

The Earnhardts' Race To the Courtroom: Who Will Get The Checkered Flag?

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On July 27, 2017, the Federal Circuit decided Earnhardt v. Earnhardt, a trademark collision between two relatives of the famous race car driver, Dale Earnhardt. The case involved an appeal from a TTAB decision

between Teresa Earnhardt, widow of Dale Earnhardt, who holds a portfolio of “Dale Earnhardt” and “Earnhardt” marks, and her stepson Kerry Earnhardt, a race car driver who sought to register “Earnhardt Collection” for furniture in Class 20 and “custom construction of homes” in Class 37. The TTAB dismissed Teresa’s opposition to the “Earnhardt Collection” application, but the Federal Circuit waved a “yellow flag” and vacated and remanded the decision.

The Federal Circuit’s opinion states that while “Earnhardt” is a surname that is typically not registrable, the addition of the term “Collection” makes it registrable if the combination of the two terms considered as a whole makes the surname not the “primary significance” of the mark. A key element in such a determination is whether the non-surname term, Collection, is “merely descriptive” of the applicant’s goods and services. If the term “Collection” was merely descriptive, then Kerry’s application would fail. On the other hand, if “Collection” altered the primary significance of the mark such that consumers would not view it as primarily a surname, then the mark would be registerable. The Federal Circuit found that the TTAB’s decision lacked clarity as to what exactly was decided:

[I]t is unclear whether the Board engaged in a merely descriptive inquiry for the term “collection” or if the Board improperly constricted its analysis to only a genericness inquiry. On one hand, the Board’s decision could be understood as finding that “collection” is neither generic nor merely descriptive of [Kerry’s] goods and services, and

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adding “collection” to “Earnhardt” alters the surname significance of Earnhardt in the mark as a whole, such that the purchasing public would not consider the mark as a whole to be primarily a merely surname.

On remand, the TTAB must consider (1) whether the term “Collection” is merely descriptive of Kerry Earnhardt's furniture and custom home construction services, and (2) the primary significance of the mark as a whole to the purchasing public. The Federal Circuit was particularly concerned that the TTAB had not made an affirmative finding so that the Court could make an evaluation of the distinctiveness of the disputed mark as a whole.

Of particular interest here is that the Federal Circuit held that the TTAB stated that the mark was neither generic nor merely descriptive, but did not make the affirmative finding of genericness or descriptiveness that the Federal Circuit has deemed important. The Court distinguished from its holding in *In re Hutchinson Technology Inc.*, 852 F.2d 552, 554 (Fed. Cir. 1988), where the Court held that the TTAB's finding that “technology” was merely descriptive was incorrect and reversed. In the instant matter, the Federal Circuit remanded so that the TTAB could explain itself as to whether it had made a finding on the distinctiveness scale.

The Federal Circuit also emphasized that it is important to evaluate the mark as a whole by considering whether the term “Collection” is generic or descriptive when considered as part of the “Earnhardt Collection” mark. The Court included the example of the mark “Sugar & Spice” for bakery products where each word itself was descriptive, but in combination they were suggestive. On remand, the Court required the Board to determine the primary significance of both “Earnhardt” and “Collection” together in its determination. We will keep you posted on which Earnhardt ultimately hits the “checkered flag.”