

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Simon Family Wines, LLC

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Serial No. 97608809

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Karin H. Butchko of Carlson, Gaskey & Olds, P.C.,
for Simon Family Wines, LLC.

Michael Furda, Trademark Examining Attorney, Law Office 129,
Pamela Y. Willis, Managing Attorney.

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Before Greenbaum, Heasley, and Coggins,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Simon Family Wines, LLC (“Applicant”) seeks registration on the Principal Register of the mark SIMON FAMILY WINES (in standard characters, with FAMILY WINES disclaimed) for “wines” in International Class 33.¹

The Trademark Examining Attorney refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that Applicant’s proposed

¹ Application Serial No. 97608809 was filed on September 27, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

mark is primarily merely a surname. When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.

I. Primarily Merely a Surname

Section 2(e)(4) of the Trademark Act precludes registration of a proposed mark on the Principal Register that is “primarily merely a surname” without a showing of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).² “A mark is primarily merely a surname if the surname is the primary significance of the mark as a whole to the purchasing public.” *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (citation and internal quotation marks omitted); *see also In re Six Continents Ltd.*, 2022 USPQ2d 135, at *6 (TTAB 2022), *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1277 (TTAB 2016). Whether the primary significance of a mark is primarily merely that of a surname is a question of fact that must be resolved on a case-by-case basis, considering the record as a whole. *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017).

To determine whether the purchasing public would perceive Applicant’s SIMON FAMILY WINES mark as primarily merely a surname, there are multiple inquiries

² As noted in footnote 1, the involved application was filed based on Applicant’s intent to use the mark in commerce; therefore, absent limited circumstances not applicable in this case, Applicant could not include a claim of acquired distinctiveness. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1212.09(a) (May 2024).

and sources of evidence that may be probative, including the following three that are pertinent to this appeal:

- Whether anyone connected with Applicant has the surname SIMON;
- Whether SIMON has a non-surname meaning; and
- The extent to which SIMON is used by others as a surname.

In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). See also *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995) (listing these and additional inquiries); *Eximius Coffee*, 120 USPQ2d at 1278 & n.4 (reviewing factors to be considered, noting no need to discuss inquiries for which the record lacks relevant evidence). These inquiries are not exclusive; any of them, singly or in combination, along with other relevant circumstances, may shape the analysis in a particular case. *In re Colors in Optics, Ltd.*, 2020 USPQ2d 53784, *1-2 (TTAB 2020) (citing *Azeka*, 122 USPQ2d at 1480); *Eximius Coffee*, 120 USPQ2d at 1278.

We consider the record and arguments to determine whether the proposed mark SIMON FAMILY WINES as a whole is primarily merely a surname. For a proposed mark such as SIMON FAMILY WINES, which includes additional words along with the term asserted to be a surname, the analysis of the mark as a whole involves addressing the issue of the surname significance of SIMON, and then assessing whether the additional words FAMILY WINES “alter the primary significance of the mark as a whole to the purchasing public.” *Earnhardt*, 123 USPQ2d at 1415; see also *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988) (surname refusal assessing surname significance of HUTCHINSON, and then “what

the purchasing public would think when confronted with [HUTCHINSON TECHNOLOGY] as a whole”).

We conduct our analysis from the perspective of the purchasing public because “it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance.” *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm’r Pat. 1955)). Here, because Applicant’s goods are “wines,” the purchasing public comprises all adult members of the general public who buy or drink wine. *Cf. In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 (TTAB 2018) (in a likelihood of confusion analysis involving wine, “[t]he relevant purchasers are ordinary consumers in the United States who purchase wine[.]”).

A. Whether Anyone Connected with Applicant Has the Surname SIMON

The Examining Attorney presented evidence from Applicant’s website showing that SIMON is the surname of both Sam Simon, the founder of Applicant, and Nada Simon, Sam’s wife and business partner.³ Similarly, the website advertises Applicant as a family-focused business (e.g., “Welcome to our family” and “family means everything to us”) and features images of Sam and Nada with their sons Michael and Peter in a vineyard.⁴ *See Darty*, 225 USPQ at 653 (finding that DARTY is primarily

³ November 23, 2022 Office Action at 10. Citations to the prosecution record in this decision refer to the .pdf version of the TSDR system; citations to the briefs in the appeal record refer to the TTABVUE docket system.

⁴ November 23, 2022 Office Action at 9, 12.

merely a surname in part because it “is not only the surname of the principal of the business, but also is used in the company name in a manner which reveals its surname significance”). Applicant presents no argument or evidence to the contrary.

