

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: November 14, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re James Lyons*

—  
Serial No. 90242811

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**Notice of Correction**

C. Blair Barbieri of Hovey Williams LLP for James Lyons

Toby Bulloff, Trademark Examining Attorney, Law Office 119,  
J. Brett Golden, Managing Attorney

**By the Board:**

On November 10, 2022, the Board issued and mailed its final decision in the above-captioned proceeding. However, the first page of the decision incorrectly indicates that the decision was mailed on November 7, 2022. This typographical error has been corrected as shown in the attached corrected form of the November 10, 2022 decision.

The time for filing a request for reconsideration, an appeal, or commencing a civil action continues runs from the November 10, 2022 mailing date of the Board's original decision. *See* Trademark Rule 2.145(d), 37 C.F.R. § 2.145(d).

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Before Kuhlke, Heasley and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, James Lyons, appeals from the Trademark Examining Attorney's final refusal to register his mark BORRELLO'S (in standard characters) on the Principal Register for various cell phone accessories and related goods in International Class 9,<sup>1</sup> on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4). For the reasons discussed below, we

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<sup>1</sup> Application Serial No. 90242811 was filed on October 8, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use anywhere and in commerce since at least as early as September 27, 2020.

affirm the refusal to register.

### **I. Primarily Merely a Surname – Applicable Law**

Section 2(e)(4) of the Trademark Act prohibits registration on the Principal Register of a mark that is primarily merely a surname, unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f). “A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance to the purchasing public is that of a surname.” *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017) (citing *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017)).

Whether the primary significance of a term is merely that of a surname is a question of fact that must be resolved on a case-by-case basis, founded on the record as a whole. *In re Olin*, 124 USPQ2d at 1330; *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017). Among the circumstances that may be probative in making this determination are: the extent to which the term is exposed to the public as a surname; whether the term is the surname of anyone connected with the applicant; whether the term has any recognized meaning other than as a surname; and whether the term has the structure and pronunciation of a surname. These inquiries are not exclusive, nor are they presented in order of importance; any of the inquiries—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case. *Id.*; *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995).

The USPTO, through the Examining Attorney, bears the burden of establishing a prima facie case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). If the USPTO establishes a prima facie case, the burden shifts to the applicant to rebut that case. *Id.* On appeal, we must weigh all of the evidence to determine whether the record as a whole supports the refusal. *In re Sava Rsch. Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994).

#### **A. BORRELLO is a Surname**

The evidence of record demonstrates that BORRELLO is a surname.<sup>2</sup> . Its surname significance is not diminished by the fact that it is presented in its possessive form, BORRELLO'S. *See In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (holding BINION and BINION'S primarily merely a surname); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (holding MCDONALD'S primarily merely a surname based on a showing of surname significance of "McDonald," the Board noting that "it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades").

#### **B. The Extent of Public Exposure to BORRELLO as a Surname**

We consider the frequency with which the term BORRELLO is used and exposed

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<sup>2</sup> See printouts from wikipedia.com, forebears.io, and ancestry.com provided with the March 9, 2021 Office Action, TSDR pp. 4-19.

to the public as a surname. During prosecution, the Examining Attorney provided evidence from the LEXIS/NEXIS surname database showing BORRELLO appearing 761 times as a surname in a nationwide directory of names,<sup>3</sup>—a number he concedes shows that BORRELLO is a rare surname.<sup>4</sup> He also provided a page from Wikipedia, which identifies four purportedly notable people having that surname, but only one is from the United States (Brian Borrello, an American artist).<sup>5</sup> Applicant, citing references that showed the population in the United States on June 20, 2022 at 334.8 million, asserts that BORRELLO is not just a rare surname, but an “*extremely* rare surname.”<sup>6</sup>

The record demonstrates BORRELLO is not frequently encountered as a surname. Nevertheless, “[t]he relevant question is not simply how frequently a surname appears ... but whether the purchasing public for Applicant’s goods is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *In re Tapio GmbH*, 2020 USPQ2d 11387, at \*9 (TTAB 2020) (quoting *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017)). In *Tapio*, the Board found that “Tapio” was primarily merely a surname, even though in the 2010 Census “Tapio” ranked at 65,244 in terms of popularity, specifically showing 304 occurrences of the Tapio surname in America,” with the Board noting that “given the massive number of surnames in the United States, even the most common surname would represent

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<sup>3</sup> September 19, 2021 Office Action, TSDR pp. 6-81.

