

ESTTA Tracking number: **ESTTA555019**

Filing date: **08/20/2013**

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

Proceeding	91205331
Party	Plaintiff Ms. Teresa H. Earnhardt
Correspondence Address	LARRY C JONES ALSTON BIRD LLP 101 S TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280 4000 UNITED STATES Larry.Jones@Alston.com
Submission	Reply in Support of Motion
Filer's Name	Carla H. Clements
Filer's e-mail	carla.clements@alston.com, larry.jones@alston.com
Signature	s/Carla H. Clements/
Date	08/20/2013
Attachments	EARNHARDT COLLECTION Opposition - SJ Reply Brief.pdf(29788 bytes )

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

Teresa H. Earnhardt,

Opposer,

v.

Kerry Earnhardt, Inc.,

Applicant.

Consolidated Opposition Nos.  
91205331 (parent) and 91205338

In the matter of:

Application Serial No. 85/383,910  
Mark: EARNHARDT COLLECTION  
(Intl. Class 20)

Application Serial No. 85/391,456  
Mark: EARNHARDT COLLECTION  
(Intl. Class 37)

**OPPOSER’S REPLY BRIEF IN SUPPORT OF  
MOTION FOR PARTIAL SUMMARY JUDGMENT**

**INTRODUCTION**

Opposer, Teresa H. Earnhardt (“Opposer”), through her undersigned counsel, hereby respectfully requests, pursuant to Rule 56(a) of the Federal Rules of Civil Procedure, 37 C.F.R. § 2.127 and TBMP § 528, entry of summary judgment in her favor and against Applicant, Kerry Earnhardt, Inc. (“Applicant”), on the issues of (i) standing; (ii) priority; and (iii) that the designation EARNHARDT COLLECTION is primarily a surname when used in connection with the particular goods and services listed in the opposed applications. When the designation EARNHARDT COLLECTION is considered as a whole, the inclusion of the term COLLECTION does not diminish the designation’s primary significance as a surname in conjunction with either furniture or custom homes. Rather, the term COLLECTION is a generic or highly descriptive term when used in conjunction with furniture or custom homes and fails to transform the

primary significance of EARNHARDT COLLECTION from primarily merely a surname to a non-surname source identifier. Accordingly, Opposer respectfully requests that the Board grant summary judgment on these issues in her favor.

## **ARGUMENT**

### **I. Opposer is Entitled to Summary Judgment on Each of the Issues of Standing and Priority.**

Opposer has established standing and priority based on her ownership of U.S. Trademark Registration No. 1,644,237, which Applicant does not dispute. Applicant's assertions of dissimilarity between the marks and goods at issue are irrelevant for purposes of this motion. Thus, Opposer is entitled to summary judgment on each of the issues of standing and priority.<sup>1</sup>

### **II. Inclusion of the Term COLLECTION Does Not Diminish the Surname Significance of the Composite Designation EARNHARDT COLLECTION When Used With Furniture or Custom Homes.<sup>2</sup>**

“[I]t is well-settled that whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname.” *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993). Applicant correctly notes that “when 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.” *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 346 (2d Cir. 1999). “However, the inclusion in a mark of a generic or *merely descriptive term* does not preclude its surname significance if, when considered

---

<sup>1</sup> While Applicant refers in its brief to an “assertion by Opposer that priority alone is somehow dispositive of her likelihood of confusion claim” (App. Brief at 4-5), Opposer has not made any such assertion.

<sup>2</sup> It appears from Applicant's brief that it does not challenge Opposer's contention that the term EARNHARDT is primarily merely a surname.

as a whole, the primary significance of the mark to the purchasing public is that of a surname.” *In re Hamilton Pharms.*, 27 USPQ2d at 1940 (emphasis added).<sup>3</sup>

Accordingly, the issue is whether the combination of the term COLLECTION with the surname EARNHARDT, when viewed in its entirety and used in conjunction with the particular goods and services listed in the opposed applications, diminishes the surname significance of EARNHARDT such that the primary significance of the composite term, when used as a designation for those goods and services, is other than as a surname.

*Miller v. Miller*, 105 USPQ2d 1615, \*18-19 (TTAB 2013).

As reflected hereinafter, COLLECTION is frequently used generically or in a highly descriptive manner in connection with furniture or custom homes. Consequently, when the term COLLECTION is added to the surname EARNHARDT to form the designation EARNHARDT COLLECTION, the primary significance of the designation, as a whole, in connection with either furniture or custom homes, remains a surname. *See In re Hamilton Pharms.*, 27 USPQ2d at 1940; *In re E. Martinoni Co.*, 189 USPQ 589, 590 (TTAB 1975) citing *In re Louis De Markus Corp.*, 136 USPQ 677, 677 (TTAB 1963) (“the descriptive word ‘process’ adds nothing to registrability of ‘Duffey Process’”). Similar to adding BRASSERIE to the surname LIPP for restaurant services, PETITE SUITES to the surname WOOLLEY’S for hotel and motel services, and LAW GROUP to the surname MILLER for legal services, appending the term COLLECTION to the surname EARNHARDT does not diminish the primary significance of the

---

<sup>3</sup> Applicant repeatedly asserts erroneously in its brief that, because the opposed designation, EARNHARDT COLLECTION, includes both a surname and an additional term, the composite designation cannot be deemed primarily merely a surname. *See, e.g.* App. Brief at 4 (“It therefore is not *primarily merely* a surname, as it includes both a surname and an additional term”) and App. Brief at 7 (“Opposer cannot make such a showing because . . . the composite mark includes a term that is not a surname”).

composite designation as a surname when that designation is used in conjunction with furniture or custom homes. *See Miller*, 105 USPQ2d 1615, *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991), *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991). Thus, Applicant's EARNHARDT COLLECTION designation, considered, as a whole, would be perceived by those who encounter it in conjunction with the marketing and sales of custom homes or furniture as primarily merely a surname.

