

ESTTA Tracking number: **ESTTA714563**

Filing date: **12/14/2015**

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

Proceeding	79150636
Applicant	Bayerische Motoren Werke AG
Applied for Mark	CULLINAN
Correspondence Address	JESSICA D BRADLEY JONES DAY 51 LOUISIANA AVENUE NW WASHINGTON, DC 20001 UNITED STATES NYTEF@JONESDAY.COM, jbradley@jonesday.com, jfroem- ming@jonesday.com, kbaird@jonesday.com
Submission	Appeal Brief
Attachments	Applicant's Appeal Brief.pdf(239462 bytes)
Filer's Name	Jessica D. Bradley
Filer's e-mail	jbradley@jonesday.com, jfroemming@jonesday.com, kbaird@jonesday.com, nytef@jonesday.com
Signature	/Jessica D. Bradley/
Date	12/14/2015

**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
)	
Serial No.: 79/150,636)	Trademark Law Office 115
)	
Mark: CULLINAN)	
)	
Filing Date: March 19, 2014)	
)	
Class: 12)	

APPLICANT’S APPEAL BRIEF

I. Introduction

This is an appeal from the Trademark Examining Attorney’s refusal to register the mark CULLINAN under Section 2(e)(4) on the grounds that the mark is primarily merely a surname. Applicant Bayerische Motoren Werke Aktiengesellschaft (“Applicant”) respectfully submits that the Examining Attorney has failed to meet her burden to establish that Applicant’s mark is primarily merely a surname, and that an examination of the evidence of record demonstrates that all the relevant factors considered in determining surname significance weigh in favor of allowing Applicant’s mark to proceed to publication. Specifically, (i) both Applicant’s and the Examining Attorney’s evidence establishes that the surname “Cullinan” is extremely rare, (ii) Applicant’s un rebutted evidence shows that nobody within Applicant or its subsidiaries has the surname “Cullinan,” (iii) Applicant’s evidence establishes that to the American public the mark “CULLINAN” has the meaning of the rare and prestigious Cullinan Diamonds, and (iv) as intended to be used by Applicant in connection with its automobiles, the mark CULLINAN does not look or feel like a surname, but rather evokes the luxurious and prestigious qualities of the Cullinan Diamonds. Beyond the surname factors considered by the Board, allowing Applicant’s mark to proceed to publication is also in line with the public policy that liberalized surname refusals so that they were limited to terms with only a “primary” surname significance. As shown by the evidence of record the mark “CULLINAN” does not have such “primary” surname significance given the extreme rarity of

“Cullinan” as a surname, the fact that nobody connected with Applicant has the surname, and the well-recognized meaning other than as a surname.

II. Argument

A. Standard of Review

“The burden is on the Patent and Trademark Office to establish a prima facie case that the involved term is primarily merely a surname.” *In re United Distillers PLC*, 56 USPQ2d 1220, 1221 (TTAB 2000); TMEP § 1211.02(a). “The determination of whether the primary significance of the designation at issue is that of a surname is based on the facts made of record.” *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); *see also* TMEP § 1211 (“Each case must be decided on its own facts, based upon the evidence in the record.”)

“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.” *In re Hutchinson Technology Inc.*, 852 F.2d 552, 553-54, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *see also In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975) (“appellant need not demonstrate non-surname significance of its mark” until the “[Patent Office] meets its burden”). Additionally, “[i]f 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; *In re United Distillers PLC*, 56 USPQ2d at 1222.

Applicant submits that the evidence of record submitted by the Examining Attorney does not meet the burden of establishing that the primary significance of the proposed mark CULLINAN is as a surname. Further, Applicant’s evidence rebuts any showing that the mark CULLINAN is primarily merely a surname, or at a minimum, raises a doubt that should be resolved in favor of Applicant to allow its application to proceed to publication.

B. All Of The Relevant Surname Factors Weigh In Applicant’s Favor

The Trademark Trial and Appeals Board has established five factors to be considered in determining whether a mark is primarily merely a surname:

- (1) whether the surname is rare;

- (2) whether the term is the surname of anyone connected with the applicant;
- (3) whether the term has any recognized meaning other than as a surname;
- (4) whether it has the “look and feel” of a surname; and
- (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression.

TMEP § 1211.01; *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995).

Applicant submits that based on the evidence of record, factors one through four weigh in its favor and supports approving its mark for publication. Specifically, the mark CULLINAN is an extremely rare surname, it is not the surname of anyone connected with Applicant, the term has a recognized meaning other than as a surname, and as intended to be used to identify Applicant’s automobiles, the mark does not have the “look and feel” of a surname. Factor five is irrelevant here given that the proposed mark is a standard character mark.¹

1. Evidence of Record Demonstrates That “Cullinan” Is An Extremely Rare Surname

“The rarity of a surname is an important factor to be considered in determining whether a term is primarily merely a surname.” TMEP § 1211.01(a)(v); *In re Garan, Inc.*, 3 USPQ2d 1537 (TTAB 1987) (“the degree of a surname’s rareness should have material impact on the weight given the directory evidence”). Both the Examining Attorney’s evidence and Applicant’s evidence demonstrates that “Cullinan” is an extremely rare surname, and accordingly will not be perceived as primarily merely a surname.

a. LexisNexis Telephone Directory Evidence

The Examining Attorney’s evidence of 630 listings from the *LexisNexis* nationwide U.S. telephone directory which contains over 93 million telephone numbers demonstrates that “Cullinan” is an extremely rare surname,² and that the Examining Attorney had not met her burden to provide evidence of a *significant* number of nationwide listings to establish primary surname significance. Although there is

¹ “Where the mark is in standard characters, it is unnecessary to consider the fifth factor.” TMEP § 1211.01 *citing In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

² According to the “Source Information” for this database the directory contains “[o]ver 93 million telephone numbers.” (Feb. 24, 2015 Response to Office Action, Bradley Decl. ¶ 3, Ex. C.)

no minimum number of telephone number listings needed to prove that a mark is primarily merely a surname, the “burden is upon Examiner of Trademarks in the first instance to present evidence, as for example a *significant* number of listings in telephone directories, sufficient to make out a prima facie showing in support of his contention that a particular mark is primarily merely a surname.” *In re Ciclo Tecnica Industrial, S.A.*, 194 USPQ 547, 548 (TTAB 1977) (emphasis in original).

An analysis of the listings provided by the Examining Attorney demonstrates that that burden has not been met here. First, the Examining Attorney has only attached 100 of the results so it is not possible to determine if any of the additional results should be considered, or if they are merely duplicative. *See In re Hall Wines*, App. No. 78926151, 2009 TTAB LEXIS 252, *5 n. 8 (TTAB Feb. 10, 2009) (“because the examining attorney only provided a partial listing (for the first one hundred), there is certainly the possibility that more duplicative entries exist”). For example, in the listings the Examining Attorney did provide, numbers 37 and 38 are both for “Bill Cullinan” on the same street in Glendive, MT indicating that they may be for the same individual. (Aug. 25, 2014 Office Action, TSDR p. 7.) Second, a review of the 100 listings provided shows that there are individuals with the surname “Cullinan” in only approximately half the states (there are twenty three states that do not show up at all in the results), and in most of the states that did show results, there were only a handful of people with the last name “Cullinan.”³ Such results do not establish that the primary significance to the nationwide purchasing public is as a surname. *See In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007) (concluding “Baik” is an extremely rare surname based on the fact that only 456 results returned from a computer search of the Verizon superpages.com).

