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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205331
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

Opposition No.: 91205331 (parent)

Application Serial No. 85/383,910

**Trademark: EARNHARDT COLLECTION
(Intl. Class 20)**

Opposition No.: 91205338

Application Serial No. 85/391,456

**Service Mark: EARNHARDT COLLECTION
(Intl. Class 37)**

**APPLICANT’S BRIEF IN OPPOSITION TO
OPPOSER’S MOTION FOR PARTIAL SUMMARY JUDGMENT**

Applicant, Kerry Earnhardt, Inc. (“KEI”), hereby submits its response to the Motion for Partial Summary Judgment, filed by Opposer, Teresa H. Earnhardt (“Opposer”).

SUMMARY

Opposer’s primary contention—that the mark EARNHARDT COLLECTION for custom homes and furniture is “primarily merely a surname” under Section 2(e)(4) of the Lanham Act (15 U.S.C. § 1502(e)(4) (“Section 2(e)(4)”)—rests on the very line of flawed reasoning that the Federal Circuit rejected in *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988).

First, Opposer ignores *Hutchinson Technology’s* admonition that a mark “must be considered in its entirety,” 852 F.2d at 554, and myopically focuses on the term “Earnhardt” in isolation. The mark at issue, however, is EARNHARDT COLLECTION—a combination of

terms that is neither *primarily* nor *merely* a surname. The fact that KEI has disclaimed exclusive rights to the word “collection” apart from its use in the mark as a whole does not change the analysis. Under *Hutchinson Technology*, the mark still must be analyzed in its entirety. *Id.* (holding that the mark HUTCHINSON TECHNOLOGY must be analyzed in its entirety, but requiring the applicant to disclaim exclusive rights in the term “technology”).

Second, Opposer’s claim that the term “collection” is somehow generic for either custom homes or furniture—and therefore should be ignored—is wrong. The term “collection” does not immediately convey, *or even describe*, furniture or custom homes. Even if Opposer were correct that the term “collection” is often used in connection with furniture or custom homes, it would not mean that the term is descriptive of them. *Hutchinson Technology* holds that mere frequency of use does not render a word generic or descriptive, *id.*, and Opposer has offered no evidence that the purchasing public would understand “collection” to mean custom homes, *or any particular class of goods at all*.

For these reasons, as well as those stated below, Opposer’s motion for partial summary judgment on her surname claim should be denied.

BACKGROUND

This is an action by Opposer, the stepmother of KEI’s CEO and part owner, Kerry Earnhardt, to oppose KEI’s application for registration of EARNHARDT COLLECTION in International Classes 20 and 37 for furniture and the construction of custom homes.¹

KEI is based in Mooresville, North Carolina. (App.’s Resp. to Op.’s Interrog. No. 6, attached to Affidavit of Matthew F. Tilley (“Tilley Aff.”), Ex. 1). Its primary business is the provision of entertainment services and personal appearances by Kerry, a successful former

¹ KEI seeks registration through two applications. On July 18, 2011, KEI filed an application (Serial No. 85/383,910) for EARNHARDT COLLECTION in International Class 20. On August 6, 2011, KEI filed an application (Serial No. 85/391,456) for EARNHARDT COLLECTION in International Class 37.

NASCAR race driver, current television host, and outdoor personality, and his wife Rene Earnhardt. (App.'s Resp. to Op.'s Interrog. No. 5).

The name "Earnhardt" is among the most recognized in automobile racing as a result of the numerous championships and career victories achieved by several generations of the family's members. Kerry Earnhardt is the eldest son of the late seven-time NASCAR Winston-Cup Champion, Dale Earnhardt. Kerry's grandfather, Ralph Dale Earnhardt, began competitive racing in 1949 and was an early stock-car racing star in the 1950s and 60s. Kerry's half-brother, Dale Earnhardt, Jr., is a current NASCAR Sprint Series racecar driver and team owner, and has been named the NASCAR Sprint Series most popular driver ten times, consecutively each year between 2003 and 2012. Kerry's son, Jeffery Earnhardt, currently races in the NASCAR Camping World Truck Series, and has driven in several NASCAR Nationwide races.

Kerry himself raced in the NASCAR Nationwide Series from 1999 to 2009, and in the Sprint Cup series during 2004-2005. Kerry retired as a driver in 2009, and has since been a host and guest host on outdoor-related television shows, and sponsored a number of outdoor-related products. (App.'s Resp. to Op.'s Interrog. No. 5).

