

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

Mailed: June 7, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cardano Risk Management B.V.

Serial No. 85230910

William C. Wright of Epstein Drangel LLP for Cardano Risk Management B.V.

Jeffrey J. Look, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Quinn, Wellington, and Lykos,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Cardano Risk Management B.V. (applicant), a Dutch corporation, has filed an application to register the mark CARDANO on the Principal Register in standard character form for "financial services, namely, financial risk management consultation, financial investment advisory services, monetary strategy consultation and research, investment services, namely, asset consultation and development services; financial asset and liability

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management; consultancy in the field of strategic use of financial derivatives" in International Class 36.¹

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, 15 U.S.C. § 1052(e)(4). When the refusal was made final, applicant filed a request for reconsideration which the examining attorney rejected. Applicant then appealed; both applicant and the examining attorney have filed briefs on the case, including a reply brief filed by applicant.

We reverse the refusal.

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. See *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. See *id.* If the examining attorney makes that showing, then we must weigh all of the

¹ Serial No. 85230910 was filed on February 1, 2011 based on Sections 1(b) (intent-to-use) and 44(e) (ownership of a foreign

evidence from the examining attorney and the applicant to determine ultimately whether the mark is primarily merely a surname. See *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we "are inclined to resolve such doubts in favor of applicant." See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In determining whether a proposed mark is primarily merely a surname, we consider the following: (1) the degree of the surname's "rareness"; (2) whether anyone connected with applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; and (4) whether the mark has the "look and sound" of a surname. *Id.* at 1332-33.²

We first look at the "rareness" of the surname. The examining attorney has submitted the results of a search from the White Pages website (www.whitepages.com - information ascertained from website on May 2, 2011), a nationwide telephone directory database, showing the surname "Cardano" appeared in "100+ results" for telephone

registration). The application was subsequently amended by applicant to delete the Section 1(b) filing basis.

² A 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 CARDANO in standard character form.

numbers.³ However, upon closer inspection of the full results of this search, the actual number of results appears to be closer to 100 and is further diminished by apparent duplicate entries. The examining attorney also points out article excerpts from various newspapers or other publications that mention individuals with the surname "Cardano." The article excerpts are not concentrated in any one geographic region and identify individuals in various states.

We find, based on the evidence, that CARDANO is an extremely rare surname. This factor weighs heavily given the purpose of Section 2(e)(4) of the Act. As explained by Judge Seeherman in her concurrence in *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 at 1924 (TTAB 2007), the "purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames, ... Rather, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses..."

³ Applicant also submitted with its request for reconsideration information from the 2000 U.S. Census indicating that there are approximately 119 individuals with the surname CARDANO in the United States (www.census.gov). The examining attorney submitted additional explanatory materials regarding the census data. This data is twelve years old and no further information has been submitted whereby we can extrapolate or infer that there may be more or less people with the surname CARDANO since the time the census was taken.

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And, "in a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use."

Id. (in main opinion) at 1923-4, citing *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

We turn next to the second factor and look to whether anyone associated with applicant has the surname "Cardano." As the examining attorney acknowledges in his brief, applicant has asserted there is no one with the surname "Cardano" associated with applicant and the examining attorney "has no evidence" to the contrary. Brief, p. 10. Accordingly, this factor is neutral.

The third factor is whether there is a recognized non-surname meaning for "Cardano," and we conclude there is not. The examining attorney has submitted evidence showing that it has no defined meaning. Applicant argues at length that the "primary significance" of "Cardano" is that it will be associated with "Gerolamo Cardano," an Italian Renaissance mathematician and physician. Brief, p. 8. Applicant argues that the recited services in the application are "intricately tied with mathematics" and that this "significance would not be lost or unknown to applicant's consumers." *Id.* Applicant cites to its own website that includes a section "Who was Cardano?" with a

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brief biography, including a mention of his study of probability. Ultimately, however, we agree with the examining attorney that the evidence fails to show that Gerolamo Cardano is considered a well-known historical figure such that the proposed mark will be associated with the mathematician. *See, e.g., In re Champion International Corporation*, 229 USPQ 550 (TTAB 1985) (primary significance of McKinley is as a surname, not of the historical figure). *Compare In re Pyro-Spectaculars Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (SOUSA not merely a surname); and *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F.Supp. 329, 165 USPQ 459, 461 (S.D.N.Y. 1970) (primary significance of DA VINCI is not merely a surname).

Finally, as to the fourth factor, namely, whether the proposed mark has the "structure and pronunciation" (or, stated differently, the "look and sound") of a surname, the record is silent in this regard. For example, there is no evidence showing the popularity of similarly-constructed surnames, e.g., other surnames that either begin with "card" or end with "dano" or otherwise bear a resemblance to "cardano." Without such evidence, we cannot find that applicant's mark has the "look and sound" of a surname. We also note that the examining attorney does not actually assert this point, but merely rebuts applicant's assertions

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that "cardano" bears a resemblance to the term "cardio." To be clear, the examining attorney does not explain how or why the proposed mark has the "look and sound" of a surname. Accordingly, we make no finding with regard to this factor.

In balancing the aforementioned factors, we accord significant weight to the rareness of the surname, realizing that the likelihood of any individual with the surname "Cardano" who may seek to use their surname in a trademark for similar services or goods is greatly reduced by the rareness of the surname. This outweighs the fact that the proposed mark has no defined meaning. On this record, we find that the Office has not met its burden of proving that the mark is primarily merely a surname. Furthermore, to the extent we had any doubt in our decision, we resolve such doubt in favor of applicant. See *In re Benthin Management GmbH*, 37 USPQ2d at 1334.

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