

<p><b>This Opinion is Not a Precedent of the TTAB</b></p>
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Mailed: March 11, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re John Inglis Company, Limited dba INGLIS, The Inglis Company*

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Serial No. 88403123

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Gregory S. Smith of Smith Tempel Blaha LLC for John Inglis Company, Limited  
dba INGLIS, The Inglis Company.

Jillian R. Burch, Trademark Examining Attorney, Law Office 128,  
Travis Wheatley, Managing Attorney.<sup>1</sup>

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Before Kuhlke, Bergsman and Heasley, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

John Inglis Company, Limited dba INGLIS, The Inglis Company (Applicant) seeks registration on the Principal Register of the mark shown below for “Pistols and parts thereof; Component parts for pistols Pistol cases; Pistol grips; Pistol holsters; Pistols; Ammunition for firearms; Automatic pistols; Covers for firearms; Handles for pistols and revolvers; Loading clips for pistols; Sights, namely, open sights for use on

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<sup>1</sup> A different Examining Attorney examined the application; the application was assigned to the present Examining Attorney for preparation of the appeal brief.

firearms; Silencers for firearms; Sporting firearms; Triggers for firearms; Weapon cases for firearms,” in International Class 13.<sup>2</sup>



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

When the refusal was made final, Applicant appealed and the Examining Attorney and Applicant filed briefs. We affirm the refusal to register.

#### I. Evidentiary Matter

In her brief, the Examining Attorney objects to an excerpt from the website definitions.net attached to Applicant’s October 22, 2019 response because it does not include the date of download.<sup>3</sup> However, although the prior Examining Attorney lodged this objection in the January 26, 2020 Office Action, she did not maintain the objection in a subsequent Office Action, on March 24, 2020, and addressed the evidence on its merits. Thus, the objection was waived.

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<sup>2</sup> Application Serial No. 88403123, filed on April. 25, 2019, based upon Applicant’s allegation of bona fide use in commerce commencing on April 24, 2019 for “pistols and parts thereof; component parts for pistols” under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and a bona fide intention to use the mark in commerce for the remaining goods under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>3</sup> 7 TTABVue 18-19.

In addition, in its January 30, 2020 Response, Applicant refers to marks in two registrations. Applicant provided only the marks and the registration numbers. While this is not sufficient to make third-party registrations of record, the Examining Attorney did not object to them in the subsequent Office Action, so we consider these references for whatever probative value they may have. *In re ActiveVideoNetworks, Inc.*, 111 USPQ2d 1581, 1594 n. 40 (TTAB 2014); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2020). Because we do not take judicial notice of registrations, our consideration is limited to what Applicant provided. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (citing *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); TBMP § 1207.03. Here, we find the listings to be of no probative value. We have no information on the status of the registrations, the goods or services therein or other circumstances. We further observe that one of the marks is a full name, not a surname. *Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d 1823, 1829 (TTAB 2009) (personal name mark is registrable without a showing of acquired distinctiveness). In any event, each case must stand on its own merits. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

## II. Primarily Merely a Surname

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. Kerry 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. *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017). 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).

Among the circumstances that may be probative in making this determination are: the extent to which the term is exposed to the public as a surname; whether the term is the surname of anyone connected with the applicant; whether the term has any recognized meaning other than as a surname; whether the term has the structure and pronunciation of a surname; and whether stylization, design or additional wording is distinctive enough to cause the mark not to be perceived as primarily merely a surname. *In re Etablissements Darty et Fils*, 225 USPQ at 653; *In re Eximius*

*Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016); *In re Benthin Mgmt.*, 37 USPQ2d at 1333-34. These factors are not exclusive, nor are they presented in order of importance; any of the factors—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case. *In re Olin Corp.*, 124 USPQ2d at 1330; *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017); *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016). 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 of Public Exposure to INGLIS as a Surname

First, we consider the frequency of, and public exposure to, INGLIS as a surname, *In re Olin*, 124 USPQ2d at 1330, keeping in mind that “[t]he relevant question is not simply how frequently a surname appears ... 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.” *In re Beds & Bars*, 122 USPQ2d at 1551. To show the extent of public exposure to INGLIS as a surname, the Examining Attorney submitted the following:

The LEXIS/NEXIS surname database showing Inglis appearing 5439 times as a surname throughout the United States;<sup>4</sup>

Screenshots from howmanyofme.com and 411.com showing INGLIS appearing 3159 times as a surname on howmanyofme.com and 6262 on 411.com; and<sup>5</sup>

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<sup>4</sup> July 12, 2019 Office Action at 10-50.

