

This Opinion is not a
Precedent of the TTAB

Mailed: May 27, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Nash Studio Inc.
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Serial No. 79284379
—

Rebecca Gan of Wenderoth LLP
for Nash Studio Inc.

Marco Masullo, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Zervas, Adlin and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Nash Studio Inc. (“Applicant”) seeks registration on the Principal Register of the proposed mark SOUND ART CREATION NASH STUDIO (in standard characters) for

Downloadable music files; pre-recorded audio compact discs featuring music and sound; downloadable music files, namely, downloadable music files; pre-recorded digital media devices featuring sound and music; phonograph records featuring sound and music; electronic circuits and multimedia software pre-recorded on CD-ROMs featuring automatic performance programs for electronic musical instruments; electric and electronic effects units for

musical instruments; audio interface; audio mixer; audio and video receivers; sound reproduction apparatus; sound transmitting apparatus; portable media player; subwoofers; headphones; recorded computer programs for processing digital music files; downloadable computer programs for processing digital music files; recorded computer software for creating and editing music and sounds; downloadable computer software for creating and editing music and sounds; downloadable electronic publications in the nature of books in the field of music; recorded electronic publications in the nature of books in the field of music; downloadable image files containing artists and musicians; recorded video discs and video tapes featuring music videos; recorded game programs for home video game machines; downloadable game programs for home video game machines; electronic circuits and multimedia software recorded on CD-ROMs featuring game programs for hand-held games with liquid crystal displays in International Class 9.¹

Production of music; record mastering; songwriting; providing online non-downloadable music and online non-downloadable sound effects being sound recordings in the nature of entertainment services; educational and instruction services relating to music, namely, education in the field of music rendered through video conferences and correspondence courses; educational and instruction services, namely, providing classes relating to arts, crafts, sports or general knowledge; arranging and conducting of seminars; providing non-downloadable electronic publications in the nature of books in the field of music; services of reference libraries for literature and documentary records, namely, providing online research and reference services via an on-line computer network by

¹ Application Serial No. 79284379 was filed on January 10, 2020 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), requesting an extension of protection based on Applicant's International Registration No. 1527821, registered January 10, 2020, with a priority date of December 13, 2019.

Page references to the application record refer to the online database pages of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Applicant's brief is at 8 TTABVUE. The Examining Attorney's brief is at 10 TTABVUE.

librarians and reference services specialists for literature and documentary records; book rental; arranging and planning being planning arrangement of showing movies, shows, plays or musical performances; providing facilities for movies, shows, plays, music or educational training; providing audio or video studio services; rental of musical instruments; movie theatre presentations being movie showing; movie film production and distribution; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; direction of making radio and television programs; operation of video and audio equipment for production of radio and television programs; rental of music recordings; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes in International Class 41.

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

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Evidentiary Issue

We turn first to an evidentiary objection raised by the Examining Attorney in his brief. Applicant submitted with its brief, for the first time, a printout from Wikipedia. Applicant has asked that we take judicial notice of geographic place names which include "Nash" listed in the Wikipedia article.

² The Examining Attorney during prosecution was Sarah Hopkins.

The Board previously addressed the admissibility of Wikipedia evidence in *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007) and determined that “[t]here are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries.” Because there is some question regarding the accuracy of information that may be obtained from Wikipedia, it is not a source from which the Board may take judicial notice. Rather, this type of evidence must be offered into the record at a time when the non-offering party will have an opportunity to rebut the evidence. *Id.*

Therefore, we do not take judicial notice of the Wikipedia printout listing geographic place entries under “Nash.” The Wikipedia printout is untimely submitted evidence and will not be given further consideration. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). (“The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.”).

II. Section 2(e)(4) Refusal

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). 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 Earnhardt v. Earnhardt, Inc.*, 846 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017).

Whether the primary significance of an applied-for term is merely that of a surname is a question of fact. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653-54 (Fed. Cir. 1985). There is no rule as to the kind or amount of evidence necessary to show that a term 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.” *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

To determine whether the purchasing public would perceive the term NASH as primarily merely a surname, we consider several inquiries including: (1) whether anyone connected with Applicant has this surname; (2) whether the term has a non-surname “ordinary language” meaning; and (3) the extent to which the term is used by others and encountered as a surname. *Darty*, 225 USPQ at 653; *In re tapio GmbH*, 2020 USPQ2d 11387, at *8-9 (TTAB 2020).

