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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applied for Mark	CULLINAN
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Trademark Application of)	Rebecca Joy Povarchuk, Esq.
Bayerische Motoren Werke Aktiengesellschaft)	Trademark Attorney
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Serial No.: 79/150,636)	Trademark Law Office 115
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Mark: CULLINAN)	
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Filing Date: March 19, 2014)	
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APPLICANT’S REPLY BRIEF

I. Introduction

Applicant Bayerische Motoren Werke Aktiengesellschaft (Applicant) submits this reply brief to respond to the arguments raised by the Examining Attorney, and maintains that the Examining Attorney has not established a prima facie case that the mark CULLINAN is primarily merely a surname, and that Applicant has either rebutted that showing, or at a minimum, raises a doubt that should be resolved in favor of Applicant to allow its application to proceed to publication. The Examining Attorney’s Appeal Brief confirms that she has not met her burden of demonstrating *primary* surname significance of Applicant proposed mark CULLINAN in connection with “motor vehicles, namely, automobiles, sports utility vehicles and light trucks; parts of aforesaid goods, namely, structural parts, engines and wheels.” The Examining Attorney’s evidence establishes at most that “Cullinan” is an extremely rare surname, and that the public is not aware of any alleged surname significance. Applicant has established with clear evidence that to the American people “Cullinan” has the meaning of the rare and prestigious Cullinan Diamonds—in particular the original Cullinan Diamond, which is the largest rough gem diamond ever found. Indeed, the Examining Attorney admits that it is only by undertaking “research” that people may discover that “someone with the surname Cullinan was

involved with the South African mine.” This admission confirms that the current primary significance of “Cullinan” to the public is the rare and prestigious diamonds, and not a long-forgotten figure involved with the original diamond mine. Similar to trademarks such as BUICK, CHEVROLET, and CADILLAC—all well-known car trademarks that were at one point in time a surname—the mark CULLINAN does not have primary surname significance. Indeed, when Applicant’s proposed mark CULLINAN is considered in relation to the motor vehicle goods covered by its application, the rarity, prestige and luxury evoked by the Cullinan Diamonds is reinforced.

II. Argument

A. Examining Attorney’s Evidence Demonstrates The Extreme Rariness Of The Surname Cullinan

The Examining Attorney’s assertion of 630 listings (only 100 of which were actually filed) from a nationwide database of over 93 million telephone numbers is insufficient to establish the primary surname significance of Applicant’s proposed mark CULLINAN. This relatively miniscule number of listings falls far short of the required showing of a “significant” number of listings to establish a prima facie case. *In re Ciclo Tecnica Industrial, S.A.*, 194 USPQ 547, 548 (TTAB 1977). Furthermore, an analysis of these limited listings as well as significant other evidence of record confirms the extreme rarity of Cullinan as a surname:

- The listings submitted by the Examining Attorney do not include *any* telephone directory listing from major metropolitan areas such as Los Angeles, Chicago, Philadelphia, Washington, D.C., Dallas and Miami, and only one listing each from New York City and Boston. (Aug. 25, 2014 Office Action, TSDR p. 1.) *See In re United Distillers Plc*, 56 USPQ2d 1220, 1221 (TTAB 2000) (surname rare where there was only one listing in the Manhattan telephone directory and four

total listings in the Washington, D.C. and the Northern Virginia telephone directories); *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995) (absence of telephone listings from Boston, Manhattan and Philadelphia showed that surname was rare);¹

- The listings submitted by the Examining Attorney also show that almost half the country, specifically 23 states, have no individuals with the last name Cullinan (*i.e.* Alaska, Arkansas, Delaware, Hawaii, Indiana, Kansas, Louisiana, Michigan, Mississippi, Nebraska, New Hampshire, New Mexico, North Dakota, Oklahoma, Oregon, Rhode Island, South Dakota, Utah, Vermont, Virginia, West Virginia, Wisconsin, and Wyoming) (Aug. 25, 2014 Office Action, TSDR p. 1.);
- The listings submitted by the Examining Attorney further show that in most of the states that did show results, there were 5 or less people with the last name “Cullinan.” (Aug. 25, 2014 Office Action, TSDR p. 1; Applicant’s Appeal Brief, p. 4 fn. 3.);
- Accordingly, “Cullinan” does not appear in the U.S. Census Bureau database of Top 1,000 surnames (February 24, 2015 Response to Office Action, Bradley Decl., ¶ 2, Ex. A) which TMEP § 1211.02(b)(iii) advises “may be more persuasive evidence of surname frequency than results from telephone directory listings.”;
- A search on www.ancestry.com for individuals with the surname “Cullinan” based on United States census and voter lists from 1980 (the most recent year

