

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 18, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Gwabboh LLC

—
Serial No. 88106129

—
Gwabboh LLC, pro se.

Elizabeth O'Brien, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

—
Before Mermelstein, Lynch and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Gwabboh LLC, applied to register the mark DARBYSHIRE (in standard characters) on the Principal Register for “audio books in the nature of short stories” in International Class 9, “[a] series of fiction works, namely, novels and books” in International Class 16, and “Digital on-demand printing services of books and other documents” in International Class 40.¹ Applicant appeals from the

¹ Application Serial No. 88106129 was filed on September 6, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) based on Applicant’s claim of a bona fide intent to use the mark in commerce.

Trademark Examining Attorney's final refusal to register on the ground that DARBYSHIRE is primarily merely a surname pursuant to Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4). We reverse.

I. Applicable Law

Section 2(e)(4) of the Trademark Act prohibits registration on the Principal Register of a mark that is primarily merely a surname, unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f). "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." *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017) (citing *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017)).

Whether the primary significance of a term is merely that of a surname is a question of fact that must be resolved on a case-by-case basis, founded on the record as a whole. *In re Olin Corp.*, 124 USPQ2d at 1330; *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017). Among the circumstances that may be probative in making this determination are: the extent to which the term is exposed to the public as a surname; whether the term is the surname of anyone connected with the applicant; whether the term has any recognized meaning other than as a surname; and whether the term has the structure and pronunciation of a surname. These factors are not exclusive, nor are they presented in order of importance; any of the factors—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case. *Id.*; *In re Integrated Embedded*, 120 USPQ2d

1504, 1506 n.4 (TTAB 2016); see *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995).

II. Analysis

The Examining Attorney argues that DARBYSHIRE is primarily merely a surname based on evidence she provided regarding the public perception, third-party use, and absence of any recognized meaning of the term other than as a surname. Applicant argues that because DARBYSHIRE is a fanciful term, is extremely rare as a surname, and is unconnected to Applicant, the mark should not be considered to be primarily merely a surname.

A. Extent to Which DARBYSHIRE is Encountered as a Surname

The Examining Attorney submitted the results of four different searches for persons with the surname DARBYSHIRE to support her argument that the public perceives DARBYSHIRE as a surname, including:

- 573 records of persons in the United States from the LexisNexis Public Records surname database;²
- 98 records of persons in the United States from the website YellowPages.com;³
- 598 records of persons (1:1,927,662 ratio) in the United States from the website Forbears.co, and

² June 6, 2019 Final Office Action, TSDR 6. The same search conducted by the Examining Attorney for the December 18, 2018 Office Action yielded 465 records.

Trademark Status & Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

³ *Id.* at 8-36.

- 137,950 records for persons worldwide from the website MyHeritage.com, but without a breakdown as to the number of persons in the United States.⁴

Applicant does not dispute that DABRYSHIRE is a surname but argues that it is “extremely rare” based on the roughly 500-600 persons in the United States having that surname, according to the Examining Attorney’s evidence.

We conclude from the evidence that DARBYSHIRE is a rare surname. However, even a rare surname is not registrable if “the purchasing public for Applicant’s [goods and] services is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *In re Beds & Bars, Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017); *see also In re Eximius Coffee*, 120 USPQ2d 1276, 1281 (TTAB 2016) (“Section 2(e)(4) makes no distinction between rare and commonplace surnames ... and even a rare surname is unregistrable if its primary significance to purchasers is a surname.”) (Citations omitted).

The Examining Attorney also made of record pages from a number of websites to support her argument that the public perceives DARBYSHIRE as primarily merely a surname, including pages from

- HouseofNames.com, which discusses the origin and history of the name, migration of the Darbyshire family to the New World, five Darbyshire settlers in the United States in the 17th-19th century, and a number of English notables having the name Darbyshire, as well as one member of the North Dakota State House of Representatives, who is the only American listed among the nine “Contemporary Notables of the name Darbyshire (post 1700)”;⁵

⁴ December 18, 2018 Office Action, TSDR 7-8. We discount this last source because it does not distinguish between persons abroad and those in the United States and therefore has little probative value.

⁵ June 6, 2009 Final Office Action, TSDR 45-50.

