

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
Ibrahim Mohammed : Examining Attorney: Daniel Stringer
: :
Serial No.: 86865356 :
: Law Office: 103
Filed: January 05, 2016 :
: :
Mark: CORLEONE FORGED :
: :
_____ :

Commissioner for Trademarks
P.O. Box 1451
Alexandria VA 22313-1451

RESPONSE TO OFFICE ACTION

COMES NOW, Ibrahim Mohammed (hereinafter the “Applicant”) by Counsel Travis Wilson of The Law Office of Travis Wilson, and submits this response to the Examining Attorney’s refusal to the instant application on the grounds of Trademark Act Section 2(e)(4) 15 U.S.C. §6 1052 (e)(4); *see* TMEP §1211, stating as follows:

ARGUMENT IN SUPPORT OF REGISTRATION

Section 2(e)(4) Refusal

The Examining Attorney refused registration of CORLEONE FORGED on the basis that CORLEONE is primarily a surname.

In support of the refusal, the Examining Attorney cites LexisNexis public records where CORLEONE appears 418 times as a surname of individuals.

While the Examining Attorney may consider 418 a large sum, relative to the population of the United States which according to the US Census, is at 322,761, 807 as of January, 2016. The results of the US Census measuring the population as of January 2016 is attached as Exhibit 1. *See* Exhibit 1. Relative to 322,761, 807, the number cited by the Examining Attorney is insignificant. Of the 418 CORLEONE surnames, .00000130 of the entire US population, at 322, 761, 807, uses CORLEONE as a surname. Given this small number in relation to the entire population, the argument that CORLEONE is primarily a surname is untenable.

We submit our own searches for the surname CORLEONE using 411 and the 50States.Com. The 411 search results yield 133 matches for the surname CORLEONE and 68 results from 50States.Com. The 411 and 50States.Com searches are attached as Exhibits 2 – 3, respectively. *See* Exhibits 2-3. CORLEONE is not even listed among the 10 frequently occurring surnames in America, per the United States Census. CORLEONE is not among the top 1002 surnames, also based on United States Census. The 10 most frequently occurring surnames list of the surnames and the Excel spreadsheet of the top 1000 surnames in America is attached as Exhibits 4 – 5. *See* Exhibits 4-5.

In recent years the Board has placed great weight on the rareness factor. In reversing a surname refusal of BAIK, the Board remarked that “Baik is an extremely rare surname. In concluding so, we rely on the fact that only 456 examples of the Baik surname were located from a comprehensive directory of the entire United States.” *In re Joint-Stock Company “Baik”*, 84 U.S.P.Q.2d 1921, 1923 (T.T.A.B. 2007).

In 2009 the Board reversed a surname refusal of BERGFELD for wine, explaining that it was giving the rareness factor “much more weight than the other three factors”:

We find, based on the evidence, that BERGFELD is an extremely rare surname. Although the examining attorney submitted evidence showing use of the surname “Bergfeld” in commerce by different individuals, **she was only able to produce evidence indicating there are fewer than 300 individuals with that surname after searching two comprehensive databases. (. . .)**

In balancing the aforementioned factors, we make no secret that the first factor, rareness of the surname, has been given much more weight than the other three factors. And, in doing so, we find that any slight tilt toward finding the mark as being primarily a surname based on the other factors is outweighed by the fact that there are fewer than 300 persons with the surname “Bergfeld.” Ultimately, we conclude that applicant’s proposed mark, BERGFELD, is so rarely used as a surname, and that the remaining *Benthin* factors provide little additional support for a finding that it would be so perceived by consumers, that it is not primarily merely a surname.

In re Hall Wines, LLC, Serial No. 78926151 (T.T.A.B. February 10, 2009) (non-precedential) (bolding added).

Likewise, in another recent decision that involved approximately 150 surname listings, the Board found the applied-for mark AMLIN to be “an *extremely* rare surname” and reversed the refusal:

Applicant argues that “Amlin” is an *extremely* rare surname while the Trademark Examining Attorney contends that it is a *relatively* rare surname. Eliminating the unavoidable duplication in the databases and choosing a midrange of one-hundred-fifty separate listings in the entire United States, we are looking at a surname for only one in every two million individuals in the U.S. population. Hence, we agree with applicant that “Amlin” is such an *extremely* rare surname that few prospective consumers are likely to perceive it as a surname, and substantially no one will be adversely affected by the registration of this term for the recited services.

In re Amlin plc, Serial No. 79011475 (T.T.A.B. September 30, 2008) (non-precedential).

In the present case, the evidence attached by Examining Attorney demonstrates that there are 12,225 individuals in the entire United States with the surname LANGDON strongly supports Applicant’s position that the term “LANGDON” in its mark LANGDON

DESIGNS is not primarily merely a surname within the meaning of Section 2(e)(4). That is, “the word ‘primarily’ was added to ‘merely’ with the clear ‘intent . . . to draft a provision which would prevent a refusal to register only because a surname was found in a directory to be the name of somebody somewhere.’” *In re Garan Inc.*, 3 U.S.P.Q.2d 1537, 1539 (T.T.A.B. 1987) (quoting *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm’r Pats. 1955)).

While Applicant is certainly mindful that determinations are made on a case-by-case basis, Applicant respectfully submits that the rarity of CORLEONE as a surname.

We note the Examining Attorney’s reference to the Corleone family per the referenced Wikipedia entry https://en.wikipedia.org/wiki/Corleone_family. The Wikipedia entry expressly states that the Corleone family is a fictitious Sicilian Family based in New York City. Given the popularity of both the novel and the movies, consumers are aware that Corleone are characters in the book and movies, and not a real life persons. We would submit that the name Corleone evokes qualities and nuances based on the characters in the movie, e.g., strong, powerful, influential, wealthy and with roots in the underground.

Per T.M.E.P. § 1211.01(a)(vi).

[C]ertain surnames are so rare that they do not even have the appearance of surnames. In such cases, even in the absence of non-surname significance, a reasonable application of the “primary significance to the purchasing public” test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful.

In light of the demonstrated rarity of CORLEONE as a surname, and the likelihood of consumers to appreciate CORLEONE beyond its surname significance, CORLEONE

FORGED is arbitrary as used on Tires, Wheel rims, Wheels.

The Board has held:

While a significant non-surname meaning usually helps the position of an applicant, we find that the converse (i.e., a determination that the involved term does not have any non-surname meaning) does not help significantly the position of the Trademark Examining Attorney.

CONCLUSION

In light of the fact that only 418 people in the United States possess the surname CORLEONE, Applicant respectfully submits that CORLEONE is not primarily a surname within the meaning of Section 2(e)(4).

WHEREFORE it is respectfully requested that the Examining Attorney withdraw his objection, uphold the Applicant's submission that the mark CORLEONE is not primarily merely a surname within the meaning of Section 2(e)(4) and approve the instant application for publication upon the Principal Register.

Respectfully submitted this 26th day of October, 2016

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