<sup>5</sup> March 24, 2020 Office Action at 2-4 (<http://howmanyofme.com> and <https://www.411.com>).

Excerpts from the LEXISNEXIS U.S. Newspaper database showing use of INGLIS as a surname in several articles nationwide.<sup>6</sup>

A few examples from the newspaper articles are set forth below:

Business Wire (New York) March 19, 2020 -- RTW Retailwinds, Inc. Announces Leadership Succession Plan That Accelerates Digital Transformation and Positions the Company for Long Term Profitable Growth; Appoints Travis **Inglis** to Chief Executive Officer Effective April 17th 2020 Gregory Scott to Step Down as Chief Executive Officer Following a Transition Period;<sup>7</sup>

The Washington Post (Washington) March 19, 2020 -- Robert Costa; Philip Rucker ... Another victim was Rep. Bob **Inglis** (R-S.C.), who this week recalled the fierce backlash in his district in early 2009, after he had voted ...;<sup>8</sup>

Courier News (Bridgewater, New Jersey) March 19, 2020 - - Esther Davidowitz, What your neighbors are doing for others ... For the Jewish holiday Purim a week ago, Jocelyn **Inglis** of Bergenfield collected unopened pasta boxes;<sup>9</sup>

Marketwire (Los Angeles, CA) June 17, 2014 – Former NSA Deputy Director John Chris **Inglis** Joins Securonix Advisory Board; **Inglis** to Bring Invaluable Insights on Insider Threat Management and Security Analytics to Securonix and its Customers ... Body Securonix today announced that former NSA Deputy Director John C. (Chris) **Inglis** has officially joined the company's advisory board. Mr. **Inglis** will advise the company on business and technology strategy while helping to educate and guide Securonix customers on the importance and approach of using analytics ... ;<sup>10</sup>

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<sup>6</sup> *Id.* at 5-41.

<sup>7</sup> *Id.* at 10.

<sup>8</sup> *Id.* at 14.

<sup>9</sup> *Id.* at 16.

<sup>10</sup> *Id.* at 28.

The Florida Times-Union (Jacksonville, FL) March 18, 2020 – including in a list Rev. Holly **Inglis**, Palms Presbyterian Church;<sup>11</sup>

The Quad-City Times (Davenport, Iowa) May 27, 2019 – **Inglis** joins short list of multiple women’s winners at Kwik Star Criterium ... Gwen Inglis had a case of déjà vu Monday afternoon. Similar to five years ago, a downpour delayed the start of the Kimberly Crest Vet Women’s Pro race. And like 2014, **Inglis** ended on the top step of the podium in the 54<sup>th</sup> running of the Kwik Star Criterium.;<sup>12</sup>

Home Furnishings News November 22, 2019 – Inspiring Woman: Susan **Inglis** ... Susan **Inglis**, the founder and executive director of the Sustainable Furnishings Council and one of HFN’s Inspiring Women this year, spoke to HFN about her passions...;<sup>13</sup>

Daily Camera (Boulder, Colorado) July 15, 2019 – Redding, **Inglis** win first Longmont Criterium in racing careers ... Sam Redding of Groove Subaru Excel Sports and Gwen **Inglis** of Stages Cycling were the top winners in the pro races at the 33<sup>rd</sup> Annual Longmont Criterium on Sunday; and<sup>14</sup>

The Lodi Enterprise (WI) August 18, 2017 – **Inglis** to educate locals about dyeing ... Kipp **Inglis**, a local artist, would like to educate community members about fiber dyeing, as she just opened Spring Creek Art Works, an up-and-coming teaching studio ... an undergraduate at the University of Wisconsin-Milwaukee.<sup>15</sup>

Applicant argues that the only evidence of public exposure is the LEXIS/NEXIS submission and because “the TTAB and the courts have rejected a strict numerical approach to a surname analysis” this is insufficient. 5 TTABVUE 12. As Applicant

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<sup>11</sup> *Id.* at 32.

