

This Opinion is not a  
Precedent of the TTAB

Mailed: March 30, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re International Tractors Ltd.*

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Serial No. 86838500

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John S. Egbert of Egbert Law Offices PLLC,  
for International Tractors, Ltd.

Daniel P. Donegan,<sup>1</sup> Trademark Examining Attorney, Law Office 104,  
Dayna Browne, Managing Attorney.

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Before Kuhlke, Taylor and Masiello,  
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

International Tractors Ltd. (“Applicant”) seeks registration on the Principal  
Register of the mark SOLIS (in standard characters) for, as amended,

Agricultural machines, namely, rotovator tillers,  
threshers, shellers, huskers, cultivators, disk harrows,  
seeders, ploughs, reapers, combine harvesters; agricultural  
instruments, namely, cutters in the nature of silage  
cutters, tree stump cutters, trench cutters; agricultural  
implements, namely, seed drills; hand tools, namely,  
electric drills; electric motors, namely, electric motors, not

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<sup>1</sup> Donald Johnson was the Trademark Examining Attorney responsible for the application prior to briefing.

for land vehicles, electric motors for machines; pumping machines, namely, compressed air pumps, fuel pumps for land vehicles; diesel oil engines for machines; engine pump sets, namely, pumps for cooling engine, pumps as part of machines, motors and engines, oil pumps for use in motors and engines in International Class 7; and

Tractors and parts thereof in International Class 12.<sup>2</sup>

By way of background, the Trademark Examining Attorney (“Examining Attorney”), in his first Office Action, initially refused Applicant’s mark on the grounds of likelihood of confusion with the mark in Registration No. 3878243 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and that Applicant’s mark is primarily merely a surname under Section 2(e)(4) of the Act, 15 U.S.C. § 1052(e)(4). The Examining Attorney also required Applicant to amend the identification of goods to identify them with more specificity and either restrict the application to the number of classes covered by fees already paid or to submit additional fees.

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<sup>2</sup> Application Serial No. 86838500 was filed on December 3, 2015, 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). During prosecution of the application, Applicant filed an amendment to allege use which was accepted on April 7, 2017. Applicant now alleges November 16, 2016 as the date of first use anywhere and in commerce for both classes of goods.

The application also includes, as more fully discussed, *infra*, a claim of prior ownership of Supplemental Register Registration No. 3878243 for the mark SOLIS (in standard characters) for “tractor towed agricultural implements, namely, broadcast seeders; tractor towed agricultural implements, namely, corn huskers; tractor towed agricultural implements, namely, disc harrows; tractor towed agricultural implements, namely, fertilizer distributors; tractor towed agricultural implements, namely, harrows; tractor towed agricultural implements, namely, harvesters; tractor towed agricultural implements, namely, hay balers; tractor towed agricultural implements, namely, hay rakes; tractor towed agricultural implements, namely, manure spreaders; tractor towed agricultural implements, namely, mowers; tractor towed agricultural implements, namely, plows; tractor towed agricultural implements, namely, reapers; tractor towed agricultural implements, namely, rollers; tractor-towed fertilizer applicators; [and] tractor-towed harrows” in International Class 7; and “tractors” in International Class 12.

In its September 22, 2016 Response, Applicant indicated that there is no likelihood of confusion with Registration No. 3878243 because the registration had been assigned to Applicant, amended the identification of goods to comply with both the identification definiteness and fee requirements, and argued against the Section 2(e)(4) refusal.

In the October 19, 2017 Office Action, the Examining Attorney withdrew the Section 2(d) refusal, indicated that the identification/fee requirements had been satisfied, and made the Section 2(e)(4) refusal final.

Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and both Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

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).<sup>3</sup> 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. *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); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). See also *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). This expression of

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<sup>3</sup> The application includes neither a claim of acquired distinctiveness under Section 2(f) nor a request for registration on the Supplemental Register. Accordingly, those issues are not before us in this appeal.

the test restates the rule set forth in *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) (“[A] correct resolution of the issue can be made only after the primary significance of the mark to the purchasing public is determined ...”) and *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). When we are faced with a Section 2(e)(4) refusal of a term in standard character form, with no other literal or design elements, we consider the impact the applied-for term has or would have on 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. If it is, *and it is only that*, then it is primarily merely a surname.” *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)) (emphasis in original).

