

RECAPTURING RARENESS: THE SIGNIFICANCE OF SURNAME RARENESS IN TRADEMARK REGISTRATION DETERMINATIONS

RUSSELL W. JACOBS*

I. INTRODUCTION

The United States has a long-standing tradition of recognizing the right of each individual to operate a business under his or her own name. The belief that consumers will remember the business by the name of the owner, and associate the quality of the goods or services with the proprietor, underlies this tradition. This grant, however, does not come without exceptions. An individual or business may register a surname as a trademark—and thereby enjoy exclusive rights to use that term—if and when consumers recognize the surname as serving principally as a trademark identifying the source of the goods or services, and not as primarily referring to a specific person with the surname. U.S. trademark law permits such registration of a surname even when registration denies others with the same surname from selling goods or offering services in the same field under their surname.

The trademark significance of a surname may come to dominate over the surname significance over time through long and exclusive use by the trademark user. In that situation, the trademark has acquired distinctiveness, so that consumers regard the term as indicating the source of the goods or services rather than as serving primarily as a surname, and the trademark owner may register it with the United States Patent and Trademark Office (the “PTO”) un-

* The author (whose surname, Jacobs, ranks as the 233rd most common in the United States in the 2000 U.S. Census) is an attorney based in Seattle, Washington. He received his J.D. from Columbia University School of Law in 2002 and his A.B. from the University of Michigan in 1999. His practice has focused on civil litigation and intellectual property. He expresses his gratitude to his grandmother Vivian Acree (surname ranking no. 5136), Denise Chang (surname ranking no. 424), and Cindy Chung (surname ranking no. 870) for their support during the preparation of this article.

der section 2(f) of the Lanham Act.¹ This article does not discuss that set of circumstances.²

Instead, this article considers the section of the Lanham Act that allows for registration of a surname upon initial use when consumers do not consider the surname meaning as the dominant meaning of the term. This can occur either because the term has another, non-surname meaning with broader recognition or because the surname prevalence is so nominal that consumers will regard the term as a coined term or an obscure term of unknown meaning. Namely, section 2(e)(4) permits the registration of all otherwise registrable terms, except one that is “primarily merely a surname.”³ In determining whether a term is “primarily merely a surname,” the analysis undertaken by the PTO focuses on how consumers would understand the significance of the term.

In the 1995 decision *In re Benthin Management GmbH*,⁴ the Trademark Trial and Appeal Board (“the Board”), the administrative body within the PTO that hears appeals of refusals to register trademarks, set forth a five-factor test to assess that consumer understanding.⁵ The *Benthin* test establishes the rareness of the surname as the first factor.⁶ The PTO has incorporated the *Benthin* test, including the rareness factor, in the Trademark Manual of Examining Procedure (“T.M.E.P.”), the guidebook used by the PTO’s examining attorneys when they assess the registrability of a mark, and has therefore prescribed the five *Benthin* factors as the appropriate framework for considering whether to register a surname.⁷ Section II sets forth in greater detail this statutory and case law framework for consideration of the rareness factor in registrability of surnames.

As conceived in the *Benthin* test, consumers probably would not think of rare surnames as surnames because they would not have encountered them as such, but instead would regard the terms as having unknown meanings and parts of speech. Additionally, the arguments for maintaining open use of surnames for all individuals with the surname prove less compelling with a rare surname because registration of the rare surname would deny very few individuals, in-

¹ Lanham Act § 2(f), 15 U.S.C. § 1052(f) (2006).

² Moreover, if the mark is in use, but has not acquired distinctiveness, the trademark owner may have the option of registering the mark on the Supplemental Register. Additionally, one may be able to use the mark without registration and obtain protections under the common law. Further discussion of these issues is beyond the scope of this article.

³ Lanham Act § 2(e)(4), 15 U.S.C. § 1052(e)(4).

⁴ 37 U.S.P.Q.2d (BNA) 1332 (T.T.A.B. 1995).

⁵ *Id.* at 1333.

⁶ *Id.*

⁷ U.S. PAT. & TRADEMARK OFFICE, DEP’T OF COM., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1211.01 (6th ed. rev. 1 2009) [hereinafter T.M.E.P.].

deed most likely no one, the opportunity to use their surnames in connection with their businesses. Based on these considerations, denying trademark registration of a rare surname would serve most often to restrict the field of available trademarks rather than to protect either consumers or people with the surname.

However, as discussed in Section III, examining attorneys do not always regard the rareness factor in these surname determinations. Examining attorneys often find references to a small number of individuals having a surname and then refuse registration because these references indicate that someone has the term as a surname.⁸

These refusals, in the form of Office Actions issued by the PTO, may cite the rareness factor along with the other factors in the *Benthin* test, but they fail to discuss how the rareness of the surnames in question will impact consumers' understanding of the meaning of the term.

Section III continues to consider a line of cases from the Board that have supported these refusals taken by the examining attorneys. In this older trend, the Board may recognize the surname in question as rare, but will affirm the refusal to register nonetheless. For example, in *In re Ulvang*,⁹ the Board affirmed the refusal to register the mark ULVANG, writing that the existence of only fifteen individuals with the name "does not mean that its surname significance would not be recognized by a substantial number of members of the general public."¹⁰

Section IV discusses recent decisions by the Board, including the precedential decision in *In re Joint-Stock Co. "Baik"*,¹¹ that offer a counter trend,

⁸ See, e.g., Office Action, Ser. No. 79011475 (May 30, 2006) (term "amlin" primarily merely a surname based on 111 references in nationwide directory), *rev'd sub. nom. In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B. Sept. 30, 2008) (not citable as precedent); Office Action, Ser. No. 78560314 (Sept. 2, 2005) (term "curlin" primarily merely a surname based on 286 references in nationwide directory), *rev'd sub. nom. In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *1, *2 (T.T.A.B. Feb. 11, 2008) (not citable as precedent); Office Action, Ser. No. 76627189 (Aug. 12, 2005) (term "bonert" primarily merely a surname based on 34 references in nationwide directory), *rev'd sub. nom. In re Bonert's Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *8-9 (T.T.A.B. Mar. 10, 2008) (not citable as precedent); Office Action, Ser. No. 78497796 (May 27, 2005) (term "urman" primarily merely a surname based on at least 200 references in nationwide directory), *rev'd sub. nom. In re Productos Urman, S.A. de C.V.*, No. 78497796, 2008 WL 906614, at *2 (T.T.A.B. Mar. 20, 2008) (not citable as precedent).

⁹ No. 78160641, 2004 WL 3060195 (T.T.A.B. Dec. 15, 2004) (not citable as precedent).

¹⁰ *Id.* at *2.

¹¹ 84 U.S.P.Q.2d (BNA) 1921 (T.T.A.B. 2007).

placing renewed weight on the factor as supporting registration.¹² A decision from 2009 that follows the new trend started by *Baik* captures well the thrust of this line of decisions. In *In re Hall Wines, LLC*,¹³ the Board allowed registration of the mark BERGFELD, a surname held by fewer than 300 people nationwide.¹⁴ The Board framed its decision by stating that “we believe it is important to accord the proper weight to the ‘rareness’ of the surname factor while keeping in mind the purpose of section 2(e)(4) of the Act,” namely, to allow individuals who want to use their surnames in connection with their businesses to use their names.¹⁵

With rare surnames, there are few individuals who would want to use a surname as a trademark in connection with a particular business, indicating that it may be appropriate to grant exclusive trademark rights in the rare surname for particular goods or services. Additionally, the Board noted that the small number of surname usages of the term ‘bergfeld’ indicated that consumers would not regard it as a surname.¹⁶

Section V assesses the approaches offered by these competing trends and suggests how to best conceive of the factor within the full context of the *Benthin* test. This article takes the position that the new trend of decisions offers the better approach toward rareness, as these cases recognize how consumers really understand rare surnames: as unknown terms with unknown meanings. Additionally, decisions from the *Baik* line of cases recognize that very few individuals, perhaps none, will suffer any negative impact as the result of the registration of a rare surname. Registration will not deny them of their livelihood. If they desire to use their surname in connection with their business, they may use it in a field other than that covered by the registration of the surname. Or, they could operate a business in the same field under a different mark.

Further, the approach taken by examining attorneys following the old line of cases presents significant evidentiary problems. When examining attorneys refuse registration based solely on evidence that a small number of individuals have the surname, they:

¹² See, e.g., *id.* at 1923–24 (“[I]n a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use.” (citing *In re Garan, Inc.*, 3 U.S.P.Q.2d (BNA) 1537, 1540 (T.T.A.B. 1987))).

¹³ No. 78926151, 2009 WL 625580 (T.T.A.B. Feb. 10, 2009) (not citable as precedent).

¹⁴ *Id.* at *4.

¹⁵ *Id.* at *2.

¹⁶ *Id.* at *4.

- (1) improperly characterize evidence of the existence of a surname significance as showing that the primary significance of the term is as a surname;
- (2) reduce the five-factor test to only one factor—the existence of a non-surname significance; and
- (3) improperly shift their burden of establishing the primary significance of the mark to the applicant.

Before turning to the competing trends and the issues they raise, however, this article begins by setting forth the statutory and case law framework regarding registration of surnames and the rareness factor.

II. STATUTORY AND CASE LAW FRAMEWORK FOR TRADEMARK REGISTRATION OF SURNAMES

Any discussion of U.S. trademark law must begin with the Lanham Act. Section 2(e)(4) of the statute allows for the registration of a surname as a trademark if the term does not have the surname meaning as its primary significance:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it

(e) [c]onsists of a mark which . . .

(4) is primarily merely a surname¹⁷

The Lanham Act does not define the language “primarily merely a surname.”

The prohibition set forth in section 2(e)(4) of the Lanham Act against registration of terms that are primarily merely surnames finds its basis in the longstanding, common-law tradition of allowing individuals to operate businesses under their own names. A few years after enactment of the 1946 Trademark Act, which contained the relevant language now found at section 2(e)(4), the District Court for the District of Columbia emphasized that the statute codified strong rights emerging from this common-law tradition:

The spirit and the intent of the entire Act indicate that Congress intended to codify the law of unfair competition in regard to the use of personal names as

¹⁷ Lanham Act § 2(e)(4), 15 U.S.C. § 1052(e)(4). As mentioned in the introduction, even if the mark is primarily merely a surname, registration may be available under section 2(f) of the Lanham Act when the mark has acquired distinctiveness as a trademark. *See supra* text accompanying note 1.

it has been developed by the courts. . . . At common law it was held that every man had an absolute right to use his own name.¹⁸

The Board likewise noted recently that:

[T]he purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses, in the same manner that merely descriptive terms are prohibited from registration because competitors should be able to use a descriptive term to describe their own goods or services.¹⁹

This tradition contemplates that when consumers recognize a surname used in connection with a business, they associate the business with the proprietor's name. While consumers understand that the name of a business may refer to the proprietor, they also understand that multiple individuals with the same surname may also operate businesses. The T.M.E.P. notes that "[t]he common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business."²⁰

In this tradition, as all people with the surname have the right to use the name in connection with their businesses, no proprietor may claim exclusive rights to use the surname and thereby deprive others with the same surname of the opportunity to use their surname in connection with their business. Accordingly, without exclusive rights to use the surname, no individual has a trademark monopoly in the surname, but rather some form of lesser rights to identify his or her business with his surname.

Nonetheless, a business may, in some cases, acquire the exclusive rights in the surname and register the term as a trademark. As noted in the introduction, if through the business's exclusive use of the surname over time consumers come to regard the surname as identifying only that business as the provider of the goods or services, then the term has become a trademark. When consumers perceive the surname as a trademark associated with one individual or business, another individual or business should not have the opportunity to use the surname, even if the junior user bears the surname. This is because the junior user would unfairly benefit from the senior user's goodwill in the mark.

Additionally, should multiple individuals use the same surname in connection with the goods or services, confusion may arise among consumers regarding possible connections among the businesses or the source of the goods. Recognizing the possibility of confusion, trademark law allows certain users of

¹⁸ *Kimberly-Clark Corp. v. Marzall*, 94 F. Supp. 254, 257 (D.D.C. 1950).

¹⁹ *In re Joint-Stock Co. "Baik,"* 84 U.S.P.Q.2d (BNA) 1921, 1924 (T.T.A.B. 2007) (Seeherman, J., concurring).

