

This Opinion is not a
Precedent of the TTAB

Mailed: August 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Carlo Ferrara SA
—

Serial No. 79162222
—

Jeffrey M. Goehring, of Young & Thompson,
for Carlo Ferrara SA.

Michael Tanner¹, Trademark Examining Attorney, Law Office 119,
Brett J. Golden, Managing Attorney.

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Before Taylor, Lykos and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Carlo Ferrara (“Applicant”) seeks registration on the Principal Register of the
mark FERET (in standard characters) for:

Precious metals and their alloys and goods made from
these materials included in this class, namely, statues and
statuettes of precious metal and their alloys, boxes of
precious metal, holiday ornaments of precious metal,
precious knobs and pulls; timepieces and chronometric
instruments; watch cases; watch straps; watch dials;

¹ The application was prosecuted by Robin Mittler, Trademark Examining Attorney, Law Office 119. Michael Tanner, Trademark Examining Attorney, Law Office 119, appeared on behalf of the USPTO at the oral hearing before the Trademark Trial and Appeal Board.

chronometers; watches; jewelry watches; watches made of precious metals or coated therewith; wristwatches; watch movements; movements for watches; watch parts in International Class 14.²

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

After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. After the request for reconsideration was denied, the appeal was resumed. Applicant and the Examining Attorney filed briefs, including Applicant's Reply Brief. For the following reasons, we reverse the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address the evidentiary objection raised by the Examining Attorney with respect to the evidence attached to Applicant's opening brief. The evidence attached to Applicant's brief is duplicative as it was previously submitted with its responses during prosecution of its application. Re-submitting such evidence is unnecessary. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (“[t]o the extent the material may simply be duplicative of matter submitted during examination, it is already of record as part of the

² Application Serial No. 79162222 was filed on February 6, 2015, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, requesting extension of protection for International Registration No. 1240021.

application file, and its submission with the briefs was unnecessary”). Accordingly, the duplicate materials attached to Applicant’s opening brief have not been considered.

II. Section 2(e)(4) Primarily Merely a Surname

Section 2(e)(4) of the Trademark Act precludes registration of a mark on the Principal Register that is “primarily merely a surname” without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. §1052(f).³ The primary significance of a mark to the purchasing public when viewed in relation to the goods or services for which registration is sought determines whether it is primarily merely a surname. *Earnhardt v. Kerry Earnhardt, Inc.*, No. 2016-1939, ___ F.3d ___, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009).

To determine whether the purchasing public would perceive Applicant’s mark as primarily merely a surname, we look to several factors including: (1) whether anyone connected with Applicant has this surname; (2) whether the term has a non-surname “ordinary language” meaning; and (3) the extent to which the term is used by others as a surname, *i.e.*, the degree of a surname’s rareness. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). In addition to the list of examples of inquiries or “factors” articulated in *Darty*, the Board articulated two

³ Applicant has not claimed or argued that its mark has acquired distinctiveness or is capable of registration on the Supplemental Register. Accordingly, those issues are not before us.

additional examples of inquiry in *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995): (4) whether the term has the “structure and pronunciation” of a surname; and (5) whether the stylization of lettering is distinctive enough to cause the mark not to be perceived as primarily merely a surname.⁴ These “factors” are not exclusive and any of these circumstances — singly or in combination — and any other relevant circumstances, may shape the analysis in a particular case. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016); *see also In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016).

The determination of whether the primary significance of the designation at issue is that of a surname is based on the facts made of record. There is no rule as to the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a surname. This question must be resolved on a case-by-case basis. *Darty*, 225 USPQ at 653-54. If there is any doubt, we must resolve the doubt in favor of Applicant. *Benthin*, 37 USPQ2d at 1334.