KEI licenses the mark EARNHARDT COLLECTION to Schumacher Homes, Inc., for use in connection with a line of custom home designs and construction services, sponsored by Kerry and Rene. (App.'s Resp. to Op.'s Interrog. Nos.7-9). These houses are offered to customers who wish to build custom designed homes, and are delivered to customers on a turn-key basis. (App.'s Resp. to Op.'s Interrog. No. 9) Schumacher launched the EARNHARDT COLLECTION line of homes in October 2011 (App.'s Resp. to Op.'s Interrog. No. 8 and 9), which have been promoted through press events and personal appearances by Kerry and Rene, as well as print and electronic media. (App.'s Resp. to Op.'s Interrog. No. 8).

Opposer filed her initial Notices of Opposition in this matter on May 16, 2012, asserting claims for (i) likelihood of confusion, (ii) dilution, and (iii) false suggestion of connection with a person, living or dead. In March 2013, she moved to amend her Notices of Opposition to add her surname claim. On May 24, 2013, the Board granted Opposer's motion. KEI consented to the motion. Four days later, on May 28, 2013—before answers were filed or due—Opposer filed her present motion for partial summary judgment.

ARGUMENT

The mark EARNHARDT COLLECTION is a composite mark. Thus, pursuant to *Hutchinson Technology* and longstanding precedent, the mark must be considered as a whole. It therefore is not *primarily merely* a surname, as it includes both a surname and an additional term. Further, the term “Collection” is not generic for either furniture or custom homes. Accordingly, Opposer's argument that the Board should exclude the term “Collection” when considering the mark's primary significance is meritless. Opposer's motion for partial summary judgment should therefore be denied as to her surname claim.

I. STANDING AND PRIORITY.

In her motion, Opposer claims standing, as well as priority, based on her ownership of Registration No. 1,644,237, issued May 14, 1991, for the mark DALE EARNHARDT for, *inter alia*, key rings, posters, decals, pocket knives, toys, clothing, and entertainment services. KEI does not dispute Opposer's motion as to these issues.

The classes of goods covered by her pleaded registration, however, are vastly different from those for which KEI seeks to register its EARNHARDT COLLECTION mark—furniture and custom homes. The stark dissimilarity between the goods covered by the parties' marks, as well as the dissimilarities of the marks themselves, belies any assertion by Opposer that priority

alone is somehow dispositive of her likelihood of confusion claim. Moreover, as to Opposer's surname claim, the issue of priority is irrelevant.

II. **OPPOSER FAILS TO ESTABLISH A PRIMA FACIE CASE THAT EARNHARDT COLLECTION IS PRIMARILY MERELY A SURNAME.**

A. ***When Properly Considered as a Whole, Earnhardt Collection is Not Primarily Merely a Surname.***

Throughout her brief, Opposer fails to treat the mark EARNHARDT COLLECTION as a whole, but instead makes her arguments as if the mark included only the term EARNHARDT in isolation. Such a piecemeal analysis is improper.

Section 2(e)(4) bars only the registration of a mark that is “*primarily merely* a surname.” (emphasis added). “In this context, ‘merely’ is synonymous with ‘only’, meaning that the question is whether significance of the mark is only a surname.” *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 15 F.3d 337 (1999); *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 206 (C.C.P.A. 1953); *In re P.J. Fitzpatrick, Inc.*, 95 U.S.P.Q2d 1412, 2010 WL 2513861 (T.T.A.B. 2010).

Where a surname is combined with additional terms or material, the primary significance of the mark must be considered as a whole, not as individual parts. See *Hutchinson Technology*, 852 F.2d at 554 (when assessing whether the public will view a mark primarily as a surname, the “mark sought to be registered must be considered in its entirety”); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 15 F.3d 337 (1999) (“[W]hen the mark at issue is a composite mark consisting of personal names and additional words, the question becomes what the purchasing public would think when confronted with the mark as a whole); *In re Standard Elektrick Lorenz Aktiengesellschaft*, 371 F.2d 870, 152 U.S.P.Q 563 (CCPA 1967) (“A mark must be considered in its entirety.”)

