

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION**

In re U.S. Trademark Application

Mark: 

Applicant: Pirelli & C. S.p.A.

Application Serial No.: 88/149,213

Filing Date: October 10, 2018

Attorney Reference: 140232.437150

Examining Attorney: Harini Ganesh, Esq., Law Office 122

**RESPONSE TO NON-FINAL OFFICE ACTION**

This is in response to the Examining Attorney's office action of November 26, 2018 (the "Office Action"). In the Office Action, the Examining Attorney issued a refusal of registration pursuant to Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4) based on a non-final determination that the Mark is primarily merely a surname. Applicant's response to the refusal is below.

**Non-final Refusal of Registration Pursuant to Trademark Act §2(e)(4)**

Applicant respectfully asserts that the Mark is not primarily merely a surname per USPTO requirements. As set forth in Trademark Manual of Examining Procedure (TMEP) §1211.01(b)(ii), a mark that contains a **distinctive stylization or** design element is **not** considered primarily merely a surname. The Examining Attorney has acknowledged in the Office Action that the Mark contains stylization, and the evidence herein will show that the stylization is distinctive and that the refusal therefore must be withdrawn per TMEP §1211.01(b)(ii).

Specifically, the evidence cited herein will show the following reasons the Mark is not primarily merely a surname:

- The Mark was intentionally designed to be distinctive, and its stylization has been specifically designated as “distinctive” by multiple experts in the study of logos;
- The distinctive stylization of the Mark conveys a specific suggestive connotation of a stretched material in the nature of Applicant’s original rubber products;
- The USPTO has officially recognized the highly stylized elongated “P” element of the Mark as an inherently distinctive mark and has granted registration on the Principal Register;
- The elongated stylized “P” design element alone is so distinctive that it has conveyed the goodwill of the entire Mark, and
- “Pirelli” is a rare surname.

**1. The stylization of the Mark is specifically designed to be distinctive.**

The Mark consists of a stylized representation of PIRELLI, in which the letter “P” is conspicuously elongated to extend over top of all the other letters and differs substantially from the other letters in its proportions. The lines that form the elongated “P” are also varied in thickness in a way that intentionally mimics rubber that has been stretched from end to end (representing Applicant’s original core products of premium tires and rubber goods). From its inception over 100 years ago, the elongated “P” has been an eye-catching and distinctive trademark element that creates a separate commercial impression from that of the name alone.

The origin of the Mark is documented in the book *Logo Life: Life Histories of 100 Famous Logos*,<sup>1</sup> which describes the Mark as having originated from a “request from an American Pirelli representative to come up with a distinctive and memorable logo” (emphasis added), resulting in the idea of “stretching out the initial P to form a roof over the other characters of the brand name.” The same passage goes on to say the “**elongated P with its**

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<sup>1</sup> Ron van der Vlugt, *Logo Life: Life Histories of 100 Famous Logos* 240-41 (2012).

**clever shift from thick to thin and back was a highly evocative way to portray the elasticity of Pirelli's premium products.**” This intentional correlation between the specific *stylization* of the Mark and a suggestive connotation with respect to the goods shows that the distinctive stylization of the Mark has trademark significance of its own. Note the “clever” and “evocative” suggestive quality is created solely by the distinctive stylization alone and has nothing to do with any surname significance.

Further evidence of stylization’s distinctiveness may be found in the fact that the Mark was selected for inclusion in the reference book, *Logo: The Reference Guide to Symbols and Logotypes*.<sup>2</sup> The author, who has cataloged over 1,300 identifying symbols and logotypes, describes the stylization of the Mark as follows: “A **distinctive**, stretched ‘P’ for the Milan-based company that started out in life as a tyre and cable maker and has now moved into property, photonics, and new materials.” (emphasis added)

It is important to note that the reference book above, described as a “complete, taxonomical guide to the history, development and style of identity design,”<sup>3</sup> is focused solely on distinctive logos and logotypes as indicators of source, not the distinctiveness of brand names. The inclusion of the Mark in such a reference book therefore does not pertain to the distinctiveness of PIRELLI as a literal element or surname. The book is instead focused on logos as indicators of source based on their stylization alone, in the sense of “identity design.”

The book attests to the fact that the *stylization* of the Mark serves as an indicator of source separate from wording or other literal elements. The fact that a leading expert in the study of logos selected the Mark for inclusion in a logo reference guide and specifically described it as visually “distinctive” is substantial evidence that the Mark contains distinctive

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<sup>2</sup> Michael Evamy, *Logo: The Reference Guide to Symbols and Logotypes* (2007).

<sup>3</sup> *Id.*

stylization that creates a separate commercial impression from that of a surname alone. As such, the mark cannot be “primarily merely a surname” and is not subject to refusal pursuant to Trademark Act §2(e)(4).

