

This Opinion is not a
Precedent of the TTAB

Mailed: November 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re IMH Columbia, LLC
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Serial No. 88094045
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David V. Radack and Jenna P. Torres of Eckert Seamans Cherin & Mellott, LLC,
for IMH Columbia, LLC.

Brian Pino, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Kuhlke, Wellington, and Lykos,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

IMH Columbia, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark THE MERRIWEATHER for “hotel services” in International Class 43.¹

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¹ Application Serial No. 88094045, filed on August 27, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

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

After the refusal was made final, Applicant appealed to this Board. The application was subsequently remanded twice by the Board, upon requests of Applicant, for further examination. Applicant also requested reconsideration on two occasions.² In response to the first request for reconsideration, the Examining Attorney withdrew a Section 2(d) likelihood of confusion refusal based on a registration for the mark MERRIWEATHER;³ however, the Examining Attorney maintained the surname refusal. After the Examining Attorney denied the second request for reconsideration, maintaining the finality of the surname refusal, the Board resumed proceedings and allowed Applicant to file a supplemental brief, which it did. The appeal is fully briefed, including a reply brief from Applicant.

We reverse the refusal.

² 4 TTABVUE (first request for reconsideration) and 8 TTABVUE (second request for reconsideration).

³ Applicant, with its first request for reconsideration, attached a copy of a signed "Coexistence and Consent Agreement," between itself and the owner of the cited registration, whereby the owner agreed to, inter alia, Applicant's registration of the involved mark. 4 TTABVUE 4-8. The cited registration (No. 4839304) is for a standard character mark on the Principal Register, without a claim of acquired distinctiveness, and covers "entertainment services, namely, providing a facility for musical concerts . . ." (copy of registration attached at TSDR Office Action issued on December 13, 2018, p. 43).

Evidentiary Objections

The Examining Attorney objects to evidence Applicant attached to its initial brief and evidence attached to Applicant's supplemental brief on the basis that said evidence was "not already of record prior to appeal."⁴

With respect to the evidence attached to Applicant's initial appeal brief, we note that this same evidence was submitted with Applicant's request for remand for consideration of that evidence.⁵ The request was granted and the application file was remanded to the Examining Attorney for consideration of "the additional evidence," which the Examining Attorney did before this appeal proceeding resumed.⁶ Accordingly, the evidence attached to Applicant's initial brief is of record, has been considered, and the Examining Attorney's objection thereto is moot.

Although the evidence attached to Applicant's initial brief is of record, we hasten to add that it was unnecessary for Applicant to attach any evidence to its brief. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments had been properly made of record). The better and preferred practice is citation to the record. *See* TRADEMARK TRIAL AND

⁴ 17 TTABVUE 3.

⁵ 8 TTABVUE (Applicant's request for remand) and 9 TTABVUE (Applicant's initial appeal brief).

⁶ 10 TTABVUE 1-2 and 13 TTABVUE 3 (Examining Attorney, in denying the request for reconsideration, states "the applicant's additional evidence is not compelling.").

APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.01 (2020) (“When referring to the record, the applicant and examining attorney should cite to the prosecution history for the application, currently the TSDR database.”).

With respect to the objection to the evidence submitted for the first time with Applicant’s supplemental brief, Applicant asks the Board to take judicial notice of some of the materials because they derive from the U.S. Census website containing data regarding the 2010 census.⁷ The Board may take judicial notice of the U.S. Census reports and we agree to do so here – the U.S. Census materials attached to Applicant’s supplemental brief are considered. *See In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 n.7 (TTAB 2016).

