

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: March 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Nordstrom, Inc.*  
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Serial No. 86303016  
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Syed Abedi of Seed Intellectual Property Law Group PLLC for Nordstrom, Inc.

Linda M. Estrada, Trademark Examining Attorney, Law Office 104, Dayna Browne,  
Managing Attorney.

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Before Seeherman, Shaw, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Nordstrom, Inc. (“Applicant”) has filed an application for registration on the  
Principal Register of the mark VALETTE in standard characters for the following  
goods:

Blazers; Blouses; Cardigans; Coats; Dresses; Footwear;  
Gloves; Jeans; Jumpsuits; Lingerie; Mock turtle-neck  
sweaters; Overalls; Pajamas; Pants; Scarves; Shortalls;  
Shorts; Skirts; Skorts; Slacks; Socks; Suits; Sweaters;

Sweatpants; Sweatshirts; Tank tops; Topcoats;  
Turtlenecks; Vests, in International Class 25.<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that Applicant's mark is primarily merely a surname. When the refusal was made final, Applicant appealed to this Board and simultaneously filed a request for reconsideration. When the Examining Attorney denied the request for reconsideration, this appeal proceeded. The case is fully briefed.

Section 2(e)(4) of the Trademark Act precludes registration on the Principal Register of a mark which is "primarily merely a surname" without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. §1052(f). A mark is primarily merely a surname if "the primary significance of the mark to the purchasing public" is a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975), *citing Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Com'r Pat. 1955). The Examining Attorney bears the initial burden of making a *prima facie* showing of surname significance. *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

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<sup>1</sup> Application Serial No. 86303016 was filed on June 6, 2014 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant's asserted *bona fide* intent to use the mark in commerce.

1994). If there is any doubt, we must resolve the doubt in favor of the applicant. *See In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, the Board identified five factors to consider in determining whether a mark is primarily merely a surname: (1) the degree of the surname's "rareness"; (2) whether anyone connected with the applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; (4) whether the mark has the "look and feel" of a surname; and (5) whether the manner in which the mark is displayed might negate any surname significance. *Id.* at 1332-33. The *Benthin* factors are not an exhaustive list of relevant considerations, and each factor's relevance and probative weight may vary from case to case.

In the case before us, factor (5) is not relevant to our analysis, because Applicant seeks to register its mark in standard characters. With respect to factor (2), Applicant has stated that "VALETTTE is not a surname of anyone connected with Applicant...."<sup>2</sup>

The Examining Attorney has submitted as evidence of the surname significance of VALETTE 33 news items that, together, make reference to 17 individuals bearing the surname VALETTE.<sup>3</sup> She has also submitted the partial results of a search for persons with the surname VALETTE in the LexisNexis Public Records database.<sup>4</sup> The search indicates "Total number found: 236" and sets forth the first 100 names,

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<sup>2</sup> Applicant's response of January 28, 2015 at 1.

<sup>3</sup> Office Action of February 24, 2015 at 10-78; Office Action of August 15, 2015 at 20-46.

<sup>4</sup> Office Action of September 23, 2014 at 4-7.

addresses and telephone numbers. Although this list of 100 persons may include some duplicate entries,<sup>5</sup> the evidence is sufficient for us to conclude that persons in the United States bearing the surname VALETTE number in the range of 200 individuals. Applicant, for its part, made of record the results of a search of <names.whitepages.com> indicating that there are 223 persons in the United States having the surname VALETTE.<sup>6</sup> Considering the very great size of the databases from which both Applicant's and the Examining Attorney's evidence is drawn, we find VALETTE to be an extremely rare surname.

In *In re Etablissements Darty et Fils, supra*, the Federal Circuit acknowledged that, even though a term might be, indisputably, a surname, it might still be perceived by the relevant public as something else, including "an arbitrary term," 225 USPQ at 653, thereby removing it from the prohibition of Section 2(e)(4). In this case, the extreme rarity of the surname VALETTE strongly suggests that few persons in the relevant market would know, or know of, a person named VALETTE. Even though persons named VALETTE have been mentioned in the press, we find it unlikely that the 33 news items of record have made a substantial impact on the relevant public's awareness of the surname significance of VALETTE. Similarly, even though several persons named VALETTE were noted in the press several times (in particular, Jean-Michel Valette (a businessman), Craig Valette (a professional hockey

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<sup>5</sup> For example, there are two listings for "Elvin Valette" in Manhattan, which may refer to the same person.

<sup>6</sup> Applicant's response of January 28, 2015 at 6-7. Applicant also submitted the results of searches for the names BAIK and LORCH, which indicated, respectively, 2032 persons and 1578 persons. *Id.* at 8-11.

player), and Rick Valette (a hockey agent)), none of these individuals appears to enjoy particular notoriety such as might apprise the general public of the surname significance of VALETTE.<sup>7</sup>

The Examining Attorney, in order to demonstrate that VALETTE does not have any meaning other than its surname significance, has submitted the results of searches for the term VALETTE in four online dictionaries.<sup>8</sup> Each shows that the dictionary has no entry for VALETTE. Applicant, for its part, has submitted evidence to show that Valette “is a commune in the Cantal *département* in south-central France.”<sup>9</sup> The Examining Attorney riposted with evidence indicating that Valette is “a very small place ... with a population of approximately 262 people,” located 247 miles from Paris and 42 miles from the capital of Auvergne.<sup>10</sup> This evidence gives us no reasonable basis for believing that any appreciable segment of the relevant public would be aware of this geographic significance of the term VALETTE; accordingly, it falls far short of demonstrating that the geographic significance is the primary significance of Applicant’s mark.

Applicant has declined to argue as to whether its mark has the “look and feel” of a surname. The Examining Attorney, anticipating the argument that VALETTE may

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<sup>7</sup> The press notices indicate that Jean-Michel Valette has been a director of several companies; Craig Valette has played hockey for teams in Saskatoon, Portland, Cleveland, Worcester, Syracuse, Houston, and Stockton; and Rick Valette spoke to the press in connection with the temporary suspension of a hockey player named Carter Ashton.

<sup>8</sup> Office Action of February 24, 2015 at 6-8; Office Action of August 15, 2015 at 50-52.

<sup>9</sup> Applicant’s response of July 21, 2015 at 13-16.

<sup>10</sup> Office Action of August 15, 2015 at 4-8.

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be similar in appearance and pronunciation to the common word “valet,” argues that such a similarity does not suffice to alter the primary significance of the mark from its surname significance. There is no evidence of record relevant to this point; thus, we have no basis for making a finding one way or the other.

On the record before us, we find that VALETTE is a surname that is so rare that relevant customers would be unlikely to perceive it as a surname and would instead perceive it as a fanciful, coined term having no specific meaning. As the primary meaning of the mark is not its surname significance, the mark is not primarily merely a surname within the meaning of Trademark Act Section 2(e)(4).

**Decision:** The refusal to register is reversed.