Analyzing Applicant’s mark under the factors identified above, we begin by looking at whether Applicant adopted its principal’s name and used it in a way that reveals its surname significance. As conceded by the Examining Attorney, there is no evidence that anyone connected to Applicant has the surname FERET.⁵ The fact that the proposed mark is not the surname of someone associated with Applicant however,

⁴ Applicant’s mark is in standard characters and thus, it is unnecessary to consider the effect of stylized lettering. *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016); *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

⁵ Examining Attorney’s Appeal Brief (9 TTABVUE 10).

does not tend to establish one way or the other whether the proposed mark would be perceived as a surname. *In re Piano Factory Group Inc.*, 85 USPQ2d 1522, 1524 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004).

Turning to the second factor, we look to whether the term FERET has a non-surname “ordinary language” meaning. Evidence that a term has no recognized ordinary language meaning or significance other than as a surname is relevant to determining whether the term would be perceived as primarily merely a surname. *See Eximius Coffee*, 120 USPQ2d at 1280; *In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986).

The evidence introduced by the Examining Attorney shows that FERET does not appear in the dictionary.⁶ However, Applicant contends that FERET is an acronym which has at least three other meanings: Facial Recognition Technology, Fast Environmental Regulatory Evaluation Tool, and Free Energy Relationship for Electron Transfer.⁷ In the November 23, 2015 Response to Office Action, Applicant presents the following evidence showing use of FERET as an acronym:

- 1) Excerpts from texts on biometrics indicating FERET is the name of a database used in facial recognition and the acronym for The Face Recognition Technology program (Response to Office Action at 15-19, 27-29);

⁶ May 21, 2015 Office Action at 13-14 from <http://www.macmillandictionary.com/spellcheck/british/?q=feret>. While the foregoing website appears to be for the British definition of “ferret,” we take judicial notice of the American version of the Macmillan Dictionary, <http://www.macmillandictionary.com/spellcheck/american/?q=ferret>, which has the same listing showing no entries for “ferret;” and at 15-19 from http://www.oxforddictionaries.com/us/spellcheck/american_english?q=feret, the Oxford U.S. English Dictionary website showing no entries for “ferret.” Page cites provided for items in Applicant’s application file are to the pdf version of the file wrapper.

⁷ Applicant’s *Ex Parte* Appeal Brief at p. 6 (7 TTABVUE 8).

- 2) Online CV for Elaine Faustman, a professor of Environmental Science at the University of Washington, listing as one of her projects “The Fast Environment Regulatory Evaluation Tool (FERET),” a “computerized cost-benefit template” used to “assess the potential health and economic benefits from reducing air pollution” (page 24) (Response to Office Action at 20-26);

Excerpt from text on cost-benefit analysis, discussing how “The Fast Environmental Regulatory Evaluation Tool (FERET)” may be used to facilitate analysis of the impact of environmental regulations (Response to Office Action at 38-39);

- 3) Excerpt from text about electron transfer, stating that FERET, or “free-energy relationship for electron transfer” is a quantitative formulation of an electron-transfer paradigm (Response to Office Action at 34-37).

Applicant argues that notwithstanding its acronym origin, FERET is an ordinary word having at least three different definitional phrases identified above.⁸ While Applicant’s evidence shows use of FERET as other than a surname by persons in specialized fields, it falls short of showing that FERET has become an ordinary word like “laser,” which began as an acronym but morphed into a common everyday term.

The analysis under this factor focuses on whether the mark has an “ordinary language meaning.” See *Darty*, 225 USPQ at 653-54; *Eximius Coffee*, 120 USPQ2d at 1278 (citing *Darty*). The issue is not whether a mark that has surname significance might also have a non-surname significance, but whether, in the context of an applicant’s goods or services, the non-surname significance is the mark’s primary significance to the purchasing public. However, the existence of other non-surname

⁸ Applicant’s *Ex Parte* Appeal Brief p. 6-7 (7 TTABVUE 8-9).

meanings of a mark does not preclude the mark from being held primarily merely a surname. *Miller v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013); see *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ2d 238, 239 (CCPA 1975); *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1942 (TTAB 1993). Here, there is no evidence supporting widespread use or public exposure of any of the acronyms such that the public would recognize FERET as having an ordinary non-surname meaning and the dictionaries have no listings of them in connection with the term FERET; thus, the alternate meanings proposed by Applicant are specialized technical acronyms used to identify certain software and techniques recognizable only by persons in those specialized fields. In view of the foregoing, FERET has no recognized ordinary language meaning or significance.

