

This Opinion is not a
Precedent of the TTAB

Mailed: February 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Pro Eagle LLC

—
Serial No. 97738815

—
Stephen C. McArthur and Thomas E. Dietrich of The McArthur Law Firm, PC,
for Pro Eagle LLC.

Nick Altree, Trademark Examining Attorney, Law Office 107,
Leslie Bishop, Managing Attorney.

—
Before Kuhlke, Allard, and Casagrande,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot program exploring the possibility of broadening or altering acceptable forms of legal citations in Board cases, the citations in this opinion vary from the citation forms recommended in Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 101.03 (June 2023). This decision cites precedential decisions of the Court of Appeals for the Federal Circuit and the Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Precedential decisions of the Board and the Director will be cited only to WESTLAW (WL) and initial citations to Board decisions will include a parenthetical indicating the decision's precedential status. There will be no citations to the United States Patents Quarterly (USPQ). Practitioners, however, should continue to adhere to the practice set forth in TBMP § 101.03 until further notice from the Board.

Pro Eagle LLC (“Applicant”) seeks registration on the Principal Register of the mark ABRAMS (in standard characters) for “Electric jacks; Lifting jacks other than hand-operated; Pneumatic jacks; Power-operated jacks” in International Class 7 and “Hand jacks; Hand operated lifting jacks; Manually-operated jacks” in International Class 8.²

The Trademark Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4), finding that the evidence shows that Applicant’s mark is primarily merely a surname.³ When the refusal was made final,⁴ Applicant requested reconsideration⁵ and then appealed. We suspended the appeal and remanded to the Examining Attorney to permit him to consider the request for reconsideration.⁶ After the Examining Attorney denied reconsideration, the appeal resumed.⁷ Applicant and the Examining Attorney filed briefs, and Applicant filed a reply.⁸ The case is now ready for decision. We affirm the refusal to register.

² Application Serial No. 97738815 was filed on January 2, 2023, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ See February 23, 2023, Nonfinal Office Action. Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO). The page numbers, if any are given, correspond to the page numbers in the downloaded .pdf-format version of the documents.

⁴ See April 6, 2023, Final Office Action.

⁵ See June 5, 2023, Request for Reconsideration.

⁶ See 2 TTABVUE.

⁷ See 5 TTABVUE.

⁸ See 6 TTABVUE (Applicant’s brief); 8 TTABVUE (Examining Attorney’s brief); 9 TTABVUE (reply).

I. Legal Background

Section 2(e)(4) of the Trademark Act prohibits registration of a mark that is “primarily merely a surname.” 15 U.S.C. § 1052(e)(4).⁹ “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.” *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554 (Fed. Cir. 1988); *see also In re Harris-Intertype Corp.*, 518 F.2d 629, 631 (CCPA 1975) (the “primary significance to the purchasing public” is determinative) (citations omitted); *In re Six Continents Ltd.*, 2022 WL 407385, at *3 (TTAB 2022) (precedential) (“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.”) (cleaned up; citations omitted).

In *In re Etablissements Darty et Fils*, 759 F.2d 15 (Fed. Cir. 1985), the Federal Circuit considered several inquiries in determining whether the purchasing public would perceive a proposed mark as primarily merely a surname, including: (1) whether the applicant adopted a principal’s name and uses it in a way that reveals its surname significance; (2) whether the term has a non-surname, ordinary language

⁹ Marks refused because they are primarily merely a surname are not forever barred from registration on the Principal Register. Upon proof of acquired distinctiveness as a source identifier under Section 2(f), 15 U.S.C. § 1052(f), they may be so registered. *See, e.g., Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 425 (Fed. Cir. 2018). Applicant does not make a claim of acquired distinctiveness in this case. Until acquired distinctiveness is proved, proposed marks that are primarily merely a surname may be registered on the Supplemental Register, *see, e.g., In re Adlon Brand GmbH*, 2016 WL 7385751, at *5 n.33 (TTAB 2016) (precedential), but Applicant has not amended its application to take advantage of that option.

meaning; and (3) the extent to which other people have that surname (i.e., its degree of rarity or commonality). *See id.* at 17. We expanded on those three potential inquiries in *In re Benthin Management GmbH*, 1995 WL 789509 (TTAB 1995) (precedential), adding two more inquiries that could lead to probative evidence: (4) whether the term has the “structure and pronunciation” or “look and sound” of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression.¹⁰ *Id.* at *2-3. “These inquiries are not exclusive, nor are they presented in order of importance; any of the inquiries—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case.” *Six Continents*, 2022 WL 407385, at *3 (citations omitted).