Additionally, the Board has explained that an analysis of telephone listings requires an examination of the number of listings produced by the Examining Attorney in light of the overall size of

³ Specifically, the breakdown is as follows: AL (1 person), AZ (4 people), CT (2 people), CA (4 people), CO (1 person), FL (6 people), GA (1 person), IA (6 people), ID (1 person), IL (7 people), KY (1 person), MA (15 people), MD (3 people), ME (1 person), MN (5 people), MO (1 person), MT (5 people), NC (7 people), NJ (2 people), NV (1 person), NY (11 people), OH (3 people), PA (4 people), SC (1 person), TN (3 people), TX (2 people), and WA (2 people). (*See* Aug. 25, 2014 Office Action, TSDR pp. 6-10.)

the database. See *In re Garan, Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987) (finding that the 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 some 43 directories of major population centers”). For example in *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994), the Board explained that in considering the 100 listings there, “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.” *Id.* Based on the record there, the Board concluded that “SAVA is indeed a rare surname.” Additionally, in another case, the Board concluded that “Baik” was “an extremely rare surname” 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 Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007). Finally, in *In re Amlin plc*, App. No. 79011475, 2008 TTAB LEXIS 473, *4-*5 (TTAB Sept. 30, 2008), based on listings data showing the surname Amlin “for only one in every two million individuals in the U.S. population” the Board concluded that “‘Amlin’ is such an extremely rare surname 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.”

Following the Board’s guidance here, considering the 630 listings produced by the Examining Attorney, only 100 of which were made of record, in a database of over 93 million listings, and considered as well in light of the overall population of the United States of over 318 million,⁴ the showing is that “Cullinan” is an extremely rare surname. (Feb. 24, 2015 Response to Office Action, Bradley Decl. ¶¶ 3-4, Exs. B, C.) See *In re Okamoto Corp.*, App. No. 85739429, 2015 TTAB LEXIS 301, *5 (TTAB February 6, 2015) (reversing refusal to register concluding that “evidence of 738 entries is not substantial evidence that the term ‘Okamoto’ is a common surname” and supports finding that it is a rare surname). In particular, viewing the search results of 630 listings in light of the total population of the United States, shows that there is but one individual with the surname “Cullinan” for every 506,122 individuals. If the

⁴ According to the U.S. Census Bureau, Population Division, the estimated 2014 population of the United States was 318,857,056 individuals. (Feb. 24, 2015 Response to Office Action, Bradley Decl. ¶ 3, Ex. B.)

Board only considers the 100 results that are actually of record, there is but one individual with the surname “Cullinan” for every 3,188,570 individuals. Similar to the Board’s determination in *Benthin*, such evidence demonstrates extreme rareness, and that no one will be adversely affected by the registration of “Cullinan” for automobiles:

[W]e find that Benthin is indeed a rare surname, and that this first factor weighs in favor of a finding that BENTHIN and design would not be perceived as primarily merely a surname. In considering the approximately 100 Benthin listings found in the PHONEDISC U.S.A. data base, we have recognized -- as we did in the *Sava* case -- the massive scope of this data base. Indeed, this data base demonstrates the rarity of the surname Benthin by showing that there is but one Benthin for every 750,000 Listings. In other words, the surname Benthin is, if not one in a million, one in three quarters of a million.

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333 (TTAB 1995). See also *In re Keo Limited*, App. No. 75612931, 2001 TTAB LEXIS 351, *2-*4 (TTAB May 3, 2001) (reversing refusal to register and concluding KEO is a rare surname where nationwide database returned only 357 listings out of 115 million listings).

b. U.S. Census Data

“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.) The TMEP instructs that “search results from this database may be more persuasive evidence of surname frequency than results from telephone directory listings.” TMEP § 1211.02(b)(iii). Accordingly, the absence of “Cullinan” from the U.S. Census Bureau database of Top 1,000 surnames further supports, and is persuasive evidence of the extreme rarity of “Cullinan” as a surname, and that it is not likely that consumers would perceive the mark CULLINAN as primarily merely a surname. See *In re The Monotype Corp.*, 14 USPQ2d 1070, 1070-71 (TTAB 1989) (absence of “Callisto” from telephone directories showed that it was a rare surname).

c. Ancestry.com Data

The Examining Attorney placed excerpts into the record from www.ancestry.com containing a color-coded map showing the number of Cullinan families in the United States per state from 1920 census

data. (March 18, 2015 Final Office Action, Attachments 5 and 6.) The color-coded map shows that 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. Evidence of such a low number of families with the surname demonstrates the extreme rarity and that the primary significance is not as a surname. *In re IdeaStream Consumer Prods. LLC*, App. No. 76543788, 2005 TTAB LEXIS 554 (TTAB Dec. 27, 2005) (60 listings of name showed rarity and “evidence as a whole does not convince us that more than a small segment of the general public has been exposed to the surname meaning of this term”).

Additionally, 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 available on the website) returned *no results*. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 1.) This evidence further demonstrates the extreme rarity of “Cullinan” as a surname in the United States, and supports that the primary significance of “Cullinan” is not as a surname.

d. Newspaper Articles

Newspaper articles are relevant in assessing rareness only to the extent the coverage shows “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) (same). Accordingly, it is not sufficient for an unknown individual to be mentioned in passing in an article published in a local publication; rather the articles must be in publications with widespread circulation and discuss well-known public personalities in order to be probative of surname significance.

As demonstrated in *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1922-23 (TTAB 2007), the Board held there that the article evidence presented by the examining attorney did not establish surname significance because it either came from publications that “are not as widely read as articles for general circulation” or “from trade papers . . . that similarly would appear to have limited readership.” Additionally, in the articles actually appearing in general circulation newspapers “the name Baik is buried in the text of the articles and would be likely to go unnoticed by most readers.” Similarly, in *In re*

Okamoto Corp., App. No. 85739429, 2015 TTAB LEXIS 301, *7-*10 (TTAB February 6, 2015), the Board found unpersuasive excerpts of articles from local newspapers, articles about local individuals, articles about an actress where it could not be determined “whether she is an actress of particular note,” and articles from sources where “it is unclear whether the readership for any of these excerpts is widespread, or more limited due to the subject matter.”

