

A Trademark By Any Other Name...

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The Lanham Act prohibits registration on the Principal Register of a mark that is “primarily merely a surname” unless an applicant can show that the mark has acquired secondary meaning such that consumers perceive the surname as an identifier of source. 15 U.S.C. § 1052(e)(4). Alternatively, a surname mark can be registered on the Supplemental Register, which is the junior federal register for marks that are considered not distinctive enough to be registered on the Principal Register. Because there are numerous benefits associated with registration on the Principal

Register, applicants often elect to argue against surname refusals.

Federal courts and the Trademark Trial and Appeal Board have held that a term is primarily merely a surname if its primary significance to consumers is that of a surname when viewed in relation to the goods or services for which registration is sought. This determination is made on a case-by-case basis, and there is no rule as to the amount or type of evidence necessary to demonstrate whether a mark would be considered primarily merely a surname. Typically, the Board and trademark examiners have used the following five-part inquiry to determine whether the primary significance of a term is as a surname:

- Whether the surname is rare.
- Whether the term is a surname of anyone connected with the applicant.
- Whether the term has any recognized meaning other than as a surname.
- Whether the term has the structure and pronunciation of a surname.
- Whether the stylization of the mark is distinctive enough to create a separate

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commercial impression.

These factors are known as the *Benthin* factors, derived from the Board's decision in *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

The Board clearly felt more attention to these issues was necessary, as it issued three precedential opinions in surname registration cases in the latter part of 2016. The unifying lesson of these cases is that the focus of the analysis will be whether the purchasing public will perceive a surname mark as having primary significance as a surname.

In September, the Board upheld refusal of an application for the mark ALDECOA on the ground that ALDECOA is primarily merely a surname. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276 (TTAB 2016). Although the Board found that the Aldecoa family had involvement in Applicant's business and the name did not have any recognized significance other than as a surname, the Board also acknowledged that the ALDECOA surname is rare. With respect to this latter point, the Board cautioned that the Lanham Act does not exempt registration of surname marks that are "shared only by a few, or provide that the purpose of the prohibition is to protect others' rights to use their surnames except for those with uncommon surnames. The only issue to be determined under the statute is whether a term 'is primarily merely a surname.'"

Also in September, the Board issued its opinion in *In re Integrated Embedded*, 120 USPQ2d 1504 (TTAB 2016), in which it upheld refusal of registration of the mark BARR GROUP as primarily merely a surname. In this case, the Board found that Michael Barr was applicant's founder and that consumers would encounter Mr. Barr's name in numerous key places on the applicant's website, such that the consumers would likely view BARR as a surname. Moreover, the Board held that the inclusion of the descriptive term GROUP in the mark does not alter the surname significance because it merely creates a perception of people that are led by an individual with the surname BARR.

Finally, in November, the Board handed down its decision in *In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717 (TTAB 2016), refusing registration of the mark ADLON as primarily merely a surname. The Board doubled-down on its emphasis on the importance of whether the public would perceive a mark as primarily merely a surname. The Board bemoaned that "rather than using [the *Benthin*] factors as guidelines, practitioners and examining attorneys have often interpreted them with a rigidity that is not warranted." The Board cautioned that a surname's rareness is not indicative of the amount or type of evidence that is necessary to establish whether the mark has primary significance to the purchasing public as merely a surname. Additionally, although Applicant had argued that the public would perceive ADLON as having trademark significance, the Board stated that trademark law recognizes that functioning trademarks may have various non-distinctive meanings, including as surnames, "which may be appreciated by customers even though they primarily understand the mark to be source-indicating." After consideration of all of the factors and evidence, the Board found that applicant failed to demonstrate that the term ADLON had any significance that would be perceived by the public other than as a surname.

The takeaway from this trilogy of cases is that Applicants facing surname refusals should not mechanically focus on the *Benthin* factors as proving or disproving surname significance. Instead, even if any of the factors are decidedly against applicant (e.g., if the mark is the surname of a founder or important employee), applicants should focus their arguments on why the purchasing public will not perceive the mark as primarily merely a surname.