<sup>4</sup> 8 TTABVUE 3 (Examining Attorney’s Brief).

<sup>5</sup> March 9, 2021 Office Action, TSDR p. 4.

<sup>6</sup> 6 TTABVUE 9 (Applicant’s Brief).

only a small fraction of the U.S. population.” *Id.* (citing *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004)). The record here shows that while BORRELLO is not a common surname in the United States, it is not so rare that it is unlikely to be perceived by the public as a surname.

**C. Whether Anyone Connected to Applicant has the Surname  
BORRELLO**

Applicant asserts, and the Examining Attorney considers it “undisputed,”<sup>7</sup> that “no one associated with Applicant uses or has the name Borrello.”<sup>8</sup>

**D. Whether BORRELLO has any recognized meaning other than as a  
Surname**

The Examining Attorney provided negative dictionary evidence from Dictionary.net, as well as from Collins’ Italian-English dictionary, to show that BORRELLO has no meaning in English or Italian.<sup>9</sup> “[W]here no common word meaning can be shown, a more difficult question must be answered concerning whether the mark presented for registration would be perceived as a surname or as an arbitrary term.” *In re Etablissements Darty et Fils*, 225 USPQ at 653. *See also In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016) (“The evidence that ALDECOA has no other recognized meaning further supports the Examining Attorney’s case that its primary significance is as a surname.”).

Applicant asserts that BORRELLO does have “other significant meanings.” Citing

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<sup>7</sup> 8 TTABVUE 3 (Examining Attorney’s Brief).

<sup>8</sup> 6 TTABVUE 13 (Applicant’s Brief).

<sup>9</sup> November 9, 2021 Final Office Action, pp. 6-9, 25.

a Wikipedia article, Applicant argues that:

[T]he primary meaning and significance of Applicant's BORRELLO'S mark is in connection with a commune and town in the province of Chieti in the Abruzzo region of Italy, which is a place of historical significance, named after the iconic ruling Borrello family. ... The city's name derives from the historical Borrello family who enjoyed its imperial dynasty and lordship over that geographic area for a great deal of time .... The family is reportedly now extinct. But, as noted by the Examining Attorney, there is a historical town in Italy that bears the same name, giving the name "Borrello" meaning and significance other than as a surname.<sup>10</sup>

Based on the same Wikipedia article, the Examining Attorney asserts that:

[T]his 'well-known' place has only 338 people within 5 square miles. Even if average Americans were to know the particular Abruzzo region of Italy (and this is questionable), it is highly unlikely they would know the Chieti province and then the tiny Borrello town within this area. This historical or geographic connotation does not rise to the level required to influence the perception of the purchasing public. Applicant's argument also falters as the Wikipedia page states that the city, like many others, was named for the Borrello family that had lordship there for a long time. Therefore, the root of the city name is that of a surname -- the Borrello family. Thus, this term appears to have no recognized meaning or significance other than as a surname.<sup>11</sup>

The relevant question is whether the term has another recognized significance other than as a surname. A mere Wikipedia page hardly provides a sufficient basis for us to find that BORRELLO, the name of a tiny commune in a foreign country, would be familiar to an appreciable segment of Americans or would be perceived by them as anything but an obscure geographic place. *See, e.g., In re Gregory*, 70 USPQ2d at 1796 ("there is nothing in the record to show that any of these places are so well known that the geographic significance...would overshadow the surname

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<sup>10</sup> 6 TTABVUE 14-15 (Applicant's Brief, internal citation omitted).

<sup>11</sup> 8 TTABVUE 4 (Examining Attorney's Brief).

significance of the term”); *Sava Rsch.*, 32 USPQ2d at 1381 (“[W]e have given little weight to the fact that SAVA is the name of a town in Israel and a river in Bosnia. We think that these meanings would most likely not be known to American purchasers of applicant’s secure communication systems.”); *In re Picone*, 221 USPQ 93 (TTAB 1984) (“the different and apparently obscure word ‘Picon’ is the name of a town and a mountain in Spain” did not overcome prima facie case of the examining attorney). Accordingly, Applicant’s evidence falls short of demonstrating that geographic significance would be the primary significance of BORRELLO to United States purchasers of cell phone accessories and related goods.