II. Analysis

A. Public Exposure (the Rarity or Commonality of the Surname ABRAMS in the United States)

The Examining Attorney argues that ABRAMS is a common surname in the United States, pointing first to evidence from the LexisNexis® U.S. public record surname database directory of addresses and phone numbers showing ABRAMS appearing over 59,000 times as a surname.¹¹ Applicant “does not dispute that Abrams is a surname of some frequency in the U.S.” and that “it is the country’s 1,387th most common surname.”¹²

¹⁰ There is no dispute in this case that the fifth inquiry does not apply because the mark in the application is in standard characters. Accordingly, we will not address this inquiry.

¹¹ 8 TTABVUE 3-4 (citing Feb. 23, 2023, Nonfinal Office Action, TSDR p.5).

¹² 6 TTABVUE 10.

The Examining Attorney also placed in the record evidence that several people with the surname Abrams have garnered varying degrees of public notoriety. This evidence includes:

- A Wikipedia entry for the surname Abrams listed over forty (40) “[n]otable people with the surname”;¹³
- Several news articles concerning entertainment producer J.J. Abrams;¹⁴
- News articles concerning Stacey Abrams, a political figure from Georgia;¹⁵
- News articles concerning Dan Abrams, a national television news commentator;¹⁶
- A news article concerning CJ Abrams, a Major League Baseball player;¹⁷
- An article concerning Floyd Abrams, a noted First Amendment attorney;¹⁸
- A news article concerning Gracie Abrams, a musical performer;¹⁹ and
- A news article concerning Elliott Abrams, a political figure.²⁰

Based on this evidence, we find that the surname ABRAMS is a common surname to which U.S. consumers have been widely exposed.

¹³ Denial of Reconsideration, 4 TTABVue 5-6.

¹⁴ *Id.* at 7-8, 14-17.

¹⁵ *Id.* at 21-26, 31-45, 66-67.

¹⁶ *Id.* at 47-49, 53-62.

¹⁷ *Id.* at 69-74.

¹⁸ *Id.* at 78-79.

¹⁹ *Id.* at 82-86.

²⁰ *Id.* at 98-100.

B. Whether Anyone Connected With Applicant Has the Surname
ABRAMS

Applicant points out that “ABRAMS is not a surname of anyone connected with Applicant.”²¹ The Examining Attorney does not contest this assertion, but counters that the absence of anyone connected with an applicant having the surname at issue “is merely a neutral factor.”²² We agree. Certainly if someone connected in a significant way with an applicant had the surname at issue, that would tend to show that the consuming public for the applicant’s goods or services would be familiar with the surname, but the opposite is not true. *See, e.g., Six Continents*, 2022 WL 407385, at *5 (“[T]he fact that no one named Atwell is associated with Applicant does not tend to establish, one way or the other, whether consumers will perceive the proposed mark as a surname. This inquiry is neutral.”) (citation omitted); *In re tapio GmbH*, 2020 WL 6938377, at *11 (TTAB 2020) (precedential) (same). We therefore find this inquiry to be neutral.

C. Whether ABRAMS Has Any Recognized Meaning Other Than That of
a Surname

Applicant’s main argument why ABRAMS is not primarily merely a surname is that “the purchasing public is highly likely to connect the term ABRAMS with the U.S. Army [Abrams] tank, not someone with the surname Abrams.”²³ Applicant points out that it chose the name ABRAMS because Abrams tanks are known to be

²¹ See 6 TTABVUE 12.

²² See 8 TTABVUE 8.

