

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bayerische Motoren Werke AG

Serial No. 79150636

Jessica D. Bradley of Jones Day, for Bayerische Motoren Werke AG.

Rebecca Povarchuk, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

Before Lykos, Shaw and Adlin,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Pursuant to Section 66(a) of the Act, 15 U.S.C. § 1141f(a), Bayerische Motoren Werke AG (“Applicant”) filed a Request for Extension of Protection of an international registration for the mark CULLINAN (in standard characters) for the following goods: “Motor vehicles, namely, automobiles, sports utility vehicles and light trucks; parts of aforesaid goods, namely, structural parts, engines and wheels,” in International Class12.¹

¹ Application Serial No. 79150636, filed on August 14, 2014, with a priority filing date of March 19, 2014, based on International Registration No. 1212768.

The Trademark Examining Attorney refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that the mark is primarily merely a surname. When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. The appeal is fully briefed. We affirm the refusal to register.

Section 2(e)(4) Primarily Merely a Surname

Section 2(e)(4) of the Trademark Act precludes registration on the Principal Register of a mark which is “primarily merely a surname” without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f). The primary significance of the mark to the purchasing public determines whether it is primarily merely a surname. *In re Hutchinson Tech., Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 654 (Fed. Cir. 1985).

The USPTO has the burden of establishing a *prima facie* case that a term is primarily merely a surname. *Etablissements Darty*, 225 USPQ at 653. “Only after the PTO has presented a *prima facie* case that a mark is primarily merely a surname will the burden switch to the applicant to rebut this finding.” *Hutchinson Tech.*, 7 USPQ2d at 1492.

Whether CULLINAN is a surname

In support of the refusal under Section 2(e)(4), the Examining Attorney submitted an excerpt of the first 100 listings out of 630 listings for the surname CULLINAN

found in the *LexisNexis* nationwide U.S. telephone database.² In addition, the Examining Attorney submitted the following evidence establishing use of CULLINAN as a surname: 1) an excerpt from the website of cullinaneducation.com, a tutoring service run by Joanne Cullinan under the name the Cullinan Education Center;³ 2) an excerpt from the website heidicullinan.com, detailing novels by author Heidi Cullinan;⁴ 3) an excerpt from a law firm website, sutherland.com, profiling a lawyer named Thomas A. Cullinan;⁵ 4) several excerpts from genealogical websites purporting to identify the derivation of the surname Cullinan;⁶ 5) ten excerpts from various online publications reporting news relating to people named Cullinan;⁷ 6) seventeen printouts from the *LexisNexis* database from various newspapers reporting news relating to people named Cullinan;⁸ and 7) an excerpt from the website South Africa History Online profiling Sir Thomas Cullinan (1862-1936), who was the founder of the Premier Mine where the Cullinan diamond, discussed *infra*, was discovered.⁹

At least one of the news stories about people named Cullinan is a duplicate. The *LexisNexis* story about Heidi Cullinan refers to the same individual whose novels are discussed at heidicullinan.com. It also is likely that some of the Cullinans discussed in the news stories are the same Cullinans found in the telephone database, however,

² Office Action of August 25, 2014, p. 1.

³ *Id.* at 5-6.

⁴ *Id.* at 7-9.

⁵ *Id.* at 10-11.

⁶ Office Action of March 18, 2015, pp. 2-15.

⁷ *Id.* at 16-48.

⁸ Office Action of October 9, 2015, pp. 2-38.

⁹ Office Action of March 18, 2015, p. 55.

we have only a partial listing from the database so this remains undetermined. Nevertheless, this evidence shows that CULLINAN is indeed a surname, and that the CULLINAN surname has been discussed in news stories.

In addition, the Examining Attorney argues that CULLINAN has no meaning other than as a surname, and in support, submitted “negative” dictionary evidence from merriam-webster.com, oxforddictionaries.com, macmillandictionary.com, and collinsdictionary.com showing that the word CULLINAN does not appear in any of those dictionaries.¹⁰

Applicant admits that CULLINAN is a surname but argues that it is not primarily merely a surname because it is “extremely rare.”¹¹ In support, Applicant submitted, *inter alia*, evidence showing that the *LexisNexis* nationwide U.S. telephone database cited by the Examining Attorney contains over 93 million listings; evidence from the U.S. Census Bureau showing that CULLINAN does not appear in the Bureau’s database of the 1,000 most common surnames;¹² and the declaration of Aimee Gessner, Senior Legal Counsel of the BMW Group, which includes Applicant, stating that “nobody within BMW AG or any of its subsidiaries has the surname “Cullinan.”¹³

Section 2(e)(4) makes no distinction between rare and commonplace surnames. *See In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006); *In re E. Martinoni Co.*, 189 USPQ 589, 590 (TTAB 1975) (“The fact that ‘MARTINONI’ may be a rare surname does not entitle it to treatment different from what would be accorded to a common

¹⁰ Office Action of August 25, 2014, pp. 2-4; Office Action of March 18, 2015, pp. 49-54.

