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OF THE TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Roundy's Supermarkets, Inc.

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Serial No. 77275882

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Nicole J. Renouard of Whyte Hirschboeck Dudek S.C. for Roundy's Supermarkets, Inc.

Tamara G. Frazier, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

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Before Holtzman, Kuhlke and Mermelstein, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Roundy's Supermarkets, Inc. to register the mark RIANO'S (in standard character form) for "retail grocery stores" in Class 35.<sup>1</sup>

The trademark examining attorney has refused registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. When the refusal was made final, applicant appealed.

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<sup>1</sup> Application Serial No. 77275882, filed September 10, 2007, based on an allegation of a bona fide intention to use the mark in commerce.

Both applicant and the examining attorney have filed briefs.

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. See *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). Among the factors to be considered in determining whether a term is primarily merely a surname are (1) the degree of a surname's rareness; (2) whether anyone connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; and (4) whether the term has the "look and sound" of a surname. See *United Distillers*, *supra* at 1221.

As to the first factor, the degree of rareness, the examining attorney submitted a printout from the LexisNexis Person Locator P-Find database indicating that there are 330 listings for the surname "Riano," along with a partial listing of the names.<sup>2</sup> The examining attorney has also submitted a page from the website, *target.com*, advertising the sale of "one of a series of family name books" which is entitled *The Riano Name in*

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<sup>2</sup> The examining attorney also introduced a printout from the website, *peoplefinders.com*, showing 100 entries for Riano. However, because the extent of overlap, if any, between the two lists cannot be determined, these entries have not been counted toward the total number of listings.

*History*.<sup>3</sup> The examining attorney acknowledges that Riano is a relatively rare surname.

Applicant argues that Riano is an exceptionally rare surname. Applicant contends that the rareness of the surname can only be determined by comparing the number of uses of that surname with the uses of other surnames in the population. To support this contention, applicant points to its evidence showing that there are very few occurrences of the name in certain individual cities in the United States, and argues that "less than one-ten thousandth of the population (0.00097%) would have the surname 'Riano.'" Brief, p. 4. Applicant has submitted a printout from wikipedia.org showing that "Riano" does not appear in the 100 most common surnames in the United States; printouts from census.gov and surnames.behindthename.com showing that it is not among the 1000 most common surnames in the United States; and an additional printout from census.gov showing that the name is not even in the top 88,000 most common surnames in the United States.

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<sup>3</sup> Applicant argues that the advertising for this book which references an additional "300,000 family name books" in the series "undercuts the credibility of this book as proof of the commonality of the 'Riano' surname." Brief, p. 5. However, we do not view this as evidence that the surname is common or well known, but simply as additional evidence that it is a surname.

We find, based on the evidence, that Riano is a rare surname.<sup>4</sup> However, Section 2(e)(4) makes no distinction between rare and commonplace surnames, see *In re Picone*, 221 USPQ 93 (TTAB 1984), and even a rare surname is unregistrable if its primary significance to purchasers is a surname. See *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); and *In re E. Martinoni Co.*, 189 USPQ 589, 590 (TTAB 1975) ("The fact that 'MARTINONI' may be a rare surname does not entitle it to treatment different from what would be accorded to a common surname when no other meaning for the word is shown."). See also *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988) ("Applicant's evidence proves that 'Pirelli' is a rare surname but fails to rebut the Examining Attorney's prima facie showing that 'Pirelli' would be viewed as a surname by the relevant public.").

Moreover, the evidence in this case far exceeds that in other cases where the surname was considered rare and thus, registrable, particularly where the limited number of listings was combined with other factors in applicant's favor. See, e.g., *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184

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<sup>4</sup> In making this finding we have given little weight to applicant's argument and evidence that the name represents only a very small percentage of the total population. We note the Board's observation in *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) that given the "vast computerized database" of surname listings and the large number of different surnames in the United States, "even the most common surnames would represent but small fractions of such a database."

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USPQ 421 (Fed. Cir. 1975) (six directory listings for the surname DUCHARME; In re Garan, Inc., 3 USPQ2d 1537 (TTAB 1987) (six directory listings for surname GARAN and one LexisNexis listing). See also In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994) (100 directory listings for SAVA; and the fact that SAVA had another meaning, i.e., as an acronym); and In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995) (100 directory listings for BENTHIN, and the mark was displayed in a "highly stylized form"). As discussed later in this decision, there are no other factors in the present case which would detract from the surname significance of this mark.

Indeed, other cases have found a term to be a rare surname, yet unregistrable, based on far fewer listings than we have here. See, e.g., In re Pohang Iron & Steel Co., Ltd., 230 USPQ 79 (TTAB 1986) (POSTEN primarily merely a surname based on 11 directory listings and 12 references from Lexis/Nexis database); and In re E. Martinoni Company, 189 USPQ 589 (TTAB 1975) (3 directory listings for the surname MARTINONI).

While Riano may be a rare surname, we cannot find, based on this record, that the surname is so rare that this factor should weigh in applicant's favor.<sup>5</sup>

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<sup>5</sup> It is true as applicant points out that the degree of rareness may have a bearing on perception of the term as a surname. Contrary to applicant's contention, however, the non-precedential case of In re Sikorsky Aircraft Corporation, Serial No. 78221800 (TTAB 2006) is not on point. Unlike the Sikorsky case, where the examining attorney

As to the second factor, applicant states that no one associated with applicant has the surname "Riano." While the fact that a term is the surname of an individual associated with the applicant may be strong evidence of the surname significance of the term, see *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), contrary to applicant's contention, the fact that no one associated with the applicant has the surname "Riano" does not tend to establish one way or the other whether the term would be perceived as a surname. See *Gregory*, supra at 1795. Thus, the fact that no one associated with applicant has the surname is not a factor that favors applicant, but rather is neutral.

