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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79150636

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: Bayerische Motoren Werke AG

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1212768

The applicant appeals the examining attorney's final refusal to register the proposed mark CULLINAN on the ground that the mark is primarily merely a surname pursuant to Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4).

FACTS

The applicant, Bayerische Motoren Werke AG, has requested extension of protection of an international registration under Section 66(a) of the Trademark Act for the standard character mark CULLINAN for "motor vehicles, namely, automobiles, sports utility vehicles and light trucks; parts of aforesaid goods, namely, structural parts, engines and wheels" in International Class 12. The examining attorney refused registration because the matter comprising the mark is primarily merely a surname. This appeal follows the examining attorney's final refusal under Section 2(e)(4).

ARGUMENT

I. APPLICANT'S PROPOSED MARK COMPRISES MATTER WHICH IS PRIMARILY MERELY A SURNAME.

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing of acquired distinctiveness under §2(f). 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *see* TMEP §§1211, 1211.01.

The following five factors are used to determine whether a mark is primarily merely a surname:

(1) Whether the surname is rare;

(2) Whether anyone connected with applicant uses the term as a surname;

(3) Whether the term has any recognized meaning other than as a surname;

(4) Whether the term has the structure and pronunciation of a surname; and

(5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

See In re Binion, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

a. THE EVIDENCE OF RECORD ESTABLISHES THAT CULLINAN IS PRIMARILY MERELY A SURNAME.

The entire record is examined to determine the surname significance of a term. The following are examples of evidence that are generally considered to be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on specimens; dictionary definitions of the term and evidence from dictionaries showing no definition of the term. TMEP §1211.02(a).

The term CULLINAN is primarily merely a surname, as evidenced by the following:

- Telephone listings from a nationwide U.S. telephone database showing the surname CULLINAN appearing 630 times (attached to the August 26, 2014 Office action, p. 1);
- Copies of the search page results from the *Merriam-Webster, Oxford, Macmillan* , and *Collins* dictionaries for American English showing that there are no entries for the term CULLINAN (attached to the August 26, 2014 Office action, p. 2, and the March 18, 2015 Office action, pp. 49-54);
- Examples from the Internet of individuals in the U.S. marketplace whose surname is Cullinan (attached to the August 26, 2014 Office action, pp. 5-10);

- Entries from various genealogy and ancestry websites about the surname CULLINAN (attached to the March 18, 2015 Office action, pp. 2-15);
- Copies of articles published nationwide with the last few years referencing individuals whose surname is Cullinan (attached to the March 18, 2015 Office action, pp. 16-47, and the October 9, 2015 Denial of Request for Reconsideration, pp. 2-38).

This evidence supports the refusal because it shows that Cullinan is a surname and does not have any other recognized meaning in ordinary language.

The applicant's argument that Cullinan is an "extremely rare" surname with 630 listings is not persuasive. The issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database because even the most common surname would represent only a small fraction of such a database. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); *see* TMEP §1211.01(a)(v). While it is not one of the most common surnames, it is not "extremely rare".

In any case, the fact that a surname is rare does not *per se* preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (holding DARTY primarily merely a surname); *In re Rebo High Definition Studio Inc*., 15 USPQ2d 1314 (TTAB 1990) (holding REBO primarily merely a surname); *In re Pohang Iron & Steel Co*., 230 USPQ 79 (TTAB 1986) (holding

POSTEN primarily merely a surname). Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname.

b. CULLINAN HAS THE LOOK AND FEEL OF A SURNAME.

The term 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. *See* TMEP §1211.01(a)(vi). Specifically, the evidence of record shows that CULLINAN is a surname of Irish origin and related to common surnames such as Cullen and Culligan. The March 18, 2015 Office action included genealogical websites detailing the shared history of these surnames and references to each other as spelling variations of the same surname (pp. 8-13), as well as telephone database entries showing the surname Cullen appearing over 29,000 times, and Culligan appearing 1,345 times (p. 1).

This surname "look and feel" supports the refusal and stands in contrast to rare surnames that possess a coined air. *See In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921, 1924 (TTAB 2007) (reversing a surname refusal in finding that BAIK did not have the "look and feel" of a surname because it has a Russian-sounding, coined feel).

c. THE TOTALITY OF THE EVIDENCE SUPPORTS THAT THE PRIMARY SIGNIFIACNCE OF CULLINAN TO THE AMERICAN PUBLIC IS THAT OF A SURNAME

If there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness. *See In re Isabella Fiore* LLC, 75 USPQ2d 1564 (TTAB 2005) (holding FIORE not primarily merely a surname where it is also the Italian translation of the

English word “flower” and the non-surname meaning is not obscure); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (holding the relatively rare surname HACKLER not primarily merely a surname, in light of dictionary meaning); TMEP §1211.01(a)(i).

However, this does not mean that an applicant only has to uncover a non-surname meaning of a term to obviate a refusal under §2(e)(4). *See In re Nelson Souto Major Piquet,* 5 USPQ2d 1367 (TTAB 1987) (holding N. PIQUET (stylized) primarily merely a surname despite significance of the term “piquet” as “the name of a relatively obscure card game”). The mere existence of other non-surname meanings of a term does not preclude a finding that the term is primarily merely a surname. *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1621 (TTAB 2013) (holding MILLER LAW GROUP primarily merely a surname for legal services despite other meanings of the term “miller”).