¹¹ Applicant’s Br., p. 3; 7 TTABVUE 4.

¹² Applicant’s Response of February 24, 2015, pp. 10-27.

¹³ *Id.* at 83.

surname when no other meaning for the word is shown.”); *Etablissements Darty*, 225 USPQ at 654 (“[A]s a surname, DARTY is not so unusual that such significance would not be recognized by a substantial number of persons.”). Thus, although rarity of a surname may be relevant to our analysis to the extent it establishes minimal public exposure to the name, rareness alone will not generally determine the registrability of a mark. The test remains whether the primary significance of the term to the purchasing public is that of a surname, based on all the evidence.

Moreover, determining whether a surname is primarily merely a surname is not decided solely by comparing the number of listings of the surname with the total number of listings, because given the large number of different surnames in the United States, even the most common surname would represent only a small fraction of the population. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004). Nor is there a minimum number of directory listings required to establish a prima facie case for refusal of registration. *See In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989). Thus, the fact that the telephone listing identifies only 630 individuals with the name Cullinan does not mean that CULLINAN is not primarily merely a surname. Rather, we find that the excerpts from various online publications and the news stories from the *LexisNexis* database show that the public has been exposed to CULLINAN as a surname, albeit infrequently.

Additionally, the fact that no one affiliated with Applicant is named Cullinan does not mean that CULLINAN is not primarily merely a surname. *In re Gregory*, 70

USPQ2d at 1795 (“[T]hat a proposed mark is not the applicant’s surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname.”).

In the absence of any other meaning of CULLINAN, we find that the Examining Attorney’s evidence establishes, prima facie, that CULLINAN is primarily merely a surname.

The Cullinan diamonds

Applicant argues that the primary meaning of CULLINAN to the purchasing public is an association with large diamonds: “[T]o 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 Cullinan diamonds and diamond mine and associates those characteristics with Applicant’s automobiles. . . .”¹⁴ In support of this alternative meaning, Applicant has made of record evidence from a variety of sources explaining the history of the various CULLINAN diamonds and the diamond mine:

- Petradiamonds.com – A web page from the owners of the Cullinan mine in South Africa. The mine was previously known as the Premier mine, but was renamed to Cullinan in 2003 (after the original founder of the mine, Sir Thomas Cullinan¹⁵). The significance of the mine is described follows:

Cullinan is one of the world’s most celebrated diamond mines and is the source of large, high-quality Type II gem diamonds. It earned its place in history with the discovery of the Cullinan diamond in 1905, the largest rough gem diamond ever found at 3,106 carats. This iconic stone was cut into the two most important diamonds which form part of the Crown Jewels in the Tower of London – the First Star

¹⁴ Applicant’s Br., p. 12; 7 TTABVUE 13.

¹⁵ Office Action of March 18, 2015, p. 55.

of Africa, which is mounted at the top of the Sovereign's Sceptre and which at 530 carats is the largest flawless cut diamond in the world, and the Second Star of Africa, a 317 carat polished diamond which forms the centerpiece of the Imperial State Crown.

The mine is famous for large, high-quality diamonds and has produced just under 800 stones of greater than 100 carats, over 130 stones weighing more than 200 carats and more than a quarter of all the world's diamonds of greater than 400 carats. It is also the world's only source of truly rare and highly valuable blue diamonds.

Notable diamonds found at the Cullinan mine since 2008 include a 507 carat white diamond named the "Cullinan Heritage."¹⁶

- Royal.gov.uk – The official website of the British Monarchy. The website describes the Crown Jewels and states that the Imperial State Crown "incorporates many famous gemstones, including the diamond known as the Second Star of Africa (the second largest stone cut from the celebrated Cullinan diamond." The website also describes the Sovereign's Sceptre: "The sceptre contains the Cullinan I diamond. At just over 530 carats, Cullinan I is the largest top-quality cut diamond in the world."¹⁷
- Tables from the United Kingdom Office of National Statistics showing that nearly 3 million U.S. residents travel to the United Kingdom each year.¹⁸
- A Wikipedia entry on "Tourism in the United Kingdom" stating that the Tower of London—which houses the Crown Jewels—is the most popular tourist destination in the United Kingdom.¹⁹
- Excerpts from the website of the Smithsonian Museum of Natural History describing an exhibition of jewels, including the "Cullinan Blue Diamond Necklace." The articles discuss other famous jewels such as the "Tiffany Diamond," the "Hope Diamond," named after Lord Henry Philip Hope; and the

¹⁶ Applicant's Response of February 24, 2015, p. 36.

¹⁷ *Id.* at 39.

¹⁸ Applicant's Response of September 18, 2015, pp. 78-83.

¹⁹ *Id.* at 85-86.

