

This is in response to the Office Action issued June 4, 2019 related to Application No. 88352339 for the mark DAVIS (“Applicant’s Mark”) for the following goods and services (“Applicant’s Goods and Services”):

“Interfaces for computers; downloadable graphical user interface software; Downloadable computer programs for user interface design; voice command and recognition software, speech to text conversion software; Downloadable interface software using artificial intelligence for enabling users to use voice commands and natural language in chat applications and voice-enabled devices; downloadable middleware for enabling users to use voice commands and natural language in chat applications and voice-enabled devices; downloadable middleware for providing an interface between software applications and operating systems; downloadable computer software for use as an application programming interface (API); downloadable middleware for software application integration; downloadable middleware for providing an interface to artificial intelligence engine software” in Class 9; and

“Providing temporary use of online non-downloadable middleware for providing an interface between software applications and operating systems; Software as a service (SaaS) featuring computer software for use as an application programming interface (API); Software as a service (SaaS) featuring computer software for voice command and recognition software, speech to text conversion software; Providing online on-downloadable graphical user interface software, computer programs for user interface design, voice command and recognition software, and speech to text conversion software; providing online non-downloadable interface software using artificial intelligence for enabling users to use voice commands and natural language in chat applications and voice-enabled devices; providing online non-downloadable middleware for enabling users to use voice commands and natural language in chat applications and voice-enabled devices; providing temporary use of online non-downloadable middleware for providing an interface between an artificial intelligence engine and software for application performance management and analytic software” in Class 42.

In the Office Action, the Examining required that Applicant clarify its listing of goods and services (which has been done as part of this response), and also refused registration under Trademark Act Section 2(e)(4), claiming Applicant’s Mark is primarily merely a surname. Applicant respectfully disagrees with this refusal for the reasons set forth below, and requests that the refusal be withdrawn.

The test to be applied in determining whether or not a mark is primarily merely a surname is its primary significance to the purchasing public. See: *In re Harris-Intertype Corporation*, 186 USPQ 238 (CCPA, 1975); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 184 USPQ 421 (CCPA, 1975); and *Ex parte Rivera Watch Corporation*, 106 USPQ 145 (Comr., 1955). Moreover, it is well established that the examining attorney bears the initial burden to make a prima facie showing of surname significance. See *Id.* (noting that unless the USPTO meets its burden, applicant need not demonstrate non-surname significance of its mark); *In re Harris-Intertype Corporation*, 186 USPQ 238 (CCPA, 1975); *In re Barcorp Industries Inc.*, 187 USPQ 61 (TTAB 1975); and *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

In the case at hand the following primary evidence was provided by the Examining Attorney:

1. LEXIS® surname database information showing DAVIS as a surname 500 times; and
2. Wikipedia entries showing well-known people with the surname DAVIS.

However, another important factor to be considered is whether the term has any other meaning other than as a surname. Notably, DAVIS is a masculine given name. See **Exhibit A**. Non-surname significance of an applied-for mark must be considered (TMEP § 1211.01(a); see *In re Isabella Fiore, LLC*, 75 USPQ2d 1564 (TTAB 2005) (reversing refusal of common surname FIORE on the ground that it also means “flower” in Italian)).

In the *Isabella Fiore* case, the LexisNexis database showed 5,193 results indicating that the mark “FIORE” was a surname with no meaning in the English language. However, the mark also originated from the Italian language and means “flower” in English. Because of the non-surname meaning behind the mark, the Board reversed the surname refusal noting that whenever there are doubts that the term is a surname, they must resolve them in favor of the applicant.

Similar to the *Isabella Fiore* case, the mark DAVIS also has substantial non-surname significance. This non-surname meaning of the mark, namely, that it also denotes a given name, detracts from the surname significance. The average consumer would not deem the primary significance of DAVIS to be merely a surname given the alternative non-surname meaning. In other words, because DAVIS can be a given name or a surname, consumers would not view the mark as being primarily merely a surname.

Indeed, a number of marks comprised of or featuring the term DAVIS have registered at the USPTO, where DAVIS was not considered to be primarily merely a surname. See examples in the table below. TESS printouts are attached as **Exhibit B**.