Whether the primary significance of an applied-for mark is merely that of a surname is a question of fact. *See Darty*, 225 USPQ at 653-54. There is no rule as to the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a surname. This question must be resolved on a case-by-case basis. *Id.* at 654. The entire record is examined to determine the primary significance of a term. 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).

In *Darty*, the Federal Circuit considered several factors in determining whether the purchasing public would perceive a proposed mark as primarily merely a surname, including: whether the applicant adopted a principal's name and used it in a way that revealed its surname significance; whether the term had a non-surname "ordinary language" meaning; and the extent to which the term was used by others as a surname. *Darty*, 225 USPQ at 653. The Board's oft-cited "*Benthin* factors," see *Benthin* 37 USPQ2d at 1333-34, are also examples of inquiries that may lead to evidence regarding the purchasing public's perception of a term's primary significance.<sup>4</sup> These "factors" are not exclusive and any of these circumstances – singly or in combination – and any other relevant circumstances may shape the analysis in a particular case.

The Examining Attorney and Applicant focused their arguments on the first four *Benthin* factors. While we review each in turn, we make our determination by weighing them together and according the appropriate weight to each one based on the evidence of record.

(1) *The Extent to Which Solis is Encountered as a Surname*

We consider first the frequency of, and public exposure to, SOLIS as a surname. In this regard, "[t]he relevant question is not simply how frequently a surname

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<sup>4</sup> In *Benthin*, the Board stated that "factors" to be considered in determining whether a term is primarily merely a surname include (1) the degree of a surname's rareness; (2) whether anyone connected with applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the term has the "structure and pronunciation" of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression. Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

appears, ... but whether the purchasing public for Applicant's [goods] is more likely to perceive Applicant's proposed mark as a surname rather than anything else." *Beds & Bars*, 122 USPQ2d at 1551. The Examining Attorney has introduced the following evidence demonstrating surname use:<sup>5</sup>

- Search results from a search of the LexisNexis® Public Records: Surname database for the term SOLIS, indicating the total number found as 110,991, and with 500 listings made of record.<sup>6</sup>
- Results of a search of 411.com, a nationwide telephone directory, finding 75,605 exact matches for SOLIS.<sup>7</sup>
- An excerpt from the 2000 U.S. Census showing that SOLIS is the 497th most common surname in the nation, with 60,045 people having SOLIS as their surname.<sup>8</sup>

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<sup>5</sup> Most of the evidence made of record by the Examining Attorney with the first Office Action was reintroduced with the Final Office Action. Where duplicated, we cite to the Final Office Action issued October 19, 2016.

<sup>6</sup> October 19, 2016 Office Action; TSDR 43. The TSDR citations are to the .pdf downloadable format.

<sup>7</sup> *Id.* at TSDR 6-35 (<http://www.411.com/name/solis>).

<sup>8</sup> *Id.* at TSDR 36-37 ([https://www.census.gov/topics/population/genealogy/data/2000\\_surnames.html#](https://www.census.gov/topics/population/genealogy/data/2000_surnames.html#)).

- Wikipedia entry<sup>9</sup> for “SOLIS” indicating that “Solis is a Spanish name derived from the Latin sol solis ..., literally meaning sun.” The Wikipedia entry listed the following people with the surname SOLIS:<sup>10</sup>
  - Brian Solis, American marketing executive
  - Gabrielle Solis, a fictional character on the ABC drama Desperate Housewives (which aired for eight seasons)
  - Hilda Solis, current [now former] U.S. Secretary of Labor, former Congresswoman for the 32nd District of California
  - Oscar A. Solis, Auxiliary bishop of the Roman Catholic Archdiocese of Los Angeles
  - Patti Solis Doyle, American political operative in the 2008 Clinton and Obama campaigns.
- Individual Wikipedia entries for the individuals listed above, except Hilda Solis,<sup>11</sup> as well as Sammy Solis, an American professional baseball pitcher [formerly] for the Washington Nationals of Major League Baseball.<sup>12</sup>
- An excerpt from the United States Department of Labor/Hall of Secretaries webpage featuring Hilda Solis.<sup>13</sup>

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<sup>9</sup> Notably, we do not accept the Wikipedia entries as factually accurate, but rather, merely as evidence that the surname SOLIS has been acknowledge and discussed by members of the public.

<sup>10</sup> *Id.* at TSDR 38-39. We have not considered the listing with regard to persons having alternative spellings or who, on the face of the descriptions, are not associated with the United States – i.e., Virgil Solis, 16th century German draughtsman and printmaker in engraving, etching and woodcut.

