

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed:
February 11, 2008
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Curlin Medical Inc.

Serial No. 78560314

George L. Snyder, Jr. of Hodgson Russ LLP for Curlin
Medical Inc.

Matt Einstein, Trademark Examining Attorney, Law Office 115
(Tomas V. Vlcek, Managing Attorney).¹

Before Seeherman, Hairston and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Curlin Medical Inc. (applicant) has applied to
register the mark CURLIN in standard characters for
"computer software for use by medical professionals for
ensuring proper medication delivery, remote monitoring of
the infusion process, facilitating infusion pump
programming, and facilitating billing, management, and

¹ A different examining attorney was responsible for this
application prior to the filing of the appeal brief.

Serial No. 78560314

archival storage of client and clinic information" in International Class 9 and "medical apparatus for introducing pharmaceutical preparations into the human body, namely, medical infusion pumps; administration sets consisting primarily of infusion equipment, namely, tubing, luer locks, luer lock caps, bag spikes, Y-sites, check valves, filters, and reservoirs" in International Class 10.²

The Examining Attorney has finally refused registration under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4), on the ground that CURLIN is primarily merely a surname. Applicant appealed. Applicant and the Examining Attorney have filed briefs. We reverse.

Trademark Act Section 2(e)(4) precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under Trademark Act § 2(f), 15 U.S.C. § 1052(f). We must decide on the unique facts of each case whether the public would perceive the mark at issue as "primarily merely a surname." *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

² Application Serial No. 78560314, filed February 3, 2005, asserting a bona intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), as the basis for the application in both classes.

Serial No. 78560314

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 associated 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 applicant's mark in this case is in standard characters, we need not consider the fifth factor, that is, whether, because of the display of the mark, it will not be perceived as a surname.

Rareness - The record establishes and the Examining Attorney concedes that CURLIN is a rare surname. With the first office action in the case, the Examining Attorney provided the results of a search in the NEXIS USFIND

Serial No. 78560314

database showing 286 records for the CURLIN surname. Applicant provided the NEXIS description of the USFIND database with its response to that action. It states, "USFIND Person Locator - Nationwide (USFIND file includes 123 million consumer records and more than 11 million business records)." Appendix A to Applicant's January 6, 2006 Response. Applicant notes, and we have confirmed, that the listing includes many obvious duplicate references to the same person. See, for example, listings 16 and 17. The Examining Attorney also provided the results of a search for "CURLIN" at rhymezone.com stating, "name: A surname (very rare: popularity rank in the U.S.: #20304)." In the final refusal in the case the Examining Attorney refers to CURLIN as "a relatively rare surname." Final Office Action at 2. Cf. *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923 (TTAB 2007) ("Baik" held to be "extremely rare" surname based on 456 examples of "Baik" surname in comprehensive directory of the entire United States).

The Examining Attorney also made of record excerpts from 37 articles from the NEXIS: NEWS-ALL database showing references to persons with CURLIN as a surname in various news articles. See attachments to Final Office Action and Denial of Reconsideration. The majority of the excerpts

Serial No. 78560314

attached to the final Office action are very brief and provide limited context. Neither these excerpts, nor those somewhat longer excerpts attached to the denial of the request for reconsideration, show references to any individual of particular note with the CURLIN surname such that the public would be conditioned to recognize this rare surname as a surname. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) (ROGAN, though rare surname, held primarily merely a surname due to media attention and publicity regarding individuals with ROGAN surname). Many of the references here include persons with CURLIN as a surname in listings of many individuals. In the articles where there is some discussion of a person with the CURLIN surname there is no evidence of any person who has been the subject of media attention or publicity to the extent that the public perception of CURLIN would be affected. Consequently, we conclude that this evidence fails to establish that this rare surname would nonetheless be recognized as a surname due to the public's exposure to its usage as a surname.

Accordingly, we conclude that CURLIN is a rare surname.

Applicant's Use - Applicant has stated that no one associated with applicant has CURLIN as a surname, and the

Serial No. 78560314

Examining Attorney does not dispute this fact.

Accordingly, for the purposes of our consideration of this case we assume that no one associated with applicant has CURLIN as a surname.

Other Meanings - The Examining Attorney argues that CURLIN has no significant meaning other than as a surname. To support this conclusion the Examining Attorney made of record the results of searches in five medical and other online dictionaries indicating no "other meaning" for CURLIN. Applicant, on the other hand, argues that CURLIN has several "other meanings."