¹ *In re Gregory*, 70 USPQ2d 1792, 1794-1795 (TTAB 2004), cited by the Examining Attorney, confirms the Board’s recognition that a low number of directory listings in combination with the absence of directory listings in major metropolitan areas is sufficient to conclude that a surname is rare.

available on the website) *does not return even a single result.* (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 1.);

- Excerpts from www.ancestry.com filed by the Examining Attorney containing a color-coded map of the number of Cullinan families in the United States per state from 96-year old census data (from 1920) show the majority of the states had only 1-12 families with the surname “Cullinan,” approximately 10 states had no families with the surname “Cullinan,” approximately 6 states had only 13-35 “Cullinan” families, and only about three states had 35-70 “Cullinan” families. (March 18, 2015 Final Office Action, TSDR pp. 6-7, Attachments 5 and 6.); and
- The news articles filed by the Examining Attorney (many of which are not properly of record) show only isolated, one-time coverage of local individuals in local newspapers, which do not demonstrate the required “media attention or publicity accorded to public personalities who have the surname” in order to demonstrate surname significance. *See* TMEP 1211.01(a)(v).²

Additionally, while rareness may not be determined *solely* on a comparison between the number of listings for a surname and the overall number of listings in a database, the Board has recognized that such comparison is relevant and should be considered—especially in relation to determining the weight to be given to the Examining Attorney’s evidence. *See In re Garan, Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987) (low number of directory results had “limited persuasive impact in view of the fact these were the only ones found in an enormous NEXIS database and

² The cases relied on by the Examining Attorney confirm the Board’s position that for news articles to be persuasive they must address public personalities and be in publications of national circulation. *See In re Rebo High Definition Studio, Inc.*, 15 USPQ2d 1314 (TTAB 1990) (recognizing that news article evidence relevant because it came from “periodicals with national circulation”); *In re Gregory*, 70 USPQ2d 1792, 1794-1795 (TTAB 2004) (holding that the “media attention” must be for “public personalities” such as the Director of the USPTO, an inductee to the National Baseball Hall of Fame or well-known comedians and actors).

some 43 directories of major population centers”); *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995) (considering “massive scope of this data base” in holding that “this data base demonstrates the rarity of the surname Benthin by showing that there is but one Benthin for every 750,000 Listings”); *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007) (holding surname “extremely rare” based “on the fact that only 456 examples of the Baik surname were located from a comprehensive directory of the entire United States”); *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994) (holding surname rare based on 100 directory listings as “it must be remembered that this data base includes over 90,000,000 listings. Thus the uses of SAVA as a surname represent about only one ten-thousandth of one percent of the surnames in this data base”).

Here, given the other evidence demonstrating rareness, and the analysis of the listings submitted by the Examining Attorney showing limited coverage across the country and in major metropolitan areas, the fact that the Examining Attorney only produced evidence of 630 listings for the surname Cullinan in a database of 93 million, and in light of the overall U.S. population of 318 million, demonstrate the extreme rarity of Cullinan as a surname.³ Accordingly, this “important factor” demonstrates that Cullinan is not primarily merely a surname.

B. “Cullinan” Is Not The Surname Of Anyone Connected With Applicant

The Examining Attorney has not responded to or addressed the clear, un rebutted evidence that “nobody within [Applicant] or any of its subsidiaries has the surname ‘Cullinan.’” (February 24, 2015 Response to Office Action, Gessner Declaration ¶ 2.) Accordingly, the

³ The Examining Attorney’s other cited cases on rareness are inapposite and fail to demonstrate that the overwhelming evidence of rarity here should not weigh in Applicant’s favor. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 16 225 USPQ 652, 653 (Fed. Cir. 1985) (court does not discuss the issue of rareness, and applicant submitted no evidence of non-surname significance); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314, 1315 (TTAB 1990) (applicant did not submit evidence of non-surname significance and applicant’s president had the surname at issue); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986) (applicant did not submit evidence of non-surname significance).

second factor in the surname analysis weighs in favor of allowing the mark CULLINAN to proceed to publication. *See In re BDH Two Inc.*, 26 USPQ2d 1556, 1558 (TTAB 1993) (in reversing refusal to register Board “note[d] that there is no evidence indicating that any individual associated with applicant bears the surname ‘Grainger’”).

