

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: FAL  
Appl. No. 88/361,475  
Owner: FMR LLC

Applicant FMR LLC (“Applicant”) makes reference to the Examining Attorney’s Office Action dated May 29, 2019. Applicant respectfully disagrees with her position that the letter string FAL primarily makes the commercial impression of a surname.

As mentioned by the Examining Attorney in her Office Action, there are five factors to be considered in determining whether the significance of a mark is primarily merely that of a surname. These factors are: (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; (4) whether the mark has the “look and feel” of a surname; and (5) whether the mark is presented in a stylized form distinctive enough to create a separate non-surname impression. *In re Benthin Management GmbH*, 37 USPQ2d 1332-33 (TTAB 1995).

Applicant has applied for the mark FAL in standard character form, so the fifth *Benthin* factor is irrelevant here. Applicant discusses the other factors below.

**I. FAL is a Rare Surname**

The Examining Attorney cites phone directory search results for a search for “FAL” as a surname. The results indicate that there are 324 people with the last name FAL in the United States. Applicant does not deny that FAL is used as a surname in the United States, but observes that if only 324 of the roughly 330,000,000 people in the United States have the surname, it is a very rare surname.

In *Joint-Stock Co. “Baik”*, 84 USPQ2d 1921 (TTAB 2007), the Board determined that the term ‘Baik’ was an extremely rare surname with only 456 listings of individuals with the surname. *Id* at 1922. In the case of FAL, there are fewer still.

The Examining Attorney bears the burden of presenting a prima facie case that a mark is non-distinctive before the Examining Attorney can properly reject the mark. *In re Etablissements Darty et Fils*, 225 USPQ 652, 653 (Fed. Cir. 1985). To meet that burden, the Examining Attorney must present substantial evidence that the mark primarily makes the impression of a surname. Applicant believes that the Examining Attorney has not made the required showing in this case. For example, she has not presented evidence of popular culture usage of FAL as a surname that would transform FAL from an obscure, rare surname that identifies only 324 people to a word that is recognized as a surname by more people than the 324 people with that name and those who know them. The rareness of “FAL” surname usage weighs in favor of acceptance of the mark as a distinctive source identifier.

## **II. No One Associated with Applicant Uses “Fal” as a Surname**

Applicant stresses that no one associated with applicant uses “FAL” as a surname. No employee, principal, officer, board member, director – no one. See the Declaration of Thomas Barry at Exhibit A to this response. Consumers have no reason to assume “FAL” surname significance based upon knowledge of or dealings with individuals associated with Applicant.

## **III. While not Defined in Dictionaries, FAL Does Not Have the “Look and Feel” of a Surname**

“FAL” makes the impression of an acronym. In fact, Applicant uses FAL as an acronym. It stands for “Fidelity Agency Lending”. Applicant does business as Fidelity Investments. In parallel with the subject application, Applicant has applied to register FIDELITY AGENCY LENDING, and the application has been accepted and allowed with “AGENCY LENDING” disclaimed (Appl. Ser. No. 88/361,425). So FAL is an acronym for a phrase that the Office has deemed distinctive. In view of the meaning associated with FAL as “Fidelity Agency Lending”, the relevant consumers are likely to construe the letter string as an acronym as opposed to as a surname. This is particularly the case where used in relation to the services applied-for here, namely, “financial services, namely, securities lending as an agent on behalf of a beneficial owner of securities to a qualified borrower”. The relevant consumers are likely to understand the “-AL” portion of the acronym as meaning “agency lending” given that the services entail agency lending. Because the relevant consumers would be dealing with Applicant, which is known as “Fidelity”, they likely would correctly interpret the acronym as just that, an acronym for “Fidelity Agency Lending”, and not as a surname.

Furthermore, Applicant regularly uses acronyms in promoting its business, including “FMR”, “FAST” and “FDLM”, so consumers in this field would naturally assume that “FAL” is yet another acronym used by Application upon encountering the term in the marketplace. See the Declaration of Thomas Barry at Exhibit A.

Alternatively, if not associated with Applicant’s agency lending services, “FAL” makes a fanciful impression that evokes the word “fal-lal”, which is defined as “a fancy ornament, especially in dress”. See the Merriam-Webster online dictionary definition at Exhibit B.

These meanings each are more likely to come to mind for the relevant consumers as opposed to surname significance. The Examining Attorney submits no evidence that FAL has the structure or pronunciation of a surname – it does not.

If there is any doubt as to primary surname significance, the doubt must be resolved in favor of the applicant. See *In re Benthin* at 1334.

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In view of the arguments above and attached evidence, Applicant requests that the Examining Attorney reconsider her decision, remove the Section 2(e) refusal and approve this application for publication.