In this connection, applicant first explains that CURLIN is a coined term derived from the term "curvilinear." Applicant explains, "The record sets forth that CURLIN is (sic) shortened form of the word curvilinear (CURviLINear) which relates to the curved arrangement of the tubing in the pumping mechanism of Applicant's peristaltic infusion pumps." Applicant's Brief at 10. Applicant also provides copies of four fact sheets related to different models of its infusion pump system. Appendix B to Applicant's Response of January 12, 2006. In each of the four examples the first item listed at the top right of each page under "Specifications" is "Pumping Mechanism" followed by "Curvilinear Peristaltic Pumping Action." The

display of this text is quite prominent and in close proximity to use of the CURLIN mark.

The Examining Attorney discounts this explanation and evidence regarding the "meaning" of CURLIN because CURLIN was not disclosed in the dictionary searches. We find applicant's explanation regarding the derivation of the mark highly relevant to both the "other-meaning" factor as well as the "look-and-feel" factor.

Of course, it is not at all surprising that one would not find CURLIN, a coined term which applicant claims as its trademark, in medical or other dictionaries. However, the "meaning," or more accurately the derivation, of the term is highly relevant to the ultimate question - How will relevant consumers perceive CURLIN? *In re Etablissements Darty et Fils*, 225 USPQ at 653. This evidence indicates that relevant purchasers, medical professionals, are likely to perceive CURLIN as a coined term, that is, as a corrupted version of "curvilinear" used by applicant as its trademark. *Cf. In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986) (arguments regarding derivation of coined term rejected in the absence of evidence showing applicant's use of coined term with terms from which it was derived). The explanation and evidence regarding the derivation of CURLIN also indicate that relevant consumers are unlikely to

Serial No. 78560314

perceive this rare surname as a surname in the context in which it is being used, that is, as applied to the specific medical equipment and software identified in the application. *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993) (GRAINGERS used in connection with "crackers and snack chips, namely corn chips, tortilla chips, wheat chips and chips made from one or more processed cereal grains" held not primarily merely a surname).

Applicant also argues that CURLIN has additional "other meanings" which should serve to remove it from classification as "primarily merely a surname." Applicant provides evidence that "curlin" is used in the field of microbiology as the name of a protein associated with Sudden Infant Death Syndrome (SIDS). See attachments to Applicant's Request for Reconsideration. The Examining Attorney discounts the importance of this use because it is confined to the field of microbiology and would be known only to those knowledgeable in the field. The Examining Attorney's point is well taken. However, in the end, we need not and do not rely on this usage to reach any conclusions here.

Applicant also submitted evidence after a remand to show that CURLIN is the name of a racehorse. Among other things, this evidence shows that "Curlin" won the 2007

Serial No. 78560314

Preakness Stakes and was the runner up in the Belmont Stakes. The Examining Attorney countered with evidence that the racehorse was named after an individual, Charles Curlin, a former slave who fought for the confederacy in the Civil War, who was a relative of one of the horse's owners. See Examining Attorney's Supplemental Statement Following Remand with Attachments.

In the end, this evidence is not particularly relevant to or probative of how relevant purchasers, medical professionals, will perceive CURLIN when it is used in connection with the applicant's goods. The explanation and evidence regarding the derivation of the mark is of overriding importance in this context, the context which really matters here. Even when we consider the evidence regarding Curlin, the racehorse, in the broader context, on balance, it still weighs in applicant's favor. On the one hand, it is evident that a significant segment of the general public may have noted the accomplishments of Curlin, the racehorse, in the media. On the other hand, it is unlikely that the rather obscure facts regarding the derivation of the horse's name would greatly affect the public perception of CURLIN. Again, we find the explanation and evidence regarding the derivation of the

mark and its impact on relevant purchasers of the identified goods to be far more significant.

Accordingly, we conclude that the most significant "other meaning" associated with CURLIN is its derivation from the word "curvilinear" and its indirect or suggestive reference to the "curvilinear peristaltic pumping action" of the identified goods. This "other meaning" indicates that CURLIN would not be perceived as a surname as applied to the identified goods.

Look and Feel - Finally we consider whether CURLIN has the "look and feel" of a surname. The Examining Attorney argues that because it is a two-syllable term and because it shares the "lin" ending with two-syllable surnames, such as, Coughlin, Conklin, Hamlin and Timlin, CURLIN has the look and feel of a surname. Applicant, on the other hand, argues that the same "structure" also fits in the case of certain common nouns and place names, such as, poplin, gremlin and Kremlin. Applicant argues further that "in" is a widely used shortened form of "ing," a common word ending, and therefore, that people may perceive the mark as a shortened form of "curling."

