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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86262060
Applicant	Eximius Coffee, L.L.C.
Applied for Mark	ALDECOA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APPLICANT: Eximius Coffee, L.L.C.

SERIAL NO.: 86/262,060

CLASS: 30

FILED: April 24, 2014

EXAMINER: Charles H Hiser IV

MARK: ALDECOA

LAW OFFICE: 112

APPEAL BRIEF OF APPLICANT

Applicant has appealed the Trademark Examining Attorney's final refusal to registration of the mark "ALDECOA" on the Principal Register under Trademark Act § 2(e)(4) which claims that Applicant's mark is primarily merely a surname.

FACTS

On April 24, 2014, Applicant filed the present application to register the mark "ALDECOA" under Section 1(b) of the Trademark Act and received U.S. Serial No. 86/262,060 (Applicant notes that an Amendment to Allege Use was filed at a later date in the prosecution). The mark was filed for "coffee, caffeine-free coffee, instant coffee, single serve coffee" in International Class 030.

In the initial Office Action dated August 11, 2014, the Examiner refused registration under Section 2(e)(4) of the Trademark Act because the term "ALDECOA" is primarily merely a surname. In the Official Action, the Examiner noted that amendment of the application to the Supplemental Register would be available if an acceptable Amendment to Allege Use was filed under 37 C.F.R. §2.76. The Examiner attached exhibits including ten portions of news articles including the word "ALDECOA", a printout from the U.S. Census Bureau showing that the term "ALDECOA" appeared in the 2000 census, a website showing that the term "ALDECOA" was a "very rare" name in the U.S., a screen shot of Applicant's website showing, in part, that Eximius Coffee, L.L.C. can trace its

roots back to Mr. Carlos de Aldecoa Fernandez and a number of translation and dictionary websites showing that the term "ALDECOA" did not have a particular meaning in English or Spanish.

On February 11, 2015, Applicant submitted a response to the Examiner addressing the Examiner's concerns in the first Office Action. In the response, Applicant focused on the fact that the term "ALDECOA" is an "extremely rare surname." Applicant was able to simply point out the evidence attached to the Examiner's First Official Action to show that the mark was clearly an extremely rare surname.

On March 3, 2015, the Examiner issued a second, final Office Action that once again refused registration on the Principal Register under Section 2(e)(4) of the Trademark Act because the term "ALDECOA" is primarily merely a surname. The Examiner once again noted that amendment to the Supplemental Register would be available if an acceptable Amendment to Allege Use is filed. The Examiner submitted twenty-one (21) portions of articles showing the existence of the word "ALDECOA" in the articles, the last page of a Lexis search for public records showing the name "ALDECOA" and a list of the top ten most circulated newspapers that are printed in the United States.

On March 10, 2015, Applicant filed an Amendment to Allege Use attaching a specimen consisting of an application of the "ALDECOA" mark to the packaging of the goods and claiming a first use date in U.S. commerce of at least as early as January 1, 2015.

On March 13, 2015, the USPTO accepted the Amendment to Allege Use and noted that the amendment met the minimum filing requirements of 37 C.F.R. §2.76(e).

Applicant timely filed a Notice of Appeal on September 2, 2015. This *ex parte* appeal was acknowledged and instituted on the same date by the Board.

ARGUMENT

I. THE MARK IS NOT PRIMARILY MERELY A SURNAME

A. The Elements of Determining Surname Significance.

Applicant believes that the record shows that the Examiner has issued a final refusal of the "ALDECOA" mark only on the fact that the term "ALDECOA" is a surname. Whether the name "is" a surname is simply not the test, however. Indeed, the term must "primarily be a surname." It is well settled that a term is primarily merely a surname if, when applied to a particular product (or used in connection with a particular service), its primary significance to the purchasing public is that of a surname. *See In re Kahan & Weisz Jewelry Mfg. Corp.*, 184 USPQ 421 (CCPA 1975). The burden is on the Patent and Trademark Office to establish a prima facie case that the involved term is primarily merely a surname. *See id.*; *see In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993); *see In re Joint-Stock Company "Baik"*, 84 USPQ2d (BNA) 1921 (TTAB 2007). Further, the question of whether the term sought to be registered is primarily merely a surname can be resolved only on a case by case basis. *See In re Joint-Stock Company "Baik"*, 84 USPQ2d (BNA) 1921 (TTAB 2007); *see In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *see generally*, 2 *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, §§13:29 and 13:30 (4th ed. 1999). Among the factors to be considered in determining whether a term is primarily merely a surname are the following: (i) whether the surname is rare; (ii) whether anyone connected with applicant has the involved term as a surname; (iii) whether the term has any other recognized meaning; and (iv) whether the term has the "look and feel" of a surname. *See In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995); *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004).

