

This Opinion is not a  
Precedent of the TTAB

Mailed: January 15, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Jos. A. Magnus & Co., LLC*  
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Serial No. 87618554  
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Chad W. Brigham of Goldenberg Heller & Antognoli P.C.,  
for Jos. A. Magnus & Co., LLC.

Kevin G. Crennan, Trademark Examining Attorney, Law Office 113,  
Myriah Habeeb, Managing Attorney.

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Before Wellington, Adlin and Coggins,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Jos. A. Magnus & Co., LLC (“Applicant”) seeks registration on the Principal Register of the mark MAGNUS (in standard characters) for “Whiskey, gin and distilled spirits” in International Class 33.<sup>1</sup>

<sup>1</sup> Application Serial No. 87618554 was filed on September 22, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark anywhere and in commerce on September 12, 2015.

The Trademark Examining Attorney refused registration on the ground that Applicant's mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4). When the refusal was made final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the request for reconsideration, and this appeal was resumed. The appeal has been briefed.

We affirm the refusal.

### **Primarily Merely a Surname**

A mark that is "primarily merely a surname" may not be registered on the Principal Register unless it has acquired distinctiveness. 15 U.S.C. §§ 1052(e) and (f); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). Applicant does not argue that its proposed mark has acquired distinctiveness, but argues only that its proposed mark is not primarily merely a surname.

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.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017) (citing *Darty*, 225 USPQ at 653). Whether the primary significance of an applied-for mark is merely that of a surname is a question of fact that must be resolved on a case-by-case basis. *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017).

We examine the entire record to determine the primary significance of a term to the purchasing public. *Id.*; *Darty*, 225 USPQ at 653; *Beds & Bars*, 122 USPQ2d at 1548; *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995). Over the years, the Board identified various factors we may consider in determining whether a mark is primarily merely a surname, including: (1) the rarity or frequency of exposure to the public of the mark being used as a surname; (2) whether anyone connected with the applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; (4) whether the mark has the structure and pronunciation of a surname; and (5) whether the manner in which the mark is displayed might negate any surname significance. *Id.* at 1332-33; *see also In re Weiss Watch Co., Inc.*, 123 USPQ2d 1200, 1203 (TTAB 2017) (discussing initial factor in terms of “whether and to what extent [term] is encountered as a surname.”). This list, however, is not exhaustive or in any particular order of importance; the Board may consider other types of evidence that may be probative as to the public’s perception of the proposed mark.

The Examining Attorney bears the initial burden of making a prima facie showing of surname significance. *Darty*, 225 USPQ at 653. If the Examining Attorney makes that showing, then we must weigh all of the evidence from the Examining Attorney and the Applicant, to determine ultimately whether the mark is primarily merely a surname. *See In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of the applicant. *See Benthin*, 37 USPQ2d at 1334.

***To What Extent MAGNUS Is Encountered As a Surname***

With regard to the factor involving the number of persons and prevalence of MAGNUS used as a surname, we point out that even rare surnames may be held primarily merely surnames if the primary significance conveyed to purchasers is that of surname. “The relevant question is not simply how frequently a surname appears, however, but whether the purchasing public for Applicant’s services is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *Beds & Bars*, 122 USPQ2d at 1551 (finding BELUSHI’S to be primarily merely a surname).

The Examining Attorney submitted the results of three different searches for persons with the surname MAGNUS:

- “7,707 records for [persons with the surname] MAGNUS” from the Whitepages website ([www.whitepages.com](http://www.whitepages.com));<sup>2</sup>
- “Total number found: 2809” in the LexisNexis Public Records surname database, with the first ten names, addresses and telephone numbers provided;<sup>3</sup> and
- U.S. Census records (from the office website [www.census.gov](http://www.census.gov)) showing 2,291 persons with the surname MAGNUS from the 2010 census.<sup>4</sup>

We find that the aforementioned evidence, even after allowing for some potential duplicate entries for the same individuals within the databases, shows that the relevant public has some exposure to MAGNUS as a surname.

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<sup>2</sup> 4 TTABVUE 56-61.

