

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO OFFICE ACTION

This is in response to the Office Action issued July 27, 2020 for the mark THE MAYBOURNE BEVERLY HILLS & Design, U.S. Application Serial No. 88894940.

IDENTIFICATION OF GOODS AND SERVICES

Pursuant to the Examining Attorney's suggestions, Applicant requests amendment of its description of goods and services as follows:

Class 16: Periodical publications **in the fields of travel, hotels, restaurants, bars, art, fashion, shopping, health and beauty**; magazines **in the fields of travel, hotels, restaurants, bars, art, fashion, shopping, health and beauty**; books **in the fields of travel, accommodation, restaurants, bars, hotels, hotel management, restaurant management, bar management**; cookery books, **cook books**; recipe books; posters; calendars; prints, **namely printed paper signs and posters**; art prints; greeting cards; notepads; address pads; diaries; printed instructional and teaching materials **in the fields of hotel management, restaurant management and bar management**; **blank writing** journals; cartoons, **namely cartoon prints and printed cartoon strips**; educational and instructional materials **in the fields of hotel management, restaurant management and bar management**; photographs; pictures; menus, **namely printed menus**; pen holders; pens; pencils; stickers; **photograph** albums; address books; date books; postcards; note cards; notebooks; writing papers; stencil kits, **namely, stencils**; **blank writing paper** pads, **memo pads**; postage stamps; stationery; tissue papers; paper decorations for cakes; baking paper; containers and cases of paper or card for baking, **namely, paper and cardboard cake boxes, paper and cardboard cake circles**

Class 43: Hotel services; restaurant, café and bar services; banqueting and catering services; brokering reservations for hotels; arranging and booking hotels and accommodation services, **namely, hotel accommodation services**; conferences, and conventions, **namely, provision of facilities for conferences and conventions**; reservation services for temporary accommodations; child minding services, **namely, day nurseries**, babysitting; information, advice and consultancy relating to the aforesaid services

Class 44: Hairdressing and hair styling services; provision of beauty treatments and therapies, **namely, beauty salon services**; pedicure and manicure services; depilatory services; cosmetic services, **namely, skin care, body care, face care services**; health care services; health spa services, **namely, health and wellness of the body and spirit, namely, providing massage, facial and body treatment services, cosmetic body care services**; spa services, **day spa services, namely, nail care, manicures, pedicures and nail enhancements**; massage services; flower arranging services; information, advice and consultancy relating to the aforesaid services

APPLICANT'S MARK IS NOT PRIMARILY MERELY A SURNAME

The United States Patent and Trademark Office (the “Office”) has taken the position that the applied-for THE MAYBOURNE BEVERLY HILLS & Design mark is primarily merely a surname. The burden is initially on the Office to establish a *prima facie* case that a mark is primarily merely a surname. If established, the burden then shifts to Applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the Applicant. *In re Yeley*, 85 USPQ2d at 1151; *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

The Trademark Trial and Appeal Board has adopted five factors for consideration in determining whether a term is primarily merely a surname. They are as follows:

- 1) Whether the surname is rare;
- 2) Whether the term is the surname of anyone connected with the Applicant;
- 3) Whether the term has any recognized meaning other than as a surname;
- 4) Whether it has the "look and feel" of a surname; and
- 5) Whether the stylization of lettering is distinctive enough to create a separate commercial impression.

TMEP §1211.01; *In re Benthin*, 37 USPQ2d at 1333-1334.

As discussed in greater detail below, Applicant respectfully disagrees that the THE MAYBOURNE BEVERLY HILLS & Design mark is primarily merely a surname because (1) MAYBOURNE is an extremely rare surname; (2) MAYBOURNE is not a surname of anyone connected with the Applicant; (3) MAYBOURNE is a well-recognized brand that consumers perceive as a trademark rather than a surname; (4) MAYBOURNE does not have the “look and feel” of a surname; and (5) Applicant’s mark incorporates unique visual and literal elements that create a distinct commercial impression; and (6) any doubt is resolved in favor of Applicant.

1. MAYBOURNE is an Extremely Rare Surname

The rarity of a surname is a factor to be considered in determining whether a term is primarily merely a surname. *In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1924 (TTAB 2007) (finding the extreme rarity of BAIK weighed against surname refusal); *In re Benthin Mgmt. GmbH,* 37 USPQ2d 1332, 1333 (TTAB 1995) (finding the fact that BENTHIN was a rare surname to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Sava Research Corp.,* 32 USPQ2d 1380, 1381 (TTAB 1994) (finding SAVA not primarily merely a surname, where there was evidence that the term had other meaning, no evidence that the term was the surname of anyone connected with applicant, and the term's use as a surname was very rare); *In re Garan Inc.,* 3 USPQ2d 1537 (TTAB 1987) (holding GARAN not primarily merely a surname).

