

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spumador S.P.A.

Serial No. 79056027

Roberta S. Bren of Oblon, Spivak, McClelland, Maier &
Neustadt for Spumador S.P.A.

Raul Cordova, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Bucher, Bergsman, and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Spumador S.P.A. ("applicant") has filed an application to register the mark VALVERDE on the Principal Register in standard character form for goods ultimately identified as "mineral and aerated waters; non-alcoholic drinks, namely, soda pops, fruit juices and fruit drinks; syrups for making beverages," in International Classes 32.¹ Applicant claimed

¹ Serial No. 79056027, filed May 26, 2008 under the Madrid Protocol, Section 66(a) of the Trademark Act of 1946, 15 U.S.C. §1141(f), based on International Registration No. 0970079.

that "[t]he English translation of the term 'VALVERDE' is 'green valley.'"

The examining attorney refused registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(4). Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. §1052(f). We must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The examining attorney bears the initial burden to make a prima facie showing of surname significance. *Id.* If the examining attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant, to determine ultimately whether the mark is primarily merely a surname. *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

The Examining Attorney submitted the evidence identified below to prove that VALVERDE is primarily merely a surname.

1. An entry for "Valverde" from *Wikipedia*. The entry identified "Valverde" as a surname.²

2. Entries from various websites for persons with the surname "Valverde," such as Junio Valverde (a Spanish actor), Alejandro Valverde (a Spanish cyclist), Maria Valverde (a Spanish actress), Jose Valverde (a Major League baseball player), and Vincent de Valverde (a Spanish bishop active in Peru during the fifteenth century).³

3. An excerpt of 500 of the 1859 entries for "Valverde" from the LexisNexis Public Records Library Surname Search.⁴

4. The entry for "Valverde" from the *WordReference.com* Italian-English dictionary. There was no English translation.⁵ There did not appear to be an Italian word "Valverde" because it was not included on a listing of close words displayed on the website.

5. The entry for "Valverde" from the Online Portuguese Dictionary (portuguesedictionary.net).⁶ This

² September 15, 2008 Office Action.

³ *Id.*

⁴ *Id.*

⁵ April 16, 2009 Office Action.

⁶ *Id.*

website did not find a Portuguese word "Valverde."

6. The entry for "Valverde" from the *Yahoo!Education* website (<http://education.yahoo.com>).⁷ No Spanish or English matches were found; in other words, there was no Spanish word "Valverde."

7. The search results for "Valverde" from the *OneLook* dictionary.⁸ There were no references to "Valverde" as a word. The search result stated, "Sorry, no dictionaries indexed in the selected category contain the word *valverde*."⁹

Applicant submitted the following evidence to show that "Valverde" is not primarily merely a surname:

1. The *Wikipedia* entry for the Battle of Valverde. The Battle of Valverde (February 20-February 21, 1862) was fought in and around Valverde, New Mexico. The battle was considered a Confederate success in the New Mexico Campaign of the American Civil War.¹⁰

2. The entry from the U.S. Census Bureau website (census.gov/genealogy/www/namesearch.html) profiling the surname "Valverde."¹¹ Valverde ranks 6141 in terms of

⁷ *Id.*

⁸ *Id.*

⁹ The excerpt made of record did not identify the dictionaries searched by *OneLook.com*.

¹⁰ March 16, 2009 response. Applicant submitted a second excerpt regarding this battle from the National Park Service website.

¹¹ *Id.*

frequency with 0.002% of the population having that surname.¹²

3. An entry from *Wikipedia* identifying "Valverde" as Italian, Portuguese and Spanish for "green valley."¹³ In addition, "Valverde" was identified as geographic locations in the Dominican Republic, Italy, Portugal, and Spain. However, there was no information regarding the renown of any of those locations.

In analyzing the surname refusal, we must determine the impact VALVERDE has on the purchasing public because "it is the impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname." *In re Giger*, 78 USPQ2d 1405, 1407 (TTAB 2006), quoting, *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975), quoting, *Ex parte Rivera Watch Corp.*, 106 USPQ 145 (Comm'r 1955) (emphasis in the original).

¹² By way of comparison, the entry provides that the surname Moore is ranked 9th in terms of frequency and is possessed by 0.312% of the population sample. In the April 16, 2009 Office Action, the Examining Attorney submitted the same information from the *Mongabay.com* website which relied on the Census Bureau data. The *Mongabay.com* website also indicated that there were approximately 4074 people with the surname "Valverde."

¹³ *Id.*

Our case law sets out a number of factors to be used to determine if the term is primarily merely a surname:

1. Whether the surname is rare;
2. Whether anyone connected with the applicant has the term as a surname;
3. Whether the term has any other recognized meaning; and,
4. Whether the term has the "look and sound" of a surname.

In re Benthin Management GmbH, 37 USPQ2d at 1332-33.¹⁴

We first look at the "rareness" of the surname. As indicated above, "Valverde" ranks 6141 in terms of frequency with 0.002% of the population or approximately 4074 people having that surname. For purposes of providing context for this data, the surname Moore is ranked 9th in terms of frequency and is possessed by 0.312% of the population sample. Certainly, although a surname is not among the most common, that does not automatically qualify it as a rare surname. While "Valverde" is not as common as "Moore," we find that "Valverde" is not a rare surname.

See In re Champion Internatinal Corporation, 229 USPQ 550, (TTAB 1985) (McKINLEY found to be primarily merely a surname in part because it was listed as the 1197th most

¹⁴ The fifth *Benthin* factor, whether the manner in which the mark is displayed might negate any surname significance, is not relevant to our analysis inasmuch as applicant seeks registration of VAVERDE in standard character form.

common surname with an estimated 23,170 people with that surname).