<sup>3</sup> Submitted with Office action issued on January 3, 2018. The Examining Attorney argues in his brief that this number has increased to 3,005, referencing evidence attached to the Office Action issued on May 17, 2019 (4 TTABVUE, denying the request for reconsideration).

<sup>4</sup> Submitted with Office action issued on November 15, 2018.

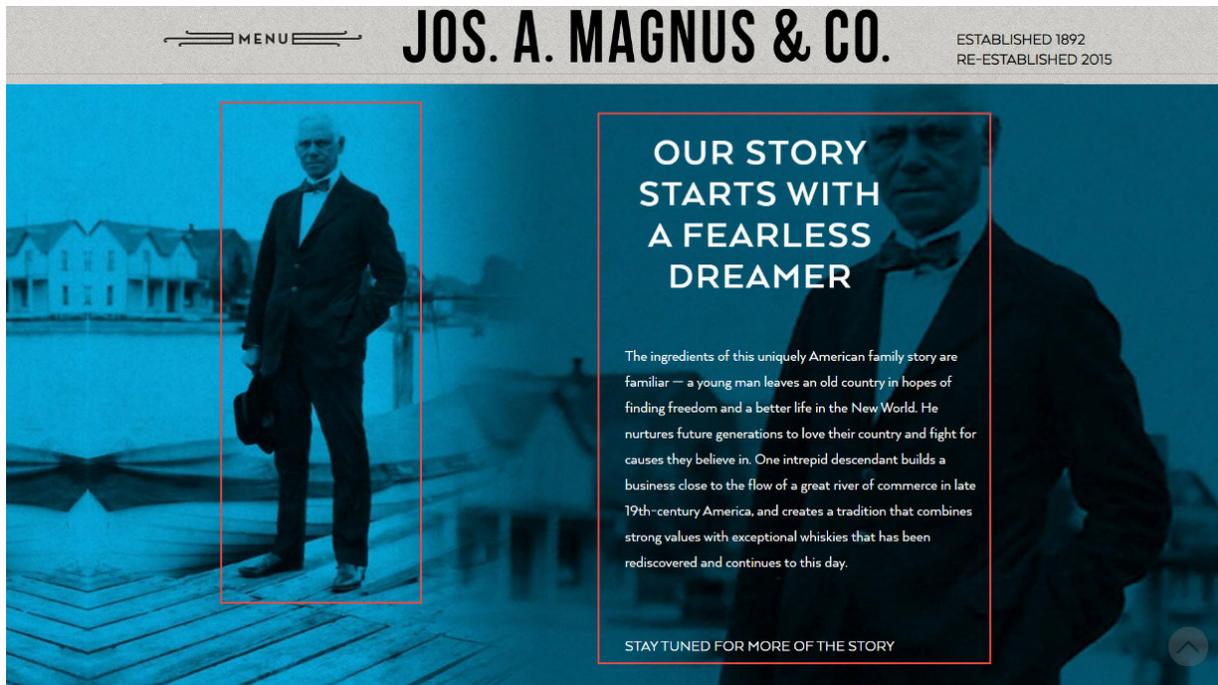
***Whether Anyone Connected to Applicant Has the MAGNUS Surname***

Applicant acknowledges that its website address (www.josephmagnus.com) and trade name, Jos. A. Magnus & Co., incorporate the term MAGNUS used as surname. Indeed, there is no dispute and Applicant readily admits that it markets its whiskey in association with Joseph Magnus, whom Applicant labels an “historical whiskey distiller.”<sup>5</sup> According to Applicant, “[t]he primary significance of Applicant’s advertising on consumers is a clear reference to a particular deceased individual” named Joseph Magnus and its intent is to “conjure in the minds of consumers a favorable connotation associated with that historical and particular whiskey magnate.” Screenshots from Applicant’s website include large pictures of Mr. Magnus and a headline referring to him as a “fearless dreamer” and the creator of “our story”:<sup>6</sup>

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<sup>5</sup> 6 TTABVUE 10.

<sup>6</sup> Attached, respectively, to Office Actions issued on November 15, 2018 and May 17, 2019.



The site goes on to describe the subsequent history and “family lore” of the Magnus family, picking up with Mr. Magnus’s great-grandson:

## The Discovery

In 2007, the great-grandson of pre-Prohibition whiskey magnate Joseph Magnus discovered a carefully wrapped, unopened bottle of 122-year-old whiskey while sifting through family memorabilia.

