

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed: January 6, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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In re The House of Terrance Proprietary Limited  
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Serial No. 79048704  
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Timothy H. Hiebert of Samuels & Hiebert, LLC for The House of Terrance Proprietary Limited.

Caryn Glasser, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).  
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Before Holtzman, Bergsman, and Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The House of Terrance Proprietary Limited ("applicant") has filed an application to register the mark RENATI on the Principal Register in standard character form for a myriad of products in International Classes 3, 26, 43, and 44.<sup>1</sup> Applicant claimed ownership of Registration

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<sup>1</sup> Serial No. 79048704, filed October 12, 2007 under the Madrid Protocol, Section 66(a) of the Trademark Act of 1946, 15 U.S.C. §1141(f), based on International Registration No. 0950033.

**Ser No. 79048704**

No. 2835742 for the mark TERENCE RENATI, in typed drawing form, for personal care products in Class 3.

The examining attorney refused registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(4). 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 Section 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 from the examining attorney and the applicant, 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.<sup>2</sup>

The Examining Attorney submitted the evidence identified below to prove that RENATI is primarily merely a surname.

1. A printout from *YAHOO.com* people search displaying five listings of people with the surname "Renati," including Ray Renati who appears in other evidence listed below.<sup>3</sup>

2. An excerpt from a *YAHOO.com* search engine report displaying five hits.<sup>4</sup> Only one hit, a reference to Ray Renati, conclusively shows "Renati" used as a surname.

3. The search results for "Renati" from the *OneLook.com* online dictionary.<sup>5</sup> There were no listings for "Renati."

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<sup>2</sup> The fifth *Benthin* factor, whether the manner in which the mark is displayed might negate any surname significance, is not relevant to our analysis inasmuch as applicant seeks registration of RENATI in standard character form.

<sup>3</sup> December 27, 2008 Office Action.

<sup>4</sup> *Id.*

<sup>5</sup> February 25, 2009 Office Action.

4. An excerpt from applicant's website referencing Terence Renati as the principal of Renati Professional Hair Products.<sup>6</sup>

5. An excerpt from Ray Renati's website at *rayrenati.com*.<sup>7</sup>

6. An excerpt from the "Surname Finder" research website at *genealogy.com* for "Renati Genealogy and Family Resources."<sup>8</sup> The examining attorney submitted what appears a cover page providing links to information. However, there was no evidence that may be gleaned from this website that there is or was any person with the surname "Renati."

7. The profile of Sujuatha Renati published on the *LinkedIn.com* website.<sup>9</sup> Although Sujuatha Renati is located in India, his/her profile may be accessed by U.S. citizens.

8. An excerpt from the *artnet.com* website promoting the work of V. Renati.<sup>10</sup>

We first look at the "rareness" of the surname. As indicated above, the examining attorney submitted evidence of seven individuals with the surname "Renati." Even the examining attorney concedes that "Renati" is a rare

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<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

surname.<sup>11</sup> Based on this record, we find that RENATI is an extremely rare surname.

Before leaving this factor, we acknowledge the inconsistent history of the Board's treatment of surname refusals with respect to the number of surname listings. There are many Board decisions where we found a term to be a rare surname, yet unregistrable. Conversely, there are many Board decisions allowing a term to be registered despite more surname listings than what we have here. In other words, there remains no threshold number of surname listings upon which we base our decisions.<sup>12</sup> Rather, we believe it is important to weigh the "rareness" of the surname factor while keeping in mind the purpose of Section 2(e)(4) of the Act. As explained by Judge Seeherman in her concurrence in *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921, 1924 (TTAB 2007), the "purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames, ... Rather, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own

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<sup>11</sup> Examining Attorney's Brief, p. 5.

<sup>12</sup> We note that the electronic databases available to examining attorneys are far more comprehensive and current than the reference materials available in the past; thus, we can presume that the number of persons listed (absent duplicative entries) is a somewhat accurate estimation of the number of individuals with the surname in the entire United States.

surnames in their businesses..." Thus, while we consider all of the *Benthin* factors, we must be mindful that there are only six persons in the United States who may be adversely affected by allowing registration of applicant's mark - that is, should any one of them decide to use the surname to identify their goods and services.<sup>13</sup> "In addition, in a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use." *Id.* (in main opinion) at 1923-4, citing *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987) (the extent of surname use is a material fact in determining whether a mark is primarily merely a surname).

We turn to the second factor and look to whether anyone associated with applicant has the surname "Renati." Applicant asserts that "[t]he name 'Terence Renati' is a combination of two given names, and is used by a person associated with Applicant whose surname is not Renati, but Marini."<sup>14</sup> However, applicant effectively uses "Renati" as a surname substitute on its website. For example, applicant's website references "Terence Renati® committed

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<sup>13</sup> Sujuatha Renati is located in India. The Examining Attorney found him/her through the LinkedIn website.

<sup>14</sup> Applicant's Brief, p. 9.

to the professional hairdresser," and there is a quote from "Terence Renati" that "Terrance Renati's goal is to maximize world awareness to care for the world we live in." Even if applicant coined the name "Terence Renati," applicant is using "Renati" as a surname. Thus, we weigh this factor in favor of a finding that "Renati" is a surname.

The third factor is whether there is another recognized meaning for "Renati." The relevant question is whether the term has another recognized significance other than as a surname. The Examining Attorney has submitted dictionary evidence indicating that "Renati" has no recognized meaning. On the other hand, applicant has submitted a printout from Switchboard, a digital directory, listing eight individuals with "Renati" as their given name.<sup>15</sup> In view of the fact that there are more examples of "Renati" as a given name than as a surname, we find that "Renati" has significance other than as a surname.

Finally, as to the fourth factor, namely, whether the proposed mark has the "look and feel" of a surname, the examining attorney argues that it does, relying primarily on applicant's use of "Renati" as a surname. Applicant, on

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<sup>15</sup> February 3, 2009 response. The printout does not display the URL, but applicant identified the URL as *Switchboard.com*.

the other hand, contends that its mark is reminiscent of the given name "Renatus." "Renatus is a first name of latin (sic) origin." Renato, Renata, Renate and Rene are derivatives of Renatus.<sup>16</sup> In view of the facts the "Renati" is an extremely rare surname and that it is also a given name, the examining attorney has not met her burden of demonstrating that "Renati" has the look and feel of a surname.

In balancing the aforementioned factors, we give the first factor, rareness of the surname, more weight than the other three factors primarily because the record shows only seven persons with the surname "Renati." Given the extreme rareness of the surname, and the fact that it has significance other than a surname, we conclude that "Renati" is not primarily merely a surname. Furthermore, to the extent we had any doubt in our decision and weighing these factors, we resolve such doubt in favor of applicant. See *In re Benthin Management GmbH*, 37 USPQ2d at 1334.

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

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<sup>16</sup> *Wikipedia* attached to the February 3, 2009 response.