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Mailed:
May 23, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Perry David Merlo

Serial No. 85510114

Perry David Merlo, applicant, appearing *pro se*.

Robert J. Struck, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Bergsman, Lykos, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On January 6, 2012, applicant Perry David Merlo applied to register the mark MERLO'S MERLOT, in standard character form, for "grape wine; red wine" in International Class 33 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).¹ The trademark examining attorney has refused registration on two grounds: that MERLO'S MERLOT is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), and that there exists a likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Application Serial No. 85510114.

§ 1052(d), with the previously registered mark LAGO DI MERLO for “wines” in International Class 33.²

Applicant timely appealed. Both applicant and the examining attorney filed briefs.

Evidentiary Issue

Applicant attached to its appeal brief two printouts from an Internet translation site, one of which indicates that the English translation of the Italian word “merlo” is “blackbird.” The examining attorney objects and asks the Board to disregard this evidence pursuant to Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), which provides that the record in an application should be complete prior to the filing of an appeal. Because applicant’s evidence was not made of record during examination and is untimely, we have given it no consideration. *See, e.g., In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 n.3 (TTAB 2008); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007).

Surname Refusal

A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance as a whole to the purchasing public is that of a surname. *See In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000). When we are faced with a Section 2(e)(4) refusal, we consider the impact a term has or would have on the purchasing public because

² Registration No. 2638605, issued October 22, 2002; combined Sections 8 and 15 affidavit accepted and acknowledged; renewed. The registration includes a translation statement that “The foreign wording in the mark, ‘LAGO DI,’ translates into English as ‘Lake of.’”

“it is that 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 Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm’r Pat. 1955)).

It is well settled that combining a surname with the generic name for the goods or services does not overcome a mark’s surname significance. *Miller v. Miller*, 105 USPQ2d 1615, 1622-23 (TTAB 2013) (finding MILLER LAW GROUP primarily merely a surname for legal services). *See also In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1945 (TTAB 1993) (holding HAMILTON PHARMACEUTICALS for pharmaceutical products primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname where “brasserie” was a generic term for applicant’s restaurant services); *In re Pickett Hotel Co.*, 229 USPQ 760, 762-63 (TTAB 1986) (refusing to register stylized mark PICKETT SUITE HOTEL for hotel, restaurant, and cocktail lounge services).

We consider five factors in determining whether a mark is primarily merely a surname:

1. whether the surname is rare;
2. whether the term is the surname of anyone connected with the applicant;
3. whether the term has any recognized meaning other than as a surname;
4. whether the term has the “look and feel” of a surname; and

5. whether the stylization of lettering is distinctive enough to create a separate commercial impression.

In re Benthin Mgmt. GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995). Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007). The examining attorney has the initial burden of presenting evidence to make a prima facie showing that a mark is primarily merely a surname. *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988).

A. Whether MERLO Is a Rare Surname

The examining attorney submitted printouts from the LexisNexis database indicating that the surname “Merlo” appeared (1) 866 times in a nationwide telephone directory of names,³ and (2) at least two dozen times in print media during the approximately one-month period from April 17, 2012 to May 15, 2012.⁴ In addition, we take judicial notice of data from the 2000 census demonstrating 2,697 occurrences of “Merlo.”⁵

Based on this evidence, we do not find “Merlo” to be a particularly rare surname. *See In re Gregory*, 70 USPQ2d 1792, 1794-95 (TTAB 2004) (holding

³ Office action, April 19, 2012, at 4-46.

⁴ Final Office action, May 17, 2012, at 9-19. Although 53 citations are of record, more than half are duplicates or from what appear to be foreign sources, leaving some 26 U.S. references to individuals with the surname “Merlo.” Several of these relate to CVS Caremark Corp. president and chief executive officer Larry Merlo and appear in what we assume to be the trade publications “Chain Drug Review” and “Drug Store News.”

⁵ Retrieved from the website of the U.S. Census Bureau (<http://www.census.gov/genealogy/www/data/2000surnames/index.html>). The Board may take judicial notice of census data. *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008).

ROGAN, with 1,087 listings in phone directories, not a rare surname). This factor supports the examining attorney's prima facie case that its primary meaning is as a surname.

We also note that Section 2(e)(4) makes no distinction between rare and commonplace surnames, *see In re Picone*, 221 USPQ 93, 95 (TTAB 1984), and even a rare surname is unregistrable if its primary significance to purchasers is a surname. *See In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (holding LIQUORE MARTINONI (stylized) for liqueur primarily merely a surname, with "liquore" being the Italian word for "liqueur," and stating: "The fact that 'MARTINONI' may be a rare surname does not entitle it to treatment different from what would be accorded to a common surname when no other meaning for the word is shown."). Although rarity of a surname is a factor in our analysis, the test remains whether the primary significance of the term to the purchasing public is that of a surname.

B. Whether MERLO is the Surname of Anyone Connected with Applicant

Applicant's name is Perry David Merlo. This fact is evidence of the surname significance of the term "Merlo." *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); *Miller*, 105 USPQ2d at 1620; *In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006).

C. Whether MERLO Has Any Recognized Meaning Other Than As a Surname

The examining attorney submitted screenshots of a dictionary search indicating that “Merlo” has no recognized meaning in English,⁶ and applicant has advanced none. The absence of evidence that MERLO has any other recognized English meaning supports the examining attorney’s prima facie case that its primary meaning is as a surname. *See In re Isabella Fiore LLC*, 75 USPQ 1564, 1566 (TTAB 2005).