The inclusion of additional terms in a mark, therefore, unless generic negates a claim that the mark is primarily merely a surname. *See Hutchinson Technology*, 852 F.2d at 554 (overturning TTAB ruling that the term HUTCHINSON TECHNOLOGY was primarily merely a surname based on the inclusion of the term “Technology”); *In re P.J. Fitzpatrick, Inc.*, SERIAL 77256618, 2010 WL 2513861 (June 11, 2010); *In re Allied Mills, Inc.*, 150 U.S.P.Q. 757, 757, 1996 WL 7295 (T.T.A.B. 1966) (composite mark “Wayne Fryers” not primarily merely a surname); *Ex Part Norquist Prods. Inc.*, 109 U.S.P.Q. 399, 400, 1956 WL 8063 (Comm’r Pats. 1956) (“Norquist Coronet” held to be “distinctive composite”); *see also California Cooler, Inc. v. Loretto Winery Inc.*, 774 F.2d 1451, 1455 (9th Cir. 1985 (“[A] composite may become a distinguishing mark even though its components individually cannot.”)).

In failing to treat the mark EARNHARDT COLLECTION as a whole, Opposer ignores these principles, and adopts the very line of flawed reasoning that the Federal Circuit rejected in *Hutchinson Technology*. In that case, the TTAB denied registration to the mark HUTCHINSON TECHNOLOGY for computers, on the grounds that it was primarily merely a surname. Like Opposer in this case, the TTAB reasoned that the additional term “Technology” was frequently used in connection with computers, and thus concluded that inclusion of the term did not remove the primary surname significance of the mark. The Federal Circuit reversed, holding:

Here, the board failed to establish a prima facie case that HUTCHINSON TECHNOLOGY is primarily merely a surname. . . . [C]ontrary to the board’s consideration of the HUTCHINSON mark, a mark sought to be registered should be considered in its entirety. The board considered the mark as two separate parts, “Hutchinson” and “technology.” . . . However, the fatal flaw in the board’s analysis is that the mark sought to be registered is not HUTCHINSON or TECHNOLOGY, but HUTCHINSON TECHNOLOGY.

852 F.2d at 555. The Court concluded that the term “Technology” was neither generic nor merely descriptive for computers, and therefore was improperly disregarded in the Board’s analysis. *Id.* at 554-55.

The holding in *Hutchinson Technology* controls this case. Here, the mark at issue is not EARNHARDT or COLLECTION, but EARNHARDT COLLECTION. Opposer fails to show that the combined mark is “only” or “primarily merely” a surname. Indeed, Opposer cannot make such a showing because, as in *Hutchinson Technology*, the composite mark includes a term that is not a surname. When considered as a whole, the mark cannot be said to be “only” or “merely” a surname.

B. “Collection” is Not a Generic Term for Either Custom Homes or Furniture.

After analyzing the term “Earnhardt” in isolation—without any consideration of the mark EARNHARDT COLLECTION as a whole—Opposer attempts to rescue her flawed analysis by arguing that the term “Collection” is generic for furniture, custom homes, or both, and therefore should be disregarded. To support that claim—though it runs contrary to any accepted definition—Opposer attempts to show that the term “Collection” is used with some frequency in connection with both furniture and custom homes, which she equates with being “generic.”

Once again, Opposer’s motion mirrors the very line of reasoning rejected in *Hutchinson Technology*. There, the Federal Circuit reversed the TTAB’s conclusion that the term “Technology” was commonly used in connection with computers and thus was “merely descriptive” of the goods offered under the mark. 852 F.2d at 554-55. The Court observed that mere frequency of use is insufficient to show that a term is generic or merely descriptive, holding:

The key to the board's decision is its reliance on Hutchinson's concession that “technology” is used on many goods similar to those listed in Hutchinson's application. However, the fact that the term “technology” is used in connection

with computer products does not mean that the term is descriptive of them. Many other goods possibly may be included within the broad term “technology,” but that does not make the term descriptive of all of those goods. . . .

. . .[W]e hold that the board clearly erred by finding that the term “technology” is merely descriptive of Hutchinson's goods. “A mark is ‘merely descriptive’ [of a product] if it ‘would immediately convey to one seeing or hearing it the thought of appellant's [product].’” As Hutchinson points out, “technology” is a very broad term which includes many categories of goods. The term “technology” does not convey an immediate idea of the “ingredients, qualities, or characteristics of the goods” listed in Hutchinson's application. Therefore, the term “technology” is not “merely descriptive” of Hutchinson's goods, and we conclude that the board's finding that the term “technology,” standing alone, is merely descriptive of Hutchinson's goods is clearly erroneous.

