This Opinion is Not a Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bonhams & Butterfields Auctioneers Corp.

Serial Nos. 85443480 & 85443485

Mary Sotis of Frankfurt, Kurnit, Klein & Selz PC,
for Bonhams & Butterfields Auctioneers Corp.

Sui Duong, Trademark Examining Attorney, Law Office 116,
Michael W. Baird, Managing Attorney.

Before Seeherman, Greenbaum and Hightower,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Bonhams & Butterfields Auctioneers Corp. ("Applicant") has filed two applications to register on the Principal Register the mark BUTTERFIELDS (in standard characters) for

> Auction services in International Class 35, and
>
> Appraisal services in the fields of all tangible personal property and consumer goods in International Class 36.[1]

[1] Application Serial Nos. 85443480 (Class 35) and 85443485 (Class 36) were both filed on October 10, 2011, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

In each application, the Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that BUTTERFIELDS is primarily merely a surname.

Applicant has appealed the refusal of each application. We affirm.

I. Consolidation

We consolidate the appeals because they involve common issues of law and fact. *See* TBMP § 1214 (2016); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997) (Board *sua sponte* considered appeals in five applications together and rendered single opinion). In addition, because the records are essentially identical in each appeal, references to the record in Serial No. 85443480 pertain equally to the other application.

II. Evidentiary Matter

We note that Applicant attached approximately 40 pages of evidence to its appeal briefs. It appears that much (and possibly all) of it is duplicative of Applicant's previously submitted evidence. Rather than engaging in a time-consuming comparison of the attachments to the briefs and the previously-filed material, to determine which material, if any, was not previously submitted and therefore is not properly of record (*see* Trademark Rule 2.142(d)), we have only considered material filed during prosecution of the applications. *See In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1080 (TTAB 2010). In that manner, we have excluded from

consideration material attached to the briefs which is duplicative of earlier filings as well as any newly-submitted, and improper, material.

III. Applicable Law

Section 2(e)(4) of the Trademark Act precludes registration of a mark on the Principal Register which is "primarily merely a surname" without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).[2] A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance to the purchasing public is that of a surname. *See In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). *See also In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). This expression of the test restates the rule set forth in *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) ("[A] correct resolution of the issue can be made only after the primary significance of the mark to the purchasing public is determined …") and *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). In *Darty*, the Federal Circuit considered several factors in determining whether the purchasing public would perceive a proposed mark as primarily merely a surname, including: whether the applicant adopted a principal's name and used it in a way that revealed its surname significance; whether the term had a nonsurname "ordinary language" meaning; and the extent to which the term was used by others as a surname. 225 USPQ at 653. The

[2] As is normally the case with § 1(b) applications such as those at issue here, neither application includes a claim of distinctiveness under § 2(f). See, generally, TMEP § 1212.09 (October 2016).

Board's oft-cited "*Benthin* factors," *see In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995), are also examples of inquiries that may lead to evidence regarding the purchasing public's perception of a term's primary significance.[3] These "factors" are not exclusive and any of these circumstances – singly or in combination – and any other relevant circumstances may shape the analysis in a particular case.[4]

When we are faced with a Section 2(e)(4) refusal of a term in standard character form, with no other literal or design elements, we consider the impact the applied-for term has or would have on the purchasing public because "it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname." *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pat. 1955)).

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[3] In *Benthin*, the Board stated that "factors" to be considered in determining whether a term is primarily merely a surname include (1) the degree of a surname's rareness; (2) whether anyone connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the "structure and pronunciation" of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression. Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

[4] *See Benthin*, 37 USPQ2d at 1333 (stating that notwithstanding the rareness of BENTHIN as a surname, panel "would find" that it "would be perceived as primarily merely a surname" because of lack of other meanings and because it is the name of applicant's Managing Director, but the highly stylized form shifted the balancing of factors to a finding that BENTHIN is not primarily merely a surname).

Whether the primary significance of an applied-for mark is merely that of a surname is a question of fact. *See Darty*, 225 USPQ at 653-54. There is no rule as to the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a surname. This question must be resolved on a case-by-case basis. *Id.* at 654; *see also, e.g., In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986). The entire record is examined to determine the primary significance of a term. If there is any doubt, we "are inclined to resolve such doubts in favor of applicant." *Benthin*, 37 USPQ2d at 1334.