**III. The Term COLLECTION is a Generic or Highly Descriptive Term When Used in Conjunction With Furniture or Custom Homes.**

Applicant's opposing brief relies almost exclusively on the decision in *Hutchinson Technology*, an *ex parte* case in which the issue was whether, in rejecting the subject application and refusing to publish it for opposition, the PTO had satisfied its burden of establishing a *prima facie* case that HUTCHINSON TECHNOLOGY was perceived as primarily merely a surname when used in conjunction with particular computer components.<sup>4</sup> Unlike the evidence of record pertaining to the term "technology," as applied to computer components in *Hutchinson Technology*, the uncontroverted evidence of record in this case easily supports Opposer's claim that the term COLLECTION is a generic or highly descriptive term when used in conjunction with either furniture or custom homes. *See The Sea Island Co. v. Kroehler Corp.*, Nos. 91120712 and 91121447, \*32 (TTAB March 21, 2005), available at <http://ttabvue.uspto.gov/ttabvue/ttabvue-91120712-OPP-53.pdf> ("The term **COLLECTION in applicant's mark, SEA ISLAND COLLECTION, is unquestionably descriptive, if not generic, in connection with a line of furniture.**").

---

<sup>4</sup> Applicant misinterprets *Hutchinson Technology* as supporting the fallacious proposition that "[t]he inclusion of additional terms in a mark, therefore, unless generic negates a claim that the mark is primarily merely a surname." App. Brief at 6.

As Applicant noted, the word “collection” is used to refer to a group, gathering, or assemblage of something, such as a collection of books or a collection of paintings. App. Brief at 9. The evidence of record demonstrates adequately, and without challenge by Applicant, that the term COLLECTION is generic or highly descriptive of Applicant’s goods which are a group, gathering, compilation or assemblage of furniture and custom homes. Moreover, Applicant admits in its brief that its EARNHARDT COLLECTION designation is used in connection with a “line” of custom home designs and construction services. App. Brief at 3. Because the term COLLECTION is generic or highly descriptive when used in conjunction with a line of furniture or a line of custom homes, the predominant portion of the designation is EARNHARDT. *See The Sea Island Co.*, Nos. 91120712 and 91121447, at \*32 (holding that the term SEA ISLAND is the dominant portion of the SEA ISLAND COLLECTION mark because the term COLLECTION is descriptive of a line of furniture). As a result, the generic or highly descriptive term COLLECTION “adds nothing in the way of trademark significance” to the dominant portion of the EARNHARDT COLLECTION furniture or custom homes designation. *See also In re Mannington Mills, Inc.*, No. 78783771, \*11 (TTAB April 22, 2008) available at <http://ttabvue.uspto.gov/ttabvue/ttabvue-78783771-EXA-13.pdf> (holding that “the descriptive word ‘oak’ adds nothing in the way of trademark significance to the surname HARRINGTON” in connection with flooring). As noted in Opposer’s Motion for Partial Summary Judgment, at least 35 companies use the term COLLECTION to refer to their furniture, and at least 30 companies use the term COLLECTION to refer the custom construction of homes. Thus, the term COLLECTION in combination with the surname EARNHARDT, when used with either

furniture or custom homes, fails to transform the surname significance of the composite term. Instead, the primary significance of the furniture or custom home designation EARNHARDT COLLECTION, considered as a whole, remains that of a surname.

**CONCLUSION**

For each of the foregoing reasons, Opposer is entitled to summary judgment in this proceeding on the issues of (i) standing; (ii) priority; and (iii) the merits of Opposer's claim under Section 2(e)(4) of the Lanham Act. Accordingly, each opposition should be sustained.

Dated: August 20, 2013

Respectfully submitted,

s/Larry C. Jones/  
Larry C. Jones  
Carla H. Clements  
Attorney for Opposer  
Alston & Bird LLP  
101 S. Tryon Street, Suite 4000  
Charlotte, North Carolina 28280-4000  
Telephone: (704) 444-1000

**CERTIFICATE OF SERVICE**

I hereby certify that on the foregoing *Opposer's Reply Brief in Support of Motion for Partial Summary Judgment* was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 20th day of August, 2013 addressed to Applicant's attorneys of record as follows:

D. Blaine Sanders  
Matthew F. Tilley  
Robinson Bradshaw & Hinson, P.A.  
101 N. Tryon Street, Suite 1900  
Charlotte, NC 28246-0106

By: s/Carla H. Clements/  
Carla H. Clements