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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 86262060

**MARK:** ALDECOA

**CORRESPONDENT ADDRESS:**

JOHN S EGBERT

EGBERT LAW OFFICES PLLC

1314 TEXAS ST FL 21

HOUSTON, TX 77002-6577

**GENERAL TRADEMARK INFORMATION:**

http://www.uspto.gov/trademarks/index.jsp

**TTAB INFORMATION:**

http://www.uspto.gov/trademarks/process/appeal/index.jsp

**APPLICANT:** Eximius Coffee, L.L.C.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

2984-1

**CORRESPONDENT E-MAIL ADDRESS:**

mail@egbertlawoffices.com

## EXAMINING ATTORNEY'S APPEAL BRIEF

### INTRODUCTION

This is an appeal from the trademark examining attorney's final refusal to register Eximius Coffee, L.L.C.'s (hereinafter "applicant") mark, ALDECOA for "coffee, caffeine-free coffee, instant coffee, single serve coffee" under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4), on the grounds that the mark is primarily merely a surname. It is respectfully requested that this refusal be affirmed.

## FACTS

On April 24, 2014, applicant filed an application to register the mark ALDECOA for "coffee, caffeine-free coffee, instant coffee, single serve coffee" based on intent-to-use the mark in commerce. On August 11, 2014, the examining attorney issued an initial Section 2(e)(4) refusal for the mark being primarily merely a surname, and also informed applicant of their option to amend to the Supplemental Register upon filing an allegation of use. Applicant responded to the Office Action refuting the Section 2(e)(4) refusal on February 11, 2015. On March 3, 2015, the examining attorney issued a final Section 2(e)(4) refusal and again informed the applicant about the supplemental register. On March 10, 2015 the applicant filed an Amendment to Allege Use and that was accepted by the examiner on March 13, 2015. Applicant filed this appeal on September 2, 2015.

## ISSUES PRESENTED

The only issue on appeal is whether ALDEOCA is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4).

## APPLICABLE LAW

In order to determine if the primary significance of the mark to the purchasing public would be regarded as a surname the following five factor test was created:

(1) Whether the surname is rare;

(2) Whether anyone connected with applicant uses the term as a surname;

(3) Whether the term has any recognized meaning other than as a surname;

(4) Whether the term has the structure and pronunciation of a surname; and

(5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

*See In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

"There is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname;" this question must be resolved on a case-by-case basis. TMEP §1211.02(a); *see In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986). The entire record must be examined to determine the surname significance of a term. TMEP §1211.02(a). The following are examples of evidence that is generally considered to be relevant to such a determination: telephone directory listings, excerpted listings and articles from computerized research databases, evidence in the application record that the term is used as a surname, the manner of use on specimens, dictionary definitions of the term and evidence from dictionaries showing no definition of the term. *Id.*

## ARGUMENT

### 1. Rare Surnames

One of the elements in determining the primary significance of a mark is to determine the rarity of a particular surname. To be clear, a rare surname may be unregistrable under Trademark Act Section

2(e)(4) if its primary significance to purchasers is that of a surname. *E.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405, 1407-09 (TTAB 2006); *see* TMEP §1211.01(a)(v). Just because a surname is rare does not mean that its primary significance to consumers is not that of a surname.

The issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database, because even the most common surname would represent only a small fraction of such a database. Rather, if a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare and would be perceived by the public as primarily merely a surname. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); *see* TMEP §1211.01(a)(v).

The evidence of record comes from a wide variety of sources and the sum of this evidence shows that American consumers, when presented with the term ALDECOA, would see the mark as a surname. The evidence of record shows: 233 people had the surname Aldecoa during the 2000 U.S. Census. *Initial office action dated August 11, 2014* at pgs. 2-3; Nearly 950 listings were identified using a public records search using Lexis. *Final office action dated March 3, 2015* at pg. 2; Attached dictionary evidence notes the term a surname. *Initial office action.* at pg. 4; And the examiner attached thirty one newspaper articles, being a sample from a larger pool of hits, from all over the nation showing the term as a surname. *Initial office action* at pg. 1; *Final office action* at pg. 1. Though Aldecoa might not be as ubiquitous as Smith, Jones, or Brown the attached evidence shows that while a rare surname, it is one that readily shows up in media reports and in various nationwide directories.