<sup>12</sup> *Id.* at 34.

<sup>13</sup> *Id.* at 36.

<sup>14</sup> *Id.* at 37.

<sup>15</sup> *Id.* at 39.

recognizes, even an uncommon surname is unregistrable if its primary significance to purchasers is as a surname. *See In re Giger*, 78 USPQ2d 1405, 1408 (TTAB 2006) (“[T]he fact that a term is not a common surname does not mean that a surname would not be considered to be primarily merely a surname.”).

Turning to the record, we find that the evidence shows the surname INGLIS has enjoyed a measure of exposure to the general public across the country, thereby raising the probability that the public at large would regard INGLIS as a surname, rather than something else. *In re Giger*, 78 USPQ2d at 1795 (ROGAN primarily merely a surname based in part on broad exposure of public to politician, athletes, actor and author with this surname.). The surname INGLIS is used across the country from California, Wisconsin, and Iowa to New Jersey, South Carolina and Florida. It has received a moderate amount of publicity, including from a public figure, former South Carolina Representative Bob Inglis, such that members of the general public are likely to encounter it as a surname. For those reasons, the extent of public exposure of INGLIS as a surname supports the Examining Attorney’s case that its primary significance is as a surname. *In re tapio GmbH*, 2020 USPQ2d 11387, at \*10 (TTAB 2020) (no need for evidence of “celebrity status” or “national notoriety” or “significant media attention” to find surname significance, although uncommon, meaningful and fairly widespread public exposure supports finding of perception as a surname).



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

The Examining Attorney submitted excerpts from the Inglis Home Appliances website discussing the founder of that company as John Inglis.<sup>16</sup>

Applicant argues that INGLIS is not a surname of anyone connected with it. Specifically Applicant asserts:<sup>17</sup>

The Office argues that the evidence presented by the Office shows that the company was founded by John Inglis. This is actually incorrect but rather, the evidence presented by the Office is affiliated with the previously-referenced company founded by John Inglis in Canada and has since been acquired and changed to WHIRLPOOL CANADA in 2001 (see evid 001 John Inglis and Company – Wikipedia and evid 002 About Inglis - Inglis Home Appliances - included an Appellant's January 30, 2020 response to the January 26, 2020 Office Action).

The legal name of applicant's company is John Inglis Company, Limited. There is no one in the company or affiliated with the company that goes by the name John Inglis or has the surname Inglis. The company was named for and the trademark for the company was selected because the term Inglis has become associated with a level of quality. 150 years ago, John Inglis and his sons started a small company in Guelph, Ontario, Canada. They founded a company built on honest principles of providing consumers with quality, long-lasting products that have practical innovation. This company no longer exists and the person John Inglis has been deceased for a considerable amount of time.

These statements attempt to pull back from Applicant's prior response "conced[ing] that the person John Inglis is an integral part of the business."<sup>18</sup> In a

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<sup>16</sup> July 12, 2019 Office Action at 2-3 (<http://inglis.ca>).

<sup>17</sup> 5 TTABVUE 12-13.

<sup>18</sup> October 22, 2019 Response at 1.

subsequent response Applicant explains that its concession “that John Inglis was an integral part of the company [was] incorrect” and it should have stated that “John Inglis is an integral part of the company NAME.”<sup>19</sup>

In the March 24, 2020 Office Action, the Examining Attorney acknowledges Applicant’s statements but addresses the evidence Applicant provided showing a historic “John Inglis and Company” that produced weapons.<sup>20</sup> The Examining Attorney observes:<sup>21</sup>

[Because] applicant’s identification of goods includes weapons, it is still unclear whether there is some formal connection between applicant’s present entity and the historical John Inglis and John Inglis Company. Assuming for the sake of argument that there is no direct succession between applicant and the historical John Inglis, the selection of the name Inglis in connection with a type of goods already associated with that name is not merely coincidental. John Inglis – and his surname INGLIS – is “an integral part of the company NAME.”

