

January 3, 2020

***Via E-Filing***

Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, VA 22313-1451

**Re: Application Serial No.: 88/404996**  
**Mark: MACNAUGHTON**  
**Filing Date: April 26, 2019**  
**Applicant: The MacNaughton Group Inc.**  
**Office Action Mailing Date: July 9, 2019**  
**Examining Attorney: Brendan J. Ketchum**

**RESPONSE TO OFFICE ACTION**

The Applicant hereby responds to the Office Action mailed on July 9, 2019.

**I. Recitation of Services**

Applicant has amended its recitation of services to address the Examining Attorney's concerns. Specifically, Applicant amends it to read as follows:

Class 36: Real estate investment; real estate management and operation **services**;  
real estate brokerage; real estate sales **management**; real estate leasing

**II. Mark Description**

Applicant has amended its mark description to address the Examining Attorney's concerns. Specifically, Applicant amends it to read as follows:

The mark consists of the stylized word "MACNAUGHTON" appearing in variably shaded gray.

**III. Applicant's Mark – MACNAUGHTON – Is Not Primarily Merely A Surname**

The Examining Attorney has refused registration of MACNAUGHTON on the ground that it is primarily merely a surname. The burden is on the Examining Attorney "to establish a

*prima facie* case that a mark is primarily merely a surname.” T.M.E.P. § 1211.02(a). Any doubts about whether a term is primarily a surname are resolved in favor of the Applicant. In re United Distillers, 56 U.S.P.Q. 2d 1220 (T.T.A.B. 2000); In re S. Oliver Bernd Freier GmbH & Co., 20 U.S.P.Q. 2d 1878 (T.T.A.B. 1991). Accordingly, the Examining Attorney must put forth sufficient evidence to “establish that the [mark’s] primary significance . . . to the purchasing public is that of a surname.” In re Kahan & Weisz Jewelry Mfg. Corp., 184 U.S.P.Q. 421, 422 (C.C.P.A. 1975); In re Garan, Inc., 3 U.S.P.Q. 2d 1537, 1539 (T.T.A.B. 1987).

Applicant contends that the evidence the Examining Attorney offered regarding the term MACNAUGHTON does not meet the Trademark Office’s burden of proof to establish a *prima facie* case that the mark MACNAUGHTON is primarily merely a surname. The Applicant requests that the Section 2(e)(4) refusal be withdrawn for the following reasons:

- The LEXISNEXIS® database search appears, at best, incomplete – it does not demonstrate that MACNAUGHTON is, in fact, primarily a surname;
- Even if certain individuals associated with Applicant have the surname MACNAUGHTON, the public does not necessarily recognize it as a surname;
- No indications exist that the reference to MACNAUGHTON in the mark is a surname (*e.g.*, no initials or first name is added; it is not written in a signature form); and
- The fact that there is no dictionary definition for MACNAUGHTON does not demonstrate that MACNAUGHTON is, in fact, primarily a surname, but indicates that it could be perceived as, among other things, a coined term.

There are various types of evidence that are relevant to ascertain the public’s perception of a term. These include:

1. Telephone directory listings
2. Research database evidence
3. Surname of person associated with the Applicant
4. Specimens confirming surname significance of term
5. Negative dictionary evidence

T.M.E.P. § 1211.02(b).

The Examining Attorney has produced results from a LEXISNEXIS® database search disclosing MACNAUGHTON appeared over 1000 times as a surname in a directory of phone numbers. However, the size of the overall database is unclear, and thus the number of purported listings cited by the Examining Attorney has no context. The database print-out appears, at best, to be incomplete.

Moreover, the various tests (*e.g.*, “telephone book test”) must be used carefully because many people have surnames which the purchasing public would never recognize as such. See Kahan & Weisz Jewelry Mfg. Corp., 184 U.S.P.Q. at 422 (“Although the use of a telephone directory may be considered a factor in determining whether a mark is primarily merely a surname, we do not find this, *standing alone*, to be determinative to the issue.”). In fact, the Lanham Act aimed to “eliminate [. . .] the practice previously existing of looking up a word in several telephone directories of large cities and refusing registration if the word was found listed anywhere as a surname without regard to any other consideration.” Ex parte Wayne Pump, 88 U.S.P.Q. 437 (Chief Examiner 1951). Thus, the database evidence offered by the Examining Attorney is not sufficient.

To the extent that the database print-out is evidence of the number of MACNAUGHTON listings in the United States, it demonstrates that the surname MACNAUGHTON is not that common. Purchasers are unlikely to regard the word as a surname if they have never seen the word used. The number of listings is relatively insignificant, especially considering that the population of the United States is over 300 million.

Further, although the Examining Attorney has noted that certain people associated with Applicant have the surname MACNAUGHTON, that does not signify that the public recognizes

it as a surname. Consumer perception of a mark is a determinative factor. Only where the only significance of a word to the public is as a surname is the word primarily merely a surname.

A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, and it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word or when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname.

See Kahan & Weisz, 184 U.S.P.Q. at 422 *quoting* Rivera, 106 U.S.P.Q. at 149.

Also, there are no indications in the mark itself that MACNAUGHTON is a surname. The mark has no initials or a first name. In re Taverniti, SARL, 225 U.S.P.Q. 1263 (T.T.A.B. 1985), recons. denied 228 U.S.P.Q. 975 (T.T.A.B. 1985) (holding J. TAVERNITY is merely a surname and the use of initial “J.” adds weight to finding of surname significance). Nor is the mark written in a signature form. In re Piquet, 5 U.S.P.Q.2d 1367 (T.T.A.B. 1987) (holding that N. PIQUET written in a signature form is primarily merely a surname because using the first name initial and display in written signature format reinforces the surname significance).

The Examining Attorney also cites to printouts from The Collins Dictionary and The Oxford Dictionary showing no results for “MACNAUGHTON.” This is not necessarily evidence that the trademark MACNAUGHTON is primarily a surname; it is evidence that MACNAUGHTON could be, among other things, a coined trademark.

**IV. CONCLUSION**

For the foregoing reasons, Applicant maintains that this application is proper for publication and respectfully requests that it be forwarded.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:  
Susanna P. Lichter

*Attorney for Applicant  
The MacNaughton Group Inc.*