The 10 articles presented by the Examining Attorney in the March 18, 2015 Final Office Action are unpersuasive as they come from local newspapers with limited readership, and only mention local individuals, often with the names buried in the text of the articles, and do not concern any “public personalities. The articles do not demonstrate primary surname significance, and in fact support the rareness of “Cullinan” as a surname. Such local publications and articles include:

- “The Observer,” a student paper serving “Notre Dame & Saint Mary’s”: mentions in passing, halfway through the article, a student, Molly Cullinan, who helped plan a local fundraising race;
- “The Naugatuck Patch”: identifies a man who was arrested and charged with breach of peace as Joseph Cullinan;
- “The Salem News”: identifies Elizabeth Cullinan as a bride who was married in a blizzard;
- NJ.com Suburban News: identifies Mrs. Cullinan as a teacher of a sixth grade Social Studies class that dressed up as Greek and Roman gods and goddesses;
- The Tribune: in an article about “local art teachers” identifies in the middle a Council Board chairman, Francis Cullinan;
- NewJerseyHills.com: identifies Kiera Cullinan as an editor of a student literary magazine;
- The Fresno Bee: in an article regarding the local Valley Children’s Hospital kids day, identifies Tom Cullinan as the publisher of the local paper; and
- “The Spokesman Review”: identifies Eastern Washington University’s president as Mary Cullinan.

Of the two remaining articles, one is from a trade publication, *Accounting Today*, and accordingly appears to have limited readership, and the other addresses accountant Brian Cullinan’s participation in ballot counting for the Oscars. Like the actress in *In re Okamoto Corp.*, there does not appear to be evidence that the accountant was of particular note. Additionally, based on the articles submitted by the

Examining Attorney the coverage of the accountant's role appeared to be for a short period in time such that it does not establish widespread recognition.

The Examining Attorney also attached 17 articles to its denial of Applicant's request for reconsideration which are not properly on record and should not be considered. Specifically, TMEP § 1211.02(b)(ii) directs that:

An Office action that includes any evidence obtained from a research database should include a citation to the research service and a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search (e.g., LexisNexis®, News and Business, All News, Aug. 5, 2007). The electronic record or printout summarizing the search should be made a part of the record.

The Examining Attorney attached the 17 articles to the denial without any discussion and there is no record of what search was conducted, the libraries or files that were searched, or the date of the search, and there is not an electronic record or print-out summarizing the search. (*See* Oct. 9, 2015 Reconsideration Letter.) Additionally, the article print-outs indicate that there were 100 documents returned in the unidentified search, but the Examining Attorney only attached 17 articles without any further explanation. Where "an examining attorney submits a very limited number of articles without indicating that it is a representative sample of a certain number of articles, the Board will assume that these are the only articles that support the examining attorney's position." TBMP § 1208.01. Further, the Board "must conclude" that the 83 articles "not made of record do not support the position that [CULLINAN] is a surname and, indeed show that [CULLINAN] has nonsurname meanings." *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989).

Even if the additional 17 articles are considered, the articles do not alter the analysis as almost all are from local newspapers regarding local events involving local individuals, and do not demonstrate widespread media coverage of public personalities with "Cullinan" as a surname.⁵ Specifically, the subjects and sources of the articles breakdown as follows:

⁵ An article from The New York Times on the web in the business and financial section discusses that the The Royal Bank of Scotland's head of its corporate and institutional bank is leaving the company, but there is no evidence that the individual is a public personality with widespread media coverage. The other potential national new source, The Hollywood Reporter.com only identifies an accountant from

- An announcement in The Ridgefield Press regarding Ridgefield Academy’s hiring a new sous chef;
- An announcement in the business briefs of East Peoria Times-Courier regarding Kathleen Cullinan Brill’s promotion to vice president, director of leasing;
- Reporting of local crimes in The Sun Chronicle (Attleboro, Massachusetts) (local news section), and in the Wellsley Townsman;
- Obituaries for local individuals published in The Augusta Chronicle, Ad Express & Daily Iowegian, and News Tribune (La Salle, Illinois);
- An Article in Lancaster Bee identifying the coach of Cheektowaga Central boys basketball team who won All-Bee Coach of the year;
- An article in Cheney Free Press (“from SmallTownPapers, Inc.”) regarding Eastern Washington University’s president;
- An article from the PR Newswire Association LLC regarding the opening of a Family Dental Center in Glenview, Ill.;⁶
- Articles in Iowa City Press – Citizen, and Sun Journal (Lewiston, Maine) regarding local authors;
- An article in the trade publication The Rhode Island Lawyers Weekly regarding an award of unpaid vacation time;
- The Tampa Tribune article regarding a local event in which hundreds of dentists offered free care; and
- An article in The Orange County Register regarding Mission Viejo’s hiring a new boys basketball coach.

These limited local articles proffered by the Examining Attorney “fall far short of . . . supporting a finding that individuals having this surname have enjoyed broad exposure to the general public such that [“Cullinan”] is well recognized as a surname.” *In re Amlin plc*, App. No. 79011475, 2008 TTAB LEXIS

Pricewaterhouse Coopers who participated in ballot counting for the Oscars. As noted above, there is no evidence that the accountant is a public personality and the evidence of record shows only limited publicity for a short period of time.

⁶ Given that this is a newswire article and there is no evidence it was actually published, it has limited probative value, if any. See *In re Classic Media, Inc.*, 78 USPQ2d 1699, 1701 (TTAB 2006) (“There is nothing in the record to indicate that this wire report was distributed; thus, it is entitled to only minimal probative value in that we cannot judge the public’s exposure to the use of the phrase in the wire report.”); *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB Sept. 25, 2001) (several article not considered because were “newswire stories (presumably unpublished)”).

473, *4-*5 (TTAB Sept. 30, 2008). Given the relative obscurity of the article references, the articles support a finding that “Cullinan” is an extremely rare surname.

e. Other Internet Print-Outs

The Examining Attorney also made of record a print-out from a law firm website of the bio of an attorney Thomas A. Cullinan, a print-out from the website heidicullinan.com, and a print-out from the website of the Cullinan Education Center. (Aug. 25, 2014 Office Action, TSDR pp. 15-21.) None of these obscure references demonstrate that the primary significance to the public of “CULLINAN” is as a surname. In particular, the Examining Attorney has not produced any record evidence demonstrating that the referenced individuals or the business have garnered any media attention or fame. *See In re Joint-Stock Co. “Baik”*, 84 USPQ2d 1921, 1923 (TTAB 2007) (in holding that examining attorney failed to meet its burden to establish prima facie case, Board noted “absence of evidence that any person with the Baik surname has achieved any notoriety”); TMEP § 1211.01(a)(v) (noting that an issue to be considered is “how rarely a term is used in the media attention or publicity accorded to public personalities who have the surname”). Additionally, the Cullinan Education Center appears to only have two locations in California which demonstrates the limited exposure to the nationwide general public. (Aug. 25, 2014 Office Action, TSDR p. 15.)

Taking into consideration that all the evidence of record (both the evidence provided by the Examining Attorney as well as Applicant’s evidence) establishes that “Cullinan” is an extremely rare surname, the first factor weighs heavily in favor of holding that “Cullinan” is not primarily merely a surname.

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

Applicant submitted, clear, un rebutted evidence that a review of the corporate directory of Applicant showed that “nobody within [Applicant] or any of its subsidiaries has the surname ‘Cullinan.’” (February 24, 2015 Response to Office Action, Gessner Declaration ¶ 2.) The Examining Attorney did not address this factor in the office actions.

