

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/445173

APPLICANT: Isabella Fiore, LLC

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MARK: FIORE

CORRESPONDENT'S REFERENCE/DOCKET NO: 531651-0003

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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

RE: Serial Number 76/445173

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-------------|--|---|-----------------|
| Applicant: | Isabella Fiore, LLC | : | BEFORE THE |
| Trademark: | FIORE | : | TRADEMARK TRIAL |
| Serial No.: | 76/445173 | : | AND |
| Attorney: | Valerie du Laney | : | APPEAL BOARD |
| Address: | Miller Nash LLP 4400 Two Union Square 601 Union Street Seattle, Washington 98101-2352 | : | ON APPEAL |

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the trademark examining attorney's final refusal to register the mark "FIORE" for "all purpose sport bags, all-purpose athletic bags, animal carriers, animal harnesses, animal leashes, athletic bags, attaché cases, baby backpacks, baby carriers worn on the body, backpacks, beach bags, billfolds, book bags, boston bags, briefbags, briefcases, briefcase-type portfolios, business card cases, business cases, calling card cases, carry-on bags, catalog cases, change purses, clothing for animals, clutch bags, clutch purses, coin purses, collars for pets bearing medical information, cosmetic bags sold empty, cosmetic cases sold empty, credit card cases, day packs, diaper bags, document cases, dog apparel, drawstring pouches, duffel bags, fanny packs, garment bags for travel, golf umbrellas, gym bags, handbags, hat boxes for travel, key cases, knapsacks, leashes for animals, leather shopping bags, leggings for animals, lipstick holders, luggage, luggage tags, mats and pads made of fabric for use with animal training, name card cases, non-motorized, collapsible luggage carts, overnight bags, overnight cases, parasols, pet clothing, pocketbooks, purses, satchels, school bags, shaving bags sold empty, shoe bags for travel, shoulder bags, suit bags, suitcases, toiletry cases sold empty, tote bags, train cases, travel bags, bags, trunks, umbrellas, vanity cases sold empty, waist packs, and wallets" in International Class 18. Registration was refused in accordance with Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052 (e)(4), on the ground that the proposed mark for which registration is sought is primarily merely a surname.

FACTS

On August 29, 2002, the applicant applied to register the typed form mark "FIORE" on the Principal Register for various goods in International Class 18. In the first Office action, the examining attorney refused registration under Section 2(e)(4) of the Trademark Act on the basis that the proposed mark was primarily merely a surname. The examining attorney also required that

the applicant submit an English translation of the foreign wording that comprised the mark. As evidence that the mark appeared to have a meaning in a foreign language, the examining attorney made of record one copy of a translation for "FIORE" acquired from the examining attorney's search of an on-line translations database. The applicant addressed the refusal in a response in favor of registration. In its response, the applicant submitted an English translation of "FIORE" which was accepted and entered into the record. The examining attorney carefully considered the applicant's arguments concerning the Section 2(e)(4) refusal, but found them unpersuasive. In accordance with 37 C.F.R. Section 2.64, a final refusal was issued in accordance with 37 C.F.R. Section 2.64 on February 5, 2004. After issuance of the final refusal, this appeal ensued.¹

ARGUMENT

THE PRIMARY SIGNIFICANCE OF THE MARK IS THAT OF A SURNAME.

A mark that is considered primarily merely a surname under Trademark Act Section 2(e)(4), 15 U.S.C.1052(e)(4) is not registrable on the Principal Register absent a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. 1052(f). Section 2(e)(4) of the Trademark Act reflects the common law that exclusive rights in a surname *per se* cannot be

¹ The applicant's brief was submitted under the name of Attorney Melissa Weiland who is with "Accessory Design Holdings, Inc.", a company that is not the applicant. A power of attorney was not filed by Ms. Weiland nor has the correspondence address been changed by the applicant. Moreover, as the Board has forwarded a copy of the applicant's brief to the examining attorney via a notice that was submitted to Attorney Valerie du Laney of Miller Nash LLP <http://ttabvueint.uspto.gov/ttabvue/v?pno=76445173&pty=EXA&eno=1>, as well as the acknowledgement of appeal and notice of brief deadline for applicant <http://ttabvueint.uspto.gov/ttabvue/v?pno=76445173&pty=EXA&eno=1>, the examining attorney has designated Ms. du Laney as the applicant's counsel for the purpose of mailing this brief by including only her name in the heading. The examining attorney also respectfully advises the Board of the existence of a similar co-pending application, namely Application Serial No. 76/445172, which is also for the typed form mark "FIORE." Said co-pending application is currently on appeal and consists, in part, of the exact surname issue addressed in this brief.

established without evidence of long and exclusive use of the surname which, therefore, changes the significance of the surname from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his or her surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

The question of whether a mark is primarily merely a surname depends on the mark's primary significance to the purchasing public. See, e.g., *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955). Each case must be decided on its own facts, based upon the evidence in the record. TMEP Section 1211.01. The following five factors are considered in the determination of whether a mark is primarily merely a surname:

- 4.the rareness of the surname;
- 5.whether anyone connected with the applicant has the mark as his or her surname;
- 6.whether the term has any recognized meaning other than as a surname; and
- 7.whether the mark has the structure and pronunciation of a surname; and
- 8.whether the mark is sufficiently stylized to remove its primary significance from that of a surname.

