

This Opinion is not a  
Precedent of the TTAB

Mailed: July 6, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re Caruso Property Management, Inc.*  
—

Serial No. 86068166  
—

Bryan P. Stanley of Kutak Rock LLP,  
for Caruso Property Management, Inc.

Cheryl Clayton, Trademark Examining Attorney, Law Office 102,  
Mitchell Front, Managing Attorney.

—  
Before Kuhlke, Kuczma and Adlin,  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Caruso Property Management, Inc. (“Applicant”) seeks registration on the  
Principal Register of the mark CARUSO HOTELS AND RESORTS (in standard  
characters) for:

Hotel and resort services in International Class 43.<sup>1</sup>

—  
<sup>1</sup> Application Serial No. 86068166 was filed on September 18, 2013, based upon Applicant’s  
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the  
Trademark Act. HOTELS AND RESORTS is disclaimed.

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

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Trademark Examining Attorney have filed briefs. For the following reasons, we affirm the refusal to register.

### I. Evidentiary Issue

Applicant submitted with its appeal brief an article from *Wikipedia* regarding a song entitled "Caruso" that was not previously made of record (*see* Exhibit A to Applicant's Brief). The Trademark Examining Attorney objects to this evidence on the ground that it is untimely.

Trademark Rule 2.142(d), 37 CFR 2.142(d), provides that the record in the application should be complete prior to the filing of an appeal, and that the Board will ordinarily not consider additional evidence after the appeal is filed. Accordingly, given Applicant's untimely submission of Exhibit A with its brief, the Trademark Examining Attorney's objection is sustained, and we have not considered this evidence.

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

The primary significance of the mark to the purchasing public determines whether it is primarily merely a surname. *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).

The question whether a word sought to be registered is primarily merely a surname can only be resolved on a case by case basis focusing on the term's primary significance to the purchasing public. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 654 (Fed. Cir. 1985). The USPTO has the burden of establishing a *prima facie* case that a term is primarily merely a surname. *Id.* at 653. If the trademark examining attorney makes that showing, then we must weigh all of the evidence from the trademark examining attorney and the applicant, to determine ultimately whether the mark is primarily merely a surname. See *In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1922 (TTAB 2007); *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve it Applicant's favor. See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

The Trademark Examining Attorney submitted a computerized research report showing that CARUSO ranks as the 1,621<sup>st</sup> "most popular last name" in the United States and that 23,919 persons in the United States share the surname CARUSO;<sup>2</sup> a dictionary definition for "Caruso, Enrico" an Italian operatic tenor who died in 1921;<sup>3</sup> a page from a surname dictionary showing that CARUSO is an American surname of Italian origin;<sup>4</sup> and excerpts from the White Pages ([www.whitepages.com](http://www.whitepages.com)) indicating

---

<sup>2</sup> 7/21/2014 Office Action p. 6, HowManyOfMe.com from <http://howmanyofme.com/search/> 07/21/2014.

<sup>3</sup> 12/22/2013 Office Action, p. 4, [Dictionary.com](http://www.dictionary.com) Unabridged. Based on the Random House Dictionary, © Random House, Inc. 2013.

<sup>4</sup> Attachment to Examiner's Brief. The Examining Attorney's request that the Board take judicial notice of the dictionary definition for the surname "Caruso" from the Oxford University Press 2003, *Dictionary of American Family Names*, Volume One A-F, is granted. The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac*

“100 results for Caruso” and listing the names of fourteen people across the country with the surname CARUSO.<sup>5</sup> Additionally, the listing of “Caruso” in *Wikipedia* shows that one of its meanings is that of a surname.<sup>6</sup>

Applicant argues that even if approximately 24,000 people have the surname Caruso, it is less than one-hundredth of one percent of the approximately 320 million people in the United States. Therefore, while admitting that “Caruso” is a surname, Applicant contends that CARUSO is a relatively rare surname.<sup>7</sup>

The issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname with the total number of listings, because given the large number of different surnames in the United States, even the most common surname would represent only a small fraction of the population. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). 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 In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988). In view of the evidence submitted and Applicant’s admission of the surname significance of CARUSO, “Caruso” is a surname.

---

*v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). *See also* TBMP § 1208.04 (June 2016).

<sup>5</sup> 12/22/2013 Office Action, pp. 6-8, White Pages from <http://www.whitepages.com/name/caruso/> 12/22/2013.

<sup>6</sup> 7/21/2014 Final Office Action, p. 5, from *Wikipedia* <http://en.wikipedia.org/wiki/Caruso> 07/21/2014.

<sup>7</sup> Applicant’s Brief p. 6 (4 TTABVUE 7).

Applicant contends that even though CARUSO is the surname of one of its principals this does not establish that the applied-for mark is viewed primarily as a surname by the relevant purchasing public.<sup>8</sup> Applicant notes that consumers rarely know the names of the principals of a corporation, pointing out that the Trademark Examining Attorney provided no evidence that the consuming public is even aware of the connection between Applicant and Mr. Caruso.<sup>9</sup> However, in this case, CARUSO is not only the surname of Applicant's principal, it is also the most important part of the Applicant's trade name, Caruso Property Management, Inc., and more importantly, of Applicant's involved mark, and in both it is used as surnames are typically used in trade names with similar structures.

