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NOT A PRECEDENT
OF THE TTAB**

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marriott International, Inc.

Serial Nos. 78489804 and 78489829

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Before Seeherman, Hairston and Mermelstein, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Applications have been filed by Marriott International,
Inc. to register the mark MARRIOTT (in standard character
form) for "charitable services, namely, employment
counseling and assistance in obtaining and maintaining
employment provided to individuals and employers; counseling
in the field of employment; coordinating volunteers for

community service" in International Class 35¹; and "charitable fund raising services; providing financial support to charitable, family services and health-related organizations; provision of in-kind contributions to public and private entities and individuals; providing educational scholarships and grants to educational institutions" in International Class 36.²

Registration has been finally refused in each case under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), on the ground that the mark which applicant seeks to register is primarily merely a surname.

Applicant, in each case, has appealed. Briefs have been filed and applicant's counsel and the senior trademark attorney also appeared at an oral hearing.³ Because the issue in each case is the same, the appeals have been treated in a single opinion.⁴

¹ Serial No. 78489804, filed on September 27, 2004, which alleges dates of first use of 1990.

² Serial No. 78489829, filed on September 27, 2004, which alleges dates of first use of 1983.

³ At the oral hearing, senior trademark attorney Brian D. Brown represented the USPTO in both cases. We note that Mr. Brown handled Serial No. 78489804. Serial No. 78489829 was handled by two different examining attorneys; Raul Cordova issued the first and second office actions and the response to applicant's request for reconsideration, which included all evidence introduced by the USPTO during examination; Peter Cheng prepared the brief. For purposes of this decision, we will refer to them collectively as the "examining attorney."

⁴ As discussed *infra*, however, the evidence submitted by the examining attorney in each case is somewhat different.

A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance to the purchasing public is that of a surname. See *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). The burden is on the examining attorney to establish a prima facie case that a term is primarily merely a surname. In *re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Among the factors to be considered in determining whether a term is primarily a surname are (1) the degree of the surname's rareness; (2) whether anyone connected with applicant has the surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the "look and sound" of a surname; and (5) whether the term is depicted in a stylized form distinctive enough to create a non-surname impression. See *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995). See also *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004).

The examining attorney, in Serial No. 78489804, conducted searches of the "www411.com" white pages database of telephone listings for "Marriott" and a given name or initial located in the states of Florida, New York and Texas (e.g., "Marriott, robert, NY"). The searches returned thirty-five residential listings of individuals with the surname MARRIOTT (a printout of thirty retrieved listings

was included). Also, the examining attorney submitted the results of a search of the website <http://lookwayup.com> where "marriott" is defined as "[n] Last name, frequency rank in the U.S. is 7195," and the results of a search of the website <http://www.rhymezone.com> where "marriott" is defined as "**name**: A surname (rare: 1 in 50000 families; popularity rank in the U.S.: #7195)." Also, the examining attorney made of record printouts from "Wikipedia" and the web site <http://sls.sites> which indicate, inter alia, that applicant's founder was J. Willard Marriott. Further, the examining attorney submitted the results of searches of the online version of the Merriam-Webster dictionary for "marriott", "marriot", "mariot", and "mariott" which reveal no entries for any of these terms. Finally, the examining attorney submitted copies of five registrations owned by applicant for marks which consist of or include the term MARRIOTT (in typed form) and which issued on the Principal Register under Section 2(f) of the Trademark Act.

The examining attorney, in Serial No. 78489829, submitted the results of a search conducted on May 4, 2005 of the Lexis/Nexis ("USFIND") database which revealed that there are 2171 residential telephone listings in the United States for persons with the surname "Marriott" (a printout of the first 100 of the retrieved listings was included); and the results of a search conducted on July 7, 2006 of the

Lexis/Nexis ("P-FIND") database which revealed that there are 2386 residential listings in the United States for persons with the surname "Marriott" (a printout of the first 125 of the retrieved listings was included). Also, the examining attorney made of record copies of the same five registrations owned by applicant which issued on the Principal Register under Section 2(f) of the Trademark Act. Finally, the examining attorney submitted the results of a search of the online version of The American Heritage Dictionary (4th ed.) for "marriott" which states that "No documents match the query."