Promotional materials touting a founder whose surname is in the mark support public perception of the mark primarily as a surname. *Olin Corp.*, 124 USPQ2d at 1332 (citing *In re Adlon Brand GmbH & Co.* 120 USPQ2d 1717, 1722 (TTAB 2016) (finding evidence clearly indicated “that the hotel was named ADLON because that was the surname of its founder, and was subsequently held out as a family operation. It is interlaced with references to persons bearing the surname ADLON who were involved in founding, managing, or promoting the hotel.”)); *see also In re Integrated Embedded*, 120 USPQ2d 1504, 1506-07 (TTAB 2016) (applicant’s website showing, discussing the credentials of, and enabling visitors to contact applicant’s “Namesake” and Chief Technical Officer Thomas Barr serve to reinforce the primary significance of BARR as a surname in the proposed mark BARR GROUP).

Applicant’s website emphasizes the Simon family connection, and shows how the public would tend to perceive SIMON FAMILY WINES as a surname. *See Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620 (TTAB 2013) (“That Applicant’s name is [Michele Ballard] MILLER strengthens the inference that the public will perceive the term as a surname.”).

B. Whether SIMON Has a Non-Surname Meaning

In an attempt to demonstrate that SIMON is not primarily merely a surname, Applicant introduced screenshots of Yahoo! search engine results for “simon.”⁵ Applicant does not mention this evidence in its brief, but when the search results were originally submitted, Applicant argued that “[a]lmost all the hits relate to Simon as a first name or retail real estate [sic]. As such, the word [‘S]imon[’] is not primarily merely a surname.”⁶

While the Yahoo! search result list itself is properly of record, none of the individual items or webpages listed in the results has been made of record. We initially note that most of the entries on the six pages of search results are duplicates. Contrary to Applicant’s assertion that “[a]lmost all the hits relate to Simon as a first name,”⁷ we observe that most of the entries refer to the musician Paul Simon, including all three of the “Top Stories” and the first video hit.⁸ Nonetheless, the truncated entries also include references to Simon Cowell, Simon Sinke, Simon Shopping Malls, and “Simon” as a biblical name and a boy’s name.⁹

Generally, truncated results from search engines are entitled to little weight. *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results—which provide little context to discern how a term is actually used on the web

⁵ May 23, 2023 Response to Office Action at 5-10.

⁶ May 23, 2023 Response to Office Action at 1.

⁷ May 23, 2023 Response to Office Action at 1.

⁸ See May 23, 2023 Response to Office Action at 5-10.

⁹ See May 23, 2023 Response to Office Action at 5-10.

page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations.”); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); *In re Tea & Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google search results entitled to little weight without additional evidence of how the searched term is used). Nonetheless, even assuming that the truncated Yahoo! search results demonstrate that “Simon” may also be a male first name, we keep in mind that “[t]he question is not whether a mark having surname significance might also have a non-surname significance, but whether, in the context of the goods . . . at issue, that non-surname significance is the mark’s primary significance to the purchasing public, thus eclipsing and relegating the mark’s surname significance to secondary rather than primary status.” *Miller*, 105 USPQ2d at 1621.


In a similar vein, Applicant argues in its appeal brief that because “numerous trademark registrations are registered with the USPTO that include the word ‘simon’, . . . [t]he word ‘simon’ in SIMON FAMILY WINES is not primarily merely a surname.”¹⁰ In support of this argument, Applicant cites to 29 third-party registrations for marks that contain the name SIMON plus additional matter,

¹⁰ 6 TTABVUE 2-3.

registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f).¹¹

Seven of the examples lend support to Applicant's earlier argument that SIMON may be a first name: for example, SIMON CARTER (for clothing), SIMON CHANG (for clothing), SIMON FISCHER (for cake and pie filling), SIMON MILLER (for clothing), SIMON PIERCE (for lamps, clocks, glassware, retail services, and restaurants), SIMON QUICK (for financial services), and SIMON SPURR (for clothing).¹² These examples convey the commercial impression of a full personal name and thus are not primarily merely a surname. *See In re P.J. Fitzpatrick*, 95 USPQ2d 1412, 1414 (TTAB 2010) (initials P.J. coupled with surname Fitzpatrick would be perceived as a given name and thus comprises an entire personal name, not merely a surname).

Others, such as the following, are coupled with design elements and would be perceived by consumers as more than primarily merely a surname. *Benthin*, 37

TTABVUE at 1334 (stylized display of  is a factor weighing against a finding that the term BENTHIN would be perceived as primarily merely a surname).