**2. The elongated “P” has been deemed an inherently distinctive mark.**

Even without a specific suggestive correlation to particular goods, the striking appearance of the elongated “P” would cause the mark to be much more highly distinctive than a surname alone.

The fact that the distinctive stylization creates a separate commercial impression from the name is further borne out by the fact that the distinctive elongated “P” in the Mark has itself been deemed by the USPTO to be an inherently distinctive trademark. It is the subject of an incontestable Principal Register registration, U.S. Reg. No. 1,960,068, which has been in force since 1996. A copy of the registration certificate is attached as Exhibit A.

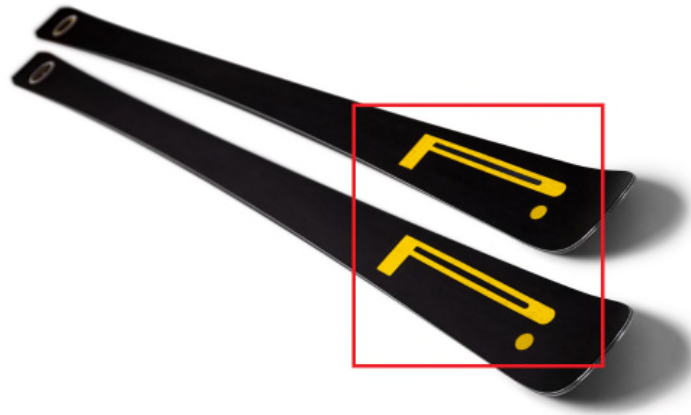
Additional evidence of this fact may be found in yet another reference book, *The World’s Greatest Brands*,<sup>4</sup> which refers to the distinctive nature of the Mark in this way: “Like the majority of long-established brands, Pirelli has adapted its logo to suit the evolution of styles and fashion, but the **elongated P** has remained consistent throughout, an **instantly recognizable** hallmark of quality and familiarity.” (emphasis added) Since the elongated “P” that is an integral part of the Mark is an “instantly recognizable” and inherently distinctive indicator of source, the unitary Mark as a whole must be inherently distinctive.

It is also important to note that the inherently distinctive “P” in the Mark is an integral part of Applicant’s coordinated branding scheme. For example, it is used on such diverse Pirelli

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<sup>4</sup> Nicholas Kochan, et al., *The World’s Greatest Brands* 134 (1996).

goods as snow skis, automobile wheels (as trade dress for wheel spokes) and footwear, as shown in the following photographs:





The distinctive Mark has even been celebrated at public events, such as re-creating only the elongated “P” with a configuration of over 40 cars<sup>5</sup> to represent the PIRELLI brand, as shown below.



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<sup>5</sup> See, <https://audiclubna.org/pirelli-parks-40-gt3-cars-at-monza-just-for-fun/> and <https://www.intercontinentalgtchallenge.com/news/1247/pirelli-recreates-its-world-famous-logo-using-more-than-40-gt3-cars-at-monza> (images captured February 8, 2019).

The reason this re-creation is significant is that it shows the elongated “P” creates a separate commercial impression, such that the “P” even standing alone conveys to the purchasing public that it unmistakably represents the complete Mark. If it were not so distinctive, it would not have this secondary meaning.

**3. The evidence of record shows that “Pirelli” is a rare surname.**

Although the primary reason the refusal must be withdrawn is that the Mark contains stylization that has been specifically recognized as distinctive by experts and creates a separate commercial impression from that of a surname, it also should be noted that the evidence of record does not establish anything more than the fact that “Pirelli” is a rare surname. The relevant evidence of record consists of database entries for only 219 possible individuals with the surname “Pirelli” in the entire United States. While the TTAB has occasionally found marks to be primarily merely a surname with very low numbers of incidence in the general population, it is important to consider that those cases do not mean that even low numbers of incidence cause a mark to be primarily merely a surname. The determination must be based on the totality of circumstances, and the TTAB has found even much higher numbers to be insufficient in many other cases.

In cases in which the TTAB has found a mark to be primarily merely a surname despite low directory listing numbers, the low numbers typically are counterbalanced by strong evidence that the name has otherwise become widely known by the purchasing public as a surname through other public exposure, such as being the surname of noted celebrities or other individuals in the public eye. No such evidence exists in this case.

Even the fact that Applicant’s founder had the surname “Pirelli” is discounted by the fact that he is long deceased, having died over 86 years ago in 1932. Thus, there is no evidence of

record to support the notion that the modern purchasing public would associate the Mark with the founder. As stated in TMEP §1211.01, “The test for determining whether a mark is primarily merely a surname depends on the primary significance of the mark as a whole to the purchasing public. (citing, *inter alia*, *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)). The same TMEP section goes on to say, “Thus, the impact the applied-for term has or would have on the purchasing public must be evaluated in determining whether the primary, and only, significance of the term is a surname significance. (citing *In re Eximius Coffee*, 120 USPQ2d at 1278; See, *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975)). The evidence of record falls far short of proving that the purchasing public would perceive the Mark to have only surname significance.

