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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hans Merensky Holdings (Pty) Ltd.

Serial No. 76528639

Aaron T. Borrowman of Kelly Lowry & Kelley for Hans Merensky Holdings (Pty) Ltd.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A.F. Petersen, Managing Attorney).

Before Quinn, Bucher and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 10, 2003, Hans Merensky Holdings (Pty) Ltd. (applicant) filed an intent-to-use application to register LATAS in standard character form on the Principal Register for "avocado trees, namely, avocado rootstocks" in International Class 31.¹ The examining attorney refused

¹ Serial No. 76528639.

registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. 15 U.S.C. § 1052(e)(4). Applicant responded; the examining attorney issued a final refusal and applicant appealed. For the reasons set forth more fully below, we reverse.

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under § 2(f) of the Act, 15 U.S.C. § 1052(f). We must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The examining attorney bears the initial burden to make a prima facie showing of surname significance. Id. If the examining attorney makes that showing, then we must weigh all of the evidence to determine ultimately whether the mark is primarily merely a surname. In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of applicant. In re Benthin Management GmbH, 37 USPQ2d 1332, 1334 (TTAB 1995).

In Benthin, the Board identified five factors, four of which are relevant here, 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 applicant has the mark as a surname, (3) whether the mark has any recognized meaning other than as a surname, and (4) whether the mark has the "look and feel" of a surname. Id. at 1332-33. Because LATAS is in standard character form, we need not consider the fifth factor here, that is, whether the display might remove it from surname treatment.

"Rareness" - With the first action, the examining attorney provided a listing of 73 individuals with "Latas" as a surname from a search of the Lexis/Nexis® USFind® data base. In that action, the examining attorney states, ". . . LATAS appears to be a relatively rare surname." Examining Attorney's First Action at 1. This statement notwithstanding, we conclude that the examining attorney satisfied the initial burden of presenting a prima facie showing of surname significance based on this evidence. In that action the examining attorney also indicated that she failed to find LATAS in the American Heritage Dictionary of the English Language.² Id. at 2

² The application record also includes a paper, dated January 16, 2004, four days before the first action was issued, identified as "NOTE TO THE FILE," indicating that the examining attorney consulted the USPTO translation branch to determine whether LATAS had a meaning in a foreign language. The paper includes a check mark by a

The examining attorney presented additional evidence with her response to applicant's request for reconsideration consisting of excerpts from four web pages showing use of LATAS as a surname, three excerpts from a Lexis/Nexis® "News" file showing use of LATAS as a surname, and a partial listing of results from a Google® search through which the referenced web pages apparently were located and accessed.³ In the action, the examining attorney does not discuss the Google® listing of results which we will address further below.

The four web pages refer to: (1) www.latas.com - Michael Latas of Michael Latas & Assoc. an executive search firm in St. Louis; (2) www.latasgroup.com - the Latas family, including Salette Latas; (3) www.familytreemaker.com - referring to the Latas Family Genealogy, and to Salette Latas of Falls Church, Virginia; and (4) www.barbarakrakowgallery.com showing references to an artist named Maryellen Latas. The news excerpts include: a story from The Rocky Mountain News referring to a Colorado executive named Bob Latas; a story from The

note stating, "checked with translation branch translation to 'cans' in Spanish."

³ In the action, the examining attorney states the following with regard to the Lexis/Nexis® materials, "These three showing (sic) are not representative of the Lexis/Nexis search." Response to

Tuscon Citizen referring to Salette Latas; and a story from The Daily Oklahoman reporting the death of Ronald Latas.

Applicant claims this evidence includes multiple references to the same individuals or families. Applicant's Brief at 3. That may be true; for example, in the USFind® list, there are two identical listings for Brian Latas, two identical listings for Lawrence Latas, and three identical listings for Philip Latas. With the record before us, it is impossible to determine conclusively whether or not any listings or other uses are duplicates.

Even assuming there are no duplicates, we conclude nonetheless that LATAS is a very rare surname. In concluding so, we rely on the fact that no more than 80 or so examples of the LATAS surname were located through extensive searches, including a search of a comprehensive directory of the entire United States. In re Sava Research Corp., supra at 1381; In re Garan Inc., 3 USPQ2d 1537, 1540 (TTAB 1987). Indeed, the comprehensive USFind® search found only one listing in New York City, and only one more in the rest of New York State, none in Chicago and only one in Los Angeles. Cf. In re United Distillers plc, 56 USPQ2d

Request for Reconsideration at 2. She does not explain what else those results included.

1220, 1221 (TTAB 2000); In re Picone, 221 USPQ 93, 94 (TTAB 1984). Thus, Latas is a very rare surname.

Applicant's Surname Use - Applicant has represented that no one connected with it has the LATAS surname. Applicant Brief at 4. This point is not in dispute. Applicant has represented that LATAS was selected as the mark on the basis of its meaning in Hungarian, "sight or vision," and applicant has provided a dictionary entry with its request for reconsideration to substantiate this meaning. Applicant also provided the following statement for printing in the record, "The Hungarian translation of LATAS is vision or sight." Applicant's Request for Reconsideration at 1.

Other Meanings - The Examining Attorney argues that LATAS has no significant meaning other than as a surname. In arguing so the examining attorney refers only to the meaning of the term in Hungarian and discounts that meaning relative to the surname significance. Examining Attorney's Appeal Brief at 3-4.