Because the Examining Attorney and Applicant focused their arguments on the first four *Benthin* factors, we review each in turn, but in making our determination we weigh them together and accord the appropriate weight to each one based on the evidence of record.[5]

A. Whether BUTTERFIELD/BUTTERFIELDS is Commonly or Rarely Used as a Surname

We first consider the frequency with which BUTTERFIELD, in the singular, is encountered and recognized by the public as a surname.

In order to show that BUTTERFIELD "is not so unusual that [its] surname significance would not be recognized by a substantial number of persons," *Miller v. Miller*, 105 USPQ2d 1615, 1620 (TTAB 2013), the Examining Attorney submitted ten pages of search results from a Lexis/Nexis nationwide telephone directory showing

[5] No other factors are discussed by Applicant or the Examining Attorney; nor is there evidence that implicates the probative significance of any other possible factor or circumstance.

the first 200 of 3,450 listings for individuals with the surname BUTTERFIELD in the United States.[6] Although Applicant suggests that these 200 results include many duplicate entries, Applicant has identified none.

Applicant also contends that the Examining Attorney only made of record the first 200 listings, and therefore Applicant has no way of knowing if the remaining results contain duplicative or otherwise questionable results. However, this Board frequently has taken the position that, when there are a large number of items retrieved by a search, it is necessary only to submit a representative sample. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) ("[A]s part of the Board's longstanding practice, parties are permitted to submit a representative sample of relevant articles obtained from an Internet database search. A party is under no obligation, and indeed is discouraged, from making all search results of record. Only a relevant, representative sample need be submitted.") (citation omitted); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011) ("There is no requirement for the examining attorney to submit all the evidence that supports his position and, indeed, the Board would be very critical if the examining attorney were to submit an inordinate number of registrations."); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("The Board has frequently stated, in connection with the submission of articles retrieved by a NEXIS search, that it is not necessary that all articles be submitted…. The same is true for materials retrieved through Internet searches.").

[6] Attached to August 23, 2012 Final Office Action in each application.

We consider the Examining Attorney's submission of 200 actual listings, and his representation as to the total number of listings, to be sufficient. Moreover, a review of this submission shows that the listings include households in approximately 40 different states. If Applicant harbored any doubts about the accuracy of the 200 listings of record or the other 3,250 listings, Applicant could have submitted rebuttal evidence. Applicant did not do so. *Cf. In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1720 (TTAB 2016) (neither the applicant nor the examining attorney "attempted to tabulate the non-duplicative listings [from switchboard.com and 411.com] so as to propose to the Board an accurate count of relevant listings.").

In addition, we take judicial notice of data from the 2000 census demonstrating 11,244 occurrences of "Butterfield" as a surname.[7]

The Examining Attorney also submitted an Internet printout from the All Music website <allmusic.com> of a biography of musician Paul Butterfield[8] and many newspaper articles from the Lexis/Nexis database referring to the Paul Butterfield

[7] Retrieved from the website of the U.S. Census Bureau <http://www.census.gov/topics/population/genealogy/data/2000_surnames.html>. It is well established that this Board may exercise discretion to take judicial notice of census data. *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008); *In re Spirits Int'l N.V.*, 86 USPQ2d 1078, 1085 n.11 (TTAB 2008). However, rather than relying on judicially noticed facts and evidence, we encourage both applicants and examining attorneys to submit during prosecution all relevant evidence that is the proper subject of judicial notice, to allow each other "a fair opportunity to meet the evidence." *In re Francis Indus., Inc.*, 199 USPQ 568, 569 n.3 (TTAB 1978). For more information about judicial notice in *ex parte* cases, see TBMP § 1208.04, and cases cited therein.

[8] Attached to January 30, 2012 Office Action.

Blues Band.[9] There are also articles from the Lexis/Nexis database about Brian Butterfield, a major league baseball coach.[10] However, in most of the articles, the individual is mentioned only in passing and is not the focus of the article. As a result, the articles are not probative to show significant public exposure to Butterfield as a surname.