In addition to the list of examples of inquiries articulated in *Darty*, the Board articulated two additional examples of inquiry in *In re Benthin*, 37 USPQ2d at 1333-34, (4) whether the term has the “structure and pronunciation” of a surname; and (5) whether the stylization of lettering is distinctive enough to cause the mark not to be perceived as primarily merely a surname. These inquiries 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. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016); *see also In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016).

III. Record

The Examining Attorney submitted evidence from the LEXISNEXIS® surname database showing NASH appearing 124,244 times as a surname.³ The Examining Attorney also provided an entry from Wikipedia that identifies NASH as a surname of “Irish, English, Welsh or Jewish origin” and Wikipedia pages showing a list of “notable people” with the surname NASH, including Johnny Nash, an American singer and songwriter, American poet Ogden Nash, Joe Nash, a former NFL professional football player, Steve Nash, a former professional basketball player, and singer-songwriter Graham Nash.⁴ The Examining Attorney submitted “negative” dictionary evidence for the term NASH that does not identify any ordinary language meaning for the term.⁵ The Examining Attorney submitted a copy of Applicant’s expired Supplemental Registration for NASH and a copy of Applicant’s stylized

The logo for the NASH trademark, featuring the word "NASH" in a bold, black, hand-drawn, brush-stroke style font. The letters are slightly irregular and have a textured appearance.

mark registered on the Principal Register under Section 2(f), 15

U.S.C. § 1052(f).⁶

³ May 28, 2020 Office Action at TSDR 13-38.

⁴ September 3, 2020 Denial of Reconsideration at TSDR 4-7.

⁵ May 8, 2020 Office Action at TSDR 2.

⁶ September 3, 2020 Denial of Reconsideration at TSDR 11-16.

The Examining Attorney submitted the following dictionary definitions:⁷

Sound: “Auditory material that is recorded.”

Art: “The conscious use of the imagination in the production of objects intended to be contemplated or appreciated as beautiful, as in the arrangement of forms, sounds, or words.”

Creation: “The act of creating.”

The Examining Attorney quoted, in the May 8, 2020 Office Action at TSDR 1, the definition of “studio” from American Heritage Dictionary as

“An establishment where an art is taught or studied,” “A room, building, or group of buildings where movies, television shows, or radio programs are produced,” “A room or building where tapes and records are produced,” and “A company that produces films.”⁸

The Examining Attorney also submitted evidence from online magazines, research papers, organizations, and one individual that use the wording “sound art creation” (emphasis supplied below):⁹

⁷ May 8, 2020 Office Action at TSDR 2-12, American Heritage Dictionary, ahdictionary.com.

⁸ As Applicant notes in its appeal brief, the definition from the actual website was never submitted by the Examining Attorney. Nonetheless, we may take and have taken judicial notice of this definition. *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016).

⁹ The Examining Attorney submitted evidence from foreign websites and sources. We evaluate the probative value of foreign information sources on a case-by-case basis. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007). We find the research papers from the foreign sources probative. *See In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (professionals in certain fields, such as medicine, engineering, computers and telecommunications and many other fields are likely to monitor developments in their fields without regard to national boundaries). On the other hand, we do not find probative the website and Facebook pages from a United Kingdom organization New Art Exchange, nae.org.uk, that offers “sound art creation” in its Saturday Art Club.⁹ July 13, 2020 Office Action at TSDR 33-35; September 3, 2020 Denial of Reconsideration at TSDR 8-10. We think it less likely that U.S. consumers searching for weekend activities in the United States would encounter these sources as the art club activities identified take place in the United Kingdom.

