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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Esposito and Esposito

Serial No. 78336150

Lane Fisher of Fisher Zucker LLC for Carmen Esposito and Claire Esposito.

Tracy Whittaker-Brown, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Holtzman, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On December 4, 2003, Carmen Esposito and Claire Esposito (Applicants) applied to register the mark Nucci's Italian Ice and Gelato in standard-character form on the Principal Register for services identified as "franchising, namely offering technical assistance in the establishment and/or operation of retail stores specializing in the sale of Italian ice, gelato and related products" in International Class 35. Applicants claim a bona fide

intention to use the mark in commerce as the basis for the application. Applicants have disclaimed the words "Italian Ice and Gelato" in the application.

The Examining Attorney has refused registration under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4), on the grounds that Nucci's Italian Ice and Gelato is primarily merely a surname. Applicants have appealed. Applicants and the Examining Attorney have filed briefs. We affirm.

Before considering the merits of the case we must dispose of one procedural issue. Applicants filed certain evidence for the first time with their main brief. The new evidence consists of search results from the Yahoo, Whitepages.com and the Westlaw Phone data bases. See Applicants' Brief, Exhibit B. The Examining Attorney has objected to this evidence on the grounds that the evidence is late. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), in relevant part, provides, "The record in the application should be complete prior to the filing of the appeal." Accordingly, it is obvious that the evidence filed with Applicants' brief is late, and therefore we will not consider it. We hasten to add that we would not reach a different decision if we had considered this evidence. In

fact, on balance, this evidence would support our conclusions.

We now turn to the merits of the appeal. Trademark Act Section 2(e)(4) precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under Trademark Act § 2(f), 15 U.S.C. § 1052(f). We must decide on the unique facts of each case whether the public would perceive the mark at issue as "primarily merely a surname." *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Examining Attorney bears the initial burden to make a prima facie showing of surname significance. *Id.* If the Examining Attorney makes that showing, then we must weigh all of the evidence to determine ultimately whether the mark is primarily merely a surname. *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, the Board identified five factors, four of which are relevant here, to consider in determining whether a mark is primarily merely a surname: (1) the degree of the surname's "rareness," (2) whether anyone associated with applicant has the mark as a surname, (3) whether the

mark has any recognized meaning other than as a surname, and (4) whether the mark has the "look and feel" of a surname. *Id.* at 1332-33. Because Applicants' mark in this case is in standard-character form, we need not consider the fifth factor, that is, whether the display might remove it from the coverage of Section 2(e)(4).

Rareness - With her second and final action, the Examining Attorney provided evidence of the surname significance of Nucci from three sources, the LEXIS/NEXIS EZFIND file, the ancestry.com web site and third-party "Nucci" registrations.¹ The EZFIND results indicate 6,412 occurrences of Nucci; the Examining Attorney made of record 100 of the "hits," numbered 1,877 through 1,977, to represent the overall results of the search. The Examining Attorney at the same time provided results from the ancestry.com web site showing 3,176 occurrences of Nucci. In the case of ancestry.com, none of the 3,176 records were provided. The Examining Attorney also provided copies of three third-party registrations for the marks RENATO NUCCI,

¹ In the first action the Examining Attorney also asserted that **Nucci** is the surname of a well-known designer. However, the Examining Attorney never provided evidence to support this assertion, and we have not considered it. In that action the Examining Attorney also referred to evidence from the "*Surname Web Search Engine*" but failed to make that evidence of record. Accordingly, we have not considered that evidence.

NUCCI MICROFIBER and CLAUDIO NUCCI MICROFIBER to show that Nucci is a surname.

We find the evidence the Examining Attorney provided sufficient to establish that Nucci is a surname. We find Applicants' arguments to the contrary unpersuasive. In reaching this conclusion we have relied primarily on the evidence from the EZFIND file. We find the examples provided more than adequate; there is no reason to believe that these examples of 100 consecutive records are not representative of the results generally. The evidence from the ancestry.com web site is also probative, primarily of the origin of the Nucci surname. However, it is unclear whether the evidence reflects persons in the United States who currently have Nucci as a surname. The census information from ancestry.com is from the 1920 census and the other information from sources identified as Historical Newspapers, U.S. Records Collection and U.S. Immigration Collection, is not dated specifically. The evidence from this site, as well as the third-party registrations, serves to confirm our conclusion that Nucci is a surname.