The fact that no one connected with Applicant has the surname “Cullinan” “weighs in favor of a finding that [CULLINAN] is not primarily a surname.” *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). *See also In re United Distillers plc*, 56 USPQ2d 1220, 1222 (TTAB 2000) (in reversing refusal to register Board noted that “there is no evidence that HACKLER is the surname of anyone connected with applicant”); *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’”). Similar to the record in *In re Aristocrat Technologies Australia Pty Ltd*, App. No. 76123722, 2004 TTAB LEXIS 137 (TTAB March 18, 2004) “this is not a situation where a company founder or other high ranking official chose to have his or her surname used...[as] the [Gessner] declaration demonstrates that there is not even a low ranking employee of the applicant with the surname.”

Accordingly, the second factor weighs in favor of allowing the mark CULLINAN to proceed to publication.

3. Primary Significance of “Cullinan” To American Public Is As A Reference To The Cullinan Diamonds And Diamond Mine

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 Cullinan diamonds and diamond mine, and associates those characteristics with Applicant’s automobiles, indicating that the trademark has a meaning other than that of a surname, and weighs against a finding that the trademark is primarily merely a surname. *See In re BDH Two Inc.*, 26 USPQ2d 1556, 1558 (TTAB 1993) (“GRAINGERS is not primarily merely a surname” where it “was coined by applicant as a suggestive term to identify its products rather than because of any surname significance”).

a. Cullinan Diamonds Have Received U.S. Press Coverage in Nationwide Publications And Are A Key Tourist Exhibit

In 1905, the largest rough gem diamond ever found at 3,106 carats was discovered and named the Cullinan diamond. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. D, p. 1.) In 1907, the

government of South Africa gifted the Cullinan Diamond to Edward VII. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. E, p. 2.) Several stones cut from the original Cullinan diamond have been incorporated into the world famous Royal Crown Jewels, including the Imperial State Crown and the Sovereign Sceptre. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. E.) 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.) The Tower of London which displays the Royal Crown Jewels featuring the Cullinan diamonds is one of the top tourist destinations in London. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 9.) The Royal Crown Jewels have also been covered in the U.S. press including in the celebrity e-magazine People.com. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Exs. 10-11.) 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.) Bloomberg Business describes the Cullinan Stone as “[t]he largest mined diamond” and reports that it is set into “Britain’s Crown Jewels.” (*Id.*, Ex. 11, p. 3.)

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. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 2.) The “Cullinan Blue Diamond Necklace” initially went on display in 2010 in the Harry Winston Gallery adjacent to the Hope Diamond. (*Id.*) In Spring 2011, the “Cullinan Blue Diamond Necklace” moved to the National Gem Gallery and is identified as one of the gallery’s “highlights.” (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 3.)

In 2009 another large, and now publicized diamond, the Cullinan Heritage, was discovered at the Cullinan diamond mine. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 5, p. 3.) The creation of a lavish necklace from the Cullinan Heritage has received nationwide coverage in the United States on both cnn.com and forbes.com. (*Id.*, Exs. 5-6.) CNN identifies the Cullinan mine as “[t]he mine where the majority of the world’s most famous diamonds have been discovered.” (*Id.*, Ex. 5, p. 3.) The CNN article uses a photo gallery to “[t]race the journey of one of the world’s rarest and largest

diamonds” from its acquisition for \$35.3 million through the design and 47,000 hours of work taken to turn the Cullinan Heritage into a single necklace. (*Id.*, Ex. 5, pp. 1, 5, 11.) Forbes describes the Cullinan Heritage as “an exceptionally rare 507.55 carat Type IIa rough diamond.” (*Id.*, Ex. 6, p. 1.) Dr. Henry Cheng, chairman of the company that purchased the Cullinan Heritage described the creation of the necklace as “continuing the Cullinan legend.” (*Id.*, Ex. 6, p. 6.)

A particularly illustrative example of the meaning the term “Cullinan” has to the American public is an article published on ABC News’ website that uses 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.) Specifically, the scenario in the lead paragraph states: “A monster storm is on a collision course with New York City and an evacuation is under way. . . . Within minutes, the world’s largest polished diamond, the Cullinan I, on loan to the Metropolitan Museum of Art from the collection of the British Crown Jewels, is whisked away by helicopter. While this may sound like the elevator pitch for an action film, the possibility of such a scenario is more fact than fiction these days.” (*Id.*, Ex. 12, pp. 1-2.) The article demonstrates that the Cullinan diamond has achieved widespread recognition as a representation of luxury in the United States.

The evidence of record establishes that the Cullinan Diamond is well-known, and the Board has held that terms that reference well-known places, people or things are not primarily merely surnames. *In re United Distillers PLC*, 56 USPQ2d 1220, 1221-22 (TTAB 2000) (association with term in well-known poem indicated that the mark “Hackler” was not primarily merely a surname); *In re Rohan Designs Limited*, Application No. 75/200,776, 2000 TTAB LEXIS 443, *7-*8 (TTAB June 28, 2000) (evidence that ROHAN was the name of a geographical area in J.R.R. Tolkien’s novel Lord of the Rings led to conclusion that term has “a recognized, well-known meaning other than that of a surname”);⁷ *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 (TTAB 2000) (finding the primary significance of M. C. ESCHER to be that of a famous deceased Dutch artist).

⁷ A copy of this decision is attached hereto as Exhibit A.

b. Cullinan Diamond Mine

Cullinan is also the name of one of the world's most celebrated diamond mines and is a source of large, high-quality Type II gem diamonds. (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 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. (*Id.*) It is also the world's only significant source of truly rare and highly valuable blue diamonds. (*Id.*) Some other diamonds that have been discovered in the Cullinan mine include:

- a 507 carat white diamond which was named the Cullinan Heritage and sold in 2010 for \$35.3 million (the highest price on record for a rough diamond);
- a 39 carat blue diamond which sold for \$8.8 million;
- a 26 carat blue diamond which was cut into a perfect 7 carat polished stone and sold for \$9.4 million in 2009;
- a 25.5 carat blue diamond that sold for \$16.9 million in 2013;
- a 29.6 carat blue diamond which sold for \$25.6 million in February 2014;
- a 122.52 carat blue diamond which sold for \$27.6 million in September 2014; and
- a 232 carat white diamond, discovered in September 2014 and expected to be sold in 2015.

