residential telephone listings in the United States for the surname Picchiotti. The examining attorney has also submitted four excerpts from the NEXIS database which list three people with the surname Picchiotti. These excerpts include an article in the Chicago Daily Herald which mentions an Angie Picchiotti; an article in Florida Today which mentions a Rena Lynn Picchiotti; and articles in two different newspapers, namely, the Chicago Sun-Times and Tri-State Defender, which mention a musician named Mark Picchiotti. An additional excerpt from the NEXIS database which is from "Global News Wire" mentions that applicant is owned by Giuseppe Picchiotti. The examining attorney has also submitted pages from the Merriam-Webster's Geographical Dictionary and Harper Collins Italian Dictionary, neither of which shows a listing for Picchiotti. The examining attorney

maintains that the above evidence establishes a *prima facie* case that applicant's mark is primarily a surname

In urging reversal of the refusal to register, applicant argues that as evidenced by the examining attorney's limited evidence, Picchiotti is a rare surname in the United States, and thus would not be perceived by the public as a surname. Further, applicant contends that as a result of its extensive use of PICCHIOTTI and the fact that it has registered PICCHIOTTI as a trademark in many other countries, PICCHIOTTI has meaning other than as a surname. Finally, applicant requests that we resolve any doubt as to whether PICCHIOTTI is primarily merely a surname in applicant's favor.

The burden is on the trademark examining attorney to establish a *prima facie* case that applicant's mark is primarily a surname. If a *prima facie* case is established, the burden then shifts to the applicant to rebut it with evidence sufficient to establish that the primary significance of the mark is other than that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). Whether a term sought to be registered is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act must necessarily be resolved

on a case by case basis, taking into account a number of factual considerations. In re Etablissements Darty et Fils, supra, 225 USPQ at 653. These considerations include:

- (1) The degree of a surname's rareness;
- (2) Whether anyone connected with applicant has that surname;
- (3) Whether the word has any recognized meaning other than that of a surname; and
- (4) The structure and pronunciation or "look and sound" of the surname.

In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

As to the first factor, namely, the degree of the surname's rareness, the evidence submitted by the examining attorney shows that Picchiotti is a rare surname in the United States. Thus, this factor weighs in favor of a finding that PICCHIOTTI would not be perceived as primarily a surname.

As to the second factor, the NEXIS excerpt made of record by the examining attorney mentions that applicant is owned by Giuseppe Picchiotti. In this regard, we note applicant's statement that "applicant cannot dispute that someone connected with applicant has the subject term as a surname." (Brief, p. 3, fn. 1). Moreover, Picchiotti is used in applicant's company name in a manner which makes

apparent its surname significance, i.e., "Messrs. Picchiotti." Thus, this second factor weighs in favor of a finding that the mark PICCHIOTTI would be perceived as primarily merely a surname. See Darty, at 653 (The mark sought to be registered, DARTY, was not only the surname of a principal of applicant's business, but also was used in the company name in a manner which revealed its surname significance).

As to the third evidentiary factor, namely, whether PICCHIOTTI has any recognized meaning other than that of a surname, applicant contends that PICCHIOTTI has another meaning because it has extensively used PICCHIOTTI and the term is registered as a trademark in many other countries. We are not persuaded by applicant's arguments. Applicant does not seek to register its mark under the provisions of Section 2(f) of the Trademark Act, and in the absence of a Section 2(f) claim, evidence of extensive use of the PICCHIOTTI mark cannot serve as the basis for allowing registration of applicant's mark. See *In re Industrie Pirelli*, 9 USPQ2d 1564, 1565 (TTAB 1988)[Without a formal claim of distinctiveness under Section 2(f), evidence of fame as a result of use of PICCHIOTTI cannot serve as the basis for allowing registration of applicant's mark]. Also, applicant's ownership of foreign registrations for

the mark PICCHIOTTI is not relevant to a determination of whether applicant is entitled to registration of PICCHIOTTI in the United States. In this case, the record is devoid of any evidence that Picchiotti has any meaning other than that of a surname. Indeed, the evidence submitted by the examining attorney shows that Picchiotti does not appear in dictionaries as an Italian or English word. Thus, the third factor also weighs in favor of a finding that PICCHIOTTI would be perceived as primarily merely a surname.

This brings us to the fourth factor to be considered in this case, namely whether Picchiotti has the structure and pronunciation of a surname, or the "look and sound" of a surname. As stated in *Pirelli*, at 1566, "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." We recognize that this factor is subjective in nature. In this case, we find that PICCHIOTTI indeed has the "look and sound" of a surname.

In view of the foregoing, we find that the examining attorney has made out a prima facie case that PICCHIOTTI is primarily merely a surname. We also find that applicant

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has failed to present evidence sufficient to rebut that prima facie case.

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