²⁰ T.M.E.P. § 1211.

surnames as trademarks to claim exclusive rights to prevent others from benefiting from the goodwill in the marks. A commonly invoked section of the statute, section 2(f) allows registration of surnames when an individual or entity has exclusively used the surname over time in such a way that consumers recognize it as a trademark.²¹ The T.M.E.P. notes that the Lanham Act

reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. . . . [B]y the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name.²²

The Lanham Act also allows for registration even without long and exclusive use under section 2(e)(4).²³ This section does not start from a position of prohibiting registration of all surnames, and then carving out exceptions, but rather starts from the position of allowing registration of all terms otherwise registrable under the Lanham Act, and then makes terms regarded as “primarily merely a surname” nonregistrable.²⁴ This construction suggests that Congress did not intend to exclude most surnames from registration, but rather only those that are not only “merely” surnames, but “primarily merely” surnames.

Congress, in drafting the 1946 Lanham Act, added the word “primarily” to “merely” for the purpose of preventing “a refusal to register only because a surname was found in a directory to be the name of somebody somewhere.”²⁵ The language “primarily merely a surname” intends “to avoid a test whereby if the surname could be found as that of an individual in a telephone book or city directory it was unregistrable.”²⁶ During the debate prior to passage of the Lanham Act, one witness testified that refusing to register a mark because “it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name . . . merely limits the field of choice.”²⁷ Accordingly, section 2(e)(4) intends to protect the rights of individu-

²¹ Lanham Act § 2(f), 15 U.S.C. § 1052(f).

²² T.M.E.P. § 1211.

²³ Lanham Act § 2(e)(4), 15 U.S.C. § 1052(e)(4).

²⁴ *Id.* This approach may be distinguished from one in which legislators may have created a blanket prohibition against surname registration and carved out exceptions to the default non-registrability of surnames.

²⁵ *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. (BNA) 145, 149 (Dec. Comm’r Pat. 1955); *see also id.* at 149 n.3 (discussing the pertinent legislative history).

²⁶ *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33 (D.C. Cir. 1953).

²⁷ *Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong. 40 (1939) [hereinafter *Hearings*] (statement of Edward S. Rogers, attorney).

als to use their surnames in connection with their business, but only when consumers would recognize those terms as surnames.

When drafting the Lanham Act, Congress understood that the purchasing public would not perceive a term to be a surname just because someone has that term as a last name. Although a surname, the term may have better-known meanings or meanings at least as well known as the surname significance, such as with the term “hill.”²⁸ In the alternative, consumers not familiar with the word or its surname significance may regard it as a coined term, or a term with a dictionary definition they do not know. In this circumstance, the rare surname does not need to acquire distinctiveness as a trademark over time because upon its initial use the purchasing public perceives it as an arbitrary or fanciful term, and therefore inherently distinctive and functioning as a trademark. As such, the user may register the surname as a trademark immediately upon use.

In its 1995 decision in *In re Benthin Management GmbH*, the Board elaborated five factors relevant to whether a mark is “primarily merely a surname”:

- (i) whether the surname is rare;
- (ii) whether the term is the surname of anyone connected with the applicant;
- (iii) whether the term has any recognized meaning other than as a surname;
- (iv) whether the term has the “look and feel” of a surname; and
- (v) whether the stylization of lettering is distinctive enough to create a separate commercial impression.²⁹

The T.M.E.P. has incorporated these five factors as the appropriate method to determine “the primary, not the secondary, significance to the purchasing public,” and whether the term is therefore primarily merely a surname and ineligible for registration.³⁰ The T.M.E.P. also notes that “[t]he question of whether a mark is primarily merely a surname depends on the mark’s *primary*

²⁸ See, e.g., *In re United Distillers, PLC*, 56 U.S.P.Q.2d (BNA) 1220, 1222 (T.T.A.B. 2000) (“While the term HACKLER certainly can be a surname, nonetheless, the word has another significance or meaning.”).

²⁹ T.M.E.P. § 1211.01 (internal citations omitted) (citing *In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d (BNA) 1332, 1333 (T.T.A.B. 1995)).

³⁰ *Id.*

significance to the purchasing public. Each case must be decided on its own facts, based upon the evidence in the record.”³¹

The *Benthin* test incorporates the rareness of the surname as its first factor. Since it issued the *Benthin* decision, the Board has repeatedly recognized rareness as a factor indicating that a term is not primarily merely a surname, and the T.M.E.P. incorporates rareness in the prescribed analysis for surname refusals.³² The Board included rareness in the *Benthin* test out of a recognition that consumers know few people having a rare name, and therefore they do not recognize the name as a surname. “[T]he rarer the surname, the less likely it is that the term will be perceived as primarily merely a surname.”³³ In *In re Garan, Inc.*,³⁴ the Board held that purchasers would not consider the surname “Garan” to be primarily merely a surname because “[v]irtually no exposure of ‘Garan’ as a surname has been demonstrated.”³⁵ Consumers will regard rare surnames as arbitrary or coined terms entitled to trademark registration rather than as surnames. The T.M.E.P. advises that:

[C]ertain surnames are so rare that they do not even have the appearance of surnames. In such cases, even in the absence of non-surname significance, a reasonable application of the “primary significance to the purchasing public” test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful.³⁶

While the rareness of the surname indicates that consumers are less likely to understand the term to be a surname, rareness by itself does not justify registration of the surname. The *Benthin* test contains four other factors and the analysis of registrability under section 2(e)(4) must consider all five factors as a whole. The proper query for the analysis does not posit how many people have

³¹ *Id.* § 1211 (citing *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. (BNA) 145, 149 (Dec. Comm’r Pat. 1955)) (emphasis in original); *see also id.* § 1211.01(a)(v) (“Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname.”).

³² *See, e.g., In re Gregory*, 70 U.S.P.Q.2d (BNA) 1792, 1795 (T.T.A.B. 2004) (not citable as precedent); *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004) (not citable as precedent).

³³ *In re IdeaStream Consumer Prods., L.L.C.*, No. 76543788, 2005 TTAB LEXIS 554, at *5 (T.T.A.B. Dec. 27, 2005) (not citable as precedent) (concluding that “Vaultz” is an extremely rare surname and not primarily merely a surname) (citing *In re Garan, Inc.*, 3 U.S.P.Q.2d (BNA) 1537, 1540 (T.T.A.B. 1987) (not citable as precedent)).

³⁴ 3 U.S.P.Q.2d (BNA) 1537 (T.T.A.B. 1987) (not citable as precedent).

³⁵ *Id.* at 1540.

³⁶ T.M.E.P. § 1211.01(a)(vi) (citing *In re United Distillers, PLC*, 56 U.S.P.Q.2d (BNA) 1220, 1222 (T.T.A.B. 2000) (HACKLER not primarily merely a surname)).

the surname, but whether the surname significance dominates consumer understanding of the term. “[T]he fact that a surname is rare does not *per se* preclude a finding that a term is primarily merely a surname. Even a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname.”³⁷ Some surnames have only surname significance, and consumers recognize them as surnames despite their rarity.³⁸ This consumer recognition of rare surnames most likely results from media attention or publicity for the surname which has made the surname significance well-known so that consumers regard the surname significance as primary.³⁹ For example, President Barack Obama has a rare surname, but because of his position as President of the United States of America, he is well-known and the public understands the term “Obama” as a surname, specifically his surname, rather than as having some other meaning.

III. THE OLD TREND DEVALUING RARENESS

Though the *Benthin* test identifies the rareness of the surname as the first factor in considering the appropriateness of registration under section 2(e)(4) of the Lanham Act, the examining attorneys at the PTO sometimes fail to give weight to this factor.⁴⁰ The Board has sanctioned this trend among examining attorneys—to devalue rareness—by issuing decisions that affirm refusals by examining attorneys to register rare surnames under section 2(e)(4).

³⁷ *Id.* § 1211.01(a)(v) (citing *In re Etablissements Darty et Fils*, 759 F.2d 15, 18 (Fed. Cir. 1985) (DARTY held to be primarily merely a surname)).

³⁸ *Id.* § 1211.01(a)(vi) (citing *In re Industrie Pirelli Societa per Azioni*, 9 U.S.P.Q.2d (BNA) 1564, 1566 (T.T.A.B. 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989) (“Pirelli,” though rare, would be regarded as primarily merely a surname)).

³⁹ *Id.* § 1211.01(a)(v); *see In re Sava Research Corp.*, 32 U.S.P.Q.2d (BNA) 1380 (T.T.A.B. 1994) (lack of media references to individuals with “Sava” surname indicated that it was not known as a surname).

⁴⁰ *See, e.g.*, Office Action, Ser. No. 79011475 (May 30, 2006) (term “amlin” primarily merely a surname based on 111 references in nationwide directory), *rev'd sub. nom. In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B. Sept. 30, 2008) (not citable as precedent); Office Action, Ser. No. 78560314 (Sept. 2, 2005) (term “curlin” primarily merely a surname based on 286 references in nationwide directory), *rev'd sub. nom. In re Curlin Med. Inc.*, No. 78560314, 2008 WL 885932, at *1 (T.T.A.B. Feb. 11, 2008) (not citable as precedent); Office Action, Ser. No. 76627189 (Aug. 12, 2005) (term “bonert” primarily merely a surname based on 34 references in nationwide directory), *rev'd sub. nom. In re Bonert's, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *8 (T.T.A.B. Mar. 10, 2008). *But see* Office Action, Ser. No. 78464418 (Mar. 15, 2005) (acknowledging rareness of the term “pintro” as a surname, but finding it to be primarily merely a surname based on lack of dictionary or foreign language meaning).

Although, as discussed *infra* in Section IV, a new trend has emerged starting in 2007 in which the Board has given greater weight and consideration to the rareness factor, the older trend persists alongside the newer trend, resulting in inconsistent approaches to the rareness factor. This section summarizes Office Actions issued by the PTO refusing registration under section 2(e)(4) as well as Board decisions affirming refusals to register under section 2(e)(4), in which the examining attorney or the Board fails to credit the rareness of the surname as favoring registration.

When an applicant applies to register a mark and the PTO examining attorney reviewing the application determines that the mark is a surname, the examining attorney will often refuse registration under section 2(e)(4) based solely on evidence that a very small number of individuals bear the surname. For example, an examining attorney issued an Office Action refusing registration of the mark URMAN under section 2(e)(4).⁴¹ In that Office Action, the examining attorney cited the “primary significance” test set forth in the T.M.E.P. and then offered the following two sentences as the sole basis for the refusal:

Please see the attached evidence from Yahoo People Search, establishing the surname significance of the surname Urman. This evidence shows the proposed mark appearing at least 200 times as a surname in a nationwide telephone directory of names.⁴²

The URMAN Office Action did not discuss the rareness factor, specifically the fact that the 200 incidences of surname usage indicate that the surname is rare and therefore less likely to be “primarily merely a surname.”⁴³

The URMAN Office Action does not stand alone. It is common for examining attorneys to refuse registration of surnames based solely on evidence from directories, such as in the applications for the marks AMLIN, CURLIN, and BONERT’S.⁴⁴ The examining attorneys began the section 2(e)(4) review for these applications by first searching directories. When the searches disclosed individuals having the surname, the examining attorneys ended the analysis and refused registration.⁴⁵ They did not look for additional evidence regarding consumer understanding of the term or other meanings, or consider the fac-

⁴¹ Office Action, Ser. No. 78497796 (May 27, 2005), *rev’d sub. nom. In re Productos Urman*, S.A. de C.V., No. 78497796, 2008 WL 906614 (T.T.A.B. Mar. 20, 2008) (not citable as precedent).

⁴² *Id.*

⁴³ *Id.*

⁴⁴ See references cited *supra* note 40.

⁴⁵ *Id.*

tors.⁴⁶ Rather, the examining attorneys issued Office Actions refusing registration based solely on the directory listings showing individuals having that name.⁴⁷

Board decisions affirming refusals of rare surnames under section 2(e)(4) all cite the *Benthin* test, and therefore list the rareness factor. However, these decisions dismiss the import of and rationale for the rareness factor in registrability determinations under section 2(e)(4). The Board's decision in *In re Ulvang*⁴⁸ illustrates the Board's approach under this trend. In *Ulvang*, the Board characterized the surname "Ulvang" as rare, when the examining attorney's search of the records of a nationwide directory disclosed only fifteen people with the surname.⁴⁹ Despite this acknowledgement of the rareness of the surname, the Board affirmed the refusal to register, writing that the small number of individuals with the name "does not mean that its surname significance would not be recognized by a substantial number of members of the general public."⁵⁰

The Board, moreover, cast doubt on the utility of ever considering the rareness of a surname in the section 2(e)(4) analysis. Namely, it noted that because the U.S. population has such a large number of surnames, a relatively small portion of the population bears each surname. "Although the 15 PowerFinder residential listings of ULVANG are a small fractional percentage of the entire PowerFinder database, virtually any surname (even extremely common surnames) would presumably also constitute only a small fractional percentage of this entire database."⁵¹

Several cases from 2008 follow this trend. In *In re Builders Best, Inc.*,⁵² the Board acknowledged that "Lowes" was a rare surname, as shown by 440 listings from a nationwide directory.⁵³ Although the Board characterized the surname as rare, it declined to consider that rareness as part of the registrability determination. The Board concluded that the term was primarily merely a surname, despite its rareness, as "the fact that a surname is rare is not determinative."⁵⁴

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ No. 78160641, 2004 WL 3060195 (T.T.A.B. Dec. 15, 2004) (not citable as precedent).