As to the other materials attached to its supplemental brief, Applicant asserts these are “updated” versions of the materials submitted with its request for remand.⁸ However, in response to the Examining Attorney’s objection to them, Applicant does

⁷ 18 TTABVUE 5. Applicant refers to the materials it attached to its supplemental brief at 15 TTABVUE 12-16. In particular, Applicant attached a page identifying the U.S. Census website address it accessed, the date accessed, a page from the website showing a link to a Microsoft Excel file, and two Excel spreadsheet pages (with the last page containing information regarding MERRIWEATHER as a surname). Applicant explained that it provided the U.S. Census information in this manner “because of the difficulties of submitting the entire 162,255-line Excel file with mostly irrelevant information as an exhibit.” 18 TTABVUE 9. We note the Examining Attorney objected to Applicant’s submission of two similar Excel spreadsheet pages with its request for reconsideration filed on February 14, 2020 (8 TTABVUE 110-111) because “the spreadsheet information is not acceptable as evidence as the source of the spreadsheet is not apparent from the evidence itself.” 13 TTABVUE 3. However, as noted, Applicant provided this information with the materials attached to its supplemental brief and the Examining Attorney did not reassert an objection on this basis.

⁸ *Id.* Specifically, Applicant asserts the materials submitted with its supplemental brief (15 TTABVUE 18-67) are “updated” versions of the materials submitted with its request for remand (8 TTABVUE 59-68).

not explain why “updated” versions were necessary. Indeed, Applicant asserts that the original materials submitted with its request for remand remain relevant in connection with Applicant’s arguments.⁹ Because these materials are untimely and, unlike the Census data, not appropriate for judicial notice, the Examining Attorney’s objection thereto is sustained and they are not given consideration in this appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *see also In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff’d*, 777 F. App’x. 516 (Fed. Cir. 2019) (“The evidence submitted with Applicant’s appeal brief that Applicant did not previously submit during prosecution . . . is untimely and will not be considered.”).

In sum, the Examining Attorney’s objection to the evidence attached to Applicant’s initial brief is moot. However, we sustain the Examining Attorney’s objection to the evidence attached to Applicant’s supplemental brief, with the exception of the U.S. Census data that of which the Board takes judicial notice.

Primarily Merely a Surname

A mark that is “primarily merely a surname” may not be registered on the Principal Register unless it has acquired distinctiveness. 15 U.S.C. §§ 1052(e) and (f); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Applicant does not argue that its proposed mark has acquired distinctiveness under Trademark Act Section 2(f), but argues only that its proposed mark is not primarily merely a surname.¹⁰

⁹ *Id.*

¹⁰ The involved, intent-to-use application does not include a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), nor a request for registration on the

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. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017) (citing *Darty*, 225 USPQ at 653). In this case, because Applicant seeks to register its mark in connection with hotel services, the relevant purchaser is any adult from the general public.

Whether the primary significance of an applied-for mark is merely that of a surname is a question of fact that must be resolved on a case-by-case basis. *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017). We examine the entire record to determine the primary significance of the mark to the purchasing public. *Id.*; *Darty*, 225 USPQ at 653; *Beds & Bars*, 122 USPQ2d at 1548; *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995). Over the years, the Board identified various factors we may consider in determining whether a mark is primarily merely a surname, including: (1) the rarity or frequency of exposure to the public of the mark being used as a surname; (2) whether anyone connected with the applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; (4) whether the mark has the structure and pronunciation of a surname; and (5) whether the manner in which the mark is displayed might negate any

Supplemental Register under Trademark Act Section 23, 15 U.S.C. § 1091. Accordingly, such issues are not before us in this appeal. *In re Weiss Watch Co., Inc.*, 123 USPQ2d 1200, 1201 n. 2 (TTAB 2017).

surname significance.¹¹ *Id.* at 1332-33; *see also Weiss Watch*, 123 USPQ2d 1203 (discussing initial factor in terms of “whether and to what extent [term] is encountered as a surname.”). These factors, however, are not exhaustive or enumerated in any particular order of importance; the Board may consider other types of evidence that may be probative as to the public’s perception of the proposed mark.

If there is any doubt, we must resolve the doubt in favor of the applicant. *See Benthin*, 37 USPQ2d at 1334.

Consumers’ Exposure to MERRIWEATHER Used as a Surname

We first consider the degree of possible exposure to the purchasing public of MERRIWEATHER as a surname. The 2010 U.S. Census data shows that approximately 4,793 individuals have this surname.¹² It is ranked 6989th in total numbers as a surname in the U.S.; and, placed in context, the “proportion per 100,000 population for name [MERRIWEATHER]” is 1.62.¹³

In addition, the Examining Attorney submitted Internet evidence showing “Merriweather” used as surname by individuals, including Wikipedia entries for NFL player Mike Merriweather and pianist and singer “Big Maceo” Merriweather, and a

¹¹ With respect to the last listed factor, because Applicant’s proposed mark is in standard character format, it cannot be argued that the mark is being displayed in any particular manner that may negate surname significance. *See In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007). Accordingly, this factor is not relevant to our decision.