TMEP §1211.02(b). See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) and cases cited therein.

The burden of proof is initially on the examining attorney to establish a *prima facie* case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). There is no rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. See, e.g., *In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB

1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that is generally considered to be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on specimens; dictionary definitions of the term and evidence from dictionaries showing no definition of the term. TMEP §1211.02(a). It should be noted that, in this case, the applicant clearly states for the record, "Applicant does not dispute that the word FIORE is a surname."²

A. The examining attorney's evidence of record has established a prima facie case that the mark is primarily merely a surname.

In the instant case, the examining attorney submits that the following evidence, properly made of record, satisfies the burden of proof with respect to the establishment of a *prima facie* case that "FIORE" is primarily merely a surname:

- evidence that the Lexis-Nexis® USFIND database of telephone listings yielded five thousand one hundred ninety-three (5,193) residential listings for the surname "FIORE"
- copies of five hundred (500) residential listings for the surname "FIORE" from the Lexis-Nexis® USFIND database
- evidence that a search of "FIORE" in the Lexis-Nexis® research database yielded three hundred eighteen (318) articles (after such search was narrowed to articles from January 1, 2004 through February 2, 2004 as the result of excessive generation of articles)
- copies of eighty-nine (89) article excerpts from the Lexis-Nexis® research database showing "FIORE" used as a surname
- ten (10) Internet webpage excerpts showing "FIORE" used as surname
- ten (10) on-line dictionary excerpts showing the absence of any definition for the term "FIORE"

The applicant contends that "the Examining Attorney has the burden of producing *substantial* evidence that the mark's primary significance to the relevant purchasing public is as a surname" (emphasis added)³. However, the applicant cites no authority for its proposition that the examining attorney must produce substantial evidence. Moreover, subsequent to the foregoing

² Applicant's brief at page 7.

³ Applicant's brief at page 5.

statement, the applicant further states to the contrary that “there is no bright-line rule as to the kind *or amount* of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname” (emphasis added)⁴ which is a valid statement. According to the applicant, the examining attorney’s finding of five thousand one hundred ninety-three (5,193) residential listings for the surname “FIORE” “does not constitute *prima facie* evidence that the term FIORE has *only* or even *primarily* surname significance,” because the examining attorney has merely shown that “some 5,000 people out of approximately 288,600,000 recently estimated to populate the United States, and out of the 1 billion records available in the LEXIS NEXIS database, have the surname ‘FIORE.’”⁵ The applicant further asserts that, based on the foregoing numbers, “FIORE” is a surname among 0.00002% of the population.

The applicant seeks to enter new evidence consisting of the 288,600,000 population statistic from the U.S. Census Bureau’s *Statistical Abstract of the United States*. The examining attorney objects to the submission of this evidence as untimely, pursuant to 37 C.F.R. Section 2.142(d). The examining attorney further objects to the applicant’s statistical calculation of 0.00002%, as there is no evidence in the record that the residential telephone listings in the Lexis-Nexis® USFIND database number one billion⁶ or that the USFIND database contains residential telephone listings for every single person comprising the alleged 288,600,000 United States population. It is highly likely that many persons comprising the aggregate United States population, such as infants and small children, (1) do not have a residential telephone; (2) have an unlisted residential telephone number; (3) use a cellular telephone in lieu of a residential land line, etc. Consequently, such persons may not be listed in the USFIND residential telephone listing database.

⁴ Applicant’s brief at page 5.

⁵ Applicant’s brief at page 6.

⁶ This figure exceeds the applicant’s proposed 288,600,000 population figure.

B. The evidence provided by the applicant fails to rebut the established prima facie case that the mark is primarily merely a surname.

The applicant argues that, “assuming the record contains a *prima facie* showing of surname significance, Applicant has rebutted that showing”⁷ by demonstrating that (1) “FIORE” is rare as a surname; (2) “FIORE” has an alternative recognized meaning; (3) “FIORE” has geographic significance; (4) “FIORE” has historical significance; (5) “FIORE” does not look or sound like a surname; (6) no one associated with the applicant has the surname “FIORE”; and (7) the United States Patent and Trademark Office has recognized the fact that equivalent marks are not primarily merely a surname.⁸ However, the evidence of record clearly demonstrates that the primary significance of the mark to the purchasing public is that of a surname, and the applicant has failed to rebut such evidence.

