

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: November 18, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mittal Steel Technologies Ltd.

Serial No. 78979091

Mark H. Tidman of Arent Fox LLP for Mittal Steel
Technologies Ltd.

Christopher L. Buongiorno, Trademark Examining Attorney,
Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Grendel, Cataldo and Ritchie de Lorena,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On April 22, 2005, Mittal Steel Technologies, Ltd.
(applicant) filed an application to register the mark
MITTAL STEEL on the Principal Register in standard
characters for "land, air and sea transport services
provided by boat, ship, rail, tractor trailer and aircraft;
shipping of cargo and freight; storage of ore, metals and
alloys" in International Class 39; and "galvanizing
services for directly reducing iron; contract manufacturing
in the field of steel; steel tempering; steel casting;

contract manufacturing in the field of metal; metal tempering; metal casting" in International Class 40. Applicant asserts a bona fide intention to use the mark in commerce in connection with both classes of services as its basis for registration. In response to a requirement by the examining attorney, applicant has disclaimed STEEL apart from the mark as shown.

The 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, 15 U.S.C. §1052(e)(4), and contended that applicant's subsequent showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is insufficient to overcome the refusal to register. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed main briefs on the case.¹

While applicant's amendment to assert a claim under Section 2(f) is essentially a concession that its mark is not inherently distinctive, we nonetheless will consider the question, as argued by applicant in the alternative, of whether the examining attorney has established that MITTAL

¹ The involved application is the "child" of "parent" application Serial No. 78615002 for the mark MITTAL STEEL reciting goods in International Class 6.

Ser No. 78979091

STEEL is primarily merely a surname. See *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). See also TMEP §1212.02(b).

Refusal to Register Under Section 2(e)(4)

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. We must decide on the facts of each case whether the mark at issue is "primarily merely a surname" under the Act. See *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. See *Id.* If the examining attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant, to determine ultimately whether the mark is primarily merely a surname. See *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. See *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 sound" of a surname.

Id. at 1332-33. Because applicant seeks registration of MITTAL STEEL in standard character form, we need not consider the fifth *Benthin* factor here, that is, whether the manner in which the mark is displayed might negate any surname significance.

Rareness

With the first Office action, the examining attorney provided a summary and partial listing of 993 individuals having "Mittal" as a surname, retrieved from a search of the Lexis Nexis Combined Person Locator computer database, restricted to the five year period between November 21, 2000 and November 21, 2005. The examining attorney further submitted an advisory notice from his prior, unrestricted search of Lexis Nexis for "Mittal" as a surname, indicating that such search was "interrupted because it will return more than 3000 results."² In addition, the examining attorney provided a summary and partial listing of 493 individuals having "Mittal" as a surname, retrieved from a search of the Yahoo! People Search computer database. The

record is silent as to the extent to which the 493 individuals listed in the Yahoo! search are duplicative of the 993 listed in the Lexis Nexis search. Nonetheless, even if we assume that results of the Yahoo! search are completely duplicative of the Lexis Nexis search, there would appear to be a minimum of 993 individuals with the surname "Mittal" in the United States during the five year period between November 2000 and November 2005. Moreover, the examining attorney has submitted additional evidence from the Lexis Nexis computer database indicating that applicant is the largest steel producer in the world, and that Mr. Lakshmi Mittal, applicant's chairman and chief executive officer, is one of the world's wealthiest individuals.

Based upon the above evidence of record, we conclude that "Mittal," is not an extremely rare surname as argued by applicant, but rather is a rare surname. *See In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). *Cf. In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 (TTAB 2007). Nonetheless, a mark may be found to be primarily merely a surname even though it is not a common surname. *See In re Giger*, 78 USPQ2d 1405 (TTAB 2006). *See also In re E. Martoni Co.*, 78

² November 21, 2005 Office action, Attachment 3.

USPQ2d 589 (TTAB 1975); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988).

Applicant's Surname Use

As noted above, the examining attorney has made of record evidence that the surname "Mittal" is associated with applicant's chairman and chief executive officer. In addition, the examining attorney has made of record further Lexis Nexis evidence indicating that Mittal is associated with applicant's chief financial officer, Mr. Aditya Mittal.

Other Meanings

There is no evidence of record that "Mittal" has any meaning, either in English or a foreign language. Applicant asserts that "the purchasing public is more likely to have become familiar with MITTAL steel products and services than they are to know someone with the surname 'Mittal.'"³ However, this argument is an amplification of applicant's contention, addressed below, that MITTAL STEEL has acquired distinctiveness as a trademark, rather than an argument that "Mittal" has any meaning beyond surname or trademark significance. Nor does applicant's evidence of

³ Brief, p. 4.

acquired distinctiveness point to any other meaning of "Mittal" in any language.

Look and Sound

Lastly, we must determine whether MITTAL STEEL has the "look and sound" of a surname. We agree with the examining attorney that the presence of the generic, disclaimed term STEEL does not diminish the surname significance of MITTAL in applicant's mark. See *In re Hamilton Pharmaceuticals, Ltd.*, 27 USPQ2d 1939 (TTAB 1993). Further we are not persuaded by applicant's argument that the absence of initials, apostrophes, or other indicia necessarily diminishes the surname significance of applicant's mark. See, for example, *In re Yeley*, 85 USPQ2d 1150, 1154 (TTAB 2007) ("there is no *per se* rule that the addition of an initial(s) to a surname means that the mark is automatically primarily merely a surname. It depends on the principal or ordinary significance of the term, and that is a question of fact."); and *In re Taverniti, SARL*, 225 USPQ 1263, 1264 (TTAB 1985) ("we must decide the issue presented herein by considering all of the relevant facts and circumstances peculiar to this case").