The third factor is the extent to which the term FERET is used by others as a surname. The Examining Attorney submits evidence from the LEXISNEXIS® surname database, a weekly updated directory of cell phone and other phone numbers (such as voiceover IP) from various data providers, showing the applied-for mark appearing 375 times as a surname.⁹ The Examining Attorney also submits evidence from the MooseRoots website stating that 356 people in the U.S. have the surname FERET, with FERET ranking as the 54,269th most common surname in the U.S.¹⁰

⁹ December 29, 2015 Office Action at 3, 5-23. Observing minor duplication of some names on the list, the Examining Attorney notes the possibility that there are different individuals having the same name that reside at different residences and have different phone numbers.

¹⁰ May 21, 2015 Office Action at 9-12; “Feret is an uncommon surname in the United States. In 2000, there were only 356 people with the last name Feret living in the US...” it is ranked (in 2000) as #54,269. <http://names.mooseroots.com/l/106405/Feret>. Applicant’s evidence

Applicant argues that FERET is not in sufficient use as a surname and therefore, would not be perceived primarily merely as a surname. Applicant submits telephone directory listings from Washington, D.C. and New York, NY showing little to no listings of FERET as a surname in those areas.¹¹ Applicant maintains the appearance only a handful of times in major metropolitan phonebooks evidences the rarity of its mark, noting that “[t]he cases show less than about 300-400 instances in a national database or census is considered rare for this analysis.”¹²

The Examining Attorney responds that the fact that a surname may not be popular in particular areas of the United States is of no import because the proper inquiry is whether the mark is found nationwide in telephone directories and databases.¹³ The Examining Attorney also notes that in the cases cited by Applicant to support the rarity of FERET, the surname refusals were reversed for other

also indicates FERET is ranked as the 54,269th most common surname in the U.S. See November 23, 2015 Response to Office Action at 9.

We note the better practice would be to retrieve this information directly from the U. S. Census Bureau. TMEP § 1211.02(b)(iii) (Jan. 2017). The data from the Census Bureau found in the Excel document entitled “File B: Surnames Occurring 100 or more times” listing of frequently occurring surnames in the United States from the 2010 Census shows FERER ranking at 55,505th with 370 occurrences; in the 2000 Census, it ranked 54,269th with 356 occurrences. See http://www.census.gov/topics/population/genealogy/data/2010_surnames.html and http://www.census.gov/topics/population/genealogy/data/2000_surnames.html. “Because the U.S. census is a standard reference, we may, and do, take judicial notice of the information.” *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1203 n.5 (TTAB 2017); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 n.7 (TTAB 2016); see also *In re Tokutake Indus. Co., Ltd.*, 87 USPQ2d 1697, 1699 n.1 (TTAB 2008); *In re Spirits Int’l N.V.*, 86 USPQ2d 1078, 1085 n.11 (TTAB 2008).

¹¹ June 29, 2016 Request for Reconsideration at 5-8, listing 5 exact matches in New York, NY and 0 exact matches in Washington, D.C.

¹² Applicant’s Reply Brief pp. 1-2 (10 TTABVUE 3-4).

¹³ Examining Attorney’s Appeal Brief (9 TTABVUE 7).

reasons.¹⁴ For example, in *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000), the Board reversed the refusal to register because HACKLER had another meaning as evidenced in Applicant's promotional materials. Similarly, in *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994), the Board reversed the surname refusal because SAVA had an alternate meaning that would be relevant to purchasers of the applicant's goods. And, in *Benthin*, 37 USPQ2d 1332 (TTAB 1995), the Board held the mark was not primarily a surname due to its stylization, but stated before addressing the stylization component of the test, "[w]ere we to stop our analysis here, we would find that the service mark BENTHIN per se would be perceived as primarily merely a surname" despite appearing just over 100 times in a U.S. surname directory.