## 2. Connection

A term that is the surname of an individual applicant or that of an officer, owner, or principal of applicant's business is probative evidence of the term's surname significance. TMEP §1211.02(b)(iv); *see, e.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985) (holding DARTY primarily merely a surname where "Darty" was the surname of applicant's corporate president); *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013) (holding MILLER LAW GROUP primarily merely a surname where "Miller" was the surname of the applicant and the term "law group" was found generic and disclaimed); *In re Cazes*, 21 USPQ2d 1796, 1796-97 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname where "Lipp" was the surname of the restaurant's founder and the term "brasserie" (translated as "brewery") was found merely descriptive and disclaimed).

Evidence from applicant's website show a deep connection with the term ALDECOA and applicant's business. *See initial office action* at pg. 5. Applicant's website traces the Aldecoa family's history in coffee back three generations. *Id.* Furthermore, the website notes the current generation of coffee brewers also shares the same surname, "Mr. and Mrs. de Aldecoa continue their daily involvement with the companies. The 3rd generation, along with a staff of seasoned professionals, has now assumed leadership roles in the company." *Id*.

Moreover the specimen of record bolsters the argument that consumers would see the mark in this case as a surname. On the specimen, right under the mark, is the term "premium family coffee." *See amendment to allege use filed March 13, 2015*. Beyond noting that the family ties in the specimen the applicant has also included the city crest of the town of Ronda, Spain and the date of when Carlos de Aldecoa Fernandez founded the family business. *Id.*

Therefore, the second element weighs heavily in favor of the term being primarily merely a surname as there is not only a connection here, but a significant reliance on the family name to bring

bearing and weight to the reputation of the business and its owners which is marketed on the business's website and packaging.

### 3. Meaning

Evidence that a word has no meaning or significance other than as a surname is relevant to determining whether the word would be perceived as primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986); TMEP §1211.02(b)(vi). Evidence of record also shows that the term ALDEOCA has no meaning in English or Spanish; in fact, the only dictionary entry for the mark noted that ALDECOA is a surname. *Initial office action* at pgs. 4, 6-8. Thus, this word appears to have no meaning in either English or Spanish and has no significance other than that of a surname.

### 4. Look and Feel

The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); *see* TMEP §1211.01(a)(vi). While there is no evidence of record for the look and feel of ALDECOA being a surname; examiner offers the argument that ALDECOA does follow some of the same linguistic patterns of other, more common, Hispanic surnames like Figueroa and Ochoa.

### 5. Stylization

Adding a non-distinctive design element or letter stylization to a term that is primarily merely a surname does not change the surname significance of the term. The primary significance of such a mark would still be that of a surname. TMEP §1211.01(b)(ii); *see In re Pickett Hotel Co.,* 229 USPQ 760, 763 (TTAB 1986) (holding PICKETT a surname despite use of stylized lettering); *cf. In re Benthin Mgmt.*

*GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995). The mark is not stylized in this case. This element should be treated as neutral.

## 6. Balance of Factors

Below is a chart which traces the elements outlined above with the seven cases that are found in the TEMP regarding "rare" surnames.

| Case Name | Factor: Rarity | Factor: Connection | Factor: Other Meaning | Factor: Look & Feel | Factor: Stylization | Outcome |
|---|---|---|---|---|---|---|
| *In re Joint-Stock Co. "Baik"* 84 USPQ2d 1921 (TTAB 2007) | -456 entries in phone directory<br><br>-Some newspaper evidence | -No connection between the mark and anyone associated with the applicant | -No other recognized meaning, though suggested connection to Russian geographical locations | -Court found no evidence of record to support the look & feel | -Not considered as mark was in standard character form | -Court reversed the examiner's decision. -- BAIK not primarily merely a surname |
| *In re Benthin Mgmy. GmbH* 37 USPQ2d 1332 (TTAB 1995) | -Nearly 100 people in 76 million phone directory | -Managing director of applicant was Mr. Siegfried Benthin | -No other recognized meaning | -Neutral factor, mark neither looked like nor unlike a surname | -Yes | -Court reversed examiner highlighting the stylization of the mark at issue. |
| *In re Sava Reaearch Corp.,* 32 USPQ2d 1380 (TTAB 1994) | -Nearly 100 people in a list of 90 million | -No connection between the mark and applicant | -yes: town in Israel, river in Bosnia, acronym in this case | -combined with the other meaning analysis | -not considered | -Court reverses the examiner |
| *In re Garan Inc.,* 3 USPQ2d | -6 listings of people with | -No connection | -no other | - Term was designed | -not | -Court reverses |