The directory, census, and All Music evidence collectively show that BUTTERFIELD is not rarely used as a surname, and they collectively demonstrate that the public has been exposed to and will perceive BUTTERFIELD as a surname.

We recognize that the applied-for mark is BUTTERFIELDS, with the final letter "S," and that the record evidence discussed above pertains to BUTTERFIELD in its singular form. In fact, Applicant attempts to rebut the evidence of surname significance by arguing this point.[11]

This Board previously has recognized that individuals frequently use their surnames, in singular, plural or possessive form, in connection with their businesses. *In re Luis Caballero, S.A.*, 223 USPQ 355, 357 (TTAB 1984) (BURDONS primarily

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[9] Attached to August 23, 2012 Final Office Action and April 11, 2013 Denial of Request for Reconsideration (5-9 TTABVUE). We have only considered articles that were published in U.S. newspapers.

[10] 10-13 TTABVUE.

[11] For this and other propositions, Applicant relies heavily on non-precedential decisions from this Board, to which the Examining Attorney has objected. Although parties may cite to non-precedential decisions, and therefore the Examining Attorney's objection is overruled, the practice is not encouraged. *Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1742 n.24 (TTAB 2014) (citing *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011)). Further, because the decisions have no precedential effect, this Board generally will not discuss them in other decisions, a practice that we follow in this opinion. *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011).

merely a surname based in part on telephone listings for BURDON; it did not matter that the mark is a plural form of the name); *In re Directional Mktg. Corp.*, 204 USPQ 675, 677 (TTAB 1979) ("However, we cannot shut our eyes to the facts that stores frequently use a possessive letter 'S' on the end of their names or marks without an apostrophe; that purchasers may thus well regard applicant's mark 'DRUMMONDS' as a possessive form of 'Drummond' ...."); *see also In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009) ("As to the mark in possessive form, BINION'S, the surname significance of a term is not diminished by the fact that the term is presented in its possessive form."). Accordingly, we do not find Applicant's arguments persuasive.

B. Whether BUTTERFIELD/BUTTERFIELDS is the Surname of Anyone Connected with Applicant

Applicant submitted an Affidavit from Lisa Gerhauser, Applicant's Vice President and General Counsel, stating that "no living individual associated with Applicant uses the term BUTTERFIELD/S as a surname."[12] Applicant acknowledges that Applicant's founder had the surname Butterfield,[13] and an article from the March 8, 2008 *San Francisco Chronicle*, submitted by the Examining Attorney,[14] reflects this corporate history ("William Butterfield's auction business opened in 1865, supplied by goods aboard the ships full of gold-seekers that sailed into San Francisco."). However, there is no evidence that Applicant publicizes this connection, for example,

[12] Attached to July 30, 2012 Response to Office Action, ¶ 4.

[13] 16 TTABVUE 8-9.

[14] Attached to August 23, 2012 Final Office Action. This is the only evidence of record that mentions William Butterfield.

on Applicant's webpage, in advertisements, or via social media. Nor is there evidence that present day consumers would understand that the term BUTTERFIELDS is associated with Applicant's founder. The Board recently addressed the virtually identical argument in *Adlon* as follows:

> [t]he apparent absence of a person named ADLON in Applicant's current management does not, in itself, reduce the likelihood that the public would perceive the mark as a surname. By contrast, if a person named ADLON were associated with the business and that association were promoted to the public, it would enhance the public's perception of the term as a surname. *See In re Integrated Embedded*, 120 USPQ2d 1504, 1507 (TTAB 2016) (where promotional materials of applicant promoted the credentials and accomplishments of its founder Mr. Barr, this reinforced the likely public perception of BARR as a surname).

Adlon, 120 USPQ2d at 1724. *See also In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278-80 (TTAB 2016) (applicant's website and specimen touted multi-generational connection of Aldecoa family with coffee). Therefore, we cannot conclude that consumers would perceive BUTTERFIELDS as a surname because of this early connection.