Although Applicant does not have anyone named Inglis associated with the business, Applicant’s company name is John Inglis and was named after John Inglis because Inglis conveys a certain level of quality in connection with weapons. As the Examining Attorney explains:<sup>22</sup>

The name “INGLIS” is used by the applicant in its own business name and in the applied-for mark as an appeal to consumers, with the hope or presumption that they

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<sup>19</sup> January 30, 2020 Response at 1.

<sup>20</sup> “By 1943 they were producing 60% of the Bren machine guns ... They also produced a large proportion of the Polsten 20 mm autocannon ... as well as the Browning Hi-Power pistol ... .” January 30, 2020 Response at 2-5 (Wikipedia entry for John Inglis and Company).

<sup>21</sup> March 24, 2020 Office Action at 1.

<sup>22</sup> 7 TTABVUE 17.

recognize the quality conveyed by the name “INGLIS”. Accordingly, the applicant itself relies on “INGLIS” being used as a surname so that consumers interpret it as such and recognize the quality conveyed by the name.

This provides support that INGLIS is primarily merely a surname.

Even if there is sufficient distance between John Inglis and Applicant, the absence of a namesake “does not in itself, reduce the likelihood that the public would perceive the mark as a surname.” *In re Adlon*, 120 USPQ2d 1717, 1724 (TTAB 2016); *see also In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1287 (TTAB 2007) (“The fact, however, that ‘a proposed mark is not applicant’s surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname.’”) (quoting *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004).

C. Whether INGLIS has Any Recognized Meaning Other Than as a Surname

The Examining Attorney submitted an excerpt from the Wordnik website showing no definitions for INGLIS, thus indicating that INGLIS has no other recognized meaning.<sup>23</sup> This further supports the Examining Attorney’s position that the primary significance of INGLIS is as a surname.

Applicant argues that the evidence it submitted points to other meanings. Applicant’s evidence comprises:

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<sup>23</sup> July 12, 2019 Office Action at 4 (<https://www.wordnik.com>).

An excerpt from Encyclopedia.com showing the term INGLIS was used in the 14<sup>th</sup> century by writers...;<sup>24</sup>

An excerpt from Urban dictionary showing it used as a euphemistic name of a small, unimportant town;<sup>25</sup>

An excerpt from Wiktionary showing INGLIS means “English” or a British person in other languages;<sup>26</sup>

INGLIS: a town located in Levy County, Florida;<sup>27</sup> and

A google translate printout showing INGLIS sounds like a Spanish word meaning English.<sup>28</sup>

Applicant characterizes these examples as “quite varied and significant meanings to the term INGLIS aside from” its surname meaning. 5 TTABVue 14. Applicant postulates that “any recognized meaning” contemplates completely obscure meanings, for example, an Old Scots word for English; it does not. Where, as here, there is evidence that the mark at issue is a surname and that it is not a term defined in a dictionary that tends to support a finding that the primary significance of INGLIS is as a surname. *See, e.g., In re Eximius Coffee*, 120 USPQ2d at 1280; *In re Etablissements Darty et Fils*, 225 USPQ at 653-54. The mere existence of other non-surname meanings of a proposed mark does not preclude a finding that it is primarily merely a surname. *See* TMEP § 1211.01(a)(ii); *Mitchell Miller, PC v. Miller*, 105

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<sup>24</sup> January 30, 2020 Response at 11 (encyclopedia.com).

<sup>25</sup> *Id.* at 17 (urbandictionary.com).

<sup>26</sup> *Id.* at 22-23 (en.wiktionary.org). We note in an earlier printout of wiktionary.com attached to the October 22, 2019 Response at 8, it does not include the meaning “British person” and had been last edited two years prior in 2017; however, the printout of this website attached to the January 30, 2020 includes this definition and indicates it was edited a few days prior on January 19, 2020.

<sup>27</sup> October 22, 2019 Office Action at 9 (definitions.net).

<sup>28</sup> January 30, 2020 Response at 24 (translate.google.com).

