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Mailed:
March 20, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Productos Urman, S.A. de C.V.

Serial No. 78497796

Andrew G. DiNovo of DiNovo Price Ellwanger LLP for
Productos Urman, S.A. de C.V.

Sani Khouri, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Grendel, Kuhlke and Cataldo, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark URMAN (in standard character form) for goods
identified in the application (as amended) as "stationery,

and related paper products; namely, notebooks, binders, folders, desk sets and desktop organizers, paper and pads.”¹

The Trademark Examining Attorney has issued a final refusal to register applicant’s mark on the ground that the mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4).

Applicant has appealed the final refusal. After careful consideration of the evidence of record and the arguments of counsel, we reverse the refusal to register.

Trademark Act Section 2(e)(4) precludes registration on the Principal Register of a mark which is “primarily merely a surname.”² The determination of whether the mark is primarily merely a surname is made on a case-by-case basis. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Any doubt as to whether the mark is primarily merely a surname must be resolved in applicant’s favor. *In re Joint-Stock Co. “Baik”*, 84 USPQ2d 1921 (TTAB 2007); *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

¹ Serial No. 78497796, filed on October 11, 2004. The application is an intent-to-use application filed pursuant to Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Such a mark may be registered on the Principal Register if it has acquired distinctiveness under Trademark Act Section 2(f). The issue of acquired distinctiveness is not before us in this case.

We base our determination of whether a mark is primarily merely a surname on the evidence of record as it pertains to five factors: (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; (4) whether the mark has the "look and feel" of a surname; and (5) whether the degree of stylization of the mark negates its surname significance. *In re Joint-Stock Co. "Baik"*, *supra*; *In re Benthin Management GmbH*, *supra*. Considering the evidence of record in the present case, we find as follows.

Because applicant is seeking to register the mark in standard character format, the "stylization" factor is neutral in this case. There is no evidence that anyone connected with applicant has the surname URMAN, so that factor likewise is neutral in this case.

We turn next to the "rareness" factor. The Trademark Examining Attorney has made of record listings from the online directories Yahoo® People Search USA, Enformation People Finders, Switchboard®, WhitePages.com®, and namestatistics.com, which show that there are approximately two hundred listings for people in the United States who have the surname URMAN. Also of record are printouts of three pages of Google® "hit lists" (without printouts of

the referenced websites) which refer to approximately five persons with the surname URMAN. It appears from a printout of an entry for URMAN from the OneLook Dictionary Search that URMAN is ranked as the 22,565th most popular surname in the United States. It also appears from a website for "House of Names" that there is an "Urman" family crest.

Based on this evidence, we find that URMAN is an extremely rare surname in the United States. The Trademark Examining Attorney concedes that the surname URMAN "appears to be rare." This factor weighs against a finding that URMAN is primarily merely a surname.

Turning next to the "other meanings" factor, we find that there are no other non-surname meanings of URMAN which would be recognized as the primary meaning of the term in the United States. Applicant has presented evidence showing that URMAN is a Tatar word meaning "forest," that it is the name of a village in western Ukraine, that it is the name of a town in Syria, and that "Al Urman" is the name of a city in Egypt. We find that each of these other meanings of URMAN are obscure and highly unlikely to be known in the United States, let alone regarded as the primary significance of the term URMAN. Applicant has presented no evidence to the contrary. This factor weighs

in favor of a finding that URMAN is primarily merely a surname.

The last factor to consider is whether the mark has the "look and feel" of a surname. This determination necessarily is subjective. The Trademark Examining Attorney has submitted no evidence that there are other recognized surnames which are constructed similarly to URMAN and which would give URMAN the look and feel of a surname. We find that URMAN does not have the look and feel of a surname. If it does, it does so only slightly.

Balancing all of the pertinent factors, we conclude that URMAN is not primarily merely a surname. Although there appears to be no other non-surname significance of the word which would be recognized as its primary significance, we find that URMAN is an extremely rare surname. If it looks and feels like a surname, it does so only slightly, and not enough to outweigh the extreme rarity of the surname in our analysis and balancing of the factors.

In addition to the factors considered above, the Trademark Examining Attorney contends that applicant has "accepted the surname significance of the term" by virtue of the fact that applicant acceded in another URMAN

application to registration of the term on the Supplemental Register. We disagree.

As background, we note that applicant responded to the final surname refusal in this intent-to-use application by submitting (1) an amendment to allege use as to certain of the originally-identified goods; (2) a request to divide the original application, into a use-based child application covering the goods upon which applicant has used the mark, and a parent application which remains an intent-to-use application covering the goods upon which applicant has not used the mark; and (3) its continued arguments traversing the surname refusal as to both the parent application and the new child application. In the course of maintaining its substantive arguments against the surname refusal, applicant stated as follows: "While applicant disagrees with the refusal of registration on the basis that the mark is primarily merely a surname, ... if the Examining Attorney is not persuaded by Applicant's arguments on this issue, **in the alternative** Applicant respectfully requests that the [new child] application be amended to seek registration on the Supplemental Register..." (Emphasis added.)

Subsequently, the division of the original application was effected by means of the creation of a new child use-

based application, Serial No. 78978188. Apparently, the Trademark Examining Attorney was not persuaded by applicant's substantive arguments on the surname refusal, and therefore accepted applicant's alternative request for amendment of the child application to the Supplemental Register. The child application subsequently proceeded to registration of the mark on the Supplemental Register.

Because applicant's request for registration on the Supplemental Register, during the prosecution of this application prior to its separation from the child application, was expressly stated to be made in the alternative and only in the event that the Trademark Examining Attorney was not persuaded by applicant's continued arguments in support of registration of the mark on the Principal Register, we decline to find that applicant has conceded that its mark in this application is primarily merely a surname which is not registrable on the Principal Register. Distinguish *In re Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037 (TTAB 2005).

Moreover, even if we were to deem applicant's amendment of the child application to one seeking registration on the Supplemental Register to be an admission against interest on applicant's part with respect to the surname significance of its mark, we would treat

such admission not as dispositive but only as a factor to consider in our determination of whether URMAN is registrable on the Principal Register. That ultimate determination must be made by the Board based on all of the evidence of record, and any possible admission by applicant is not binding on the Board. See *In re Hester Industries, Inc.*, 230 USPQ 797 (TTAB 1986).

Based on all of the evidence of record and for the reasons discussed above, and notwithstanding any possible admission against interest on applicant's part, we find that URMAN is not primarily merely a surname and that it is registrable on the Principal Register in the parent application involved in this appeal. Any doubts as to the correctness of this conclusion are resolved in applicant's favor.

Decision: The refusal to register is reversed.