Family lore had always remembered Joseph Magnus for the pioneer he was in the whiskey business at the turn of the century, but the family was shocked to discover their ancestors had protected and passed down what is believed to be the very first bottle of Joseph A. Magnus whiskey ever made, dated May 1892.

Applicant asserts, however, that “Joseph Magnus is a past figure and not a founder of Applicant. No individual with the last name MAGNUS is or has been involved in the business, and when encountering Applicant’s web pages consumers

are not exposed to active participants in Applicant's business with the name of MAGNUS."<sup>7</sup>

Given Applicant's trade name and the manner in which Applicant markets its goods, the question of whether Applicant's founder was actually Joseph Magnus or if anyone with the surname MAGNUS is currently involved in Applicant's business is beside the point and, in this case, not necessary for the "connected with" factor to weigh in favor of finding it to be primarily a surname. We find it significant that Applicant has made and continues to prominently make a connection with a person having the surname MAGNUS. Applicant touts this connection directly in its communications with relevant consumers. Applicant's actions and the actual name of its company clearly reinforce the surname significance of MAGNUS. *See Darty*, 225 USPQ at 653 (finding that DARTY is primarily merely a surname in part because it "is used in the company name [translated as "Darty and Son"] in a manner which reveals its surname significance ..."); *In re Weiss Watch*, 123 USPQ2d at 1203 ("Applicant's promotion of its founder's connection to the company and its goods is persuasive of consumer perception of WEISS as a surname.").

We find no meaningful difference between Applicant's promotion of a connection with a person having the surname MAGNUS and other cases where we held that a party's promotion of its founder having the surname as establishing public exposure to that surname. *See In re Olin Corp.*, 124 USPQ2d 1327 (although there was "no evidence that anyone with the surname OLIN has had a publicly known connection

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<sup>7</sup> 7 TTABVUE 10.

with the company in recent years,” Applicant’s marketing indicating that its founder had that name “further supports that the public perceives OLIN primarily as a surname.”); *see also In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1722 (TTAB 2016) (Applicant’s reliance on evidence showing ADLON may designate an historic hotel was “obviously problematic” because the evidence also showed “that the hotel was named ADLON [after] the surname of its founder, and was subsequently held out as a family operation”). Thus, we are not persuaded by Applicant’s argument that MAGNUS will be understood by consumers as uniquely referencing the deceased individual named Joseph Magnus and, because this individual had no actual business involvement in Applicant’s affairs, this somehow negates the surname significance of MAGNUS in the mind of the public.

Put simply, Applicant’s self-made connection between its products and the deceased whiskey distiller, Joseph Magnus, exacerbates the surname significance of MAGNUS because actual purchasers of Applicant’s products will encounter the mark alongside surname use of MAGNUS. Furthermore and to be clear, there is no evidence showing that Joseph Magnus has any notoriety in the eyes of consumers other than possibly through Applicant’s promotion, let alone reach a level of fame that has been found in other cases as overcoming surname significance. *Cf. Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 165 USPQ 459, 461 (SDNY 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (holding SOUSA for fireworks and production of events and shows featuring

pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant's goods and services were of a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music"). Applicant's contention that Mr. Magnus was a whiskey pioneer and magnate does not, by itself, render him an historical figure or even famous. *See In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (despite evidence that Applicant with surname "Binion" played a significant role in the gaming industry in Las Vegas, BINION held primarily merely a surname because notoriety was not deemed so remarkable or significant to be an historical figure).

***Applicant's Claim of Ownership of Related Registrations***

Applicant has claimed ownership of two registrations: Reg. No. 5694463 (JOSEPH MAGNUS) and Reg. No. 5281526 (JOS. A. MAGNUS & CO.). In its request for reconsideration, Applicant argues:<sup>8</sup>

There is no doubt that personal name marks and trade names are registrable on the Principal Register as their primary significance on consumers is not merely a surname. The same is true of Applicant's online advertising noted by the Examin[ing Attorney], and the MAGNUS brand.

