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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Markbens Administradora de Bens Eireli

Serial No. 85713043

Arturo Perez-Guerrero of Law Offices of Arturo Perez-Guerrero for Markbens Administradora de Bens Eireli.

Leslie L. Richards, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Zervas, Kuhlke and Kuczma, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Markbens Administradora de Bens Eireli, filed an application to register on the Principal Register the mark **LEARDI** in stylized form for services ultimately identified as “Assistance in business management; assistance in industrial or commercial management; Business advisory, consultancy and information on the implementation and viability of the franchise system; franchise management, namely, consultation and assistance in business management;

advisory, consultancy and information on business management in the field of intellectual property,” in International Class 35.¹

Registration has been refused under Section 2(e)4 of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that LEARDI is primarily merely a surname.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

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 to the purchasing public is that of a surname. *See In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). The burden is on the examining attorney to establish a *prima facie* case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). 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. *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.” *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995). Among the factors to be considered in determining whether a term is primarily merely a surname are (1) the degree of a surname’s rareness; (2) whether anyone

¹ Application Serial No. 85713043, filed on August 26, 2012, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the “look and sound” of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression. *Benthin*, 37 USPQ2d at 1333. *See also In re Gregory*, 70 USPQ2d 1792 (TTAB 2004).

We first look at the “rareness” of the surname. During prosecution, the Examining Attorney submitted search results from a LexisNexis nationwide telephone directory showing 62 as the total number of listings for individuals with the surname LEARDI in the United States.² This evidence tends to show that LEARDI is a rare surname. *See United Distillers*, 56 USPQ2d at 1221 (“Hackler” held to be a rare surname despite 1295 listings in phone directories). The Examining Attorney also points to a few excerpted materials retrieved from the internet showing use of LEARDI as a surname in various circumstances and across the United States.³ The examples include: websites for a dentist, a lawyer, a creative director, an artist, a columnist a therapist; a court decision; three obituaries; and an excerpt from youtube.com. These few examples do not reflect the type of uses that would outweigh the rareness of this surname. *See Gregory*, 70 USPQ2d at 1795 (ROGAN primarily merely a surname based in part on broad exposure of public to politician, athletes, actors and author with this surname); *see*

² First Office Action (December 21, 2012).

³ Final Office Action (July 29, 2013) and Denial of Request for Reconsideration (February 19, 2014).

also Sava Research Corp., 32 USPQ2d at 1381; and *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987).

Based on the evidence, we find LEARDI to be a rare surname. While this weighs in Applicant's favor it does not end the inquiry. 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."). *See also In re Adrian Giger and Thomas Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006) ("[T]he fact that a term is not a common surname does not mean that a surname would not be considered to be primarily merely a surname.") and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989). In other words, while LEARDI is a rare surname, and this factor weighs in Applicant's favor, we must nonetheless examine the remaining factors to determine whether LEARDI is "primarily merely a surname."

The second factor we consider is whether anyone associated with Applicant has the surname LEARDI. In a voluntary amendment filed on November 27, 2012, Applicant indicated that LEARDI identifies Paulo Roberto Leardi whose consent is

of record. A term that is the surname of someone associated with the Applicant is evidence of the surname significance of the term LEARDI and supports the Examining Attorney's *prima facie* case that LEARDI is primarily merely a surname. *Etablissements Darty et Fils*, 225 USPQ at 653; *Miller v. Miller*, 105 USPQ2d 1615, 1620 (TTAB 2013); *Giger*, 78 USPQ2d at 1408.


As to the third factor, the Examining Attorney submitted the online search results from the website www.wordnik.com showing no definitions found for the term LEARDI and providing various examples of LEARDI used as a surname on the same page.⁴ The absence of evidence that LEARDI 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).

Turning to the fourth factor, we consider whether LEARDI has the look and sound of a surname. The internet material submitted by the Examining Attorney, while not sufficient to establish that LEARDI is a common surname, does support this factor to the extent that in the only public uses of the word and the only examples given by wordnik.com, it is in fact used as a surname. Moreover, it does not have the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix, or as an initialism or acronym. Rather it appears to be a cohesive term with no meaning other than as a surname. *Gregory*, 70 USPQ2d at 1796. We acknowledge this factor is a subjective inquiry, *see Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009),

⁴ Denial of Request for Reconsideration (February 19, 2014).

but some names, by their very nature, have only surname significance even though they are rare surnames. *See Industrie Pirelli Societa per Axioni*, 9 USPQ2d at 1566 (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”). While we do not find LEARDI, by its very nature, to be so clear as the case in *Pirelli*, it does look, sound and feel like a surname.

Finally, we consider whether the stylization in Applicant’s applied-for mark is sufficiently distinctive to create a separate commercial impression. In *Benthin*,

the Board found that the mark  was “stylized to the point that the letters also function as a design element.” *Benthin*, 37 USPQ2d at 1334. Here, the stylization of the lettering is not unusual. The letters are readily discernible and the style of lettering is not so distinctive as to create a separate commercial impression in the minds of the purchasers of Applicant’s services. The term, although in stylized letters, would still be perceived as a surname. *See In re Pickett Hotel Company*, 229 USPQ 760, 763 (TTAB 1986) (“The style of lettering [for the mark



... is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers.”).

Applicant relies on the rareness factor in arguing against the refusal asserting that “LEARDI is virtually an unknown term in this country [and] is perceived by the consuming public as a coined invented term, not as a surname.” App. Br. p. 2. While LEARDI may be a rare surname, we cannot find, based on this

record, that this factor should outweigh the other factors such that the consuming public would perceive it as a coined term and not as a surname.

In conclusion, while it is clear that LEARDI is a rare surname, there is simply no persuasive evidence in the record that it would be perceived as anything other than a surname in the United States. Accordingly, we find that the Examining Attorney has met her initial burden of establishing that LEARDI would primarily be viewed as a surname, and Applicant has not rebutted the Examining Attorney's *prima facie* case.

Decision: The refusal to register under Section 2(e)(4) of the Trademark Act is affirmed.