

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: June 4, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re The Hyman Companies Inc.*  
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Serial No. 85483695  
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Timothy D. Pecsenty of Blank Rome LLP,  
for The Hyman Companies Inc.

Rebecca A. Smith, Trademark Examining Attorney, Law Office 110,  
Chris A. F. Pedersen, Managing Attorney.

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Before Seeherman, Kuhlke and Lykos,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

The Hyman Companies Inc. (“Applicant”) seeks registration on the Principal Register of the mark **ROMANÓV** (in standard characters) for, as amended, “decorative eggs made of non-precious metals” in International Class 6; “jewelry; table clocks; decorative eggs made of precious materials” in International Class 14; “picture frames” in International Class 20; and “decorative porcelain boxes” in International Class 21.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85483695, filed November 30, 2011, pursuant to Section 1(b) of the Trademark Act.

The Trademark Examining Attorney has refused registration of Applicant's mark pursuant to Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that the applied-for mark is primarily merely a surname. For the reasons set forth below, we reverse the refusal to register.

Section 2(e)(4) of the Trademark Act of 1946 provides that absent a showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), registration must be refused on the Principal Register if the proposed mark is "primarily merely a surname." "The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis." *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Office bears the initial burden of establishing a *prima facie* case that a proposed mark is "primarily merely a surname." *Id.* (internal citations omitted). If the Examining Attorney establishes a *prima facie* case, the burden shifts to Applicant to rebut the showing made by the Examining Attorney. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993).

*In re Benthin Management GmbH*, 37 USPQ2d 1332, 1335 (TTAB 1995), sets forth five factors, four of which are relevant here, to consider in determining whether a proposed mark is primarily merely a surname:

1. The degree of the surname's "rareness";
2. Whether anyone connected with the applicant has the involved term 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.<sup>2</sup>

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<sup>2</sup> We need not consider the fifth *Benthin* factor, whether the manner in which the mark is displayed might negate any surname significance, because Applicant applied to register the mark "ROMANÓV" in standard character form.

Our focus is on the impact the term has or would have on the purchasing public because “it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname.” *In re Isabella Fiore LLC*, 75 USPQ 1564, 1565 (TTAB 2005) (emphasis in original), quoting *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975).

1. *The Degree of the Surname’s “Rareness”*

The Examining Attorney argues that **ROMANÓV** is a common, not rare, surname. In support of this assertion, the Examining Attorney submitted the search results from the website *411.com Free Directory Assistance* (www.411.com), showing “100+ Results” for the surname ROMANÓV, and attached nine of these individual listings as illustrations. March 14, 2012 Office Action.

The record reflects that the *411.com Free Directory Assistance* website is “powered by White Pages.” *Id.* While we do not have specific information in the record regarding the size of either the *411.com* or *White Pages* databases, it would appear that they include directory listings for those who have telephone land lines. We also do not have information in the record explaining the numerical significance of “100+ Results” – whether it means a few more results than 100 or thousands more than 100. Since it is the Examining Attorney’s initial burden to demonstrate the surname significance of a mark, we give Applicant the benefit of the doubt and assume the former. With this in mind, the Examining Attorney’s submissions from

the *411.com* database do not support a finding that **ROMANÓV** is a common surname but rather the contrary, that Applicant's proposed mark is a rare surname. *See, e.g., In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921 (TTAB 2007) (the surname "Baik" was found to be an "extremely rare surname" based on a listing of 456 individuals with that surname in the Verizon superpages.com database); *In re Yeley*, 85 USPQ2d 1150 (TTAB 2007) (YELEY found to be rare surname based on listing of 147 individuals from directory of entire United States).

*2. Whether anyone connected with the applicant has the involved term as a surname*

Applicant contends that the fact that no person connected with Applicant bears the surname **ROMANÓV** weighs in favor of finding that it is not primarily merely a surname. While the second factor alone is not determinative, it is undisputed that no one connected with Applicant has the surname **ROMANÓV**.

*3. Whether the mark has any recognized meaning other than as a surname*

Applicant argues that because **ROMANÓV** is a name of historical significance identifying the House of Romanov, the imperial dynasty that ruled Russia from 1613 to 1917, it is not primarily merely a surname.<sup>3</sup> On the other hand, the Examining Attorney contends that because **ROMANÓV** has "no dictionary definition or meaning, either obscure or readily recognized," it has no significance other than as a surname.

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<sup>3</sup> The Examining Attorney submitted an entry from *Wikipedia* for "House of ROMANÓV" as referring to "the second and last imperial dynasty to rule over Russia, reigning from 1613 until the February Revolution abolished the crown in 1917." March 14, 2012 Office Action.

The Examining Attorney also argues that because **ROMANÓV** does not refer to “one highly famous individual” but rather several from the House of Romanov (for example Peter the Great, Catherine the Great, and Nicholas II), it remains primarily merely a surname. Specifically, the Examining Attorney maintains that the term refers to

a well-known family dynasty in Russia where many members of this dynasty bore the name Romanov. Hence, consumers would not associate this name with any one particular famous person in history. They would understand the term to refer to a surname that also happens to be the surname of a famous family dynasty in Russia. The fact that the name is well known in reference to this particular Russian dynasty makes it more likely for consumers to believe that the term is a surname with no other significance.