Applicant again made reference to its ownership of these registrations in its brief ("use of its registered marks JOSEPH MAGNUS (Reg. No. 5,694,463) and JOS. A. MAGNUS & CO. (Reg. No. 5,281,526) on whiskey, gin and distilled spirits."),<sup>9</sup> within

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<sup>8</sup> 6 TTABVUE 10.

<sup>9</sup> 7 TTABVUE 9.

its argument that “the primary significance [of MAGNUS] on the consumer is the reference to a particular person: Joseph Magnus.”<sup>10</sup>

Applicant, however, did not submit copies of these registrations and the Board does not take judicial notice of registrations, including those that may be owned by Applicant. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) 1208.02 (2019). Accordingly, the registrations that Applicant relies upon are not of record.

Even if, in arguendo, we were to accept Applicant’s claim of ownership of the aforementioned registrations, we fail to see how they would be probative with respect to the surname refusal as to MAGNUS, without any preceding given name. Applicant is correct that surnames preceded by given names or multiple initials are generally registrable on the Principal Register because the commercial impression conveyed is that of a specific individual and not primarily merely a surname. But that is not the case here. And, to the extent that Applicant is relying on its putative registrations to show that MAGNUS, by itself, has become a distinctive source identifier for Applicant’s goods, this is essentially a claim of acquired distinctiveness (i.e., a claim that the mark “has become distinctive of the applicant’s goods in commerce” under 15 U.S.C. § 1052(f)). Such a claim has not been asserted in the involved application and thus is not before us. *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1992) (“without a formal claim of distinctiveness under [Section 2(f)], evidence of fame cannot serve as the basis for allowing registration of applicant’s mark.”).

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<sup>10</sup> *Id.* at 7.

***Whether MAGNUS Has Any Non-Surname Meaning or Significance***

As to the third factor, the Examining Attorney and Applicant disagree as to whether there is a demonstrated alternative meaning for “Magnus.” The Examining Attorney asserts that MAGNUS “has no recognized meaning other than as a surname.”<sup>11</sup> In support, the Examining Attorney submitted “negative dictionary” evidence, that is, evidence showing that the term MAGNUS cannot be found in THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE<sup>12</sup> or MACMILLAN DICTIONARY.<sup>13</sup> The Examining Attorney submitted additional evidence showing the term MAGNUS in dictionaries, but points out that it is only used in conjunction with other terms, i.e., “Magnus effect” or “magnus hitch.”<sup>14</sup> And, with respect to the term “Magnus effect,” the Examining Attorney points out the etymology provided in the dictionary is “after Heinrich G. Magnus ... German chemist and physicist,” which supports surname significance.

The Examining Attorney also acknowledges Applicant’s submission of the following definition from the online CAMBRIDGE DICTIONARY: “magnus: a Latin word meaning ‘great,’ used in medical names and descriptions.”<sup>15</sup> However, the Examining Attorney argues that Applicant did not provide any additional evidence that the Latin

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<sup>11</sup> 9 TTABVUE 9.

<sup>12</sup> Attached to Office Action issued on January 3, 2018, TSDR p. 30.

<sup>13</sup> Attached to Office Action issued on May 17, 2019, TSDR p. 3.

<sup>14</sup> Attached to Office Action issued on November 15, 2018, TSDR pp. 7-8. Definitions taken from Merriam-Webster online dictionary.

<sup>15</sup> Attached to Applicant’s request for reconsideration; 6 TTABVUE 66.

meaning for MAGNUS would likely be understood by the relevant purchasing public.<sup>16</sup>

Applicant, on the other hand, contends that MAGNUS has two “recognized meanings and significance other than that of only a surname.”<sup>17</sup> After reiterating the argument that “consumers will immediately perceive the meaning and significance of MAGNUS as a reference to the pre-Prohibition era whiskey pioneer, Joseph Magnus,” but not associate the name with Applicant,<sup>18</sup> Applicant argues that “[t]he PTO has recognized this [Latin] meaning and significance on at least two occasions,” pointing to two cancelled registrations containing English translations of the term MAGNUS as “great, abundant, vast” and “great or king.”<sup>19</sup>

As to the Latin meaning of MAGNUS, there is minimal evidence to suggest that the relevant public would be aware of this meaning. A single dictionary definition showing that MAGNUS is the Latin word for “great” and “used in medical names and descriptions,” even when combined with the two translation statements from cancelled registrations, does not show that this meaning is well-recognized or would pertain to distilled spirits. Rather, the negative dictionary evidence from two other

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<sup>16</sup> 9 TTABVUE 10.