⁴⁹ *Id.* at *2.

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² No. 76642671, 2008 WL 1963581 (T.T.A.B. Apr. 30, 2008) (not citable as precedent).

⁵³ *Id.* at *6.

⁵⁴ *Id.*

In the 2008 decision in *In re Lash's Lessons, LLC*,⁵⁵ the Board characterized the surname “Merrow” as rare based on listings showing at most 3,295 individuals with the name.⁵⁶ Nonetheless, the Board treated this small number of listings in directories as establishing the surname significance as the primary significance of the term. The Board concluded that the rareness factor weighed against registration of the mark MERROW because the evidence showing that individuals had the surname “Merrow” established the “surname significance of the mark MERROW to the relevant purchasing public.”⁵⁷ The Board also criticized the inclusion of rareness in the registrability analysis under section 2(e)(4) because the factor fails to recognize the large number of surnames shared by Americans.⁵⁸ The Board, echoing its language in *Ulvang*, stated that “given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of the total population.”⁵⁹

In *In re Roundy's Supermarkets, Inc.*,⁶⁰ also from 2008, the Board affirmed the refusal to register the mark RIANO'S, where the examining attorney's search of nationwide directories had disclosed only 330 individuals with the surname.⁶¹ In affirming the refusal, the Board relied heavily on the evidence of surname significance from the directories, concluding that “there are no other factors in the present case which would detract from the surname significance of this mark.”⁶² The decision again displays skepticism by the Board towards the utility of the rareness of the surname in assessing the primary significance of a mark: “While Riano may be a rare surname, we cannot find, based on this record, that the surname is so rare that this factor should weigh in applicant's favor.”⁶³ The Board also noted that the Lanham Act does not mention rareness: “Section 2(e)(4) makes no distinction between rare and commonplace surnames.”⁶⁴

⁵⁵ No. 78857737, 2008 WL 2385964 (T.T.A.B. May 27, 2008) (not citable as precedent).

⁵⁶ *Id.* at *2.

⁵⁷ *Id.* at *3; *see also id.* at *4.

⁵⁸ *Id.* at *3.

⁵⁹ *Id.* (quoting *In re Gregory*, 70 U.S.P.Q.2d (BNA) 1792, 1795 (T.T.A.B. 2004)) (internal quotations omitted).

⁶⁰ No. 77275882, 2008 WL 5078732 (T.T.A.B. Nov. 19, 2008) (not citable as precedent).

⁶¹ *Id.* at *1, *5.

⁶² *Id.* at *2.

⁶³ *Id.*

⁶⁴ *Id.*

The Board's 2009 decision in *In re Jaguar Cars Ltd.*⁶⁵ agreed with the applicant's characterization of the surname "Daimler" as rare based on fewer than 100 individuals with the surname disclosed in nationwide directories.⁶⁶ Nonetheless, the Board affirmed the refusal to register, noting that "a mark may be found to be primarily merely a surname even though it is not a common surname. . . . [T]here is no minimum number of listings needed to prove that a mark is primarily merely a surname."⁶⁷

Also from 2009, *In re White Rock Distilleries, Inc.*⁶⁸ invoked the same principles to affirm the refusal to register the term "tarleton" under section 2(e)(4).⁶⁹ The Board characterized the surname "Tarleton" as "not a 'common' surname," but noted that "there is sufficient evidence to find that it is not rare" based on directory listings showing 793 individuals nationwide with the surname, as well as news articles showing surname usages of the term.⁷⁰

IV. THE NEW TREND VALUING THE RARENESS FACTOR

In contrast to the decisions discussed *supra* in Section III, which follow the old trend of failing to grant weight to the rareness factor, a new trend has emerged in decisions since 2007 in which the Board has placed renewed emphasis and focus on the rareness factor.⁷¹ Namely, in decisions following this trend the Board has acknowledged the rareness of the surnames in question and concluded that because of this rareness, (1) consumers would not know of the surname meaning, and (2) registration of the rare surname was unlikely to impact someone with the surname in a negative way. As a result, the Board has reversed the refusal to register the mark under section 2(e)(4). This approach con-

⁶⁵ No. 77035168, 2009 WL 1068750 (T.T.A.B. Apr. 7, 2009) (not citable as precedent).

⁶⁶ *Id.* at *2. Although many consumers will be aware of the mark DAIMLER used in connection with automobiles and will therefore perceive of the term "daimler" as a trademark, rather than as a surname, the issue before the Board involved registration under section 2(e)(4) and not registration under section 2(f). Therefore, consumers' understanding of the significance of the term based on its use over time, relevant to the section 2(f) analysis of acquired distinctiveness, did not come before the Board. Accordingly, the Board considered the question of consumer understanding of the term in the abstract, having to ignore that the mark had been used for decades.

⁶⁷ *Id.* at *3.

⁶⁸ No. 77248231, 2009 TTAB LEXIS 538 (T.T.A.B. Aug. 28, 2009) (not citable as precedent).

⁶⁹ *Id.* at *1.

⁷⁰ *Id.* at *5–6, *8.

⁷¹ At the same time, as discussed above, the old trend has continued to find expression in Board decisions issued concurrently with these decisions expressing the new trend. Section V, *infra*, will discuss resolution of these competing trends.

trasts to the approach taken under the old trend, in which the Board concluded that consumers would regard the surname significance as primary because a number of individuals had that surname, even if that number reached only several hundred. A summary of cases from this new trend follows.

The new trend first appeared in the Board's decision in *Baik*, from 2007. The Board designated its decision in *Baik* as precedential, meaning that applicants may consider it authoritative and setting forth the Board's position beyond the specific facts of the case in question. The Board has not designated any of the other decisions in either this or the prior section as precedential. Nonetheless, decisions such as *Builder's Best*, *Lash's Lessons*, *Roundy's Supermarkets*, *Jaguar Cars*, and *White Rock* continue to follow the old trend and disregard the precedent set forth in *Baik*, even though the decisions issued after *Baik*.

The examining attorney in *Baik* refused registration of the mark BAIK based on a search that disclosed references to 456 individuals in nationwide directories, bankruptcy notices for individuals with the surname "Baik," and newspaper articles that referred to individuals with the surname "Baik."⁷² The Board reversed the refusal to register, concluding that such evidence did not support "a finding that Baik is well recognized as a surname," but rather that "Baik is an extremely rare surname."⁷³ "[I]n a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use."⁷⁴ In the absence of evidence showing that a person with the surname "Baik" had achieved notoriety, the Board concluded that consumers would regard the term "baik" as a coined, Russian-sounding term, rather than as a surname.⁷⁵

Judge Ellen Seeherman joined in the Board's main decision in *Baik*, and also filed a concurring opinion. While Judge Seeherman stated that she was filing the concurring opinion with the purpose of discussing the proper role of the "look and feel" factor in the Benthin test, her opinion also touched on the proper interpretation of the rareness factor. In her opinion, Judge Seeherman returned to the principal rationale for restricting surname registrations, namely, the common-law tradition of permitting individuals to use their names in connection with their livelihoods: "the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their busi-

⁷² *In re Joint-Stock Co. "Baik,"* 84 U.S.P.Q.2d (BNA) 1921, 1922 (T.T.A.B. 2007).

⁷³ *Id.* at 1922, 1923.

⁷⁴ *Id.* at 1923–24.

⁷⁵ *Id.* at 1923, 1924.

nesses.”⁷⁶ Bearing in mind this tradition, she commented that it is unlikely that trademark registration of a rare surname would have any significant negative impact on another individual with that surname: “If a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.”⁷⁷

In 2008, the Board issued a decision in the case *In re Curlin Medical, Inc.*, which followed the trend set in *Baik*. The Examining Attorney had refused to register the mark CURLIN under section 2(e)(4) based on 286 references to individuals with the surname “Curlin” disclosed in a search of nationwide directories, a dictionary definition of “curlin” identifying the term as a surname, and 37 newspaper articles containing surname usage of the term “curlin.”⁷⁸ The Board reversed the refusal to register the mark because the evidence showed the surname was rare and the articles did not “show references to any individual of particular note with the CURLIN surname such that the public would be conditioned to recognize this rare surname as a surname.”⁷⁹ The Board concluded that consumers were more likely to consider the term “curlin” to be a coined term derived from the term “curvilinear,” given the curved nature of the tubing in the applicant’s pumps that were the subject of the application.⁸⁰

The panel hearing the appeal in *Curlin Medical* once more included Judge Seeherman. She took the opportunity to file another concurring opinion, again to discuss the “look and feel” factor. She expounded further on her comments in *Baik* that registration of a rare surname would have a potential negative impact on only a very small number of people, if anyone.

If a surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. Accordingly, if the Examining Attorney cannot show that a reasonable number of people have a particular surname, in my view the Office cannot meet its burden of prima facie showing that a mark is primarily merely a surname.⁸¹

⁷⁶ *Id.* at 1924 (Seeherman, J., concurring).

⁷⁷ *Id.*

⁷⁸ *In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *1, *2 (T.T.A.B. Feb. 11, 2008) (not citable as precedent).

⁷⁹ *Id.* at *2.

⁸⁰ *Id.* at *3.

⁸¹ *Id.* at *6 (Seeherman, J., concurring).

Judge Seeherman went on to argue in a footnote that some terms may occur so infrequently as surnames that consumers would not understand them as surnames, regardless of what the other factors indicated: “[I]f a term is sufficiently rare, we should find it registrable regardless of the evidence on the other factors.”⁸² She supported this statement by noting that as a result of the improvements in electronic databases of nationwide listings of individuals, which now consist of more expansive, accurate, and complete information, the listings offer better indications of how the purchasing public will understand the surname.⁸³ She suggested that “with the availability of these computer databases, we can determine whether a term is truly a rare surname.”⁸⁴

This trend continued in 2008 with *In re Amlin, PLC*.⁸⁵ Judge Seeherman did not sit on the panel hearing this appeal. The examining attorney had submitted evidence that referenced approximately 150 individuals in the U.S. with the surname “Amlin.”⁸⁶ Because only one in every two million individuals in the U.S. had the surname, the Board concluded that the term was an extremely rare surname.⁸⁷ In the *Amlin* decision, the Board picked up on Judge Seeherman’s comments in her concurring opinions in *Baik* and *Curlin Medical* and concluded that “substantially no one will be adversely affected by the registration of this term for the recited services.”⁸⁸ The Board also held that because “Amlin” is an extremely rare surname, “few prospective consumers are likely to perceive it as a surname.”⁸⁹ The Board concluded that the surname’s rareness favored registration and, after considering the other factors, the Board reversed the refusal to register under section 2(e)(4).⁹⁰

Continuing the trend set in *Baik*, the Board, in a panel on which Judge Seeherman did not sit, gave weight to the rareness factor in its February 2009 decision in *In re Hall Wines, LLC*.⁹¹ The Board reversed the examining attorney’s refusal to register the mark BERGFELD when the examining attorney’s

⁸² *Id.* at *6 n.4.

⁸³ *Id.*

⁸⁴ *In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *6 n.4 (T.T.A.B. Feb 11, 2008) (Seeherman, J., concurring) (not citable as precedent).

⁸⁵ No. 79011475, 2008 WL 4674600 (T.T.A.B. Sept. 30, 2008) (not citable as precedent).

⁸⁶ *Id.* at *2.

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at *1.

