

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
November 27, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

*In re SBE Hotel Licensing, LLC*¹
—

Serial No. 85054771
—

Lee J. Eulgen, Sarah S. Smith, and Katherine Dennis Nye of Neal Gerber & Eisenberg LLP for SBE Hotel Licensing, LLC.

Dominick John Salemi, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).
—

Before Holtzman, Zervas, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On June 4, 2010, Applicant SBE Hotel Licensing, LLC applied to register the mark THE HENDRYX HOTEL for “hotel, restaurant and bar services” in International Class 43 pursuant to Section 1(b) of the Trademark Act. The trademark examining attorney has refused registration on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. When the refusal was made final, applicant timely appealed and filed a request for

¹ The application was originally filed in the name of 1717 Vine Management, LLC. The February 16, 2012 assignment from 1717 Vine Management, LLC to SBE Hotel Licensing, LLC is recorded in the Office Records at Reel Number 4719/0854.

reconsideration along with its appeal. Its request for reconsideration was denied. Both applicant and the examining attorney have filed briefs, and applicant has filed a reply.

Analysis

Applicant's mark combines HENDRYX with the words THE and HOTEL, generic in association with applicant's services. When wording combined with a surname is incapable of functioning as a mark (i.e., a generic name for the goods or services), registration must be refused on the ground that the entire mark is primarily merely a surname under Section 2(e)(4). *See In re Pickett Hotel Co.*, 229 USPQ 760, 762-63 (TTAB 1986) (refusing to register the stylized mark PICKETT SUITE HOTEL for "hotel, restaurant, and cocktail lounge services"); *see also In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1945 (TTAB 1993) (holding HAMILTON PHARMACEUTICALS for pharmaceutical products primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services"); *In re Woolley's Petite Suites*, 18 USPQ2d 1810, 1812 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (holding POSSIS PERFUSION CUP primarily merely a surname, the Board finding that "[a]pplicant's argument that PERFUSION CUP is not a generic name for its goods . . . is contradicted by the evidence the Examining Attorney has pointed to"); *In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (holding LIQUORE

MARTINONI (stylized) for liqueur primarily merely a surname, with “liquore” being the Italian word for “liqueur”).

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 as a whole to the purchasing public is that of a surname. *See In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000).

When we are faced with a Section 2(e)(4) refusal, we consider the impact a 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)).

Whether a mark is primarily merely a surname is a question of fact. *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 make out a prima facie showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989); *In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term.

There are five factors to be considered in determining whether a mark is primarily merely a surname:

1. whether the surname is rare;
2. whether the term is the surname of anyone connected with the applicant;
3. whether the term has any recognized meaning other than as a surname;
4. whether the term has the “look and feel” of a surname; and
5. whether the stylization of lettering is distinctive enough to create a separate commercial impression.

In re Benthin Mgmt. GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995). 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).

The examining attorney has the initial burden of presenting evidence to make a prima facie showing that a mark is primarily merely a surname. *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988).

A. Whether HENDRYX Is a Rare Surname

The examining attorney has submitted the first two pages of an Internet White Pages search for the last name “Hendryx” that found over 100 results, although only eight listings were provided. The examining attorney also has submitted what appear to be 15 of the first 37 results of a search of the LexisNexis research database that returned 6,225 stories.² The results submitted, all from the

² The better practice would have been to provide information about what search was conducted and any additional relevant information regarding the results, such as the number of documents viewed. See Trademark Manual of Examining Procedure § 1211.02(b)(ii) (8th ed. rev. 2012).

approximately one-month period of October 18, 2011 to November 22, 2011, reference some 20 different individuals with the last name “Hendryx.”

Applicant, in turn, argues that “Hendryx” is a rare surname. Applicant has submitted U.S. Census Bureau data from the 2000 census demonstrating that more than 27,000 surnames are more popular in the United States than “Hendryx”; the data demonstrates 837 occurrences for “Hendryx.”