¹¹ 6 TTABVUE 3-4 (table of registrations); October 26, 2023 Request for Reconsideration at 9-71 (TESS printouts of 30+ registrations). Although Applicant lists 32 registrations, we do not include or consider Registration Nos. 1709751, 3108427 or 5724446. Two of these issued under Section 44(e) or 66(a) and do not demonstrate exposure of the mark prior to registration through use in commerce and, therefore, have no probative value. *See, e.g. Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1221 (TTAB 2011). The other was not submitted, so we cannot determine the registration basis, register, mark, or goods/services.

¹² October 26, 2023 Request for Reconsideration at 12-15, 26-27, 34-35, 38-39, 42-43, 50-51.



Still other marks include additional distinctive matter so the marks as a whole would not be perceived as primarily merely a surname. *See* TMEP § 1211.01(b)(vii) (“If the wording combined with the surname is inherently distinctive (i.e., matter that is fanciful, arbitrary, or suggestive), the mark is not considered to be primarily merely a surname under §2(e)(4).”). For example: SIMON 451 (for books), SIMON DOES (for graphic design), SIMON ELEMENT (for books), SIMON SAFETY BEAR (for teaching materials), SIMON VERSUS (for clothing), SIMON SAYS (for editing software), and SIMON PULSE (for books).¹⁴

None of the third-party registrations are for marks that include the term FAMILY WINERY, or even just FAMILY, and none are for marks identifying wine or wine-related services. But “[e]ven if some prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.” *In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

¹³ October 26, 2023 Request for Reconsideration at 16-17, 28-29, 48-49, 56-57.

¹⁴ October 26, 2023 Request for Reconsideration at 8-9, 20-23, 46-47, 52-53, 58-59, 70-71.

C. The Extent to which SIMON is Used by Others as a Surname

Next, “we consider the frequency of, and public exposure to, [SIMON] as a surname . . . keeping in mind that [t]he relevant question is not simply how frequently a surname appears . . . but whether the purchasing public for Applicant’s [goods] is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *In re tapio GmbH*, 2020 USPQ2d 11387, at *9 (TTAB 2020) (internal citation omitted) (quoting *In re Beds & Bars*, 122 USPQ2d at 1551).

The Examining Attorney introduced the following evidence of public exposure to SIMON as a surname:

- Search results from the LexisNexis Surname Database showing 214,286 entries for “Simon,” with representative samples showing individuals with this surname found widely distributed across the country;¹⁵
- The Forebears website showing “Simon Surname” and indicating that SIMON is “457th Most Common surname in the World,” with an “Incidence” of 104,003 in the United States, where it “Ranks” 366 with a “Frequency” of 1:3,485;¹⁶ and
- Articles from multiple news sources reporting on people with the surname SIMON, including musicians Carly Simon and Paul Simon, poker player Gilles Simon, Indiana Pacers (basketball team) owner Herb Simon, and politician Steve Simon, among others.¹⁷

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

Applicant does not dispute any of this evidence. We find the evidence sufficiently

¹⁵ November 23, 2022 Office Action at 15-17.

¹⁶ November 23, 2022 Office Action at 18-19.

¹⁷ November 23, 2022 Office Action at 32-46; December 6, 2023 Reconsideration Denied at 8-45, 59-64.

probative to establish that the purchasing public has been exposed to the surname SIMON. *See tapio*, 2020 USPQ2d 11387, *9; *Eximius Coffee*, 120 USPQ2d at 1280.

D. Additional Matter in the Mark, and the Mark as a Whole

While the evidence above indicates that consumers would understand SIMON as a surname, we must consider the proposed mark SIMON FAMILY WINES as a whole. *Earnhardt*, 123 USPQ2d at 1413 (“[T]he PTO must consider the mark ‘in its entirety’ rather than merely ‘consider[ing] the mark as two separate parts’”). In the context of the proposed mark, Applicant disclaimed FAMILY WINES after the Examining Attorney repeatedly noted that FAMILY WINES is merely descriptive of Applicant’s wine.¹⁸

We consider FAMILY WINES highly descriptive of the goods identified by Applicant, and in the context of SIMON FAMILY WINES as a whole, the additional wording enhances the surname significance of SIMON. A family is “[a] group of persons related by descent or marriage,” and a surname is “[a] name shared in common to identify the members of a family, as distinguished from each member’s given name. Also called **family name, last name.**”¹⁹ Adding FAMILY immediately

¹⁸ November 23, 2022 Office Action at 4-5 (disclaimer required); July 26, 2023 Final Office Action at 4-5 (disclaimer required); October 26, 2023 Request for Reconsideration at 4 and 67 (disclaiming “family wines”). While Applicant disclaimed “family wines,” the full disclaimer is not yet reflected in the Office’s database; however, this administrative oversight does not affect our analysis.