We turn to the second factor and look to whether anyone associated with applicant has the surname "Valverde." Applicant asserts that no one associated with applicant has a the surname "Valverde." However, the fact that "a proposed mark is not 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*, 70 USPQ2d 1792, 1795 (TTAB 2004).

The third factor is whether there is another recognized meaning for "Valverde." The relevant question is whether the term has another recognized significance other than as a surname. Words having significance other than as a surname are not "primarily merely a surname." *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969) (BIRD is not primarily merely a surname); *Ex parte Omaha Cold Storage Co.*, 111 USPQ 189 (Comm'r Pat. 1956) (DOUGLAS is not primarily merely a surname); *In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989) (CALLISTO has no surname meaning from Greek mythology); *In re BDH, Inc.*, 26 USPQ2d 1556 (TTAB 1993) (GRAINGERS for crackers and chips is not a surname because it would be perceived as

suggestive of the grain-based nature of the product); see also TMEP §1211.01(a) (6th ed. 2009).

Applicant contends that "Valverde" is Spanish, Italian, and Portuguese for "green valley" based on a *Wikipedia* entry. Also, applicant asserts that "Valverde" is a town in New Mexico where a Civil War battle was fought. In rebuttal, the Examining Attorney submitted entries from online dictionaries to show that "Valverde" is not a recognized Spanish, Portuguese or Italian word. In this regard, we could not find the word "Valverde" in an Italian, Spanish or Portuguese dictionary.¹⁵ On the other hand, "Valverde" was listed in the Dictionary of American Family Names, Vol. 3, p. 530 (2003), as a Spanish "habitational name from any of the numerous places named Valverde 'green valley.'"

With respect to "Valverde" being a town in New Mexico where Union and Confederate forces fought the Battle of Valverde, there is no evidence indicating that there is any

¹⁵ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). There was no entry for "Valverde" in the following dictionaries: Larousse, English-Spanish Dictionary (Unabridged) (1994); Collins, Spanish Dictionary (6th ed. 2000); Burke, Street Spanish Slang Dictionary & Thesaurus (1999); McGraw Hill, The Red-Hot Book of Spanish Slang and Idioms (2007); NTC's Compact Portuguese and English Dictionary (1995); Sansoni, English-Italian Italian-English Dictionary (3rd ed. 1995); and Dictionary of Italian Slang and Colloquial Expressions (1996).

significant consumer recognition of "Valverde" as a geographic location or the location of a Civil War battle. It is unlikely that most individuals are aware of any location identified by the name "Valverde" or that a Civil War battle was fought in Valverde, New Mexico. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1942 (TTAB 1993) (the primary significance of HAMILTON is a surname despite evidence that it has minor significance as a geographic term and as a given name). In fact, to the extent that there is any recognition of Valverde, New Mexico, it may support the conclusion that "Valverde" would be viewed as a surname because cities, counties, streets, lakes and other things often derive their names from an individual's name. See *In re Harris-Intertype Corporation*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975); *In re Champion International Corp.*, 229 USPQ at 551.

Likewise, with respect to the *Wikipedia* entry that identified "Valverde" as geographic locations in the Dominican Republic, Italy, Portugal, and Spain, there is no evidence that any of those locations have any renown in the United States and, therefore, whether consumers in the United States will perceive "Valverde" as having a geographic or non-surname meaning. See *In re Gregory*, 70 USPQ2d at 1796.

In view of the foregoing, we find that the evidence of "Valverde" as a surname is greater than the evidence that "Valverde" has any other significance.

The fourth and final factor is whether the proposed mark has the "look and sound" of a surname. This is a subjective factor concerning whether VALVERDE has the "structure and pronunciation" or "the look and sound" of a surname. *In re Benthin Management GmbH*, 37 USPQ2d at 1333; *In re Sava Research Corp.*, 32 USPQ2d at 1381; *In re Industrie Pirelli*, 9 USPQ2d 1564, 1566 (TTAB 1988). As stated in *Industrie Pirelli*, "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." *Id.*

The examining attorney argues that it does, relying primarily on the facts that more than 4000 individuals have "Valverde" as a surname and that there is no evidence of any alternative significance. Applicant, on the other hand, contends that "Valverde" looks and sounds like a foreign (or unusual) word rather than like a surname. On this point, we agree with applicant.

The argument has been made that absent compelling evidence from the first three *Benthin* factors, the mere fact that a term has the "look and feel" of a surname

should not hurt an applicant. *See In re Joint-Stock Company "Baik,"* 84 USPQ2d 1921, 1924 (TTAB 2007) (J. Seeherman, concurring). In any case, this Board has clearly stated the logical converse, namely, that an alleged surname without the "look and feel" of other readily-recognizable surnames *helps* applicant under this fourth *Benthin* factor. *See In re Gregory,* 70 USPQ2d at 1796 ("When a term does not have the look and sound of a surname, it clearly aids the applicant").

In this regard, there is no evidence that "____verde" or "Val____" is a common or recognized structure for a surname (e.g., ____berg as in Steinberg, ____man as in Bergsman, ____lov as in Orlov, etc.). There is also no evidence that any individuals with the "Valverde" surname are notable to consumers in the United States. Hence, on this fourth and final *Benthin* factor, we find for applicant.

On the issue of whether a mark is primarily merely a surname under Section 2(e)(4), we resolve any doubts we have in favor of the applicant and pass the application to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods may file a notice of opposition. *In re Benthin Management GmbH,* 37 USPQ2d at 1334. Balancing the

factors, we find that although VALVERDE is an uncommon surname without alternative meanings, it does not have the look and sound of a surname. In view of the foregoing, we find that VALVERDE is not primarily merely a surname.

Decision: The refusal to register under Section 2(e)(4), on the ground that VALVERDE is primarily merely a surname, is reversed.