C. Whether BUTTERFIELD/BUTTERFIELDS has any Recognized Non-Surname Significance

To show that BUTTERFIELD has other, non-surname significance, Applicant points to four U.S. towns or townships named BUTTERFIELD, and an entry from the *Urban Dictionary* defining BUTTERFIELD variously as "growing very tall," "playing an obscure musical instrument with skill," and "seemingly communicating telepathetically [sic] in order to cheat at games."[15] In addition, Applicant points to

[15] Attached to July 30, 2012 Response to Office Action.

evidence from the website IMDB.com[16] to support its argument that "Butterfield 8 was the shorthand term phone operators used for the dialing prefix BU-8" as well as the title of a book that was adapted into a "well-known movie starring Elizabeth Taylor and Eddie Fisher, for which Taylor won her first Academy Award."[17] Applicant also points to a listing in the online version of *New York Magazine* of a restaurant named "BUtterfield 8"[18] as evidence that "'Butterfield 8' is also the name of a popular New York City restaurant and bar inspired by the film and novel." [19]

Contrary to Applicant's argument, the mere existence of non-surname meanings of the mark does not preclude a finding that the mark is primarily merely a surname. "To be considered primarily merely a surname, a term does not have to be devoid of any non-surname significance." *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1567 (TTAB 2005). As this Board stated in *Miller*:

> The question is not whether a mark having surname significance might also have a non-surname significance, but whether, in the context of the goods or services at issue, that non-surname significance is the mark's primary significance to the purchasing public, thus eclipsing and relegating the mark's surname significance to secondary rather than primary status.

Miller, 105 USPQ2d at 1621 (citations omitted). "Thus the determining factor is the primary (not secondary) significance to the public…." *Harris-Intertype*, 186 USPQ at 239. *See also Darty et Fils*, 225 USPQ at 653 ("The statute … reflects the common law

[16] 4 TTABVUE 21-24.

[17] 16 TTABVUE 11-12.

[18] 4 TTABVUE 26.

[19] 16 TTABVUE 12.

that exclusive rights in a surname per se can not be established without evidence of long and exclusive use which changes its significance to the public from a surname of an individual to a mark for particular goods or services.”).

Applicant’s arguments and evidence are not persuasive. First, the four towns named BUTTERFIELD are small, with a combined population of approximately 1,700, and their existence does not establish either that the primary meaning of “Butterfield,” to most consumers, is as a geographical term, or that most consumers would even be aware of the existence of these towns. *See Harris-Intertype*, 186 USPQ at 239, in which HARRIS was found to be primarily merely a surname, despite the fact that HARRIS was the name of several small towns.

Second, there is no evidence that BUTTERFIELD appears in any mainstream dictionary of record. The *Urban Dictionary* appears to be located on a website on which people both provide definitions and comment on those provided by others, and therefore has limited probative value. *See In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013) (“Our consideration of the Urban Dictionary definitions is with the recognition of the limitations inherent in this dictionary, given that anyone can submit or edit the definitions.”). Further, the entry on which Applicant relies shows 21 “thumbs up” and 11 “thumbs down.” We take this “thumb count” as evidence of a lack of user consensus regarding the listed slang meanings. Applicant points to identical definitions from the websites <soslang.com>[20] and

[20] 4 TTABVUE 17-18.

<dictionaryupdate.com>[21] as corroboration of the *Urban Dictionary* entries. However, this evidence is somewhat suspect, given the very casual nature of the entries.[22]

Third, while a reference to "Butterfield 8" might evoke the movie and novel of the same name, the applied-for mark is not BUTTERFIELD 8. The existence of the movie and novel "Butterfield 8" does not make BUTTERFIELD *per se* something other than a surname. As for the defunct telephone exchange BUTTERFIELD, there is no evidence that this long-ago exchange name would be understood by consumers today. In this respect, the Board's decision in *Adlon*, is instructive. There, the Board found that rather than demonstrating that the former Hotel Adlon in Berlin "is so historically prominent that the hotel significance of ADLON has supplanted the surname significance," evidence that the hotel bore the founder's surname and continued to promote its connections with the Adlon family "shows the term ADLON used in a context that actually suggests that the term is a surname." 120 USPQ2d at 1722-23. Moreover, evidence concerning the contemporary Hotel Adlon Kempinski in Berlin was not "so prominent that its name has supplanted the surname significance of the term ADLON standing alone." *Id.*

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[21] 4 TTABVUE 19.