C. Totality Of The Evidence Establishes Primary Significance of “Cullinan” To American Public Is The Cullinan Diamonds And Diamond Mine

The totality of the evidence of record establishes that, to the American public, “Cullinan” has the meaning of the world’s largest diamonds, and the diamond mine that is the source for these rare diamonds. The mark CULLINAN evokes the characteristics of luxury and prestige associated with the world’s largest diamond, and associates those characteristics with Applicant’s automobiles. The Examining Attorney overlooks key evidence, including coverage in nationwide U.S. publications, establishing that the primary meaning of “Cullinan” as a reference to the world’s largest diamonds and diamond mine, and that the qualities evoked by such diamonds have permeated American culture. Additionally, the Examining Attorney has not identified any evidence in the record that Sir Thomas Cullinan was a famous figure or that the U.S. public is even aware of him, especially considering that recent nationwide coverage of the Cullinan Diamonds makes no reference to Sir Thomas Cullinan.

1. Extensive Evidence Demonstrating Non-Surname Significance

Applicant has made of record abundant evidence of the non-surname significance of Cullinan as meaning the Cullinan Diamonds, and the diamond mine, which the Examining Attorney fails to recognize in her brief recitation of Applicant’s evidence. Such evidence includes the following:

- The original Cullinan Diamond is not just any diamond, but rather the largest rough gem diamond ever found (3,106 carats). (Feb. 24, 2015 Response to Office

Action, Bradley Decl. Ex. D, p. 1; Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 4, Ex. 11, p. 3);

- A May 3, 2015 article published on ABC News' website demonstrates that the Cullinan diamond has achieved widespread recognition as a representation of luxury in the United States, by using a fictional theft of the Cullinan diamond from the New York Metropolitan Museum of Art to lead off a discussion about the growing security concerns presented by hackers. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 12);
- A September 4, 2015 article and photo gallery were published on cnn.com under the headline "Trace the journey of one of the world's rarest and largest diamonds" discussing the discovery of the more recent Cullinan Heritage diamond. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 5.) CNN identifies the Cullinan Diamond Mine as "[t]he mine where the majority of the world's most famous diamonds have been discovered." (*Id.*, Ex. 5, p. 3.);
- A September 3, 2015 article published in the Lifestyle section on Forbes.com also reports on the Cullinan Heritage diamond which Forbes describes as "an exceptionally rare 507.55 carat Type Ila rough diamond." (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 6, p. 1.) In the Forbes article the creation of a lavish necklace from the Cullinan Heritage diamond is described as "continuing the Cullinan legend." (*Id.*, Ex. 6, p. 6.);
- The "Cullinan Blue Diamond Necklace" is a celebrated mineral science exhibition on display at the Smithsonian National Museum of Natural History in Washington, D.C., and is identified as one of the National Gem Gallery's

“highlights.” (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Exs. 2-3.);

- A September 9, 2014 article published on NBCNews.com reported on the discovery of a 232.08-carat diamond at the Cullinan mine. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 4.) NBC News reported that “[t]he stone was discovered at the Cullinan mine, famed for the largest rough gem diamond ever recovered, the 3,106 carat Cullinan Diamond found in 1905, which was cut into stones that are part of Britain’s Crown Jewels.” (*Id.*);
- An April 16, 2015 article published on Bloomberg Business describes the original Cullinan Stone as “[t]he largest mined diamond” and reports that it is set into “Britain’s Crown Jewels.” (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 11, p. 3.) In discussing a recent discovery of a large emerald, a source in the article comments that “maybe it’s another Cullinan.” (*Id.*);
- In addition to the NBC News and Bloomberg Business articles which demonstrate that the American public is aware that the Cullinan Diamonds are part of the Royal Crown Jewels, a May 27, 2015 article in e-magazine People.com about Queen Elizabeth’s crown shows the significance of “Cullinan” as meaning diamonds, including those incorporated in the Queen’s crown and other Royal Crown Jewels, thereby demonstrating that this primary meaning has permeated American culture. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 10.) People.com identifies the “Cullinan II” as having a prominent position in Queen Elizabeth’s Imperial State Crown, and reports that the crown