Without endorsing the theories applicant advances here, we nonetheless conclude that CURLIN, in this context, does not have the look and feel of a surname. We find the

Serial No. 78560314

Examining Attorney's argument regarding the "structure" of CURLIN relative to certain known surnames far less compelling on these facts than in other cases where the Board has found that the mark has the look and feel of a surname. *See, e.g., In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988) (PIRELLI held primarily merely a surname).

Accordingly, we conclude that CURLIN does not have the look and feel of a surname.

Finally, after considering all of the relevant factors identified in *Benthin*, we conclude that the Examining Attorney has failed to establish a prima facie case that CURLIN is primarily merely a surname. *In re Joint-Stock Co. "Baik"*, 84 USPQ2d at 1924. Furthermore, even if we were to conclude that the Examining Attorney had established a prima facie case here, applicant has presented sufficient evidence to rebut the prima facie case.

Decision: We reverse the refusal to register the mark under Trademark Act Section 2(e)(4).

Seeherman, Administrative Trademark Judge, concurring:

I concur with the decision of the majority, and with much of the analysis. I add this concurring opinion to reiterate the point that I made in my concurring opinion in *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921 (TTAB 2007), as to how the "look and feel" factor should be interpreted in assessing whether a mark is primarily merely a surname. As I said in *Baik*, if a term does not have the "look and feel" of a surname it should not be refused registration even if there is evidence to show that it is, in fact, a surname, but in the converse situation, registration should not be refused simply because the mark at issue is similar in sound or appearance to other surnames. The Examining Attorney's arguments in the present case with regard to the "look and feel" factor--that CURLIN has the same "lin" ending as two-syllable surnames such as Coughlin, Conklin and Hamlin--illustrates the problem with using this factor to show that a term has surname significance. Curlin is very different from Coughlin, Conklin and Hamlin, as different as are the ordinary words "poplin" and "gremlin" noted by applicant. We can reach absurd results if we base our analysis on whether certain syllables or letter chains can be found in the applied-for mark and in various surnames. As I said in *Baik*, interpreting the "look and feel" factor to refuse registration of marks simply because

Serial No. 78560314

they are similar to recognized surnames does not serve the intention of the statute, which is to keep surnames available for use by those with that surname. See *Kimberly-Clark Corp. v. Marball, Comr. Pats.*, 94 F.Supp 254, 88 USPQ 277, 279 (D.D.C. 1950) ("The spirit and the intent of the entire Act indicate that Congress intended to codify the law of unfair competition in regard to the use of personal names as it has been developed by the courts. ... At common law it was held that every man had an absolute right to use his own name.").

As an additional point, in this case CURLIN is such a rare surname that I believe that fact alone is a sufficient basis on which to conclude that it is not primarily merely a surname. During the hearings on the bills that eventually became the Lanham Act, the testimony shows that Congress was not trying to prevent the registration of surnames per se; one witness pointed out that "almost every word you can think of is somebody's surname, somewhere" and to refuse the registration of a term because "it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice." *Hearings*

*on H.R. 4744 Before the Subcomm. Trade-Marks of the House Comm. on Patents, 76th Cong., 1st Sess. (1939) at 40.*³

If a surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. Accordingly, if the Examining Attorney cannot show that a reasonable number of people have a particular surname, in my view the Office cannot meet its burden of prima facie showing that a mark is primarily merely a surname.⁴

That is the situation in the present case. The Examining Attorney was able to find only 286 records for the surname CURLIN in a search of a national database, and even that number reflects several duplications. Thus, the number of people with the surname CURLIN is so small that

³ Congress also intended that surnames which have other meanings should be registrable.

⁴ Many surname cases were decided prior to the availability of computer databases showing surname listings for everyone in the United States, and therefore there was some uncertainty, based on evidence from a limited number of print telephone directories, about how rare a surname might be. As a result, the Board and the Courts often looked to factors other than the rareness of the surname to support a finding that a term was not primarily merely a surname. I suggest that, with the availability of these computer databases, we can determine whether a term is truly a rare surname, and if a term is sufficiently rare, we should find it registrable regardless of the evidence on the other factors.

Serial No. 78560314

the purpose of the statute prohibiting the registration of marks which are primarily merely surnames would not be served by refusing registration in this case.