B. The Surname "ALDECOA" Is Extremely Rare.

Among the most important factors to be considered in determining whether a term is primarily merely a surname would be whether the surname is rare. *See In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995); *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). The Examiner in this proceeding has submitted absolutely no evidence showing that the term "ALDECOA" is a common surname in the U.S. Inexplicably, the Examiner instead states that the "ALDECOA" mark "appears to be a relatively rare surname" and, at the same time, attaches evidence that a) can be interpreted as showing that the term "ALDECOA" is an extremely rare surname or b) cannot be interpreted at all in relation to the question of whether the "ALDECOA" surname is rare. *See* [Official Action of August 11, 2014]; *see* [Final Official Action of March 3, 2015]. Since it is clear the Examiner is to look only at the significance to "the purchasing public," it is also clear that rareness should be directed to how rare a particular surname is to purchasers in the United States. *See In re Kahan & Weisz Jewelry Mfg. Corp.*, 184 USPQ 421 (CCPA 1975).

In the Official Actions, the Examiner attaches portions of thirty-one (31) news articles from various news outlets, some being foreign news outlets, that reference the term "ALDECOA" as a surname. *See* [Evidence in the Form of Partial Articles attached to Official Actions]. Such articles admittedly refer to some persons in the U.S. named Aldecoa, including two high school football players, a cancer foundation director, two grade school teachers, an American Legion member, a young business person, a court administrator, a military veteran, a police officer, a city code inspector and a manicurist. In addition, a number of the articles mention foreign persons with the "ALDECOA" surname, including Mr. Ignacio Aldecoa (a Spanish writer who died in 1969), a Spanish doctor and inventor, a Mexican drug trafficker, a French criminal, a foreign exchange

student in the U.S. and a Mexican journalist. Some of the articles are unclear as to which country the person named "ALDECOA" is from, such as a New York Marathon runner, or as to whether the names are duplicative. What is clear, however, is that in any standard that could possibly be devised to make a determination as to whether a surname has "appear[ed] routinely in news reports, articles and other media as to be broadly exposed to the general public," is not met with the sample of articles submitted by the Examiner in this case. *See In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); see TMEP §1211.01(a)(v).

Thus, in a world composed of more than seven billion people, the Examiner has submitted a mere 31 references to persons having the surname "ALDECOA" to allegedly show that "the general public has been exposed, through news media, to the use of Aldecoa as a surname." *See* [Official Actions]. While some of the publications may have a high circulation (as evidenced by the Examiner's list of the top ten most circulated newspapers printed in the U.S.), many of the publications submitted do not appear on that list. Furthermore, even the articles that are found in these particular publications would, in the opinion of Applicant, not be the type of articles read by the persons subscribing to such publications. Clearly, this is impossible to determine, but only a handful of subscribers are interested, for instance, in the outcome of a local high school football game.

Applicant is actually quite confused as to why the Examiner states that the surname "ALDECOA" is a name that "appears to be a relatively rare surname" within the U.S. In the initial Official Action, the Examiner entered into evidence, and included in his arguments, that the 2000 U.S. Census reports only 233 people with the "ALDECOA" surname. *See* [Attachments to First Official Action]. Another page attached to his first Official Action from rhymezone.com explicitly

states that "ALDECOA" is a "very rare" surname in the U.S. *See id.* These two documents alone would seemingly show the Examiner that the term "ALDECOA" is considered a rare surname that will not be perceived as such by the general public. *See In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) ("In considering the approximately 100 'Benthin' listings found in the PHONEDISC U.S.A. database, we have recognized the massive scope of this database. Indeed, this database demonstrates the rarity of the surname 'Benthin' by showing that there is but one 'Benthin' for every 750,000 listings. In other words, the surname 'Benthin' is, if not one in a million, one in three quarters of a million."); *see In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987) ("Here, since it appears that the directory and NEXIS evidence shows 'Garan' to be an extremely rare surname, we conclude that the directory and NEXIS evidence only slightly supports the Office's position that GARAN is primarily merely a surname."); *see In re Sava Research Corp.*, 32 U.S.P.Q.2d 1380, 1381 (TTAB 1994) ("At first blush, the material from the PHONEDISC U.S.A. database (1992 ed.) showing that at least 100 different Savas live throughout the United States would indicate that Sava is not an extremely rare surname. However, it must be remembered that this database includes more than 90,000,000 listings. Thus, the uses of Sava as a surname represent about only one ten-thousandth of one percent of the surnames in this database.").

More recently, the Board relied on the fact that only 456 examples of the "Baik" surname were located from a comprehensive directory of the entire United States to help come to the conclusion that the term "Baik" was not primarily merely a surname. *In re Joint-Stock Company "Baik"*, 84 USPQ2d (BNA) 1921 (TTAB 2007). Similarly, the Board also recently reversed the Examining Attorney's refusal to register the mark "BOLAN" based upon a "finding of the degree of the surname's rareness on the 455 listings for the name 'BOLAN' from the LexisNexis data base."