| | | | | | | |
|---|---|---|---|---|---|---|
| 1537 (TTAB 1987) | surname | between the mark and applicant | meaning | to play on the word guarantee | considered | examiner |
| *In re Etablissements Darty et Fils,* 759 F.2d 15 (Fed. Cir. 1985) | -"examiner made of record evidence that others in a number of cities in this country bear the surname DARTY" | -Principal of firm had the surname Darty. | -appears to have no other meaning | -name of company is Darty et Fils (Darty and Sons) | -not considered | -Federal Circuit upholds TTAB's decision to affirm examiner's refusal |
| *In re Rebo High Definition Studios Inc.* 15 USPQ2d 1314 (TTAB 1990) | -6 telephone listings<br><br>-multiple newspaper articles | -Founder of company had surname Rebo | -No recognized meanings | -applicant argues acronym but no evidence to support contention | -not considered | -TTAB upholds examiner's refusal to register the mark |

In all of the cases cited above the court tends to weigh the objective, i.e. first three, elements more strongly than the latter, subjective two. The mark at hand should be found to be primarily merely a surname regardless of a finding by this court on the rarity of ALDECOA because the mark does not have another recognized meaning and there is a strong connection with the owners of the applicant. In both *Darty* and *Rebo* the court determined the mark was a surname on very similar facts as to this case, i.e. the mark was rare but there was evidence of a connection to the applicant and there was no other meaning. Further, in *Baik*, *Sava*, and *Garan* there was no evidence of connection to the applicant and there was also some evidence of other meanings and/or connotations. The *Benthin* case appears to be the only outlier to this trend. In *Benthin*, the court ruled that the mark was not primarily merely a

surname even with evidence of association and no other meaning; however, in that case the court noted (in conjunction with the other factors) "we believe that when Benthin is presented in the highly stylized form shown in applicant's service mark, it would not be perceived as primarily merely a surname." *Benthin* at 1334. There is no stylization in this case. The lessons that these cases teach appears to be that rarer surnames are generally not going to be regarded as such when used as a mark barring evidence that the other two objective elements are met. In this case the latter two objective elements are met. The term ALDECOA has no other recognized meaning, as stated its only dictionary entry is as a surname, and the applicant goes out of their way to and imbue their products and business with their family's legacy and name. Thus, on a balance of factors the mark ALDECOA should be considered primarily merely a surname.

## 2. Applicant's Arguments Are Unpersuasive

### a. "Extremely Rare"

Applicant asserts many times over that the surname Aldecoa is "extremely rare." First, while the surname Aldecoa might be rare that does not preclude the primary significance of the mark to consumers as a surname. *E.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405, 1407-09 (TTAB 2006); *see* TMEP §1211.01(a)(v). As stated earlier, rarity is not the death of a Section 2(e)(4) refusal, it is merely one of five factors. Furthermore, the examiner does take issue with the "extremely rare" language proffered by the applicant. In *Benthin* the court found 100 instances of a surname in a phone directory as rare. *See Benthin* at 1333. The same is true in *Sava* where the court noted "At first blush, the material from the PHONEDISC U.S.A. data base (1992 ed.) showing 'that at least 100 different SAVAs live throughout the United States' would indicate that SAVA is not an extremely rare surname," and further "In light of the foregoing, we find that SAVA is indeed a rare surname." *Sava* at 1381. The examining attorney placed in the record that the 2000 U.S. Census had more than twice as many individuals with the surname Aldecoa than there were individuals

with the surname Benthin or Sava. Thus, if Benthin and Sava were not "extremely rare" there is no way that Aldecoa should be considered thus.

### b. Newspaper Evidence

Applicant also attacks examiner's newspaper evidence noting that the evidence submitted could not meet "any standard that could possibly be devised". *Applicant's brief* at pg. 5. Examiner points to the facts in the *Rebo* case where the examiner proffered six telephone listings from various large cities and excerpts from the NEXIS database of which the court notes six were probative. *Rebo* at 1315. In this case there were 31 articles submitted all showing ALDECOA being used as a surname. Furthermore, in that sample there are articles from widely read publications including: The New York Times, The Washington Post, The Los Angeles Times, The Baltimore Sun, and The Detroit Free Press.

