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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 Locman S.p.a.

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Serial No. 79006905

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Kathleen A. Costigan of Hedman & Costigan, P.C. for Locman,  
S.p.a.

Gina M. Fink, Trademark Examining Attorney, Law Office 109  
(Dan Vavonese, Managing Attorney).

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Before Hairston, Zervas and Mermelstein, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Locman S.p.a. (an Italian corporation) has filed an  
application to register the mark MANTOVANI (standard  
character form) for goods ultimately identified as: <sup>1</sup>

Clocks; clocks in general; watches, not  
wristwatches; casings for clocks; ribbon fobs for  
watches and pocket watches; watchbands; jewelry  
and wristwatches and pocket watches; clocks and  
chronometric instruments, namely, chronometers,

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<sup>1</sup> Serial No. 79006905, filed April 22, 2004, based on an  
International registration, Registration No. 837695, under the  
provisions of the Madrid Protocol.

small watches, wristwatches, dial trains for time pieces; dials for clock and watch making; clockworks, namely, parts for clocks; dial trains for clockwork mechanisms; chronometers; sun dials; gear-trains for clock and watch making, clock hands for clock and watch-making, works of art, namely, figures, sculptures of precious metal; table plates of precious metal; pendulums for clock and watch making, barrels for clock and watch making, fastening chains for clocks, chronographs for use as clocks, chronoscopes, jewelry; cigar and cigarette cases of precious metal; tea caddies of precious metal; earrings, ornaments of precious metal; candlesticks of precious metal; tea caddies of precious metal; mesh bags of precious metals; cuff links; bracelets being jewelry, pendants, ampules of precious metal; busts of precious metal; glove compartments of precious metal, coffee services of precious metal, non-electric coffeepots of precious metal, candelabra of precious metal, candle holders made of precious metal, nutcrackers of precious metal, ashtrays of precious metal for smokers, fob chains being jewelry, cigar and cigarette holders for smoking purposes of precious metal, cigar chests of precious metal, jewelry boxes of precious metal, necklaces being jewelry, egg frames of precious metal, canisters for household use made of precious metal, tie clips, tie pins, small brooches of precious metal, diamonds, plated articles, namely, jewelry of precious metal, jewelry caskets of precious metal, chests for clocks, pins being jewelry, decorative and ornamental pins, needle holders of precious metal, cigar and cigarette holders of precious metal, clock cases, statuettes of precious metal, threads of precious metal being jewelry, filters for tea of precious metal, flasks of precious metal, trimmings for harnessing of precious metal, stemless glasses of precious metal, coupes made of precious metal, clocks, atomic clocks, electric clocks, oil cruets of precious metal, signboards of precious metal, iridium, ornaments made of ivory, rough or semi-processed black amber, tokens made of copper being jewelry, ingots of precious metal, medals, medallions

being jewelry, oil cruet sets of precious metal, unwrought or semi-wrought precious metals, collectible, commemorative coins, wristwatches and pocket watches; olivine, namely, precious stone; gold thread being jewelry, unwrought or beaten gold, hair ornaments of precious metal, ornaments made of black amber, osmium, palladium, ornaments being jewelry, ornaments made of silver, shoe ornaments of precious metal, tea strainers of precious metal, strainers of precious metal; wall clocks, pearls being jewelry; precious articles, namely, jewels, namely semi-precious stones, precious stones, cabarets in the nature of trays of precious metal for domestic purposes, platinum metal, dishes of precious metal, pepper pots of precious metal, match holders of precious metal, cigar and cigarette holders of precious metal, fancy key rings of precious metal; toothpick holders of precious metal, coin purses of precious metal, napkin holders of precious metal, tobacco tins of precious metal, powder compacts of precious metal, containers for household and kitchen use of precious metal, springs for clocks, alarm clocks, rhodium, rings for napkins of metals, rings for napkin holders of precious metal, ruthenium, salad bowls of precious metal, salt shakers of precious metal, objects of imitation gold, saucers of precious metal, soup bowls of precious metal, spinel, namely, precious stones, figures of precious metal, statuettes of precious metal, paste jewelry, sugar bowls of precious metal, coasters for glasses of precious metal, snuff boxes of precious metal, cups of precious metal, tea services of precious metal, teapots of precious metal, urns of precious metal; kitchen utensils of precious metal, namely, pot and pan scrapers, rolling pins, spatulas, turners, whisks; pots of precious metal, glasses for clocks in International Class 14; and

