

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 1, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Remo USA, Inc.
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Serial No. 90231210
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Peter J. Willsey and Vincent J. Badolato of Brown Rudnick LLP for Remo USA, Inc.

Alaina Arthur, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Cataldo, Adlin and Larkin, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Remo USA, Inc., seeks registration on the Principal Register of the proposed mark REMO (in standard characters), identifying the following services:

Telecommunication services, namely, providing multimedia teleconferencing, videoconferencing, and online meeting services, namely, web conferencing for communication and networking via audio, video and text, and for viewing, sharing, editing, and discussion of documents, data, and images by participants, over the Internet and Intranets In International Class 38; and

On-line social networking services in International Class 45.¹

¹ Application Serial No. 90231210 was filed on October 1, 2020, based upon Applicant's allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), as to both classes of services.

The Trademark Examining Attorney has refused registration of Applicant's proposed mark under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that the proposed mark is primarily merely a surname.

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney submitted briefs. We affirm the refusal to register.

When we cite the prosecution history, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format. When we cite to the briefs, we refer to TTABVUE, the Board's docketing system, by docket entry followed where appropriate by the page number (e.g., 10 TTABVUE 5).

I. Evidentiary Matters

The asserted third-party registrations listed in Applicant's brief, 4 TTABVUE 13-15, were not introduced into the record during prosecution and will be given no consideration. The record in an appeal should be complete prior to the filing of an appeal. Trademark Rule 2.142(d); 37 C.F.R. § 2.142(d). And merely listing or summarizing portions of registrations does not make them of record. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018); *Edom Labs. Inc. v. Licher*, 102 USPQ2d 1546, 1550 (TTAB 2012).

Similarly, the hyperlinks in Applicant's September 1, 2021 Response to first Office Action at 8 and brief, 4 TTABVUE 7, 9, to the U.S. Census and Playback.fm are not evidence of record. We have made clear that providing hyperlinks to internet materials is insufficient to make such materials of record. *See In re Olin Corp.*, 124 USPQ2d 1327, 1331 n.15 (TTAB 2017) (citing *In re Powermat Inc.*, 105 USPQ2d 1789,

1791 (TTAB 2013)); *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (stating that “a reference to a website’s internet address is not sufficient to make the content of that website or any pages from that website of record”); *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (noting that because of the transitory nature of internet postings, websites referenced only by links may later be modified or deleted). Further, Applicant’s reference in its brief² to the results of a Google search of “REMO” without submission of the search results themselves are of no probative value.

The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. Trademark Rule 2.142(d); 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 (Jun. 2022) and authorities cited therein.

II. Issue on Appeal

The issue on appeal is whether Applicant’s proposed REMO mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act.³

III. Applicable Law

Section 2(e)(4) of the Trademark Act provides that absent a showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), registration on the Principal

² 4 TTABVUE 10.

³ Applicant has not claimed that REMO has acquired distinctiveness under Trademark Act Section 2(f). Nor has Applicant amended the application to seek registration on the Supplemental Register.

Register must be refused if the proposed mark is “primarily merely a surname.” 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. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 13-15F.3d 1374, 123 USPQ2d 1411 (Fed. Cir. 2017); *see also In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1277 (TTAB 2016); *In re Integrated Embedded*, 120 USPQ2d 1504 (TTAB 2016).

Various inquiries may be considered in the factual determination of whether the purchasing public would perceive a proposed mark as primarily merely a surname, including the following that are relevant in this case: whether the term has a non-surname, “ordinary language” meaning; the extent to which the term is used by others as a surname – i.e., rarity; and whether the term has the structure and pronunciation of a surname.⁴ *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653-54 (Fed. Cir. 1985); *Eximius Coffee*, 120 USPQ2d at 1278 n.4 (reviewing factors from *Darty* and *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995) and noting there is no need to discuss other inquiries for which

⁴ The proposed mark in this case is displayed in standard characters. Accordingly, it is unnecessary to consider whether any stylization of the lettering is distinctive enough to create a separate commercial impression. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); *Integrated Embedded*, 120 USPQ2d at 1506 n.4.

The evidentiary record supports Applicant’s contention that REMO “is not used as a surname by anyone connected with the Applicant. There is simply no evidence to the contrary.” Applicant’s brief; 4 TTABVUE 10. We thus give no further consideration to this inquiry. *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1287 (TTAB 2007) (quoting *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2001) (“[T]hat ‘a proposed mark is not applicant’s surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname.’”)).

the record lacks relevant evidence); *In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1719 & 1721 (TTAB 2016) (noting the consideration, if there is relevant supporting evidence of record, “of an alternative perceived meaning (which may include the perception of the mark as a coined term)”).

We conduct our analysis from the perspective of the purchasing public because “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.” *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)).

IV. Evidence and Analysis

In support of the refusal, the Examining Attorney introduced the following evidence:

- Results from two searches of the LexisNexis search engine showing 1,656 and 1,851 entries for the surname “Remo,” with 200 listings made of record.⁵ The listed individuals reside throughout the United States. *See* March 2, 2021 first Office Action at 5-13; December 9, 2021 final Office Action at 7-16.
- Search results from the online dictionaries Merriam-Webster.com, AHDictionary.com, MacMillanDictionary.com and Lexico.com showing no results for “remo.” *Id.* at 14; *Id.* at 17-19.
- A screenshot from Forbears.com genealogical website indicating there are 15,248 people in the world with the surname Remo, with 1,049 in the United States. The webpage also indicates Remo has no known meaning. December 9, 2021 final Office Action at 5-6.
- A screenshot from Forbears.com showing phonetically similar surnames to “Remo,” with the most prevalent in the United States being Remoy,

⁵ The searches were performed on March 2, 2021 and December 9, 2021 which may account for the discrepancy in numbers.