“FIORE” is not a rare surname.

The applicant maintains that “FIORE” is a rare surname, because the USFIND database in which the examining attorney found five thousand one hundred ninety-three (5,193) residential telephone listings for “FIORE” is massive in scope. However, there is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. See, e.g., *In re Industrie Pirelli S.p.A.*, 9 USPQ 1564 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (twenty-four listings of Petrin found sufficient); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986) (eleven telephone listings and twelve Lexis-Nexis® references of persons named Posten found sufficient). Further, in addition to the five thousand one hundred ninety-three (5,193) USFIND residential telephone listings made of record, the examining attorney has also made of record three hundred eighteen (318) articles (from a narrowed Lexis-Nexis® search)⁹ and ten (10) Internet excerpts. It should also be noted that, even if the applicant had proved that

⁷ Applicant’s brief at page 6.

“FIORE” is a rare surname, rare surnames may be unregistrable under Trademark Act Section 2(c)(4) if their primary significance to purchasers is that of a surname. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990).

The fact that “FIORE” is an Italian word with an English translation does not obviate its primary surname significance.

The applicant asserts that, because “FIORE” means “flower” in Italian, “FIORE” cannot be held to be primarily merely a surname. In actuality, the fact that a term also has a meaning other than that of a surname does not necessarily prove that the term is not primarily merely a surname. The primary significance of a term is not determined by the fact that the term has another meaning, but by whether the other meaning is the primary meaning given to the term by the purchasing public. See *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987). As indicated in *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.”¹⁰ Whatever meaning a term may have to the purchasing public of another country (e.g., Italy) has no bearing on the determination of the term’s significance to consumers in the United States. See *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983).

The applicant contends that Italian is increasingly popular as a language for study and practice in the United States. The applicant further maintains that its goods are “sold primarily at luxury retailers such as Saks Fifth Avenue, Neiman Marcus and Bloomingdales [sic], whose clientele can reasonably be expected to be relatively well-educated and well-traveled”¹¹ and, thus, knowledgeable of the Italian language. The applicant has not submitted any evidence supporting

⁸ Applicant’s brief at pages 7 – 12.

⁹ Eighty-nine (89) of the three hundred eighteen (318) article excerpts have been made of record.

¹⁰ See also *In re Carl Braun, Camerawerk*, 124 USPQ 184 (TTAB 1960).

¹¹ Applicant’s brief at page 8.

its argument that the goods are sold solely in upscale trade channels or any evidence supporting its argument that shoppers at upscale stores are well-educated, well-traveled, and/or knowledgeable of the Italian language. Given that English is the predominant language in the United States, 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.*, 27 USQ2d 1939, 1942 (TTAB 1993); 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 “FIORE” is that of an Italian word (i.e., “FIORE”) which, while susceptible to translation into English as “flower,” is nonetheless not an English term itself. With respect to the applicant’s argument that its “ISABELLA FIORE” merchandise is often accompanied by the symbol of a single rose which emphasizes the “flower” translation of “FIORE,”¹² it is noted that the proposed mark in this case is the typed form mark “FIORE” and does not contain any flower design. The Board’s decision will be premised on the mark in this application, not that plus any additional matter which may appear with this mark when it is used. *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1143 (TTAB 1993).

“FIORE” is not primarily a geographic or historical term.

The applicant argues that “there are several historical and current place names *that include the word FIORE*, including street names, villa names, an entire town in Italy (as well as Paraguay), and the famous Gothic cathedral in Florence, Santa Maria del Fiore”¹³ (emphasis added). However, the applicant has not submitted evidence of the term “FIORE,” standing alone, as having any major significance as a geographic term. The fact that a term is shown to have some minor

¹² Applicant’s brief at page 8. See also page 11 hereof for additional details concerning the applicant’s usage of “Isabella Fiore.”

¹³ Applicant’s brief at page 9.

significance as a geographical term will not dissipate its primary significance as a surname. TMEP §1211.01(a)(iii). *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (“The fact ... that “HAMILTON” has been shown to have some minor significance as a geographical term does not dissipate its primary significance as a surname.”); *In re Picone*, 221 USPQ 93, 95 (TTAB 1984). It should also be noted that the examining attorney has made of record ten (10) dictionary excerpts showing the absence of any definition, geographic or otherwise, for the term “FIORE.”

