

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Teresa H. Earnhardt

v.

Kerry Earnhardt, Inc.

Opposition Nos. 91205331 (parent) and 91205338
Serial. Nos. 85383910 and 85391456
—

ON REMAND FROM THE U.S. COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Larry C. Jones and Carla Clements of Alston & Bird LLC
for Teresa H. Earnhardt.

D. Blane Sanders and Cary B. Davis of Robinson, Bradshaw &
Hinson, P. A. for Kerry Earnhardt, Inc.

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Before Bergsman, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

On February 26, 2016, the Board issued a decision dismissing the consolidated oppositions filed by Teresa H. Earnhardt (“Opposer”) to the Kerry Earnhardt, Inc. (“Applicant”) applications for the mark EARNHARDT COLLECTION for “furniture,” in Class 20, and “custom construction of homes,” in Class 37. The oppositions were

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based on a claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and a claim that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4).

Opposer appealed to the U.S. Court of Appeals for the Federal Circuit. In its decision dated July 27, 2017, the Court vacated the Board's decision solely on the basis of the Section 2(e)(4) refusal and remanded the matter to the Board to determine whether the mark EARNHARDT COLLECTION is primarily merely a surname. In our February 26, 2016 decision, we found that the name "Earnhardt" is not merely a surname.

The Court ordered us to consider the following: (1) whether the term "collection" is merely descriptive of Applicant's furniture and custom home construction services and (2) the primary significance of the mark as a whole to the purchasing public. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1415 (Fed. Cir. 2017).

A. Is the term "collection" merely descriptive of Applicant's furniture and custom home construction services?

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

In support of its argument that “collection” is merely descriptive of Applicant’s furniture, Opposer introduced webpages from various third-party websites showing the word “collection(s)” being used in connection with furniture, i.e.: Thomasville Furniture Collections, Horchow Furniture, Crate & Barrel, Ashley Furniture Home Store and Kincaid Furniture. Clements, Test. 51 TTABVUE at 13, 26, 29, and 32-45. In each example, the word “collection” is used to designate a grouping of brands or styles of furniture (Thomasville – AMERICAN ANTHEM), a grouping of furniture by use (Horchow Dining Collections) or a grouping of furniture by material composition of the furniture (Kincaid Furniture – wood collection and upholstery collection). *Id.* at 26, 29, 45.

The word “collection” is defined as:

2. A group of things or people.

“a rambling collection of houses.”¹

Based on the record before us, we find that the term “collection,” when used in connection with furniture, provides information to the consumer about the manner in which the furniture is grouped to effectuate sale, which, as discussed above may be by brand, place of use (dining room collection) or composition (wood collection). Accordingly, the term “collection” is merely descriptive of furniture.

¹ We take judicial notice of the definition of the word “collection,” from the online US English version of Oxford Living Dictionaries, en.oxforddictionaries.com (accessed November 13, 2018). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

Similarly, the record shows that use of the term “collection” in connection with the custom construction of homes also conveys information to consumers, for example, that houses of similar styles or characteristics are grouped together for marketing. According to Mary Becker, Vice President of Sales and Marketing of Shumacher Homes, Applicant’s licensee, her company uses the term “collection to describe the architectural style of the EARNHARDT COLLECTION homes.” Becker Test, 50 TTABVUE 16, 50. She also testified that other companies use the term “collection” to indicate that their homes have certain features and in the housing industry the term collection can be used to identify a portfolio or group of homes or home designs. *Id.* at 50, 52. When used in connection with custom-constructed homes, the term “collection,” conveys an immediate idea of a grouping of homes by architectural style, as well as other common features. Because “collection,” when used in connection with the custom construction of homes immediately conveys ideas about groupings of homes with a common architectural style (characteristics), and features, it is merely descriptive of the Applicant’s services.

B. What is the primary significance of the mark as a whole to the purchasing public?

“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, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988), *see also*, *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1481-82 (TTAB 2017). Thus, we must determine whether the addition of the term “Collection” detracts from or displaces

the surname significance of the name “Earnhardt” in the mark EARNHARDT COLLECTION.

The evidence of record establishes that the word “Collection” is merely descriptive of characteristics of Applicant’s furniture, such as styles, uses or material composition, and that it is descriptive of characteristics and features of Applicant’s custom construction of homes services, such as construction of homes in particular architectural styles. Moreover, there is nothing in the combination of EARNHARDT COLLECTION that diminishes or transforms the immediate connotation that the furniture or custom construction of homes services involves a grouping under the EARNHARDT name. Thus, the word “COLLECTION” does not detract from or change the surname significance of the mark EARNHARDT COLLECTION. *See, In re Integrated Embedded*, 120 USPQ2d 1504, 1510 (TTAB 2016) (Addition of term “GROUP” to the surname “BARR” “does not detract from or change the significance conveyed by the mark BARR GROUP as a whole.”). Accordingly, the addition of the descriptive word “COLLECTION” to the surname “EARNHARDT” does not detract from the surname significance of the mark EARNHARDT COLLECTION. Taken together, the primary significance of the mark EARNHARDT COLLECTION is that it merely indicates that the goods and services are sold in a group or collection by a person named EARNHARDT.

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Accordingly, we find that the mark EARNHARDT COLLECTION for furniture and the custom building of homes is primarily merely a surname and we reverse our dismissal of the opposition on the basis of the surname refusal.²

Decision: The opposition is sustained.

² Our dismissal of Opposer's claim of likelihood of confusion is not affected by this decision.