

**Applicant's Response to Office Action**  
**Trademark Act Section 2(e)(4) - 15 U.S.C. § 1052(e)(4)**

Applicant has applied to register HUNTINGTON for “interior window blinds” in Class 20. The Examining Attorney has refused registration of the mark as primarily merely a surname under Trademark Act Section 2(e)(4). In response to the Office Action issued on August 15, 2017, Applicant respectfully responds as follows:

**I. Test for Determining Whether a Mark Is Primarily Merely a Surname**

The test for determining whether a mark is primarily merely a surname depends on the primary significance of the mark as a whole to the purchasing public. *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); TMEP § 1211.01. The determination that the applied-for mark depends on whether the primary, and only, significance of the term is as a surname. *In re Eximius Coffee*, 120 USPQ2d 1276, 1278 (TTAB 2016). The factors relevant to the determination are as follows:

- (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 "structure and pronunciation" of a surname
- (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression

*See In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); TMEP § 1211.01. The factors are not exclusive as any other relevant circumstances may shape the analysis in a particular case. *In re Eximius Coffee*, 120 USPQ2d at 1278; TMEP § 1211.01.

If doubt exists as to whether the mark is primarily merely a surname, it is resolved in Applicant's favor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

## II. Applicant's Mark Is Not Primarily Merely a Surname

The 2(e)(4) analysis is concerned with the “primary significance of the mark as a whole to the purchasing public.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1505 (TTAB 2016) (quoting *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)). Based on the *Benthin* factors, Applicant respectfully asserts that the applied-for mark is not primarily merely a surname and thus, would not be perceived as such by the purchasing public.

### A. Evidence of Surname Significance is Minimal.

It is incumbent on the Examining Attorney in the first instance to show that a mark is primarily merely a surname. *See In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 U.S.P.Q. 421 (C.C.P.A. 1975). However, the evidence made of record to support the primarily merely a surname refusal is insubstantial. The Examining Attorney has attached a Lexis page showing the first ten references of a reported 14,498 hits in a search of the LexisNexis® surname database. This is not a significant number. When considering evidence from broad databases the Board acknowledges the “massive scope” of such databases. *See In re United Distillers PLC*, 56 USPQ2d 1220, 1222 (TTAB 2000) (holding a surname with 1295 listings in a database of 80 million entries is rare). The LEXISNEXIS public records database contains approximately 736 million unique identities. *See* “LexisNexis® Public Records” available at <http://www.lexisnexis.com/public-records/> attached as Exhibit A. As compared to the statistics in *United Distillers*, the ratio of individuals with the surname HUNTINGTON is proportionally nearly the same: 14498 in 736 million. Moreover, it is not clear whether these are unique references or if additional investigation would disclose that there are multiple entries for the same individuals, thereby reducing the total number of individuals with this surname.

Further, the Wikipedia references to purportedly notable individuals with this surname are of limited value. Wikipedia references are not necessarily reliable because, at the Trademark Trial and Appeal Board has held, Wikipedia is a collaborative resource that anyone can edit. *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032–33 (TTAB 2007). Moreover, even if there were reliable evidence of these individuals, there is no evidence that they are notable enough to help the purchasing public to perceive mark as a surname or that this public would

know that Huntington’s Disease bears the surname of the doctor who discovered it. Finally, there is no evidence that the mark is a surname of anyone associated with Applicant.

Given the extremely low ratio of public records returned with the surname “HUNTINGTON” compared to the total number of records, the relative obscurity of the individuals noted, even if they were from a more reliable source, and an absence of any evidence that the mark is a surname of anyone associated with Applicant, the threshold demonstration of surname significance has not been met.

B. Applicant’s Mark Has Significance Other Than as a Surname.

When evaluating whether a mark is primarily *merely* a surname, the Examining Attorney must evaluate whether the primary, *and only*, significance of the term is a surname significance. *In re Eximius Coffee*, 120 USPQ2d at 1278 (citing *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975)).

The mark here is not primarily merely a surname because it has other equal, if not greater, significance as a first name and geographic term.

The term HUNTINGTON also has geographic significance, including as the name of a number of towns, as part of the name of a popular surfing beach, and the Huntington section of Alexandria, Virginia, which is also a metro stop in the metropolitan Washington, DC, which is the sixth largest metropolitan area in the United States. See listing of towns called HUNTINGTON in the US, excerpt of tourist activities in Huntington Beach, California, map of Huntington area of Alexandria, Virginia, the Huntington Metro web page, and Washingtonian article at Exhibit B. Further, HUNTINGTON is also a first name. See NameBerry listing for HUNTINGTON, including notable people with this first name at Exhibit C.

Based on the additional significance of the mark, Applicant submits that the purchasing public encountering Applicant’s mark would not perceive it to be primarily merely a surname.

**III. Conclusion**

For the reasons outlined above, Applicant respectfully requests that the Examining Attorney withdraw the surname refusal and approve Applicant’s mark for publication in the Official Gazette.