

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION

**RESPONSE TO OFFICE ACTION**

Filing Date: 08/31/2016  
Serial Number: 87/156,479  
Mark: MCKINNEY  
Name of Applicant: American Woodmark Corporation  
Mailing Date of Action: 11/14/2016  
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Law Office 103

**INTRODUCTION**

American Woodmark Corporation (“Applicant”) filed the present application to register the trademark MCKINNEY (“Applicant’s Mark” or the “Mark”) based on Applicant’s *bona fide* intent to use the Mark in commerce to identify certain of Applicant’s goods in International Class 20, namely, *bathroom vanities; kitchen cabinets*.

On November 14, 2016, the Examining Attorney (“Examiner”) for the United States Patent and Trademark Office (“USPTO”) issued an Office Action denying registration based on the Examiner’s belief that the Applicant’s Mark was primarily merely a surname under Section 2(e)(4) of the Lanham Act, 15 U.S.C. § 1052(e)(4).

## STATEMENT IN SUPPORT OF REGISTRATION

Applicant respectfully disagrees with the Examiner's finding that Applicant's Mark is primarily merely a surname. Accordingly, Applicant asks the Examiner to pass the Mark to publication. In support of its request, Applicant submits the following:

**I. The Examiner has not established a *prima facie* case that Applicant's Mark is primarily merely a surname.**

In evaluating whether a mark is primarily merely a surname, the relevant standard is "the *primary significance* of the mark as a whole *to the purchasing public.*" *In re Hutchinson Tech. Inc.*, 852 F.2d 552 (Fed. Cir. 1988) (emphasis added) (footnote omitted); T.M.E.P. §1211.01. The reason for consideration of the purchasing public is "because it is that impact of impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname." *In re Eximius Coffee, LLC*, 120 U.S.P.Q.2d 1276, 1278 (T.T.A.B. 2017) (citing *In re Harris-Intertype Corp.*, 518 F.2d 629 (C.C.P.A. 1975)) (emphasis in original). The burden is on the Examiner to establish a *prima facie* case that the primary significance of the Mark to the purchasing public is merely that of a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15 (Fed. Cir. 1985). Applicant submits that Examiner has not produced sufficient evidence to establish a *prima facie* case that the Mark is primarily merely a surname.

To simply provide evidence that persons in the United States possess a surname identical to the Mark in question is not sufficient to establish the primary significance of such term to the consuming public. One need not posit more than the existence of widely used surnames such as "Kitchen," "Ford," and "King" to see why the mere citation proffered by Examiner fails to shift the burden of proof regarding the primary significance of a term to the public. Without more, the

number of times that a surname is listed in a telephone directory is irrelevant to whether *the public views the term as primarily merely a surname*. Even though a term may appear as a surname in a telephone directory, that same term can have other meanings that affect the public's perception. Courts have explicitly stated that if "the purchasing public, upon seeing [a mark that may also be a surname] on the goods, may not attribute surname significance to it, it is not primarily merely a surname." *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm'r Pats. 1955) (citing the names "King," "Cotton," and "Boatman" as surnames that bring to mind other meanings). Moreover, Examiner has provided insufficient evidence that the *public views Applicant's Mark as primarily merely a surname*. The public will not view Applicant's Mark as a surname due to its geographical connotation, as discussed below.

Aside from a single listing from namestatistics.com, Examiner offers very little evidence that the public views Applicant's Mark primarily as a surname. This additional evidence fails to meet Examiner's burden of establishing a *prima facie* case that Applicant's Mark is primarily merely a surname. Examiner's additional evidence consists of a single dictionary at Wordnik.com that does not include a definition for the term MCKINNEY. As detailed further below, numerous well-recognized dictionaries include an entry for MCKINNEY and demonstrate that the term does indeed have a recognized meaning other than as a surname. In light of all of this, Applicant respectfully submits that the Examiner has not established a *prima facie* case that Applicant's Mark is primarily merely a surname.

**II. Applicant's Mark has recognized meaning other than as a surname and thus is not *primarily merely a surname*.**

The recognized geographical meaning of Applicant's Mark means that the Mark cannot be primarily merely a surname. The geographical meaning of MCKINNEY shows that the

purchasing public, upon seeing the Mark, is not likely to attribute surname significance to it, and therefore it is not primarily merely a surname. *Rivera*, 106 U.S.P.Q. at 149.

In *In re Ferrara*, the Trademark Trial and Appeal Board (“TTAB”) reversed a refusal to register the surname FERRARA on the grounds that the examiner failed to prove that the public was more likely to recognize FERRARA as a surname than as an Italian city, stating that “[t]here is no indication by the examiner why the surname significance of ‘FERRARA’ is greater than the geographical significance thereof.” 166 U.S.P.Q. 238 (T.T.A.B. 1970). Thus, the TTAB held that the Examiner had not carried its burden of proving that the mark was “*primarily* merely a surname.” *See id.* As in *In re Ferrara*, Examiner gives no indication here as to why the evidence of any surname significance of the Mark establishes that such surname significance is greater than its geographic connotation.