Bags, namely, all purpose sport bags, all purpose carrying bags, all purpose athletic bags, beach bags, belt bags, book bags; handbags; suitcases; backpacks; wallets; coin purses; briefcases; attache cases of skin and skin substitutes; pouches of leather, drawstring pouches, felt

pouches; trunks; animal skins, shopping bags made of skin; leather goods made of skin, namely, leather briefcases, leather cases for keys, leather for shoes, leather handbags, leather purses, leather shopping bags, pouches of leather, traveling bags, traveling cases of leather; animal skin and leather imitations made thereof; parasols; beach parasols; umbrellas; walking sticks; harnessing trimmings, namely, animal harnesses, bits, leather for harnesses and other saddlery articles, namely, saddlery of leather in International Class 18.

Registration has been finally refused under Section 2(e)(4) of the Trademark Act on the ground that the mark applicant seeks to register is primarily merely a surname.

Applicant has appealed. Applicant and the trademark examining attorney have filed briefs, and applicant filed a reply brief. We affirm the refusal to register.

The initial burden is on the examining attorney to establish a prima facie case that a mark is primarily merely a surname. If a prima facie case is established, the burden then shifts to the applicant to rebut the showing made by the examining attorney. The question of whether a term sought to be registered is primarily merely a surname may only be resolved on a case by case basis. See *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993).

The factors to be considered in determining whether a term is primarily merely a surname are the following:

- (1) The degree of a surname's rareness;
- (2) Whether anyone connected with the applicant has that surname;
- (3) Whether the word has any recognized meaning other than that of a surname; and
- (4) Whether the word has the look and sound of a surname.<sup>2</sup>

See *In re Benthin Management GmbH*, 37 USPQ2d 1332

(TTAB 1995).

In this case, we agree with the examining attorney that the record contains sufficient evidence to make a prima facie case that the primary significance of the mark MANTOVANI to the purchasing public for applicant's goods is that of a surname and that such showing has not been rebutted by applicant. Specifically, the examining attorney furnished evidence that a search of the LexisNexis ("USFIND Person Locator-Nationwide") database returned 153 residential listings of individuals with the surname "Mantovani" (a printout of 99 of the retrieved listings was included); the results of a "Google" search for "mantovani" which returned "hits" or website links for Annunzio Paolo Mantovani; Al Mantovani & Sons; Bráulio Mantovani; Maria Domenica Mantovani; and Luiz Mantovani; and an entry in

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<sup>2</sup> A fifth factor, not present in this case, concerns whether a mark which is presented in a stylized form is distinctive enough to create a separate non-surname impression.

Wikipedia, an online encyclopedia, for "Mantovani"  
[**Mantovani**, born **Annuzio Paolo Mantovani** (November 15, 1905-March 29, 1980 was a popular conductor and entertainer in the "easy listening style."]. In addition, the examining attorney submitted printouts from several on-line dictionaries that show no entries for the word "mantovani," and a third-party registration, Registration No. 2577602 for the mark MANTOVANI for sauces, condiments and spices, which issued under Section 2(f).

Applicant, with respect to its position, submitted a page from the Manhattan "White pages" showing two residential listings for persons with the surname "Mantovani," and a printout from the U.S. Census Bureau website estimating the U.S. population at approximately 296 million. Applicant argues that the evidence of record shows that "Mantovani" is only very rarely used as a surname.

Although the record shows that MANTOVANI is indeed a rare surname, it is nonetheless the case that even a rare surname is unregistrable (absent a showing of acquired distinctiveness) if its primary significance to purchasers is that of a surname. See, e.g., *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985).

Further, this Board has held that "there is no minimum number of directory listing required to establish a prima facie case" in support of a surname refusal. In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988). See also In re Gregory, 70 USPQ2d 1792, 1795 (TTAB 2004) (no "per se benchmark" as to minimum number of listings); and In re Petrin Corp., 231 USPQ 902 (TTAB 1986).

We find, therefore, that the searches of the LexisNexis database and "Google," the Wikipedia entry, and the "negative" dictionary evidence, are sufficient to establish the surname significance of the mark MONTAVANI to the relevant purchasing public. In sum, the Board finds that the examining attorney's evidence is sufficient to establish a prima facie showing.

Further, this Board has held that the fact that a term is the surname of an individual associated with the applicant is strong evidence of the surname significance of the term. See e.g., In re Industrie Pirelli Societa per Azioni, supra. In this case, applicant acknowledges that "Mantovani" is the name of a principal of applicant. (Brief at 5). In this regard, the examining attorney submitted printouts from applicant's website which state "LOCMAN Italy - Founded in 1986 by Marco Mantovani, LOCMAN

watch brand has been on the cutting edge of design and style, sparking trends with its innovative timepieces." The fact that "Mantovani" is the surname of applicant's founder weighs heavily in favor of a surname finding.

