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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IMSA-MEX, S.A. DE C.V.

Serial No. 78464418

John S. Egbert of Egbert Law offices for IMSA-MEX, S.A. DE C.V.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Holtzman, Walsh and Cataldo, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On August 9, 2004, IMSA-MEX, S.A. DE C.V. (applicant) filed an application to register the mark PINTRO on the Principal Register in standard-character form for:

Building materials of metal, namely, metal building panels, metal roofing, metal roofing tiles, metal decking, metal ceiling panels, metal floor tiles, metal door and window frames and casings, metal boards for flooring, metal girders and joists; metal load bearing constructions, namely, framework of metal for buildings, reinforcing materials of metal for buildings, building boards of metal, building panels of metal, building linings of metal, and building wall cladding of metal; steel, unwrought and partly wrought common metals and their alloys and steels in the form

of strips, hoops, coils, sheets, tubes and plates; rolled steel sheets, coated steel sheets, aluminized steel sheets, and galvanized steel sheets, in International Class 6.

Applicant asserts a bona fide intention to use the mark in commerce as its basis for registration.

The examining attorney refused registration 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). Applicant responded; the examining attorney issued a final refusal; and applicant appealed. Applicant and the examining attorney have filed briefs.

We reverse.

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under § 2(f) of the Act, 15 U.S.C. § 1052(f). We must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. 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 connected 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 PINTRO is in standard-character form, we need not consider the fifth factor here, that is, whether the display might negate any surname significance.

"Rareness" - With the first action, the examining attorney provided a listing of 24 individuals with "Pintro" as a surname from a search of the Lexis/Nexis® USFind® data base. In that action, the examining attorney states that PINTRO, "... appears to be a relatively rare surname."

Examining Attorney's First Action at 2. In that action the examining attorney also indicated that she failed to find PINTRO in the American Heritage Dictionary of the English Language. Id. The examining attorney presented no further evidence with regard to the significance of PINTRO.

On this record, we conclude that "Pintro" is an extremely rare surname. In concluding so, we rely on the fact that only 24 examples of the Pintro surname were located from a comprehensive directory of the entire United States. In re Sava Research Corp., supra at 1381; In re Garan Inc., 3 USPQ2d 1537, 1540 (TTAB 1987). In fact, as applicant notes, at least fifteen of the 24 entries are concentrated in the New York State, or even in the New York City metropolitan area. Cf. In re United Distillers plc, 56 USPQ2d 1220, 1221 (TTAB 2000); In re Picone, 221 USPQ 93, 94 (TTAB 1984). Therefore, we conclude that Pintro is an extremely rare surname.

Applicant's Surname Use - Applicant has represented that no one connected with it has the Pintro surname. This point is not in dispute.

Other Meanings - The Examining Attorney argues that PINTRO has no meaning other than as a surname and offers the referenced dictionary evidence in support of this position. Applicant, on the other hand, argues that PINTRO is a coined term derived from two Spanish terms: "pintor" meaning "painter" and "pinto" meaning "piebald" or "having many colors."

The Examining Attorney notes that applicant has not provided any definitions to support this assertion. We

accept applicant's representation that PINTRO is a coined term at face value without regard to the assertions regarding the derivation. We question whether U.S. purchasers would recognize that the mark is derived from these Spanish terms, and consequently we have not relied on these assertions in reaching our conclusions in this case. This is unlike cases where the mark *is* a recognized foreign term, rather than a coined term *derived from* allegedly recognized foreign terms. Cf. In re Picone, 221 USPQ at 94; In re Carl Braun, Camerawerk, 124 USPQ 184, 185 (TTAB 1960).

On the same basis we reject applicant's further argument that potential purchasers would perceive the mark as suggestive in view of applicant's further assertion that the identified products are pre-painted. We find the connections between the foreign terms and the goods too tenuous under these circumstances to conclude that the mark would be perceived as suggestive.

As to the perceived meaning of PINTRO, lastly we note the absence of any evidence that any person with the Pintro surname has achieved any notoriety. That sort of evidence may indicate that the public would be more likely to perceive PINTRO as a surname. Cf. In re Gregory, 70 USPQ2d 1792, 1795 (TTAB 2004) (evidence of public figures

with Rogan surname found relevant to public perception).

"*Look and Feel*" - Lastly we must consider whether PINTRO has the "look and feel" of a surname, a critical factor in this case. As to this factor, the examining attorney argues that PINTRO has the look and feel of a surname stating, "Many surnames end with the letter 'O', for example, Amato, Bruno, Castro, DeMarco, Gallo, Romano. CASTRO even ends with the same last three letters as PINTRO." Examining Attorney's Brief at 5. Applicant disagrees.

We reject the examining attorney's argument that the mere fact that the mark ends in "O" imbues the mark with the look and feel of a surname. In fact, the only example the examining attorney offers with a common letter string of three letters is Castro. We also find this unpersuasive. We see no shared "pattern" such that the public would assume that PINTRO is a surname.

In the case of a very rare surname, we cannot assume that the purchasing public will recognize the mark as a surname based on exposure to the surname use. In re Garan Inc., supra at 1540. It is in the case of a rare surname that we need to weigh "look and feel" carefully, particularly where there is no "cue," such as a title, an initial or possessive form to signal that the term is a

surname. See, e.g., In re Nelson Souto Major Piquet, 5 USPQ2d 1367, 1368 (TTAB 1987). For example, certain surnames, though rare, resemble common surnames "in their structure and pronunciation." In In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988). We see no evidence that such is the case with PINTRO. Cf. In re United Distillers plc, supra at 1221. In this case, there is no evidence that relevant purchasers would be "preconditioned" to perceive PINTRO as a surname as with "Pirelli." In re Garan Inc., supra at 1540. Accordingly we find that PINTRO does not have the look and feel of a surname.

In sum, based on the record in this case, we conclude that the examining attorney has failed to meet the burden of establishing a prima facie case that PINTRO is primarily merely a surname. Accordingly, we conclude that PINTRO is not primarily merely a surname. Furthermore, at a minimum this record raises serious doubts as to the primary surname significance of PINTRO, and we must resolve any doubt in favor of applicant. In re Benthin Management GmbH, 37 USPQ2d at 1334.

Decision: The refusal to register applicant's mark on the ground that it is primarily merely a surname is reversed.