**E. Whether BORRELLO has the Structure and Pronunciation of a Surname**

The Board has acknowledged that “[a]ssessing whether [a term] has the structure and pronunciation of a surname is a ‘decidedly subjective’ inquiry.” *In re Tapio GmbH*, 2020 USPQ2d 11387, at \*13 (quoting *Benthin*, 37 USPQ2d at 1333). In connection with that inquiry, “[a]pplicants 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.” *Id.* “Pertinent evidence typically consists of other common surnames that are configured similarly and sound similar to the proposed mark.” *Tapio*, 2020 USPQ2d 11387, at \*12.

To support his contention that BORRELLO has the structure and pronunciation of a surname, the Examining Attorney provided a Lexis/Nexis listing of 702 surname hits nationwide for the alternate spelling BORELLO (with one “R”). Additionally, he provided printouts from Italiangenealogy.com and Italyheritage.com, which indicate

that the suffix “-ELLO” is common in Italian surnames and connotes “smaller” or “little.”<sup>12</sup> Further and “[m]ost importantly with respect this mark,” he argues, Applicant’s presentation of BORRELLO in its possessive form “enhances the initial reaction to that of a family’s name.”<sup>13</sup> He concludes that “American purchasers have been exposed to Italian surnames for several generations and would readily perceive applicant’s mark with its ‘-ELLO’ ending as being a surname, whether or not they had been personally exposed to that exact name.”<sup>14</sup>

Applicant disagrees, contending instead that BORRELLO “has the structure and pronunciation of a geographic location, not a surname, since that is the term’s primary significant meaning and in light of the typical structure and pronunciation of other Italian towns, cities, and regions (i.e., Milano, Palermo, Abruzzo, Veneto, Moltepulciano).”<sup>15</sup> Furthermore, asserts Applicant, “[e]ven if it can be shown that Italian surnames may be more prone to use of the -ELLO suffix, that does not provide an indication as to the prevalence of the -ELLO suffix in the relevant United States population or whether the relevant purchasing public would associate the -ELLO suffix primarily, and only, in connection with a surname.”<sup>16</sup>

We are not persuaded by Applicant’s contention that the ending letter “O” in BORRELLO gives it the structure and pronunciation of a geographic location because

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<sup>12</sup> September 19, 2021 Office Action, TSDR pp. 6-42; November 9, 2021 Final Office Action, TSDR pp. 12-24.

<sup>13</sup> 8 TTABVUE 5 (Examining Attorney’s Brief).

<sup>14</sup> *Id.*

<sup>15</sup> 6 TTABVUE 17 (Applicant’s Brief).

<sup>16</sup> *Id.*

some Italian towns, cities, or regions end in that letter. Instead, we agree with the Examining Attorney that BORRELLO does have the structure and pronunciation of a surname, particularly an Italian surname, and that Applicant's use of the possessive is consistent with the use of a surname. *See Beds & Bars*, 122 USPQ at 1551 ("Insofar as contextual clues are concerned, the mark BELUSHI'S includes the surname BELUSHI in the possessive form (i.e., with an apostrophe 's'). This is consistent with perception of the term as a surname.").

## **II. Conclusion**

We find that the Examining Attorney has established a prima facie case that BORRELLO'S is primarily merely a surname presented in its possessive form, which Applicant failed to rebut. In particular, the evidence of record demonstrates that BORRELLO is an actual surname and has no other "ordinary language meaning," which supports a finding that BORRELLO'S is primarily merely a surname presented in the possessive form. *See In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1721 (TTAB 2016) (lack of dictionary entry for the applied-for mark created a "strong inference" that the mark had no other non-surname meaning). While Applicant's evidence shows that BORRELLO is also the name of a small commune in Italy named for a historical Borrello family, it does not demonstrate that any appreciable segment of the United States would be aware of that obscure geographic location, and it does not detract from BORRELLO'S primary significance as a surname. Put simply, "there is no persuasive evidence in the record that [BORRELLO'S] would be perceived as anything other than as a surname in the

United States.” *Eximius Coffee*, 120 USPQ2d at 1283.

**Decision:** The refusal to register BORRELLO’S under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4), is affirmed.