Reg. No./App. No.	Mark	Relevant Goods/Services
5520260	DAVIS	Class 11: plumbing products for residential applications, namely, faucets and showerheads.
5635550	DAVIS INDUSTRIAL “INDUSTRIAL” disclaimed	Class 6: Cat walks in the nature of prefabricated metal platforms and ladders; Bin liners, namely, fitted liners fabricated to cover the inside of a metal bin to prevent wear; Conveyor accessories, namely, non-mechanical metal hoppers. Class 7: Conveyors; Belt stands being structural parts for conveyors; Belt stands adapted for conveyors for supporting conveyor belts when not assembled on a conveyor; Belt winding machines for conveyors; Conveyor belts; Conveyor takeups being structural parts of conveyors; Conveyor accessories, namely, mechanical discharging hoppers, conveyor belt washing machines, conveyor belt fitted covers, drip pans being structural parts for conveyors used for debris collection; structural conveyor parts in the nature of idlers, pulleys, and rubber lining for metal conveyor components to ease material flow and transitions; structural conveyor parts in the nature of rake flights for stacker reclaimers used to reclaim material, drag roller chain flights being structural parts for conveyors, all being parts of machines. Class 37: Installation, maintenance, repair, and reconditioning of conveyors; Installation, maintenance, repair, and reconditioning of conveyor belts; Reconditioning of conveyors. pulleys to improve lagging; Reconditioning of conveyor belts by splicing and vulcanizing to improve stability and functionality; Reconditioning gypsum board belts by splicing and sanding them; Installation, maintenance, repair, and reconditioning of moving walkways. Class 40: Fabrication of conveyor belts; Steel fabrication for conveyor equipment, hoppers, and cat walks. Class 42: Inspection of conveyors for quality assurance purposes; Inspection of conveyor belts for quality assurance purposes; Inspection of moving walkways for quality assurance purposes. Class 45: Inspection of conveyors for safety purposes; Inspection of conveyor belts for safety purposes; Inspection of moving walkways for safety purposes.
5506263	DAVIS TECHNOLOGIES “TECHNOLOGIES” disclaimed	Class 9: Racing automobile hardware and software for traction control, power management and acceleration control, electrical system management, wheel speed management, and brake control for use on race tracks
5408957	DAVIS AEROSPACE AND MARITIME “AEROSPACE” and “MARITIME” disclaimed	Class 41: Providing educational courses of instruction at the senior high school level, in the fields of aviation, aerospace and maritime occupations
4563595	DAVIS ACADEMY DRIVING SCHOOL “ACADEMY DRIVING SCHOOL” disclaimed	Class 41: educational services in the nature of driving schools

Similar to these marks, DAVIS in the present case would not be viewed by consumers as primarily merely a surname due to its given name significance.

Furthermore, Applicant is a company and there is no direct connection as it relates to the trademark with anyone that uses DAVIS as a surname. Without a connection, the mark is not primarily a surname in the minds of the purchasing public. See *In re Sava Research Corp.*, 32 USPQ2d 1380, 1994 (TTAB 1994) (weighing lack of connection in the applicant's favor); *In re Bonham & Butterfields Auctioneers Corp.*, (TTAB 2016) (non-precedential) (declining to conclude that consumers would perceive disputed term as a surname, even where applicant's founder bore same name, in absence of evidence that the applicant publicized this connection and public was aware of it). In order for Applicant's Mark to be primarily a surname, the public must perceive Applicant's Mark as such. Since there is no direct connection to DAVIS used as a surname by Applicant, Applicant's Mark is not primarily a surname. Notably, marks registered with the USPTO where DAVIS is considered to be primarily merely a surname are those owned by individuals with the DAVIS surname. Again, that is not the case here.

Finally, the Courts in *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995) and in *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 (TTAB 2007), both stated that after the evidence is weighed, if there is any doubt, **the doubt must be resolved in favor of the applicant.** Due to the given name significance of DAVIS, there *is doubt* that DAVIS is primarily merely a surname.

In conclusion, Applicant's Mark DAVIS has substantial non-surname significance. This results in strong evidence that DAVIS is more likely to be seen as a trademark rather than primarily merely a surname. In other words, because DAVIS is a given name, the purchasing public would not view the term DAVIS as used in Applicant's Mark as being primarily merely surname. At the very least this evidence creates doubt that DAVIS is primarily merely a surname, and as discussed above, doubt must be resolved in the favor of the Applicant.

Therefore, the Applicant kindly requests withdraw of the refusal.