According to the Examining Attorney, ascertaining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database, because even the most common surname would represent only a small fraction of such a database.¹⁵ Rather, if a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare and would be perceived by the public as primarily merely a surname. *In re Gregory*, 70 USPQ2d at 1795. Moreover, even rare surnames may be unregistrable and there is no minimum number of directory listings required to establish a *prima facie* case for refusal of registration. See *Eximius Coffee*, 120 USPQ2d at 1281; *In re*

¹⁴ Applicant's *Ex Parte* Appeal Brief at p. 4 (7 TTABVUE 6).

¹⁵ Examining Attorney's Appeal Brief (9 TTABVUE 8).

Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988) *aff'd* 883 F.2d 1026 (Fed. Cir. 1989).

The Examining Attorney submits the following Internet evidence showing the FERET surname appearing in news reports and articles on websites around the country and accessible to the general public:

University of Rhode Island web page for Brett Feret, instructor at the College of Pharmacy, web.uri.edu (December 29, 2015 Final Office Action at 24-25);

Healthgrades.com and rateabiz.com web pages for dentist Dr. Adam E. Feret in New Jersey (December 29, 2015 Final Office Action at 26-29, 37-39);

Discogs.com web page for musician Philippe Feret, (December 29, 2015 Final Office Action at 30-31);

ITFTennis.com web pages for player Antoine Feret¹⁶, (December 29, 2015 Final Office Action at 32-33);

Thebluebench.org web page for volunteer coordinator Bethany Feret in Colorado (December 29, 2015 Final Office Action at 34-36);

Vimeo.com page for videos by Angie Feret (December 29, 2015 Final Office Action at 40-42);

Daily Southtown newspaper 12/29/15 Police Blotter listing identifying Damian Feret as being arrested for possessing, growing, and selling marijuana, chicagotribune.com (December 29, 2015 Final Office Action at 43-44);

Kankakee Valley, Illinois *Daily Journal* Honor Roll listing for Beecher High School, including Benjamin Feret, daily-journal.com (December 29, 2015 Final Office Action at 49);

Variety website featuring short subject film reviews listing Julien Feret as the Producer of "Butter Lamp" (pages 58-

¹⁶ According to the International Tennis Federation website, Antoine Feret is a tennis player from France.

60) variety.com, and Kansas City Star¹⁷ website reviewing short film “Butter Lamp” and mentioning Julien Feret (page 74-75), kansascity.com (December 29, 2015 Final Office Action at 55-62, 69-81); and,

SportsDayHS Baseball Roundup listing Jacob Feret as a high school baseball pitcher in Texas (page 66), sportsday.dallasnews.com (December 29, 2015 Final Office Action at 63-68).

Applicant maintains the evidence introduced by the Examining Attorney is insufficient to show the public views FERET as a surname. “For example, there is no evidence of a famous person or well-known fictional character with the name Feret, no evidence of a historical person with the name Feret, no evidence of a national story involving the name Feret, etc. There are only ordinary references to one of the 300-400 people in the U.S. that has this name, such as a person’s online professional biography, a film credit, or a high school sports story.” Inasmuch as “virtually everyone” has some sort of direct or indirect web presence, it is no different from a person’s name appearing in a telephone listing, a neighborhood newsletter, or a catalogue. Nothing is suggested “over and above the fact that a few hundred people in the U.S. have this name.”¹⁸

Examples of evidence that are generally considered to be relevant include excerpted listings and articles from computerized research databases and evidence in the application record showing the term used as a surname. *See* TMEP §1211.02(b)(i)-

¹⁷ The online article published by the Kansas City Star begins by noting that “[s]hort subject films have all but disappeared from regular movie theaters....” Thus, article indicates the “Butter Lamp” is a short 15 minute film.