The question is not whether a mark that has surname significance might also have any non-surname significance, but whether the non-surname significance is the mark’s primary significance to the purchasing public. *Id*.

The record includes evidence that an individual whose surname was CULLINAN, Sir Thomas Cullinan, was the inspiration behind the naming of a South African diamond mine and a large diamond discovered there.[1] The examining attorney and applicant thus agree that the surname Cullinan is also used in reference to a large diamond found in South Africa and its resulting cut stones.

[1] The applicant alleges that the only evidence on this issue is one article not properly made of record because the URL was inadvertently omitted from the printout. This ignores other references to Sir Cullinan in the record (attached to the March 19, 2015 Office action, pp. 2-5, is a copy of the HouseofNames.com website about the

Applicant's evidence fails to establish that the primary significance to the American purchasing public relates to these diamonds because there is no evidence reflecting that "Cullinan" has permeated the American lexicon, culture, or overall awareness as relates to diamonds or any other non-surname meaning. The applicant's evidence on this point reflects only that:

1. There is a diamond mine in South Africa named the Cullinan mine where large diamonds have been found (September 18, 2015 Request for Reconsideration, Exhibit 4);
2. The stones cut from those diamonds have been used for jewelry outside the United States (September 18, 2015 Request for Reconsideration, Exhibit 5 referencing a Chinese jeweler, and Exhibit 10 referencing the British crown jewels);
3. London is in the United Kingdom and is a popular tourist destination, including visits to see the British crown jewels (September 18, 2015 Request for Reconsideration, Exhibit 8).

From these basic facts the applicant draws the unsupported conclusion that the meaning of "Cullinan" has shifted for the American public. However, there is no evidence demonstrating that even among the small percentage of Americans who have traveled to London and also seen the crown jewels, there is any awareness or retention of the factoid that some of the jewels are made using stones from a specific diamond and what that name is. Given the history of the diamond, those who are sufficiently interested to research it would discover that someone with the surname Cullinan was involved with the originating South African mine.

Cullinan surname which includes a list of "Contemporary Notables of the name Cullinan", including Sir Thomas Cullinan and his status as having "given his name" to the diamond). The examining attorney further notes that the applicant has not rebutted with evidence or argument the assertion that the Cullinan diamond and mine were named after Sir Thomas Cullinan.

Applicant was unable to produce any dictionary, other linguistic, literary, or cultural resources supporting that "Cullinan" has non-surname significance in the general American consciousness. This is despite the news evidence submitted by the applicant. At best, the news coverage shows that for a few brief moments of time surrounding large diamond finds, there were some references to the Cullinan mine or diamonds within the news blitz some Americans may or may not have encountered as part of the nonstop news cycle. There is no evidence that any such coverage has had any effect in altering the surname significance of the name Cullinan.

Instead, the bulk of the evidence of record is that Cullinan is a surname Americans encounter as such nationwide. The applicant attempts to minimize the few dozen articles[2] and marketplace examples in the record showing Cullinan appearing in media and advertisements as a surname. The applicant characterizes the surname Cullinan as appearing in connection with only "local individuals" and "local events" (Applicant's brief, pp. 8-9), and refers to a marketplace example as unpersuasive because the service provider "appears to only have two locations in California" (Applicant's brief, p. 11). The applicant's attempt to analyze many of the dozens of examples as local to specific areas (e.g. Ridgefield, NJ, Tampa, FL, Orange County, CA, Iowa City, IA, Augusta, GA, etc.) simply highlights how the surname appears nationwide and that Americans of various walks of life encounter the surname.

[2] The applicant urges the Board not to consider the 17 articles attached to the October 9, 2015 as not being made properly of record because a record of the search conducted was not submitted, nor were copies of all articles retrieved submitted (Applicant's brief, p. 9). The examining attorney respectfully asserts that these articles are properly of record. The articles are submitted in full form showing that they were retrieved from the *LexisNexis* database, their date of publication, the copyright and publication information. As set forth in TBMP 1208.01, "It is not necessary that all articles retrieved by a search of NEXIS or other databases be submitted and, indeed, the Board discourages such submissions where they are unnecessarily cumulative or not probative."

Indeed, the strength of this volume of evidence is in fact that it shows Cullinan appearing as a surname in contexts small and large—from major business news to "ordinary" life events of birth, death, and marriage (*see e.g.*, news of a business leader of large bank whose surname is Cullinan in the *New York Times* attached to the October 9, 2015 Denial of Request for Reconsideration, pp. 28-29; news of a wedding during a blizzard involving a Cullinan family in the *Salem News* attached to the March 19, 2015 Office action, pp. 32-33). The applicant is correct that the coverage does not reference just one famous person; instead it reflects the routine and ordinary encounters Americans have nationwide relating to the Cullinan name, supporting that American consumers know it primarily as a surname.

CONCLUSION

The examining attorney has demonstrated that applicant's proposed mark consists of wording which is primarily merely a surname and thus respectfully requests that the Board affirm the refusal to register under Section 2(e)(4) of the Trademark Act.

Respectfully submitted,

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