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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86360517
Applicant	3454240 Canada inc.
Applied for Mark	CORSINO
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of 3454240 Canada Inc.

Serial No. 86360517

Trademark: CORSINO

Filing Date: August 7, 2014

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant 3454240 Canada Inc. (hereinafter “Applicant”) and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

II. STATEMENT OF THE CASE

On or about August 7, 2014 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following goods: “Compression garments for athletic or other non-medical use, namely, jerseys, shorts, jackets, pants, one-piece suits, vests, arm and leg warmers, caps, gloves, t-shirts.”

On or about November 25, 2014 the Examining Attorney refused registration of the Applicant’s trademark on the grounds that it is primarily merely a surname under Section 2(e)(4) of the Trademark Act of 1946 when used on or in connection with Applicant’s goods.

On or about December 23, 2014 Applicant filed a response to the Office Action dated November 25, 2014 arguing in support of registration. However, ultimately Applicant’s argument was not deemed persuasive by the Examining Attorney and, accordingly, on or about January 13, 2015 the Examining Attorney made the refusal final.

The instant appeal now timely follows.

III. ARGUMENT IN SUPPORT OF REGISTRATION Refusal under Section 2(e)(4) of the Trademark Act of 1946

The question of whether a term is primarily merely a surname depends on the primary, not the secondary, significance to the purchasing public. The Trademark Trial and Appeal Board has identified five factors to be considered in making this determination:

- (1) Whether the surname is rare (*see* TMEP §1211.01(a)(v));
- (2) Whether the term is the surname of anyone connected with the applicant;
- (3) Whether the term has any recognized meaning other than as a surname (*see* TMEP §§1211.01(a)–1211.01(a)(vii));
- (4) Whether it has the “look and feel” of a surname (*see* TMEP §1211.01(a)(vi)); and
- (5) Whether the stylization of lettering is distinctive enough to create a separate commercial impression (*see* TMEP §1211.01(b)(ii)).

In re Benthin Mgmt. GmbH, 37 USPQ2d 1332, 1333-1334 (TTAB 1995). Where the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant. *Yeley*, 85 USPQ2d at 1151; *Benthin*, 37 USPQ2d at 1334.

The burden is initially on the examining attorney to establish a prima facie case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902, 902-03 (TTAB 1986).

A. The Surname in Applicant’s Trademark is Rare

Under *Benthin*, if the surname is rare no refusal should be issued. *See also In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 833, 184 USPQ 421, 422 (CCPA 1975) (finding six telephone directory listings insufficient to establish a prima facie case); *In re BDH Two Inc.*, 26 USPQ2d 1556, 1558 (TTAB 1993) (finding twenty-one telephone directory listings, eleven excerpts from a research database, primarily from foreign publications, and a dictionary page showing no listing for the proposed mark insufficient to establish a prima facie case); *In re*

Garan Inc., 3 USPQ2d 1537, 1540 (TTAB 1987) (finding six telephone directory listings, a reference in a television news program, and a dictionary page showing no listing for the proposed mark insufficient to establish a prima facie case). *See also In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007) (finding the extreme rarity of BAIK weighed against surname refusal); *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994) (finding SAVA not primarily merely a surname, where there was evidence that the term had other meaning, no evidence that the term was the surname of anyone connected with applicant, and the term’s use as a surname was very rare); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987) (holding GARAN not primarily merely a surname).

According to the Examining Attorney, there are only 623 instances in the United States wherein the term Corsino is used as a surname. Under *Benthin*, it is respectfully submitted that in a country of over 320,000,000 people this amount is far too few to establish the primary significance of Corsino as a surname here in the United States. *In re Benthin Mgmt. GmbH*, 37 USPQ2d at 1333-1334.

As such, it is respectfully submitted that the instant refusal under Section 2(e)(4) of the Act should be withdraw based upon the rarity of the alleged surname at issue.

B. The Term is Not the Surname of Anyone Connected to the Application

The Applicant for CORSINO is 3454240 Canada Inc. There is no evidence of record that would suggest that the term at issue is the surname of anyone connected to the Application. *In re Benthin Mgmt. GmbH*, 37 USPQ2d at 1333-1334.

As such, it is respectfully submitted that the instant refusal under Section 2(e)(4) of the Act should be withdraw based upon the fact that there is no evidence of record establishing a link between the alleged surname and anyone connected to the Application.

C. The Term Lacks the Look and Feel of a Surname

Certain surnames are so rare that they do not even have the appearance of surnames. In such cases, even in the absence of non-surname significance, a reasonable application of the “primary significance to the purchasing public” test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful. *In re United Distillers plc*, 56 USPQ2d 1220, 1222 (TTAB 2000) (finding HACKLER does not have the look and feel of a surname); *see also In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1923 (TTAB 2007) (finding lack of other recognized meaning does not in itself imbue a mark with the “look and feel” of a surname).

In the instant case, it is submitted that despite the evidence of record the term Corsino simply lacks the look and feel of a surname sufficient that it would be perceived by the purchasing public to be primarily a surname. The term at issue does not have the immediate look and feel such as SMITH or JONES. Rather, it lacks this requisite element that would establish the primary significance of the same as a surname sufficient to hold on the instant refusal.

As such, the refusal to register the trademark under Section 2(e)(4) of the Act should be withdrawn.

IV. CONCLUSION

WHEREFORE, it is respectfully submitted that the refusal to register the instant trademark for CORSINO should be reversed. As set forth above, the evidence of record establishes less than 630 instances wherein the trademark appears as a surname in a country of 320,000,000 plus people. In other words, persons with the term Corsino for a last name represent only .0001% or one ten thousandth of 1% of the U.S. population. Such must be said to

be rare under the test annunciated above. Moreover, the trademark lacks the overall look and feel of a surname and, moreover, as not the surname of anyone associated with the application.

Accordingly, it is respectfully requested that the Trademark Trial and Appeal Board reverse the refusal of the Examining Attorney and withdraw the refusal to register the instant trademark.

Respectfully submitted this 28th day of December, 2015

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