⁹¹ No. 78926151, 2009 WL 625580 (T.T.A.B. Feb. 10, 2009) (not citable as precedent).

evidence showed fewer than 300 people nationwide with the surname.⁹² The Board framed its decision with the observation that “we believe it is important to accord the proper weight to the ‘rareness’ of the surname factor while keeping in mind the purpose of section 2(e)(4) of the Act.”⁹³ Regarding that purpose, *Hall Wines* quoted with approval the language from Judge Seeherman’s concurrence in *Baik* that “the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses.”⁹⁴

Hall Wines also noted that the rareness of the surname indicated that consumers would lack familiarity with the surname: “[I]n a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use.”⁹⁵ In consideration of this, the Board took the significant step of valuing the rareness of the surname as the dominant factor in the section 2(e)(4) analysis.

In balancing the aforementioned factors, we make no secret that the first factor, rareness of the surname, has been given much more weight than the other three factors. And, in doing so, we find that any slight tilt toward finding the mark as being primarily a surname based on the other factors is outweighed by the fact that there are fewer than 300 persons with the surname “Bergfeld.” Ultimately, we conclude that applicant’s proposed mark, BERGFELD, is so rarely used as a surname, and that the remaining *Benthin* factors provide little additional support for a finding that it would be so perceived by consumers, that it is not primarily merely a surname.⁹⁶

In *Hall Wines*, the Board still considered the other factors in the analysis, but found them less persuasive than the evidence showing less than 300 individuals with the surname in the country.⁹⁷

As in Judge Seeherman’s concurring opinion in *Curlin*, the Board’s willingness in *Hall Wines* to place increased importance on the rareness factor resulted in part from the availability of more reliable directories of surname frequency.⁹⁸ While noting that there remains no threshold number to establish whether a term is primarily merely a surname, the Board commented:

⁹² *Id.* at *1, *2.

⁹³ *Id.* at *2.

⁹⁴ *Id.* (citing *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1924 (T.T.A.B. 2007) (Seeherman, J., concurring)).

⁹⁵ *Id.* at *2 (citations omitted) (internal quotations omitted).

⁹⁶ *Id.* at *4.

⁹⁷ *In re Hall Wines, L.L.C.*, No. 78926151, 2009 WL 625580, at *4 (T.T.A.B. Feb. 10, 2009) (not citable as precedent).

⁹⁸ *Id.* at *4 n.10.

[T]he electronic databases available to examining attorneys today are far more comprehensive and current than the reference materials available in the past; thus, we can presume that the number of persons listed (absent duplicative entries) is a fairly accurate estimation of the number of individuals with the surname in the entire United States.⁹⁹

V. THE PROPER PLACE OF RARENESS IN THE ANALYSIS

What explains these competing trends set forth in Sections III and IV? The treatment of the rareness factor will obviously differ in each case depending on the specific evidence and arguments contained in the record for that case. Further, the inconsistent treatment of the rareness factors in these two trends may result from the different compositions of the panel of three judges assigned for each case from the pool of twenty on the Board. Different judges conceive of rareness in fundamentally distinct ways. As discussed in the remainder of this section, the decisions from the older trend treat all surnames—rare or common—equally, believing that because someone has a surname then consumers will regard it as a surname. The *Baik* line of cases, on the other hand, acknowledges that consumers will not recognize the surname significance of rare surnames, absent significant media exposure of a famous individual with that name, and that it is unlikely that registration of these surnames will deprive anyone of rights to use their name in connection with their business.

Of course, the proper approach for examining attorneys and the Board must include consideration of rareness in the context of the other four factors. The rareness factor alone should never be dispositive. But no Board decision has placed exclusive weight on the rareness factor and determined that a mark was registrable merely because of its rareness. On the other hand, as revealed in the cases summarized in Section III, the Board has refused to register rare surnames that consumers would likely regard as trademarks rather than as surnames. These refusals limit the trademark field without justification, and as a result prevent businesses from selling their goods and offering their services under the marks that they have determined have the commercial appeal that they want to associate with their business. Businesses devote substantial resources to choosing a trademark, building their products and services under the mark, and then developing marketing campaigns around the mark. Thus, a refusal to register a surname mark wastes these resources, requiring the businesses to begin the process again with a new mark, even after that mark may have acquired goodwill among consumers.

⁹⁹ *Id.*

The remainder of this section discusses these competing understandings of rareness, and why rareness matters. The first subsection explores how consumers understand rare surnames. The second subsection looks at the significance of evidence establishing that a small number of individuals have a surname, and how examining attorneys have misused this evidence. The third subsection considers the impact of registration of a rare surname on others with the surname. The fourth subsection looks at the degree of rareness in assessing registrability. The fifth subsection considers the “look and feel” factor as it relates to the rareness factor, and how the “look and feel” factor may serve as a control against registration of rare surnames that consumers recognize primarily as surnames based on media exposure to a renowned individual bearing that surname.

A. *Consumer Understanding of Rare Surnames*

The two trends take opposing views on how consumers understand rare surnames. Decisions in the new trend express the better view that consumers will not understand the surname significance of a term they have never previously encountered as a surname.¹⁰⁰ On the other hand, decisions in the old trend posit that evidence of surname significance establishes that the primary significance of the term is as a surname, or claim that the rareness of the surname has no impact on consumer understanding of a term’s meaning.¹⁰¹ This section sets forth the positions toward consumer understanding from each trend, then discusses how the old trend fails to appreciate how consumers really understand the meaning of rare surnames, and why the new trend better captures the true approach of consumers.

In the new trend, the Board has appropriately weighed the rareness of a surname in favor of the applicant because consumers would not understand the term to be a surname. The Board stated clearly that “the rarer the surname, the less likely it is that the term will be perceived as primarily merely a surname.”¹⁰² The Board based this approach on the observation that consumers cannot know

¹⁰⁰ See, e.g., *In re Hall Wines*, 2009 WL 625580, at *2 (not citable as precedent) (citing *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1923–24 (T.T.A.B. 2007)); *In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *12 (T.T.A.B. Mar. 10, 2008) (citation omitted).

¹⁰¹ See, e.g., *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004) (not citable as precedent); *In re Lash’s Lessons, L.L.C.*, No. 78857737, 2008 WL 2385964, at *2, *3 (T.T.A.B. May 27, 2008) (not citable as precedent).

¹⁰² *In re IdeaStream Consumer Prods., L.L.C.*, No. 76543788, 2005 TTAB LEXIS 554, at *5 (T.T.A.B. Dec. 27, 2005) (not citable as precedent) (citation omitted).

and understand a term to which they have had no exposure.¹⁰³ As early as 1987, the Board concluded in its decision in *In re Garan* that “Garan” is not primarily merely a surname because “[v]irtually no exposure of ‘Garan’ as a surname has been demonstrated.”¹⁰⁴ More recently, the Board held that because “Amlin” is an extremely rare surname, “few prospective consumers are likely to perceive it as a surname.”¹⁰⁵ In three separate opinions, the Board wrote that “in a case such as this involving a very rare surname, we cannot assume that the purchasing public will view the mark as a surname based on exposure to the surname use.”¹⁰⁶ The T.M.E.P. also incorporates this reasoning into the approach for assessing registrability of surnames. “[C]ertain surnames are so rare that they do not even have the appearance of surnames. . . . [A] reasonable application of the ‘primary significance to the purchasing public’ test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful.”¹⁰⁷

Meanwhile, decisions from the older trend misunderstand consumer understanding of surname significance in the following ways. First, the Board has treated small number of listings in directories as establishing the surname significance as the primary significance of the term.¹⁰⁸ For example, in a decision from 2009, the Board agreed with the applicant’s characterization of the surname “Daimler” as rare based on fewer than 100 individuals with the surname disclosed in nationwide directories.¹⁰⁹ It noted that “a mark may be found to be

¹⁰³ See, e.g., *In re Garan*, 3 U.S.P.Q.2d (BNA) 1537, 1540 (T.T.A.B. 1987) (not citable as precedent).

¹⁰⁴ *Id.*

¹⁰⁵ *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B. Sept. 30, 2008) (not citable as precedent).

¹⁰⁶ *In re Hall Wines, L.L.C.*, No. 78926151, 2009 WL 625580, at *2 (T.T.A.B. Feb. 10, 2009) (not citable as precedent) (citing *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1923–24 (T.T.A.B. 2007)); *In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *12 (T.T.A.B. Mar. 10, 2008) (citation omitted).

¹⁰⁷ T.M.E.P. § 1211.01(a)(vi).

¹⁰⁸ *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004) (not citable as precedent) (although characterizing the surname “Ulvang” as rare, where the records of a nationwide directory disclosed only fifteen people with the surname, affirming the refusal to register because consumers would regard the surname significance as primary); *In re Lash’s Lessons, L.L.C.*, No. 78857737, 2008 WL 2385964, at *2, *3 (T.T.A.B. May 27, 2008) (not citable as precedent) (affirming refusal to register MERROW, when 3,295 directory listings established both that the surname was rare and that consumers would regard the surname significance as primary).

¹⁰⁹ *In re Jaguar Cars Ltd.*, No. 77035168, 2009 WL 1068750, at *2 (T.T.A.B. April 7, 2009) (not citable as precedent) (citations omitted).

primarily merely a surname even though it is not a common surname” and that “there is no minimum number of listings needed to prove that a mark is primarily merely a surname.”¹¹⁰

Second, the Board has characterized a surname as rare, but then declined to consider that the rareness would have any impact on consumers’ understanding of the mark. For example, the Board noted that “[w]hile Riano may be a rare surname, we cannot find, based on this record, that the surname is so rare that this factor should weigh in applicant’s favor.”¹¹¹ The Board affirmed the refusal to register the mark RIANO’S because “there are no other factors in the present case which would detract from the surname significance of this mark.”¹¹²

Third, decisions from the old trend have also stated that the concept of rareness creates a false distinction among surnames because all surnames have surname significance no matter how many or few people share the surname. The Board noted in *Roundy’s Supermarkets* that the Lanham Act does not mention rareness: “Section 2(e)(4) makes no distinction between rare and commonplace surnames.”¹¹³ Moreover, the Board has criticized the inclusion of rareness in the registrability analysis because it fails to recognize the large number of surnames shared by Americans. Namely, because the U.S. population has such a large number of surnames, a relatively small portion of the population bears each surname. In *Ulvang*, the Board claimed that “[a]lthough the 15 PowerFinder residential listings of ULVANG are a small fractional percentage of the entire PowerFinder database, virtually any surname (even extremely common surnames) would presumably also constitute only a small fractional percentage of this entire database.”¹¹⁴ The Board also noted in *Lash’s Lessons* that “given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of the total popula-

¹¹⁰ *Id.* at *3.

¹¹¹ *In re Roundy’s Supermarkets, Inc.*, No. 77275882, 2008 WL 5078732, at *1–2 (T.T.A.B. Nov. 19, 2008) (not citable as precedent); *see also In re Builder’s Best, Inc.*, No. 76642671, 2008 WL 1963581, at *6 (T.T.A.B. April 30, 2008) (not citable as precedent) (The Board characterized “Lowe’s” as a rare surname, as shown by 440 listings from nationwide directory, but concluded that it was still primarily merely a surname, as “the fact that a surname is rare is not determinative.”).

¹¹² *In re Roundy’s*, 2008 WL 5078732, at *2, *5.

¹¹³ *Id.* at *2 (citation omitted).

¹¹⁴ *In re Vegard Ulvang*, No. 78160614, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004) (not citable as precedent).

tion.”¹¹⁵ According to this logic, the PTO would have to characterize all surnames as rare and the rareness factor would favor registration of all surnames. Given that the PTO will not register all surnames, rareness is ineffective to distinguish between registrable and non-registrable terms.

The decisions from the new trend express the better view of how consumers will regard a rare surname which they have never encountered before, namely that they will consider it to be a coined term or a rare term with an unknown meaning. The approach from the old trend to the directory listings evidence—that the public knows of the surname significance and accepts that meaning as the primary one for the term because the directories contain listings for the surname—ignores the way language works and the real differences between rare and common surnames.

Contrary to the position taken in the old trend, Congress acknowledged that consumers understand rare and common surnames differently when it passed section 2(e)(4).¹¹⁶ *Roundy’s Supermarkets*, a Board decision from the old trend, expressed concern that Congress did not specify rareness as a consideration for determining the primary significance for consumers under section 2(e)(4).¹¹⁷ The lack of statutory reference to the rareness factor does not mean rareness has no place in the “primarily merely a surname” analysis. While the *Roundy’s Supermarkets* decision correctly noted that the Lanham Act does not distinguish between rarer and more common surnames, the legislative history reveals that Congress considered rareness a factor that favored registration.¹¹⁸ Congress did not want to limit registration of a mark because “it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, [as] it merely limits the field of choice.”¹¹⁹

Further, even though the Lanham Act does not mention the other four factors, the PTO and the Board include them in the analysis of registrability because of their usefulness in determining how the public will understand the mark. As the case law recognizes, the rareness factor merits consideration in the

¹¹⁵ *In re Lash’s Lessons, L.L.C.*, No. 78857737, 2008 WL 2385964, at *3 (T.T.A.B. May 27, 2008) (not citable as precedent) (quoting *In re Gregory*, 70 U.S.P.Q.2d (BNA) 1792, 1795 (T.T.A.B. 2004)) (internal quotations omitted).