USPQ2d 1615, 1621 (TTAB 2013) (“the record is devoid of evidence that the non-surname meanings of MILLER, i.e., a mill operator or a moth, are the primary significance thereof or somehow eclipse its surname significance” in connection with legal services); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986) (holding PETRIN primarily merely a surname despite applicant’s argument that the mark represents an abbreviated contraction of “petroleum” and “insulation”); *see also In re Etablissements Darty et Fils*, 225 USPQ at 653-54 (holding DARTY primarily merely a surname despite applicant’s argument that the mark is a play on the word “dart”). Rather, we must consider whether the non-surname meanings eclipse the surname significance of the proposed mark.

The examples submitted by Applicant are not sufficient to rebut the showing of the primary surname significance to consumers. The small town in Florida does not dissipate its surname significance. *In re Hamilton Pharm. Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (geographical meaning relatively minor, HAMILTON primarily merely a surname). Similarly, the other minor and obscure meanings do not constitute a readily recognized meaning to strip it of its primary surname significance. *Id.* There is nothing in the record to indicate that these meanings are readily recognized by the average consumer, and it is not sufficient for Applicant to simply uncover other meanings of the term when the surname significance predominates. *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1367-68 (TTAB 1987). In addition, as the

Examining Attorney explains, the Spanish word for “English” is “Inglés,” not INGLIS, and the two terms are not phonetically equivalent.<sup>29</sup>

We do not believe that these other meanings of the term INGLIS are sufficient to call into question its significance as “primarily merely a surname.” *See e.g., In re Harris-Intertype*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975); *In re The British Oxygen Company Limited*, 161 USPQ 242 (TTAB 1969) (significance of “Boyle” in Boyle’s Law and Boyle temperature is clearly that of a surname); *In re United States Catheter & Instrument Corp.*, 158 USPQ 52 (TTAB 1968) (surnames of doctors may become accepted type designations for medical or surgical appliances). That is, none of this evidence shows that INGLIS has another meaning so common that it is likely to be the primary meaning to the public. *See e.g., Fisher Radio Corp. v. Bird Elec. Corp.*, 162 USPQ 265, 266-67 (TTAB 1969) (BIRD not primarily merely a surname due to ordinary language meaning of “bird”).

In short, while Applicant argues that purchasers would not perceive INGLIS as a surname because of the alternative meanings for INGLIS, the surname significance of INGLIS is far more common and predominant. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d at 1943.

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<sup>29</sup> 7 TTABVUE 19.

D. Whether INGLIS Has the Structure and Pronunciation of a Surname

The Examining Attorney relies on the common surname INGLE to support the position that INGLIS has the structure and pronunciation of a surname.<sup>30</sup> Applicant counters that the evidence “does not specifically point to any particular portion of the evidence to support this position.”<sup>31</sup> While the surname INGLE shares the first four letters, “the mere sharing of a prefix, suffix, or letter string does not result in the sort of structural similarity that is helpful to our analysis.” *In re Adlon*, 120 USPQ2d at 1724. As we have recognized, this inquiry is highly subjective, *In re Eximius Coffee*, 120 USPQ2d at 1280, and on this record we find it carries no weight in the determination.

E. Whether the addition of a background diamond design and the geographic term US Removes the Perception of Primarily Merely a Surname

Applicant argues:<sup>32</sup>

When used in conjunction with the design mark INGLIS in the diamond, the design elements of the mark clearly distinguishes it from a surname. Further, the term US could also be construed as an object of the verb INGLIS, such as INGLIS US or TRY US, or VISIT US or LIKE US. However, without any further context, one cannot determine if the US refers to the United States or a group of people. The diamond border separates the mark from any surrounding text and thus clearly delineates it as a trademark, whereas the absence of the border may allow

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<sup>30</sup> LEXIS/NEXIS surname database showing 19675 entries for the surname INGLE, July 12, 2019 Office Action at 58.

<sup>31</sup> 5 TTABVUE 15.

<sup>32</sup> 5 TTABVUE 15-16.

the mark to be more associated with surrounding text and thus, although unlikely, confused with a surname.