We are compelled to point out that the Examining Attorney’s assertion that there exists no dictionary definition for the term “Romanov” is belied by the Examining Attorney’s own evidence set forth below:

- An entry for “Romanov” from *The Free Dictionary By Farlex* ([www.thefreedictionary.com](http://www.thefreedictionary.com)) defining the term as the “Russian ruling dynasty (1613-1917) that began with the accession of Czar Michael (1596-1645, ruled 1613-1645) and ended with the abdication of Nicholas II during the Russian Revolution”<sup>4</sup> or alternatively as “1. a member of the imperial family that ruled Russia from 1613 to 1917;”<sup>5</sup> and
- An entry for “Romanov” from the online encyclopedia *infoplease* ([www.infoplease.com](http://www.infoplease.com)) defining the term as the “ruling dynasty of Russia from 1613 to 1917. The name Romanov was adopted in the 16<sup>th</sup> cent. by a family of boyars (great nobles) that traced its beginnings to the 14<sup>th</sup> cent.”

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<sup>4</sup> This Internet dictionary definition is derived from *The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).

<sup>5</sup> This Internet dictionary definition is derived from *Random House Kernerman Webster’s College Dictionary* (2010).

Clearly, U.S. English dictionary entries for the term **ROMANÓV** do indeed exist, and more importantly, they show that the term is recognized as identifying the Russian imperial dynasty that ruled from 1613-1917. While it is obvious that the dynasty derived its name from the surname of its members, and that the converse is true as well (that is to say that members of that dynasty bear that surname), this is distinct from the overall impact or impression of the term. Simply put, the term **ROMANÓV** has significance apart from a surname as the designation of the Russian imperial dynasty. This is especially true when considered within the context of Applicant's identified goods of "decorative eggs made of non-precious metals;" "jewelry; table clocks; decorative eggs made of precious materials;" "picture frames;" and "decorative porcelain boxes," items associated with royalty, and in particular the Romanov imperial dynasty. *See* entry from *Wikipedia* for "Romanov family jewelry" discussing the return of the Romanov family jewelry by Sweden. March 14, 2012 Office Action.

We note that both Applicant and the Examining Attorney have discussed the surname case law pertaining to historical figures,<sup>6</sup> and in particular the passage from *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1290 (TTAB 2007) (holding WATSON primarily merely a surname) embodied in TMEP § 1211.01(a)(iv) (April

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<sup>6</sup> *See Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (holding SOUSA for fireworks and production of events and shows featuring pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant's goods and services were of a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music").

2014) that “a surname that would not be evocative of a particular historical individual but, rather, would be more evocative of numerous individuals, does not qualify for registration as a historical name and is merely a surname of numerous individuals with varying degrees of historical significance.” Given, however, that the record clearly shows that the term **ROMANÓV** is synonymous with the imperial Russian dynasty we need not address the applicability of this line of case law here. Consumers encountering Applicant’s mark are more likely to think of the House of Romanov, and not a particular famous individual or individuals bearing that surname.

*4. Whether the mark has the “look and sound” of a surname*

This fourth factor is highly subjective, and involves whether Applicant’s proposed mark has the “structure and pronunciation” or “the look and sound” of a surname. *Benthin Management GmbH*, 37 USPQ2d at 1333. “[C]ertain rare surnames look like surnames, and certain rare surnames do not ....” *Id.* The Examining Attorney submitted an excerpt obtained from the web site *House of Names.com* of the “Romanov Surname History,” explaining the early origins and history of the surname. April 29, 2013 Final Office Action. *See also* excerpt from the website *Familypedia* “Romanov surname.” The suffix “-ov” evokes the Russian language and is common to Russian surnames. For this reason, we find that **ROMANÓV** has the structure and pronunciation and therefore the “look and feel” of a surname.

To summarize, we have determined that Applicant's mark is a rare surname and that no one associated with Applicant bears that surname. These factors, coupled with our determination that prospective consumers encountering the mark **ROMANÓV** will perceive the mark as identifying the imperial ruling dynasty of Russia, leads us to find that the Office failed to demonstrate that Applicant's mark is "primarily merely a surname."

**Decision:** The refusal to register Applicant's mark **ROMANÓV** under Section 2(e)(4) is reversed.

Seeherman, Administrative Trademark Judge, concurring:

I agree with the majority that the refusal of registration should be reversed. Because, on this record, **ROMANÓV** must be treated as an extremely rare surname, that fact alone should be a sufficient basis on which to find the mark registrable. As I stated in my concurring opinion in *Joint-Stock Co. "Baik"*, 84 USPQ2d at 1924, the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses, and therefore, if a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant. The evidence that **ROMANÓV** has the meaning of the Russian dynasty merely provides an additional reason for reversing the refusal of registration.