(*Id.* Ex. D, p. 1)

In September 2014, the discovery of a 232.08-carat diamond at the Cullinan mine received nationwide news coverage in the United States on the NBC News website. (Sept. 18, 2015 Request for Reconsideration, Second Bradley Decl. Ex. 4.) The article 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.*) The Cullinan mine has also been the subject of various artistic and photographic works, including a two week exhibition of Cullinan Drawings in London’s Mayfair district. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. D, pp. 1-2.)

c. Negative Dictionary Evidence Does Not Establish Surname Significance

The mere fact that “Cullinan” does not appear in four dictionaries referenced by the Examining Attorney is not determinative of surname significance and fails to establish a prima facie case. *See In re BDH Two, Inc.*, 26 USPQ2d 1556, 1557-58 (TTAB 1993) (explaining that examining attorney’s dictionary evidence showing no listing “does not mandate refusal”). As the Board explained in *In re Garan Inc.*, 3 USPQ2d 1537, 1539 (TTAB 1987) with regard to negative dictionary evidence, “[t]hat there are no other meanings of the name in the English language will not support refusal of registration of the surname under the ‘primarily merely a surname’ statutory language unless the average member of the purchasing public would, upon seeing it used as a trademark, recognize it as a surname.” Given the other evidence of record establishing the rareness of “Cullinan” as a surname, the purchasing public is not likely to recognize it as a surname when used in connection with Applicant’s automobiles. Moreover, when considering that the primary meaning of “Cullinan” to the American public is to refer to the prestigious and rare, large diamonds, rather than an ordinary word, the lack of dictionary evidence is expected.

d. American Public Is Not Aware of Sir Thomas Cullinan

The Examining Attorney submitted one article regarding Sir Thomas Cullinan which is not properly of record, and does not demonstrate the significance of the term “Cullinan” to the general American public. First, the article does not bear a url or date, and accordingly is not properly of record. *See* TMEP § 710.01(b) (“When making Internet evidence part of the record, the examining attorney must . . . provide complete information as to the date the evidence was published or accessed from the Internet, and its source (e.g., the complete URL address of the website)”). Second, the article appears to come from a foreign website titled South African History Online,⁸ there is no evidence of record showing the American public is aware of this foreign website, and 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

⁸ There is no url printed on the page so the source of the article is not clear.

perception of a term that is determinative.”); *In re BDH Two, Inc.*, 26 USPQ2d 1556 (TTAB 1993) (“it is the surname significance of the term in the United States which is determinative of the registrability issue” and noting with respect to foreign publications “we are unable to conclude. . .that there has been any meaningful exposure of ‘Grainger’ as a surname in the United States.”)

There is no evidence in the record that Sir Thomas Cullinan was a famous figure or that the U.S. public is even aware of him. None of the publications from U.S. websites reference or mention Sir Thomas Cullinan, rather they only use “Cullinan” to refer to the diamonds or the mine. Indeed, the evidence properly of record shows widespread recognition and exposure to the original Cullinan diamond and other Cullinan diamonds without any reference to Sir Thomas Cullinan demonstrating that the primary significance of “Cullinan” to the American public is the diamonds and the qualities evoked by diamonds rather than as a surname.

4. “Cullinan” Does Not Evoke The “Look” Or “Feel” Of A Surname

Based on the meaning of “Cullinan” as the world’s largest diamond, and the characteristics of luxury and prestige suggested by such a reference, the mark CULLINAN does not have the look or feel of a surname, and the Examining Attorney may not rely on this factor to establish primary surname significance. *In re Champion International Corp.*, 184 USPQ 362, 363 (TTAB 1974) (“[i]t is not sufficient for an affirmative holding in this regard to hold...that the term looks and sounds like a recognized surname”); *In re Barcorp Industries, Inc.*, 187 USPQ 61 (TTAB 1975) (“manifestly [the examiner] cannot rely on the fact that a term looks like a surname”).

a. “Cullinan” Evokes Luxury In Relation To Motor Vehicles

The “look and feel” of Applicant’s mark CULLINAN is not determined in isolation, but must be considered in relation to the motor vehicle goods covered by Applicant’s application. “[T]he issue presented . . . is whether the term [“Cullinan”] is primarily merely a surname, in terms of what the word means to the relevant purchasers of applicant’s goods. A term is primarily merely a surname if, when applied to a particular product . . . its primary significance to the purchasing public is that of a surname.” *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000) (reversing refusal to register).

Here, the evidence indicates that the term “Cullinan” evokes luxury and prestige based on the diamond and mine. Accordingly, using “Cullinan” in connection with Applicant’s motor vehicles will lead purchasers to conclude that the motor vehicles are luxurious and prestigious. Additionally, the absence of any evidence of record showing the use of surnames as trademarks for motor vehicles further supports that the public perception of the use of “Cullinan” in connection with automobiles will be as a trademark evoking luxury and prestige. *See In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (in reversing refusal to register Board noted that there was not “any evidence that surnames have been used as trademarks for typefonts (or related goods), such that the public would attribute a surname significance to CALISTO when it is applied to applicant’s goods”).

Further, the manner in which Applicant uses its trademarks in connection with motor vehicles demonstrates that the “appearance and use” of “Cullinan” will not be “in a form akin to that of a surname.” *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987). In particular Exhibit F demonstrates the manner in which Applicant has used its trademarks to identify its automobiles, *i.e.* the usage of the marks are prominent and set-off from other text such that they have the appearance of trademarks, and the mark CULLINAN is intended to be used in a similar manner. (Feb. 24, 2015 Response to Office Action, Bradley Decl. ¶ 7, Exs. F-G.)

b. Rarity of “Cullinan” Demonstrates Mark Does Not Look Or Feel Like A Surname

As established in Section II.B.1, “Cullinan” is an extremely rare surname. “[C]ertain surnames are so rare that they do not even have the appearance of surnames.” TMEP § 1211.01(a)(vi). Such is the case here where the rarity combined with the recognition of the “Cullinan” diamonds and mine support that consumers would not associate the “look” or “feel” of a surname with “Cullinan.” *See In re United Distillers plc*, 56 USPQ2d 1220, 1222 (TTAB 2000) (“we find that this relatively rare surname will not be perceived as primarily merely a surname”).

c. Evidence Regarding Other Surnames Not Probative Of Surname Significance

Applicant submits that telephone listings for other surnames cited by the Examining Attorney were not properly made of record and are irrelevant to the determination of the perception of the term “Cullinan.” (See March 18, 2015 Final Office Action, TSDR p. 4, 6-14.) For the lists allegedly relating to the surnames “Cullen” and “Culligan,” the Examining Attorney has not complied with TMEP § 1211.02(b)(ii) for making research database of evidence as there is no indication in the record of the library or files that were searched, the date of the search, or an electronic record or printout summarizing the search. Further, there is no indication that the search results were printed from the LexisNexis directory, as an incomplete list was merely included within the text of the Office Action.

Additionally, telephone directory evidence is only relevant when it relates to the surname significance of the mark at issue. See e.g. TMEP § 1211.02(b)(i). Regardless, neither “Cullen” nor “Culligan” appear in the U.S. Census Bureau list of Top 1,000 surnames, and accordingly are themselves rare which supports granting registration to Applicant. (Feb. 24, 2015 Response to Office Action, Bradley Decl. Ex. A.) As the Board has previously held, “we are not convinced that the similarity of Baik to other obscure surnames somehow results in Baik having the ‘look and feel’ of a surname.” *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007).