¹² TSDR Office Action issued on December 13, 2018, at p. 154; the same information was also submitted by Applicant with its supplemental brief (15 TTABVUE 12-16) for which we take judicial notice, as discussed *supra*.

¹³ 15 TTABVUE 16.

Harlem Globetrotters website printout for team player “Money” Merriweather.¹⁴ The Examining Attorney also submitted information regarding a Tennessee Williams play “Will Mr. Merriweather Return From Memphis?” as well as copies of articles from the LexisNexis database involving individuals with the surname “Merriweather.”¹⁵

Applicant argues that “Merriweather” is a “rare” surname and “the relevant purchasing public of Applicant’s hotel services has not been exposed to THE MERRIWEATHER with any frequency as a surname, [and] is not likely to view the mark as primarily merely a surname, particularly in connection with the services of the application.”¹⁶

We find that the number of persons with the surname indicates it is not a common surname. The proportion of individuals per 100,000 population indicates it is very unlikely that the purchasing public encounter individuals with the surname. However, as we have often pointed out, even rare surnames may be held primarily merely surnames if the primary significance conveyed to purchasers is that of surname. “The relevant question is not simply how frequently a surname appears, however, but whether the purchasing public for Applicant’s services is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *Beds & Bars*, 122 USPQ2d at 1551 (finding BELUSHI’S to be primarily merely a surname).

¹⁴ 11-13 TTABVUE (attached to Office issued on March 26, 2020).

¹⁵ *Id.*

¹⁶ 9 TTABVUE 11-12.

The evidence showing several individuals of some notoriety having the surname “Merriweather” enhances the likelihood that the general public has been exposed to this surname.

No One Associated With Applicant Has Surname MERRIWEATHER

The Examining Attorney acknowledges, “Applicant has confirmed to the Examining Attorney that no person associated with Applicant has the surname Merriweather.”¹⁷ Accordingly, this factor does not favor finding Applicant’s mark will be perceived as primarily merely a surname and remains neutral in our analysis.

Any Recognized Non-Surname Meaning for MERRIWEATHER

To show that the term “Merriweather” has no recognized meaning, other than as a surname, the Examining Attorney submitted some “negative dictionary” evidence, i.e., printouts from a dictionary database showing that the term has no defined meaning.¹⁸ This type of evidence may be used to demonstrate that there is no recognized meaning to a term. *See, e.g., Darty*, 225 USPQ at 653; *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016).

Applicant, on the other hand, argues that “Merriweather (and slight variations in spelling, including the phonetically equivalent Meriwether) is also a given name, as in Marjorie Merriweather Post, and including the famous explorer Meriwether Lewis (of Lewis and Clark).”¹⁹ In support, Applicant submitted printouts from the

¹⁷ 9 TTABVUE 12, referencing Applicant’s response filed on April 17, 2019.

¹⁸ TSDR Office Action issued on December 13, 2018, at p. 12.

¹⁹ 9 TTABVUE 9.

Wikipedia websites with information regarding American explorer Meriwether Lewis (“leader of the Lewis and Clark Expedition”),²⁰ and Marjorie Merriweather Post, a prominent American businessperson and socialite, who died in 1973.²¹

Applicant further argues that “Merriweather” has additional, non-surname meanings. Specifically, Applicant asserts that the term “Merriweather” may be used to reference the “Merriweather Post Pavilion,” an outdoor concert venue in Columbia, Maryland, and named for Marjorie Merriweather Post.²² Applicant submitted printouts of the first three pages from a Google Internet search engine result for the term “merriweather,” with the vast majority of “hits” referring to the concert venue. A few Google “hits” from the search also reference a specific font type called “Merriweather” or “Merriweather Serif,” that was “designed by Eben Sorken at Adobe Fonts.”²³ Applicant also relies on evidence advertising a “Merriweather District,” located in Columbia, Maryland, surrounding the Merriweather Post Pavilion and touted as “the first high density, mixed-use neighborhood in Downtown Columbia.”²⁴

With respect to Applicant’s contention that “Merriweather,” by itself, will be perceived by consumers as identifying the outdoor concert venue, it argues that “evidence to support this connection includes the fact that the owners of the music venue have a registration for just MERRIWEATHER in connection with

²⁰ 8 TTABVUE 71-80.