Applicant, in support of its position, submitted the same evidence in each case. Specifically, applicant submitted copies of thirteen registrations which it owns for marks that consist of or contain MARRIOTT and which issued on the Principal Register without a Section 2(f) claim; and a printout from the U.S. Census Bureau web site showing a national population count estimated at 297,563,554 on September 30, 2005.

We first turn to the fifth factor, i.e., whether the term sought to be registered is depicted in a stylized form distinctive enough to create a separate non-surname impression. Applicant maintains that it frequently uses MARRIOTT in a stylized form and with a design element which is distinctive enough to create a non-surname impression.

The problem with this argument, however, is that applicant seeks to register MARRIOTT (in both applications) in standard character format; there is no stylization or design involved. Because we are constrained in this proceeding to consider the registrability of the marks as they are shown in the applications, applicant's arguments about any actual use of the mark cannot be considered. We turn therefore to a consideration of the first four factors.

As to the first factor, i.e., the degree of rareness of MARRIOTT, applicant argues that, at best, the record shows that MARRIOTT is an extremely rare surname. Applicant argues that the examining attorney's Lexis/Nexis search results, in particular, are flawed because only the first 100 and 125 results of the respective searches were made of record. Applicant maintains that it has no way of knowing if the remaining results contained duplicative or otherwise questionable results. In any event, applicant contends that based on the listings of record, only about two one-thousandths of one percent of the United States population may have the MARRIOTT surname, and that such evidence "certainly does not meet the 'unusually large number' generally required as set out in the case of *In re Harris-Intertype*." (Applicant's brief at 6).

We acknowledge that the actual printouts submitted by the examining attorney from the searches of the Lexis/Nexis

and the "www411.com" white pages computerized databases show a small number of residential listings for persons with the "Marriott" surname, i.e., 100, 125 and 30 respectively. However, we disagree with applicant's criticism that these submissions are insufficient to support the larger numbers retrieved by the Lexis/Nexis searches. The Board has frequently taken the position that, in connection with Nexis searches in general, it is necessary only to submit a representative sample. We consider the examining attorney's submission of a number of the actual listings, combined with the search results showing the numbers of additional listings that were retrieved, to be sufficient. Although the actual listings that were submitted show several listings that appear to be duplicative, even allowing for duplicative or questionable results among the non-submitted Lexis/Nexis listings, it is reasonable to conclude that the results demonstrate approximately 2000 residential listings for persons with the "Marriott" surname. Moreover, a review of the submitted evidence from the "www411.com" white pages and Lexis/Nexis computerized databases reveals that the listings are spread throughout the United States and include households in at least twenty different states.

In this case, we find that while MARRIOTT is not a common surname, we cannot conclude that the surname is so rare that this factor, the degree of the surname's rareness,

should weigh in applicant's favor, or weigh only slightly in support of the USPTO's position. The evidence shows that, in terms of telephone directory listings alone, in excess of 2000 people in the United States have the surname "Marriott." This evidence, of course, does not take into consideration additional people living in a particular household, or those people whose telephone numbers are not listed in telephone directories, either because they prefer not to have their numbers publicly listed, or because they use only a cellular telephones. As a result, we find that the evidence is sufficient for us to conclude that MARRIOTT is not a rare surname, as that concept has been interpreted in the case law. In this regard, we note that the "rhymezone" evidence submitted by the examining attorney characterizes the "Marriott" surname as "rare." This characterization appears to be based solely on the frequency of use of "Marriott" as a surname in the general U.S. population. However, the fact that the authors of a web site consider a name rare in terms of its frequency of use as a surname does not necessarily mean that such surname will be considered rare under the Board's case law. See *In re Gregory*, supra, at 1795. [The existence of two elected officials with the surname ROGAN led the Board to conclude that "the name may be rare when viewed in terms of frequency of use as a surname in the general population, but not at