Further, the alleged evidence relating to “Cullen” and “Culligan” is irrelevant as there is no evidence of record demonstrating that the American public associates “Cullinan” with either of those alleged surnames. The Board has previously held that “it is not sufficient” for an examining attorney to simply hold “that the term looks and sounds like a recognized surname.” *In re Champion International Corp.*, 184 USPQ 362, 363 (TTAB 1974); see also *In re Barcorp Industries, Inc.*, 187 USPQ 61 (TTAB 1975) (“manifestly [the examiner] cannot rely on the fact that a term looks like a surname”). As noted in a concurring opinion, “if the Office is not able to muster sufficient evidence to show that the mark is the surname of a reasonable number of people, and must instead resort to finding other surnames which

rhyme with the mark or differ from the mark by one or two letters, I believe that it is not proper to refuse registration.” *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007).

5. Public Interest Favors Allowing “Cullinan” To Register

Given the extreme rarity of “Cullinan” as a surname, the fact that nobody connected with Applicant has the surname, and the well-recognized meaning other than as a surname, allowing Applicant’s mark CULLINAN to register is in line with the policy behind the limitation of refusals to terms with a “primary” surname significance. As the Board has explained:

The purpose of the change made by the Act of 1946 was to liberalize the previously existing practice. Under the law surnames were considered unregistrable and any word which was in use as a surname would be refused registration even though the word had a common meaning and its use as a surname was minor. The addition of the word ‘primarily’ indicates that . . . if the word has ordinary meanings as a word and its use as a surname is relatively unimportant, it may be registered without regard to the fact that it might have been used as a surname.

In re Lesney Products and Co., 181 USPQ 401, 402 (TTAB 1974) (reversing refusal to register).

“[T]he purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses . . . If a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.” *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1921, 1924 (TTAB 2007) (concurring opinion). Given the extreme rarity of “Cullinan” as a surname, and the lack of any evidence associating the surname “Cullinan” with motor vehicles, allowing registration of the mark CULLINAN in connection with motor vehicles will not be injurious to the public.

III. Conclusion

For the reasons set forth herein, Applicant respectfully submits that the subject mark CULLINAN is not primarily merely a surname. 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,

December 14, 2015

By: /Jessica D. Bradley/

Jessica D. Bradley
JONES DAY
51 Louisiana Avenue, N.W.
Washington, D.C. 20001-2113
202.879.3939

Attorney for Applicant
Bayerische Motoren Werke Aktiengesellschaft

INDEX OF CASES

	Page
<i>In re Amlin plc</i> , App No. 79011475, 2008 TTAB LEXIS 473 (TTAB Sept. 30, 2008).....	5, 10, 11
<i>In re Aristocrat Technologies Australia Pty Ltd</i> , App. No. 76123722, 2004 TTAB LEXIS 137 (TTAB March 18, 2004)	12
<i>In re Barcorp Industries, Inc.</i> , 187 USPQ 61 (TTAB 1975).....	17, 19
<i>In re BDH Two Inc.</i> , 26 USPQ2d 1556 (TTAB 1993).....	12, 16, 17
<i>In re Benthin Management GmbH</i> , 37 USPQ2d 1332 (TTAB 1995).....	3, 6
<i>In re Champion International Corp.</i> , 184 USPQ 362 (TTAB 1974).....	17, 19
<i>In re Ciclo Tecnica Industrial, S.A.</i> , 194 USPQ 547 (TTAB 1977).....	4
<i>In re Classic Media, Inc.</i> , 78 USPQ2d 1699 (TTAB 2006).....	10
<i>In re Garan, Inc.</i> , 3 USPQ2d 1537 (TTAB 1987).....	3, 5, 16, 18
<i>In re Gregory</i> , 70 USPQ2d 1792 (TTAB 2004).....	7
<i>In re Hall Wines</i> , App. No. 78926151, 2009 TTAB LEXIS 252 (TTAB Feb. 10, 2009).....	4
<i>In re Hutchinson Technology Inc.</i> , 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).....	2
<i>In re IdeaStream Consumer Prods. LLC</i> , App. No. 76543788, 2005 TTAB LEXIS 554 (TTAB Dec. 27, 2005)	7
<i>In re Joint-Stock Co. "Baik,"</i> 84 USPQ2d 1921 (TTAB 2007).....	passim

<i>In re Kahan & Weisz Jewelry Mfg. Corp.</i> , 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975).....	2
<i>In re Keo Limited</i> , App. No. 75612931, 2001 TTAB LEXIS 351 (TTAB May 3, 2001)	6
<i>In re Lesney Products and Co.</i> , 181 USPQ 401 (TTAB 1974).....	20
<i>In re The Monotype Corp.</i> , 14 USPQ2d 1070 (TTAB 1989).....	6, 9, 18
<i>In re Okamoto Corp.</i> , App. No. 85739429, 2015 TTAB LEXIS 301 (TTAB February 6, 2015)	5, 8
<i>In re Opus One, Inc.</i> , 60 USPQ2d 1812 (TTAB Sept. 25, 2001).....	10
<i>In re Rohan Designs Limited</i> , App. No. 75200776, 2000 TTAB LEXIS 443 (TTAB June 28, 2000)	14
<i>In re Sava Research Corp.</i> , 32 USPQ2d 1380 (TTAB 1994).....	5, 12
<i>In re United Distillers PLC</i> , 56 USPQ2d 1220 (TTAB 2000).....	passim
<i>In re Yeley</i> , 85 USPQ2d 1150 (TTAB 2007).....	2, 3
<i>Michael S. Sachs Inc. v. Cordon Art B.V.</i> , 56 USPQ2d 1132 (TTAB 2000).....	14

EXHIBIT A



In re Rohan Designs Limited
Serial No. 75/200,776
Trademark Trial and Appeal Board
2000 TTAB LEXIS 443
December 7, 1999, Hearing
June 28, 2000, Decided

DISPOSITION:

[*1]

Decision: The refusal to register the mark ROHAN under Section 2(e)(4) is reversed.

COUNSEL:

Harold L. Marquis and Ryan A. Schneider of Deveau, Colton & Marquis for applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

JUDGES: Before Simms, Seeherman, and McLeod, Administrative Trademark Judges.

OPINION BY: McLeod, Linda K.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Opinion by McLeod, Administrative Trademark Judge:

An application has been filed by Rohan Designs Limited to register the mark ROHAN for "leather and imitation leather, and the use therein in making goods, namely trunks and traveling bags; luggage; bags; backpacks; wallets; belts; umbrellas; parasols and walking sticks" in International Class 18 and "articles of outerclothing and underclothing, and waterproof articles of outerclothing, namely, rainwear; mackintoshes; coats; jackets; fleece jackets; waistcoats; trousers; breeches; underbreeches; leggings; dresses; skirts; culottes; blouses; track suits; sweatshirts, sweaters; tops; shirts; polo shirts; T-shirts; undershirts; vests; shorts; pants; underwear; socks; headwear; hats; caps; scarves; [*2] gloves; mittens; footwear; boots; shoes; salopettes; slippers; belts" in International Class 25. n1

n1 Application Serial No. 75/200,776, filed November 20, 1996, based upon a bona fide intent to use the mark in commerce under Section 1(b), 15 U.S.C. § 1051(b). Applicant claims ownership of Registration No.

1,733,157 for the mark ROHAN for "articles of clothing; namely, underbreeches, T-shirts and under skirts."