Id. (citations omitted).

As revealed by Opposer’s assertion that the term “Collection” is commonly used for *both* furniture *and* custom homes (two distinctly different products), the term is not generic for either. Instead, like the term “Technology,” the term “Collection” is a “broad term” that encompasses many types of goods. It does not describe any particular characteristic of the goods or services offered under the EARNHARDT COLLECTION mark.

In order for a term to be generic, it must be “‘generally a common description of goods’ or services or refer[] ‘to the genus of which the particular product is a species.’” *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 15 F.Supp.2d 389, 394 (S.D.N.Y. 1998) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976)). In *Hutchinson Technology*, the Court explained that a mark is “merely descriptive,” if it “‘immediately conveys to one seeing or hearing it the thought [of the product].’” *Id.* 852 F.2d at 555 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986)).

Granted, an applicant may not avoid a surname objection merely by adding a generic term for the goods or services she offers under the mark. *See In re Hamilton Pharms. Ltd.*, 27 U.S.P.Q.2d 1939 (T.T.A.B. 1993). The term “Collection,” however, is not generic for furniture or the construction of custom homes.

The dictionaries define “collection” as follows:

“[T]he body formed by gathering; an assemblage, or assembly; as, a *collection* of books or paintings; a *collection* of strangers”

WEBSTER’S NEW TWENTIETH CENTURY DICTIONARY, UNABRIDGED 355 (Jean L. McKechnie, et al., eds., 2d Ed. 1983) (Tilley Aff. Ex. 2).

“2. A group of objects or works to be seen, studied, or kept together.

3. An accumulation; a deposit; *a collection of dust on the piano.*”

See AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 327 (3d Ed. 1996) (Tilley Aff. Ex. 3).

Thus, the word “Collection” has various meanings: It can refer to a data collection, a museum collection, taking up a collection for a charitable cause, collections of antiques or other valuables or collections of objects generally. What is key, however, is that the term “Collection” does not refer to, or immediately convey, any particular type of good or services. Likewise it does not describe any particular characteristic of furniture or custom homes. If a member of the public were offered “a collection,” her most likely reaction would be to ask, “A collection of what?”

The term “Collection” is materially similar to the term “Technology” in *Hutchinson Technology*. It is “a broad term” that may include many goods other than those to be offered under the applied-for mark. Accordingly, it is neither generic nor merely descriptive.

C. *KEI’s Disclaimer of Rights to the Term “Collection,” Apart from Use In the Mark as a Whole, Does Not Change the Analysis.*

At the conclusion of her brief, Opposer also suggests that the term “Collection” should be disregarded because KEI disclaimed any right to Collection alone (other than as used in the mark). That argument is a red herring. In *Hutchinson Technology*, the Court concluded the case by remanding with instructions that the applicant disclaim rights to “Technology.” 852 F.2d 356-57. That is, the Court considered the mark as a whole, even though it required a disclaimer.

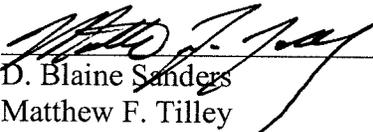
Thus, regardless of the disclaimer, in this case, the Board should still consider the mark EARNHARDT COLLECTION as a whole.

Opposer has not shown, and cannot show, that the term "Collection" is generic for either furniture or the construction of custom homes. Thus, because the mark EARNHARDT COLLECTION is a composite mark that must be considered as a whole, Opposer cannot make a *prima facie* case that EARNHARDT COLLECTION is primarily merely a surname. Her motion for partial summary judgment on her surname claim should therefore be denied.

CONCLUSION

For the reasons stated above, KEI requests that the Board deny Opposer's motion for partial summary judgment concerning her surname claim.

This the 1st day of August, 2013.



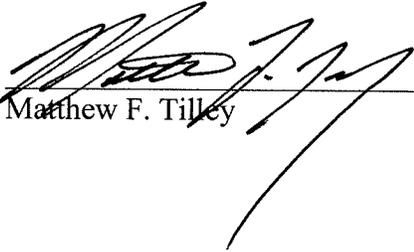
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing has been served upon the party listed below by depositing same in the United States mail, postage prepaid, in an envelope(s) addressed as follows:

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This 1st day of August, 2013.


Matthew F. Tilley