The third factor is whether there is another recognized meaning for Riano. The examining attorney has submitted the relevant page from the website [Dictionary.reference.com](http://Dictionary.reference.com) containing no entry for "riano" to demonstrate that "riano" has no non-surname, dictionary meaning.

Applicant, however, argues that "Riano" has several meanings other than as a surname. None of applicant's arguments is persuasive. First, applicant's argument that "Riano" would be understood as a shortened version of "Mariano," which

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failed to establish a prima facie case, having submitted evidence of only one listing for the name Sikorsky, based on the evidence in the present case, this is clearly not a situation where the surname is so rare or obscure that it may not fall within the proscription of Section 2(e)(4) of the Act.

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applicant claims is a given name, is speculative and unsupported. Applicant has submitted TESS printouts of two third-party registrations for MARIANO'S and design (Reg. Nos. 1001671 and 1145216), one of which indicates that "The name and portrait shown are that of Mariano Martinez, Jr. whose consent is of record." This evidence may show that "Mariano" is a given name. However, it has no bearing on the question of whether the different name "Riano" would also be perceived by the public as a given name.

Applicant also argues that "Riano" has geographical significance as a small town in the province of Rome, Italy. Applicant has submitted an entry for "Riano, Italy" from the website wikipedia.org which states that "Riano" has a population of 7,185 and which describes the area as:

a commune (municipality) in the Province of Rome in the Italian region Latium. It is located about 20 km north of Rome, in the Tiber River valley, not far from Veio. ...

The relevant question is whether the term has another recognized significance other than as a surname. This evidence is not sufficient to find that Riano, as the name of a small town in a foreign country, would be familiar to many Americans or that it would be anything but an obscure geographic place. See, e.g., Gregory, supra 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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significance of the term"); Sava Research, *supra* at 1381 ("we 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."); and Picone, *supra* at 95 (the fact that "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).

Applicant further argues, relying on *In re Isabella Fiore LLC*, 75 USPQ2d 1564 (TTAB 2005), that "riano" has a meaning in a foreign language and, in particular, that the term "is a derivation of the Italian word 'riannodare' - which means 'to renew.'" Applicant has submitted an entry from *Collins Italian Dictionary* (2<sup>nd</sup> ed. 2005) defining "riannodare" as "(lacci) to retie, (cravatta) to reknot (fig) (amicizia) to renew." Applicant argues that in relation to its grocery stores, the term suggests "'renewed' love of supermarkets and shopping for food." Brief, pp. 9-10.

Even assuming that American consumers who are familiar with Italian would translate "riannodare" into English as "to renew," (and it is not clear on this record that they would), there is no evidence that "riannodare" and "riano" are equivalent terms. There is nothing to indicate that the different word "riano" would be recognized by consumers as a derivation of

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"riannodare," or that they would ascribe the same English meaning to both terms. See, e.g., *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) ("WOOLLEY'S and 'wooly'" are not "interchangeable words"); *In re Pickett Hotel Co.*, 229 USPQ 760, 761 (TTAB 1986) ("'Pickett' and 'picket' are not interchangeable in appearance or meaning"); and *Picone*, supra at 95 ("That applicant has established that... 'piccone' is an Italian word meaning 'pick' or 'pickax'" did not overcome the examining attorney's prima facie case).

Thus, applicant's reliance on *Fiore* is misplaced. In that case, the Board found, applying the doctrine of foreign equivalents, that "Fiore" is an Italian word "that is listed as the only translation of the common English word 'flower,'" and further that the term "is spelled in the standard Italian dictionary form." Thus, the Board concluded that "there is no question of whether the term would be recognized in its current form as the Italian word for 'flower.'" Applicant has not shown that the term "Riano," itself, has an ordinary foreign language meaning, let alone, unlike in *Fiore*, that any such foreign language meaning would be familiar to the American public.<sup>6</sup>

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<sup>6</sup> Applicant has also relied on *In re The Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989), wherein the Board found that CALISTO is not primarily merely a surname in that (distinguishing *Pickett Hotel*) it is the phonetic equivalent of "Callisto" which has non-surname meanings. In the present case, however, "riano" is not the equivalent of "riannodare," phonetically or otherwise.

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As to the fourth factor, we find that RIANO has the "look and feel" of a surname, given the evidence that it is indeed a surname, albeit a rare one, and the fact that there is nothing to indicate that the term would be perceived as having any other meaning or significance. In addition, the mark is not "RIANO" alone but "RIANO'S" with an apostrophe "s" and we find that the possessive form of the term reinforces its impression as a surname.

Applicant argues that *In re Luis Caballero, S.A.*, 223 USPQ 355, 356 (TTAB 1984), wherein the term BURDONS was found to be a surname, "stands for the proposition that an apostrophe 's' is irrelevant to the surname analysis." Reply, p. 4. Applicant misstates the Board's point in that case. The only point the Board was making was that businesses often do not use an apostrophe to indicate possessive form. The Board made no finding as to whether a possessive form does or does not indicate a surname.

Applicant's reliance on *Woolley's Petite Suites*, supra, is similarly unpersuasive. While the Board did say, as applicant notes, that "the addition of an apostrophe 's' to ...WOOLLEY does nothing to change surname character," the Board specifically stated that "In fact, since the apostrophe 's' indicates the possessive form of the name, its use probably reinforces its surname significance." In other words, the

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possessive form does not detract from the surname significance of a term, but may in fact reinforce it.

In view of the foregoing, we find that RIANO'S would be perceived primarily as a surname.

**Decision:** The refusal to register under Section 2(e)(4) of the Trademark Act is affirmed.