all rare when viewed as a name repeated in the media and in terms of public perception."]. A mark may be found to be primarily merely a surname even though it is not a common surname. See *In re Giger*, 78 USPQ2d 1405 (TTAB 2006). See also *In re E. Martoni Co.*, 78 USPQ2d 589 (TTAB 1975); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988). Moreover, there is no minimum number of listings needed to prove that a mark is primarily merely a surname. With respect to applicant's argument regarding the small percentage of people living in the United States with the surname "Marriott", "given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of the total population." *In re Gregory*, supra, at 1795.⁵

As to the second factor, i.e., whether anyone associated with applicant has the surname MARRIOTT, we note that the "Wikipedia" printout states that applicant was

⁵ Insofar as the concurring opinion is concerned, the situation discussed therein is not before us. As we have indicated, the number of "Marriott" listings in the computer databases is sufficient for us to find that "Marriott" is not an especially rare surname. Even if, however, we had found that "Marriott" was very rare based on a record with only a few listings in the computer databases, that would not have foreclosed the inquiry, i.e., we would not have automatically found that the term was registrable based only on its frequency. Rather, we still would have looked at the evidence on the remaining surname factors. In short, we would have balanced the fact that the surname was very rare with the other surname factors to determine whether the Office had made out a *prima facie* case. While it may be unusual to deny registration of a very rare surname, decisions of registrability should be made in light of all probative evidence.

founded by J. Willard Marriott, and that his son, J.W. "Bill" Marriott, Jr., is the current Chairman and CEO of applicant. This reinforces the surname significance of MARRIOTT. Further, the "Wikipedia" printout states that "Bill is actively involved in various boards and councils... ," and "[h]e serves as chairman of the President's Export Council, a group that advises the President on matters relating to export trade, and serves as chairman of the Leadership Council of the Laura Bush Foundation for America's Libraries." The printout from the web site <http://sls.sites> discusses the history of applicant and the activities of the Marriott family, indicating that "[t]he Marriotts have been extremely active in the Salt Lake Valley" and that the "Marriott family donated funds needed for the Marriott library at the University of Utah and have helped with a variety of other notable efforts in the Salt Lake Valley." As a result of Bill Marriott's civic involvement on the national level and the Marriott family's philanthropic activities in the Salt Lake City area, a significant number of individuals in the United States would be exposed to the "Marriott" name. This is also likely to cause consumers to view MARRIOTT as a surname.

The third factor we consider is whether there is evidence of another recognized meaning of the term MARRIOTT. The examining attorney submitted dictionary evidence which

shows that there are no listings or entries for "marriott" (or variations thereof) in The American Heritage Dictionary and Merriam-Webster Dictionary. For its part, applicant makes the following argument with respect to this factor:

A search for MARRIOTT in any number of databases shows that MARRIOTT has significance other than as a surname. For example, a search in the Nexis news database demonstrates that the vast majority of uses of MARRIOTT are in conjunction with commerce, not as a surname. Similarly, a review of the first 500 results of a Google Internet search for MARRIOTT demonstrates that the vast majority of the results have nothing to do with surnames but rather demonstrate that MARRIOTT has a commercial or other non-surname significance. Indeed, the searches show that MARRIOTT is used to identify:

- a theatre
- a library
- a dance center
- a business school
- an arena
- geographical locations, such as Marriott Hill; Marriottsville; and the town of Marriott, sometimes known as Marriott-Slaterville
- various corporations
- hospitality and related services

(Brief at 9).