“However, since the last publication in 2004, NAISA has been offering ongoing workshops that teach the basics of **sound art creation** on an ongoing basis.”¹⁰

“Collaborative Creativity in Participatory **Sound Art Creation**.”¹¹

An Introductory Sound/Art Music Class through The Public School/New York, covering, among other things, the “primary areas of **sound art creation**” and “the conceptual and philosophical aspects of **sound art creation**.”¹²

“A closer look at the catalogue of Wolfgang Rihm is quite interesting considering his opposition towards **sound art creation**.” . . . “In this way von Bose is closer to **sound art creation** than Rihm and – from the technical point of view – much more modern.”¹³

“Attention should be given to curatorial and funding models, with the aim of strengthening the platform for **sound art creation**.”¹⁴

¹⁰ July 13, 2020 Office Action at TSDR 24. Naisa, New Adventures in Art and Sound, Sound Art Basics, naisa.ca. The webpage lists synopses of articles that form a printed booklet, including one article for “creating art with sound.” *Id.*

Although this is a Canadian publication, United States consumers searching for a printed booklet in English about sound art may encounter information about this publication when conducting an Internet search. *See In re i.am.Symbolic, LLC* 127 USPQ2d 1627, 1634 n.8 (TTAB 2018) (the Board did not wholly discount evidence from a foreign website with prices for goods listed in Euros stating “U.S. consumers may have some exposure to such websites retrieved from an Internet search.”). *See also In re Well Living Lab*, 122 USPQ2d 1777, 1781 n.10. (TTAB 2017) (websites of the Canadian companies found probative of U.S. consumer understanding of the term “well living”). We therefore find this evidence has some probative value.

¹¹ July 13, 2020 Office Action at TSDR 4, 7, Collaborative Creativity in Participatory Sound Art Creation, researchgate.net. The above quote is the title of a project by Visda Gouarzi with the goal of “[c]reating a platform for sound artists and public to create sound art together.” *Id.* at 7.

¹² July 13, 2020 Office Action at TSDR 2-3, facebook.com.

¹³ July 13, 2020 Office Action at TSDR 10, 12. Viviane Waschbüsch, The Stance of German “New Simplicity” Composers on Sound Art, Electroacoustic Music Beyond Performance, from the Proceedings of the Electroacoustic Music Studies Network Conference, Berlin (June 2014), ems-network.org. The paper quotes Mr. Rihm as calling the creators of sound art the “garden gnomes of music” and notes that Mr. Rihm “is totally opposed to any conceptual music and sound art.” *Id.* at 8, 10.

¹⁴ July 13, 2020 Office Action at TSDR 16. Journal of Sound Studies Sound Art and Public Engagement in the Built Environment, Conor McCafferty, Reflections from an Architecture Center, researchcatalogue.net. This paper discusses programming sound art into urban spaces.

“Consider the auditory object as an intended object –a musical performance or **sound art creation.**”¹⁵

Planephones ... “represent an innovative **sound art creation.**”¹⁶

“The emerging use of software agent technology as a tool in music/**sound art creation**, part of a wider interest in the deployment of interactive music systems such as those applying complementary techniques from evolutionary arts . . .”¹⁷

“Here was a creation that flawlessly combined a number of music elements that interested me at the time . . . The fact that these elements were used was not so important as how they were mesmerizingly put together, providing me with a new ideal for **sound art creation.**”¹⁸

The LinkedIn page of Keiko Uenishi describes the duties of a sound-artist/sound designer “as sound design, **sound-art creation.**”¹⁹

¹⁵ July 13, 2020 Office Action at TSDR 18-19. Online music magazine: Perfect Sound Forever Presents Porous Music, Daniel Barbiero, On Playing by an Open Window, Performance, Accidental Sound, and String Quartet with Windows, Open (April 2015), furious.com. This article discusses Dutch sound artist Harold Schellinx’s music creation of String Quartet with Windows, Open, which incorporated 24 hours of street sounds combined with a grid of 1024 violin sounds. *Id.* at 20.

¹⁶ July 13, 2020 Office Action at TSDR 27, Wikipedia.com.

¹⁷ July 13, 2020 Office Action at TSDR 29. Ian Whalley, The University of Waikato, Hamilton, New Zealand, Software Agents in Music and Sound Art Research/Creative Work: current state and a possible direction, semanticscholar.org. This paper’s preface states that “composers, musicians and computer scientists have begun to use software-based-agents to create music and sound art” and the paper is a survey of recent work in this area. *Id.* at 29.

¹⁸ July 13, 2020 Office Action at TSDR 36. Online publication, monk mink pink punk, Francis Collobert, English translation of a 1996 interview with Giancarlo Toniutti (Spring 1999), ronsen.org.