¹¹⁶ *Hearings*, *supra* note 27, at 40.

¹¹⁷ *In re Roundy’s Supermarkets, Inc.*, No. 77275882, 2008 WL 5078732, at *1–2 (T.T.A.B. Nov. 19, 2008) (not citable as precedent).

¹¹⁸ *Hearings*, *supra* note 27, at 40.

¹¹⁹ *Id.*

section 2(e)(4) analysis as well because rareness shows the degree of unfamiliarity consumers will have with the term and its surname meaning.¹²⁰

The distinction between rare and common surnames is not merely a legal construct by Congress or the courts, but reflects a reality of consumer understanding. Some surnames are common and well-known. The Board correctly noted in *Lash's Lessons* that the United States lacks a surname shared by a majority of individuals. A surname shared by that many people would render null the effectiveness of the surname to distinguish and identify people. Nonetheless, large numbers of people share certain surnames. According to the United States Census Bureau, the 2000 census recorded the following five surnames (with numbers of occurrences) as the most common: Smith (2,376,206); Johnson (1,857,160); Williams (1,534,042); Brown (1,380,145); and Jones (1,362,755).¹²¹ Out of the 281,421,906 residents of the United States reported in the 2000 census,¹²² each of these surnames constituted between 0.484% and 0.844 % of the population. While these names each represent less than one percent of the U.S. population, an incredibly large number of people have these names—more than one million Americans for each name.¹²³ Because of the large number of people with these names, Americans know, or know of one of the 2.3 million Smiths, one of the 1.8 million Johnsons, one of the 1.5 million Williamses, one of the 1.3 million Browns, or one of the 1.3 million Joneses, or have one of these surnames themselves, and therefore recognize these terms as surnames.¹²⁴

On the other hand, it would be surprising if any significant portion of the U.S. population knew an “Ulvang.” The records of the 2000 Census contain no individuals with the surname “Ulvang.”¹²⁵ The evidence of fifteen individuals in the United States from nationwide directories cited by the Board in its

¹²⁰ See, e.g., *In re Garan*, 3 U.S.P.Q.2d (BNA) 1537, 1540 (T.T.A.B. 1987).

¹²¹ U.S. CENSUS BUREAU, GENEALOGY DATA: FREQUENTLY OCCURRING SURNAMES FROM CENSUS 2000, <http://www.census.gov/genealogy/www/data/2000surnames/index.html> [hereinafter *Genealogy Data*].

¹²² U.S. CENSUS BUREAU, YOUR GATEWAY TO CENSUS 2000, www.census.gov/main/www/cen2000.html [hereinafter *Gateway*].

¹²³ *Genealogy Data*, *supra* note 121.

¹²⁴ *Id.* Because these surnames are commonplace, we recognize them as having surname significance. This does not necessarily mean, though, that we understand the primary significance to be as a surname. For example, we also understand the term “brown” as referring to the color.

¹²⁵ U.S. CENSUS BUREAU, FILE B: SURNAMES OCCURRING 100 OR MORE TIMES, <http://www.census.gov/genealogy/www/data/2000surnames/names.zip> [hereinafter *Surnames*].

decision indicates that only 0.00000533% of the population recorded in the 2000 Census would have had the surname “Ulvang.”¹²⁶ More than 158,413 times as many people in the United States have the surname Smith. The surname “Ulvang” is rare. The surname “Smith” is not. The rareness of the surname “Ulvang” makes a difference in consumer understanding of the term; its infrequent occurrence makes it unlikely that consumers would have heard it. With so few individuals named Ulvang, it is unlikely that American consumers would know an Ulvang and recognize the term as a surname.

Consumers understand rare surnames like they do all rare terms—as unknown terms with unknown meanings and unknown parts of speech. The words a speaker understands and uses represent but a small fraction of the words that exist. The vocabulary of a college-educated speaker consists of only about 2.8% of the number of words contained in the Oxford English Dictionary.¹²⁷ A speaker has not encountered the remaining 97.2% of the words in that dictionary—or many terms outside the dictionary, like certain rare surnames, slang terms, coined trademarks, and foreign terms. That speaker therefore does not know their meanings or their function in speech. The vast majority of rare terms—those that by definition few people use—belong in the group of words a speaker has not encountered, and he or she will therefore understand most rare terms as unfamiliar terms with unknown meanings. The unknown term could have a surname significance, but the user of language may also think that the term has a geographic significance, an obscure, technical, or specialized dictionary definition, a significance in a foreign language, a slang meaning, or only trademark significance.¹²⁸ Rather than ascribing the term a meaning at random,

¹²⁶ See *Gateway*, *supra* note 122 (stating that in the year 2000, the U.S. had a population of 281,421,906 people); *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004) (stating 15 people had the surname Ulvang).

¹²⁷ There are 600,000 definitions in the Oxford English Dictionary, which represents only a portion of the words in the English language. Wikipedia, *English language*, en.wikipedia.org/wiki/English_language (last visited Feb. 28, 2010). The vocabulary size of college-educated speakers consists of only about 17,000 word families. Wikipedia, *Vocabulary*, en.wikipedia.org/wiki/Vocabulary (last visited Feb. 28, 2010) (citing E.B. Zechmeister et al., *Growth of a Functionally Important Lexicon*, 27 J. OF READING BEHAV. 201 (1995)).

¹²⁸ Interestingly, in *Roundy's Supermarkets*, the Board rejected the applicant's arguments that there were non-surname meanings of the term “riano,” namely that it meant “renew” in Italian, and that it was a town in Italy with 7,185 residents, because there was no evidence that American consumers would know these meanings. No. 77275882, 2008 WL 5078732, at *3–4 (T.T.A.B. Nov. 19, 2008) (not citable as precedent). Although the number of residents of the town named Riano (7,185) is larger than the number of Americans with the surname Riano (330), and it was therefore over twenty times more likely that a consumer would know someone who lived in Riano than who had the name “Riano,” the Board still found that the surname significance would be more dominant. *Id.* at *1, *3.

such as assuming that the term is a surname, the speaker will consider the rare surname to be a term whose meaning he or she does not know. T.M.E.P. section 1211.01(a)(vi) recognizes this, observing that consumers would regard rare surnames as arbitrary or fanciful, rather than as surnames.¹²⁹ Concluding that consumers perceive of the term “ulvang” as a surname because there are fifteen individuals with that name would render this section of the T.M.E.P. meaningless.

When a speaker lacks familiarity with a term, he or she does not regard that term as having a meaning as a surname merely because a surname significance exists. The speaker lacks familiarity both with the term and the surname significance and cannot ascribe to the term a meaning not known to exist. Consumers unaware of the term and the meaning would not make a leap and think of it as a surname. They would have no reason to believe that a particular individual having that name, a name unknown to them, has some association with those goods or services. Therefore, the benefit to using the term as a trademark would derive from the sounds and appearance of the term, and not from any connection consumers would draw to an individual with that name.

Further, consumers will not learn the surname meaning of a term when it enters the public realm as a trademark. When the term appears as a trademark, it probably does not carry with it contextual clues that would identify the term as a surname to consumers. When a speaker encounters a new term, he or she learns its meaning through context. A title like “Ms.” or “Dr.” precedes a surname, or the surname refers to a specific person introduced in a conversation or a text. When a term appears on product packaging as a trademark, it does not necessarily carry any surname cues. For example, the mark ULVANG appears on a label on an article of clothing, accompanied by a graphic design, but in this context does not bear any reference to an individual with the surname “Ulvang” or other language cues to identify it as a surname.¹³⁰ Without references on the packaging to an individual with the name “Ulvang,” consumers will not regard the term as a surname, but rather as a trademark. This contrasts with the position under the old trend that consumers will understand the mark ULVANG as a surname when they see it used as a trademark on clothing packaging even though they have never heard the term used as a surname.

The new trend thus better recognizes how consumers understand rare surnames. The Board correctly and succinctly wrote that in cases “involving a very rare surname, we cannot assume that the purchasing public will view the

¹²⁹ T.M.E.P. § 1211.01(a)(vi).

¹³⁰ For an example of the mark as it appears on clothing, see *Ulvang.com: Products*, <http://www.ulvang.com/default.pl?showPage=180> (last visited Feb. 28, 2010).

mark as a surname based on exposure to the surname use.”¹³¹ Without surname use, consumers are more, or at least equally as, apt to regard the term as coined.

B. The Meaning of Evidence Establishing Rareness of a Surname

As argued in the preceding subsection, consumers will not understand rare surnames as having primarily a surname significance because they will not know that significance, unless someone with that surname has gained notoriety. Nonetheless, as summarized in Section III, *supra*, examining attorneys at the PTO often interpret evidence of the rareness of a surname as showing that consumers will believe that the surname significance dominates over other meanings. For example, an examining attorney refused registration of the mark BONERT’S even though a search of nationwide directories disclosed only 34 individuals with the surname “Bonert.”¹³² Refusals made in spite of evidence of the rareness of the surname, and without any other evidence to support the refusal, raise three problems with respect to the evidentiary standards and burdens of the rareness factor:

- (1) the examining attorneys confound the existence of a surname significance, however slight, with primary significance of the term as a surname;
- (2) the factor regarding non-surname significance becomes the only factor the examining attorney will consider once directories disclose listings for individuals with the surname; and
- (3) the examining attorneys fail to meet their burden of establishing the primary significance of the mark, and improperly shift that burden to the applicant.

First, Office Actions refusing registration based solely on a small number of listings contained in nationwide directories suggest that the examining

¹³¹ *In re Hall Wines, L.L.C.*, No. 78926151, 2009 WL 625580, at *2 (T.T.A.B. Feb. 10, 2009) (not citable as precedent) (quoting *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1923–24 (T.T.A.B. 2007)) (internal quotations omitted); *In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *12 (T.T.A.B. Mar. 10, 2008) (not citable as precedent) (citation omitted).

¹³² Office Action, Ser. No. 76627189 (Aug. 12, 2005) (term “bonert” primarily merely a surname based on 34 references in nationwide directory), *rev’d sub. nom. In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *8 (T.T.A.B. Mar. 10, 2008) (“Bonert,” with evidence of only 600 individuals with surname, was “extremely rare”).

attorneys issuing these Office Actions misunderstand the significance of directory listings. The examining attorneys in cases such as *Bonert's* used the small number of listings as evidence that the public would understand the primary significance of the mark to be as a surname merely because there are a handful of individuals with that surname.¹³³ These directory listings establish a surname significance for the term and few applicants would dispute that such meaning exists. However, the registrability analysis does not query whether a surname significance exists, but whether consumers consider that surname significance as the primary significance. The directory listings should not be interpreted to establish primary significance among consumers.

Listings revealing fewer than 300 individuals with a surname out of the population of the entire United States represent but 0.0001% of the population.¹³⁴ With so few individuals having the surname, the purchasing public is unlikely to know of those individuals bearing the surname and, therefore, the surname significance is nominal at best among consumers. Yet rather than viewing the small number of listings as supporting registration, examining attorneys have used the mere existence of the listings as their basis to refuse registration, denying rareness from having its proper role in the five-factor test for determining whether a term is “primarily merely a surname.” This approach violates Congress’s legislative intent of section 2(e)(4), which added the word “primarily” to “merely” in the 1946 Act in order to prevent “a refusal to register only because a surname was found in a directory to be the name of somebody somewhere.”¹³⁵ Worded differently, the language “primarily merely a surname” intends “to avoid a test whereby if the surname could be found as that of an individual in a telephone book or city directory it was unregistrable.”¹³⁶ These refusals run counter to this precise concern expressed by Congress and thereby misapprehend how consumers understand rare surnames.

Second, the examining attorney’s treatment of the small number of directory listings as establishing the surname significance as primary fails to follow the evidentiary approach set forth in the *Benthin* test. The examining attorney should consider all five *Benthin* factors as a whole.¹³⁷ The approach taken for the BONERT’S application, as well as for other refusals of rare surnames,

¹³³ See references cited *supra* note 40.