Based on this evidence, we find that “Hendryx” is a somewhat rare surname. However, Section 2(e)(4) makes no distinction between rare and commonplace surnames, *see In re Picone*, 221 USPQ 93, 95 (TTAB 1984), and even a rare surname is unregistrable if its primary significance to purchasers is a surname. *See In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006); *In re E. Martinoni*, 189 USPQ at 590 (“The fact that ‘MARTINONI’ may be a rare surname does not entitle it to treatment different from what would be accorded to a common surname when no other meaning for the word is shown.”); *see also In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314, 1315 (TTAB 1990) (holding REBO primarily merely a surname); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988) (“Applicant’s evidence proves that ‘Pirelli’ is a rare surname but fails to rebut the Examining Attorney’s prima facie showing that ‘Pirelli’ would be viewed as a surname by the relevant public.”); *In re Pohang Iron & Steel*, 230 USPQ at 80 (holding POSTEN primarily merely a surname); *In re Etablissements Darty et Fils*, 225 USPQ at 654 (holding DARTY primarily merely a surname). Although rarity of

a surname is a factor in our analysis, the test remains whether the primary significance of the term to the purchasing public is that of a surname.

Moreover, the number of individuals having the surname “Hendryx” reflected in the examining attorney’s evidence in this case exceeds the numbers located in other cases where the surname was considered rare and thus registrable. *See, e.g., In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) (relying on six directory listings for the surname DUCHARME); *In re Garan, Inc.*, 3 USPQ2d 1537, 1540 (TTAB 1987) (six directory listings for surname GARAN and one LexisNexis listing). In other cases, a term has been found to be a rare surname, yet unregistrable, based on references similar to or fewer than we have here. *See, e.g., In re Pohang Iron & Steel*, 230 USPQ at 80 (finding POSTEN primarily merely a surname based on 11 directory listings and 12 references from LexisNexis database); *In re E. Martinoni*, 189 USPQ at 590 (three directory listings for the surname MARTINONI).

While “Hendryx” may be a somewhat rare surname, we cannot find, based on this record, that it is so rare that this factor should outweigh the other factors.

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

Applicant’s counsel submitted a declaration stating that it is his understanding that HENDRYX “is not the surname of any person connected with the Applicant. In particular, it is not the last name of any founder, member, or officer of Applicant.” This factor is neutral. *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1287 (TTAB 2007); *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004).

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

The examining attorney has submitted print-outs of searches of one dictionary and two geographical dictionaries indicating that HENDRYX has no recognized meaning, and applicant has proffered none. The absence of evidence that HENDRYX has any other recognized meaning supports the examining attorney's prima facie case that its primary meaning is as a surname.

D. Whether HENDRYX Has the "Look and Feel" of a Surname

Finally, we consider whether the term has the structure and pronunciation, or "look and feel," of a surname, which is a subjective inquiry. *In re Jack B. Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). Some names, by their very nature, have only surname significance even though they are rare surnames. *See In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d at 1566 (holding PIRELLI primarily merely a surname and stating that "certain rare surnames look like surnames and certain rare surnames do not and . . . 'PIRELLI' falls into the former category"); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986) (holding PETRIN primarily merely a surname).

The examining attorney's evidence supports his argument that HENDRYX has the "look and feel" of a surname. He has shown that there are numerous individuals in the United States with that surname. This conclusion is strengthened by the census data submitted by applicant, which shows that there are an additional 41,879 occurrences of the surname "Hendricks" and 34,032 occurrences of the surname "Hendrix," both of which are among the most popular

1,000 U.S. surnames and have the same structure and pronunciation as “Hendryx.” Additionally, HENDRYX would not be perceived as an initialism or acronym, and does not have the appearance of a coined term combining a recognizable root word with a prefix or suffix.

Conclusion

In view of the examining attorney’s evidence, we find that the record contains sufficient evidence to establish prima facie that the primary significance of HENDRYX to the purchasing public for applicant’s goods is merely that of a surname within the meaning of Section 2(e)(4). The record indicates that the surname significance of “Hendryx” would be readily recognized. Applicant has not rebutted the examining attorney’s prima facie case through evidence or argument. We therefore find that applicant’s proposed mark is primarily merely a surname under Section 2(e)(4).

Decision: The refusal to register under Section 2(e)(4) of the Trademark Act is affirmed.