Applicant also contends that its mark has meaning other than as a surname. Specifically, applicant argues that "[Mantovani] is both the name of a principle [sic] of the Applicant corporation and a registered trademark of the Applicant corporation. The mark has been registered in the European Community Trademark Office." (Brief at 5).

However, contrary to applicant's argument, and as noted above, the fact that a term is the surname of an individual associated with the applicant is strong evidence of the surname significance of the term. Further, the fact that applicant has registered the term MANTOVANI in the European Community Trademark Office does not serve to establish that the term has another recognized meaning as contemplated by the third Benthin factor. In considering this factor, the Board has looked to whether there is evidence that the term has any other meaning in English or another language or if it is an acronym. See e.g. *In re Monotype Corp.*, 14 USPQ2d 1070 (TTAB 1989) [The Board considered the fact that CALISTO was the variant spelling of the Greek mythological nymph "Callisto" in determining that the term was not

primarily merely a surname]; In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994) [The Board considered the applicant's argument that the term SAVA was an acronym for "Securing America's Valuable Assets" in determining that the term was not primarily merely a surname]; and In re Isabella Fiore LLC, 75 USPQ2d 1564 (TTAB 2005) [The Board considered the fact that the term FIORE means "flower" in Italian in determining that the term was not merely a surname]. In this case, there is no evidence that MANTOVANI has another recognized meaning, and in the absence thereof, this factor favors a finding that the mark MANTOVANI is primarily merely a surname.

Further, applicant contends that its mark lacks the "look and feel" of a surname. The examining attorney, however, argues that MANTOVANI looks and sounds like an Italian surname, and that it is similar to the surname, "Montovani." The examining attorney submitted evidence that a search of the LexisNexis ("USFIND Person Locator-Nationwide") database returned 29 residential listings of individuals with the surname "Montovani." The record here shows that "Mantovani" is, in fact, a surname. It the surname of applicant's founder. Under this admittedly subjective factor, we find that "MANTOVANI" has the structure and sound of a surname of Italian heritage.

Two additional arguments made by applicant require comment:

Again the Applicant submits that this mark is known to the purchasing public as the identifying mark of a line of quality merchandise. In particular, MANTOVANI watches are well known to the purchasing public.

Applicant also submits that, in the world of design, it is common for the designer to use one or both names to mark their goods. The purchasing public has come to accept the trademarks, ARMANI, MISSONI, DOLCE & GABBANA, TRUSSARDI and VERSACE.  
(Brief at 4).

In support of these arguments, applicant has offered printouts from an Internet website at which its watches are sold, and copies of seven third-party applications and three third-party registrations for such marks as ARMANI, GORGIO ARMANI, MISSONI and design, DOLCE & GABBANA, TRUSSARDI and design and VERSACE, each for a variety of goods.

With respect to applicant's first point that its MANTOVANI mark is well known, evidence of the "fame" of applicant's mark would certainly be a relevant factor in establishing distinctiveness under Section 2(f) of the Trademark Act. However, applicant has not claimed the benefits of Section 2(f) and, without a formal claim of distinctiveness under Section 2(f), evidence that

applicant's mark is well known cannot serve as the basis for allowing registration of applicant's mark.<sup>3</sup>

With respect to applicant's second point, we are certainly aware that it is a common practice for fashion designers to market clothing and other goods under their surnames. It is still the case, however, that a surname, even of a designer, will be unregistrable if its primary significance to purchasers is that of a surname, in the absence of a showing of acquired distinctiveness.

Insofar as the applications and registrations submitted by applicant are concerned, they do not persuade us to reach a different result herein. The applications are evidence only of the fact that such applications were filed. Insofar as the three third-party registrations are concerned, we note that the marks DOLCE & GABANNA in Registration No. 2148585 and GORGIO ARMANI in Registration No. 2890116 are not primarily merely surnames, and the registration for VERSACE (Registration No. 2440541) issued under the provisions of Section 2(f). In short, these applications and registrations do not support applicant's

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<sup>3</sup> We note that the examining attorney directed applicant's attention to possibly seeking registration under the provisions of Section 2(f).

position that it is entitled to registration in this case. In any event, it is well settled that each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]

**Decision:** The refusal to register applicant's mark under Section 2(e)(4) is affirmed.