In this case, the Examining Attorney has cited whitepages.com, which only lists 5 people with the last name Maybourne, when a duplicate reference is taken into account. Additionally, the forebears.io website cited by the Examining Attorney indicates there were only 6 instances of the Maybourne surname in the U.S. in 2014, or 1 in 60,418,418. Further, the U.S. Census Bureau has compiled and made publicly available a list of the 162,254 surnames that occur 100 or more times in the U.S. (from 2010 Census) and "MAYBOURNE" does not even appear on this list (see "File B: Surnames Occurring 100 or more times" available for download from the U.S. Census Bureau website at https://www.census.gov/topics/population/genealogy/data/2010_surnames.html). Thus, Applicant submits that this is strong evidence that MAYBOURNE is a very rare surname.

By way of comparison, the U.S. Census Bureau identifies 1003 individuals with the surname "BAIK" which was determined by the TTAB to be "extremely rare" which weighed against a surname refusal. *In re Joint-Stock Co.,* 84 USPQ2d. 1921 (TTAB 2007). Similarly, the

U.S. Census Bureau identifies 352 people with the “BENTHIN” surname which was considered a rare surname to be a factor weighing against a finding that the term would be perceived as primarily merely a surname. *In re Benthin*, 37 USPQ2d at 1333. Additionally, the U.S. Census Bureau identifies 718 people with the “SAVA” surname which was determined to be not primarily merely a surname as there was no evidence that the term was the surname of anyone connected with applicant and the term’s use as a surname was very rare. *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). Finally, the U.S. Census Bureau identifies 196 people with the “GARAN” surname, which was held to be not primarily merely a surname. *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987).

The word MAYBOURNE is by no stretch of the imagination a commonly used surname. On the contrary, it is an extraordinarily rare one. Thus, in this case it is not reasonable to assume from Maybourne being a surname in a vanishingly small percentage of the population that Applicant’s consumers must perceive the mark to be a surname.

Further, although the Examining Attorney listed 20 references from an ancestry.com search for passports and travel lists under the name Maybourne, many of these names look to be duplicates of each other and look to span back as far as 1795. Further, the Examining Attorney has argued that “Maybourne” has the structure of a surname because other surnames exist, such as “Mayborne” and “Mayborn”. However, Applicant submits that these terms are different and are themselves extremely rare, as neither appear in the 2010 Census list surnames that occur 100 or more times in the U.S., and per the forebears.io evidence cited by the Examining Attorney, there were only 46 instances of the Mayborne surname in the U.S. in 2014, and 73 instances of the Mayborn surname in the U.S. in 2014. Thus, none of the evidence cited by the Examining Attorney shows that Mayboune is a common surname or a term that consumers will even understand it as a

surname. Indeed, the OneLook search for Maybourne by the Examining Attorney returned no results. As such, the evidence shows that Maybourne is an extremely rare surname in the United States and Applicant's mark is not primarily merely a surname.

2. *No One Connected with the Applicant has the Surname Maybourne*

There is no evidence that anyone connected with the Applicant has the surname Maybourne. In fact, not only is there no such person, but the mark was devised by a branding company, as follows. Applicant owns, inter alia, three of the world's most exclusive and famous hotels, each located in the famous and exclusive area of Mayfair in London. Applicant's predecessor is The Savoy Group, the then owner of the famous Savoy Hotel in London. Upon sale of that hotel it became necessary for The Savoy Group to change its name and for that purpose they sought the assistance of a branding company, Landor Associates. Attached as **Exhibit A** is a description from that branding company of how the mark MAYBOURNE was devised.

The starting point was Mayfair, an exclusive area in Central London, because of the desire to associate with the exclusivity of that geographical area. Second, the concept involved the addition of the word "bourne", to suggest these hotels were "born" in Mayfair, the "e" being added to make the mark seem "English". As Landor Associates say, "The name sounds and looks well established, premium and quintessentially English." The mark has nothing to do with a surname, nor do consumers perceive it to be one.

Consumers of Applicant's services under the mark are not planning on staying at a typical hotel. For instance, Applicant's hotels in Mayfair are very high-end hotels and are not inexpensive to stay at. These consumers are sophisticated, selecting high priced and exclusive services with care and very much aware of the nature and location of these hotels. They are purposefully choosing to stay in a particular, exclusive and famous hotel in Mayfair, London. The mark is

intimately associated in the minds of consumers with these factors and thus, it is not primarily merely a surname.