<sup>17</sup> 7 TTABVUE 11.

<sup>18</sup> *Id.*

<sup>19</sup> Applicant attached copies of the two registrations with its request for reconsideration (6 TTABVUE 40 and 46, respectively):

Reg. No. 1898233 (MAGNUS) for “bakery goods, namely, bread and rolls; mixes consisting principally of processed grains for making bread and rolls; and processed grain mixes for use as additives to bakery doughs” issued on June 6, 1995 and was cancelled on March 11, 2006.

Reg. No. 3461522 (MAGNUS) for “motion picture films about adult entertainment” issued on July 8, 2008 and was cancelled on February 13, 2015.

dictionaries indicates that the Latin meaning may be obscure or irrelevant to consumers' perceptions. There is no evidence showing use of this term in any form of parlance. Moreover, as to the translation statements in the now-cancelled registrations, we are not privy to any information that may have served as a basis for their entry into the registration files.

Accordingly, and on this particular record, we cannot find that MAGNUS has a recognized alternative meaning other than being a surname.

***The Existence of Third-Party Registrations for the Mark MAGNUS***

Applicant points out that the Examining Attorney initially refused registration of Applicant's mark on the additional ground that there was a likelihood of confusion with a registered standard character mark MAGNUS for wine.<sup>20</sup> A potential likelihood of confusion was also raised based on an earlier-filed application for the standard character mark MAGNUS for alcoholic beverages, except beers. The registration was subsequently cancelled and the application went abandoned, thus obviating both refusals.<sup>21</sup>

Applicant also submitted copies of twelve live, third-party registrations for the standard character mark MAGNUS in connection with various goods and services.<sup>22</sup>

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<sup>20</sup> Office Action dated January 3, 2018, with copies of the cited registration (Reg. No. 4074283) and application (Ser. No. 87476755) attached.

<sup>21</sup> Reg. No. 4074283 (issued December 20, 2011) was cancelled on July 27, 2018. Application Ser. No. 87476755 (filed June 6, 2017) was abandoned on March 7, 2018.

<sup>22</sup> Copies of the registrations attached to the request for reconsideration (6 TTABVUE 14-43). Applicant also submitted copies of various applications and cancelled registrations. However, applications have no probative value other than to show that they were filed; the cancelled registrations likewise have little to no probative value because they only show that they at one point issued.

The registrations are on the Principal Register with no claim of acquired distinctiveness.

Applicant argues that the existence of the aforementioned registrations shows that the Office has “given the word mark MAGNUS arbitrary and distinctive trademark and service mark significance with respect to various goods and services” and that “[t]here is no logical reason to conclude that purchasers encountering a third party’s MAGNUS mark for ‘wines,’ ‘alcoholic beverages, except beers’ or any of the other goods and services associated with the disclosed MAGNUS Principal Registrations would not give that MAGNUS mark surname significance, while purchasers encountering Applicant’s MAGNUS mark on ‘whiskey, gin and distilled spirits’ would afford the MAGNUS mark surname significance.”<sup>23</sup>

In response to the third-party registration evidence, the Examining Attorney asserts that “each application must be considered on its own record” and that Applicant has not “indicate[d] whether the third-party registrations include a fact pattern that is similar and significant to the instant refusal, namely, the Applicant’s use of MAGNUS as a surname on its website, in its marketing materials, and on its goods.”<sup>24</sup>

The Examining Attorney is correct, and as we have often held, we must decide each case on its individual merits and record; we cannot substitute evidence before us with findings made by examining attorneys or the records in other proceedings. *In*

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<sup>23</sup> 7 TTABVUE 16.

<sup>24</sup> 9 TTABVUE 11-12.

