

ARGUMENTS

Applicant has applied to register the mark HUGHES for various electronic devices in Class 9, Application No. 86/617,566. The Office refused registration on grounds that the mark is primarily merely a surname. In addition, the Office also required an amendment to the recitation of goods listed in the application.

HUGHES is not Primarily Merely a Surname

The burden is on the Office to prove that the primary significance of the HUGHES mark is as a surname. *Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 83 1 (C.C.P.A. 1975). Applicant respectfully submits that the burden has not been met. The primary significance of the mark with the relevant public is not primarily merely as a surname. HUGHES is also a given name and geographic locations in Wisconsin and Arkansas, as well as airports in California and Alaska, as shown by Applicant's evidence herein.

The Office also has objected to Applicant's recitation of goods as indefinite. As set forth more fully below, Applicant responds to this objection by amending its recitation of goods as requested.

Applicant has shown that HUGHES is not primarily merely a surname and has appropriately amended its recitation of goods. Applicant therefore respectfully requests that the Office approve its mark for publication.

The Evidence in the Record is not Sufficient to Establish HUGHES is Primarily Merely a Surname

"The test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public." *In re BDH Two Inc.*, 26 USPQ2d 1556, 157-58 (ITAB 1993). See also *In re Garan, Inc.*, 3 USPQ 2d 1537 (TTAB 1987) ("[T]he test to be applied in the administration of this provision [15 U.S.C. § 1052(e)(4)] ... is . . . what is the primary significance to the purchasing public.") (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Com' r Pats. 1955); *In re Advanced Spine Fixation Systems*, 25 USPQ 2d 1 363, 1366 (TTAB 1992) ("The test for determining whether a proposed mark is primarily merely a surname is what the term means to the purchasing public"). Thus, it is not controlling that a word may be used as a surname; what is important is how the public perceives that word.

In *Garan*, the Trademark Trial and Appeal Board reversed the Patent and Trademark Office's refusal to register the mark GARAN for hosiery on the basis that the mark GARAN was primarily merely a surname. The Office had supported the refusal with listings for the name GARAN from four telephone directories, from a NEXIS story referencing a Dr. Garan, and from the lack of an entry for "Garan" in a dictionary. The Board, however, was not persuaded by the evidence and concluded that simply because "there are no[] other meanings of the name in the English language [does] not support refusal of registration of the surname under the 'primarily merely a surname' statutory language." *In re Garan*, 3 USPQ 2d at 1539. The Board specifically noted that the Lanham Act 's legislative history indicated no intent to refuse registration of a mark merely because it consists of or contains a term "found in a directory to be the name of somebody somewhere." *Id.*

As in *Garan*, for the subject application, the Office has provided examples of surname use found through a search of the *LexisNexis Research* database as the basis for the refusal to register HUGHES. This is not sufficient evidence to support the refusal. See *Kahan*, supra, 508 F. 2d at 833 (finding telephone directory evidence standing alone to be an insufficient showing). Moreover, the *Lexis/Nexis Research* database evidence fails to establish that the sole impression of HUGHES to the relevant public, i.e., consumers of automation and monitoring related goods and services, is that of a surname. The Office also provides a Wikipedia article entitled "Hughes (Surname)" as evidence that the word "Hughes" has no meaning other than as a surname. However, Applicant respectfully points out that a search on Wikipedia shows that Hughes can be used as a surname, given name, place, airport name, company name, as well as many other uses (see Exhibit A, print out from <https://en.wikipedia.org/wiki/Hughes>).

HUGHES is a Given Name

The Office has asserted that HUGHES is primarily merely a surname. While Applicant does not dispute that Hughes is a surname, Applicant submits that it is also a given name. When a surname is also known as a given name, the practice of the Patent and Trademark Office is to allow the mark on the Principal Register. *In re S. Oliver* is the seminal case that sets forth the proposition that a surname which is also a known given name, may not be held as primarily merely a surname within the meaning of the Trademark Act, 20 USPQ2d 1878 (TTAB 1991). In that case, the Examining Attorney refused registration of the mark S. OLIVER on grounds that it was primarily merely a surname. The Examining Attorney argued that the "S." in the mark was not sufficient to obviate the refusal since it reinforced, rather than diminished, the surname significance of the term OLIVER. The Trademark Trial and Appeal Board,, hereinafter TTAB, held that where the significance of a surname is also as a given name, doubt must be resolved in favor of the Applicant as to the primary significance of the mark. *Id.* (Seeherman, concurring) (stating that it is clear that OLIVER per se would not be considered primarily merely a surname in view of its recognition as a given name.) Like OLIVER, HUGHES is a well-known given