Additionally, the applicant continues to assert that with seven billion people on Earth the examiner's evidence of occurrences of ALDECOA as a surname is of such a small portion of the entire population of the earth, that those seven billion people would not view the mark in this case as primarily merely a surname. The examiner would counter that the surnames Smith, Johnson, Williams, Brown, and Jones, when compared on a global scale would not make a dent either. In any even the proportion of the world's population with the surname Aldecoa is not the test. Instead the test is what perception the American consuming public will have of the term "ALDECOA".

### c. There Is No Minimum Number of Occurrences Below Which A Term Cannot Be A Surname

The applicant runs through most of the cited cases picking out the number of occurrences of the surname at issue: *Benthin*, ~100; *Sava*, ~100; *Garan*, 6; *Baik*, 456; *Bolan*, 455; and *Curlin*, 286. The examiner's evidence comes from multiple sources showing 233 people had the surname Aldecoa in 2000 to

nearly 1000 people have that surname currently. *Initial office action* at pgs. 2-3; *Final office action* at pg. 2. Applicant contends that there are duplicates in the LEXIS evidence. Although there may appear to be some minor duplication, two different individuals with the same name may reside in a different residence and have a different phone number. Moreover, even if every entry was a duplicate, which is not the case, the evidence would put the number of Aldecoas in America at roughly 475.

In any event, "[t]here is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname;" this question must be resolved on a case-by-case basis. TMEP §1211.02(a); *see In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986). In this case, the overall search results show a sufficient number of uses as a surname, which in the context of the other *Binion*, factors, lead to the conclusion that the purchasing public would perceive this term primarily merely as a surname. *See In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d at 1537; TMEP §§1211, 1211.01.

Finally, in regards to the numbers, the Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action. *See In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew's Theatres, Inc.*, 769 F2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Florists' Transworld Delivery, Inc.*, 106 USPQ2d 1784, 1786 (TTAB 2013); TBMP §1208.

### d. Connection

There is a common thread that runs through many rare surname cases that have been discussed by the examiner and applicant; In *Baik*, *Bolan*, *Bergfeld*, *Sava*, *Garan*, and *Curlin* in each of these cases

the mark was a rare surname without a connection to the applicant or the underlying business. However, in *Darty* and *Rebo* the names' of the principals of the businesses were Darty and Rebo, and in those cases the marks were determined to be primarily merely a surname.

This case, no matter what the applicant contends with the numbers, is more like *Darty* and *Rebo* than *Baik* and *Sava*. Examiner attached as evidence a screen shot from the applicant's website in which the company promotes the quality of and markets their coffee as different because of the family history involved here. *See initial office action* at pg. 5. Furthermore this evidence directly links the mark with the current generation of Aldecoas, "Mr. and Mrs. de Aldecoa continue their daily involvement with the companies. The 3rd generation, along with a staff of seasoned professional, has now assumed leadership roles in the company." *Id.* Moreover, as stated, the specimen of use also ties the mark to the applicant's family and their history. *See amendment to allege use* at pg. 2. This evidence goes far beyond a mere connection, this evidence shows the applicant is readily telling its family's story as a marketing technique.

Indeed, in applicant's brief it is conceded that Aldecoa is a surname connected with applicant. "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." *Applicant's Brief* at pg. 11.

As to the term "de" referred to on the website, in Spanish the term "de" means "of, from;" however there is no evidence that Aldecoa was a place in Spain, Mexico, or the United States. No evidence has been offered by the applicant either in this regard. However, even if there was a place called Aldecoa the geographically significance of it would be minor and the fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname. *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993); *In re Picone*, 221 USPQ 93, 95 (TTAB 1984); TMEP §1211.01(a)(iii).

## CONCLUSION

The record in this case shows that the mark is a surname for people in the United States, that this name is used in newspapers, has no other meaning, has linguistic similarities to other Hispanic surnames, and is relied on by the applicant to differentiate their coffee business. On the balance of factors the examiner has shown that this mark would be perceived by the American public as primarily merely a surname. Accordingly, the Board is respectfully requested to affirm the refusal to register the mark under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052(e)(4).

Respectfully submitted,

/Charles H Hiser IV/

Examining Attorney

Law Office 112

(571) 272-7526

charles.hiser@uspto.gov

Angela Bishop Wilson

Managing Attorney

Law Office 112