¹⁹ July 13, 2020 Office Action at TSDR 41. Keiko Uenishi, Program Administrator, Music Technology, Steinhardt/NYT at New York University, linkedin.com.

Applicant submitted a list of applications and registrations without a disclaimer of the word “creation” in support of its argument that the term “creation” is not descriptive.²⁰

IV. Analysis

In this case, Applicant and the Examining Attorney have presented evidence and/or arguments regarding the above-listed inquiries, but both acknowledge that stylization is not relevant because the proposed mark is in standard characters.²¹ *See Integrated Embedded*, 120 USPQ2d at 1506 n.4; *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007). We review the four remaining inquiries, but in making our determination we weigh them together and accord the appropriate weight to each one based on the evidence of record.

A. The Extent to Which NASH is Encountered as a Surname

The Examining Attorney’s LEXISNEXIS® surname database evidence shows NASH appearing 124,244 times in the United States.²² The database listing, submitted as a representative sampling of 500 names from the results shows specific

²⁰ June 22, 2020 Response to Office Action at TSDR 2-4. Providing such a list does not make the third-party registrations or applications of record. *See In re Duofold*, 184 USPQ 638, 640 (TTAB 1974). The Examining Attorney did not object to Applicant’s list in the July 13, 2020 Office action nor advise Applicant that this list is insufficient to make the listed registrations and applications of record. Therefore, the Examining Attorney waived any objection to consideration of the list. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff’d*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). We will consider the list of third-party registrations and applications “for whatever limited probative value such evidence may have.” *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).

²¹ 8 TTABVUE 27 n.4; 10 TTABVUE 7.

²² May 28, 2020 Office Action at TSDR 13-38.

individuals with the surname NASH in at least 34 different states. The Wikipedia NASH surname entry includes in its list of “notable people” 24 individuals from the United States with the NASH surname as well as other notable individuals with the surname that would be known to U.S. consumers.²³

Applicant criticizes the Examining Attorney’s database evidence as having duplicate entries of specific individuals that moved, along with invalid postal addresses.²⁴ Applicant speculates that the remaining entries that have not been submitted by the Examining Attorney likely include incomplete entries, duplicate entries as well as possible business listings.²⁵ Applicant argues that the database evidence should be afforded less weight because the complete search results were not submitted by the Examining Attorney.²⁶ Applicant also notes the lack of census database evidence.²⁷ Applicant submits that considering the population of the United States, “the alleged 124,244 listings of ‘NASH’ as a surname in the entire United States represents only 0.0375% of the surnames in this country,” making it a “relatively rare surname in the United States.”²⁸

We are not persuaded by these arguments. When evidence is obtained from a research database, the examining attorney does not have to make all of the pages of

²³ September 3, 2020 Denial of Reconsideration at TSDR 4-7.

²⁴ 8 TTABVUE 28.

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.* at 28-29.

record. It is sufficient to include only a portion of the search results, “as long as the sample was a fair representation of what the entire search revealed.” *In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068, 1069 n.2 (TTAB 1992). As to Applicant’s criticism that the database evidence reflects only a small percentage of individuals when considered in the context of the population of the United States, the Board has previously explained that whether a surname is uncommon is not determined solely based on percentages. *See In re tapio*, 2020 USPQ2d 11387, at *9 *citing In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). Also, while there are some duplicate and incomplete entries in the database sampling, even if we discount those entries, the remainder of the sampling, which is the majority of the entries, are complete and identify different individuals in different locations from across the United States.²⁹

“The issue to be determined under the statute is whether the public would perceive the surname significance as the mark’s primary significance, not whether the surname is rarely encountered.” *See In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1721 (TTAB 2016). Therefore, we find the surname database and Wikipedia evidence probative. *See In re Olin Corp.*, 124 USPQ2d 1327, 1331 (TTAB 2017) (surname database and Wikipedia evidence probative that OLIN is not an uncommon surname).