Carmen Lucia Ruby,” named after the wife of the jewel’s donor.²⁰

- An article from nbcnews.com describing the discovery of a 232 carat rough diamond at the Cullinan mine in 2014.²¹
- Articles from cnn.com and forbes.com describing the cutting and polishing of the “Cullinan Heritage,” the 507 carat rough diamond found at the Cullinan mine in 2009.²²
- People.com – the website of *People* magazine describing Queen Elizabeth’s Imperial State Crown: “Nestled in the ‘brow’ of the crown—just below the breathtaking Black Prince’s Ruby set in the central panel—is the huge Cullinan Diamond, which was found in Africa in 1905, weighing 3,601 carats. . . . The stone was later cut into several pieces, with the ‘Cullinan II’ earning a spot on the Imperial State Crown. . . .”²³
- An article from *BloombergBusiness* on the gemstone business and noting that the “largest mined diamond is the 3,106 carat Cullinan stone, found in South Africa and set into Britain’s Crown Jewels.”²⁴
- An article from abcnews.go.com on the threat of hackers and describing the fictional theft of “the world’s largest polished diamond, the Cullinan I.”²⁵

Applicant argues that these examples of coverage of the Cullinan diamond, the other diamonds found at the Cullinan mine, and the Cullinan mine itself establish that CULLINAN “has a meaning other than that of a surname, and weighs against a finding that the trademark is primarily merely a surname.”²⁶ We disagree.

²⁰ *Id.* at 17-20.

²¹ Applicant’s Response of September 18, 2015, pp. 22.

²² *Id.* at 28-76.

²³ *Id.* at 88-90.

²⁴ *Id.* at 94-96.

²⁵ *Id.* at 98.

²⁶ Applicant’s Br., p. 12. 7 TTABVUE 13.

Regarding the excerpt from Petradiamonds.com, it is not clear from the record whether prospective consumers in the United States are familiar with this web site or the diamond mine, which is located in South Africa. Further, given that the mine was named the “Premier” mine for its first 100 years, and only re-named Cullinan mine in 2003, it also is not clear whether prospective consumers would associate the Cullinan mine with “the characteristics of luxury and prestige,” as Applicant suggests.

Regarding the number of American tourists visiting the United Kingdom, the fact that nearly 3 million Americans may travel annually to the United Kingdom—even assuming many view the crown jewels—does not mean that these visitors will view CULLINAN as anything more than the surname of the individual who discovered the Cullinan diamond. On the contrary, these tourists are as likely to view CULLINAN as a surname inasmuch as the identity of Sir Thomas Cullinan, the founder of the Premier mine, is intertwined with the history of the Cullinan diamonds.

Neither do the remainder of the articles establish that the meaning of CULLINAN, as a reference to diamonds and the diamond mine, has supplanted the significance of CULLINAN as a surname. In nearly all of the articles, CULLINAN is followed by one or more nouns describing a diamond or the mine. For example, the terms “Cullinan Diamond,” the “Cullinan Blue Diamond Necklace,” the “Cullinan stone,” and the “Cullinan mine” all “represent the normal naming of a place or other item after an individual.” *In re Harris-Inter-type Corp.*, 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975) (“It is also significant that, except for the name of a ‘city,’ the

word ‘Harris’ is coupled with the place or thing so named.”). Moreover, the excerpts from the website of the Smithsonian Museum of Natural History reinforce the likely consumer perception that jewels may be named after people because these excerpts describe three other famous jewels named after individuals: the “Tiffany Diamond,” the “Hope Diamond,” and the “Carmen Lucia Ruby.”

Whether the mark has the “structure and pronunciation” of a surname

Lastly, we consider whether CULLINAN has the “structure and pronunciation” of a surname. The Examining Attorney argues that CULLINAN “has the ‘look and feel’ of a surname due to its shared origin and history with—and the resulting visual and phonetic resemblance to—other common, well-known surnames” such as “Cullen” and “Culligan.”²⁷ The determination of whether CULLINAN has the “structure and pronunciation” of a surname is subjective in nature. Nevertheless, we do not find the evidence on this point to be particularly helpful. CULLINAN doesn’t share the same “structure and pronunciation” as “Cullen” inasmuch as they have different ending vowels and have two versus three syllables. CULLINAN is more similar in “structure and pronunciation” to “Culligan” but the evidence that “Culligan” is a surname does not establish that a significant portion of United States consumers are familiar with the surname. Based on the paucity of evidence, combined with the subjective nature of this factor, we are unable to make a definitive determination whether Applicant’s mark has the “structure and pronunciation” of a surname.

²⁷ Examining Attorney’s Br., p. 5; 9 TTABVUE 6.

Balancing the evidence of record, we find that the Examining Attorney has demonstrated that CULLINAN is primarily merely a surname that is in use and recognized in the United States and that Applicant has failed to demonstrate another meaning of the term as perceived by a meaningful proportion of the consuming public. Accordingly, the refusal to register the mark because it is primarily merely a surname must be affirmed.

Decision: The refusal to register Applicant's mark CULLINAN under Section 2(e)(4) of the Trademark Act is affirmed.