¹⁸ Applicant’s *Ex Parte* Appeal Brief p. 5 (7 TTABVUE 7).

(b)(iii), (b)(v)-(b)(vi). Recent decisions of the Board have upheld the probative value of such evidence. In *Eximius Coffee*, the Board held that excerpts from various regional newspapers such as the Washington Post and Detroit Free Press, in which individuals with the surname ALDECOA were mentioned in relation to sports scores, local events, and their jobs, “are the type of evidence that can be probative and aid analysis because they show public exposure to ALDECOA used as a surname.” 120 USPQ2d at 1280-81. In *In re Adlon Brand GmbH & Co. KG c/o FUNDUS FONDS-Verwaltungen GmbH*, 120 USPQ2d 1717, 1720-21 (TTAB 2016), the Board affirmed the refusal of the surname ADLON based on evidence from Facebook, Twitter, LinkedIn, and IMDb, holding that “what matters is that through these media the public has been exposed to the term ADLON as a surname” and “regardless of the nature of the content of these social network postings, they illustrate the ways in which members of the public may be exposed to people who bear the surname ADLON.” For these reasons, the Examining Attorney argues the appearance of FERET in telephone directories and mentions in various media shows that the primary significance of the mark to the purchasing public is as a surname.

Although the record shows that FERET is a surname having 375 listings, there is very little evidence of media attention or publicity of persons having that surname. Moreover, there is no showing of any widely recognized public personalities with that surname. Thus, FERET has not been shown to have broad public exposure.

Moving to the fourth factor, whether the term has the “structure and pronunciation” of a surname, applicants and examining attorneys may submit

evidence that, due to a term's structure or pronunciation, the public would or would not perceive it to have surname significance.

The Examining Attorney points to the following evidence of numerous surnames he contends are similar to FERET to show that the general public is accustomed to seeing last names, including surnames similar in structure and pronunciation, that look and sound like FERET:

Screen shot of WorldVitalRecords.com listing over 2,000 surnames beginning with FER-, including FERETT, FERENT, and FERETI (December 29, 2015 Final Office Action at 82-85);

Listings from Washington, D.C. and New York, NY whitepages websites including individuals with surnames similar to FERET, such as FORET, FERRETTE, FERRAT, FOREIT, and FIRAT (June 29, 2015 Request for Reconsideration at 5-8).

Applicant challenges the probativeness of this evidence, especially the lists from the WorldVitalRecords website, because “the first three letters of virtually any five letter term could be searched against a surname database to find surnames that begin with such first three letters.” Applicant also asserts that it is unaware of any Board decision that has undertaken this approach when analyzing the “look and feel” of a last name.¹⁹ In response, the Examining Attorney notes that in *Eximius Coffee*, 120 USPQ2d 1276, the Board considered whether other individuals had surnames that ended with the suffix “OA” when determining whether ALDECOA had the structure and pronunciation of a surname. *Id.* at 1280.²⁰ Ultimately, the Board declined to

¹⁹ Applicant's *Ex Parte* Appeal Brief at p. 8 (7 TTABVUE 10).

²⁰ Examining Attorney's Appeal Brief (9 TTABVUE 14).

determine whether the mark had such structure and pronunciation because the examining attorney had merely asserted “ALDECOA does follow some of the same linguistic patterns of other, more common, Hispanic surnames like Figueroa and Ochoa” but had not included evidence proving they were surnames. *Id.* Here, the evidence shows that terms which share a prefix or suffix with FERET, such as FORET, FERRETTE, and FERRAT, are listed in surname directories. However, without evidence of the uniqueness or recognition of such prefixes or suffixes as part of surnames, there is little association or correlation between those surnames and Applicant’s mark, rendering such evidence to be of little value.