It is reasonable to conclude from the nationwide telephone database and Wikipedia evidence of “notable persons,” that NASH has had measurable public exposure as a

²⁹ Some minor duplication of entries is to be expected in virtually any data compilation. Therefore, we find that even allowing for some duplication, this does not cast doubt as to the probative value of the surname database evidence.

surname and would be perceived as such. *See e.g., In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA, 1975), (examining attorney’s sole reliance on 1900 telephone directory listings for Cleveland, Ohio and the Maryland suburban section of Washington D.C., was sufficient to establish prima facie that HARRIS was merely a surname and shift the burden of proof to applicant); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009) (BINION found to be primarily merely a surname based on 1416 listings in a nationwide telephone directory and a dictionary excerpt showing the absence of an entry for “Binion”); *In re Directional Marketing Corp.*, 204 USPQ 675, 677 (TTAB 1979) (“telephone directories may in appropriate cases serve in and of themselves to make out a prima facie showing that a particular designation is primarily merely a surname and hence to shift to applicant the burden of rebutting this showing”). Therefore, we find NASH is commonly encountered as a surname in the United States, and “it is likely to be perceived by the public as having surname significance.” *In re Olin Corp.*, 124 USPQ2d at 1331.

B. Whether NASH is the Surname of Anyone Connected with Applicant

Both Applicant and the Examining Attorney agree that there is no evidence to indicate that anyone connected with Applicant has the surname NASH.³⁰ Applicant submits that this factor favors Applicant.³¹

However, the fact that no one associated with Applicant has the surname NASH does not tend to establish one way or the other whether the term would be perceived

³⁰ 8 TTABVUE 29; 10 TTABVUE 10.

³¹ 8 TTABVUE 29.

as a surname. This inquiry is neutral. *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1287 (TTAB 2007); *In re Gregory*, 70 USPQ2d at 1795.

C. Whether NASH Has Any Recognized Meaning Other Than As a Surname

To establish that NASH does not have any ordinary language meaning, the Examining Attorney relies on negative dictionary evidence. The search results for the term NASH from the American Heritage Dictionary yielded no results of any word in the English language but identified two historical figures Frederick Nash (American writer) and Thomas Nash (English writer).³²

Applicant does not focus on the Examining Attorney's dictionary evidence, but argues that the Examining Attorney's Wikipedia evidence was misleading. Applicant submits that a search of "Nash" in Wikipedia shows many other meanings for "Nash" than a surname, including the nickname of Nashville, Tennessee which it claims is the primary significance to the purchasing public.³³

However, none of this evidence is in the record, and as we already stated, we do not take judicial notice of Wikipedia pages. "Attorney argument is no substitute for evidence."³⁴ *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)).

³² May 8, 2020 Office Action at TSDR 2.

³³ 8 TTABVUE 29, 30.

³⁴ Applicant argued in its June 22, 2020 Response to Office Action at TSDR 1 that NASH "is shorthand for Nashville," but it did not support this statement with any evidence.

In the absence of any countervailing evidence supplied by Applicant, this negative dictionary evidence “establishes that [NASH] has no recognized meaning other than as a surname.” *Olin*, 124 USPQ2d at 1332; *see also Adlon*, 120 USPQ2d at 1719-20 (examining attorney’s “negative dictionary evidence,” evidence showing that the term ADLON cannot be found in dictionaries, supported a finding “that there is no other apparent meaning of the term” as a word); *In re Binion*, 93 USPQ2d at 1537 (a dictionary excerpt showing the absence of an entry for “Binion” supported a finding that BINION was primarily merely a surname).

D. Whether Evidence Shows that NASH has the Structure and Pronunciation of a Surname

Applicants and examining attorneys may submit evidence that, due to a term’s structure or pronunciation, the public would “be likely to perceive it as similar to the structure and sound of other surnames, common words or coined terms.” *Adlon*, 20 USPQ2d at 1724.

As Applicant points out, during examination, the Examining Attorney presented no evidence of how members of the public would perceive the structure and sound of NASH and whether members of the public would or would not be likely to perceive it as a surname.³⁵

Therefore, we find this inquiry neutral.

³⁵ The Examining Attorney references the surname database evidence as evidence of the pronunciation and structure of the NASH, but this evidence does not address whether NASH is similar to the structure and sound of other surnames.

E. Conclusion as to the term NASH

Overall, the record contains evidence showing that NASH is an actual, relatively common surname and that no other meaning exists. Applicant's unsupported argument that consumers would not perceive NASH as a surname is unconvincing.³⁶ On this record, the primary significance of NASH to the purchasing public is primarily merely that of a surname.