The first problem with this argument is that applicant failed to make of record the results of its Nexis and Google searches. Second, even assuming that applicant had presented evidence showing that the term "marriott" identified a handful of towns and other commercial and non-commercial enterprises, these minor occurrences do not demonstrate that the term is not primarily a surname. See

In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) [Cities, towns and other things may be named after an individual]. Third, as discussed infra, because applicant seeks registration on the Principal Register without resort to Section 2(f), applicant cannot be heard to argue that MARRIOTT identifies its "various corporations" and "hospitality and related services." See in re Cazes, 21 USPQ2d 1796 (TTAB 1991) [Applicant argued that LIPP or BRASSERIE LIPP is no longer primarily merely a surname because the significance of the term is now that of a mark for her restaurant; argument rejected because applicant did not seek registration under Section 2(f)]. In short, there is no evidence that the term "marriott" has any other recognized meaning. Thus, it is the surname significance of "Marriott" which dominates.

The fourth factor we consider is whether MARRIOTT has the look and sound of a surname. Applicant contends that MARRIOTT "looks more like a foreign word than a surname, although it has no foreign language meaning." (Brief at 14). Applicant has not submitted any evidence of a foreign word that resembles MARRIOTT, such that we could conclude that consumers seeing MARRIOTT would regard it as being a foreign term or as something other than a surname. Admittedly, this is a somewhat subjective factor, but we agree with the examining attorney that the term has the look

and sound of a surname, especially since the record shows that there are numerous individuals with the surname "Marriott," that such term has no meaning or connotation other than its surname significance; and that nothing in the record indicates that MARRIOTT would be perceived as an initialism or acronym, or a coined term. Rather, the term MARRIOTT "appears to be a cohesive term with no meaning other than as a surname." In re Gregory, supra at 1796.

Several additional arguments made by applicant require comment. Applicant argues that its mark "is not linked with any surname indicators," such as "and Sons" or "and Co." (Brief at 12), and thus the purchasing public would not view its mark as primarily merely a surname. While the addition of certain terms to a surname has been found to reinforce rather than detract from the surname significance of a mark (See e.g., In re Rath, 402 F.3d 1207, 47 USPQ2d 174 (Fed. Cir. 2005) [Federal Circuit affirmed board decision holding that DR. RATH was primarily merely a surname]; In re Giger, supra [GIGER MD held primarily merely a surname]; and In re I. Lewis Cigar Mfg. Co., 205 F.2d 204, 98 USPQ 265 (CCPA 1953) [S. SEIDENBERG & CO.'S held primarily merely a surname], the fact that applicant has not added such a term to MARRIOTT does not mean that the mark would be not be perceived primarily as a surname.

Applicant also argues that the USPTO has issued fourteen registrations to applicant for marks that consist of or contain MARRIOTT on the Principal Register without a Section 2(f) claim and that such registrations show that the USPTO has treated MARRIOTT as not primarily merely a surname. We note that three of the registrations relied upon by applicant are for MARRIOTT marks depicted in a stylized form distinctive enough to create a separate non-surname impression. Moreover, as previously noted, the examining attorney submitted five registrations for marks that consist of or contain MARRIOTT which issued on the Principal Register with a Section 2(f) claim. Thus, we are unable to draw the conclusion urged by applicant based on its prior registrations. In any event, the Board's task in this ex parte appeal is to determine, based on the record before us, whether applicant's mark is primarily merely a surname. Each case must be decided on its own merits. Moreover, the determination of registrability of those particular marks by the examining attorneys cannot control our decision in the cases now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 156 (Fed. Cir. 2001) ["Even if some 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."]

Further, applicant asserts that the USPTO has issued registrations for the mark HILTON on the Principal Register without a Section 2(f) claim even though "Hilton" is a more common surname than "Marriott." There is no evidence of record with respect to any registrations allegedly issued for HILTON marks and the Board does not take judicial notice of third-party registrations. See e.g., *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Even if such evidence had been made of record, as noted above, each case must be decided on its own set of facts.