Since there has been no significant public exposure regarding individuals with the surname “Pirelli” that would cause today’s purchasing public to associate “Pirelli” primarily and solely with surname use, the fact that the Examining Attorney has produced directory evidence of only 219 possible individuals with the surname “Pirelli” clearly indicates it is a rare surname in the United States. See, *e.g.*, *In re Hall Wines, LLC*, Serial No. 78926151 (TTAB 2009) (“[A]ny 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.”) See also, *In re Amlin plc*, Serial No. 79011475 (TTAB 2008) (**150** listings of individuals found to be not only rare, but an extremely rare surname, such “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.”) The analysis reflected in the quotes above is consistent with established TTAB jurisprudence and is highly relevant here.



Based on the US Census Population Clock,<sup>6</sup> the current population of the United States to date is approximately 328,857,000. Even if we were to assume *arguendo* that the directory evidence of only 219 individuals with the surname “Pirelli” contains no duplicates, names of deceased individuals, clerical errors, or otherwise inaccurate information, it only means that approximately one in 1.4 million individuals in the United States has the surname “Pirelli.” That is to say, less than .0000007 percent of the US population (a mere 7 out of ten million people). At such a miniscule percentage, common sense dictates it is a rare surname. The directory evidence of record therefore should be given little weight in this case. *See, In re Garan, Inc.*, 3 USPQ2d 1537 (TTAB 1987) (“[T]he degree of a surname’s rareness should have material impact on the weight given the directory evidence.”) (emphasis added)

**4. Any doubt must be resolved in favor of Applicant.**

USPTO Rules of Practice and the TTAB have made clear that “If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant.” TMEP §1211.01 (citing *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007) and *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

Even if the substantial body of evidence cited in this response did nothing more than raise doubt as to whether a refusal was warranted, the required course of action still would be for the Examining Attorney to resolve such doubt in favor of Applicant and approve the Mark for publication. That being said, it is inconceivable that there would be any doubt in the current case that the Mark is *not* primarily merely a surname. For the Examining Attorney not to withdraw the refusal would be in direct contradiction of the opinions of trademark experts who have

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<sup>6</sup> United States Census Population Clock at <https://www.census.gov/popclock/>, visited May 9, 2019.

written about this very Mark and to completely dismiss the demonstrated impact of the stylization on the purchasing public as an indicator of source apart from any surname significance.

### **Conclusion**

Due to the strong commercial impression created by the elongated “P” in the Mark, the Mark’s distinctive stylization has trademark significance that exists apart from any surname significance. Because marks that contain a distinctive stylization are not considered to be primarily merely a surname, and considering all the other relevant factors discussed above per TMEP §1211.01(b)(ii), Applicant asserts that the Mark is not subject to refusal per Trademark Act §2(e)(4).

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For all the foregoing reasons, Applicant requests that the Examining Attorney withdraw the refusal and approve the Mark for publication.

Respectfully submitted,



Andrew D. Price  
Steven B. Powell  
**VENABLE LLP**  
Attorneys for Applicant

**Exhibit A – Copy of Applicant’s U.S. Reg. No. 1,960,068**

Int. Cl.: 12

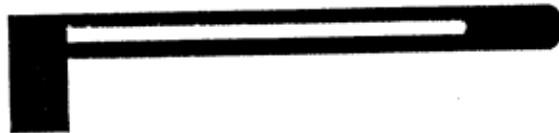
Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

**United States Patent and Trademark Office**

**Reg. No. 1,960,068**

Registered Mar. 5, 1996

**TRADEMARK  
PRINCIPAL REGISTER**



PIRELLI S.P.A. (ITALY CORPORATION)  
VIALE SARCA 222  
20126 MILAN, ITALY

FOR: TIRES; PNEUMATIC, SEMI-PNEUMATIC AND SOLID TIRES FOR VEHICLE WHEELS; WHEELS FOR VEHICLES, INNER TUBES AND RIMS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

PRIORITY CLAIMED UNDER SEC. 44(D) ON ITALY APPLICATION NO. MI94C010402, FILED

11-15-1994, REG. NO. 642905, DATED 1-17-1995, EXPIRES 11-15-2014.

THE MARK CONSISTS OF THE STYLIZED LETTER "P".

SER. NO. 74-634,497, FILED 2-15-1995.

BARBARA GAYNOR, EXAMINING ATTORNEY