F. Is the wording SOUND ART CREATION and STUDIO merely descriptive or generic of Applicant's goods and services?

Our inquiry does not end here, however. We must now examine the additional wording to Applicant's mark, SOUND ART CREATION and STUDIO to determine whether the primary significance of the mark SOUND ART CREATION NASH STUDIO as a whole to the purchasing public is that of primarily merely a surname. *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). "A key element in such an inquiry is determining the relative distinctiveness of the [additional] term[s] in the mark" and whether the additional terms have generic or descriptive significance. *Earnhardt*, 123 USPQ2d at 1413-1414.

However, as indicated, the assessment of a composite mark containing a surname is not limited to the inquiry of whether the additional terms are capable of functioning

³⁶ Applicant argues that until August 2017, when a new Examination Guide was issued, a composite mark [that] was comprised in part of a surname + descriptive literal matter, ... did not fall within §2(e)(4) and, therefore, was not considered 'primarily merely a surname.'" 8 TTABVUE 28 n.5. However, we must consider the Section 2(e)(4) surname refusal under current USPTO policy or practice.

as a mark or not. *Hutchinson Tech*, 7 USPQ2d at 1492-93. Rather, we must consider the meaning of the mark as a whole. *Id.* at 1492.

Applicant's goods are:

Downloadable music files; pre-recorded audio compact discs featuring music and sound; downloadable music files, namely, downloadable music files; pre-recorded digital media devices featuring sound and music; phonograph records featuring sound and music; electronic circuits and multimedia software pre-recorded on CD-ROMs featuring automatic performance programs for electronic musical instruments; electric and electronic effects units for musical instruments; audio interface; audio mixer; audio and video receivers; sound reproduction apparatus; sound transmitting apparatus; portable media player; subwoofers; headphones; recorded computer programs for processing digital music files; downloadable computer programs for processing digital music files; recorded computer software for creating and editing music and sounds; downloadable computer software for creating and editing music and sounds; downloadable electronic publications in the nature of books in the field of music; recorded electronic publications in the nature of books in the field of music; downloadable image files containing artists and musicians; recorded video discs and video tapes featuring music videos; recorded game programs for home video game machines; downloadable game programs for home video game machines; electronic circuits and multimedia software recorded on CD-ROMs featuring game programs for hand-held games with liquid crystal displays in International Class 9.

Applicant's services are:

Production of music; record mastering; songwriting; providing online non-downloadable music and online non-downloadable sound effects being sound recordings in the nature of entertainment services; educational and instruction services relating to music, namely, education in the field of music rendered through video conferences and correspondence courses; educational and instruction services, namely, providing classes relating to arts, crafts, sports or general knowledge; arranging and conducting of

seminars; providing non-downloadable electronic publications in the nature of books in the field of music; services of reference libraries for literature and documentary records, namely, providing online research and reference services via an on-line computer network by librarians and reference services specialists for literature and documentary records; book rental; arranging and planning being planning arrangement of showing movies, shows, plays or musical performances; providing facilities for movies, shows, plays, music or educational training; providing audio or video studio services; rental of musical instruments; movie theatre presentations being movie showing; movie film production and distribution; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of radio or television programs; direction of making radio and television programs; operation of video and audio equipment for production of radio and television programs; rental of music recordings; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes in International Class 41.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), 15 U.S.C. § 1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

“A generic term is the common descriptive name of a class of goods or services.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986); accord *In re Cordua Rests., Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016) (quoting

Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc., 786 F.3d 960, 965 (Fed. Cir. 2015)).

Applicant argues that the wording “sound art creation” is “a dissonant amalgamation of disparate noun concepts” and is suggestive and not descriptive “because it does not merely describe a particular characteristic or feature of Applicant’s content and content services.”³⁷ Applicant submits that if even “one of these disparate terms, e.g., ‘CREATION’” is found to be suggestive, “the Examiner’s refusal under Section 2(e)(4) must fail, because this suggestive term would be said to ‘carry’ Applicant’s composite mark.”³⁸

We first consider the word “studio.” American Heritage Dictionary defines studio as “[a] room or building where tapes and records are produced.” This wording is at least descriptive of Applicant’s services of “providing audio and video studio services” and “production of music services” and of Applicant’s downloadable music goods and its goods featuring music and sounds pre-recorded on various media all of which would typically be produced in a studio.