D. Whether MERLO Has the “Look and Feel” of a Surname

Finally, we consider whether the term has the structure and pronunciation, or “look and feel,” of a surname, which is a subjective inquiry. *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). Some names, by their very nature, have only surname significance even though they are rare surnames. *See In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989) (holding PIRELLI primarily merely a surname and stating that “certain rare surnames look like surnames and certain rare surnames do not and . . . ‘PIRELLI’ falls into the former category”).

The examining attorney’s evidence supports his argument that MERLO has the “look and feel” of a surname, showing that there are numerous individuals in the United States with that surname. This conclusion is strengthened by record evidence indicating that the Merlo family of California produces the wine sold under the cited registration discussed *infra*, LAGO DI MERLO.⁷ Applicant’s presentation

⁶ Final Office action, May 17, 2012, at 20-22 (retrieved from Merriam-Webster.com).

⁷ *Id.* at 4-8 (screenshots from www.lagodimerlo.com).

of the name in the possessive form MERLO'S reinforces its surname significance. *See, e.g., In re Binion*, 93 USPQ2d at 1537-38 (holding BINION and BINION'S for casino, gaming, hotel, and bar services primarily merely surnames); *In re Woolley's Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (holding McDONALD'S primarily merely a surname and noting that "it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades").

Applicant concedes that "Merlo's Riesling" or "Merlo's Chardonnay" "would be arguably merely surnames and generic terms," but argues that MERLO'S MERLOT "has a unique meaning above an[d] beyond merely a surname and a generic term" and constitutes "a play on two similarly sounding words which sound the same and are interchangeable."⁸ While we agree that the terms may be homophones, we do not view this as diminishing or displacing the surname significance of the phrase in designating a type of good (merlot wine) offered by applicant (Mr. Merlo).

We find that the record contains sufficient evidence to establish prima facie that the primary significance of MERLO'S MERLOT to the purchasing public for applicant's goods is merely that of a surname within the meaning of Section 2(e)(4). Applicant has not rebutted the examining attorney's prima facie case through evidence or argument. We therefore find that applicant's proposed mark is primarily merely a surname under Section 2(e)(4).

⁸ Appeal Brief at unnumbered p. 8.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We discuss the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Goods and Channels of Trade

We turn first to the similarity of the goods and their channels of trade, the second and third *du Pont* factors, respectively. Registrant’s goods are broadly identified as “wines,” which encompass applicant’s more narrowly defined “grape wine” and “red wine.” The goods, therefore, are legally identical, as applicant concedes.⁹

⁹ See Appeal Brief at unnumbered p. 2.

Because there are no limitations to the goods in the application or the cited registration as to channels of trade and classes of purchasers, we must presume that the respective goods travel through all usual channels of trade and are offered to all normal potential purchasers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *see also Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973). Moreover, given that the goods are legally identical and there is no limitation in the identifications, we must presume that the goods travel in the same channels of trade, and are available to the same classes of purchasers. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

In view of the above, we find that the goods are legally identical, travel in the same channels of trade, and are sold to the same classes of purchasers. In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly support a conclusion that confusion is likely.

B. Similarity of the Marks

We next consider the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (*quoting du Pont*, 177 USPQ at 567). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar

in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*, No. 92-1086 (Fed. Cir. June 5, 1992).

Where the goods are legally identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark is MERLO'S MERLOT. The cited registration is for LAGO DI MERLO, which translates into English as "Lake of Merlo."¹⁰ In this case, there is no dispute in the record regarding the translation of registrant's mark. We must therefore assume that the ordinary U.S. consumer familiar with Italian would "stop and translate" the foreign wording in registrant's mark to "Lake of Merlo." *See Palm Bay Imps. Inc.*, 73 USPQ2d at 1696. We view MERLO and its possessive form, MERLO'S, to be the dominant portions of the two marks. Prospective consumers encountering applicant's applied-for mark are likely to view applicant's mark MERLO'S MERLOT and registrant's LAGO DI MERLO as creating similar commercial impressions.

¹⁰ See Registration No. 2638605 (translation statement); Office action, April 19, 2012, at 2. Applicant does not contend, and there is no record evidence indicating, that "Lago di Merlo" or "Lake of Merlo" denotes an actual geographic location.

We are not persuaded by applicant's argument that the dominant portions of each mark are the words LAGO and MERLOT. With regard to applicant's mark MERLO'S MERLOT, it is well-settled that descriptive or generic matter may have less significance in creating a mark's commercial impression and little weight in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (*quoting In re Nat'l Data Corp.*, 224 USPQ at 752). Here, the examining attorney submitted evidence that "merlot" is "a dry red wine made from a widely grown grape originally used in the Bordeaux region of France for blending; *also* : the grape itself."¹¹ "MERLOT" thus is generic for applicant's goods.

With regard to the cited mark, the phrase "LAGO DI" modifies "MERLO." Given the structure of applicant's mark, consumers who are familiar with registrant's LAGO DI MERLO goods would view the term MERLO'S MERLOT, when used in association with applicant's goods, as designating a particular varietal of registrant's wines. Therefore, we find that the marks make similar commercial impressions, and the first *du Pont* factor weighs in favor of a likelihood of confusion.

We have carefully considered all of the evidence of record as it pertains to the relevant *du Pont* factors, as well as applicant's arguments (including any arguments not specifically discussed in this opinion). We find that because the

¹¹ Final Office action, May 17, 2012, at 2-3 (dictionary definition retrieved from Merriam-Webster.com).

Serial No. 85510114

goods are legally identical, the channels of trade and classes of purchasers are the same, and the marks are similar, confusion is likely between applicant's marks and the mark in the cited registration.

Decision: The refusals to register under Sections 2(e)(4) and 2(d) of the Trademark Act are affirmed.