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name. Applicant conducted a "First Name" search on the Ancestry.com website, which retrieved more than 1 million results for HUGHES as a given name. See Exhibit B - A copy of the results page and representative hit list is attached as evidence.

HUGHES has Geographic Significance

The term HUGHES also has geographic significance. If a mark that is considered a surname also has a non-surname significance, such as a common dictionary definition, or is a known geographic location or a given name, the mark is not primarily merely a surname. For example, the following marks which were held not to be "primarily merely a surname": BIRD, KENT, DOUGLAS, WELLINGTON, HERITAGE, CALISTO, CRAINGER and FAIRBANKS, all have alternative non-surname significance. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 13:30 at 13-56 (citing *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969); *G.B. Kent & Sons v. P. Lorillard Co.*, 101 USPQ 161 (2d Cir. 1954); *Ex Parte Omaha Cold Storage Co.*, III USPQ 189 (Comm'r Pat. 1956); *Ex Parte Gemex Co.*, I 11 USPQ 443 (Comm'r Pat. 1956); *Drexel Enterprises, Inc. v. Colby*, 138 USPQ I (S.D. Cal. 1963); *In re Monotype Corp.*, 14 USPQ2d 1070 (TTAB 198); *In re BDH Two, Inc.*, 26 USPQ2d 1556 (TTAB 1993); *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977)). Apart from its surname and given name significance, HUGHES also has geographic significance, as it is the name of cities in Wisconsin and Arkansas, as explained on the Wikipedia website at <http://en.wikipedia.org/wiki/Hughes,Wisconsin> and <http://en.wikipedia.org/wiki/Hughes,Arkansas>, as well as on Hughes, Arkansas' website located at <http://hughesarkansas.org/MMeet-the-Mayor.html>. Additionally, Hughes is the name of two airports, as explained at ([https://en.wikipedia.org/wiki/Hughes_Airport_\(Alaska\)](https://en.wikipedia.org/wiki/Hughes_Airport_(Alaska))) and [https://en.wikipedia.org/wiki/Hughes_Airport_\(California\)](https://en.wikipedia.org/wiki/Hughes_Airport_(California))) (See Exhibit C - Copies of printouts from Wikipedia and an excerpt from Hughes, Arkansas' website.)

In *In re Ferrara*, evidence was submitted showing that the mark FERRARA was both a surname and a geographical location in Italy, 166 USPQ 157 (TTAB 1970). The Office did not set forth any evidence as to why it believed that the surname significance of the mark predominated its geographic significance, and the TTAB held in favor of the Applicant. *Id.* See also *Ex Parte Gemex Co.* 111 USPQ 443 (Comm'r Pat.) (holding that WELLINGTON is as well known as a surname as it is a geographic location, and is therefore not primarily merely a surname). Likewise, it cannot be shown in the instant matter that the mark HUGHES is better known as a surname than as a geographic location or given name.

Given the number of references to HUGHES as a given name, and its geographic significance, it cannot be said that consumers would primarily view the mark as a surname. Consumers familiar with HUGHES as a given name would view its primary significance as a given name. Further, consumers familiar with HUGHES as the name of a city in Wisconsin or Arkansas would likely view its primary significance as geographic. Accordingly, the mark is not primarily merely a surname, and it is respectfully requested that the Office withdraw the refusal and approve the application for publication.

