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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Phoenix Intangibles Holding Company

Serial Nos. 76562080 and 76587659

David V. Radack of Eckert Seamans Cherin & Mellott, LLC for
Phoenix Intangibles Holding Company.

Toni Y. Hickey, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Phoenix Intangibles Holding Company seeks registration
on the Principal Register of the mark **LAURENTI** for goods
recited in two applications, as amended, as follows:

"Processed olives; olive oil; canned
tomatoes; and frozen, prepared and packaged
entrees consisting of meat, fish, poultry or
vegetables" in International Class 29;

"Pasta; pizza sauce; tomato sauce; spaghetti
sauce; vinegar; cookies, crackers; rice;
bread crumbs; bakery desserts; and frozen,
prepared and packaged entrees consisting
primarily of pasta or rice" in International
Class 30;

"Fresh olives; unprocessed olives; fresh vegetables; and fresh fruits" in International Class 31;

"Mineral water" in International Class 32;

"Cooking wine and wine" in International Class 33;¹

"Processed mushrooms, artichoke hearts, chickpeas, eggplant, zucchini, asparagus, peppers, onions, grape leaves, beans and lentils; dried tomatoes; salads except macaroni, rice, and pasta salad, namely, antipasto salads and tabouleh; seafood; peppercorns; cheese, meat-based, fruit-based and vegetable-based spreads; anchovy paste; dried figs, apricots and dates; soup; hummus; tahini; dairy based dip, namely tzatziki; baba ganoush; soprassetta meat; salami; proscuitto ham; and cheese" in International Class 29;

"bread; risotto; coffee; tea; espresso; spices; capers; prepackaged pita bread sandwiches; dried peppercorns for use as a spice; rice cake, namely, baba ganoush; and flour based chips, namely, pita chips" in International Class 30; and

"Fresh nuts and fresh onions" in International Class 31;²

These cases are now before the Board on appeal from the final refusals of the Trademark Examining Attorney to register this designation based upon the ground that the

¹ Application Serial No. 76562080 was filed on November 26, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Application Serial No. 76587659 was filed on April 16, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4).

Applicant and the Trademark Examining Attorney submitted briefs on both cases. Applicant did not request an oral hearing. The marks, the legal issues, the procedural histories and overall records are nearly identical in these two appeals. Accordingly, these cases were consolidated in order to issue a single opinion for the appeals of the refusals to register these two applications. We affirm both refusals.

In support of the surname refusals, the Trademark Examining Attorney has made of record the following: evidence from the USFIND database consisting of address lists and telephone directories including approximately 167 listings of the surname LAURENTI from within the United States; excerpts from the LEXIS/NEXIS database; and portions of Internet articles found using the Google search engine, allegedly demonstrating the surname use of the term LAURENTI, as well as excerpts from websites such as www.mytrees.com, www.rhymezone.com, www.genealogy.com,

www.onegreatfamily.com,³ and www.ancestry.com,⁴ which uniformly identify LAURENTI as a rare surname.

However, applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname case. Applicant challenges the Trademark Examining Attorney's conclusion that the purchasing public would perceive the mark as primarily merely a surname. Applicant argues that the designation LAURENTI is a very rare Italian surname that has actually been dying out in the United States; that no one connected with applicant has this surname; that "Laurenti" does not have the look and feel of a surname; and that the best case for the Trademark Examining Attorney's position is insufficient to make a *prima facie* case, namely, that according to the United States Census Bureau, the name LAURENTI is "62,511th in popularity rank [among 88,799 unique surnames] in the U.S.!"⁵

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to

³ <http://www.onegreatfamily.com/surname/LAURENTI?AID=9761992&RID=595199>; " <2,500 [LAURENTI] in 1990 US Census count (approximate)."

⁴ For example, this site shows "106 [LAURENTI] matches in U.S. Federal Census Records (1700 - 1930); 323 matches in Birth, Marriage and Death Records; 767 matches in historical newspapers (1700's - 2001)."

⁵ http://www.census.gov/genealogy/names/nam_meth.txt

the purchasing public. See In re Hutchinson Technology Inc., 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), citing In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Trademark Examining Attorney to establish a *prima facie* case that a mark is primarily merely a surname. See In re Etablissements Darty et Fils, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the Trademark Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut this finding.

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4) on terms shown in standard character drawings:

- (i) the degree of surname rareness;
- (ii) whether anyone connected with applicant has the surname;
- (iii) whether the term has any recognized meaning other than that of a surname; and
- (iv) the structure and pronunciation or "look and feel" of the surname.

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

We find that the Trademark Examining Attorney has met her initial burden of establishing that LAURENTI is primarily merely a surname. In particular, the Trademark Examining Attorney has presented evidence of hundreds of LAURENTI surname references from the USFIND database and from genealogical websites. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a *prima facie* surname case. See Hutchinson Technology, 852 F.2d at 554, 7 USPQ2d at 1492; Darty, 759 F.2d at 16, 225 USPQ at 653; see also 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 13.30, p. 13-50 (4th ed. 2001).

