

Following The Earnhardt's Race To the Courtroom, USPTO Raises the Bar on Surnames

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Last month we reported on the Federal Circuit decision in *Earnhardt v. Earnhardt*, vacating and remanding the TTAB's dismissal of the opposition by Teresa Earnhardt (widow of Dale Earnhardt) to the "Earnhardt Collection" trademark application filed by her stepson Kerry Earnhardt. On remand, the Court required the Board to determine the primary significance of both "Earnhardt" and "Collection" together in its determination of whether the additional term "Collection" makes the mark EARNHARDT COLLECTION registrable (even though

"Earnhardt" standing by itself is a surname that is typically not registrable). On August 28, 2017, the PTO issued updated trademark examination guidelines clarifying the policies and procedures for examining marks containing merely descriptive or generic wording in addition to a surname. These guidelines will be incorporated in the October 2017 revision of the TMEP.

TMEP §1211.01(b)(vi) states that when merely descriptive wording is combined with a surname, the mark is not considered primarily merely a surname under §2(e)(4) of the Lanham Act because merely descriptive wording is capable of functioning as a mark. This rule surprisingly did not facilitate easy registration of surname marks. Under the new PTO guidelines, in cases where none of the additional matter combined with a surname is inherently distinctive or has acquired distinctiveness (it is merely descriptive or generic), refusal of the entire mark as being primarily merely a surname based on §2(e)(4) will be appropriate in most circumstances.

The PTO's decision to update the trademark examination guidelines was driven by the

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Board's observation that the old guidance contradicts the Federal Circuit's directive, which requires a mark to be considered in its entirety and is not limited to whether the additional matter can function as a mark. In In Re Hutchinson Technology Incorporated, 852 F.2d 552 (Fed. Cir. 1988), the Federal Circuit stated that "[t]he test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public." The Court in *Hutchinson* determined that the Board made two errors in its analysis that HUTCHINSON TECHNOLOGY is primarily merely a surname for etched metal electronic components, flexible circuits and other goods in Class 9: (1) the Board incorrectly considered the mark as two separate parts "Hutchinson" and "technology" and analyzed the registrability of each word separately rather than considering what the purchasing public would think when confronted with the mark as a whole; (2) the evidence did not establish that "technology" was generic or merely descriptive of the identified goods. The Court reversed the refusal to register.

The *Hutchinson* test was applied by the Board in Azeka Bldg. Corp. v. Azeka, 122 USPQ2d 1477, 1492 n.9 (TTAB 2017), which noted "the assessment of a composite mark containing a surname is not limited to the inquiry of whether the additional term is capable of functioning as a mark or not.... Rather ... we must consider the meaning of the mark as a whole." The Board found the addition of the term RIBS did not alter the meaning of the mark AZEKA'S RIBS for "barbeque sauce" as a whole to displace the primary surname significance of AZEKA, and sustained the opposition on the ground that Opposer has established that AZEKA'S RIBS is primarily merely a surname and not registrable on the Principal Register absent a finding of acquired distinctiveness.

In the Earnhardt v. Earnhardt decision issued on July 27, 2017, the Federal Circuit clarified that the meaning of a mark must be evaluated as a whole by considering whether the additional term(s) are generic or merely descriptive. Further, the meaning of the mark as a whole must be assessed to determine whether adding the additional term to the surname alters the primary significance of the mark as a whole.

In conclusion, the new rules should help harmonize the PTO's examination of surname-based marks combined with additional terms in their entirety, rather than considering the mark as separate terms. Further, the mark should be analyzed for both genericness and descriptiveness in the overall impression of the mark. However, to avoid a refusal under §2(e)(4) altogether, applicants should seek registration for a mark composed of a surname and a suggestive (or stronger term), settle for obtaining a Supplemental Registration, at least initially (see TMEP § 1211), or avoid surnames altogether as a brand identity.