Applicants have argued that the Examining Attorney's evidence shows that Nucci is only a rare surname. Applicants assert that the overall number of occurrences in the evidence is small, that the evidence includes many

duplicate listings, and that the number of occurrences of record represent a miniscule percentage of the entire U.S. population.

In the overall circumstances here, whether or not we categorize Nucci as a rare surname would not affect the ultimate determination as to whether Nucci is or is not "primarily merely a surname." Therefore, for the purposes of our analysis, we assume that it is rare, as Applicants argue. However, we emphasize here that even a rare surname can be primarily merely a surname within the meaning of Section 2(e)(4) depending on the facts of a given case. *In re Etablissements Darty et Fils*, 225 USPQ at 653; *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990). As discussed below, Nucci is such a surname and this is such a case.

Applicants' Use - Applicants have stated that no one associated with Applicants has Nucci as a surname. The Examining Attorney suggests that Applicants should provide proof of this assertion in an affidavit or otherwise. We reject the Examining Attorney's suggestion that Applicants should provide further evidence on this point. In the absence of contradictory evidence of record, such as the appearance of the name on a specimen, the Examining Attorney should accept the statement from Applicants'

attorney that no one associated with Applicants has Nucci as a surname. Accordingly, for the purposes of our consideration of this case we assume that no one associated with Applicants has Nucci as a surname. Here again, we must emphasize that this fact is not determinative of whether Nucci is a surname within the meaning of Section 2(e)(4).

Other Meanings - The Examining Attorney argues that Nucci has no meaning other than as a surname. On the other hand, Applicants argue that the Examining Attorney has not established the lack of other meanings, and Applicants suggest that Nucci may be perceived as an Italian word. We have consulted *Cassell's Italian Dictionary* (1967 ed.) and have found no entry for an Italian word which is in any apparent way related to Nucci.² Nor do we have any evidence that Nucci is a given name. Accordingly, we conclude that Nucci has no "other meaning."

Look and Feel - Finally we consider whether Nucci has the "look and feel" of a surname. We conclude that it does.

² The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

First, Nucci is used in its possessive form in the mark - Nucci's Italian Ice and Gelato. This fact supports the conclusion that relevant consumers will perceive Nucci, as used in the mark, as primarily merely a surname. *In re Woolley's Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991) ("... since the apostrophe 's' indicates the possessive form of the name, its use probably reinforces its surname significance."). See also *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (McDonald's held primarily merely a surname.).

Furthermore, although Applicants argue to the contrary, Nucci has the structure, or "look and feel," of an Italian surname. *In re Industrie Pirelli Societa Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989). The appearance of the word "Italian" immediately following Nucci in the mark reinforces this impression. The context of the intended use also reinforces this impression, that is, in relation to "franchising, namely offering technical assistance in the establishment and/or operation of retail stores specializing in the sale of Italian ice, gelato and related products." The services focus on Italian-style products reinforcing the impression that Nucci is an Italian surname. These facts lead us to conclude that Nucci's

Italian Ice and Gelato has the "look and feel" of a surname.

Furthermore, we conclude that the disclaimed wording, "Italian Ice and Gelato," is generic for the services identified here. Therefore, we reject Applicants' argument that the inclusion of this wording in the mark negates the surname significance of the mark. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993).

In conclusion, based on the evidence of record noted here we conclude that the Examining Attorney has established a prima facie case that Nucci is a surname. Furthermore, we have considered the relevant factors and evidence and conclude that Nucci's Italian Ice and Gelato is primarily merely a surname within the meaning of Section 2(e)(4). We conclude so principally because, although Nucci is a rare surname, the term Nucci has no meaning other than as a surname, and it has the "look and feel" of a surname, as used in the mark.

Decision: We affirm the refusal to register the mark under Section 2(e)(4).