Examiner argues that the term MCKINNEY appears to have no recognized meaning other than as a surname and has presented the evidence of a single dictionary entry from Wordnik.com to support this statement. This single dictionary entry is not dispositive. While Applicant concedes that negative dictionary evidence may demonstrate the lack of non-surname significance, the term MCKINNEY is featured in many respected dictionaries and consistently listed as a term with significant geographic meaning. Such entries include:

1. Merriam-Webster defining “McKinney” as a “city in northeastern Texas north of Dallas *population* 131,117” (*See Exhibit A*);
2. Dictionary.com defining “McKinney” as “a city in NE Texas” (*See Exhibit B*);  
and
3. Oxford Dictionaries defining “McKinney” as “[a] city in northeastern Texas, in the northeastern part of the Dallas-Fort Worth metropolitan area; population

121,211 (est. 2008). It is noted for its remarkable growth since 1990, when its population was 21,283” (*See* Exhibit C).

Because the sole definition for the term in each dictionary centers on the term’s geographical significance, this evidence demonstrates that MCKINNEY has considerable geographical meaning that the consuming public would recognize as such. “A term with surname significance may not be primarily merely a surname if that term also has a well-known geographical meaning.” *See* T.M.E.P. § 1211.01(a)(iii); *In Re Colt Indus. Operating Corp.*, 195 U.S.P.Q. 75 (T.T.A.B. 1997). McKinney, Texas has gained a considerable amount of attention in recent years as a rapidly expanding suburb of Dallas. McKinney’s city website lists a number of distinguished awards, including “#1 Best Place to Live in America” by *Money Magazine* in 2014, “#8 Fastest Growing City” by WalletHub, a “Top Ten Place to Move” by *Forbes* in 2012, among several other accolades. *See* Exhibit D. Furthermore, a number of other cities in the United States are named McKinney, including two locations in Arkansas, one in Kentucky, and one in North Dakota (*See* Exhibit E). This evidence demonstrates that the geographical significance is more prominent than, or at least equal to, the surname significance. Thus, in either case, the consuming public would not view Applicant’s Mark as primarily merely a surname and the Examiner’s burden is not met.

Furthermore, the consuming public will not confront Applicant’s Mark in a context that emphasizes any surname significance of the word. In *In re Etablissements Darty et Fils*, the court focused on the context of the use of DARTY in “Darty et Fils” because its use as the name of an equipment repair and distribution business highlighted its surname significance to consumers. 759 F.2d 15 (Fed. Cir. 1985). In the case at hand, the Mark will not be displayed to consumers as a company name or as an overarching brand name. In fact, Applicant has adopted

a longstanding practice of adopting geographical terms to name its cabinets to evoke certain connotations. Thus, the Mark will be shown as labeling for a single door style for Applicant's kitchen cabinets and bathroom vanities. This means that the Mark will be one of many door style names, such as FAIRBANKS, CHARLESTON, and SCOTTSDALE (all federally registered marks) that are presented to the purchasing public at the point of sale (*See* Exhibit F). As demonstrated in the Exhibit, all of the door style names featured next to each other do not emit any sense that the Mark is primarily merely a surname. In this context, the purchasing public will not connect the Mark to any surname significance and will instead attribute geographic significance to it.

**III. Any doubt in the primarily merely a surname analysis should be resolved in Applicant's favor.**

Finally, the Trademark Trial and Appeal Board has recognized that “[i]f there is any doubt [in a primarily merely a surname analysis], we must resolve the doubt in favor of applicant.” *See In re Yeley*, 85 U.S.P.Q.2d 1150, 1151 (T.T.A.B. 2007) (citing *In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d 1332, 1333-1334 (T.T.A.B. 1995)). Although Applicant believes that the Examiner will reasonably find that the general public will not perceive the Mark as primarily merely a surname, Applicant asks the Examiner to bear in mind that any doubt regarding whether the Mark is primarily merely a surname should be resolved in Applicant's favor. *See id.* In light of this presumption in favor of Applicant's position, Applicant believes that it is entitled to have Applicant's Mark pass to publication.

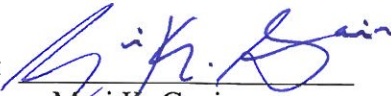
**CONCLUSION**

In view of the foregoing, Applicant respectfully submits that Applicant's Mark is not primarily merely a surname within the meaning of Section 2(e)(4) of the Lanham Act. The evidence that Examiner has provided does not establish that any surname significance of

Applicant's Mark would be likely to impact the purchasing public, when used in connection with kitchen cabinets and bathroom vanities, as *primarily* merely a surname. Applicant's Mark has a recognized meaning other than as a surname, as a city in northeastern Texas, as demonstrated by the evidence cited above. The Examiner has not proven that any surname significance of Applicant's Mark is greater than its geographical significance. Furthermore, the Mark will be used in a context that does not emphasize any significance of the Mark as a surname and instead emphasizes geographic significance. Finally, any doubt should be resolved in Applicant's favor.

On the basis of the foregoing, Applicant respectfully submits that Applicant has resolved all outstanding issues with respect to Applicant's Mark. Accordingly, Applicant requests that Examiner pass the Mark to publication.

Respectfully submitted,

By:   
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