²³ 6 TTABVUE 13; *see also id.* at 4-5, 7, 12-14, 15, 19.

rugged and “[t]hat was the image we wanted to be associated with our jacks.”²⁴ Applicant argues that “[b]ecause the purchasing public seeing the term ABRAMS on power jacks and manual jacks is highly likely to perceive the term as being connected with the tank, not merely a surname, the application should be allowed.”²⁵ Responding, the Examining Attorney points out that “any connection or association in the minds of the purchasing public between applicant’s goods and tanks is purely speculative, and entirely unsupported by any evidence in the record.”²⁶

We agree with the Examining Attorney. First, an applicant’s intent about how consumers will perceive a mark is essentially meaningless. Consumer perception is based on evidence, not intentions. *See, e.g., UMG Recordings, Inc. v. Mattel, Inc.*, 2011 WL 5014005, at *21 (TTAB 2011) (precedential) (“Applicant’s witnesses have testified to applicant’s intention to suggest, as applied to its toy vehicles, the city of Detroit and the idea of strength. However, we must look to the likely consumer perception of the mark in connection with the identified goods, rather than applicant’s intended connotation.”); *cf. Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1345 (CCPA 1977) (“Seabrook contends that it ‘intentionally selected this mark because its distinctiveness would enable the design to distinguish its products from those of others.’ However, regardless of Seabrook’s intentions, it is the association, by the

²⁴ 6 TTABVUE 12 (citing Declaration of Benson Su, Mar. 9, 2023, Response to Nonfinal Office Action, at TSDR 9).

²⁵ *Id.* at 15.

²⁶ 8 TTABVUE 8.

consumer, of the ‘oval’ design with Seabrook as the source that is determinative.”) (emphasis in original).

Second, and as Applicant notes, the relevant legal question is the significance to the public of the proposed mark in connection with the goods (or services) identified in the application. As we put it in *Mitchell Miller, A Pro. Corp. v. Miller*, 2013 WL 2329829 (TTAB 2013) (precedential), “[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 or services 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.” *Id.* at *6 (emphasis added); *see also Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377 (Fed. Cir. 2017) (“to evaluate whether the commercial impression of a mark that combines a surname with a second term is still primarily merely the surname, the PTO must determine whether the primary significance of the mark as a whole **in connection with the recited goods and services** is that of the surname”) (emphasis added).²⁷

Here, there is no evidence bearing on whether consumers will perceive ABRAMS, in the context of jacks, as referring to an Army tank rather than the common surname ABRAMS. In that regard, this case differs significantly from the case on which

²⁷ *See* Applicant’s Brief, 6 TTABVUE 10 (“The question here of whether ABRAMS would be seen **by the purchasing public in the market for an (sic) power jack or hand jack** as having its primary significance as a surname must be resolved on the specific facts of this case.”) (emphasis added).

Applicant places its greatest emphasis, *In re Pyro-Spectaculars, Inc.*, 2002 WL 745587 (TTAB 2002) (precedential). In *Pyro-Spectaculars*, the surname at issue (SOUSA) was less common than the surname here (ABRAMS). The evidence showed that the most famous person with the Sousa surname was patriotic-song composer John Phillip Sousa, a person of great historical significance. *Id.* at *3. The Board also emphasized the relationship between John Phillip Sousa and the goods and services at issue:

Even more important under the present circumstances is the specific nature of applicant's goods and services and the significance of the term SOUSA when used therewith. Applicant intends to use the term SOUSA in connection with fireworks and with shows featuring pyrotechnics. Clearly these are goods and services which would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music. Thus, we agree with applicant that when the relevant purchasing public encounters the term SOUSA, as it is intended to be used in connection with applicant's fireworks and fireworks displays, the immediate association of the term SOUSA will be with the famous "March King," John Philip Sousa. The primary significance of the term SOUSA, as used in connection with these goods and services, is as the name of a specific person well known in American history for his patriotic music. Although "Sousa" may also be a surname in current use in the United States, any such connotation of the term would clearly be secondary in significance when consideration is given to the particular nature of applicant's goods and services.

Id. at *3. Here, in contrast, there is no evidence that the Abrams tank has any relationship or association with jacks that would prompt jack buyers to conjure the Abrams tank. *Pyro-Spectaculars* does not compel reversal in the significantly different circumstances here.