²¹ *Id.* at 25-30.

²² TSDR Office Action issued on December 13, 2018, at pp. 7-9; also at 9 TTABVUE 43-49.

²³ 9 TTABVUE 61-62.

²⁴ TSDR Applicant’s April 17, 2019 response, pp. 2-8.

entertainment services that registered without a 2(f) claim.”²⁵ Although this registration, discussed *supra* (see Note 3), is of record, we are not privy to that registration file history which may have included evidence not before us in this appeal. Moreover, as the Examining Attorney has correctly pointed out, while consistency in examination is highly desirable, it is well settled that the Board is not bound by previous decisions of examining attorneys and applicants have no “substantive right to consistency.” *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *see also In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006); *In re City of Hous.*, 101 USPQ2d 1534, 1542 (TTAB 2012), *aff’d*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). In sum, the allowance and existence of the MERRIWEATHER registration does not dictate our decision in this appeal.

In all, the evidence shows that the term “Merriweather,” by itself, may have multiple non-surname meanings. Particularly, the term, or its near equivalent, may be understood as a first name given the notoriety of the American explorer Meriwether Lewis.

Structure and Pronunciation

Whether a term has the structure and pronunciation of a surname is a “decidedly subjective” inquiry. *Eximius*, 120 USPQ2d at 1280 (quoting *Benthin*, 37 USPQ2d at 1333). As the Board noted in *In re Olin Corp.*, 124 USPQ2d 1327, 1332 (TTAB 2017) *Olin*, “applicants and examining attorneys may submit evidence that, due to a term’s structure or pronunciation, the public would or would not perceive it to have surname

²⁵ 15 TTABVUE 6.

significance.” In general, the ‘structure and pronunciation’ factor involves whether a term, in this case “Merriweather,” is similar or dissimilar to other surnames in structure and pronunciation and this being probative of a likely perception (or not) of the term as a surname. In this regard, the Examining Attorney submitted evidence showing 10 persons with the surname “Meriweather”²⁶ and 9 persons with the surname “Mayweather.”²⁷ Although “Merriweather” may be close in structure and pronunciation to these other surnames, this evidence has little, if any, probative value given there are so few persons shown to have these surnames.

Applicant and the Examining Attorney have also argued whether the structure and pronunciation of Applicant’s mark, based on the addition the definite article “the,” negates any perception that the overall mark is primarily and merely a surname. Specifically, Applicant “emphasizes that the inclusion of the element THE in Applicant’s mark is yet another factor . . . that diminishes any surname significance of the mark as a whole to the relevant purchasing public, because THE MERRIWEATHER has the look and feel of the name of a building rather than a surname.”²⁸ This argument takes on particular relevance because, as Applicant notes, the meaning of THE MERRIWEATHER is determined “when considering the relevant purchasers of Applicant’s services include those looking for hotel accommodations.”²⁹ In support, Applicant submitted Internet evidence showing other

²⁶ TSDR December 13, 2018 Office Action, pp. 122-124.

²⁷ TSDR April 29, 2019 Office Action, pp. 132-135.

²⁸ *Id.* at 8.

²⁹ 15 TTABVUE 7. We note Applicant specifically argues that the relevant purchasers are those looking for hotel accommodations “in or near Columbia, Maryland, or between

hotels with names prefaced by “The,” e.g., The Ritz-Carlton, The Inn at Penn, The Bellevue, The Edgewater Inn, The Warwick, The Plaza, The Carlyle Hotel, and The Mark.³⁰ Applicant also cites to *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (holding “a mark sought to be registered must be considered in its entirety,” and reversing a surname refusal of HUTCHINSON TECHNOLOGY for electrical components).