“is a centerpiece of the Crown Jewels exhibit popular with tourists.” (*Id.*, Ex. 10.);

- Beyond recognition in nationwide news and magazine articles, Applicant’s evidence also shows that the Cullinan Diamonds incorporated into the Royal Crown Jewels are a top tourist destination in London. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. E; Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 9.) London is a key tourist destination for Americans with approximately 2.97 million visits from U.S. citizens in 2014. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Exs. 7-8.); and
- As reported in the NBC News article, Cullinan is also the name of one of the world’s most celebrated diamond mines. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 4; Aug. 25, 2014 Response to Office Action, Bradley Decl. Ex. D, p. 1.) The Cullinan mine is known for large, high quality diamonds and has produced more than a quarter of all the world’s diamonds of greater than 400 carats, is the world’s only significant source of truly rare and highly valuable blue diamonds, and a number of notable diamonds selling for millions of dollars have also been discovered at the Cullinan mine. (Aug. 25, 2014 Response to Office Action, Bradley Decl. Ex. D, p. 1.)

Like Fiore and Hackler, the evidence of record establishes that “Cullinan” has a recognized meaning apart from being a surname, and especially when used on Applicant’s luxury motor vehicles, the primary significance of the well-known diamonds will be evident. *See In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1569 (TTAB 2005) (Fiore translates to flower in Italian and when seen on goods purchasing public may not attribute surname significance); *In re*

United Distillers plc, 56 USPQ2d 1220, 1221-22 (TTAB 2000) (non-surname meaning of Hackler evident when considered in relation to applicant's goods).⁴ Indeed, the above-summarized evidence establishes the American public's awareness of the "Cullinan legend" represented by the renowned diamonds, that the largest-ever-mined diamond is the epitome of luxury, and that the Cullinan diamonds represent a standard against which other jewels are measured (maybe it will be a "Cullinan").

The Examining Attorney does not deny that the one article she submitted regarding Sir Thomas Cullinan is not properly of record. (9 TTABVUE p. 7, fn. 1.)⁵ The only other reference in the evidence properly of record that the Examining Attorney could find regarding Sir Thomas Cullinan was a passing reference buried in an article on the HouseOfNames.com website. This needle in the haystack is insufficient to establish primary surname significance in the face of recent nationwide U.S. press coverage, and other evidence that only identifies "Cullinan" as the well-known diamonds and the diamond mine without any mention of Sir Thomas Cullinan.

The Examining Attorney also admits that the American public is not aware of Sir Thomas Cullinan in stating that it is only by conducting "research" that someone could potentially discover that there was a Sir Thomas Cullinan who had a connection to the diamond mine. The press coverage and other evidence demonstrate that the current primary significance of "Cullinan" to the American public is the diamonds and the qualities evoked by diamonds.

⁴ The cases relied on by the Examining Attorney are inapposite as both the amount of evidence, and the level of recognition of the non-surname meaning in those cases were much less than the level of recognition of the meaning of "Cullinan" as the diamonds and diamond mine established by the evidence of record here. See *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1368 (TTAB 1987) (only evidence of non-surname significance was one obscure dictionary definition); *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013) (no evidence of non-surname significance was made of record).

⁵ Even if this article was considered it comes from a foreign website titled South African History Online, and there is no evidence of record showing the American public is aware of this foreign website. Therefore the article does not demonstrate recognition of the public in the United States. See TMEP § 1211.02(b)(i) ("It is the American public's perception of a term that is determinative.")

2. Articles Submitted By The Examining Attorney Are Not Properly Of Record And Do Not Establish Primary Surname Significance

The Examining Attorney's response confirms that the articles she submitted with the October 9, 2015 Denial of Request for Reconsideration are not properly of record. The Examining Attorney has not identified what specific search she conducted, what the date range parameters were for her search, or what libraries or files were searched. She has also not provided any electronic record or print-out of what search she conducted. All of this is required to make evidence from a research database or service properly of record. *See* TMEP § 1211.02(b). Simply making selective articles of record that resulted from the search does not meet this standard, as none of the required information is identified on the articles, and the Examining Attorney does not identify anywhere in the record where this information can be found. The missing information is key to determining what weight, if any, to give to these obscure articles. For example, without knowing the date range searched it is difficult to evaluate the significance of the 17 examples submitted by the Examining Attorney. Seventeen is a rather low number of articles, and if the Examining Attorney's search covered 10 years, then the number of results is even less probative of any surname significance.

