

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PRIPD, LLC

Serial No.: 87/822,146

Mark: CARLYLE

Examining Attorney: Collier L. Johnson II

RESPONSE

In the Office Action dated June 25, 2018, the Examining Attorney refused registration of the above-referenced mark under Trademark Act §2(e)(4), alleging that the applied-for mark is primarily merely a surname.

In this regard, the Examining Attorney argues that:

An applicant's mark is primarily merely a surname if the surname "is the primary significance of the mark as a whole to the purchasing public." *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (quoting *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)); TMEP §1211.01.

The following five inquiries are often used to determine the public's perception of a term's primary significance:

- (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.

In re Eximius Coffee, LLC, 120 USPQ2d 1276, 1278 & n.2, 1282-83 (TTAB 2016) (citing *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995) for the *Benthin* inquiries/factors); TMEP §1211.01; *see also In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985).

These inquiries are not exclusive, and any of these circumstances – singly or in combination – and any other relevant circumstances may be considered when making this determination. *In re Eximius Coffee, LLC*, 120 USPQ2d at 1277-78; TMEP §1211.01. For example, when the applied-for mark is not stylized, it is unnecessary to consider the fifth inquiry. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); TMEP §1211.01.

Please see the attached evidence from the U.S. Census Bureau, establishing the surname significance of CARLYLE. This evidence shows the applied-for mark appearing 3,476 times as a surname in the 2010 Census. *See* https://www.census.gov/topics/population/genealogy/data/2010_surnames.html (File B: Surnames Occurring 100 or more times).

Additionally, evidence that a term has no recognized meaning or significance other than as a surname is relevant to determining whether the term would be perceived as primarily merely a surname. *See In re Weiss Watch Co.*, 123 USPQ2d 1200, 1203 (TTAB 2017); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016); TMEP §1211.02(b)(vi). The attached evidence from Merriam-Webster shows that Carlyle does not appear in the dictionary, except to note its surname existence. *See* <https://www.merriam-webster.com/dictionary/Carlyle>. Thus, this term appears to have no recognized meaning or significance other than as a surname.

Moreover, evidence that a term has the structure and pronunciation of a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016); *see In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); TMEP §1211.01(a)(vi). Please see the attached evidence from the Internet displaying multiple surnames similar to Carlyle. *See* <https://www.familyreedna.com/groups/carlile/about/background>.

Though there is no indication that CARLYLE is the surname of an individual associated with the applicant, this factor, which weighs against a Section 2(e)(4) refusal, is outweighed by the preceding three factors and the fact that the applicant's mark is not stylized.

Because CARLYLE is a surname, has the look and sound of a surname, has no other significant meaning apart from being a surname, and is not stylized, the mark CARLYLE is primarily merely a surname. Thus, the registration must be refused pursuant to Trademark Section 2(e)(4).

Applicant respectfully disagrees with the foregoing analysis and submits that the Examining Attorney has failed to make a *prima facie* showing of surname significance. It is well-settled that the burden is on the Examining Attorney to establish a *prima facie* case that a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). If there is any doubt, the Board is “inclined to resolve such doubt in favor of the applicant.” *In re Benthin Management GmbH*, 37 USPQ 1332, 1334 (TTAB 1995).

Turning to the first of the five factors, the Examining Attorney suggests (without explicitly stating as much) that the applied-for mark is not rare because it appears 3,476 times in the 2010 US Census. Applicant respectfully disagrees. First, as mentioned, the Examining Attorney does not provide a specific statement or finding that the term “carlyle” as a surname is common. Second, the Examining Attorney does not mention that this appearance in the 2010 US Census is found at line number 9357 - meaning it is hardly a common or popular name in the United States. In fact, inasmuch as there were only 3,476 appearances of the name in the entire United States in 2010, it is rather unlikely that a consumer encountering this term would deem it to be a surname.

Turning to the second of the five factors, the Examining Attorney states that there is no indication that CARLYLE is the surname of an individual associated with Applicant, and acknowledges that this factor weighs against a Section 2(e)(4) refusal. Applicant confirms that the term “carlyle” is not the surname of an individual associated with the company.

Turning to the third of the five factors, the Examining Attorney attaches a single page from a single dictionary, and argues that “CARLYLE” does not appear in this

dictionary, except to note its surname existence. In response, Applicant has attached a page from another on-line dictionary (see Exhibit 1), and the first page from a Google search of the term “carlyle” (see Exhibit 2). The attached dictionary page includes a reference to a Scottish essayist named “Thomas Carlyle”, but also notes that the term “carlyle” is a “male given name”, thereby refuting the Examining Attorney’s finding that there is no recognized meaning or significance for the term “carlyle” other than as a surname. The first page from the Google search failed to return a single link referring to an individual with the surname Carlyle. This evidence also refutes the Examining Attorney’s finding that there is no recognized meaning or significance for the term “carlyle” other than as a surname.

Turning to the fourth of the five factors, the Examining Attorney attaches a single internet page which allegedly shows multiple surnames similar to CARLYLE. The Examining Attorney argues that this single internet page establishes that CARLYE has the structure and pronunciation of a surname. Applicant respectfully disagrees. First, the submitted evidence fails to support a *prima facie* finding that the term “carlyle” has the structure and pronunciation of a surname. The facts here are very similar to the facts in *In re Grand & Piano Parts Distribution B.V.*, Serial No. 85/946,217 (TTAB March 31, 2015), a case in which the Board was unable to make a definitive determination of the “look and feel” of the mark based on a single reference to the term in question from a page from a genealogy website. Here, the Examining Attorney has submitted and is relying upon the very same type of webpage which was submitted in the *Grand & Piano Parts* case and found to be insufficient by the Board. Specifically, the Board in *Grand & Piano Parts* was unable to conclude that the mark in question had the “look and feel” of a

surname because of the “dearth of evidence.” Applicant respectfully submits that the Examining Attorney’s reliance on a single reference to support his conclusion of “look and feel” is also lacking due to a “dearth of evidence.” Second, Applicant has attached as Exhibit 3 copies of four US trademark registrations for the mark CARLYLE. Thus, there are at least four unexpired US registrations on the principle register for the wordmark CARLYLE covering goods such as whiskey, tobacco, cigars and cigarettes, metal hardware, and industrial paper products. This demonstrates that consumers are familiar with and recognize this term as a trademark capable of identifying various goods. Third, as discussed in *In re Nordstrom, Inc.*, Serial No. 86303016 (TTAB March 12, 2016), there are often times that a term (even if occasionally used as a surname) might still be perceived by the relevant public as something else, including an arbitrary term, thereby removing it from the prohibition of Section 2(e)(4). In the *Nordstrom* case, the Board found that consumers would be unlikely to view the term VALETTE as a surname, but instead would view it as a coined, fanciful term with no specific meaning. This reasoning applies equally to the case at hand where consumers would be unlikely to view the term “carlyle” as a surname, but rather as a coined fanciful term with no specific meaning, like, for example, the use of the term “carlyle” in the name The Carlyle Hotel.

In view of the “death of evidence” submitted by the Examining Attorney, together with the evidence submitted herewith by Applicant, and keeping in mind that all doubts must be resolved in Applicant’s favor, it is respectfully submitted that the above-identified mark is not primarily merely a surname. Accordingly, reconsideration and allowance of the present application is respectfully solicited.

Respectfully submitted,

Dated: 4 August 2018

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