It is well established that combining a surname with a term that is merely descriptive or generic of an applicant's goods and/or services or otherwise not source indicating typically does not "detract from the primary surname significance" of the mark. *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d at 1481-82, 1481 n.9 (construing *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492-93 (Fed. Cir. 1988)); *see also Earnhardt v. Kerry Earnhardt, Inc.*, 123 USPQ2d at 1413 (need to determine whether COLLECTION alters primary significance of mark as a whole), *In re Weiss Watch Co.*, 123 USPQ2d 1200 (TTAB 2017) (holding WEISS WATCH COMPANY for clocks, watches, and related goods primarily merely a surname); *In re Integrated Embedded*, 120 USPQ2d at 1507 (BARR GROUP primarily merely a surname where BARR was the surname of the co-founder and applicant's corporate officer); *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d at 1615 (holding MILLER LAW GROUP for legal services primarily merely a surname); *In re Hamilton Pharms. Ltd.*, 27 USPQ2d at 1939 (holding HAMILTON PHARMACEUTICALS primarily merely a surname for pharmaceutical products); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES primarily merely a surname for hotel and motel services).

The same holds for the geographically descriptive term US. US is defined as the abbreviation for the geographic designation United States.<sup>33</sup> It simply informs the

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<sup>33</sup> "The United States of America (USA), commonly known as the United States (U.S. or US) or America, is a country comprising 50 states, a federal district, five major self-governing



consumer this refers to the US location of the company, and is, therefore, geographically descriptive. We reject Applicant's unsupported speculation that "the term US could also be construed as an object of the verb INGLIS, such as INGLIS US or TRY US, or VISIT US or LIKE US ... ." <sup>34</sup> Thus, we find the addition of US does not detract from the primary significance of the surname INGLIS.

Turning to the background design element, in general the addition of a non-distinctive design element does not remove the primary significance of the proposed mark which, in this case, is that of a surname. Here, the plain single line diamond background shape in which INGLIS is placed is not so unusual or distinctive to convey a separate commercial impression and, therefore, is not sufficient to change the primary significance of the mark as a whole as primarily merely a surname. *See In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998); *In re Anton/Bauer, Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988); *In re Wendy's Int'l, Inc.*, 227 USPQ 884, 885 (TTAB 1985); *In re Haggard Co.*, 217 USPQ 81, 83-84 (TTAB 1982).

Combining these two non-distinctive elements does not add up to a separate commercial impression that alters the primary significance of the mark as a whole as a surname. *Earnhardt v. Kerry Earnhardt, Inc.*, 123 USPQ2d at 1413. <sup>35</sup> This only

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territories, and various possessions." (<https://en.wikipedia.org>) July 12, 2019 Office Action at 70.

<sup>34</sup> 5 TTABVue 15-16.

<sup>35</sup> The dissent refers to an excerpt from *Hutchinson* in a manner that suggests a surname refusal should be issued only when there is nothing else in the proposed mark. However, in a more recent decision, the Federal Circuit made clear that in considering whether a proposed mark is primarily merely a surname, it is important to understand the primary significance of the mark as a whole. As the Court explained: [I]n *Hutchinson*, we did not find that any mark consisting of a surname and a merely descriptive term is registrable as a trademark as

occurs where the additional matter removes the primary significance as merely a surname. *See In re Yeley*, 85 USPQ2d 1150, 1153 (TTAB 2007) (holding that the proposed mark J.J. YELEY was recognized as the full name of the well known NASCAR race driver and as such was perceived as a reference to a particular person and not primarily merely a surname).

Overall, the record contains evidence showing that INGLIS is a surname and that no other meaning exists that surpasses its primary significance as a surname. In addition, the additional geographically descriptive term US and the plain diamond background do not remove the primary surname significance. On this record, the primary significance of the mark as a whole to the purchasing public is that of a surname. On balance, taking all the considerations above together, we find that the proposed mark as a whole is primarily merely a surname within the meaning of Section 2(e)(4).

### III. Decision

The refusal to register is affirmed.

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a matter of law, nor did we find that such a mark is always primarily merely a surname and not registrable as a matter of law.” *Earnhardt v. Kerry Earnhardt, Inc.*, 123 USPQ2d at 1415. In other words, there is no per se rule one way or the other, but the dissent appears to be advocating for just that.

To be clear, in keeping with the instruction from the Federal Circuit, the majority does not find that the designation US and the diamond background design are simply a part of a surname, nor do we “pretend” they do not form part of the commercial impression of the mark as a whole. The finding is that these elements do not remove the primary significance of the mark as a whole as a surname.