[22] For example, one of the four contributors to the <soslang.com> website "defines" "Butterfield" as a small town in Minnesota, listing "Reasons to live here – grew up here and don't know any better" and "Reasons to leave – every reason you can imagine"; another contributor states that Christopher Butterfield is a hacker who "will steal your myspace/facebook/twitter passwords"; and a third contributor states that "[d]uring his early work," Dr. Butterfield "even began to sprout wings and proclaim himself to be the winner for the foundation of the winged horse jumping competition of 1175 AD." 4 TTABVUE 17-18.

D. Whether BUTTERFIELD/BUTTERFIELDS has the Structure and Pronunciation of a Surname

As evidence that Applicant's proposed mark BUTTERFIELDS has the structure and pronunciation of a surname, the Examining Attorney submitted evidence of other common surnames that end with the word "field" (Hatfield, Mayfield and Whitfield).[23] In response, Applicant contends that "BUTTERFIELDS is just as similar to surnames that end in 'field' as it is to other words that end in 'fields' such as coalfields, cornfields, minefields, playfields, and hayfields."[24] However, this argument is inapposite because it conflates the third *Benthin* factor, where we consider whether the term has other recognized non-surname meanings, with the fourth *Benthin* factor. Under the fourth *Benthin* factor, that a term is similar to other surnames in structure and pronunciation may be probative of whether the public would recognize the term as a surname, and that is so even if the term also is similar to other common words. On the other hand, if a term is not similar to other surnames in structure and pronunciation, the lack of similarity may be probative of likely perception of the term as something other than a surname. We are persuaded by the Examining Attorney's evidence that BUTTERFIELDS has the structure and pronunciation of a surname.

E. Third-Party Registrations for BUTTERFIELD

Applicant argues that the refusal should be reversed because "numerous" other BUTTERFIELD marks already exist on the Principal Register with no claim of

[23] Attached to August 23, 2012 Final Office Action.

[24] 16 TTABVUE 13.

acquired distinctiveness pursuant to Section 2(f).[25] During prosecution, Applicant provided a list of seven such registrations, but did not submit copies of the registrations.[26] However, the Examining Attorney did not object to this evidence or otherwise advise Applicant that the list was not sufficient to make the registrations of record at a point when Applicant could have cured the insufficiency.[27] The Examining Attorney therefore has waived any objection as to the admissibility of the list, and we will consider the list of registrations for whatever probative value it may have. *See In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).

As the Examining Attorney correctly points out, of the seven listed registrations, only one is for BUTTERFIELD alone; the other six are for multiple word marks or composite word and design marks. In many cases, a mark in which a surname is combined with a descriptive, suggestive, or arbitrary term, or with other matter, has been found not to be primarily merely a surname. *See, e.g., Integrated Embedded*, 120 USPQ2d at 1509-1510 (consumers would perceive various third-party BARR-inclusive marks as not primarily merely surnames when, for example, they constituted plays on words, or had distinctive design elements); *Hutchinson*, 7 USPQ2d at 1493 (holding HUTCHINSON TECHNOLOGY for computer components

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[25] 16 TTABVUE 14.

[26] July 30, 2012 Response to Office Action.

[27] *See* TBMP § 1208.02 ("if an applicant includes a listing of registrations in response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have waived any objection to consideration of the list itself….").

not primarily merely a surname when the mark is considered as a whole; case remanded for entry of a disclaimer of "TECHNOLOGY" before publication); *Benthin*, 37 USPQ2d at 1334 (stylized display of term BENTHIN weighed against a finding that consumers would perceive the term as primarily merely a surname). Thus, these six third-party registrations are not probative because Applicant's mark is just BUTTERFIELDS, with no additional matter. As for the registration for BUTTERFIELD *per se*, this single registration is not sufficient to overcome the other evidence of record.

IV. Conclusion

Viewing these factors together, we find that BUTTERFIELD is primarily merely a surname, and that the addition of an "S" to this term does not change that significance. In reaching this conclusion, we have carefully considered all of Applicant's arguments and evidence, even if not specifically discussed herein, but have not found them persuasive.