While we acknowledge that this is a somewhat subjective factor, we nonetheless agree with the examining attorney that the term has the look and sound of a surname,

especially since the record shows that there are nearly one thousand individuals with the surname "Mittal;" that such term has no readily recognized meaning other than its surname significance; and that nothing in the record indicates that "Mittal" would be perceived as an initialism or acronym, or a coined term. Rather the term "appears to be a cohesive term with no meaning other than as a surname." *In re Gregory, supra*, 72 USPQ2d at 1796.

Balancing the various factors, we find that the four relevant factors bearing upon the issue herein favor a determination that the primary significance of the mark MITTAL STEEL to the purchasing public for applicant's services is that of a surname. We find, therefore, that the examining attorney has presented evidence sufficient to establish that applicant's mark is primarily merely a surname.

Applicant's Evidence of Acquired Distinctiveness

While this appeal involves an intent-to-use application, an intent-to-use applicant which has used its mark on related goods or services may nonetheless file a claim of acquired distinctiveness before filing an amendment to allege use or statement of use if the applicant can establish that, as a result of the applicant's use of the mark on other goods or services, the

mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001).

The Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

The required showing is essentially twofold. First, applicant must establish, through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce. All of the rules and legal precedent pertaining to such a showing in a use-based application are equally applicable in this context.... Second, applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999). *See also* Trademark Manual of Examining Procedure (TMEP) §1212.09(a) (4th ed. 2005).

Applying the standards enunciated herein, we begin by looking at applicant's claim of acquired distinctiveness in

Ser No. 78979091

connection with the goods or services upon which the term MITTAL STEEL has been used in commerce. The issue is whether applicant's use and promotion of MITTAL STEEL in connection with these goods or services over a period of time has been of such a nature and extent that the primary significance of the term in the minds of the consuming public is no longer primarily merely as a surname, but rather as an indication of the source of such goods and services. See *In re McDonald's Corp.*, 230 USPQ 304 (TTAB 1986); and *In re Advanced Spine Fixation Systems, Inc.*, 25 USPQ2d 1363 (TTAB 1992).

In this regard, applicant has submitted a declaration with exhibits regarding use of MITTAL STEEL. In the declaration, signed on December 21, 2006, applicant's director and financial controller, Shekhar Kumar Shara, attests as follows:

applicant is the largest producer and manufacturer of steel in the world, providing steel for numerous purposes and related galvanizing, storage and manufacturing services;

applicant, through its predecessors in interest, was founded in 1989 and has been operating worldwide, including in the United States, since early 2004;

Ser No. 78979091

since applicant's first use in early 2004 of its MITTAL marks to the date of the declaration, sales of its products and services in the United States have exceeded \$19.1 billion;

during the same time period, applicant has expended \$10 million on advertising and marketing its MITTAL marks in the United States in major general circulation newspapers and magazines as well as trade publications and the internet;

applicant employs over 300,000 people in more than 60 countries;

applicant's steel production represents approximately 10% of the world's crude steel production; and

in 2005, applicant's combined revenues were \$77.5 billion.

As exhibits to its declaration, applicant submitted excerpts of articles concerning applicant and its activities under its MITTAL STEEL mark from The New York Times, Washington Post, Wall Street Journal, Los Angeles Times, and Forbes, retrieved from the Westlaw computer database.

Applicant's showing of acquired distinctiveness demonstrates that it has made extensive use of MITTAL STEEL as a trademark in numerous countries throughout the world,

Ser No. 78979091

including the United States, since 2004. Applicant's showing further establishes that it has generated very substantial revenues under the MITTAL STEEL mark in the United States during that time and expended substantial amounts in advertising expenditures as well. Further, applicant's evidence establishes that it has generated significant media coverage for its goods and services under the MITTAL STEEL mark in major newspapers and magazines in the United States. These goods include various steel products and the services include producing and manufacturing steel as well as galvanizing and storage services related thereto.

As noted above, the services identified herein include: "land, air and sea transport services provided by boat, ship, rail, tractor trailer and aircraft; shipping of cargo and freight; storage of ore, metals and alloys" in International Class 39; and "galvanizing services for directly reducing iron; contract manufacturing in the field of steel; steel tempering; steel casting; contract manufacturing in the field of metal; metal tempering; metal casting" in International Class 40. Applicant has demonstrated that its MITTAL STEEL mark has acquired distinctiveness for goods and services including galvanizing, manufacturing and storage of steel products,

which are included among the services recited therein. Further, applicant's transportation, shipping, tempering and casting of iron and steel are related to the goods and services for which applicant has demonstrated that its MITTAL STEEL mark has acquired distinctiveness inasmuch as they are related to the production and manufacturing of steel products.

Accordingly, we find that applicant has established acquired distinctiveness for its MITTAL STEEL mark when used in association with the services which are the subject of applicant's application. See Trademark Rule 2.41(a).

The refusal to register on the Principal Register on the basis that applicant's mark is primarily merely a surname under Section 2(e)(4) is affirmed. However, the examining attorney's refusal to register on the ground that applicant has failed to prove the applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act is reversed.