<sup>11</sup> May 2, 2017 Denial of Request for Reconsideration; TSDR 12-35.

<sup>12</sup> October 19, 2016 Office Action; TSDR 40-42.

<sup>13</sup> May 2, 2017 Denial of Request for Reconsideration; TSDR 10-11.

- An article from dmagazine, featuring Miguel Solis' decision not to run against Pete Sessions.<sup>14</sup>
- A press release of Wabash College stating that Rodolfo Solis has been named a 2017 American Political Science Association Ralph Bunch Summer Institute Scholar.<sup>15</sup> and
- A Tulane University online news report featuring Luis Guillermo Solis' (Tulane alumnus and current Costa Rican President) receipt of the President's medal.<sup>16</sup>

We find this evidence demonstrates that SOLIS is used as a surname across the country, and that it has received a good deal of exposure, as demonstrated by discussion of numerous individuals named SOLIS on Wikipedia and in the press. In addition the U.S. Census bureau data, showing 60,054 occurrences of the surname SOLIS, and indicating that it is the 497th most common surname in the United States, along with the telephone directory search results which returned 75,605 names, establishes that the surname SOLIS is not rarely encountered in the United States. Indeed, Applicant does not assert otherwise and, in fact, does not address this factor.

*(2) Whether SOLIS is the Surname of Anyone Connected with Applicant*

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<sup>14</sup> *Id.* at TSDR 36-40.

<sup>15</sup> *Id.* at TSDR 41.

<sup>16</sup> *Id.* at TSDR 42-46.



We now consider whether anyone with a publicly known connection with Applicant has the surname “Solis.” Although conceding that “the term ‘SOLIS’ can be used as a surname of Spanish origin,”<sup>17</sup> Applicant affirmatively states, and there is no record evidence to the contrary, that “no person connected with the Applicant’s business has the surname ‘SOLIS.’” However, the fact that no one named SOLIS is associated with Applicant is not controlling. *See In re Gregory*, 70 USPQ2d 1792, 1995 (TTAB 2004) (The Board stated that the fact that “a proposed mark is not the 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.”). Thus, this is a neutral factor in our determination.

(3) *Whether SOLIS has any Recognized Meaning Other Than as a Surname*

The Examining Attorney has demonstrated that SOLIS has no recognized meaning in English other than as a surname by showing that searches for SOLIS in the online dictionaries Lookwayup.com, Merriam-Webster.com and Rhymezone.com, collectively, returned no results of a non-surname meaning.<sup>18</sup> This “negative”

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<sup>17</sup> Applicant goes on to point out that it is extremely unlikely that its applied-for mark SOLIS was derived from a surname of Spanish origin because Applicant is a limited company (Ltd.) of India. While that may be so, that is not the relevant inquiry. The ultimate inquiry is whether the public perceives the primary significance of SOLIS as a surname, with one of the factors in the inquiry being whether someone associated with Applicant bears SOLIS as a surname. In any event, it is not inconceivable that an Indian entity could have an officer with a Spanish surname.

<sup>18</sup> October 19, 2016 Office Action; TSDR 49-51. The definitions did, however, corroborate the surname meaning of the term. For example, the evidence from Lookwayup.com defines SOLIS as a “[l]ast name, frequency rate in the U.S. is 726.” Similarly, SOLIS is defined by Rhymezone.com as “[a] surname (common: 1 in 6250 families; popularity in the U.S. is # 726). The definition from Merriam-Webster, however, indicated that SOLIS is a “biographical name” and lists “Hilda (Lucia) 1957- United States secy. of labor (2009-13).”

dictionary evidence (i.e., listings showing nothing except surname/biographical meanings) supports a finding that the primary significance of SOLIS is as a surname. *See, e.g., In re Eximius Coffee LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016) (citing *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 (TTAB 2005)). *See also Darty*, 225 USPQ at 653-654.

Applicant has countered this position, arguing that its mark has a meaning in Latin that the purchasing public would perceive when encountering its mark that is unrelated to any alleged surname significance. Applicant particularly explains that “[t]he term ‘SOLIS’ is a rather widely known Latin word with a well understood meaning. [Internal citation omitted.] In Latin, the term ‘SOLIS’ can mean ‘sun’ or ‘sunlight,’ depending on whether the term was used with other Latin words.” Br. p. 6.<sup>19</sup>

By this argument, Applicant has invoked the doctrine of foreign equivalents. We accordingly consider whether the doctrine is applicable and, if so, whether the meaning of SOLIS in Latin is the primary significance of SOLIS. *See Isabella Fiore*, 756 USPQ2d at 1567-68 (The Board found FIORE, which means “flower” in Italian, not primarily merely a surname.).