Applicant also asserts that it "operates one of the world's most well-known and extensive hotel, restaurant, and hospitality companies...;" that it has "continuously offered services under the mark MARRIOTT since as early as 1960, and each year, millions of Applicant's customers obtain services under the mark MARRIOTT;" and that "as a result of Applicant's longstanding and extensive advertising and promotional activities, the mark MARRIOTT has become one of the most readily recognized and famous trademarks in the world." (Brief at 2). This argument, however, goes to whether applicant's mark has acquired distinctiveness, not to whether the term MARRIOTT, viewed in and of itself, is primarily merely a surname. See *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986) ["In short, we have here a situation where a noninherently distinctive term, having no

ordinary meaning other than that of a surname is sought to be registered. While applicant has demonstrated a strong public association between the mark sought to be registered and applicant's restaurant services, the Board concludes that this evidence is evidence of secondary meaning and that in the absence of a claim of secondary meaning pursuant to Section 2(f), registration must be refused under Section 2(e)(3)."]

Finally, applicant argues that any doubt as to whether MARRIOTT is primarily merely a surname should be resolved in its favor. Applicant is correct that our case law holds that if we have doubt about whether the term is a surname, we resolve that doubt in favor of the applicant for publication of the mark. In this case, we have no such doubt.

In sum, when we consider the evidence as a whole, we find that the USPTO has made out a prima facie case that MARRIOTT is primarily merely a surname and that applicant has not rebutted this prima facie case.

Decision: The refusal to register is affirmed in each case.

Seeherman, Administrative Trademark Judge, concurring:

I write this concurring opinion to elaborate on comments I made in my concurring opinion in *In re Joint-Stock Company "Baik"*, __USPQ2d__ (Serial No. 78521961, TTAB

August 28, 2007). Although we look at several factors in determining whether a mark is primarily merely a surname, it is the first factor, the rarity of the surname, which is critical in determining whether the Office has made out a prima facie case. The purpose of Section 2(e)(4) of the Trademark Act is to keep surnames available for use by those with that surname. See *Kimberly-Clark Corp. v. Marball*, Comr. Pats., 94 F. Supp 254, 88 USPQ 277, 279 (D.D.C. 1950) ("The spirit and the intent of the entire Act indicate that Congress intended to codify the law of unfair competition in regard to the use of personal names as it has been developed by the courts. ... At common law it was held that every man had an absolute right to use his own name."). During the hearings on the bills that eventually became the Lanham Act, the testimony shows that Congress was not trying to prevent the registration of surnames per se; one witness pointed out that "almost every word you can think of is somebody's surname, somewhere" and to refuse the registration of a term because "it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice." *Hearings on H.R. 4744 Before the Subcomm. Trade-Marks of the House Comm. on Patents, 76th Cong., 1st Sess.* (1939) at 40.⁶

⁶ Congress also intended, as discussed *infra*, that surnames which have other meanings should be registrable.

If a surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. Accordingly, if the Examining Attorney cannot show that a reasonable number of people have a particular surname, in my view the Office cannot meet its burden of *prima facie* showing that a mark is primarily merely a surname.⁷

It is only after the Office has met the burden of showing that a mark is not an extremely rare surname that the other factors should come into play. In effect, I suggest that even if all of the other factors that we use to determine surname significance were to favor the Examining Attorney's position, if the surname is so rare that essentially no one will be affected by its registration, the mark should be registrable. The remaining factors are used in determining whether, even though the Office has shown

⁷ Many surname cases were decided prior to the availability of computer databases showing surname listings for everyone in the United States, and therefore there was some uncertainty, based on evidence from a limited number of print telephone directories, about how rare a surname might be. As a result, the Board and the Courts often looked to factors other than the rareness of the surname to support a finding that a term was not primarily merely a surname. I suggest that, with the availability of these computer databases, we can determine whether a term is truly a rare surname, and if a term is sufficiently rare, we should find it registrable regardless of the evidence on the other factors.

that the mark is a surname, it is primarily merely a surname, or whether it would have another, non-surname significance to consumers.