The Trademark Examining Attorney has finally refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that applicant's mark is primarily merely a surname.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was held.

In support of his surname refusal, the Examining Attorney has made of record approximately 1,170 ROHAN surname listings from PHONEDISC POWERFINDER USA ONE 1997 (3rd ed.). As additional evidence, the Examining Attorney relies upon pages from *Webster's Ninth New Collegiate Dictionary* and *Webster's New Geographical Dictionary*, which show no listing of the term "Rohan." According to [*3] the Examining Attorney, this evidence is sufficient to meet his burden of proving that the applied-for mark is primarily merely a surname. The Examining Attorney also argues, among other things, that the evidence submitted by applicant during prosecution is insufficient to show that ROHAN has another meaning which is well enough known to the public to rebut the Examining Attorney's prima facie surname case.

Applicant, on the other hand, contends that the Examining Attorney has failed to establish a prima facie surname case. Applicant challenges the Examining Attorney's PHONEDISC evidence on the ground that it represents a small fraction of the total U.S. population, and that a number of the listings are duplicative. As a result, applicant concludes that ROHAN is, at most, a rare surname. Applicant claims that there are only twelve listings of ROHAN in the *Greater Atlanta White Pages* (1995). According to applicant, the term ROHAN was selected by applicant because of its literary meaning of a fictional geographical area in J.R.R. Tolkien's novel "Lord of the Rings." n2 Applicant argues, among other things, that ROHAN is the name of a small town in France; that it does not have [*4] the look or sound of a surname; and that the name is not associated with anyone in applicant's business. In support of its position, applicant has submitted affidavits, telephone directory listings, and a printout from the Internet of information on the San Diego State University's academic web server that is also named ROHAN after the geographical area in Tolkien's novel.

n2 Although the copy of Tolkien's novel that accompanied applicant's brief is untimely, the Board has considered the evidence inasmuch as the Examining Attorney specifically stated that he does not object to its consideration during the oral hearing. See Trademark Rule 2.142(d).

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. *In re Hutchinson Technology Inc.*, 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), citing *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Examining Attorney to establish a prima facie case that a mark is [*5] primarily merely a surname. *Hutchinson Technology*, 852 F.2d at 554, 7 UPQ2d at 1492; *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985).

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and sound" of the surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

Turning to the first factor to be considered, the degree of a surname's rareness, the Examining Attorney has demonstrated that there are over 1,100 ROHAN surname listings from the PHONEDISC database. We recognize, however, that some of the PHONEDISC listings are duplicative n3 and that, in reality, there are relatively few ROHAN surnames scattered throughout several cities in the United States. n4 Indeed, applicant has shown that there only twelve ROHAN surnames listed in the *Greater Atlanta White Pages*. While ROHAN is not [*6] as rare as BENTHIN or SAVA, on the evidence of record we find that it is a relatively rare surname. n5 See *Benthin, supra*; *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) (one hundred SAVA surname telephone directory listings).

n3 The dissent was unable to find any duplicate ROHAN listings in the PHONEDISC evidence. However, a cursory review of the evidence reveals that there are a number of duplicate ROHAN listings. For example: Annemarie Rohan, 100 Westwood Oaks Ct., Kankakee, IL; Brendon Rohan, 1341 Harrison Ave., Butte, MT; Charles Rohan, 6508 Fenske Lane, Needville, TX; Daniel M. Rohan, 915 Cary Rd., Algonquin, IL; David J. Rohan, 664 Forest Ridge Lane, Pacific, MO; Emanuel Rohan, 6320 Lyndon B. Johnson Fwy, Dallas, TX; Howard E Rohan, 1311 Hampton Hall Drive NE, Atlanta, GA; and Joseph Rohan, 26 Denby, Marthasville, MO.

n4 Applicant's evidence concerning the degree of rareness of the ROHAN surname in London, England is irrelevant because we are concerned with whether consumers in the United States perceive the applied-for mark as primarily merely a surname.

n5 The dissent relies upon evidence that he acknowledges is not part of the record. Our decision, of course, must be based on the evidence of record, not any additional information which the dissenting judge may have obtained from his review of other files and his own search of the NEXIS database. It is the Examining Attorney's burden to submit sufficient evidence to prove the basis for refusing registration. If the Examining Attorney had in fact made of record the additional evidence discussed by the dissent, the majority may have reached a different result in this case.

[*7]

The second factor in determining whether ROHAN would be perceived as primarily merely a surname is whether "anyone connected with applicant" has the name. *In re Monotype Corp.*, 14 USPQ2d 1070, 1071 (TTAB 1989). Applicant has presented an affidavit from Mr. Freeman, chairman and managing director of applicant, attesting that no one associated with applicant has the ROHAN surname.

The third factor to be considered is whether ROHAN has recognized meanings other than that of a surname. Applicant's evidence that ROHAN is the name of a small town in France is unpersuasive on the third factor. There is simply no evidence that consumers in the United States are familiar with this small, obscure town in France. *See Harris-Intertype*, 518 F.2d at 631 n.4, 186 USPQ at 239 n.4 (Harris, Missouri, population 174, and Harris, Minnesota, population 559, held obscure); *cf. In re Colt Indus. Operating Corp.*, 195 USPQ 75 (TTAB) (FAIRBANKS (Alaska) so well known as a geographical term that it was not deemed primarily merely a surname).

On the other hand, applicant has proven that ROHAN is the name of a geographical area in T.R.R. Tolkien's novel [*8] "Lord of the Rings." According to the evidence of record, Tolkien's novel was first published in 1965, and reprinted sixty-five times. In addition, there is evidence that a major university in the United States named its academic web server after the ROHAN geographical area described in Tolkien's novel. n6 Based upon this evidence, we conclude that ROHAN has a recognized, well-known meaning other than that of a surname.

n6 The dissent is unimpressed with this evidence because there is no indication of how often the Web site is visited by users. However, the mere fact that a major university selected the term because of its use in Tolkien's novel demonstrates that ROHAN has a recognized meaning other than that of a surname.

As to the remaining factor, namely, whether ROHAN has the structure and pronunciation of a surname, we acknowledge that this is a somewhat subjective factor. Simply put, we find that ROHAN does not necessarily have the "look or sound" of a surname. *See In re Garan*, 3 USPQ2d 1537 (TTAB 1997) (GARAN does not have look or sound of surname).

E. J. Seeherman

L. K. McLeod

Administrative Trademark Judges, Trademark Trial and Appeal Board

DISSENT BY:

[*9]

SIMMS

DISSENT:

Simms, Administrative Trademark Judge, dissenting:

I strongly disagree with the conclusion of the majority that the mark ROHAN is not primarily merely a surname and that this refusal should be reversed.

As the majority acknowledges, the test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. Upon a careful review of this record, it is clear that the primary significance of the mark ROHAN is that of a surname.