¹³⁴ See *Gateway*, *supra* note 122 (stating that in the year 2000, the U.S. had a population of 281,421,906 people).

¹³⁵ *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. (BNA) 145, 148, 149 (Comm’r Pat. 1955) (discussing the pertinent legislative history).

¹³⁶ *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33 (D.C. Cir. 1953).

¹³⁷ See T.M.E.P. § 1211.01.

renders all factors null except the existence of a non-surname significance. Namely, in this approach, when the examining attorney has found a surname significance, the examining attorney starts from the assumption that surname significance is primary, and then deems four of the five factors—all except the existence of a non-surname significance—to support this assumption. As already discussed, examining attorneys view the rareness of the surname as weighing against the applicant, or as having no weight, because the surname significance exists. But additionally, examining attorneys have concluded that because these directory listings establish a surname significance for the term, it therefore also has the “look and feel” of a surname, which will also weigh against registration.¹³⁸ This argument has serious flaws, further discussed in Section V.E., as evidence from directory listings has no relevance to the “look and feel” factor; a term does not have the “look and feel” of a surname merely because directories disclose a surname significance for the term. The other two factors—association of an individual having the surname with the applicant and stylization of the mark—will not show a non-surname significance, and therefore cannot overcome the examining attorney’s starting assumption that the directory listings establish the surname significance as primary. The remaining factor, the existence of a non-surname meaning, becomes the determinative factor. That is, if the term has a well-known, non-surname significance, the examining attorney may approve it for registration, but otherwise the examining attorney will issue an Office Action refusing registration, merely because the examining attorney found a trivial surname significance.

In approaching section 2(e)(4) in this way, the examining attorney fails to consider the five factors as a whole. On the contrary, the examining attorney creates a new test, not one set forth in the case law or the T.M.E.P.: when the examining attorney finds even a nominal surname significance, the applicant must submit evidence to establish that a non-surname significance dominates. In this approach, only evidence of a well-known, non-surname significance would suffice to overcome a refusal based on evidence of surname significance from directory listings. This test does not consider the primary significance of the term for consumers, but rather, in the absence of a dominant non-surname meaning, denies registration when a surname significance exists, even if most consumers do not know of the surname significance and certainly do not consider it to be the primary meaning. The examining attorney has rendered consumer awareness of the surname significance irrelevant in this test. The ex-

¹³⁸ See, e.g., Office Action, Ser. No. 78560314 (Sept. 2, 2005) (term “curlin” has the “look and feel” of a surname based on directory listings), *rev’d sub. nom. In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *1 (T.T.A.B. Feb. 11, 2008).

aming attorney, in effect, has deleted the wording “primarily merely” from section 2(e)(4).

Third, when the PTO refuses registration based solely on evidence that some individuals have that surname, the PTO inappropriately transfers the initial evidentiary burden to the applicant. The PTO bears the burden of presenting evidence establishing that the term is primarily merely a surname.¹³⁹ With directory listings, the examining attorney may establish that a surname significance exists, but these listings alone cannot satisfy the burden of establishing the surname significance as the primary significance under *Benthin*. Yet, rather than explore how consumers would regard the primary significance of the term by using the five *Benthin* factors, the examining attorney deems the analysis complete after conducting the directory search. Although the examining attorney has not met the burden of establishing the primary significance of the term, he or she refuses registration merely because a surname significance exists. With this approach to the evidentiary burden, the examining attorney may deem the burden satisfied if he or she finds but one person, living or dead, who has that surname.

Such a refusal to register based solely on the existence of a surname significance transfers the initial burden of establishing the primary significance to the applicant. In order to satisfy this burden, the applicant must show that the surname significance is not the primary significance and that the term has a dominant non-surname significance. The examining attorney abdicates his or her responsibility to look for evidence establishing the term’s meaning and consider how consumers will understand the term. The Federal Circuit has held that this burden shifting is improper:

The [B]oard held that in view of the lack of any established secondary meaning of appellant’s mark, the mark would only have the significance of a surname to purchasers. Thus, the [B]oard, in essence, shifted the burden of proof to appellant without first establishing that DUCHARME is primarily merely a surname. As stated previously, the Patent Office has the burden to show that DUCHARME is primarily merely a surname and unless it meets its burden, appellant need not demonstrate non-surname significance of its mark.¹⁴⁰

Nonetheless, this burden-shifting continues to happen.

¹³⁹ *In re Etablissements Darty Et Fils*, 759 F.2d 15, 16 (Fed. Cir. 1985); *In re Raivico*, 9 U.S.P.Q.2d (BNA) 2006, 2007 (T.T.A.B. 1988) (not citable as precedent); T.M.E.P. § 1211.02(a).

¹⁴⁰ *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 831–32 (C.C.P.A. 1975).

C. It Is Less Likely That Multiple Businesses in the Same Field Will Use Rare Surnames

In decisions from the *Baik* trend, the Board has returned to the policy reasons for the limitations on trademark registration of surnames. These decisions have embraced the rareness factor within the context of the principal rationale for restricting surname registrations embodied in the common-law tradition of permitting individuals to use their names in connection with their livelihoods.¹⁴¹ As Judge Seeherman noted in a concurring opinion in *Baik*, “the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses”¹⁴² The Board’s main opinion in *Hall Wines* quotes this language with approval.¹⁴³ As these decisions note, registration of rare surnames, that is, granting an exclusive right to use a surname, is unlikely to deny people the opportunity to use their surnames in connection with their businesses.¹⁴⁴ Decisions from the older trend do not mention this policy consideration.

The new trend acknowledges that it is unlikely that trademark registration of a rare surname will have any significant negative impact on a non-applicant who has that surname. As Judge Seeherman noted in her concurring opinion in *Baik*, very few people would have any interest in using the surname as a mark.¹⁴⁵ “If a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.”¹⁴⁶

She further noted in her concurring opinion in *Curlin Medical* that even if someone else wanted to use the surname as a mark, the restriction on use would apply only to the same field as the applicant’s.¹⁴⁷ Judge Seeherman explained,

If a surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. Accordingly, if the examining attorney cannot show that a reasonable number of people have a particular surname, in my view the Office

¹⁴¹ *In re Joint-Stock Co.* “Baik,” 84 U.S.P.Q.2d (BNA) 1921, 1922–23 (T.T.A.B. 2007).

¹⁴² *Id.* at 1924.

¹⁴³ *In re Hall Wines, L.L.C.*, No. 78926151, 2009 WL 625580, at *6 (T.T.A.B. Feb. 10, 2009).

¹⁴⁴ *Id.*; *Baik*, 84 U.S.P.Q.2d at 1924 (Seeherman, J., concurring).

¹⁴⁵ *Baik*, 84 U.S.P.Q.2d at 1924 (Seeherman, J., concurring).

¹⁴⁶ *Id.*

¹⁴⁷ *In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *6 (T.T.A.B. Feb. 11, 2008).

cannot meet its burden of prima facie showing that a mark is primarily merely a surname.¹⁴⁸

The Board in *Amlin* adopted Judge Seeherman's position from her concurrence in *Curlin Medical*. In *Amlin*, the Board noted that "substantially no one will be adversely affected by the registration of this term for the recited services."¹⁴⁹ The examining attorney submitted evidence that referenced approximately 150 individuals in the U.S. with the surname "Amlin."¹⁵⁰ Because only one in every two million individuals in the U.S. had the surname, the Board concluded that the term was an extremely rare surname.¹⁵¹ Accordingly, the Board found it unlikely that registration would negatively impact anyone and the rareness factor therefore favored the applicant.¹⁵²

In recognizing an exception to the common-law tradition respecting the right of an individual to use his or her name in connection with a business in the case of rare surnames, the Board is not arguing that individuals with rare surnames have inferior rights to those with more common surnames.¹⁵³ Rather, the Board recognizes the clearly different circumstances presented when 200 people share a surname as opposed to 200,000.¹⁵⁴ With a rare surname, registration of the surname as a trademark realistically would not deny anyone else the right to use his or her surname. It is extremely unlikely that two or more of the 200 individuals sharing a rare surname will sell goods or provide services in the same field. For more common goods and services, the possibility of overlap in business between individuals with the same surname increases, which may support more open use of the surname by individuals bearing that name, and a reticence to register the mark. Such a situation is extremely unusual, though. Individuals may choose from thousands of types of businesses and need not open the same type of company as one that uses their surname as a trademark. Moreover, even if individuals wish to open a business in the same field, they may choose from thousands of possible trademarks to use in connection with the business.

Some individuals with the same surname of course will be related to each other and they may desire to continue in the same field as the family business started by a relative. Suppose one operates a business under the family

¹⁴⁸ *Id.*

¹⁴⁹ *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B Sept. 30, 2008).

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.*

name in order to benefit from the goodwill created by his or her relative. Unless they do so with the relative's permission and under common quality control, this use may result in confusion among consumers regarding the relationship between the businesses. Trademark law intends to protect against such consumer confusion and stop the junior user from using the mark in a confusing manner.¹⁵⁵

Accordingly, no one has an absolute, unqualified right to use their surname in connection with their business. If an individual has used his or her surname as a trademark to such an extent that it has acquired secondary meaning, and others have not used the mark, he or she may register it under section 2(f) because the trademark significance has come to dominate over the non-trademark significance. For example, McDonald's Corporation owns registrations for marks including the term "McDonald's," even though that term is a surname possessive. This is because consumers have come to understand the term "McDonald's" as a mark used in connection with restaurants and associated goods and services, rather than as a surname referring to a specific person, as a result of the company's extensive use of the mark over decades.¹⁵⁶ The user of the trademark, McDonald's Corporation in this case, can claim exclusive rights in it because consumers privilege the trademark meaning. It is a longstanding provision of U.S. trademark law that the holder of the registration obtained through acquired distinctiveness based on long and exclusive use may prevent others with the name from using or registering the mark in connection with goods or services in his or her field.

In an analogous situation, with a rare surname, the user may register the surname because consumers regard it as having trademark significance instead of, or more prominent than, its surname significance. The trademark owner using the rare surname need not have used it to the same extent as one would need to use a more common surname in order to create secondary meaning. Consumers do not know the surname significance of the rare surname as they would with the more common surname and the trademark user therefore does

¹⁵⁵ Lanham Act § 2(d), 15 U.S.C. § 1052(d):

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it

- (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

¹⁵⁶ See, e.g., Registration Number 804,365 (registered Feb. 22, 1966) (mark MCDONALD'S registered with a Section 2(f) claim of acquired distinctiveness).

not need to overcome the strength of the surname meaning. With a more common surname, a period of exclusive use can condition consumers to understand the surname to function as a trademark by identifying the user, and not someone else with the surname, as the sole provider of the goods. Such extensive use over time proves unnecessary with rare surnames because the vast majority of consumers lack familiarity with the surname in question, and they will never regard it as a surname, but rather always as an arbitrary or coined term. The non-surname, or trademark, significance dominates among consumers when they first encounter the rare surname, which makes it registrable even without acquired distinctiveness. By using the rare surname as a trademark before others do, the user can claim exclusive rights in the surname and prevent others from using it.

Rareness by itself, however, should not determine the appropriateness of registration for a surname. Though few individuals may bear the surname, the surname significance may become well known through high public exposure of an individual with that surname. With a well-known surname, the surname significance may dominate. Section 2(e)(4) would call for refusal to register this term.¹⁵⁷

Even in the case, though, when media coverage has made the surname meaning well known, that rare surname nonetheless may still merit trademark registration. If the individual with the rare surname who has gained notoriety wants to register the name and thereby deny others the opportunity to use the mark for related goods or services, he or she has built goodwill in the name and should benefit from it to the exclusion of others. Further, it is unlikely that registration will adversely affect anyone else. It would be surprising if the small number of other individuals with the surname would want to use their surname in connection with a business offering goods or services in a related field. But assuming that these other individuals want to enter the same field or use the trademark, registration of the surname will not deprive them of their livelihood. They may use a different mark in connection with related goods or services, or they may use and register the surname in connection with unrelated goods and services. It is recognized that these possibilities do not respect the common-law tradition of allowing individuals to use their last names in connection with their businesses. Consumer confusion should remain the fundamental concern, and if registration of the surname would result in confusion as to the source of the goods or services, registration may be inappropriate. In the vast majority of

¹⁵⁷ T.M.E.P. § 1211.01 (noting that Congress intended section 2(e)(4) to exclude registration of terms such as “Johnson” and “Jones,” which are well-known as surnames).

cases, however, refusing registration of the rare surname would improperly limit the applicant's choice of trademark.

