

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77818198
LAW OFFICE ASSIGNED	LAW OFFICE 102

MARK SECTION (no change)

ARGUMENT(S)

Applicant carefully considered the issues raised in the Office Action dated December 8, 2009, and notes the comments of the Examining Attorney with appreciation.

Substantively, Applicant must respectfully disagree with the proposed refusal to register Applicant's mark HAYDEN'S GRILL AND BAR under Section 2(e)(4) of the Trademark Act as the Examining Attorney contends that the mark "is primarily merely a surname." Favorable reconsideration is therefore requested.

As discussed by the Trademark Trial and Appeal Board (TTAB) in the case of *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995), the proper evidentiary standard for evaluating whether a term is "primarily merely surname" involves an examination of the following factors: (1) the degree of a surname's rareness; (2) whether anyone connected with applicant uses the mark as a surname; (3) whether the mark has any recognized meaning other than that of a surname; and (4) whether the mark has the "look and sound" of a surname.¹ Any doubt concerning these factors should be resolved in favor of the applicant. *See id.* at 1334.

Initially, Applicant points out that the Examining Attorney carries the full burden to make a *prima facie* showing of surname significance. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). Furthermore, it is the "impact or impression [on the purchasing public of how the mark is used] which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, **and it is only that**, then it is primarily merely a surname." *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975), (*quoting Ex parte Rivera Watch Corp.*, 106 UPSQ 145 (Comm'r 1955)) (emphasis added).

Here, the Examining Attorney acknowledges that Applicant's mark includes the wording GRILL AND BAR. However, he contends that the combination of "a surname with the generic name for the goods and/or services does not overcome a mark's surname significance." Contrary to the Examining Attorney's position, "a mark sought to be registered must be considered in its entirety." *In re Hutchinson Technology Incorporated*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (holding the Board committed a "fatal flaw" by analyzing the registrability of the terms HUTCHINSON and TECHNOLOGY separately rather than the HUTCHINSON TECHNOLOGY mark as a whole).

In addition, the Examining Attorney relies solely upon the search results from the online database LexisNexis, namely pointing out that HAYDEN appears as a surname 15,087 times in a nationwide telephone directory of names in support of his contention that HAYDEN is "primarily merely a surname." Importantly, the Examining Attorney fails to provide any reference to the size of the searched database and makes no analysis to determine whether these results render the term a "common" or "rare" surname. Moreover, the Examining Attorney does not indicate whether this number takes into account duplicative listings.

Pursuant to the United States Census Bureau's web page, the current estimated population of the U.S. is over 309,000,000. Thus, the 15,087 times that Hayden appears as a surname in this database only works out to 0.00488% in the United States. There is not a threshold number of surname listings upon which a particular surname is considered "rare." Nevertheless, this relatively small percentage indicates that Hayden appears to be a relatively rare surname. *See In re United Distillers PLC*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER a rare surname of only 0.001%). As a result, this factor does not weigh in favor of a finding that HAYDEN'S GRILL AND BAR is primarily merely a surname.

Turning to the second factor, Applicant asserts that it does not use Hayden as a surname, nor associates with anyone who does.

Thus, this factor weighs heavily in Applicant's favor that HAYDEN'S GRILL AND BAR is not primarily merely a surname.

With respect to the third factor, the Examining Attorney completely ignores whether there is another recognized meaning for HAYDEN. Indeed, the relevant question is whether the term has another recognized significance other than as a surname. Importantly, Hayden is a popular given name in the United States for both boys and girls. See www.wikipedia.org. In addition, Hayden is becoming increasingly popular as a given name in the United Kingdom wherein it means "hay valley" from the Old English combination of "heg" meaning hay and "denu" meaning "valley." See *id.* In view of the fact that Hayden is well recognized as a given name and the Examining Attorney's fails to provide any evidence indicating that Hayden has no recognized meaning, this factor also weighs in Applicant's favor that HAYDEN'S GRILL AND BAR is not primarily merely a surname.

Finally, as to the fourth factor, whether the proposed mark has the "look and feel" of a surname, the Examining Attorney again fails to even address this factor. Applicant argues that HAYDEN does not have the "look and feel" of a surname based upon the reasoning of the Board in *Benthin*. Specifically, when evaluating this "decidedly subjective" factor, the Board found that BENTHIN "[did] not have the clear look and sound of a surname [. . .], nor [did] it have the clear look and sound of an arbitrary term...." *In re Benthin Management GmbH* at 1333 (emphasis added). This lack of clear evidence led to the Board's conclusion that the "fourth factor [was] neutral," and therefore did not weigh against publication. *Id.* Following the Board's reasoning, Applicant respectfully contends that in light of the other factors previously discussed (namely, that HAYDEN is a relatively rare surname and it is also a popular given name) as well as the Examining Attorney's failure to present any evidence demonstrating that HAYDEN'S GRILL AND BAR has the look and feel of a surname, HAYDEN'S GRILL AND BAR does *not* have the "clear look and sound of a surname" necessary to prevent registration of the mark.²

After reviewing the foregoing remarks, it is believed that the Examining Attorney will agree that all the issues raised in the Office Action have been satisfactorily addressed. In consideration of the favorable *Benthin* factors set out above, it is submitted that HAYDEN'S GRILL AND BAR is not primarily merely a surname. Therefore, Applicant respectfully requests allowance of the application. However, if further discussion on any of the issues raised in the Office Action is deemed necessary, Applicant's Counsel requests that the Examining Attorney contact him at the following telephone number.

Respectfully submitted,

KING & SCHICKLI, PLLC

Trevor T. Graves

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Lexington, Kentucky 40507

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SIGNATURE SECTION

RESPONSE SIGNATURE	/Trevor T. Graves/
SIGNATORY'S NAME	Trevor T. Graves
SIGNATORY'S POSITION	attorney of record
DATE SIGNED	06/08/2010
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Tue Jun 08 11:16:30 EDT 2010
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XXX- 20100608111630955887-7781 8198-46036bada4eacd8ab35e

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77818198** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant carefully considered the issues raised in the Office Action dated December 8, 2009, and notes the comments of the Examining Attorney with appreciation.

Substantively, Applicant must respectfully disagree with the proposed refusal to register Applicant's mark HAYDEN'S GRILL AND BAR under Section 2(e)(4) of the Trademark Act as the Examining Attorney contends that the mark "is primarily merely a surname." Favorable reconsideration is therefore requested.

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SIGNATURE(S)

Response Signature

Signature: /Trevor T. Graves/ Date: 06/08/2010

Signatory's Name: Trevor T. Graves

Signatory's Position: attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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