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Mailed: November 13, 2006  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lockton Companies, Inc.

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Serial No. 78461678

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Chad W. Brigham of Lewis, Rice & Fingersh, L.C. for Lockton Companies, Inc.

Robert J. Lavache, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Hairston, Walters and Drost, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Lockton Companies, Inc. has filed an application to register the mark ABANTE (standard character form) for services ultimately identified as:

human resources consultation; employee benefit plan account auditing services; conducting business research and surveys for human resources and employee benefits purposes in International Class 35;

employee benefits consultation, namely, employee benefit plan analysis services; employee benefit plan administration services; providing financial

information, namely, financial data reporting in the field of employee benefit plans; and financial analysis, namely, benchmarking in the nature of measuring the financial performance of employee benefit plans in International Class 36;

electronic data transmission for human resources and employee benefit professionals and employers in International Class 38; and

compliance services, namely, reviewing standards and practices to assure compliance with employee benefit laws and regulations in International Class 42.<sup>1</sup>

Registration has been finally refused under Section 2(e)(4) of the Trademark Act on the ground that the mark applicant seeks to register is primarily merely a surname.

Applicant has appealed. Applicant and the trademark examining attorney have filed briefs, and applicant filed a reply brief. We affirm the refusal to register.

The initial burden is on the examining attorney to establish a prima facie case that a mark is primarily merely a surname. If a prima facie case is established, the burden then shifts to the applicant to rebut the showing made by the examining attorney. The question of whether a term sought to be registered is primarily

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<sup>1</sup> Serial No. 78461678, filed August 4, 2004, alleging dates of first use and first use in commerce of July 15, 2004.

merely a surname may only be resolved on a case by case basis. See In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993).

The factors to be considered in determining whether a term is primarily merely a surname are the following:

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

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

The examining attorney maintains that he has submitted sufficient evidence to make a prima facie case that the primary significance of the mark ABANTE to the purchasing public for applicant's services is that of a surname and that such showing has not been rebutted by applicant.

Applicant argues, however, that the examining attorney erred in finding that the mark is primarily merely a surname because:

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<sup>2</sup> A fifth factor, not present in this case, concerns whether a mark which is presented in a stylized form is distinctive enough to create a separate non-surname impression.

(i) the Trademark Attorney located a very small amount of individuals who had the surname "Abante" in the massive nationwide databases he researched, which showed that the surname is rare, (ii) Applicant's Mark has other recognized meanings, as it is the Latin root for "advance" or "advantage," as evidenced by the dictionary definitions that Applicant attached thereto, (iii) "Abante" is not the surname of anyone connected with Applicant, (iv) "Abante" does not have the "look and feel" of a surname, but rather, Applicant's Mark has the look and feel of [a] non-English term (i.e., Latin or Spanish), (v) the public and the United States Patent and Trademark Office (the "PTO") have already acknowledged the trademark significance of ABANTE, as evidenced by two prior registrations that the Trademark Attorney cited in Office Action No. 1 and (vi) all doubt as to the surname significance of Applicant's Mark must be resolved in favor of Applicant. (Brief at 3).

In this case, we agree with the examining attorney that the record contains sufficient evidence to make a prima facie case that the primary significance of the mark ABANTE to the purchasing public for applicant's services is that of a surname and that such showing has not been rebutted by the applicant. The examining attorney submitted evidence that a search of the LexisNexis ("EZFIND Combined Person Locator Nationwide") database returned 355 residential listings of individuals with the surname "Abante" (a printout of 311 of the retrieved listings was included); 8 article excerpts from the LexisNexis ("News") database, each of which refers to an individual with the surname "Abante;" evidence that 16 "matches" for

individuals with the surname "Abante" were found in a search of the "Peoplefinders.com" website, 14 matches were found in a search of the "Yahoo! People Search.com" website, and 10 matches were found in a search of the "switchboard.com" website; and printouts from several on-line dictionaries that show no entries for the word "abante."

Applicant argues that of the more than 300 residential listings and "matches" submitted by the examining attorney, only 82 distinct individuals with the surname "Abante" are represented therein; and that these 82 individuals constitute a miniscule portion of the United States population of 295,734,134, as shown by the July 2005 edition of The World Factbook. Thus, it is applicant's position that the "Abante" surname is extremely rare.

