

U.S. Trademark Application Serial No. 88/814,541
Mark: ALBEN
Attorney Ref. No. 10065-0001

REMARKS

In the Office Action, the Examining Attorney refuses registration of Applicant's mark "ALBEN" finding the applied-for mark to be primarily merely a surname. In support of this conclusion, the Examining Attorney submits evidence from Whitepages.com purported to show the applied-for mark appearing over ten thousand (10,000) times as a surname in a nationwide phone directory of names.

Applicant has carefully reviewed the Examining Attorney's Whitepages evidence, and it appears that the evidence is insufficient to support a finding that "ALBEN" is primarily merely a surname. Accordingly, the Examining Attorney has not satisfied the burden of establishing a prima facie case that Applicant's mark "ALBEN" is primarily merely a surname and the refusal should be withdrawn. See TMEP §1211.02(a).

Specifically, with respect to the Whitepages evidence, most of the listed results are not for "ALBEN," but rather are for other surnames. In fact, very few entries of the results show "ALBEN," while the vast majority of the over ten thousand (10,000) results are for other names, e.g., Albin, Alban, Albon, Welboan, Ulbin, Wright, Gullett, Knuffke, Speerstra, Peterson, Hollaway, to name a few. See Exhibit A; Exhibit B; and Exhibit C, showing search results for "ALBEN" in Delaware, Maine and Alaska. In order to illustrate the deficiency of the evidence, Applicant has highlighted the many other names that appear in the search results on Whitepages.com for three (3) of the states searched in the nationwide search. See Id. Notably, none of the search results in Delaware are for "ALBEN;" while all but two (2) of the search results in Maine and all but four (4) of the search results in Alaska are for names other than "ALBEN," with many of them being for names that are vastly different in both appearance and sound. The fact that the search results largely consist of surnames that are not even similar to "ALBEN" is not surprising given that the "Search Guide" on Whitepages.com states "Don't worry if you forget how to spell their name correctly, our search algorithms will search for alternative spellings." Exhibit D.

Accordingly, based on the Whitepages.com evidence, the Examining Attorney's finding that "ALBEN" appears over ten thousand (10,000) times as a surname, is a complete overstatement. To the contrary, the evidence appears to support a finding that "ALBEN" is actually a very uncommon and rare surname. Thus, the public's perception of "ALBEN" would not be as primarily merely a surname. Moreover, because the evidence does not support the Examining Attorney's assertion that "ALBEN" appears over ten thousand (10,000) times as a surname, the Examining Attorney has not satisfied the burden of establishing a prima facie case that the mark is primarily merely a surname. Furthermore, "ALBEN" is not the surname of anyone connected with Applicant. In addition, the meaning of "ALBEN" is a combination of the names of the partner members of Applicant, i.e., "Al" and "Ben" and, therefore, has a meaning other than as a surname.

As the evidence submitted by the Examining Attorney fails to show that Applicant's mark "ALBEN" is primarily merely a surname, and in fact rather indicates that "ALBEN," as a surname, is extremely rare, the Examining Attorney has not satisfied the burden of establishing a prima facie case that the mark is primarily merely a surname. In addition, "ALBEN" is not the surname of anyone connected with Applicant, but rather is a made-up term consisting of a combination of a few letters from each of the names of Applicant's members and, therefore, has a meaning other than as a very rare surname. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's mark as being primarily merely a surname.