The Trademark Examining Attorney's USFIND evidence is collected from telephone and address directories across the country. There is no magic number of directory listings required to establish a *prima facie* surname case. In re Gregory, 70 USPQ2d 1792 (TTAB 2004); In re Cazes, 21 USPQ2d 1796, 1797 (TTAB 1991); In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988), aff'd unpublished decision No. 89-1231, 883 F.2d 1026 (Fed. Cir. 1989). Based upon more than a hundred LAURENTI surname references in the USFIND database, we conclude that hundreds of

persons currently living in the United States have the surname "Laurenti."⁶

We note that applicant dismisses the significance of the 167 listings from the USFIND database inasmuch as this number ranks "Laurenti" at "62,511th in popularity rank in the U.S." population. However, we find applicant's arguments as to the infrequency of the occurrences in the census, or contentions that we should overturn the position of the Trademark Examining Attorney based upon this surname's specific rank in frequency of appearance, to be a hollow reed. Given the incredibly rich diversity of surnames in this country, we conclude, instead, that this ranking means only that many persons in the U.S. have surnames even more rare than "Laurenti."

⁶ We conclude there are "hundreds" inasmuch as we can assume that more than one person of the same family name resides at many of the listed telephone numbers, and that there is not a complete overlap with the genealogical listings.

In any event, we should point out that the evidence in this case is more compelling than that in several reported cases where a rare surname was found to be registrable - especially when a limited number of listings is combined with other relevant factors. See e.g. *Kahan & Weisz*, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); and *In re Garan, Inc.*, 3 USPQ2d 1537 (TTAB 1987)(six GARAN telephone directory listings and one NEXIS listing); see also *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994)(one hundred SAVA surname telephone directory listings, but SAVA has other meanings, looks like an acronym, and the Trademark Examining Attorney produced evidence of only one individual having the surname SAVA with a search of the NEXIS database); and *Benthin Management*, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings, but the design mark was presented in "a highly stylized form").

In response to applicant's arguments (accompanied by printouts showing dates of death of various persons having the family name "Laurenti") that this is an Italian surname that actually appears to be "dying out" in the United States, the Trademark Examining Attorney argues in her Office action of December 12, 2004 that the totality of her Lexis/Nexis evidence, coupled with the phone listing data, demonstrates "that there are numerous people in the United States with the surname LAURENTI who are having children, attending high school, mourning funerals [sic], engaging in sporting activities and authoring scientific journals."

We must agree with applicant that the truncated heading portions of most of these Lexis/Nexis excerpts, as shown in the TICRS electronic record and as sent to applicant, fail to include any evidence of how the term "Laurenti" is actually used in these stories.

Nonetheless, in addition to the two Lexis/Nexis hits where "Laurenti" is clearly the surname of two specific individuals, the Trademark Examining Attorney has made of record several articles found in her Internet search of the term "Laurenti." These excerpts show, for example, that persons in the news having the surname "Laurenti" include Adolpho Laurenti, Associate Economist of LaSalle Bank, and

Jeffrey Laurenti, Executive Director, Policy Studies,
United Nations Association of the United States.

As to the second Benthin factor, there is no clear evidence in this record that someone with the surname LAURENTI is associated with applicant. Thus, based on the evidence in this record, this factor is neutral.

The third Benthin factor we consider is whether the term has a recognized meaning other than that of a surname. The Trademark Examining Attorney has submitted a web page printout from the www.onelook.com online database indicating that the term "laurenti" has no non-surname meaning. In the face of this showing, applicant has failed to identify even a remote or obscure meaning for the term LAURENTI.

Finally, we consider whether LAURENTI has the structure and pronunciation - or the "look and feel" - of a surname. See In re Industrie Pirelli, 9 USPQ2d at 1566. The Board found PIRELLI to be a surname because, *inter alia*, it "looks like an Italian surname, being similar in structure to Italian surnames which do appear in excerpts from the American Surnames reference book made of record by applicant (viz., Antonelli, Mancinelli, Pacelli, etc.)." *Id.* at 1565. LAURENTI, like PIRELLI, is a three-syllable

Italian surname ending in the letter "i." Additionally, it has a similar structure and pronunciation to related surnames such as Laurent, DeLaurentis and Laurente. See Garan, 3 USPQ2d at 1538. On this factor, it is our view that LAURENTI would be perceived only as a surname.

By contrast, if a term does not have the look and feel of a surname, such that consumers are likely to view it as something other than a surname, it would not be primarily merely a surname. For example, the term HACKLER will not be perceived as primarily merely a surname when used in connection with alcoholic beverages. In addition to the fact that the term HACKLER has a dictionary meaning that appears to tie into these goods, the term HACKLER does not have the clear "look and feel" of a surname. In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000). See also Benthin Management, *supra*. That is clearly not the case herein.

In conclusion, while LAURENTI is a rare surname, it has the look and feel of a surname and the record points to no other recognized meaning for this term.

Decision: The refusals in both of these applications to register the term LAURENTI under Section 2(e)(4) of the Act are hereby affirmed.