Applicant also argues that “there is no single person to whom the public would instantly connect” the term ABRAMS.²⁸ Applicant contrasts the situation here with that in *In re Bed & Bars Ltd.*, 2017 WL 2391858 (TTAB 2017) (precedential), in which the surname “Belushi,” though exceedingly rare, was found to be perceived primarily merely as a surname because it was the surname of the famed comedian John Belushi. *Id.* at *9. But Applicant points to no authority from either the Federal Circuit or the Board that Section 2(e)(4) refusals require evidence of a “single person to whom the public would instantly connect” the term at issue. Rather than employing per se requirements, Section 2(e)(4) cases, like all trademark cases, are resolved on a case-by-case basis based on each case’s unique evidentiary record. *See, e.g., Etablissements Darty*, 759 F.2d at 17 (“The question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis.”); *Six Continents*, 2022 WL 407385, at *2 (“This question must be resolved on a case-by-case basis. We examine the entire record to determine the primary significance of a term.”) (citations omitted).

Third, and as Applicant concedes, the term ABRAMS as used on Army tanks is not entirely “other than as a surname.” If other posited meanings represent “the normal naming of a place or other item after an individual,” such other meanings generally are less significant than otherwise. *See, e.g., Harris-Intertype*, 518 F.2d at 631 (discounting such evidence where the other meanings “represent “the normal naming of a place or other item after an individual”); *In re Champion Int’l Corp.*, 1985

²⁸ 6 TTABVUE 11.

WL 72044, at *3 (TTAB 1985) (precedential) (other uses of McKinley as geographic places and buildings represented only “the normal naming of a place or building after an individual (whether President McKinley or someone else)” and thus were insufficient “to take it out of the ‘primarily merely a surname’ category”). Here, the evidence shows, and Applicant concedes, that the Abrams Tank was named after a person, Army General Creighton Abrams.²⁹

Applicant also tries to turn the tables, arguing that, as a legal matter, it was the Examining Attorney’s burden to show what consumers in the jack market would perceive. *See* 9 TTABVUE 4. We disagree. Once the Examining Attorney provides evidence to make out a prima facie case that ABRAMS is primarily merely a surname—and here, the evidence the Examining Attorney developed is more than sufficient—it becomes Applicant’s burden to provide evidence showing that other meanings predominate in the context of the goods or services at issue. *See In re Pohang Iron & Steel Co.*, 1986 WL 83576, at *2 (TTAB 1986) (precedential) (“The directory listings provided by the Examining Attorney in this case, coupled with the Lexis/Nexis material are, in our view, sufficient to establish a prima facie case that POSTEN is primarily a surname and thus to shift the burden to the applicant to show that, although a surname, POSTEN has some other significance to the purchasing public. However, applicant’s showing does not satisfy this burden.”); *see also In re Industrie Pirelli Societa per Azioni*, 1988 WL 252329, at *3-4 (TTAB 1988) (precedential) (examining attorney’s evidence that Pirelli, while a rare surname,

²⁹ 6 TTABVUE 7, 13 n.3; *see also* April 06, 2023, Final Office Action, at TSDR 7, 11, 21.

resembled a surname in structure and pronunciation, adequately made out a prima facie case, which the applicant failed to rebut); *see generally In re Pacer Tech.*, 338 F.3d 1348, 1352 (Fed. Cir. 2003) (the USPTO “is an agency of limited resources” and “cannot be expected to shoulder the burden of conducting market research”) (citations omitted). Other than Applicant’s subjective intent that jack consumers associate ABRAMS with a tank and not a surname—which is weak tea—there is no evidence suggesting that the tank, rather than the surname, meaning will predominate with jack consumers.

We do note our agreement, however, with Applicant’s objection to the Examining Attorney’s citation of other registrations of marks consisting of or containing the term ABRAMS.³⁰ The Examining Attorney placed several registrations of ABRAMS marks in the record and noted that each of them was either registered on the Principal Register upon a showing of acquired distinctiveness under Section 2(f) or registered on the Supplemental Register. The Examining Attorney argues that this indicates that these other ABRAMS marks were determined not to be inherently distinctive because they were each primarily merely a surname.³¹

Applicant urges that the Examining Attorney’s argument about these other registrations “is irrelevant and improperly treats prior USPTO actions [in allowing registrations for other ABRAMS marks] as controlling.”³² Applicant is correct. Each

³⁰ See 6 TTABVUE 17-19.