In re Grand & Piano Parts Distribution B.V., Serial No. 85946217 (TTAB March 31, 2015). In Judge Seeherman's discussion of extremely rare surnames, she explains that "there are very few, if any, people who can possibly be affected by the registration of that surname." *In re Curlin Medical Inc.*, Serial No. 78560314, (TTAB, February 11, 2008) (concurring opinion). As for the surname "CURLIN", the PTO found only 286 records in a national database, a number that Judge Seeherman considered "so small that the purpose of the statute prohibiting the registration of marks which are primarily merely a surname would not be served by refusing registration in this case." *Id.*

The above cases show that the Board has time after time determined that the small number we are discussing in relation to the "ALDECOA" surname (the number 233) would be an example of an "extremely rare" number. While Applicant understands the dilemma presented to the Board in creating a finite number of persons within this type of analysis, and the established law that each case is to be determined on a case by case basis, this particular case makes this trademark practitioner concerned that every application examined by a U.S. Trademark Examiner will be determined to not be extremely rare even when the evidence clearly fits within the parameters set by the Board in previous decisions. As a practitioner that seeks to zealously defend his clients, it is extremely unfortunate if applicants for trademark registrations must always argue this particular issue via an Appeal to the Trademark Trial and Appeal Board. Surely there is some type of guidance that can be given to Examiners other than always to dispute this issue, even if that guidance is to look to previous decisions when making such a decision.

In an effort to bolster the Examiner's weak argument in relation to rareness of a surname, the Examiner has attached to the Final Official Action the very last page of what is purported to be evidence that shows "949 white pages listings for people with the surname ALDECOA" in the

United States. *See* [Final Official Action and Attachments]. Applicant notes that only the last page of his Lexus search was attached to the Final Official Action, making it impossible to see how many of the entries are duplicates. Interestingly, Applicant notes that the one page that has been attached appears to contain two sets of duplicate entries (Ysidra Aldecoa and T Aldecoa). As such, Applicant is inclined to take the word of the U.S. Census Bureau on the particular issue of the number of persons having the name Aldecoa and certainly hopes that the Board takes this fact, as well.

The burden of proof is on the Examiner to determine, on the unique facts of this case, whether the American public would perceive the "ALDECOA" mark as "primarily merely a surname." *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Applicant simply cannot see how the rarity of this particular surname would even an issue in this case.

The Board recently agreed that "rareness" is the most important factor in the surname analysis. *In re Hall Wines, LLC*, Serial No. 78926151 (February 10, 2009). The Board explained that "we believe it is important to accord the proper weight to the 'rareness' of the surname factor while keeping in mind the purpose of Section 2(e)(4) of the Act. *See id.* Referenced in that decision was the explanation of this concept by Judge Seeherman in her concurrence in *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 at 1924 (TTAB 2007). To that end, Applicant has reproduced Judge Seeherman's concurrence as a whole below since, at only one paragraph long, it is quite concise and could establish important guidance to Examiners as to how to determine whether any particular mark is "primarily merely a surname" if accepted by the Board as a whole. Judge Seeherman states as follows:

"I agree with the majority that the refusal of registration should be reversed. Because, on this record, ROMANÓV must be treated as an extremely rare surname, that fact alone should be a sufficient basis on which to find the mark registrable. As I stated in my concurring opinion in *Joint-Stock Co. "Baik"*, 84 USPQ2d at 1924, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses, and therefore, if a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant. The evidence that ROMANÓV has the meaning of the Russian dynasty merely provides an additional reason for reversing the refusal of registration."

See In re The Hyman Companies Inc., Serial No. 85483695 (TTAB June 4, 2014).

The Trademark Act Section 2(e)(4) is quite simple in stating that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) consists of a mark which ... (4) is primarily merely a surname." Applicant believes that Judge Seeherman's discussion fits within Trademark Act Section 2(e)(4)'s framework. As discussed above, it only makes sense that Section 2(e)(4) is directed to the American consumer and to what he or she would believe is "primarily merely a surname." If the American consumer is not familiar with a particular name, does not normally encounter persons that have that name, and if an Examiner can provide no evidence of American consumers understanding a particular word to be a surname, then an extremely rare surname cannot be "primarily merely a surname" in the mind of the relevant American consumer. Add to this the important premise discussed above as to the actual purpose of Section 2(e)(4), and

it seems that a consensus opinion by the Board upholding the spirit of the Section 2(e)(4) would be appropriate while also preventing the completely arbitrary experience that every Applicant using an extremely rare surname on a product package will have to go forward with an appeal of the decision of an Examiner to obtain its mark on the Principal Register. Quite simply, if there are not many people with the surname in question, then it is extremely unlikely that any person will be affected by the registration of such a surname as a trademark.

