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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Binda International S.A.

Serial No. 78313893

Cecelia M. Perry of McGlew and Tuttle for Binda
International S.A.

Christina Brightmire King, Trademark Examining Attorney,
Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hairston, Bucher and Holtzman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Binda International S.A. seeks registration on the
Principal Register of the mark **BREIL** for goods identified as
"horological and chronometric instruments, precious stones,
jewelry and costume jewelry articles" in International
Class 14.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 78313893 was filed on October 15,
2003 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

register this designation based upon the ground that the 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 have fully briefed the case. Applicant did not request an oral hearing. We affirm the refusal to register.

In support of the surname refusal, the Trademark Examining Attorney cites to evidence she placed into the record:

A total of 43 listings from telephone books in the United States are of record. These listings identify use of the surname in fourteen (14) geographically dispersed states: California, Colorado, Florida, Illinois, Indiana, Massachusetts, Michigan, New Jersey, New York, Ohio, Oregon, Pennsylvania, Virginia and Wisconsin. Additional evidence from the Nexis database, made of record in the first Office action issued May 31, 2004, indicates coverage of stories involving persons whose surname is BREIL, namely, Lynne, Klaus, Rebecca, John, Dolores, Phyllis, Kimberley, Ilan and Peter. Use of the surname for individuals mentioned in materials originated in many geographical areas of the United States, namely, York Daily Record (York, PA), The Seattle Times, The York Dispatch (York PA), Buffalo News (New York), Richmond Times Dispatch (Virginia), Art Business News and The Wichita Eagle, Daily Variety, and Ophthalmology Times.

However, applicant argues that the Trademark Examining Attorney has failed to establish a *prima facie* surname

case. Applicant alleges that "[t]he rule is an unusually large number of directory listings are needed to carry the burden of proof," citing to In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975) to support this proposition. Applicant goes on to allege that the Trademark Examining Attorney has not met her burden of proof with "a listing of 40 white page occurrences and 15 NEXIS occurrences." Applicant concedes that while the designation BREIL "can be considered a very rare surname" ... "out of a population of about 296,217,713 in the United States this is .00001687%." Applicant argues repeatedly that the term BREIL is not likely to be perceived as a surname but will instead be thought of as a coined or fanciful word. Applicant also contends that there is no one in the applicant company who has the BREIL surname; that the word "Breil" does not have the look and feel of a surname; and that any doubt should be resolved in favor of applicant. Acknowledging that there is no other recognized meaning for the word "Breil," applicant argues that this fact alone does not establish BREIL to be primarily merely a surname, especially in light of its rarity as a surname.

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

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., *supra*. 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 BREIL is primarily

merely a surname. In particular, the Trademark Examining Attorney has presented evidence of forty-three listings from telephone books coupled with fifteen occurrences in the Nexis/Lexis database. 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, 7 USPQ2d at 1492; Darty, 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 evidence is collected from electronic versions of national telephone directories. 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 the BREIL surname references in the various Lexis/Nexis databases, we conclude that at a minimum, dozens of persons currently living in the United States have the surname "Breil."²

² We note 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

We note that applicant dismisses the various listings the Trademark Examining Attorney submitted for the record inasmuch as "out of a population of about 296,217,713 in the United States this is .00001687%." However, we find applicant's arguments as to the infrequency of the occurrences in the record to be a hollow reed. The rich diversity of surnames in this country is amply reflected in computer database evidence. If one were to take a statistical measurement of this database for common names like "Smith" or "Jones," each would constitute a relatively small fraction of the total database content. Gregory, *supra* at 1795.

In any event, the Trademark Examining Attorney also has made of record excerpts of articles found in her Nexis search of the term "Breil." These excerpts show that some persons named in these news articles are different from those listed in the telephone listings mentioned above.

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").

As to the second Benthin factor, there is no clear evidence in this record that someone with the surname BREIL 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. According to the record, BREIL lacks any readily recognized meaning in the ordinary parlance. Furthermore, applicant conceded in its brief that BREIL has no other meaning than that of a surname. Applicant's brief at page 7.

Finally, we consider whether BREIL has the structure and pronunciation - or the "look and feel" - of a surname. 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. The term BREIL has a similar structure and pronunciation to related Germanic surnames such as BRULE, BRIEL and BREILING. See Garan, 3 USPQ2d at 1538. Accordingly, on this factor, we agree with the Trademark Examining Attorney that BREIL 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.

As to applicant's suggestion, made for the first time in its brief, that in spite of a finding that this is primarily merely a surname, it has acquired distinctiveness as a source indicator for watches, we agree with the well-articulated position expressed by the Trademark Examining Attorney in her appeal brief:

Applicant further argues that BREIL is a famous trademark, it was registered by Applicant's predecessor for watches on the Principal Register for 21 years but was not renewed due to non-use in the United States and that a surname refusal was not given during the prosecution of the original application. Applicant further argues that BREIL is registered in several countries and that the goods are sold throughout the world

and that BREIL has gathered trademark significance worldwide and is a well-known watch through the sale and advertising throughout the world. Applicant further stated that American purchasers of fine watches know BREIL and will associate the trademark with watches. The fame of the applicant's mark and the earlier existence of a previous registration would certainly be relevant factors in establishing distinctiveness under Section 2(f) of the Trademark Act. Applicant has not claimed the benefits of Section 2(f) and, without a formal claim of distinctiveness under Section 2(f), the evidence of fame and a prior registration cannot serve as the basis for allowing registration of applicant's mark. See *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986).

In conclusion, while BREIL is a rare surname, it has the look and feel of a surname, the record points to no other recognized meaning for this term, and applicant has not attempted to take advantage of the provisions of Section 2(f) of the Act.

Decision: The refusal to register the term BREIL under Section 2(e)(4) of the Act is hereby affirmed.