

# THE DAILY RECORD

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## IP FRONTIERS

### The limited right to use your own name

What do barbeque sauce, wine and law firms have in common? Each frequently finds themselves at the center of legal disputes over the right to use and/or register one's family name (or "surname") as a trademark. Indeed, our region is no stranger to this controversial issue. See *The Taylor Wine Company, Inc., v. Bully Hill Vineyards, Inc.*, 590 F.2d 701 (2d Cir. 1978)(injunction granted which prohibited defendant, Walter S. Taylor, from using the Taylor family name as a trademark and placed restrictions of how his signature could be used on wine labels).

Trademark infringement suits over surnames typically stem from two situations: (1) disputes over the use of a family name by a "junior user," in particular where the original trademark has acquired considerable good will; or (2) common surnames which are being used by two different companies with similar profiles.

#### Factors considered to determine registrability

The right to trademark and/or use one's own family name is not an absolute right and the guiding principles are anything but straightforward. As a general rule, last names, i.e., "surnames," cannot be registered as trademarks as the federal trademark rules prohibit registration of trademarks that are primarily, or predominantly, merely a surname. See Lanham Act, Section 2(e)(4). Furthermore, even if you are successful in registering your name, it can be difficult to stop others from using it because, for the most part, the trademark laws favor the right of a person to use his or her name as a source identifier for their goods or services.



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To register a surname as a trademark in connection with a business, the Trademark Office considers multiple factors in evaluating whether a trademark will be perceived as predominantly a "surname":

- (i) Is the proposed trademark a common surname, or is it rare? If rare, this weighs in favor of registration;
- (ii) Is the proposed trademark the applicant's last name? If not, this weighs in favor of registration;
- (iii) Does the proposed trademark have any other recognized meaning(s) other than a surname? If yes, this weighs in favor of registration;
- (iv) Does the proposed trademark "look and feel" like a surname? If yes, this weighs against registration; and
- (v) Is the proposed trademark sufficiently stylized or otherwise distinctive, and thus not primarily merely a surname? If yes, this weighs in favor of registration.

See Trademark Manual of Examining Procedure (TMPEP) 1211.01; see also *Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013) (precedential). Ultimately, the question that must be answered is would the public recognize or perceive the proposed trademark as a surname. If the proposed trademark is held to be "primarily merely a surname" under the above analysis, it will be refused registration on the Primary Register.

Two recent cases have shed some light

on how the Trademark Trial and Appeal Board (hereinafter "TTAB") is treating the "surname" trademark issue (and, arguably, the unintended significance of an apostrophe). In *Azeka Building Corp. v. Brian Kenji Azeka*, 122 USPQ2d 1546 (TTAB 2017) (precedential), the applicant sought to federally register AZEKA'S RIBS as a trademark for use with barbecue sauce. The opposer, a relative of the applicant, opposed registration of AZEKA'S RIBS arguing, among other things, that the proposed trademark was a surname. The TTAB agreed and refused registration. In refusing the registration, the TTAB focused on the public's perception of the name, including the fact that it contained an apostrophe "s," which signaled to consumers that it was a surname; the fact that "Azeka" was applicant's surname; and that AZEKA had no other meaning. Other evidence introduced included approximately 866 individuals using the last name "Azeka" and three websites that demonstrated use of the term "Azeka" as a surname.

In *In re Beds & Bars Limited*, 122 USPQ2d 1546 (TTAB 2017) (precedential), the TTAB affirmed the Examining Attorney's refusal to register BELUSHI'S. In evaluating whether the applied-for trademark was "merely a surname," and therefore not registrable as a trademark, the TTAB focused on (1) the fame of the "Belushi Brothers," arguing that fame increased the public's awareness of "Belushi" as a surname; and (2) the use of the apostrophe "s" in the proposed trademark, which connoted use as a surname to the

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public. Based on these two factors, the TTAB refused registration under Section 2(e)(4), even though evidence was presented that the name “Belushi” is rare (only a handful of individuals share this last name) and the applicant’s last name was not “Belushi.”

### **Acquired distinctiveness exception**

The restriction against registering surnames as trademarks is not that simple. Not surprisingly, there is an exception to the general rule that surnames are not protectable as trademarks. Namely, the U.S. Trademark Office will register a surname if it has “acquired distinctiveness,” sometimes referred to as “secondary meaning.” See, e.g. *Brennan’s, Inc. v. Brennan’s Rest., LLC*, 360 F.3d 125, 131 (2d Cir. 2004) (BRENNAN’S trademark held to have achieved distinctiveness via history and unsolicited media). Once secondary meaning for a surname has been established, it can be registered and used to stop others from using their own name in connection with similar goods or services, provided such use might cause consumer confusion. This is why names like Trump, Disney, Gucci and Ford are registered trademarks. Under these circumstances, a person’s right to use his or her own name becomes much more complicated and can result in complex, lengthy and very expensive legal suits.

Establishing proof of acquired distinctiveness can be prohibitively expensive and frequently cannot be met. The applicant needs to submit proof of length and exclusivity of use, advertising and mar-

keting expenditures, prior registrations for similar goods or services, unsolicited media coverage, sales success and/or expensive consumer surveys in order to sufficiently establish the proposed trademark has acquired distinctiveness and is perceived by the public as a source identifier. In some limited circumstances, five years of continuous use may be sufficient to establish acquired distinctiveness without the need to submit other evidence. See Lanham Act, Section 2(f). But, typically, proving acquired distinctiveness is a heavy and expensive undertaking with uncertain results.

### **Practice tips**

While it may seem counterintuitive, there is no inalienable right to use one’s own name as a trademark. And, while using a family name may seem important and an obvious choice, one should weigh the risks and benefits of using a surname as a trademark. Given the uncertainty surrounding trademark rights associated with surnames, they are not always the best choice and it may be advisable to select an alternate trademark, i.e., one that is more unique or “distinctive,” and thus easier to use, register and/or enforce as a trademark.

In reality, despite the risks of using a surname commercially, many will continue to do so. In those cases, it is important to evaluate the pros and cons of seeking a trademark registration before filing; perform a trademark search; and carefully craft the trademark application in the best way possible to avoid a surname refusal. For example, some ways to avoid a surname refusal

include one or more of the following: (1) combining two or more names (i.e. “Smith and Wesson”); (2) combining a nondescriptive, distinctive word with a surname; (3) avoiding the use of apostrophe’s, which the Board recently has used to affirm surname refusals; (4) using your first name or initials with your last name; and/or (5) including a design component. If the Principal Registration does not work, the Supplemental Register may be an alternate option.

Also, be sure any agreements regarding assignment or shared use of the trademark are in writing, even if between family members. For example, in the recent *Stubbs* barbeque case, the original 1996 agreement regarding shared use of the trademark STUBBS for prepared food (i.e. barbeque sauce) vs. barbeque restaurants services was an informal “handshake” agreement. While the informal agreement worked well for several years, it ultimately ended in a lengthy and expensive litigation, followed by settlement wherein Stubbs Austin Restaurant Company had to change its name.

Finally, remember that when it comes to family conflicts over use of a name, a court’s ultimate goal is to minimize a likelihood of confusion to the public in connection with a registered trademark, while protecting a junior family member’s right to use his or her surname in commerce.

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