The 17 articles further lack probative value because the record shows that the Examining Attorney's search produced 100 articles and she only filed 17. The Examining Attorney provided no explanation regarding the reason for filing only the 17 articles. For example, the Examining Attorney has not advised either in the Denial of the Request for Reconsideration, or in her appeal brief, that the articles she filed were a representative sample of the overall results. While the Examining Attorney is not required to submit all the articles returned in her unidentified search, the evidentiary value, if any, assigned to the results will depend on the Examining Attorney's explanation of what she filed. Where, as here, the Examining Attorney

has submitted only a small amount of the articles her search returned and has not indicated that these articles are representative of the overall search, then “the Board will assume that these are the only articles that support the examining attorney’s position.” TBMP § 1208.01. The Board must further conclude that the additional 83 articles that the Examining Attorney did not submit “show that [Cullinan] has nonsurname meanings.” *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (noting that the examining attorney did not give any indication of whether the submitted articles “were representative of the rest”).

Moreover, both the TMEP and Board precedent are clear that in order to be evidence of surname significance, the articles should show “media attention or publicity accorded to *public personalities* who have the surname.” TMEP §1211.01(a)(v) (emphasis added); *see also In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) ((holding that the “media attention” must be for “public personalities” such as the Director of the USPTO, an inductee to the National Baseball Hall of Fame or well-known comedians and actors). Articles only appearing in local publications with limited circulation regarding local individuals do not establish surname significance. *See In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007) (articles that do not appear in publications of general circulation holding that they “do not support a finding that the public has been widely exposed to Baik as a surname”); *In re Okamoto Corp.*, App. No. 85739429, 2015 TTAB LEXIS 301, *7-*10 (TTAB February 6, 2015) (finding unpersuasive excerpts of articles from local newspapers and articles about local individuals). Here, the Examining Attorney admits that none of the articles she submitted reference a famous person. Accordingly, the Examining Attorney has not met the standard for showing primary surname significance.

Nor has the Examining Attorney demonstrated how isolated references in local newspapers demonstrate nationwide exposure. The 10 articles properly of record only show limited local exposure covering 7 of 50 states,⁶ including one publication that states that it is a “student-run” paper that serves only “Notre-Dame & St. Mary’s” (March 18, 2015 Office Action, TSDR p. 22), and two accounting articles which are trade publications the Board has held have “limited readership.” *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007). Even if the 17 articles not properly of record are considered, these articles only show coverage in 8 additional states.⁷ The Examining Attorney’s evidence confirms that there has not been widespread or even nationwide exposure to “Cullinan” as a surname, and the small number of isolated local news reporting do not show primary surname significance.

The few Internet references the Examining Attorney submitted are also isolated and reference only local individuals, and the Examining Attorney has not shown how these represent “marketplace” use or primary surname significance. (*See Applicant’s Appeal Brief*, 7 TTABVUE p. 11.) Such limited, local coverage about local and admittedly non-famous people does not establish that the primary significance of Cullinan is as a surname.

The Examining Attorney also overstates her article evidence as a “volume of evidence” consisting of “dozens of examples” and a “few dozen articles.” However, the Examining

⁶ Specifically, the publications’ areas of coverage are: The Observer (Notre Dame, Indiana), The Spokesman Review (Spokane, WA), Naugatuck Patch (Naugatuck, CT), The Salem News (Essex County, MA), NJ.com (New Jersey), The Tribune (Asheville, Hendersonville and Weaverville, NC), Echoes Sentinel (New Jersey), and The Fresno Bee (Fresno, CA).