In the Alternative, HUGHES has acquired distinctiveness based on over 20 years of use and multiple prior registrations that include HUGHES for related goods or services

In the alternative, if the Office is not persuaded by Applicant's arguments and evidence, Applicant asserts that HUGHES has acquired distinctiveness based on Applicant's over 20 years use of multiple marks incorporating "HUGHES" in connection with its business in the United States and numerous registrations for HUGHES formative marks for goods and services that are related to the goods listed in this application. Some of Applicant's existing U.S. Registrations include the following:

HUGHES, Reg. No. 4,881,785, for Computer software for telecommunications applications and hardware, namely, computer software for managing, controlling and accessing telecommunications and data communications networks, satellite communications, next generation networks, intelligent networks, network management, Internet and e-commerce based systems for use by telecommunication providers and data communications equipment manufacturers, systems integrators and communication service providers; computer software for telecommunications services, namely, the transmission of audio, voice, video, data and information via satellite, telephone and computer; Computer software for storage and delivery of text, audio, visual, software and media content; Computer software for hosting, managing, developing and maintaining applications, content, software, websites and databases; Nondownloadable and downloadable software for managing computer applications, operating systems and databases; Computer software for providing access to a global communications network or other computer or communications networks; Computer operating system software for use in database management

HUGHES, Reg. No. 4,580,481, for Providing e-mail services, namely, providing secure email services; Telecommunications services, namely, the transmission of audio, voice, video, data and information via satellite, providing telecommunications connections to and communications through a global computer network; providing telecommunications connections to a global computer network; broadcasting programs via a global computer network; electronic transmission of messages and data; audio broadcasting; Providing multiple-user access to a global computer information network; video-conferencing services; Interactive satellite communication services, namely, transmission of sound and video via satellite or interactive multimedia networks; Pay-per-view television transmission services; Delivery of messages by electronic transmission; On-demand video transmission services; Telecommunications gateway services; Telecommunications services, namely, providing email services; telecommunications access services, namely, providing multiple user bandwidth and dedicated access to the Internet to enable electronic access to computer software, Internet websites, Internet web software applications, electronic databases, digital

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content, and business computer software applications of others accessible via the Internet; Computer services, namely, providing virtual and nonvirtual application servers to others; Computer consulting and design services; Cloud computing services, namely, remote and on-site infrastructure management and monitoring of web applications, databases, operating systems, electronic messaging systems, information technology systems, software applications, network data storage, data protection, database optimization, processes, hardware, router and switch monitoring, custom application monitoring and data warehousing for others; Computer services, namely, Integration of private and public cloud computing environments; Computer services, namely, Cloud hosting provider services; Computer consulting services in the fields of data center architecture, public and private cloud computing and applications, and evaluation and implementation of internet technology and services; Providing virtual computer systems and virtual computer environments through cloud computing; Technical consulting services in the fields of data center architecture, public and private cloud computing solutions and applications, and evaluation and implementation of internet technology and services; Technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; Technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems; Technical support services, namely, monitoring technological functions of websites, network systems and servers; Computer services, namely, maintenance and updating of computer software and monitoring and reporting on the performance, availability, and errors of websites, network systems and services of others and generating automated notification and tickets in connection therewith. Computer services, namely, providing an interactive website featuring technology that allows users to consolidate and manage application sharing, presentation broadcasts, web page sharing, polling and instant messaging and connections to existing and emerging application programming interfaces; Design and development of electronic data security systems; Cloud computing featuring software for use in the monitoring and management of web applications, databases, operating systems, network data storage, data warehousing and database optimization; Monitoring the computer systems of others for technical purposes and providing back-up computer programs; Remote computer network technical monitoring and software maintenance services; Hosting Internet sites for others; Remote computer backup services; Application services provider, namely, hosting computer software applications of others; Computer services, namely, interactive hosting services which allow the user to publish and share their own content and images on-line; Managed hosting services, namely, hosting computer software applications of others, and hosting and managing the websites of others using data center and disaster recovery facilities; Computer services, namely, cloud hosting provider services; Computer services for managed hosting for use in the operation of hosting Internet sites of others, namely, data recovery from hosted computer software, Internet websites, Internet web software applications, electronic databases, digital content, and business computer software applications of others that are accessible via the Internet; computer virus protection services; Computer services, namely, providing an interactive website featuring technology that allows user to consolidate and manage application sharing, presentation broadcasts, web page sharing, polling and instant messaging and connections to existing and emerging application programming interfaces. Monitoring services, namely, monitoring the computer systems of others for technical purposes such as for route efficiency, end-user performance, network topology and configuration and other technical purposes and providing back-up computer programs and facilities; Technical support, namely, monitoring network systems; Providing user authentication services for accessing a secure virtual computing environment