We next consider the wording “sound art creation.” Based on the dictionary definitions from American Heritage Dictionary, “sound art creation” is the creation through imagination of recorded auditory material in a particular arrangement of sounds, intended to be contemplated or appreciated as beautiful. The evidence submitted by the Examining Attorney shows that “sound art creation” is a descriptive

³⁷ 8 TTABVUE 34.

³⁸ *Id.*

term of art in relation to music and sound art.³⁹ For example, The Public School/New York offers an introductory Sound/Art Music Class that covers “sound art creation” and “the conceptual and philosophical aspects of sound art creation”; a research article discusses website and software agent technology used “as a tool in music/sound art creation.”

Based on the evidence of record, as used in connection with Applicant’s goods, the wording “sound art creation” describes a feature of Applicant’s downloadable and pre-recorded media featuring music and sound, its video goods featuring music, its electronic publications in the field of music, and its computer software for creating and editing music and sounds.

Similarly, as used in connection with Applicant’s services, the wording “sound art creation” describes a feature of Applicant’s music production services, audio or video studio services, non-downloadable music and sound effects, video conferences and correspondence courses in the field of music, providing classes related to arts, (which is broad enough to include sound art creation) and non-downloadable electronic publications in the field of music.

Therefore, the wording “sound art creation” is also merely descriptive when used in connection with Applicant’s goods and services.

³⁹ Applicant’s list of third party registrations and applications which identify the registration or application number and the mark does not include enough information for us to determine the Office’s treatment of the term CREATION. We note that third-party applications are not evidence of anything except that the applications were filed on particular dates.

G. What is the primary significance of the mark as a whole to the purchasing public?

As noted above, “[t]he test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public.” *Hutchinson Tech.*, 7 USPQ2d at 1492. Thus, we must determine whether the addition of the wording SOUND ART CREATION and STUDIO detracts from or displaces the surname significance of the name NASH in the mark SOUND ART CREATION NASH STUDIO.

We are not persuaded by Applicant’s argument that SOUND ART CREATION NASH STUDIO will be viewed by consumers as suggestive of its music related goods and services and that NASH evokes either a “coined term” or “an ambiguous place-name, given the lack of contextual use as a surname.”⁴⁰

The evidence of record establishes that the word STUDIO is at least descriptive of Applicant’s audio and video studio and music production services and merely descriptive of a feature of Applicant’s music goods. The evidence of record also establishes that SOUND ART CREATION is merely descriptive of characteristics of applicant’s downloadable and pre-recorded media featuring music and sound, its video goods featuring music, its electronic publications featuring music, and its computer software for creating and editing sounds and music, as well as its music production services, its audio and video studio services, its educational services in the field of music, and its electronic publications featuring music.

⁴⁰ 8 TTABVUE 30-32.

Taken together, the primary significance of the mark SOUND ART CREATION NASH STUDIO is that the goods and services feature sound art creation and are provided by or offered through a studio connected to a person named NASH. Indeed, SOUND ART CREATION happens in the NASH STUDIO. There is nothing in the combination of SOUND ART CREATION NASH STUDIO that diminishes or transforms this immediate connotation. Thus, the addition of the wording SOUND ART CREATION and STUDIO to NASH does not detract from nor change the surname significance conveyed by the mark SOUND ART CREATION NASH STUDIO as a whole. *See In re Weiss Watch Co., Inc.*, 123 USPQ2d 1200, 1207 (TTAB 2017) (“There can be no dispute that when used in connection with watches, the additional words WATCH COMPANY are incapable of source-identifying function and, viewing the mark as a whole in the context of the identified goods, do not alter the primary significance of the proposed mark WEISS WATCH COMPANY as primarily merely a surname.”); *In re Woolley’s Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991) (“Adding PETITE SUITES to the surname WOOLLEYS does not create a mark which is anything other than primarily merely a surname.”).

Accordingly, we find that the mark SOUND ART CREATION NASH STUDIO for the identified goods and services is primarily merely a surname.

Decision: The Section 2(e)(4) refusal to register Applicant’s mark SOUND ART CREATION NASH STUDIO is affirmed.