⁷ The publications areas of coverage are: The Ridgefield Press (Ridgefield, CT), East Peoria Times-Courier (East Peoria, IL), The Sun Chronicle (Attleboro MA), The Augusta Chronicle (Augusta, GA), Lancaster Bee (Lancaster, NY), Ad Express & Daily Iowegian (Centerville, Iowa), Cheney Free Press (WA), PR Newswire (Glenview, IL), Iowa City Press Citizen (IA), News Tribune (LaSalle, IL), Sun Journal (Lewiston, ME), Rhode Island Lawyers Weekly (RI), The Tampa Tribune (Tampa, FL), Orange County Register (CA), and Wellesley Townsman (MA). Applicant has already demonstrated that the only two national publications do not show surname significance because the individuals mentioned therein are not public personalities and there is no evidence of widespread media coverage about them. (*See* 7 TTABVUE pp. 9-10, n. 5.)

Attorney has only submitted 27 articles, and only 10 of those articles were properly made of record and should even be considered. The Examining Attorney's meager evidence properly of record does not a "volume" make. Indeed, the 83 articles the Examining Attorney did not submit or explain and which are accordingly deemed to be evidence of non-surname significant are much closer to representing a "volume of evidence" supporting a contrary result. *See In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989).

Accordingly, the third factor in the surname analysis weighs in favor of allowing the mark CULLINAN to proceed to publication.

D. The Examining Attorney Fails To Demonstrate That "Cullinan" Has The "Look" Or "Feel" Of A Surname

The Examining Attorney's evidence does not establish that Cullinan has the look or feel of a surname, and it is not enough for the Examining Attorney to meet her burden to state "that the term looks and sounds like a recognized surname." *In re Champion International Corp.*, 184 USPQ 362, 363 (TTAB 1974). The Examining Attorney's evidence only discusses the history of various Irish surnames, and the use of those surnames in Ireland. It does not establish that the American public is aware of such history, or provide any evidence of use or awareness of Cullinan as a surname in the United States. For example, one of the website excerpts she attaches states only that "Cullinan/Cullinane is nearly restricted to the west [in Ireland], from Galway south to Cork." (March 18, 2015 Office Action, TSDR p. 8.) Another website excerpt discussing "O'Cullen" states only that the "sept" with this name "lay in the Barony of Barryroe (County Cork)" and that "[b]ranches of the family spread to Counties Clare and Waterford." (March 18, 2015 Office Action, p. 11.)

The Examining Attorney also has not demonstrated that either Cullen or Culligan are "common, well-known surnames" as she alleges, and the similarity of Cullinan to "other obscure

surnames” does not result in Cullinan having the look or feel of a surname. *See In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007). For example, one of the website excerpts she attaches discusses a Cullen family that is located “in the townland of Tullycorker, near the small town of Clogher in southern County Tyrone (Northern Ireland),” again only showing use in Ireland (not the United States), and only in a small town. (March 18, 2015 Office Action, p. 8.) Additionally, the Examining Attorney has not responded to dispute that the telephone directory evidence she attached is not properly of record for failing to comply with the requirements of TMEP § 1211.02(b)(ii). As established by Applicant, neither “Cullen” or “Culligan” appear in the U.S. Census Bureau list of Top 1,000 surnames. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. A.)

The Examining Attorney further fails to consider “Cullinan” in relation to the goods applied for which Applicant has shown reinforces the primary significance of the characteristics of the Cullinan Diamonds, specifically luxury, rarity, and prestige. (Applicant’s Appeal Brief, 7 TTABVUE pp. 17-18.) The Examining Attorney also does not address evidence of the manner in which Applicant uses its trademarks in connection with motor vehicles showing that its use of Cullinan will not be in a form akin to that of a surname. (Applicant’s Appeal Brief, 7 TTABVUE p. 18.)

Accordingly, the fourth factor in the surname analysis weighs in favor of allowing the mark CULLINAN to proceed to publication.

III. Conclusion

For the reasons set forth herein and in Applicant’s Appeal Brief, Applicant respectfully submits that the Examining Attorney has not met her burden of establishing that Applicant’s proposed mark CULLINAN is primarily merely a surname. Additionally, Applicant has submitted substantial evidence demonstrating that CULLINAN is not primarily merely a

surname, or at a minimum raising a doubt which must be resolved in Applicant's favor. Applicant therefore respectfully requests that the refusal to register be withdrawn, and that Applicant's mark CULLINAN be allowed to proceed to publication.

Respectfully submitted,

February 23, 2016

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