The Examining Attorney disagrees, noting that that the addition of the word “the” in marks has generally been held to have little significance as to the mark’s overall commercial impression and little, if any, source-identifying value.³¹ The Examining Attorney argues that, in this particular case, the prefix THE in the mark “does not change the primary perception of the surname . . . particularly when the evidence of record shows that famous Americans have the surname MERRIWEATHER.”³² Likening “Merriweather” to other surnames -- GARCIA and EINSTEIN, he argues that “[i]f anything, the term THE emphasizes the surname nature of the surname

Washington, D.C. and Baltimore, where the Merriweather Post Pavilion is located, and where a new Merriweather business district is being developed.” *Id.* It is improper to narrow the relevant class of prospective consumers based Applicant’s particular location because Applicant seeks a geographically unrestricted registration of its mark. Accordingly, we must assume Applicant will render its hotel services to all persons looking for hotel services and not limited to one geographic region. *Cf.*, *In re Integrity Mutual Insurance Company, Inc.*, 216 USPQ 895, 896 (TTAB 1982).

³⁰ 8 TTABVUE 86-108.

³¹ 17 TTABVUE 12.

³² *Id.*

MERRIWEATHER because it denotes a particular person with that surname, e.g., THE EINSTEIN, THE GARCIA, etc.”³³

With regard to the Examining Attorney’s first point, the Board has long and often found that because the word “the” is a definite article mostly used to denote a particular object, the word generally has almost no trademark significance, particularly in the case of a likelihood of confusion or descriptiveness analysis. *See, e.g., In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (definite article THE adds “no source-indicating significance to the mark as a whole”); *In re Narwood Prods., Inc.*, 223 USPQ 1034 (TTAB 1984); *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 USPQ2d 269, 271-71 (TTAB 1980); *United States Nat’l Bank of Oregon v. Midwest Savings and Loan Ass’n.*, 194 USPQ2d 232 (TTAB 1977). Nevertheless, this does not mean that we can overlook any role the word may play in determining whether consumers will perceive Applicant’s mark THE MERRIWEATHER as primarily merely a surname. Indeed, as the Court of Appeals for the Federal Circuit instructed in *Hutchinson*, we must “consider[] what the purchasing public would think when confronted with the mark as a whole.” 7 USPQ2d 1492.

Here, we find the word “the” in THE MERRIWEATHER diminishes the likelihood that a prospective purchaser of hotel services would perceive the mark as primarily merely a surname. We disagree with the Examining Attorney’s contention that, in this context, the mark “denotes a particular person” with the surname

³³ *Id.*

“Merriweather.” That is, it would be somewhat nonsensical or grammatically improper to reference a single person by a surname and prefaced by “the,”³⁴ without additional explanation or reason given. Because “Merriweather” is singular and prefaced by “the,” it is more likely the relevant public would believe the mark is merely identifying the physical hotel. In this regard, Applicant’s evidence regarding other hotel names prefaced by the word “the” is probative because it helps show that consumers often encounter names of hotels or buildings that begin with the word “the.” Put simply, the structure of the mark THE MERRIWEATHER, in the context of an uncommon name and one with other meanings, is such that consumers may not perceive it as primarily merely a surname.

Conclusion

Upon consideration of all of the evidence before us, and all relevant factors, this record does not support a finding that consumers are likely to view and understand the mark THE MERRIWEATHER, when considered in its entirety, in connection with hotel services to be primarily merely a surname. *Benthin*, 37 USPQ2d at 1334 (doubt resolved in favor of applicant). We make our finding based on “Merriweather” being a relatively uncommon surname, having several possible non-surname meanings, including a very similar, known historical first name, and the overall mark having a structure that, when consumers encounter Applicant’s mark THE

³⁴ Applicant submitted evidence regarding the proper usage of the definite article “the.” 8 TTABVUE 82-84 (“Student Writing Support” from the University of Minnesota website). The website provides that “the” should be used in situations when “family names made plural with an ‘s’ (the Pinkers)” and with “names of most buildings or structures (the Empire State Building).” *Id.* at 83.

MERRIWEATHER for hotel services, they will not perceive it as primarily merely a surname.

Decision: The refusal to register is reversed.