

## Singing the surname blues



| Friday, June 9, 2017

Last month, the Trademark Trial and Appeal Board (TTAB) issued a precedential decision, affirming the Trademark Office's refusal of registration for BELUSHI'S for "travel reservations" and related services and "hotel...restaurant and catering services" and related services on grounds that the mark functions "primarily merely as a surname." Although the board admitted in this case the surname is rare, it found that given the celebrity of John Belushi and Jim Belushi, consumers would recognize the mark as a surname. In this particular case, only five people in the United States are named Belushi – confirming that the term is exceedingly rare. However, the board affirmed the refusal of registration despite the rarity of the surname finding purchasers would "immediately recognize [the mark] as a surname." In other words, the board held the Belushi name is not rare when considered in terms of its exposure as a surname.

### **The status of the law**

Section 2(e)(4) of the Trademark Act and the various cases interpreting this section are clear that absent a showing of acquired distinctiveness, terms that function "primarily merely as a surname" shall be rejected. The primary significance to the purchasing public determines whether the mark is primarily merely a surname. In addition, the cases set forth a number of factors to help trademark examiners and applicants determine whether a term is "merely a surname":

- i. Whether the surname is a rare
- ii. Whether anyone connected with the applicant uses the term as a surname (if the term identifies a historical figure, the term may not be merely a surname)
- iii. Whether the term has recognized meaning other than a surname
- iv. Whether the term has the look and feel of a surname

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### **Application to other decisions**

The Trademark Office has recently rejected many surname trademark applications and in the past year issued a number of precedential decisions regarding this hotly contested area of the law. Although rare surnames and additional terms to the surname mark in the past have generally tipped the scales in an applicant's favor, recent decisions have overruled both of these factors and not in applicant's favor.

In trying to register ALDECOA for coffee, the mark was found to be primarily merely a surname despite its rarity as a surname. The evidence suggested no other meaning for the mark other than as a surname, but the Trademark Trial and Appeal Board found there was a "strong connection" between the surname and the mark owners. Moreover, the board's finding was motivated largely based on how the owners used the name on the product labels (ALDECOA Premium Family Coffee) which indicated the mark was a surname.

The board reached a curious decision in the ADLON case, finding the surname rare but affirming the decision to register the name for hospitality services, based on the fact that the Hotel Adlon was a famous hotel in Berlin during WWII and was the social center of Nazi Germany named after its founder. Although the hotel has since been destroyed and rebuilt, it has been the subject of many films and documentaries. The board was split in this rationale, since it seemed unclear whether U.S. consumers would be as familiar with this historical reference. Nevertheless, the decision is precedential.

In trying to register BARR GROUP for engineering, training, and expert witness services in the field of computer hardware and software, the board rejected the mark as primarily merely a surname, finding that the BARR surname is not rare, and given Michael Barr's status as co-founder and chief technology officer of the company, consumers would recognize the mark as a surname. In combining the BARR name with GROUP, the board held that GROUP does not lend any source identifying significance to the mark, enabling the term to be recognized as anything more than primarily merely a surname.

Lastly, the board dealt with another surname refusal and additional matter in the precedential decision of AZEKA RIBS for barbecue sauce. The applicant's last name is AZEKA and while 866 people in the US have the name AZEKA, the board found that the AZEKA name has "at least some public exposure in the media" as a surname. The addition of the word RIBS to the mark did not detract from the mark being primarily merely a surname as the board found the addition of the word RIBS at least descriptive and possibly generic when used in connection with barbecue sauce.

Although these decisions seem to indicate a step toward an absolute bar to register surnames on the Principal Register absent a showing of acquired distinctiveness, we note that through the years, the Trademark Office's examination procedures have evolved. For instance, in 1906, when CARTER'S for various children's clothing items was filed by the William Carter Company (a brand that was named for him), there was no requirement to file for acquired distinctiveness. Similarly, in the 1920s when WRIGLEY'S first filed its trademark for chewing gum, no surname refusal or showing of required distinctiveness was required. In 2013, Mott's was unsuccessful in trying to register its name for baby food on the Principal Register without acquired distinctiveness, despite the fact that it has been using its name for the related goods of fruit juices and sauces for more than 150 years.

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### **How do I get my surname registered?**

If you have a trademark application that contains a surname, it's recommended you seek guidance from an **experienced intellectual property attorney**. Remember, the most distinctive and protectable trademarks are those marks that are fanciful or coined terms. For instance, if your last name is "Conway" and you're in the telecommunications business, the mark you might adopt may be CONTEL (which was an active registration for more than 30 years until the mark was recently cancelled in September 2016 for failure to file an Affidavit of Continued Use).

When all else fails, remember as long as you are using the mark in connection with the applied for goods in interstate commerce, the trademark is eligible for protection on the Supplemental Trademark Register as a descriptive trademark until the mark has "acquired distinctiveness."

If you have any questions about this case or any trademark application you would like to file, please **contact us**.