Decision: The refusal to register Applicant's mark BUTTERFIELDS is affirmed in each application.

Seeherman, Administrative Trademark Judge, concurring:

I concur with the result reached by the majority that BUTTERFIELDS should be refused registration because it is primarily merely a surname. However, I disagree with some of the majority's analysis, particularly as it relates to the effect of the

rareness of a surname on the determination of whether a mark should be refused registration on the ground that it is primarily merely a surname.

The majority follows the reasoning of several decisions recently handed down by the Board, namely *In re Integrated Embedded*, *In re Eximius Coffee* and *In re Adlon*, cited in the majority opinion. In those decisions, the Board makes it clear that a mark will be found to be primarily merely a surname as long as there is evidence that some people have that surname, no matter how rare the surname is, as long as it is perceived as a surname. The opinions now use the language whether the term is "encountered" as a surname, rather than "the degree of a surname's rareness," the language quoted in *Benthin* from *In re Garan Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987). See, for example, *Eximius Coffee*, 120 USPQ2d at 1280, which addresses this factor with the subheading, "Whether ALDECOA Is Rarely Encountered As a Surname." The majority has employed similar language, considering whether the mark is "encountered and recognized by the public as a surname." p. 5 *supra*.

I accept that the Board can and should consider the factors as discussed in the majority opinion in terms of purchaser perception, since if consumers do not perceive a mark as primarily merely a surname it should not be prohibited from registration under Section 2(e)(4). However, before considering whether consumers would view the mark to be primarily merely a surname, I think the Board must first determine whether there are a sufficient number of people with a particular surname for the mark to even rise to the level of a surname. That is, there must first be a showing

that there is some threshold number of people with that surname to make out a *prima facie* case for refusal under Section 2(e)(4).

The approach, articulated in the majority opinion and the recent Board decisions on which the majority opinion relies, of considering only whether the mark will be perceived as a surname, ignores the purpose behind why the statute prohibits the registration of surnames. "The 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." *Binion*, 93 USPQ2d at 1540.[28] *See also Kimberly-Clark Corp. v. Marball*, 94 F. Supp. 254, 88 USPQ 277, 279 (D.D.C. 1950) ("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 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."). As explained by the Federal Circuit Court of Appeals in *Darty et Fils*, 225 USPQ at 653, the

[28] In *Eximius Coffee* the Board, although noting that some Board cases had indicated a legislative purpose of Section 2(e)(4) was to protect individuals to be able to use their own names in connection with their businesses, relied on a statement made by Assistant Commissioner Leeds in *Ex parte Rivera*, 106 USPQ at 147, that "The legislative history of the statute, including the testimony of the witnesses before the Congressional Committees, is just about as confused as the decisional law." *Eximius Coffee*, 120 USPQ2d at 1282, quoting *ex parte Rivera*, 106 USPQ at 147. That statement was made in a case in which there was no question that the mark, RIVERA, is a surname, and the issue was whether, because it is also a Spanish word for a small stream, it was not "primarily merely" a surname. Accordingly, the statement in *Rivera* should not be used as a basis for casting doubt on the statements in *Binion* and other Board cases as to the legislative purpose of the statutory prohibition.

common law "recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business."

During the hearings on the bills that eventually became the Lanham Act, the testimony shows that Congress was not trying to prevent the registration of surnames *per se*; one witness pointed out that "almost every word you can think of is somebody's surname, somewhere" and to refuse the registration of a term because "it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice." *Hearings on H.R. 4744 Before the Subcomm. Trade-Marks of the House Comm. on Patents*, *76th Cong., 1st Sess.* (1939) at 40.

Although, as *Darty* says, the common law "recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business," 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. The chance that an individual with a rare surname would have a need to use the surname in his or her business, and that he or she would be prevented from doing so by the registration of that name by another for particular goods or services, is extremely remote. As I stated in my concurring opinion in *In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1924 (TTAB 2007), "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." 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.