¹⁹ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (ahdictionary.com, accessed August 13, 2024) (original emphasis in italics). The Board may take judicial notice of dictionary evidence, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including from online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

after SIMON in the mark creates the overall impression that SIMON is the surname (i.e., family name) of the owner of the winery making Applicant's goods. The following Internet evidence submitted by the Examining Attorney makes this clear, demonstrating that it is common for wineries to be run as family businesses, identifying in a winery name the surname of the family who runs it, and using the term "family winery" or the like to describe their operations:

- Benton Family Wines ("Benton Family Wines is a boutique, family-owned and operated winery in Napa Valley. Our family works to produce wines of balance");²⁰
- Hamel Family Wines (Pamela Hamel and George Hamel, Jr, vintners; John Hamel, II, director of winegrowing);²¹
- Jackson Family Wines ("Farmers from the beginning, Jess Stonestreet Jackson, Jr. and his family buys an aging orchard in Lake County The Jackson Family continues to be the leading producer of chardonnay. . . . The family purchase[d] part of the historic Tepusquet Vineyard on the Santa Maria Bench");²²
- Hope Family Wines ("The Hope family has been farming in Paso Robles for more than 30 years.");²³
- Conway Family Wines ("Since before our family's leap into the wine business, sibling trio Tom, Gillian, and John Conway have always shared a passion for Santa Barbara wines. . . . Our parents Chris and Ann Conway and our siblings Gareth and Sally Conway Wood are incredibly supportive of our dreams and are always there to bring new ideas, taste through new wines, and inspire us. All seven of us share ownership in Conway Family Wines.");²⁴

²⁰ November 23, 2022 Office Action at 47.

²¹ July 26, 2023 Final Office Action 7, 9.

²² July 26, 2023 Final Office Action 18-19.

²³ July 26, 2023 Final Office Action 22.

²⁴ July 26, 2023 Final Office Action 29-30.

- Inman Family Wines (“Kathleen Inman is the owner, winemaker, and general manager of Inman Family Wines”);²⁵
- Scheid Family Wines (“Family owned and operated, Scheid Family Wines vineyards are located along a 70-mile spread of the Salinas Valley in the Monterey AVA. . . . The Scheid family – Al, Scott, and Heidi – along with our dream team of employees, are passionate about crafting the best wine possible”);²⁶
- Trombetta Family Wines (“Rickey Trombetta, mother and owner, grew up in Sonoma County. . . . After learning the ins and outs of the industry . . . , [her daughter] Erica joined the family team as winemaker in 2014.”);²⁷
- McManis Family Vineyards (“Family owned and operated since 1990 by Ron and Jamie McManis Justin McManis, Tanya McManis Heuvel, and son-in-law Dirk Heuvel . . . all work full time at McManis Family Vineyards. The McManis family has been growing grapes in this region for five generations.”);²⁸ and
- Ackerman Family Vineyards (“Here at Ackerman Family Vineyards, we value wines that are rooted in tradition but made in the spirit of today.”).²⁹

We find that the addition of FAMILY WINES to SIMON in Applicant’s mark enhances, rather than diminishes, the overall likely consumer perception that SIMON is the surname of the owner of the winery where Applicant’s goods are produced or sourced. *See In re Piano Factory Grp. Inc.*, 85 USPQ2d 1522, 1527 (TTAB 2006) (finding that adding the familial entity designation “& SONS” to the surname VOSE emphasized and reinforced the surname significance of VOSE); *see also Darty*, 225 USPQ at 653 (addition of familial reference “et Fils,” which translates as “and

²⁵ July 26, 2023 Final Office Action 31.

²⁶ July 26, 2023 Final Office Action 37.

²⁷ July 26, 2023 Final Office Action 41.

²⁸ November 23, 2022 Office Action at 50.

²⁹ November 23, 2022 Office Action at 52.

Son,” is “in itself . . . highly persuasive that the public would perceive DARTY as a surname.”).

E. Conclusion

The evidence demonstrates that SIMON is an actual surname to which the public has had a reasonable degree of exposure. The evidence also demonstrates that SIMON is the surname of multiple people associated with Applicant. Although there is evidence of record demonstrating that SIMON may sometimes have non-surname significance as a given name, the addition of the term FAMILY WINES to SIMON in Applicant’s mark strengthens the overall perception that SIMON in Applicant’s mark is a surname. We find that the primary significance of SIMON FAMILY WINES to the purchasing public is that of a surname within the meaning of Section 2(e)(4) of the Trademark Act.

II. Decision

The refusal to register Applicant’s mark SIMON FAMILY WINES is affirmed.