The applicant further claims that “FIORE” is associated with a number of historical people, events, and customs, including the Italian mystic, Joachim of Fiore.¹⁴ Decisions concerning historical names generally draw a line between names which are so widely recognized that they are almost exclusively associated with a specific historical figure and are thus not considered primarily merely a surname, *e.g.* *Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci), and names which are only semi-historical in character and thus can be perceived as primarily merely a surname, *e.g.*, *Frances Rothschild, Inc. v. U.S. Cosmetic Fragrance Marketing Corp.*, 223 USPQ 817 (N.D. Tex. 1983) (ROTHSCHILD held primarily merely a surname despite being the surname of a historical banking family); *In re Champion International Corp.*, 229 USPQ 550 (TTAB 1985) (MCKINLEY held primarily merely a surname despite being the surname of a deceased president). In this case, the applicant has not submitted any evidence that “FIORE” is so widely recognized that is almost exclusively associated with a particular historical figure.

¹⁴ Applicant’s brief at page 10.

“FIORE” has the look and feel of a surname.

The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); TMEP §1211.01(a)(vi). The applicant contends that “FIORE” “does not have the look, sound, or pronunciation” of a surname. However, the examining attorney submits that, given the well-known fact that Italian surnames often end with a vowel, the term “FIORE” has the look, sound and pronunciation of the surname of a person with Italian heritage and would be so recognized by the purchasing public.

The applicant’s “ISABELLA FIORE” name emphasizes the surname significance of “FIORE.”

The applicant argues that there is no person associated with it who has the surname “FIORE.”¹⁵ While the applicant’s statement may be true, as the applicant has noted, “since 1998, Applicant has marketed an exclusive line of accessories, including bags, under the mark ISABELLA FIORE.”¹⁶ A review of U.S. Registration No. 2824673, owned by the applicant and attached to and made of record by the applicant in its response to the first Office action, indicates that, because “ISABELLA FIORE” was perceived as the given name and surname of an individual, the applicant was required to indicate for the record whether the name referred to a living individual. Accordingly, although the name, “Isabella Fiore,” is coined, it is the examining attorney’s position that, based on the fact that the applicant’s name is Isabella Fiore, LLC and the applicant has marketed a variety of designer goods under the name, “Isabella Fiore,” the primary meaning given to “FIORE” by consumers in the marketplace would be that of the surname of Isabella Fiore.

¹⁵ Applicant’s brief at page 11.

¹⁶ Applicant’s brief at page 1.

The fact that “FIORE” is the phonetic equivalent of a term with no surname significance does not overcome the surname significance of “FIORE.”

The applicant maintains that, “FIORE” is the phonetic equivalent of “FIORI,” and “the PTO has registered numerous marks using or incorporating “FIORI” without evidence of acquired distinctiveness.” As previously indicated herein, the question of whether a mark is primarily merely a surname depends on the mark’s *primary* significance to the purchasing public.¹⁷ Accordingly, the fact that the surname is also the phonetic equivalent of other terms does not change the surname significance of the term.¹⁸

C. The examining attorney has properly weighed the applicant’s evidence.

The applicant contends that “the Examining Attorney has not correctly weighed Applicant’s evidence”¹⁹ by failing to “review the entire wall of evidence.”²⁰ According to the applicant, when determining whether a mark is primarily merely a surname, “the legal standard established by the TTAB or the federal courts, and case law is clear that all relevant factors be taken into account together, weighed, and balanced as a whole.”²¹ The applicant further alleges that the examining attorney has improperly attempted to “chip away”²² at each of the factors and has not weighed all of the factors together as a whole. On the contrary, the examining attorney has properly considered, analyzed and weighed the applicant’s evidence in accordance with the factors established by the Trademark Trial and Appeal Board in *Benthin*²³ and has determined that the factual considerations, on balance, weigh in favor of a finding that “FIORE” is primarily merely a surname.

¹⁷ See, e.g., *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm’r Pats. 1955).

¹⁸ See *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986).

¹⁹ Applicant’s brief at page 12.

²⁰ Applicant’s brief at page 13.

²¹ Applicant’s brief at page 13.

²² Applicant’s brief at page 13.

²³ 37 USPQ2d 1332, 1333-1334 (TTAB 1995).

CONCLUSION

As the evidence of record supports, the proposed mark "FIORE" is primarily merely a surname. "FIORE" is not rare; it does not have a recognized meaning that obviates its surname significance; it is not primarily a geographic or historical term; it has the look and feel of a surname; and its surname significance is emphasized by the fact that the applicant is Isabella Fiore, LLC. Therefore, the examining attorney requests that the refusal to register the mark on the Principle Register on the basis of Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052 (e)(4) be affirmed.

Respectfully submitted,

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NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
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