³¹ See 8 TTABVUE 6-7.

³² See 6 TTABVUE 18.

decision rests on its own facts and evidence, and we do not know the facts and evidence in those cases. *See, e.g., Harris-Intertype*, 518 F.2d at 632. And while consistency in examination is a valid goal, we evaluate each case on its own record. In addition, we are concerned with consumer perception, and consumers are unaware of what is registered or not. *See, e.g., Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 1005 (CCPA 1973) (“The purchasing public is not aware of registrations reposing in the Patent Office ...”); *Adlon Brand*, 2016 WL 7385751, at *7 (third-party registrations of the term ADLON, which was refused as primarily merely a surname, “reveal little to nothing about the public’s perception or understanding of the term ADLON). For these reasons, we have previously rejected arguments by **Applicants** that third-party registrations of other marks containing the term refused as primarily merely a surname is probative evidence that the relevant class of consumers primarily view the term as something other than a surname. *See, e.g., Integrated Embedded*, 2016 WL 7368696, at *5-6 (TTAB 2016) (precedential). That it is a USPTO examining attorney, not an applicant, arguing that these registrations are probative (because they issued upon a claim of acquired distinctiveness) does not avoid these problems or make them vanish. We therefore give these third-party ABRAMS registrations little to no probative value, but even so, the totality of the evidence strongly indicates that the primary meaning U.S. consumers attribute to ABRAMS is that of a surname.

D. Whether ABRAMS Has the “Structure and Pronunciation” or “Look and Sound” of a Surname

Another relevant inquiry is whether ABRAMS has the “structure and pronunciation” or “look and sound” of a surname. *See Benthin*, 1995 WL 789509, at *2. The Examining Attorney contends that the evidence under this inquiry supports the refusal, citing evidence of the commonality of other surnames that are similar to ABRAMS in the U.S.³³ This evidence includes:

- A screenshot from the LexisNexis® public record U.S. surname database showing 87,238 occurrences of the variant surname Abraham, listing the first 10 results;³⁴
- A screenshot from the LexisNexis® public record U.S. surname database showing 7,067 occurrences of the variant surname Abrahams, listing the first 10 results;³⁵ and
- A screenshot from the LexisNexis® public record U.S. surname database showing 14,666 occurrences of the variant surname Abram, listing the first 10 results.³⁶

We have previously held this type of evidence to be relevant. *See, e.g., tapio GmbH*, 2020 WL 6938377, at *13 (pertinent evidence “typically consists of other common surnames that are configured similarly and sound similar to the proposed mark”) (citation omitted). Where the subject mark has aural, visual, structural, and/or other similarities with other similar surnames, that further supports that consumers

³³ 8 TTABVUE 10.

³⁴ 4 TTABVUE 118 (denial of reconsideration).

³⁵ *Id.* at 119.

³⁶ *Id.* at 120.

perceive the term at issue primarily as a surname. Applicant does not address this evidence or argument in either its principal brief or its reply.

We find this evidence probative because the surnames Abram, Abraham, and Abrahams look and sound similar to ABRAMS. We find this evidence to further support that U.S. consumers view ABRAMS primarily as a surname.

E. Weighing the Evidence Together

Our final step is to “weigh [our findings on the relevant *Benthin* inquiries] together and accord the appropriate weight to each one based on the evidence of record.” *In re Eximius Coffee, LLC*, 2016 WL 6819241, at *2 (TTAB 2016) (precedential). Here, we find on the evidence in the record that ABRAMS is a common surname in the U.S. to which U.S. consumers are widely exposed. We further find that, in the context of the goods identified in the application (jacks), consumers will not perceive the term ABRAMS as referring to anything (including tanks) other than a surname. And we also find that ABRAMS looks and sounds like a surname and has the structure and pronunciation of a surname. These findings heavily support a determination that Applicant’s ABRAMS mark is primarily merely a surname. The fact that no one connected with Applicant has the surname ABRAMS is neutral, weighing neither for or against a finding that Applicant’s proposed ABRAMS mark is primarily merely a surname. On balance, we find that Applicant’s ABRAMS mark is primarily merely a surname.

Decision: The refusal to register Applicant’s mark ABRAMS under Section 2(e)(4) of the Trademark Act is affirmed.