*re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (“Although consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us”); *In re Finisair Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). The Federal Circuit has also instructed that each case must be examined on its own merits against the backdrop of the governing statute(s), and that the USPTO’s allowance of prior registrations that may have some characteristics of the application at hand does not bind the USPTO. *In re Shinnecock Smoke Shop*, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); and *In re Nett Designs, Inc.*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We thus keep in mind that our finding that Applicant closely associates itself and its goods with that of an individual having the surname MAGNUS can only be made based on the evidence of record in this appeal.

At the same time, we do not ignore the twelve live registrations for the same mark, MAGNUS, all on the Principal Register without a claim of acquired distinctiveness, covering various goods and services. At the very least, the existence of these registrations shows that the Office, on at least a dozen occasions, has not held MAGNUS to be primarily merely a surname. However, without knowing more, or in fact anything, about the underlying facts and circumstances in those cases, we cannot say that the registrations demonstrate Office practice with respect to the surname significance of MAGNUS. Moreover, in this case, Applicant promotes a connection with an individual with the surname MAGNUS; the same may not have been true

with the 12 third-party registrants. Without being privy to the prosecution records of those registration files, it is not possible to ascertain whether the examining attorneys determined that there was no connection between the registrants and individuals having the surname MAGNUS or if there was additional evidence that is not before us in this proceeding. In other words, the examining attorneys may have reached the determination that MAGNUS is not primarily merely a surname based on evidence not of record in this proceeding.

***Whether MAGNUS has the Structure and Pronunciation of a Surname***

Whether a term has the structure and pronunciation of a surname is a “decidedly subjective” inquiry. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016) (quoting *Benthin*, 37 USPQ2d at 1333). As the Board noted in *Olin*, 124 USPQ at 1332, “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.”

The Examining Attorney relies on US Census evidence and argues that MAGNUS “has the structure and pronunciation of a surname because it is the prefatory wording in four surnames: Magnuson, Magnusson, Magnussen, and Magnusen.”<sup>25</sup> We are not convinced by this reasoning or evidence. To the contrary, the evidence tends to indicate that MAGNUS may have significance as a given name. That is, the four surnames listed above are patronyms – a surname created by adding a suffix, such as “son” or the equivalent, to the given name of a father or ancestor, e.g., John-

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<sup>25</sup> 9 TTABVUE 11, citing to evidence attached to Office Action dated November 15, 2018.

Johnson, Donald-Donaldson, Robert-Robertson, David-Davidson, Peter-Peters[o,e]n, etc. We hasten to add, however, that Applicant has not argued that MAGNUS has any significance as a first name.

Applicant, on the other hand, asserts that “the average American purchaser would correctly believe that the mark has the structure and pronunciation of a non-English word, such as a Latin term,”<sup>26</sup> referencing the CAMBRIDGE DICTIONARY definition showing it to be a Latin word. Applicant also relies on the Examining Attorney’s negative MACMILLAN DICTIONARY evidence that provides “Sorry, no search results for magnus. Did you mean: magnums magnum magnets . . . [and other words].”<sup>27</sup>

We agree with Applicant that the structure and pronunciation of MAGNUS may suggest a Latin word to some American consumers. However, we reiterate this is a fairly subjective matter and is certainly not conclusive that consumers encountering MAGNUS on Applicant’s goods would not perceive the term as a surname. We thus find this factor neutral.

### ***Conclusion***

We have considered the evidence before us in its entirety and all relevant factors and ultimately find that a prima facie showing has been made that consumers are likely to view and understand the mark MAGNUS on the identified goods to be primarily merely a surname. Although the Office has previously found MAGNUS to be inherently distinctive in other cases, we cannot rely on those registrations and

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<sup>26</sup> 7 TTABVUE 14.

<sup>27</sup> Negative dictionary evidence attached to Office Action dated May 17, 2019, 4 TTABVUE 50.

must base our decision on the record before us. The evidence regarding any possible alternative, non-surname meaning for MAGNUS is meager and counterbalanced by the negative dictionary evidence. We are persuaded that consumers will perceive MAGNUS as a surname because Applicant strongly promotes a connection between itself and an individual having the surname MAGNUS. “This, in itself, is highly persuasive that the public would perceive [the mark] as a surname.” *In re Weiss Watch*, 123 USPQ2d at 1202, quoting *Darty*, 225 USPQ at 653.

**Decision:** The refusal to register is affirmed. The application will be abandoned in due course.