Applicant also contends that the term FERET is “most structurally and phonetically similar” to the word “ferret” which is the name of an animal.²¹ The Examining Attorney counters that the slight difference in spelling between FERET and “ferret” changes the word’s significance into that of a surname, citing *In re Integrated Embedded*, 120 USPQ2d 1504 (TTAB 2016), where the Board held that the mark BARR GROUP is primarily merely a surname despite BARR’s similarity in both sound and appearance to the common term “bar,” stating “[t]here is no evidence that BARR has another common word meaning such that the language meaning is likely to be the primary meaning to the public.” 120 USPQ2d at 1510 (*citing Darty*, 225 USPQ at 653). Similarly, in *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986), the Board held PICKETT SUITE HOTEL is primarily merely a surname although PICKETT is similar to the common term “picket,” rejecting “appellant’s argument

²¹ Applicant’s *Ex Parte* Appeal Brief at p. 8 (7 TTABVUE 10).

that because the surname PICKETT is the phonetic equivalent of the word ‘picket,’ a word describing a type of fence or a labor demonstrator, a prima facie case has not been made out. ‘Pickett’ and ‘picket’ are not interchangeable in appearance or meaning.... *Id.* at 761. *See also In re Woolley’s Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991) (holding WOOLLEY’S PETITE SUITES primarily merely a surname despite the similarity of WOOLLEY’S and WOOLY). Similarly, there is no evidence that FERET has another common word meaning and FERET and “ferret” are not interchangeable in appearance or meaning. “To accept [Applicant’s] argument would automatically excuse from the proscription of Section 2(e)[(4)] all surnames that sound like words having other ordinary meanings, a result which would emasculate the purpose of the statute to preclude registration of signs which are primarily merely surnames.” *Pickett Hotel*, 229 USPQ at 761.

The Examining Attorney further argues that FERET and “ferret” are even more distinguishable than the examples above in view of the different pronunciation of Applicant’s mark explaining that the single consonant followed by –ET in Applicant’s mark indicates the suffix should be pronounced as a long letter “A,” citing to “ordinary terms such as ‘VALET,’ ‘BERET,’ and the well-known surnames ‘MONET,’ ‘MANET,’ and ‘ROGET,’ that are pronounced with a long ‘A’ sound.”²² According to the

²² Examining Attorney’s Appeal Brief (9 TTABVUE 15-16). The Examining Attorney’s request, made at fn.3 (9 TTABVUE 16), that the Board take judicial notice of the definitions of “valet,” “beret,” “Monet,” “Manet,” and “Roget,” including the pronunciation for each showing that they end in a long ‘A’ sound. The request for judicial notice is granted. *See In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 n.18 (TTAB 2015) (taking judicial notice of definition from Merriam-Webster Online Dictionary at www.merriam-webster.com); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition

Examining Attorney, such terms and surnames demonstrate that FERET is pronounced differently than the term “ferret,” and the existence of the well-known surnames with the same –ET suffix as in Applicant’s mark, including MONET (a famous painter), MANET (also a famous painter) and ROGET (author of a famous thesaurus), further demonstrates that FERET has a structure and pronunciation that consumers are accustomed to seeing in a surname.²³ However, it is well established that there is no such thing as a correct or proper pronunciation of a trademark. *See In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1987); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); *Yamaha Int’l Corp. v. Stevenson*, 196 USPQ 701 (TTAB 1977).

Additionally, although Applicant previously argued that FERET should be viewed as an ordinary non-acronym term, when addressing the mark’s structure and pronunciation it also makes the argument that FERET has the “look and feel” of an acronym. Pointing to the structure of the mark, Applicant notes that its consonant-vowel-consonant-vowel-consonant makeup is found in acronyms such as “LASER, FUBAR, RADAR, SONAR, and TASER.”²⁴ This argument however, is entitled to little consideration. It completely overlooks that many surnames also have a similar five-

from Encarta Dictionary because it was readily available in specifically denoted editions via the Internet and CD-ROM).

²³ Examining Attorney’s Appeal Brief (9 TTABVUE 16).