HUGHES, Reg. No. 3,093,477 for installation and servicing of equipment for data processing and telecommunications; telecommunications services, namely the transmission of voice, video, data and documents via satellite, telephone and computer; telecommunications gateway services; providing telecommunications connections to a global computer network; providing multiple-user access to a global computer information network; broadcasting programs via a global computer network; and pay-per-view television transmission services; transmission of messages and data; video broadcasting and video messaging services; video conferencing services; for others, namely, interactive educational services delivered over a global computer network; providing multiple-user access to a global computer information network; and interactive satellite communications services; computer consultation and integration of computer systems and networks; design of fixed and mobile satellite, wireless and computer communication networks for others; consulting services in connection with fixed and mobile satellite, wireless and computer communication networks ; and testing, analysis and evaluation of the goods and services of others for the purpose of certification

HUGHESNET and **HUGHESNET & DESIGN**, Reg. No. 3,235,303 and 3,277,871 for telecommunications services, namely the transmission of voice, video, data and documents via satellite, telephone and computer; telecommunications gateway services; providing telecommunications connections to a global computer network; broadcasting programs via a global computer network ; electronic transmission of messages and data; video broad casting and video messaging services; audio broad casting; and providing multiple-user access to a global computer information network; video-conferencing services; video streaming services; video messaging services; virtual network telecommunications services, namely, pro viding an interface for application sharing, presentation broadcasts, web page sharing, polling and instant messaging; and providing a web-based interface which transparently con verts audio and video material from one user application to another

HUGHESNET and **HUGHESNET & DESIGN**, Reg. No. 3,235,304 and 3,277,872 for equipment for receiving, processing, and transmitting voice, video, data and information via telecommunications and wireless signals, satellite and computers, namely, receivers, receiver module s, modulators, transmitters, multiplexers, decoder boxes, data processors, integrated circuits, set-top boxes primarily comprised of a receiver and circuitry, computer operating hardware and software for use in the aforementioned goods, satellite dishes, satellite earth stations, and very small aperture terminals (VSAT)

HUGHES, Reg. No. 2,886,885 for satellites, and parts thereof; wireless communications hardware for receiving, processing, and transmitting telecommunications and wireless signals via satellite, computer, and telephone, namely, receivers, transmitters, communication terminals, antennas, circuit cards, receivers circuits, and modules; earth satellite stations; decoder boxes; remote controls for satellite, computer, and telephone receivers, transmitters, antenna and communication terminals; computer controlling hardware and software for use in the aforementioned goods; and computer software for managing, controlling and accessing telecommunications and data communications networks, satellite communications, next generation networks, intelligent networks, network management, Internet and e-commerce based systems for use by telecommunication providers and data communications equipment manufacturers, system integrators and communication service providers

HUGHES, Reg. No. 2,886,884 for broadcasting programs via the Internet; broadcasting via a computer network; electronic mail services; transmission of data, voice and video via satellite, computer and telephone; satellite communication services; interactive satellite communication services; pay-per-view television transmission services; delivery of messages by electronic transmission; video broadcasting; and on-demand video transmission services; providing multiple-user access to the Internet; providing telecommunications connections to the Internet; telecommunications gateway services

HUGHES, Reg. No. 3,006,113 for engineering services; design and development software for others for use in the telecommunications field; computer data information services, namely, providing databases featuring general and local news and information specific geographic areas

True and accurate copies of records for these registrations from the United States Patent and Trademark Office's TESS database are attached herewith as Exhibit D.

The HUGHES mark functions as a source identifier for the listed services is further strengthened by Applicant's registrations for HUGHES and HUGHESNET on the Principal Register. The registrations cover goods and services closely related to the goods for which Applicant presently seeks registration of HUGHES. Applicant's recitation of goods and services in its prior registrations on the Principal Register cover a broad scope of telecommunications goods and services. Applicant's applied for automation and monitoring services relates to the telecommunications services listed in Applicant's prior registrations. The applied for automation and monitoring goods are associated with or related to Applicant's automation and monitoring, which are a type of telecommunications service generally provided by telecommunications providers like Applicant. Thus, the goods and services covered by the previously registered marks are closely related to the goods listed in the application.