We acknowledge that a substantial number of the residential listings and matches are "duplicates," such that the number of distinct individuals with the surname "Abante" is certainly closer to 82 than 300. Although the record shows that ABANTE is indeed a rare surname, it is nonetheless the case that even a rare surname is unregistrable (absent a showing of acquired distinctiveness) "if its primary significance to purchasers is that of a surname." See, e.g., *In re Etablissements*

Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Further, this Board has "declined to hold that a minimum number of telephone listings is necessary to establish a prima facie surname significance case." See, e.g., In re Petrin Corp., 231 USPQ 902, 903 (TTAB 1986). See also In re Gregory, 70 USPQ2d 1792, 1795 (TTAB 2004) (no "per se benchmark" as to minimum number of listings); and In re Petrin Corp., supra. We find, therefore, that the searches of the LexisNexis database and other websites, when coupled with the 8 article excerpts from the LexisNexis database and the "negative" dictionary evidence, are sufficient to establish the surname significance of the mark ABANTE to the relevant purchasing public. In sum, the Board finds that the examining attorney's evidence is sufficient to establish a prima facie showing.<sup>3</sup>

Applicant notes that this Board has held that the fact that a term is the surname of an individual associated with the applicant is strong evidence of the surname significance of the term. See e.g., In re Industrie

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<sup>3</sup> Indeed, the evidence in this case, is significantly greater than in other cases where the surname has been categorized as "rare." See e.g. In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (Fed. Cir. 1975) (six DUCHARME surname telephone listings); and In re Garan, Inc., 3 USPQ2d 1537 (TTAB 1987) (six GARAN telephone directory listings and one LexisNexis listing).

Pirelli Societa per Azioni, 9 USPQ2d 1564 (TTAB 1988). In view thereof, applicant argues that where as here, no one associated with applicant has the surname "Abante," this factor weighs heavily in applicant's favor.

However, contrary to applicant's contention, the Board has stated that the fact that "a proposed mark is not the applicant's surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname." In re Gregory, supra at 1795. Thus, the fact that no one associated with applicant has the surname "Abante" does not favor applicant, but rather is a neutral factor in this case.

Applicant also contends that its mark has meaning other than as a surname. According to applicant, "[a]bante' is the Latin root for the English term 'advance.'" (Brief at 7). Applicant submitted the results of searches of "en.wiktionary.org;" and "merriam-webster.com" for the words "advance" and "vanguard," the pertinent portions of which are reproduced below:

**advance**

English

Etymology

From Old French avancer (French avancer) from late Latin abante, from ab + ante 'before.' The spelling with *d* was a mistake, a- being supposed

to be from Latin *ad*. *Avaunt* is an earlier form of the same source-word.  
(en.wiktionary.org)

**vanguard**

Etymology: Middle English *vantgard*, from Middle French *avant-garde*, from Old French, from *avant-* (from *avant* before, from Late Latin *abante* + *garde* guard - more at ADVANCE  
(merrian-webster.com)

**advance**

Etymology: Middle English *advauncen*, from Old French *avancier*, from (assumed) Vulgar Latin *abantiare*, from Late Latin *abante* in front, from Latin *ab-* + *ante* before - more at ANTE-  
(merriam-webster.com)

Although we acknowledge that the term "abante" has significance as a Latin term, we doubt the purchasing public would know of this significance. We note that applicant has made of record a printout of its Internet homepage where the following information about the term "abante" is set forth.

**Abante** (ah-BAHN-tay) from 15<sup>th</sup> century, Late Latin.

Modern word: **Advantage**.<sup>4</sup>

- A superior position resulting from factors of benefit to its possessor.
- A benefit resulting from course of action.

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<sup>4</sup> Although applicant initially argued that "abante" is also the Latin term for "advantage," applicant offered no dictionary evidence to support its contention in this regard. In view thereof, and because applicant did not pursue this particular argument, we have given it no consideration.



To us, this is an indication that the significance of "abante" as a Latin term is obscure since applicant considered it necessary to apprise the purchasing public of this meaning at its Internet homepage. In short, we are not persuaded that the term "abante" has any other recognized meaning. Thus, it is the surname significance of "Abante" which dominates and, therefore, this factor favors a finding that the mark ABANTE is primarily merely a surname.

Further, applicant contends that its mark does not have the "look and feel" of a surname. The examining attorney has submitted evidence that searches of the "switchboard.com" website returned 100 matches for individuals with the surname "Amante;" 100 matches for "Asante;" 100 matches for "Assante," 7 matches for "Adante," and 10 matches for "Arante." It is clear that ABANTE is very much like these surnames having an "-ante" suffix. In view thereof, and while admittedly a subjective determination, it is our view that ABANTE has the "look and feel" of a surname.

Two additional arguments made by applicant require comment. In his initial Office Action, the examining attorney also refused registration of applicant's mark under Section 2(d) of the Trademark Act, citing two

registrations owned by the same entity, namely, Registration No. 2317098 for the mark ABANTE and Registration No. 2306488 for the mark ABANTE PROGRESSION, both for "computer software used to track and manage group and individual performance in education, business or sports environments." Applicant argues that these registrations show that the "PTO [has] appropriately given the mark ABANTE trademark significance in the past with respect to unrelated goods." (Brief at 11).

This argument does not persuade us to reach a different result herein. It is well settled that each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]

Finally, applicant is correct that our case law holds that if we have doubts about whether the term is a surname, we resolve them in favor of the applicant for publication of the mark. *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). In this case, we have no such doubts.

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**Decision:** The refusal to register applicant's mark on the ground that it is primarily a surname is affirmed.