D. The Degree of Rareness May Influence Registrability

No decision has resolved the question of how rare is rare enough—decisions from the old trend find that no surname is rare enough, while decisions from the new trend leave open how rare is rare enough. As discussed in Section V.A., decisions from the old trend have declined to distinguish rare names from common surnames; in effect, under this approach no surname is rare enough. The Board noted in *Roundy's Supermarkets* that “[w]hile Riano may be a rare surname, we cannot find, based on this record, that the surname is so rare that this factor should weigh in applicant's favor.”¹⁵⁸ In that case, the evidence showed only 330 individuals with the surname.¹⁵⁹ If a surname held by only 330 individuals, out of a country of 300 million, does not qualify as rare, then one must wonder if any surname would qualify as rare for the panel in *Roundy's Supermarkets*. Other language from the decision in *Roundy's Supermarkets* further suggests that the panel indeed would not find any surname rare enough. The decision noted that “Section 2(e)(4) makes no distinction between rare and commonplace surnames.”¹⁶⁰

In *Ulvang*, the Board argued that “virtually any surname (even extremely common surnames) would presumably also constitute only a small fractional percentage of this entire database.”¹⁶¹ In *Lash's Lesson*, that Board argued that ““given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of the total population.””¹⁶²

On the other hand, decisions from the new trend have made a distinction among “extremely rare,” “relatively rare,” and “rare” surnames, though without defining these concepts. The roots of these distinctions appear to go back to a Board decision from 2000. In *In re United Distillers*,¹⁶³ the Board characterized “Hackler” as a “relatively rare” surname based on 1,295 listings in a nationwide

¹⁵⁸ *In re Roundy's Supermarkets, Inc.*, No. 77275882, 2008 WL 5078732, at *2 (T.T.A.B. Nov. 19, 2008).

¹⁵⁹ *Id.* at *1.

¹⁶⁰ *Id.* at *2.

¹⁶¹ *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004).

¹⁶² *In re Lash's Lesson, L.L.C.*, No. 78857737, 2008 WL 2385964, at *3 (T.T.A.B. May 27, 2008) (quoting *In re Gregory*, 70 U.S.P.Q.2d (BNA) 1792, 1795 (T.T.A.B. 2004)).

¹⁶³ *In re United Distillers, PLC*, 56 U.S.P.Q.2d (BNA) 1220 (T.T.A.B. 2000).

directory containing 80 million entries.¹⁶⁴ Considering the rareness of the surname and the existence of a non-surname dictionary meaning for the term “hackler,” the Board held that the primary significance of the relatively rare surname was not as a surname.¹⁶⁵ Despite the characterization of “Hackler” as a “relatively rare” surname, as opposed to “rare” or “extremely rare,” the Board still found in favor of the applicant, directing registration of the mark.

The Board picked up this distinction in subsequent decisions. For example, in *Amlin*, the examining attorney and the applicant disagreed on the degree of rareness of the surname “Amlin.” The examining attorney characterized it as “relatively rare,” based on directories showing between 111 and 192 individuals with the surname “Amlin,” and the applicant characterized it as “extremely rare.”¹⁶⁶ The Board agreed with the applicant that “Amlin” was an “extremely rare” surname, pointing out that based on the mid-point number of 150 individuals with the surname “Amlin,” the surname occurred in only about one in two million Americans.¹⁶⁷ Accordingly, “few prospective consumers are likely to perceive it as a surname, and substantially no one will be adversely affected by the registration of this term for the recited services.”¹⁶⁸

The Board has characterized other surnames as extremely rare.¹⁶⁹ For example, in *Baik*, the Board held that listings of 452 individuals with the surname “Baik” indicated that the surname was “extremely rare,” and not “relatively rare” as the examining attorney had asserted.¹⁷⁰ The Board found that the term was not primarily merely a surname.¹⁷¹

In one case the Board considered the rarity of the surname as the most significant factor. In *Urman*, the Board determined that “Urman” was an “extremely rare” surname where evidence showed that there were only about 200 individuals with the surname and it ranked as the 22,565th most popular Ameri-

¹⁶⁴ *Id.* at 1221.

¹⁶⁵ *Id.* at 1222.

¹⁶⁶ *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B. 2008).

¹⁶⁷ *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ *In re Hall Wines, L.L.C.*, No. 78926151, 2009 WL 625580, at *6 (T.T.A.B. Feb. 10, 2009) (“Bergfeld,” with evidence of only 300 individuals with surname, was “extremely rare”); *In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *8 (T.T.A.B. Mar. 10, 2008) (“Bonert,” with evidence of only 600 individuals with surname, was “extremely rare”); *In re IMSA-MEX, S.A. de C.V.*, No. 78464418, 2007 WL 954356, at *2 (T.T.A.B. 2007) (not citable as precedent) (“Pintro,” with evidence of only 24 individuals with surname, was “extremely rare”).

¹⁷⁰ *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921 (T.T.A.B. 2007).

¹⁷¹ *Id.* at 1924.

can surname, and the factor therefore weighed in favor of the applicant.¹⁷² The Board stated that the rareness of the surname outweighed the lack of a non-surname meaning and the possibility that it might have the look and feel of a surname.¹⁷³

Nonetheless, these characterizations of the degree of rareness may create a distinction without significance. No decision has turned on the characterization of a surname as “extremely rare,” as opposed to another degree of rareness. Neither the *Urman* decision, nor any other, makes any suggestion that if the surname were only “rare” or “relatively rare,” the Board would have reached a different result.

Even in the new trend, the Board has resisted setting a threshold number defining what makes a term rare enough for registration.¹⁷⁴ Nor has the Board ever defined or distinguished the wording “extremely rare” versus “relatively rare.” Notwithstanding this lack of clarity, as seen in *Amlin* and *Baik*, the Board has granted registration to surnames characterized as “extremely rare,” so it benefits applicants to characterize their surnames as such.¹⁷⁵ But there remains no guidance for what makes a surname “extremely rare.”

The rarer the surname, the more appropriate registration becomes, but any threshold absolute numbers indicating that a surname is rare would necessarily change over time as the population fluctuates. Perhaps it would help to define rareness by percentages of the population, as the Board did in *Amlin* when it noted that “Amlin” occurred in only one in every two million Americans. However, it is important to remember that the fact that only a handful of individuals bear a surname cannot mandate registration as a rare surname may still have attained a high degree of consumer awareness because a famous person bears that name. Keeping in mind that the overriding question remains the primary significance of the term, a test based solely on a threshold absolute number of individuals bearing the surname remains inappropriate because population numbers cannot, by themselves, convey how consumers understand the term.

¹⁷² *In re Productos Urman, S.A. de C.V.*, No. 78497796, 2008 WL 906614, at *2 (T.T.A.B. Mar. 20, 2008).

¹⁷³ *Id.*

¹⁷⁴ *See, e.g., In re Hall Wines*, 2009 WL 625580, at *6 n.10.

¹⁷⁵ *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *2 (T.T.A.B. 2008); *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1924 (T.T.A.B. 2007).

E. The “Look and Feel” of the Term May Balance the Rareness of the Surname

When discussing the rareness factor, decisions from both trends consider the relationship between rareness and the fourth *Benthin* factor—whether the term has the “look and feel” of a surname. The fourth factor considers whether the term has the structure and pronunciation of a more common surname, which would weigh against registration.¹⁷⁶ Although the examining attorney and the Board sometimes look for common prefixes, like “mc-,” or suffixes, like “-man,” in order to determine whether the term has the “look and feel” of a surname,¹⁷⁷ they often subjectively consider whether the term looks like a surname to them.¹⁷⁸ In the context of the rareness factor, the Board has struggled to define the meaning of “look and feel.” Under the old trend, decisions find that the existence of a surname significance means that the term has the “look and feel” of a surname.¹⁷⁹ The new trend proposes two different approaches to the “look and feel” factor in the case of a rare surname: either to ignore the factor or to place increased emphasis on it.¹⁸⁰ These disparate treatments show that the Board has not resolved the significance of or method for approaching the “look and feel” factor.

A full treatment of the factor goes beyond the scope of this article. However, given the Board’s comments relating the rareness and “look and feel” factors, it merits consideration. Further, a revived and clarified “look and feel” factor may help put the rareness factor in perspective. Perhaps, unlike any of the conceptions put forth in either the old or new trend, the “look and feel” factor has a role in aiding the analysis of a rare surname from the perspective of the

¹⁷⁶ *In re Industrie Pirelli Societa per Azioni*, 9 U.S.P.Q.2d (BNA) 1564, 1566 (T.T.A.B. 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989).

¹⁷⁷ *See, e.g., In re Max Rohr, Inc.*, Ser. No. 78764755, at *7 (T.T.A.B. Mar. 20, 2008) (not citable as precedent) (KAUFMANN had the “look and feel” of a surname based on the large number of surnames ending in the suffix “-man.”), *available at* <http://des.uspto.gov/Foia/ReterivePdf?flNm=78764755-03-20-2008&system=TTABIS>.

¹⁷⁸ *See, e.g., In re Jeld-Wen, Inc.*, Ser. No. 78772837, at *6 (T.T.A.B. Mar. 11, 2008) (not citable as precedent) (affirming the refusal to register the term LANGFORD under § 2(e)(4), but noting that the “look and feel” factor “is highly subjective” and declining to give it any weight “[g]iven the absence of any evidence in support of the examining attorney’s claim” that the term had the “look and feel” of a surname), *available at* <http://des.uspto.gov/Foia/ReterivePdf?flNm=78772837-03-11-2008&system=TTABIS>.

¹⁷⁹ *See, e.g., In re Roundy’s Supermarkets, Inc.*, No. 77275882, 2008 WL 5078732, at *4 (T.T.A.B. Nov. 19, 2008).

¹⁸⁰ *See, e.g., In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *11 (T.T.A.B. Mar. 10, 2008).

primary inquiry under section 2(e)(4)—that is, do consumers consider the term to have the look and feel of a surname such that the surname significance dominates? A consideration of how to approach this question follows here after discussions of how both trends view the “look and feel” factor in connection with the rareness factor.

In decisions from the old trend, the Board has held that listings of surnames from directories, even though referencing only a small number of individuals, establish not only the surname significance of the term, but also that it has the “look and feel” of a surname. For example, the Board deemed the term “riano” to have the “look and feel” of a surname because of “the evidence that it is indeed a surname.”¹⁸¹ The Board concluded that because the term “daimler” lacked a non-surname significance, the term “daimler” had the look and feel of a surname.¹⁸² Additionally, the Board made a conclusory holding that the term “ulvang” had the look and feel of a surname, without citing any evidence or setting forth any arguments in support of this holding.¹⁸³

These approaches to the “look and feel” factor create a tautology: evidence of surname significance establishes that the term has the “look and feel” of a surname. In other words, consumers know that a term is a surname because it is a surname, even if they have never heard of it before. This tautology is unhelpful in determining how consumers really understand a term and it also renders two factors weightless. First, as previously discussed, this conception renders weightless the rareness factor.¹⁸⁴ This view misconstrues this evidence and concludes that the surname significance dominates among consumers even though the surname is rare. Namely, the Board takes the small number of directory listings as evidence indicating that the term is primarily merely a surname, despite the lack of any indication that consumers will understand a term to which they have had little or no exposure as having surname significance.

Second, this conception renders weightless the “look and feel” factor. This view posits that consumers will understand the term as having the “look and feel” of a surname solely because a surname significance exists. The “look and feel” factor lacks any significance if all surnames have the “look and feel” of surnames merely because they are surnames. Under this interpretation of the factor, “look and feel” would always weigh against registration. For this factor to aid in understanding the primary significance of the term, some surnames must not have the “look and feel” of a surname. Rare surnames without signifi-

¹⁸¹ *In re Roundy's*, 2008 WL 5078732, at *4.

¹⁸² *In re Jaguar Cars, Ltd.*, No. 77035168, 2009 WL 1068750, at *4 (T.T.A.B. Apr. 7, 2009).

¹⁸³ *In re Vegard Ulvang*, No. 78160641, 2004 WL 3060195, at *2 (T.T.A.B. Dec. 15, 2004).

¹⁸⁴ *See supra* Section V.A.

cant media attention (those surnames unknown by the vast majority of consumers), fit within the group of surnames that do not have the “look and feel” or a surname.