In determining whether a term has a non-surname significance, we must still take into consideration the degree of rareness of the surname; if the term is a common surname, stronger evidence, e.g., that the surname would also be recognized as a word, would be required to show that it is not primarily merely a surname, but if the name is uncommon, but not extremely rare, evidence on the remaining factors may be sufficient to show that the term would or would not be perceived as a surname, and therefore would or would not, under the statute, be primarily merely a surname.

Thus, we look at whether anyone connected with the applicant has that surname, since that would reinforce the surname significance of the mark to consumers. We also look at whether people with that surname are frequently in the news, or are public figures, since that again would cause consumers to regard the term as a surname. In re Gregory, supra.

However, if a mark is shown in a distinctive display that gives it a non-surname significance, it will not be primarily merely a surname. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995). Similarly, if a term has a recognized non-surname meaning, it cannot be primarily

merely a surname. In this connection, the legislative history makes clear that the Lanham Act was designed to change the then-practice of the Patent Office of refusing registration of common words, such as COTTON and KING, simply because those words were also found as surnames in directories. See *Hearings on H.R. 4744*, supra. Or if a term does not have the look and feel of a surname, even though it does not have another recognized meaning, it should not be found to be primarily merely a surname. See *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.3d 831, 184 USPQ 421 (CCPA 1975), in which DUCHARME for watches was found not primarily merely a surname. The Court, commenting on the Kahan & Weisz decision in *In re Etablissements Darty et Fils*, supra, 225 USPQ at 653, stated that "we can see that it [DUCHARME] was likely to be taken as a fanciful mark for watches derived from the apt word 'charm'." See also *In re The Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989), in which CALISTO was found to be not primarily merely a surname because of the combination of the limited evidence of surname significance and the fact that CALLISTO had other meanings, such that CALISTO might be perceived as a misspelling of CALLISTO rather than as a surname. Compare, *In re Pickett Hotel Company*, 229 USPQ 760 (TTAB 1986) in which the Board found that PICKETT, which was shown to be

the surname of a large number of people, would not be perceived as merely a misspelling of the word "picket."

Further, with respect to the factor of "look and feel," as I said in my concurring opinion in *In re Joint-Stock Company "Baik"*, supra, I believe that registration should not be refused simply because the mark at issue is similar in sound and appearance to other surnames. Rather, the evidence that should be considered in connection with this factor is evidence that shows a term does not have the look and feel of a surname and therefore would not be perceived as a surname. Accordingly, evidence on this factor would be part of the applicant's evidence rebutting the prima facie case made by the Office showing that a significant number of people have a surname, to demonstrate that the term is not primarily merely a surname because it will not be perceived primarily merely as a surname.

Applying this analysis to the case at hand, I agree with the majority that, although there are a limited number of individuals with the surname MARRIOTT, it is not such a rare surname that others with the surname will not be damaged by the registration of MARRIOTT by applicant. In other words, the name should remain available so that others who have that surname may use it in connection with the identified services. The fact that a person with the surname Marriott--J. Willard Marriott-- is applicant's

founder, and that his son Bill Marriott and the Marriott family is active in charitable activities, reinforces the conclusion that consumers will perceive the mark as a surname. Further, as the majority has pointed out, there is no design element that would take away from the surname significance of the term. Finally, I also agree with the majority that there is no evidence that the mark has another, non-surname, meaning, or that consumers would view this mark as anything other than a surname. Thus, although MARRIOTT is certainly not a common surname, there is no evidence that would suggest a non-surname significance or in any way would support the position that, because of the rarity of the name, consumers would not perceive it as a surname. Accordingly, I agree that the refusal of registration should be affirmed because MARRIOTT is primarily merely a surname.