²⁴ Applicant’s *Ex Parte* Appeal Brief pp. 7-8 (7 TTABVUE 9-10). While Applicant failed to provide evidence that these terms are acronyms, we take judicial notice of the definitions of LASER, FUBAR, RADAR and SONAR, which establishes that they are acronyms. *See* Merriam-Webster dictionary at <https://www.merriam-webster.com/dictionary>. However, TASER is a registered trademark of Taser International, Inc.; Trademark Electronic Search System (TESS).

letter construction; for example, the telephone white pages listings noted the surnames FORET, FIRAT and FIRET follow this pattern.²⁵

Lastly, Applicant contends that the structure and pronunciation of FERET should not weigh against it because the FERET surname is rare.²⁶ However, the Examining Attorney correctly notes that the Board has repeatedly dismissed this proposition, most recently in *Adlon*, which rejected the argument that rareness should be used to determine whether the second through fourth *Benthin* factors should be addressed, unequivocally holding “there is no support for this ‘threshold’ approach.” 120 USPQ2d at 1721. The Board further explained “the degree of a surname’s rareness is not dispositive of the amount or kind of evidence the entire record must contain to establish that the 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.” 120 USPQ2d at 1721.²⁷

Applicant notes that evidence showing the surnames cited by the Examining Attorney – Ferett, Ferent, Fereti, Foret, Ferrette, Ferrat, Forrat, Foreit, and Firat – are similar in sound to FERET is completely lacking, urging the Board to require more objective evidence of how consumers perceive the structure and sound of FERET

²⁵ Request for Reconsideration at 6-8. Additionally, *see* five-lettered surnames listed in December 29, 2015 Office Action at 82 Ferak, Feres; at 83 Feran, Ferar, Feras, Ferat, Feret, Ferey, Ferez; at 84 Feray, Ferem, Feren.

²⁶ Applicant’s *Ex Parte* Appeal Brief p. 7 (7 TTABVUE 9).

²⁷ Examining Attorney’s Appeal Brief (9 TTABVUE 17).

and whether it is similar to other surnames.²⁸ The mere sharing of a prefix, suffix or letter string does not result in the sort of structural similarity that is helpful to our analysis. *Adlon*, 120 USPQ2d at 1724. Moreover, there is no evidence showing that the surnames cited are similar in sound. Additionally, the Board has recognized that arguments regarding the structure and sound of surnames are highly subjective in nature. *See Eximius Coffee*, 120 USPQ2d at 1280 (reference to similar purported surnames “without proving that they are surnames, without showing how common such surnames ... are, and without providing some other objective evidence of how members of the public perceive the structure and sound of ALDECOA is not sufficient to enable us to determine that ALDECOA has a structure and pronunciation similar to that of other purportedly common surnames”); *Benthin*, 37 USPQ2d at 1333. Thus, the evidence presented is not sufficient to enable us to determine that FERET has a structure and pronunciation similar to that of other purportedly common surnames. More objective evidence of how members of the public would perceive the structure and sound of FERET and whether they would be likely to perceive it as similar to the structure and sound of other surnames, common words or coined terms, is required. *Adlon*, 120 USPQ2d at 1724.

III. Conclusion

Based on the evidentiary record showing that FERET has limited public exposure or notoriety as a surname in the social media references cited by the Examining Attorney and no contextual clues regarding any limited surname significance in the

²⁸ Applicant’s Reply Brief p. 3 (10 TTABVUE 5).

way Applicant actually uses the term, the record falls short of showing by substantial evidence that consumers would be likely to perceive FERET as primarily merely a surname. To the extent that the lack of substantial evidence casts doubts on whether or not the primary significance of the term FERET when applied to Applicant's goods is a surname significance, that doubt must be resolved in favor of Applicant, and the mark published for opposition. *See In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1924 (TTAB 2007).

Decision: The refusal to register Applicant's mark FERET under § 2(e)(4) is reversed.