Whether the doctrine of foreign equivalents applies turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record. The doctrine may be applied to words or terms from common, modern languages. *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison*

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<sup>19</sup> Applicant’s Brief, p. 6; 11 TTABVUE 7.

*Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Although words from modern languages are generally translated into English, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when it is likely that “the ordinary American purchaser would ‘stop and translate’ [the term] into its English equivalent.” *Id.*, (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). See generally TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1209.03(g) (Oct. 2017). However, “[w]hen it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1696, (citing *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY’S for canned vegetables)). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

The Examining Attorney takes the position that the doctrine of foreign equivalents is not applicable in this case because “Latin is considered a dead language which consumers would not be expected to stop and translate.” To confirm this status, the Examining Attorney in his brief has requested, and we have taken, judicial notice of dictionary definitions from [Ahdictionary.com](http://ahdictionary.com) and [En.oxforddictionaries.com](http://en.oxforddictionaries.com).<sup>20</sup>

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<sup>20</sup> The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110

Ahdictionary.com defines “dead language” to mean, “[a] language, such as Latin, that is no longer learned as a native language by a speech community,”<sup>21</sup> while En.oxforddictionary.com defines it as “A language which is no longer in everyday spoken use, such as Latin.”<sup>22</sup> This evidence not only demonstrates that Latin is routinely considered a “dead language” that is no longer in everyday use, but that it is also no longer learned as a native language by speech communities. In fact, Applicant conceded that Latin is not routinely spoken in the United States.<sup>23</sup>

Nonetheless, on this point, Section 1207.01(b)(vi)(B) of the TMEP is further illuminative:

If [as in this case] evidence shows that the language at issue is highly obscure or a dead language, the doctrine will generally not be applied. *See Palm Bay Imps.*, 396 F.3d at 1377, 73 USPQ2d 1689, 1696; *cf. In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1351, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009) (indicating that the doctrine of foreign equivalents does not require that terms from dead or obscure languages be literally translated for the purpose of determining descriptiveness). The determination of whether a language is “dead” is made on a case-by-case basis, based upon the meaning the word or term would have to the relevant purchasing public. For example, Latin is generally considered a dead language. However, if evidence shows that a Latin term is still in use by the relevant purchasing public (i.e., if the term appears in current dictionaries or news articles), then this Latin term would not be considered dead.

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USPQ2d 1227, 1229 n.4 (TTAB 2014); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>21</sup> <https://www.ahdictionary.com/work/search.html?q=dead%20language>. 13 TTABVUE 14-15.

<sup>22</sup> [https://en.oxforddictionaries.com/definition/us/dead\\_language](https://en.oxforddictionaries.com/definition/us/dead_language). 14 TTABVUE 18.

<sup>23</sup> Applicant’s Brief, p. 6; 11 TTABVUE 7.

Here, Applicant has provided no evidence regarding the number of persons having knowledge of Latin in the United States or showing that the term “Solis” is a term that is still in use by the purchasing public in the context of its Latin meaning. Instead, Applicant relies on its unsupported argument that “[m]any students in high school and college still study Latin and would certainly come across the word “sunshine” or “sun” in their Latin studies.” Even if this is so, the fact that a dead language is studied in an academic setting does not mean that the relevant purchasing public would be likely to stop and translate SOLIS to its Latin equivalent such that its Latin meaning would be its primary significance.

Applicant also postulates that although Latin is not routinely spoken by members of the U.S. population, the impact of Latin on modern culture is undeniable, as Latin serves as the foundation upon which numerous modern languages are built, and many modern languages contain the root of the Latin word “solis” in their word for sun. Again, while this may be so, it is unlikely that the ordinary American purchaser is familiar with the etymology of the term SOLIS and, thus, it is unlikely that the primary significance of SOLIS to that purchaser would be its meaning in Latin.

Notably, the fact that Applicant, on its website, apparently finds it necessary to educate the public to the non-surname meaning of “solis” bolsters our finding that the public would not be aware of any non-surname meaning upon initially encountering Applicant’s SOLIS mark.