Applicant argues that the evidence shows that LATAS is not primarily merely a surname, in large part, relying on the listing of results from the Goggle® search the examining attorney provided with her response to the request for reconsideration, as well as the meaning in

Hungarian. Applicant states, "the first 20 results of approximately 230,000 results were provided in the office action. Only (4) referred to an individual's last name. Thirteen of the references referred to the term 'Latas' in the Spanish equivalent of 'can.' Yet another referred to a U.S. Lata map. Still another reference referred to the acronym LATAS for Laboratory for the Assessment and Training for Academic Skills." Applicant's Brief at 3. Applicant later argues, "The third Benthin factor is whether the mark has any recognized meaning other than as a surname. The term LATAS is a Hungarian word meaning 'vision or sight' . . . The only other meaning the Applicant is aware of is the Spanish translation meaning 'can.' Thus the term has recognized meaning other than as a surname, and Applicant respectfully asserts that such meanings are more common than the surname that the Examining Attorney has unearthed." Id. at 4.

In weighing the evidence bearing on this factor, we agree with applicant. First, we take judicial notice of the following definition from Cassell's Spanish-English English-Spanish Dictionary (Cassell & Co. Ltd. 1959): "*lata, n.f.* small log, tinned plate or tinned iron plate; tin can . . ." (emphasis provided). The listing of Google® results, though limited, indicates that the Spanish meaning

of LATAS is significant. Of the twenty results, there are only two people named Latas mentioned, Michael and Salette (which appears three times). On the other hand as many as 12 of the twenty results appear to refer to the Spanish word LATAS. This evidence alone is at least sufficient to cast serious doubt with regard to the contention that the primary significance of LATAS is as a surname. In fact, we believe this evidence outweighs the surname evidence, particularly when this factor is considered along with other factors, especially, the "look and feel" factor. In re Sava Research Corp., supra at 1380-81.

The USPTO generally applies the doctrine of foreign equivalence in examining trademarks. See TMEP §§ 1207.01(b)(vi) & 1209.03(g) and cases cited therein (4th ed. 2005). The Board has applied the doctrine in surname cases to evaluate whether the English meaning of a foreign word may override any surname significance. See In re Picone, 221 USPQ 93, 94 (TTAB 1984); In re Carl Braun, Camerawerk, 124 USPQ 184, 185 (TTAB 1960). The Board has extended the doctrine of foreign equivalents to the Spanish language. See, e.g., In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983). In fact, there is probably wider familiarity with Spanish than any language other than English in the United States. Accordingly, we believe it

is appropriate here to consider the apparent Spanish language significance of LATAS in determining whether its primary significance is as a surname. The evidence of record indicates that the Spanish language significance surpasses the surname significance.

"Look and Feel" - Lastly we must consider whether LATAS has the "look and feel" of a surname. As to this factor, the examining attorney argues, "The fact that LATAS is a surname supports the finding that the name 'LATAS' looks and sounds like a surname. The American purchasing public will recognize the primary significance of the term as a surname." Examining Attorney's Brief at 4. Applicant argues the opposite noting that, "The mark is not combined with initials, a title such as Mr. or Mrs., or is in a plural or possessive form." Applicant's Brief at 4.

The Examining Attorney's argument is essentially circular - it looks and feels like a surname because it is a surname. In the case of a very rare surname, we cannot assume that the purchasing public will recognize the mark as a surname based on exposure to the surname use. In re Garan Inc., supra at 1540. It is in the case of a rare surname that we need to weigh "look and feel" carefully, particularly where there is no "cue," such as a title, an initial or possessive form to signal that the term is a

surname. See, e.g., In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1368 (TTAB 1987). For example, certain surnames, though rare, resemble common surnames "in their structure and pronunciation." In In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988). We see no evidence that such is the case with LATAS. Cf. In re United Distillers plc, supra at 1221. In this case, there is no evidence that relevant purchasers would be "preconditioned" to perceive LATAS as a surname as with "Pirelli." In re Garan Inc., supra at 1540. Accordingly we find that LATAS does not have the look and feel of a surname.

On the contrary, there is significant evidence that LATAS may be perceived as a foreign word, that is, a Spanish word meaning "tin can." The Hungarian meaning reinforces this conclusion. Though Hungarian is not as familiar to consumers in the United States as Spanish, Hungarian is likewise a language subject to the general doctrine of foreign equivalents. Weiss Noodle Co. v. Golden Cracknel and Specialty Co., 290 F.2d 845, 129 USPQ 411, 413 (CCPA 1961). Furthermore, the evidence that LATAS is a word in two languages other than English indicates that it could simply be perceived as a word of foreign derivation though the precise meaning may not be known.

In conclusion, the examining attorney has made a prima facie showing that LATAS is a surname, noting that it is a rare surname. In re Etablissements Darty et Fils, supra at 653. Applicant has rebutted that showing by relying on evidence provided by the examining attorney establishing that "latas" is a common Spanish word meaning "tin cans" and applicant's own evidence that "latas" means "vision or sight" in Hungarian. Based on the totality of the evidence we conclude that LATAS is not primarily merely a surname because: it is a very rare surname; it is not the surname of anyone connected with applicant; it has significant meanings in other languages; and it does not have the "look and feel" of a surname. In re Garan Inc., supra at 1540; In re Benthin Management GmbH, supra at 1332-33. Furthermore, at a minimum this record raises serious doubts as to the primary surname significance of LATAS, and we must resolve any doubt in favor of applicant. In re Benthin Management GmbH, supra at 1334.

Decision: The refusal to register applicant's mark on the ground that it is primarily merely a surname is reversed.