C. Discussion of the Connection of the Surname to Applicant.

In the First Official Action, the Examiner attaches a discussion of the roots of Applicant's company. The exhibit attached by the Examiner does make clear that Eximius Coffee, L.L.C. has its roots reaching back to 1925 when Mr. Carlos de Aldecoa Fernandez (notably from Madrid, Spain) first produced coffee (not under the mark at issue), and continued with his son Carlos de Aldecoa Pereda. Sixty years later, the business was expanded to Houston, Texas (in 1985). While the persons responsible for the creation of the beginning of what resulted in the current business enterprise did have the term "ALDECOA" in their surname, this fact is not and should not be determinative of the outcome of this case. It seems appropriate to also bring up in this section the fact that the actual surname of the "roots" of this company is not "Aldecoa," but is instead "de Aldecoa." While a minor difference, it is certainly worth mentioning since the surname test does not mention whether minor differences are irrelevant. One thing that is certain, however, is that the fact that the founders of the present company having the "ALDECOA" as part of their name does not in any way show whether the American public would perceive the "ALDECOA" mark as "primarily merely a surname." *Etablissements Darty et Fils*, 225 USPQ at 653. Indeed, most of this history

was developed within Spain and Mexico, and no evidences would show the public would perceive the name as primarily merely a surname within the United States.

D. Discussion of Any Recognized Meaning of the term "ALDECOA"

The Examiner has submitted evidence that the term "ALDECOA" is not present in dictionaries and translation search engines. *See* [First Official Action]. Applicant has nothing to add to the search of the Examiner, but continues to believe that, in this case, this factor has no bearing on whether the American public would perceive the "ALDECOA" mark as "primarily merely a surname." *Etablissements Darty et Fils*, 225 USPQ at 653.

E. The term "ALDECOA" Does Not have the Look and Feel of a Surname

The fourth factor in the test is highly subjective, and involves whether Applicant's proposed mark has the "structure and pronunciation" or "the look and sound" of a surname. *Benthin Management GmbH*, 37 USPQ2d at 1333. "[C]ertain rare surnames look like surnames, and certain rare surnames do not" *Id.* The Examiner has not included any evidence as to the early origins and history of the surname. There is no mention in the evidence of the "structure" of this surname in any of the evidence submitted by the Examiner. As such, there can be no comparisons made to other surnames that might show this term has a particular "structure" that is often found in surnames. Since no evidence has been presented as to how this particular surname looks and feels, the attorney for Applicant wishes to submit his subjective opinion as to the look and feel of the surname at this time. For the record, this coffee drinking attorney was not aware that the term "ALDECOA" was a surname prior to meeting the persons associated with my client several years ago. The Examiner does not discuss the "look and feel" factor in the two Official Actions submitted. Unfortunately, we

are unable to determine his subjective opinion until after his response is submitted, if one is indeed submitted.

II. AMENDMENT TO THE SUPPLEMENTAL REGISTER ONLY IN THE ALTERNATIVE

As discussed in the "facts" section found above, Applicant filed an Amendment to Allege Use prior to its Notice of Appeal during the prosecution of the "ALDECOA" mark at issue in this proceeding. Therefore, Applicant respectfully requests that, in the unlikely event that the present appeal is not decided in favor of Applicant as to registrability of the "ALDECOA" mark on the Principal Register, that the present application is remanded to the Examiner for the entering of an amendment to the Supplemental Register. To be clear, Applicant wishes for the Board to determine the present issue at appeal prior to remanding this mark to the Examiner for determining registrability on the Supplemental Register.

III. CONCLUSION

In this Appeal Brief, Applicant has simply used the terminology commonly referred to by the Board in its surname related decisions, namely, the phrase "extremely rare surname." Applicant notes that it is clear from the record that the term "ALDECOA" would be considered by the TTAB to be an "extremely rare surname." *See In re Joint-Stock Company "Baik"*, 84 USPQ2d (BNA) 1921 (TTAB 2007) (relying on the fact that only 456 examples of the "Baik" surname were located from a comprehensive directory of the United States). When an extremely rare surname such as "ALDECOA" is being applied for, the purposes of the Trademark Act are surely met if the mark is allowed to register. Further, it is completely arbitrary without further evidence to argue that the term "ALDECOA" has the "look and feel" of a surname. Applicant notes that no similar registered or

pending mark which would bar registration under the Trademark Act was found by the Examiner and, as such, Applicant respectfully requests that the present mark be passed to publication at an early date.

Respectfully submitted,

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Date

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