- Wikipedia.com, listing nine purportedly “notable” people in the United Kingdom having the surname Darbyshire;⁶
- WillDarbyshire.com, the personal website of author Will Darbyshire, who wrote a book that is offered for sale on Amazon;⁷
- Darbyshire.com, the business website of Daryshire Machine, Inc., a New Mexico company founded by Jack Darbyshire in 1952 that produces farming equipment;⁸ and
- Darbyshire.uk.com, a United Kingdom business website for a picture framer and fine art fabricator based in London.⁹

Applicant argues that this evidence is not probative because these are not commonly known websites:¹⁰

[I]t is well known that a web domain can be purchased and a web page can be built within minutes on a builder, very inexpensively. Furthermore, the amount of web traffic these sites receive is unknown. Given this information, it is highly unlikely that a few uncommonly known sites can transform the name borne by roughly 500-600 persons in the country into a common name.

The Examining Attorney responds that Applicant’s argument should not be considered because “[A]pplicant did not provide evidence showing these sites are uncommon.”¹¹ It is, however, the Examining Attorney’s initial burden to establish a prima facie case that an applicant’s mark is primarily merely a surname. *In re*

⁶ *Id.* at 51.

⁷ *Id.* at 53-54.

⁸ *Id.* at 55-56.

⁹ *Id.* at 57-60.

¹⁰ 4 TTABVUE 4.

¹¹ 6 TTABVUE 6.

Hutchinson Technology, Inc., 852 F.2d 552, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988); *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). Therefore, we consider these websites for whatever value they may have, balanced against other factors being considered.

Although it is inaccurate to suggest that a surname must be a common name to be refused registration, as Applicant does, we agree that this evidence does not suffice to show that U.S. consumers are familiar with DARBYSHIRE as a surname. To begin with, one would first have to be familiar with DARBYSHIRE as a surname to engage in search for its history and origins, or to search for notable persons having that name. Second, the evidence is inadequate to show that the “notable” persons referred to on those websites, predominantly from the United Kingdom, are notable to the ordinary purchaser in the United States. Third, given the nature and content of the websites, we cannot presume that U.S. purchasers have been exposed to the several personal and business websites listed. On this record, we find that DARBYSHIRE is rarely encountered as a surname and is unlikely to be perceived by the public as having surname significance.

B. Connection to Applicant as a Surname

Applicant states that DARBYSHIRE is not the surname or anyone connected to or associated with Applicant.¹² In reply, the Examining Attorney observes that this, therefore, is a neutral factor,¹³ which is correct. The fact that the proposed mark is

¹² 4 TTABVUE 4.

¹³ 6 TTABVUE 8.

not the surname of someone associated with Applicant does not tend to establish one way or the other whether the proposed mark would be perceived as a surname. *In re Piano Factory Grp. Inc.*, 85 USPQ2d 1522, 1524 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004).

C. Recognized Meaning Other than a Surname

The Examining Attorney provided “negative dictionary” evidence, that is, evidence showing that the term DARBYSHIRE cannot be found in THE OXFORD DICTIONARY or THE COLUMBIA GAZETTEER OF THE WORLD,¹⁴ which Applicant does not dispute. Accordingly, we find that DARBYSHIRE has no recognized ordinary language meaning or significance. *In re Etablissements Darty et Fils*, 225 USPQ 652, 653 (Fed. Cir. 1985); *Eximius Coffee*, 120 USPQ2d at 1278 (citing *Darty*).

D. Structure and Pronunciation as a Surname

While neither the Examining Attorney nor Applicant provided evidence as to whether DARBYSHIRE has the structure or pronunciation of a surname, we take judicial notice of the fact that a “shire” is “an administrative subdivision *especially*: a county in England”¹⁵ and is used a suffix in the names of English counties, e.g., Oxfordshire and Yorkshire.¹⁶ As a result, we find that DARBYSHIRE tends to evoke a place name rather than a surname.

¹⁴ December 18, 2018 Office Action, TSDR 10-16.

¹⁵ <https://www.merriam-webster.com/dictionary/shire>. The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions.

¹⁶ <https://dictionary.cambridge.org/dictionary/english/shire>

III. Conclusion

In sum, we find that the evidentiary record, as a whole, does not establish that the primary significance of DARBYSHIRE to the purchasing public is merely that of a surname within the meaning of Section 2(e)(4). Because we have doubts, we resolve those doubts in Applicant's favor. *See In re Benthin Mgmt. GmbH*, 37 USPQ2d at 1334.

Decision: The refusal to register under Trademark Act § 2(e)(4) is reversed.