**Bergsman, Administrative Trademark Judge, dissenting:**

I respectfully dissent from the majority's decision finding that INGLIS US and design reproduced below is primarily merely a surname.



INGLIS is primarily merely a surname. However, the mark is not INGLIS. As described by Applicant, “The mark consists of the stylized wording ‘INGLIS US’, ‘INGLIS’ over ‘US,’ inside a diamond outline.” The 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.

A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, and 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.

*Hutchinson Tech.*, 7 USPQ2d at 1492 (quoting *Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Com'r Pat.1955))). In this regard, “a mark sought to be registered must be considered in its entirety.” *Id.* The depiction of the name INGLIS over the abbreviation US and within a diamond background conveys more than just a surname. The majority finds that Applicant's mark is primarily merely a surname by characterizing the letters US and the diamond background design as parts of an

individual's surname or pretending they do not form part of the commercial impression engendered by the mark.

The purpose behind prohibiting the registration of marks that are primarily merely surnames is not to protect the public from exposure to surnames, as though there were something offensive in viewing a surname. Rather, 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. *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1924 (TTAB 2007 (Seeherman, J., concurring) (citing *See Kimberly-Clark Corp. v. Marball, Comr. Pats.*, 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."))).

There has been a general reluctance on the part of courts to protect surnames as registrable trademarks. For example, the general rule that the addition of a "first name initial" does not remove a mere surname from being considered to be "primarily merely a surname" stems from *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (CCPA 1953) in which the court found "S. SEIDENBERG & CO'S." to be primarily merely a surname and unregistrable under Section 2(e)(4) (formerly Section 2(e)(3)). In that case, the court found "that 'Seidenberg' is clearly a surname which can have

no other meaning or significance than that of a surname...” and that the addition of the single initial was not sufficient to remove it from that category.

*Lewis Cigar* was an early decision interpreting Section 2(e)(3) of the Trademark Act. The former Trademark Act of 1905 prohibited the registration of marks consisting of the names of individuals and, by interpretation, surnames as the significant portion of an individual’s name. Section 5 of the Trademark Act of 1905, *Ex parte Dallieux*, 83 USPQ 262 (Comr. Pats. 1949). The reluctance to register surnames and individual names under the previous Act has a residual influence, and the Courts and this Board has interpreted the restrictions of Section 2(e)(3), now 2(e)(4), broadly.

However, there is no absolute rule or public policy suggesting that individuals have an absolute right to use their names. *See Ford Motor Co. v. Ford*, 462 F.2d 1405, 174 USPQ 456, 458 (CCPA 1972) (“the interest in allowing an entrepreneur to use his own surname as a trademark on his goods must give way to the more compelling public and private interests involved in avoiding a likelihood of confusion or mistake as to source where use of the surname leads to such confusion or mistake.”). *See also Nina Ricci S.A.R.L. V. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (VITTORIO RICCI for handbags, clothing and retail store services in the field of clothing is likely to cause confusion with NINA RICCI for clothing and accessories even though Vittorio Ricci was the name of defendant’s principal); *Justin Indus., Inc. v. D.B. Rosenblatt, Inc.*, 213 USPQ 968, 976 (TTAB 1981) (“the right to use one’s name in his business [JUSTIN LTD.] may be circumscribed if it conflicts with a mark

previously used by another [JUSTIN] and is likely to cause confusion as to the origin of the business or of the goods sold thereunder.”); *Jack Winter Inc. v. Lancer of Cal., Inc.*, 183 USPQ 445, 446 (TTAB 1974) (DAVID WINTER for clothing is likely to cause confusion with JACK WINTER for clothing); *Girard-Perregaux & Cie, S.A. v. Perregaux*, 122 USPQ 95, 96 (Comm’r. Pats. 1959) (“Paul Perregaux” is likely to be confused with “Girard Perregaux” and “Perregaux”). Therefore, there is no basis for the policy or practice of broadly interpreting the scope of what is “primarily merely a surname.” The Board should restrict the application of what is “primarily merely a surname” to trademarks that consist of a mark that is, and only is, a surname.