First, it is interesting to note that, while the majority mentions that applicant has claimed ownership of a registration for the mark ROHAN for certain articles of clothing, the majority fails to mention that that registration issued pursuant to the provisions of Section 2(f) of the Act, *15 USC § 1052(f)*. A review of the Office database of registrations reveals that that registration was cancelled pursuant to the provisions of Section 8, *15 USC § 1058*. n1

n1 A review of that registration file, which is not of record herein, reveals a surname refusal as well as the kind of evidence from the NEXIS database which the majority seems to have desired from the Examining Attorney in this case. The numerous NEXIS printouts in the registration file show use of the name "Rohan" as a surname, including that of a dean of a law school as well as a college basketball coach. Also, during the pendency of that application, applicant was advised of a prior pending application for the mark ANDREW ROHAN for certain items of clothing. That application eventually became abandoned.

[*10]

In surname cases, even a small number of listings has been sufficient to establish a *prima facie* case of surname significance. See, for example, *In re Lewis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984). Even rare surnames have been found to be barred under the Lanham Act. See *In re Rebo High Definition Studio, Inc.*, 15 USPQ2d 1314 (TTAB 1990). In the *Benthin* and *Sava* cases, cited by the majority, there were around one hundred listings from computerized telephone directory databases. As the Examining Attorney has pointed out, even the relatively common surname Lopez comprises only .00055% of the Phonedisc database listings.

In the instant case, the Phonedisc database printouts of record reveal, by my count, 1275 listings of the surname Rohan. n2 In addition, there are no listings of this word in a geographical dictionary or in an ordinary dictionary. The majority states that:

[S]ome of the PHONEDISC listings are duplicative and that, in reality, there are relatively few ROHAN surnames scattered throughout several cities in the United States.

The statement that there are relatively few listings "scattered throughout several cities [*11] in the United States" is simply incorrect. A review of the 1275 listings reveals that individuals with the surname Rohan are located in literally hundreds of towns and cities throughout every state except Delaware. And I can find only 26 apparent duplicate listings, bringing the total down to 1249 surname listings.

n2 While the Examining Attorney states (brief, 4) that there are "approximately 1170" listings of record, my

count reveals 1275 Rohan surname listings from Phonedisc.

Even applicant's own evidence in this case shows use of Rohan as a surname. That evidence consists of a copy of an Internet search wherein the following links to Web pages are discovered:

Rohan vs. American Bar Ass'n

C4 Filing--Bob Rohan for City Council--In-Kind Contributions

Despite the evidence of surname significance, the majority, relying upon the reference to "Rohan" in Tolkien's "The Lord of the Rings" trilogy, concludes that this term has a "recognized, well-known meaning other than that of a surname." That is, "Rohan" is the "recognized, well-known" name of a mythical geographic area mentioned in that novel. This conclusion is simply absurd. An informal poll of over half [*12] a dozen of my colleagues, while revealing unanimous awareness of Tolkien's "The Lord of the Rings," shows absolutely no awareness whatsoever of the term "Rohan" from that novel. While there is no question that the book (trilogy) is a well-known piece of literature, it is another matter to say that various words, real and invented, from that series of books are also "recognized [and] well-known." Tolkien was apparently a master of inventing names and a casual review of the second in the trilogy, "The Two Towers," reveals a great many.

The majority also appears to be applying a double standard in this case. On the one hand, the Examining Attorney is apparently being told that he needed to place in the record evidence that the name "Rohan" appears as a surname in the Nexis or some other database of newspapers or magazines, even though there is evidence of over 1200 listings from the Phonedisc database. On the other hand, applicant is not being required to submit any evidence of recognition of Rohan as a geographical term from "The Lord of the Rings." That is to say, the type of evidence of purchaser recognition which the majority seems to demand of the Examining Attorney is being presumed [*13] from applicant--awareness of "Rohan" as the name of a mythical kingdom from Tolkien's work. To the same extent that the novel may be said to be "in circulation" amongst the general public, so too are the telephone directories (and the people bearing the surname Rohan, for that matter). Indeed, a Nexis search of the term "Rohan" discussed in the same articles in which Tolkien's "The Lord of the Rings" is also discussed reveals only five references in U.S. publications in over twenty years. Two of those references deal with a relatively recent video game called "Riders of Rohan" based upon Tolkien's book and two of the articles discuss "Riders of Rohan," not "Rohan" per se. Suffice it to say that "Rohan" as a fictional geographic place is rarely mentioned in the vast Nexis database. Yet, despite this fact, the majority comes to the incredible conclusion that "Rohan" is "recognized [and] well-known" as the name of a fictional geographic place. The Examining Attorney is absolutely correct that the evidence is insufficient to show that "Rohan" has another meaning which is well enough known to the public to rebut his *prima facie* case. See *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). [*14]

While this record is sufficient to establish a *prima facie* case of surname significance, I also note that searching the term "Rohan" in the News Library of the Nexis database, even just the "Last 90 days," retrieves a message that this search found over 1,000 stories where this name appeared. A review of hundreds of those "hits" shows, as expected, not one reference to Rohan as the mythical geographic area from "The Lord of the Rings." n3

n3 The name "Rohan" appears in these stories as both a surname and as a given name. I note that applicant never argued or presented any evidence on the only reasonable basis for reversal here--that Rohan is not primarily merely a surname because it is also used and recognized as a given name.

With respect to the use of this term as the name of the Web server of San Diego State University, there is also no evidence of how often that Web site is visited, especially by others than the faculty, staff and students at that institution.

Also, the name "Rohan" has the look or sound of a surname, at least to me. There are certainly a number of

surnames which end in the suffix "han", such as Callahan and Houlihan, and this name also brings to mind [*15] such other perhaps more common surnames as Rowan and Cohan (as in George M. Cohan). Applicant argues, brief, 4, that the name Rohan is similar to surnames like Cotton and King. However, those names have obvious and well-recognized dictionary meanings which detract from any possible surname significance.

Finally, I note that applicant intends to use its mark in connection with a variety of articles of clothing as well as such goods as luggage, wallets and belts. In this connection, I believe that it is a well-known fact amongst the general public that clothing is often sold under the name (or surname) of the designer or maker. Such well-known designer names include Oleg Cassini, Yves Saint Laurent, Evan Picone, Valentino, Liz Claiborne, Ralph Lauren, Versace, Bill Blass, Tommy Hilfiger, Donna Karan, Calvin Klein, Giorgio Armani and Geoffrey Beene. Suffice it to say that the general public, accustomed to the use of such names in connection with clothing and related merchandise, is all the more likely to perceive applicant's asserted mark as a surname used as a brand for clothing and other goods.

Because I believe that the Examining Attorney has established a *prima facie* case that [*16] the primary significance of the term "ROHAN" is that of a surname, and that applicant has not rebutted this showing with sufficiently probative evidence, I would affirm the refusal. n4

n4 Although I have referred to matters outside the record in this opinion, let me make it clear that the record in the application file is sufficient to make out a *prima facie* case that the primary significance of "Rohan" is that of a surname.

R. L. Simms

Administrative Trademark Judge, Trademark Trial and Appeal Board

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsAbandonmentGeneral OverviewTrademark LawProtection of RightsRegistrationGeneral OverviewTrademark LawSubject MatterNamesPersonal Names