Resmo, Reamo, Remoud, Reamous, Raymo, Reyma, Ritmo, Romoo, Rhamo and Rajomo. *Id.* at 20-22.

This evidence demonstrates that “Remo” is an actual surname, and that “Remo” or “remo” has no other “ordinary language meaning.”⁶ *See Darty*, 225 USPQ at 653; *Adlon*, 120 USPQ2d at 1721 (lack of dictionary entry for the applied-for mark created a “strong inference” that the mark had no other non-surname meaning).

Applicant contends that the evidence of record showing a modest number of individuals in the United States “with the ‘Remo’ surname demonstrates the rarity of the name, which alone should outweigh the other remaining factors in the determination.”⁷ Applicant further contends that “[d]ue to the rarity of REMO used as a surname, the consuming public would not primarily recognize this term as a surname, and there is practically no risk to persons wanting to use the surname in business.”⁸

No set rule governs the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a surname. *Eximius Coffee*, 120 USPQ2d at 1278. We reject Applicant’s argument that the rarity of REMO as a surname means that the public is unlikely to view it as primarily merely a surname. The evidence of individuals in a number of locations throughout the United States

⁶ The Examining Attorney introduced evidence that “San Remo” is a port city in Italy. March 2, 2021 first Office Action at 14. However, there is no evidence of the extent, if any, to which consumers in the United States are aware of this city or would associate Applicant’s REMO mark for telecommunications and social networking services with this location.

⁷ 4 TTABVUE 8.

⁸ 4 TTABVUE 9.

who bear the REMO surname shows that it “is not so unusual that such significance would not be recognized by a substantial number of persons.” *Darty*, 225 USPQ at 653. Moreover, “even a rare surname is unregistrable if its primary significance to purchasers is a surname.” *Id.* at 1281; *see also In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989) (holding that despite the rarity of “Pirelli” as a surname, the relevant public still would view it primarily as a surname). The statutory provision makes no distinction between rare and commonplace surnames. *Adlon*, 120 USPQ2d at 1721; *Eximius Coffee*, 120 USPQ2d at 1282.

There is no minimum number of persons who must have, or be aware of, a surname in the United States for a mark consisting of that surname to be found to be primarily merely a surname under Section 2(e)(4) if the record shows that the mark is a surname in the United States, that there is some recognition of the mark as such in the United States, and that there is no other demonstrated meaning of the mark. *Adlon*, 120 USPQ2d at 1724. “The issue to be determined under the statute is whether the public would perceive the surname significance as the proposed mark’s primary significance, not whether the surname is rarely encountered.” *Adlon*, 120 USPQ2d at 1721. “[T]he degree of a surname’s rareness is not dispositive of the amount or kind of evidence the entire record must contain to establish that a mark’s primary significance to the purchasing public is that of a surname; the amount or kind of evidence necessary to demonstrate that the term is ‘primarily merely’ a surname will vary on a case-by-case basis.” *Id.*

Applicant raises unsupported arguments that REMO is a coined term with no recognized meaning and the “absence of REMO from the dictionary as observed in the Office Action is not significant in the immediate context because the term is not a noun or a descriptive term for the relevant goods.”⁹ To the contrary, the Examining Attorney’s evidence demonstrates that REMO is a surname and that the term has no other understood meaning. *See Adlon*, 120 USPQ2d at 1719 (stating that consideration will be given to whether the public may perceive the mark to be primarily a meaningless, coined term only “if there is evidence to so indicate”). “In order to show that the public would perceive a proposed mark as a coinage, in the face of evidence establishing that the mark is a surname with no other recognized meaning, some objective countervailing evidence of such a perception is required.” *Id.* at 1723. As noted above, the results of Applicant’s asserted Google search are not in the record. As a result, on this record the only significance of REMO is that of a surname.

Applicant’s speculative arguments that the absence of a dictionary definition for REMO is not significant in this case similarly are unsupported by the record. Applicant’s “assertions are unsupported by sworn statements or other evidence, and ‘attorney argument is no substitute for evidence.’” *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, *14 (TTAB 2019) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (internal quotation omitted)).

⁹ 4 TTABVUE 10.

Applicant argues that the “Examining Attorney did not submit any evidence in the Office Action showing how the mark REMO resembles a common surname in its structure or pronunciation, or evidence demonstrating that the consuming public would recognize the mark as a surname.”¹⁰ We agree that the Examining Attorney’s evidence discussed above shows REMO is similar in structure and pronunciation to other relatively uncommon or rare surnames.¹¹ However, in the absence of any objective evidence of the relevant public’s perception, this attorney argument fails to overcome the evidence of surname significance. *See Adlon*, 120 USPQ2d at 1724 (rejecting an argument based on structure and pronunciation because “[w]ith respect to this difficult type of argument, we would require more objective evidence, whether from Applicant or the Examining Attorney, of how members of the public would perceive the structure and sound ... and whether they would be likely to perceive it as similar to the structure and sound of other surnames, common words or coined terms.”).

Overall, the record contains multiple sources showing that REMO is an actual surname and that no other meaning exists. Applicant’s unsupported argument that consumers would view the term as an arbitrary brand name is unconvincing. Thus, on this record, the “primary significance of the mark as a whole to the purchasing

¹⁰ 4 TTABVUE 11.

¹¹ As noted above, these include Remoy, Resmo, Reamo, Remoud, Reamous, Raymo, Reyma, Ritmo, Romoo, Rhamo and Rajomo. December 9, 2021 final Office Action at 20-22.

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public” is that of a surname. REMO would be perceived by the purchasing public as primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act.

Decision: The refusal to register is affirmed.