In short, if the surname is rare, there is no need to keep it available for anyone with that surname simply because there is a theoretical possibility that another might wish to use the surname for goods or services related to those of the applicant. The Federal Circuit appears to have recognized that this should be a consideration in the surname analysis by its statement in *Darty,* made in connection with evidence that the surname appeared in a number of telephone directories across the nation:[29] "Nor can the interests of those having the surname DARTY be discounted as de minimis." 225 USPQ at 653. Although in that case the evidence was sufficient to show that DARTY was not a rare surname, the obvious corollary is that, if there are very few people with a particular surname, the chance that any would be affected by the registration of the surname by a particular applicant for particular goods or services is *de minimis*.

The Lanham Act, and the courts' interpretation of it, has never been as rigid with respect to other grounds of refusal as the Board's test now appears regarding

[29] At the time the *Darty* decision issued in 1985, the Patent and Trademark Office relied on a sample of telephone directories to show that a mark was a surname. The Board and its primary reviewing court would essentially extrapolate from such directory evidence that additional directories would list additional names. Because the Office now has access to much more complete databases, which can easily be searched by computer, it can be determined with much greater precision the number of people in the entire United States who have a particular surname.

surnames, i.e., if a mark would be perceived as a surname, no matter how rare, Section 2(e)(4) is an absolute bar to its registration.[30] In an analogous situation, in determining whether there is a likelihood of confusion under Section 2(d) of the statute, the case law teaches us that it is a *likelihood* of confusion, not a theoretical possibility of confusion, which we must consider. "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969), quoted with approval in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

However, under the Board's current approach to Section 2(e)(4), the *perception* of the mark controls, without any consideration given to whether there is a real need to keep a mark available because there are others with that surname who wish to use it for the same or related goods or services. The logical extension of that approach is that, if an examining attorney can show that there are even just a handful of people with a particular surname, but there are also a number of widely read articles prominently mentioning some of those people, the mark must be refused as being primarily merely a surname.[31]

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[30] As the majority has pointed out, marks refused under Section 2(e)(4) can be registered through resort to the provisions of Section 2(f) if an applicant can demonstrate acquired distinctiveness.

[31] To the extent that a rare surname is also the surname of a famous person, such that there is wide exposure of the name to the public, I would argue that the proper refusal of such a mark would be under the false suggestion of a connection portion of Section 2(a), since the

Another problem with limiting the analysis to public perception of the mark, without first determining whether it should even be considered to be a surname due to its rarity, occurs when we consider the "structure and pronunciation" factor (often referred to as whether the mark has the "look and feel" of a surname). I have previously, in my concurring opinion in *In re Joint-Stock Co. "Baik,"* 84 USPQ2d at 1924, criticized the idea that a mark should be refused as being primarily merely a surname simply because it rhymes with a surname or differs from a surname by one or two letters. However, under the Board's current approach, a rare surname could be refused registration, even if there has been almost no exposure of that surname to the public, so long as the term looks like a surname in terms of structure, and has no other meaning or carries any suggestion that it is a coined word, since it would be perceived by consumers to be a surname.

Accordingly, in my view, the rareness of a surname must be part of the threshold question of whether there is sufficient evidence of surname use for the mark to qualify as being a surname, and only if the answer to that question is "yes" should the analysis reach a consideration of whether the mark will be recognized as a surname.[32]

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public would associate the surname with the particular famous person, rather than viewing it as a surname in general.

[32] In past decisions I have treated the rareness of a surname as part of the consideration of the first *Benthin* factor. Although I have always viewed the rareness of the surname as the primary factor that should be considered, such that if the surname is rare, that should be determinative, my thinking has evolved. I can understand the logic of viewing the factor of the rareness of the surname in terms only of the perception of whether the mark is a surname. But I submit this has to be done in conjunction with first determining whether a mark rises to the level of a surname, or we are left with absurd results, such as those I have suggested above.

Although, for the reasons discussed above, I disagree with the analysis articulated by the majority, the evidence in this case shows that BUTTERFIELD is not a rare surname and it does not have a significant non-surname meaning. Further, the addition of the "S" to BUTTERFIELD in Applicant's mark does not change the surname significance. Therefore, I concur in the result, and agree with the majority that BUTTERFIELDS is primarily merely a surname and that the refusal of registration under Section 2(e)(4) should be affirmed.