The new trend of decisions does not conceive of the “look and feel” factor for rare surnames in the same way, but rather either places increased emphasis on the factor or gives no weight to the factor. In some cases following the *Baik* trend, the Board has suggested increasing the weight accorded to the “look and feel” factor as a counter force to the weight placed on the rareness factor. In *Bonert’s* and *IMSA-MEX*, the Board stated that “[i]t is in the case of a rare surname that we need to weigh ‘look and feel’ carefully. For example, certain surnames, though rare, resemble common surnames ‘in their structure and pronunciation.’”¹⁸⁵

The Board did not explain the need for the added scrutiny. Perhaps the Board emphasized the “look and feel” factor out of a worry that increased weight on the rareness factor would result in too many surname registrations. Or maybe the Board had a concern that the test for registration under section 2(e)(4) would change from the five-factor *Benthin* test to a simple mathematical test of the number of individuals with a surname, thereby making rareness dispositive and resulting in an abandonment of the nuanced balancing prescribed in the five-factor test. Thus, one could conceive of the “look and feel” factor as both a proper counterweight to the rareness factor to protect against over-registration and a way to preserve the balancing test.

However, in these decisions the Board did not amplify the appropriate approach for a more careful consideration of the “look and feel” factor in the case of rare surnames. Nor has the Board defined the “look and feel” factor with any objective specificity. The applicant must wonder what the more careful consideration entails—how will the Board determine that a mark has the “look and feel” of a surname and how will consideration of this factor differ as between rare and more common surnames?

In other decisions from the new trend the Board has gone the other direction in its approach to the “look and feel” factor for rare surnames. The Board questioned whether it should accord any weight to the “look and feel” factor when considering a rare surname. In *Amlin*, the Board stated that it could not base a refusal to register a rare surname on the “look and feel” of the term in

¹⁸⁵ *In re Bonert’s, Inc.*, 2008 TTAB LEXIS 683, at *11 (quoting *In re Industrie Pirelli Societa per Azioni*, 9 U.S.P.Q.2d (BNA) 1564, 1566 (T.T.A.B. 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989)) (citing *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1922 (T.T.A.B. 2007)); *In re IMSA-MEX S.A. de C.V.*, No. 78464418, 2007 WL 954356, at *3 (T.T.A.B. Mar. 22, 2007) (citing *Baik*, 84 U.S.P.Q.2d at 1922).

question.¹⁸⁶ “[W]e find that the Trademark Examining Attorney cannot base a *prima facie* case under Section 2(e)(4) of the Act on the mere fact that the rare surname at issue has some similarity in structure and pronunciation to another, more common surname, like ‘Hamlin.’”¹⁸⁷ Judge Seeherman wrote in her concurring opinion in *Baik* that “[i]nterpreting the ‘look and feel’ factor to refuse registration of marks simply because they are similar to recognized surnames does not serve the intention of the statute.”¹⁸⁸ She further noted in her concurrence in *Curlin Medical* that “[w]e can reach absurd results if we base our analysis on whether certain syllables or letter chains can be found in the applied-for mark and in various surnames.”¹⁸⁹

Under this approach, the Board has expressed concern that the PTO may refuse to register a surname solely because it might have a “structure and pronunciation” similar to other surnames.¹⁹⁰ Indeed, the statute does not prohibit registration of terms that sound like surnames, but rather terms which consumers understand to have primarily a surname meaning.¹⁹¹ The term’s similarity to another surname does not determine how consumers will understand the term. Either the consuming public knows the surname significance—and therefore has become accustomed to thinking of it as a surname—or it does not. Each term has its own meanings and creates different commercial impressions for the purchasing public, separate and apart from any meanings associated with a term having a similar sound or spelling. Even if two terms rhyme or have similar endings or syllables, the differences between them may be sufficient to make one sound like a surname and the other not. This is especially true where one term is a common surname, which consumers are accustomed to seeing as a surname, and the other, similar term is rare, and consumers do not know its surname significance. Despite the similarities between the terms, consumers have not become accustomed to seeing the rare surname used as a surname and will therefore not regard it as a surname.

Perhaps apart from these three incompatible approaches, a new conception of the “look and feel” factor would better inform the section 2(e)(4) analysis for rare surnames. Keeping in mind the focus of the section 2(e)(4) test on consumer understanding, one may well interpret the “look and feel” factor as referring not to language patterns, but rather to consumer awareness of the sur-

¹⁸⁶ *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *3 (T.T.A.B. Sept. 20, 2008).

¹⁸⁷ *Id.* at *3.

¹⁸⁸ *Baik*, 84 U.S.P.Q.2d at 1924 (Seeherman, J. concurring).

¹⁸⁹ *In re Curlin Med., Inc.*, No. 78560314, 2008 WL 885932, at *5 (T.T.A.B. Feb. 11, 2008).

¹⁹⁰ *Id.*

¹⁹¹ Lanham Act § 2(e)(4), 15 U.S.C. § 1052(e)(4).

name significance through surname usage of the term. Comparing the structures and pronunciation of different terms can prove quite subjective and, importantly, does little to aid in the analysis of how consumers actually understand the term. But consumers may understand even a rare surname as having the “look and feel” of a surname, not as the result of its similarity to other surnames, but rather as the result of prominent awareness of an individual with the surname, shown for example by substantial media exposure.

As currently conceived, no factor directly incorporates this crucial way of considering the frequency and extent of surname usage, although the Board sometimes mentions it under the rareness or “other meanings” factors.¹⁹² Speakers come to understand meaning through repeated use of a term, such that references in conversations, in news media, or in entertainment to someone, real or fictional, bearing a surname, would expose the public to the surname meaning. Accordingly, the Board sometimes considers whether media exposure of a surname has created substantial public awareness of surname usage.¹⁹³ Media reports showing repeated references to an individual with a rare surname may overcome the presumption that the purchasing public has not heard of the surname because it is rare, depending on the extent of the use and exposure. Such evidence indeed may indicate that the surname has become so well recognized as a surname that consumers consider the primary significance to be as a surname.¹⁹⁴ The Board therefore has repeatedly noted that in some cases a mark,

¹⁹² *Amlin, Baik*, and other cases discuss media exposure of the surname under the rareness factor. *In re Amlin, PLC*, No. 79011475, 2008 WL 4674600, at *3 (T.T.A.B. Sept. 20, 2008); *In re Joint-Stock Co. “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1922 (T.T.A.B. 2007); *In re SieMatic Schweiz GmbH*, Ser. No. 79033882, 2009 TTAB LEXIS 563, at *4–5 (T.T.A.B. Aug. 14, 2009) (not citable as precedent) (evidence of at most 28 unique individuals with surname “sigmann” from nationwide directories and media reports referencing five individuals with surname did not support conclusion that term was primarily merely a surname, as the news stories “do not demonstrate that individuals having the surname Sigmann have enjoyed broad exposure to the general public such that Sigmann is well recognized as a surname”). The Board has also considered the public’s knowledge of the surname through media exposure under the “other meanings” factor. *In re Bonert’s, Inc.*, No. 76627189, 2008 TTAB LEXIS 683, at *9 (T.T.A.B. Mar. 10, 2008) (no evidence that a person with “Bonert” surname had achieved notoriety); *In re IMSA-MEX S.A. de C.V.*, No. 78464418, 2007 WL 954356, at *2 (T.T.A.B. Mar. 22, 2007) (same with “Pintro”).

¹⁹³ *See, e.g., In re Amlin*, 2008 WL 4674600, at *2; *In re Curlin Med.*, 2008 WL 885932, at *2 (“Neither these excerpts, nor those somewhat longer excerpts attached to the denial of the request for reconsideration, show references to any individual of particular note with the CURLIN surname such that the public would be conditioned to recognize this rare surname as a surname.”); *Baik*, 84 U.S.P.Q.2d at 1922.

¹⁹⁴ *See, e.g., In re Tommy Bahama Group, Inc.*, No. 78482456, 2007 WL 411950, at *3 (T.T.A.B. Feb. 1, 2007) (not citable as precedent) (even assuming that “Campolo” is a rare

though not a common surname, may be primarily merely a surname for consumers because the surname has become well-known.¹⁹⁵ The more renowned the individual bearing the name, the more likely it becomes that the public will understand the surname significance.

For example, President Obama has a rare surname, yet Americans will regard the surname significance as the primary significance of “obama.” The 2000 Census on-line records disclosed no references to “Obama.”¹⁹⁶ The WhitePages online nationwide directory revealed only 29 references, including multiple duplicate references to the President.¹⁹⁷ The dictionary contains no non-surname listing for the term “obama,”¹⁹⁸ nor did a search disclose any foreign equivalents. Yet, while the term “obama” is a rare surname, the public knows that “Obama” is a surname. It has come to have the “look and feel” of a surname for consumers as a result of the extensive media exposure of the President. Indeed, the best-known and perhaps only significance of the term to the American public is as the President’s surname.

The primary significance of “Obama” as a surname mandates refusing registration under section 2(e)(4) of applications filed by those attempting to benefit from, or disparage, the goodwill associated with the President’s name. Such a refusal would protect consumers who might think that the President is offering or somehow endorsing the goods or services.¹⁹⁹ This refusal to register would apply to applicants who do not bear the name, not the person of renown with the name. The President himself may register the surname because the goodwill associated with the surname clearly derives from him personally and

surname, its primary significance to the public would be as a surname based on the well-known author, professor and theologian Tony Campolo).

¹⁹⁵ See, e.g., *In re Industrie Pirelli Societa per Azioni*, 9 U.S.P.Q.2d (BNA) 1564, 1565 (T.T.A.B. 1988), *aff’d*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Giger*, 78 U.S.P.Q.2d (BNA) 1405, 1408 (T.T.A.B. 2006) (not citable as precedent).

¹⁹⁶ See *Surnames*, *supra* note 125.

¹⁹⁷ WhitePages, Free People Search, http://www.whitepages.com/search/FindPerson?firstname_begins_with=1&firstname=&name=obama&where= (last visited Mar. 5, 2010).

¹⁹⁸ Dictionary.com, <http://www.dictionary.reference.com/browse/obama> (last visited Feb. 28, 2010).

¹⁹⁹ There have been over a hundred applications for marks consisting of or containing the term “obama,” or a variation thereof. The PTO generally refuses registration under Section 2(c) of the Lanham Act because the applicant has not submitted the consent of the individual to whom the mark refers, namely the President. See, e.g., Office Action, Ser. No. 77699559 (Apr. 14, 2009); Office Action, Ser. No. 79067316 (May 21, 2009); Office Action, Ser. No. 77634691 (Jan. 22, 2009).

registration of the surname would be unlikely to deny anyone else of the rights associated with their name.

Given the fundamental importance of the degree of consumer familiarity of the surname significance in the determination of the primary significance of the term, the section 2(e)(4) analysis must devote space for the consideration of the type and extent of surname usage of the term, particularly in the media. Perhaps the Board may address this consideration under the “look and feel” factor and determine whether consumers know the surname significance so well that they will understand the term as having the “look and feel” of a surname. It is preferable to conceive of the “look and feel” factor in terms of consumer understanding based on evidence of usage, such as media coverage, rather than to use the “look and feel” factor to structurally compare the surname in question to other surnames (“sounds like one”), or to conclude that a term has the “look and feel” of a surname merely because the term has a surname meaning. Neither of these latter approaches explores how consumers actually understand the surname. Approaching the “look and feel” factor with a focus on consumer awareness also keeps the rareness factor in perspective. By recognizing that although consumers are unlikely to understand a rare surname as having surname significance, substantial public exposure to surname usage may condition consumers to view the primary significance of the term as being a surname.

VI. CONCLUSION

The future role of the rareness factor remains uncertain. As noted earlier, out of the decisions from 2007 to present that discuss the rareness factor, the Board only designated *Baik*, a decision which accords great weight to the rareness of a surname and recognizes the rationale behind the factor, as having precedential authority.²⁰⁰ The designation of this decision as precedential may indicate the direction of the Board in the future, but some decisions subsequent to *Baik* have not followed its approach to the rareness factor. This article has argued that the trend expressed in *Baik* offers the better approach to rareness because rareness matters—it indicates that a term is not primarily merely a surname. Consumers cannot understand a term as having a surname meaning when they have never heard it used as a surname, individuals with that surname face no significant impediment to maintain their livelihood as the result of the registration of their surname by someone else, and denying registration of rare surnames unnecessarily restricts the field of available trademarks. However, until the Board resolves its approach to the rareness factor in a more consistent man-

²⁰⁰ See *supra* Section IV.

ner, trademark applicants may find that they lose their investment in a mark that happens to be a rare surname when they receive a refusal of registration.