The evidence from the *Dictionary of American Family Names* indicates that CARUSO is an Italian word for a

“nickname from *caruso* ‘close-cropped’...” and “[t]his word was also used in the more general sense ‘boy’, ‘lad’, since in the Middle Ages young men of fashion sometimes wore their hair much shorter than was the prevailing style. In the Girgenti area of Sicily the term was a metonymic occupational name for a worker in the sulfur pits, since such workers were required to wear their hair short.”<sup>10</sup>

The *Wikipedia* evidence also refers to

---

<sup>8</sup> Applicant's Brief pp. 5-6 (4 TTABVUE 6-7); Examining Attorney's Appeal Brief (6 TTABVUE 7).

<sup>9</sup> Applicant's Brief pp. 6-7 (4 TTABVUE 7-8).

<sup>10</sup> See attachment to Examining Attorney's Appeal Brief from *Dictionary of American Family Names*, Oxford University Press 2003 (6 TTABVUE 13-16).

“caruso’ (uncapitalized), as an Italian noun derived from the Sicilian language referring to ‘dear boy’ as a reference to a mine laborer.”<sup>11</sup>

When, as here, the term has a meaning in a foreign language, we consider the meaning’s significance in the United States. *In re Isabella Fiore LLC*, 75 USPQ 1564, 1568 (TTAB 2005). The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the word into its English equivalent. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (Citations and internal quotation marks omitted). If there is a readily recognized meaning of the term apart from its surname significance, registration should be granted. *Cf. In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1367-68 (TTAB 1987) (fact that “Piquet” was “the name of a relatively obscure card game is unlikely to be known to purchasers and is certainly not the ordinary meaning of the term).

Here, few people could be expected to know that the surname “Caruso” derives from “caruso,” an Italian/Sicilian historical noun referring to “boy” in the general sense and to “dear boy” as a reference to a historical mine laborer. That the surname “Caruso” also has this obscure meaning does not detract from its primary surname significance. Many surnames of foreign origin have obscure meanings which lose out to the primary surname significance. *See In re Spirits International N.V.*, 86 USPQ2d 1078, 1085 (TTAB 2008); *In re Isabella Fiore LLC*, 75 USPQ 1564, 1568 (TTAB 2005); *In re Advanced Spine Fixation Systems, Inc.*, 25 USPQ2d 1367, 1369 (TTAB 1992).

---

<sup>11</sup> 7/21/2014 Final Office Action, p. 5. *Wikipedia*; Applicant’s Brief p. 6 (4 TTABVUE 7).

When CARUSO is used for the name of a hotel, it would be much more likely to be perceived as a surname, perhaps the owner's, than as conveying that a "dear boy" operates or provides the name for the hotel. In short, the absence of evidence showing that CARUSO has a readily recognized meaning apart from its surname significance favors a finding that it is a primarily merely a surname.

Lastly, Applicant contends that its mark is not primarily merely a surname because CARUSO identifies Enrico Caruso, "1873-1921 an outstanding Italian operatic tenor."<sup>12</sup> However, the fact that an individual is famous in a particular field generally will not dissipate the term's primary significance as a surname. *See In re Binion*, 93 USPQ2d at 1537-38; *In re Thermo LabSystems, Inc.*, 85 USPQ2d 1285, 1289 (TTAB 2007). There is a difference between being an individual that has made a historically significant contribution and being an individual that has achieved such renown as to become an historical figure. *In re Thermo LabSystems, Inc.*, 85 USPQ2d at 1289. The evidence of record does not support that the primary significance of CARUSO for Applicant's hotel and resort services is Enrico Caruso.

In considering the mark as a whole, we find that the wording HOTELS AND RESORTS does not change the significance of the mark. Combining a surname, such as CARUSO, with the generic name for the goods and/or services, *i.e.*, HOTELS AND RESORTS, does not overcome the mark's surname significance. *See In re Woolley's*

---

<sup>12</sup> 12/22/2013 Office Action p. 4, from *Dictionary.com* based on Collins English Dictionary-Complete & Unabridged 10<sup>th</sup> Edition, 2009 © William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009 and Random House Dictionary, ©Random House, Inc. 2013. Applicant's Brief p. 7 (4 TTABVUE 8).

*Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *see also Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1622 (TTAB 2013) (holding MILLER LAW GROUP primarily merely a surname for legal services, noting that LAW GROUP is a generic designation for a law firm); *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1944 (TTAB 1993) (holding HAMILTON PHARMACEUTICALS primarily merely a surname for pharmaceutical products); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname for restaurant services).

In view of the foregoing, CARUSO HOTELS AND RESORTS is primarily merely a surname as contemplated under § 2(e)(4). The evidence of record shows that CARUSO is a surname, and Applicant concedes this. Moreover, the terminology HOTELS AND RESORTS is generic wording that has been disclaimed. Thus, the primary significance of CARUSO HOTELS AND RESORTS is that of a surname.

**Decision:** The refusal to register Applicant's mark CARUSO HOTELS AND RESORTS under Section 2(e)(4) is affirmed.