3. *MAYBOURNE is a Well-Recognized Brand That Consumers Perceive as a Trademark Rather Than a Surname*

Further, Applicant submits that its MAYBOURNE marks are well-recognized and associated with the hotels in which Applicant's goods and services are provided. Applicant also owns registrations for its MAYBOURNE and MAYBOURNE HOTEL GROUP & Design marks in the United States, further evidencing that consumers perceive Applicant's MAYBOURNE marks primarily as source identifiers. The goods and services claimed in the subject application are the types that are marketed and sold in close association with the services claimed in Applicant's prior registrations discussed above. Thus, consumers will immediately associate Applicant's MAYBOURNE marks as emanating from the same source and consumers clearly perceive the primary significance of Applicant's marks as that of trademark significance, rather than primarily merely as a surname.

4. *MAYBOURNE Does Not Look or Sound Like a Surname*

Further, Applicant's mark does not have the "look" or "feel" of a surname. In Renati¹, the Board, in reversing the Examining Attorney noted that as to 'look and feel,' because 'Renati' was an extremely rare surname, "the examining attorney has not met her burden of demonstrating that 'Renati' has the look and feel of a surname". Likewise, the rareness of the surname MAYBOURNE weighs against the Examining Attorney's position that MAYBOURNE has the look and feel of a surname.

¹ See In re House of Terrance Proprietary Ltd., Serial No., 79048704, 2010 TTAB LEXIS 8, *10 (T.T.A.B. 2010) [not precedential] ("Renati").

Here, because the mark combines two English words (“may” and the phonetic equivalent of “born,”), it does not have the appearance of being a surname. MAYBOURNE is more likely to be perceived as “may-born,” as set forth above, or as a brand name. Instead, MAYBOURNE looks and feels like the brand name for a large, successful hotel group.

In Baik, the applicant argued that BAIK “is an arbitrary Russian sounding word mark” that sounds “similar to Baikal, a Russian lake in Siberia” and to “the Baikal mountain range in Siberia.” It’s noted that BAIK is promoted along with the words “VODKA Siberia,” and urged that the public sees BAIK as a “fanciful Russian term used in a trademark sense.” The Board, in reversing the Examining Attorney, agreed with the applicant. The Board also noted that the fact that the public may view a mark as having the “look and feel” of a surname should not be a basis for refusal of rare surnames. “If the surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.”

Likewise, as discussed above, Maybourne is an arbitrary British sounding word mark that sounds similar to Mayfair, an exclusive area in Central London, with the addition of the word “bourne”, to suggest these hotels were “born” in Mayfair. In fact, given the history behind Applicant’s selection of the mark, the mark is reminiscent of a city name, e.g. Melbourne, May City, Maywood, Maytown, May Creek, Mayport, Bourne etc. See In re Hall Wines, LLC, 2009 TTAB LEXIS 252, *7 (T.T.A.B. 2009) [not precedential]. In any event, despite the Examining Attorney’s evidence, it is just as plausible, if not more so, for consumers to think that the mark has no meaning at all.

5. *Applicant’s Mark Incorporates Distinctive Visual and Literal Elements That Create a Distinct Commercial Impression*

Pursuant to TMEP § 1211.01(b)(ii), a mark comprised of a word that, standing by itself, would be considered primarily merely a surname, but which is coupled with a distinctive stylization or design element, is not considered primarily merely a surname. *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995) (finding stylized display of term BENTHIN to be a factor weighing against a finding that the term would be perceived as primarily merely a surname). In the present case, the subject mark incorporates distinctive visual elements that create a distinct commercial impression. Further, the literal portion of Applicant's mark is not primarily merely a surname. In addition to the term MAYBOURNE itself not being primarily merely a surname, Applicant's mark incorporates the additional literal terms "THE" and "BEVERLY HILLS". Thus, Applicant's THE MAYBOURNE BEVERLY HILLS & Design mark in its entirety is certainly not primarily merely a surname, as these additional terms create a unique commercial impression that does not have primary significance as a surname. For instance, the definite article "THE" in Applicant's mark conveys that the term MAYBOURNE refers to a particular/specific hotel, and not to an extremely rare surname. All of the above further helps to ensure that consumers do not view the mark as primarily merely a surname.

6. *Doubt is to be Resolved in Favor of Applicant*

As with questions of descriptiveness under Section 2(e)(1), "on the question of whether a mark would be perceived as primarily merely a surname, we are inclined to resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods or services can file a notice of opposition." *Benthin*, 37 U.S.P.Q.2d at 1334.

Because MAYBOURNE is not primarily viewed by the purchasing public as a surname, it is not primarily merely a surname. It has a meaning aside from any surname significance, and

Applicant respectfully requests that the Examining Attorney withdraw the objection to register the subject mark.

CONCLUSION

Applicant has responded to all matters in the Office Action and should the Examining Attorney have any questions with regard to this Response or to any matter relating to this Application, in general, a telephone call to Applicant's undersigned representative at the telephone number listed below would be greatly appreciated.

Respectfully submitted,

/s/ /bssmith/

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