

Serial No. 77/759190

Mark: MILAZZO

Response:

On September 15, 2009, the Examining Attorney assigned to this application issued an initial Office Action refusing registration of the mark MILAZZO under Section 2(e)(4). Applicant respectfully offers the following Response to traverse the refusal of the Examining Attorney.

Section 2(e)(4) of the 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). The Trademark Trial and Appeal Board decides each 2(e)(4) case on its facts. The Examining Attorney bears the initial burden to make a prima facie showing of surname significance. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed.Cir. 1985).

If the Examining Attorney makes that showing, then the Board must weigh all 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 USPQ 2d 1380, 1318 (TTB 1984). If there is any doubt, the Board must resolve the doubt in favor of the Applicant. *In re Benthin Management GmbH*, 35 USPQ2d 1332, 1334 (TTAB 1995).

In Benthin, the Board identified five factors, four of which are relevant here, to consider when 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 a surname; and (4) whether the mark has the "look and feel" of a surname. *Id.* at 1332-33. (Because the mark is in standard character form, we need not consider the fifth *Benthin*; i.e., whether the manner in which the mark is displayed negates any surname significance.)

To justify a surname refusal, the Examining Attorney bears the burden of producing substantial evidence that the mark's primary significance to the relevant purchasing public is as a surname. *In re Harris-Intertype Corp.* 518 F.2d 629 (CCPA 1975). On review, the Examining Attorney is presumed to have provided the best available support of a refusal to register. *See In re Federated Department Stores, Inc.*, 3 USPQ2d 1541, 1542 n. 2 (TTAB 1987).

Applicant respectfully submits that the Examining Attorney has not met the burden as set by the Board or the Federal Circuit and argues that the refusal to register under Section 2(e)(4) should be withdrawn for the reasons stated below.

Rareness of the Mark

As evidence attached to the September 15, 2009 Office Action, the Examining Attorney provided a partial list and screen shot of individuals having MILAZZO as a

surname, retrieved by a search of the LexisNexis Research Database. Based on the search results, the Examining Attorney states that these evidence “establishes the surname significance of the surname MILAZZO” (Office Action, p. 2).

The Examining Attorney offered only 100 names and address of individuals named MILAZZO and states that states that there are a total of 1,062 pertinent records. None of these records has been verified to ascertain if the listed individual has died, married or moved out of the country. Nor has the list been vetted for duplicate entries. In a country with over 300 million people, an unsupported total of 300 people with that surname proves that the surname is extremely rare in the United States. *See In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1923 (TTAB 2007) (BAIK considered “extremely rare” based on 456 directory listings.) *See also In re United Distillers PLC,* 57 USPQ2d 1220, 1221 (TTAB 2000)(HACKLER held rare with 1,295 listings). Applicant respectfully submits that the use of MILAZZO as surname among such a tiny portion of the population does not constitute prima facie evidence that the term has primarily surname significance.

The rare nature of MILAZZO as a surname in the United States strongly favors the Applicant.

Applicant’s Surname Use

While the Examining Attorney did not address the Applicant’s surname use, to the best of the knowledge of the Attorney of Record, no one connected with the Applicant uses MILAZZO as a surname. Accordingly, this factor favors Applicant.

Other Meanings

The Examining Attorney does not address whether MILAZZO has any other meaning other than a surname. But, since this is an important issue for the Board, Applicant will address it in this Response A Google search of the term MILAZZO shows that the primary meaning of MILAZZO is the city by that name in Italy. Indeed, the entire first screen of Google “hits” refers only to the Italian City of Milazzo. The province has a population of over thirty thousand people and is a well-known tourist destination, visited by travelers from all over the world. (Wikipedia pages attached as Ex. 1). Geographic locations are an important indicator that a term is not primarily merely a surname. It is well settled in trademark law that a well-known geographic location may traverse a surname refusal. In 1977 the Board stated that:

[W]e are of the opinion that the geographic significance of the term referred to by Applicant, that is, its significance as the name of a well-known city in Alaska, is just as dominant in character as the surname significance. Under such circumstances, it cannot be said that the primary significance of the word “FAIRBANKS” to the purchasing public would be that of a surname.

In re Colt Industries Operating Corp. 195 USPQ 75, 78 (TTAB 1977).

Because the term MILAZZO has a primary significance as a geographic location and the Board recognizes that a geographic location influences the perception of the purchasing public, Applicant argues that the term MILAZZO is not primarily a surname. Accordingly, this factor favors Applicant.

Look and Feel

The Examining Attorney did not address the issue of the “look and feel” of the term MILAZZO. It is Applicant’s argument that the “look and feel” factor of *Benthin* does not fulfill the purpose of Section 2(e)(4). Judge Seeherman questioned the relevance of the fourth *Benthin* factor; i.e., whether registration should be refused because a mark “is similar in sound or appearance to other surnames.” She observed that:

The purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames, as though there were something offensive in viewing a surname. Rather, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses.

Baik at 1294.

As Judge Seeherman’s dissent so succinctly states, the fact that the public may view a mark as having the “look and feel” of a surname arguably has nothing to do with keeping surnames available for people who want to use their own surnames. Far more important to Judge Seeherman is the rareness factor.

Alternatively, Applicant argues that the term MILAZZO has the “look and feel” of a geographic location, not a surname, since that is the term’s primary meaning. Accordingly, the “look and feel” factor favors Applicant.

Conclusion

The Examining Attorney’s Office Action does not support the Examining Attorney’s position that MILAZZO is primarily merely a surname under Section 2(e)(4). On the contrary, the Applicant has shown that the four relevant *Benthin* factors clearly favor the Applicant. MILAZZO is an extremely rare surname in the U.S., no individual at Applicant’s business is named MILAZZO, MILAZZO is primarily known as a geographic location in Italy, and the term MILAZZO does not have the “look and feel” of surname. Accordingly, Applicant requests that the Examining Attorney approve this application for publication for opposition purposes.