

## Some Clarity On Surname Trademarks From USPTO

Authored by Davide Schiavetti for Law360

Article

9.14.17

In August, the USPTO issued Examination Guide 3-17, setting forth guidelines that effectively change the policies and procedures that address marks comprised of terms that are “primarily merely a surname” under §2(e)(4) of the Lanham Act, and an additional term.

Before the introduction of the new guidelines, TMEP §1211.01(b)(vi) regulated the issue and provided that if any additional wording – even when descriptive – was to be combined with a surname, the mark did not fall within §2(e)(4) and therefore was not considered “primarily merely a surname”. While this regulation may appear to allow easy registration of surname marks, applicants have learned that in practice this is not always the case as Examining Attorneys routinely deny applications based on §2(e)(4).

Ultimately, the Examining Attorney’s determination would hinge on whether the term combined with a surname was generic or merely descriptive. While some terms can easily be identified as either generic or merely descriptive the line of demarcation often is far from clear. A refusal based on the genericness of the term added to the surname contaminates the whole mark and bars registration. Conversely, when the combined term is merely descriptive, the Examining Attorney needs to conduct an analysis of the mark in its entirety to determine whether the addition of the term defeats the primary connotation of the mark as a surname. The new guidelines address this point and clarify the parameters of the analysis in an attempt to harmonize the outcomes.

The decision that triggered the new examination guide is a decision of the Court of Appeals for the Federal Circuit, *In re Hutchinson Tech.*<sup>1</sup>, in which a trademark applicant appealed the Trademark Trial and Appeal Board’s (TTAB) decision to refuse registration of his mark. The mark at issue was “HUTCHINSON TECHNOLOGY” for goods in class 9, which was refused solely on the basis that the mark was primarily a surname. The Federal Circuit, however, found that the TTAB erred in its analysis. In explaining its position, the Court raised two interesting points.

### Key Contact

Davide F. Schiavetti

### Related Areas of Practice

Appellate Litigation

Trademark Litigation

Trademark Prosecution

First, it provided more clarity as to the meaning and scope of “merely descriptive” marks. Interestingly, the Court reasoned that, while the term “technology” may be used in connection with goods that are listed in the application (in this instance etched metal electronic components, flexible circuits, etc.), it is essentially too broad to be “merely descriptive,” as it includes many categories of goods and therefore does not immediately convey the idea of the specific goods in Hutchinson’s application. Thus, if a surname survives the genericness test, over-inclusive added words, like “technology,” might actually shield it from refusal under §2(e)(4).

This analysis is particularly interesting when considering the well-established idea of the genericness continuum, where generic words are on one end of the spectrum and arbitrary terms on the other. Merely descriptive terms are the second least distinctive type of marks on the spectrum. According to the decision in *Hutchinson*, however, broad descriptive terms might avoid the threshold and classification as “merely descriptive.” In practice, this results in a term that is on a higher level of the continuum than “merely descriptive” words, to actually help land a registration if combined with a surname.

The importance of the analysis and related classification of the combined term as either “descriptive” or “generic” is further stressed by the decision of the Federal Circuit in *Earnhardt v. Kerry Earnhardt*<sup>2</sup>. In that case, the Federal Circuit remanded the decision to the TTAB, because it was unclear whether the TTAB had limited itself to a genericness inquiry of the term, or if it had also considered the descriptiveness of the mark.

Second, the Court warned not to rely solely on the applicant’s concessions, and to always consider the marks in their entirety. In *Hutchinson*, the applicant conceded that many of the goods listed in their application used “technology”, so the TTAB relied on this concession and ruled that the inclusion of the term “technology” did not exempt the mark from refusal under §2(e)(4) because the added term did not carry sufficient significance to avoid the mark from being perceived as “primarily a surname.” According to the Federal Circuit, this analysis was erroneous. Instead, the TTAB should have considered how the purchasing public would react to “HUTCHINSON TECHNOLOGY” in its entirety, rather than simply to “HUTCHINSON” or “TECHNOLOGY”. As a result, the Court remanded the case to the Board for reevaluation.

This second point constitutes the bulk of the new guidelines released by the USPTO in August. Before the release of the examination guide, both the TTAB and the Federal Circuit had reiterated the necessity to consider surname-based marks combined with additional terms in their entirety. In *Azeka Bldg. Corp. v. Azeka*<sup>3</sup>, the Board utilized the factors identified in *Eximius Coffee* to determine whether a mark is primarily merely a surname in its entirety: 1) whether the term is the surname of anyone connected with the applicant; 2) whether the term has any recognized meaning other than as a surname; 3) whether evidence shows that the term has the structure and pronunciation of a surname; 4) whether there is contextual use related to surname significance; and 5) whether the evidence shows use of the term as a surname is rare. Interestingly, it analyzed whether the addition of the term “ribs” to “Azeka’s” detracted from the primary significance of Azeka as a surname before it completed the five-prong test, specifically before the last factor. Again, at the end of its analysis in *Earnhardt v. Kerry Earnhardt*, the Federal Circuit reiterated how important it is for the TTAB to consider the mark and its effect on the public as a whole, and not as two separate terms.

In conclusion, it is important that a mark for which registration is sought be analyzed for both genericness and descriptiveness, and that such analysis comprises the overall impression of the surname combined with the additional term. As explained in the instances above, it seems that there are better odds in obtaining a registration for a mark comprised of a surname and a broad descriptive term rather than a surname and a “merely descriptive” term. In light of the new guidelines, however, the safest course of action for practitioners is arguably to suggest that clients avoid using their surnames if possible and rather let their creativity loose to avoid the uncertain outcome of this analysis.

<sup>1</sup> *In re Hutchinson Tech.* 852 F.2d at 554, 7 USPQ2d at 1492.

<sup>2</sup> *Earnhardt v. Kerry Earnhardt*, \_\_\_ F3d. \_\_\_\_, 123 USPQ2d 1411 (Fed. Cir. 2017)

<sup>3</sup> *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1492 n.9 (TTAB 2017)

This article was originally published in Law360's Expert Analysis on September 14, 2017. To read the article on Law360's site, [click here](#).