Because Applicant's HUGHES registrations have been in continuous use since 1987 and have been registered since 2003 and cover related goods and services, they naturally reinforce the source identifying function of the HUGHES mark in the subject application. Therefore, Applicant's mark has acquired distinctiveness and will not be viewed as primarily merely a surname.

Because the present HUGHES application and Applicant's prior registrations cover related services and goods, Applicant's HUGHES mark for the goods listed in the application will inevitably create the same, continuing commercial impression as the prior HUGHES and HUGHESNET registrations for goods and services, such that the consuming public will consider them both as the same mark. See TMEP § 12.04(b). Therefore, the marks are legal equivalents. As such, the proven distinctiveness of Applicant's registrations on the Principal Register and the length of Applicant's ownership of its HUGHES registrations for closely related goods and services should be imputed to Applicant's present HUGHES application, such that its impression upon the consuming public is not as primarily merely a surname. See 37 C.F.R. § 2.41(b).

In the alternative, the Applicant asserts that the HUGHES mark has acquired distinctiveness for telecommunications related goods and services based on its continuous use of the mark for over 20 years and its multiple prior registrations for marks that include HUGHES for telecommunication related goods and services. Applicant asserts a claim of distinctiveness under Section 2(1) of the Trademark Act as to HUGHES, and requests that the application be approved for publication.

AMENDMENT OF RECITATION OF GOODS

As requested by the Examining Attorney, Applicant amends its recitation of goods to the following: (Applicant's amendments to the identification of goods appear in bold print below.). Applicant has also submitted herewith fees covering the additional classes added to the present application.

Class 9: Home and office electrical power automation systems comprising wireless and wired controllers, controlled devices, and software for appliances, lighting, security and other home and office electrical power monitoring and control applications; Remote controls; Electronic devices for environmental monitoring, control, and automation; computer software for use in environmental monitoring, control, and automation systems; electronic devices and computer software that allow users to remotely interact with environmental monitoring, control, and automation systems; electronic devices and computer software that allow the sharing and transmission of data and information between devices for the purposes of facilitating environmental monitoring, control, and automation; Video surveillance and recording devices *in the nature of remote video monitoring system consisting of a camera* and

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video monitor for recording and transmitting images to a remote location; Irrigation control and monitoring devices, namely, flow meters and flow switches, Electric controls for home entertainment systems; Weather monitoring devices, namely, devices for monitoring external temperature, wind speed and direction, barometric pressure, and humidity; Computer application software for use on computers and hand-held, namely, mobile phones and tablet computers, to control devices and energy usage in homes and businesses from a remote location; Electronic devices for environmental monitoring and control, namely, smoke alarms, carbon monoxide alarms, fire alarms, security alarms and sensors; Environmental hazard detectors, namely, devices to detect and record the presence of water, humidity levels, heat, temperature, movement, motion, and sound; Lighting control apparatus, namely, devices to sense ambient light; Computer application software for use on computers and hand-held, mobile phones and tablet computers, to monitor and control lighting, cameras, smoke detectors, doors, motion sensors, sprinklers systems, and carbon monoxide, from a remote location by wired or wireless communication; Devices for environmental monitoring and control, namely, smoke alarms, carbon monoxide alarms, fire alarms, environmental hazard detectors, lighting equipment, and security alarms and sensors

Class 10: healthcare monitoring and control devices, namely, blood pressure, heart rate, blood sugar, and weight monitors, wearables for tracking metabolic activity and vital sign statistics, devices for monitoring body temperature and respiratory conditions, calorie intake monitoring devices, fitness and exercise monitoring devices, and glucose monitoring devices

Class 11: Irrigation control devices, namely, spray nozzles; faucet control devices, namely, faucet taps and water control valves

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the subject application is appropriate for publication. Favorable action in this regard is respectfully requested. The Examining Attorney is requested to contact the undersigned directly at with any questions.

DATED this 15th day of February, 2016

Respectfully submitted,

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