

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: The Edison Companies, LLC

Serial No.: 88255927

Mark: EDISON

Class: 36

OA Date: March 29, 2019

Examiner: Laura Gorman Kovalsky

**RESPONSE TO  
OFFICE ACTION**

This communication responds to the Office Action issued March 29, 2019 (the “Office Action”) regarding the application by The Edison Companies, LLC (“Applicant”) for registration of the mark EDISON (the “Mark”) in Class 36, as reflected in Application Serial No. 88255927 (the “Application”).

**I. DISCUSSION**

**A. Surname Refusal.**

The Examiner has refused registration of the Mark because it is allegedly “primarily merely a surname”. In determining whether a mark is “primarily merely a surname,” the following criteria must be considered: (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;” and (4) whether the term has the structure and pronunciation of a surname. *See, e.g., In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995). Applicant asserts that the Mark is not primarily merely a surname, because it has significant non-surname meaning.

1. Rareness of “Edison”: The Office Action provides evidence that the term Edison appears roughly 12,700 times as a surname in the U.S. With the U.S. population currently at just

under 330 Million people, the Edison surname accounts for less than 0.004% of the population. Even if not an extremely rare surname, Edison is certainly not a common surname.

2. Whether Anyone Connected With Applicant has the Surname Edison. Edison is not the surname of anyone connected with Applicant.
3. Non-Surname Meaning.

While acknowledging that “Edison” has surname significance, Applicant submits that surname recognition of “Edison” is primarily tied to Thomas Edison, the deceased well-known inventor of the light bulb (among other products). Thomas Edison is a historical figure who has become synonymous with invention and creativity, and is known as “The Father of Invention”. See, e.g., <https://www.nytimes.com/1997/06/01/nyregion/the-father-of-invention.html>,

<https://www.google.com/search?q=%22father+of+invention%22+%26+edison&tbm=isch&source=univ&sa=X&ved=2ahUKEwiBu4bdz-zkAhVTsZ4KHZ1DBI4Q7A16BAgEECQ&biw=1345&bih=592#imgrc=fgpRUvV2xaQeiM:&spf=1569436896133>), and the cover pages below for relevant video productions. In such a case, the term in question is not merely a surname. See, e.g., *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (holding SOUSA for fireworks and production of events and shows featuring pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant’s goods and services were of a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music").

In addition, the term “Edison” has multiple non-surname meanings. First, Edison is the name of a township in New Jersey with a population of roughly 100,000 people. See [https://en.wikipedia.org/wiki/Edison,\\_New\\_Jersey](https://en.wikipedia.org/wiki/Edison,_New_Jersey). It is also the name of geographic locations in California, Georgia, Nebraska, Ohio, Washington and West Virginia. <https://en.wikipedia.org/wiki/Edison>. It also refers to a computer programming language

([https://en.wikipedia.org/wiki/Per\\_Brinch\\_Hansen](https://en.wikipedia.org/wiki/Per_Brinch_Hansen)). Where a term with surname significance also has well-known geographic or other meaning, it is not merely a surname. See, e.g., *In re Hunt Elecs. Co.*, 155 USPQ 606 (TTAB 1967) (holding HUNT not primarily merely a surname despite surname significance); *In re Colt Indus. Operating Corp.*, 195 USPQ 75 (TTAB 1977) (holding FAIRBANKS not primarily merely a surname).

In fact, the USPTO has consistently treated the term EDISON as not merely a surname. A search of the USPTO's on-line records for existing registrations for the mark EDISON (without additional wording) reveals eleven such registrations (copies attached). Of those, one is registered on the Supplemental Register, one claims acquired distinctiveness, and nine are registered on the Principal Register without any claim of acquired distinctiveness. While each mark must be assessed on its own merits, this record shows a clear preference among examiners to treat EDISON as an inherently distinctive mark.

Applicant's Mark should be treated as a suggestive or arbitrary designation because its surname significance, if any, is likely to be overwhelmed by the association with Thomas Edison and, by extension, a spirit of innovation and invention. Therefore, Applicant requests that the surname refusal be withdrawn.

#### **B. Identification of Services.**

In connection with this response, Applicant amends its services description as follows:

Mutual fund investment; Fund investment consultation; Management of a capital investment fund; Private equity fund investment services; Hedge fund investment services; Financial services, namely, investment advice, investment management, investment consultation and investment of funds for others, including private and public equity and debt investment services; Incubation services, namely, providing financing to freelancers, start-ups, existing businesses and non-profits, ~~incubator services~~ and providing, facilitating and arranging for financing, equity capital investment and debt investment and providing strategic financial advisory services to emerging and start-up companies and entrepreneurs; Investment services, namely, venture capital funding services to emerging and start-up companies;

business accelerator services, **namely, business consulting in the field of emerging and startup companies, providing business development assistance services and business management support to emerging and startup companies, and providing work spaces containing business equipment to others**

## **II. CONCLUSION**

Based upon the discussion above, Applicant respectfully submits that it has addressed each of the issues raised in the Office Action, and therefore respectfully requests that the Mark be allowed to proceed to publication. Should any questions remain with respect to the above, please contact James L. Vana.