In sum, Applicant’s evidence, consisting mostly of unsubstantiated argument, falls far short of establishing that the Latin language is still in use by any number of

ordinary American purchasers and, accordingly, it is unlikely that speakers of Latin will stop and translate SOLIS immediately to “sunshine.” Instead, they would perceive its primary significance as that of a surname. For these reasons, the doctrine of foreign equivalents is not appropriate in this case.

(4) *Whether SOLIS has the Structure and Pronunciation of a Surname*

We recognize, first, that the assessment of whether SOLIS has the structure and pronunciation of a surname is a “decidedly subjective” inquiry. *Eximius Coffee*, 120 USPQ2d at 1280 (quoting *Benthin*, 37 USPQ2d at 1333). As the Board noted in *In re Olin Corporation*, 124 USPQ 1327, 1332 (TTAB 2017), “applicants and examining attorneys may submit evidence that, due to a term’s structure or pronunciation, the public would or would not perceive it to have surname significance.”

Here, the Examining Attorney maintains that SOLIS is similar in structure and pronunciation to other frequently encountered surnames (as shown in the 2000 Census excerpt<sup>24</sup>): Davis (7<sup>th</sup> most popular), Harris (24<sup>th</sup> most popular), and Morris (56<sup>th</sup> most popular). He particularly expounds that each of these surnames, along with SOLIS, are disyllabic, with an ending consisting of “-is.” We find this evidence unpersuasive to show that SOLIS has the structure and pronunciation of a surname.

Applicant contends that “SOLIS” does not have the visual appearance or spoken sound of a surname because it does not follow the pattern of any common type of surname, e.g., -son, -ter.

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<sup>24</sup> October 19, 2016 Office Action; TSDR 36-37.

The evidence is not clear on this point either way, and does not factor into the determination. *Eximius Coffee*, 120 USPQ2d at 1280.

(5) *Other Arguments*

Applicant also contends that the commercial impression it sought to associate with its mark is clearly related to the sun, the yellow sunbeam appearing on its specimen suggesting a ray of sunshine. The problem with Applicant's argument is that, regardless of what it *intends* the connotation of its mark to be, there is no evidence that purchasers would actually perceive it as having that connotation – the yellow sunbeam not being a part of its mark. *Cf. In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001) (commercial impression of a mark is determined independent of the context of actual usage).

As for the Examining Attorney, he argues that an additional consideration for treating the term SOLIS as primarily merely a surname is Applicant's prior Registration No. 3878243 for SOLIS on the Supplemental Register, which serves as evidence of the weakness of the mark for essentially the same goods. Applicant responded by explaining that:

[T]he trademark application [underlying Registration No. 3878243] was prosecuted by another Applicant, pro se, and ... the mark was amended to the Supplemental Register October 12, 2010. The pro se Applicant did not enter any arguments against the surname refusal. The trademark registration was then assigned to Applicant on May 19, 2016 [to overcome a Section 2(d) refusal]. Any statements made within the prosecution of the prior registration are not binding on Applicant's trademark application at issue in this ex parte appeal, which is a wholly separate and distinct application as compared to the prior registration.

14 TTABVUE 5.

We agree. Our primary reviewing court addressed a very similar issue in *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010). In *Chippendales*, one of the issues on appeal was “whether the granting of a Section 2(f) registration for a mark of acquired distinctiveness moots the request for an inherent distinctiveness registration.” *Id.* at 1685. The court held that inherent distinctiveness is decided at the time of registration. It thus follows that even if a mark was previously registered pursuant to Section 2(f) of the Trademark Act as having acquired distinctiveness, or on the Supplemental Register as lacking inherent distinctiveness or secondary meaning, an applicant is not foreclosed from filing a later application seeking an inherently distinctive registration of the same mark.

(6) *Conclusion*

In conclusion, we find that the record, taken as a whole, establishes that the primary significance of SOLIS to the purchasing public is that of a surname. In making this finding, we accord particular weight to our determination that SOLIS is a common surname with no other meaning that would be recognized by ordinary American purchasers because application of the doctrine of foreign equivalents is not appropriate in this case as it is unlikely that consumers would stop and translate SOLIS. While Applicant is correct that doubt about whether a term is a surname is resolved in the applicant’s favor, here we have no doubt.

**Decision:** The refusal to register SOLIS under Section 2(e)(4) is affirmed.