

Surnames and American Trademark Law

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American law discourages trademark registration of words that look and sound like surnames, yet some surnames are trademarks or parts thereof. The controlling issue in determining whether a mark is “primarily merely a surname” is its primary significance to the purchasing public, but several factors contribute to this determination: (1) surname rareness; (2) personal relation to the surname; (3) alternate meanings; (4) whether the mark has the structure and pronunciation of a surname; and (5) the mark’s style. Thus, rarer, semantically developed, transparently onomastic words have a better chance of trademark status: it is by no means easy to determine what counts as the look and sound of a surname. Trademark law inadvertently promotes onomastic discrimination. Because the mass of American consumers easily identifies Western European surnames, those names are better protected from commercial appropriation. The “look and sound of a surname,” after all, is culturally determined. As a result, the law both reflects and reinforces attitudes about what counts as a surname and what doesn’t.

American law discourages trademark registration of words that look and sound like surnames, so that, among other reasons, those possessed of particular surnames can use their own names for commercial purposes. The assumption would seem to be that, if a word is easily recognizable as a surname, it “belongs” to those it denominates and cannot be appropriated to a firm’s exclusive use. Yet it is also true that some surnames are used as trademarks or parts thereof. The controlling issue in determining whether a mark is “primarily merely a surname,” as defined by the federal Lanham Act (15 U.S.C § 1051, 1052(e)(4)), is its primary significance to the purchasing public, and several factors contribute to this

determination. The factors recognized by trademark law inadvertently promote onomastic discrimination; because the mass of American consumers easily identifies Western European surnames, those names are better protected from commercial appropriation than would less frequently encountered surnames from other parts of the world. The “look and sound of a surname,” after all, is culturally determined. As a result, the law both reflects and reinforces attitudes about what “counts” as a surname and what doesn’t.

Trademark law places marks into a “spectrum of distinctiveness,” whereby marks are classified as (1) arbitrary or fanciful, such as ZIMA for a brand of malt beverage or APPLE for a brand of computer; (2) suggestive, such as VISA for a brand of credit card; (3) descriptive, such as LEAN CUISINE for a brand of low-calorie frozen meals; or (4) generic, such as *escalator*, *shredded wheat*, *aspirin*, *frisbee*, etc., based upon their use and their significance to the purchasing public. An arbitrary or fanciful mark is a word in common usage applied to a product or service unrelated to its meaning. Such marks are generally considered to be the best and most distinctive kinds of trademarks; their ability to identify the source to which they refer is given the broadest protection under the law. Arbitrarily coined or fabricated words also fall under this category, such as the marks XEROX for photocopiers or CINGULAR for wireless services.¹ On the other end of the spectrum are generic words, those not used for a brand of a kind of thing but for the kind of thing itself. Such words are not registrable as trademarks.

Between the two ends of the spectrum lies a range of non-inherently descriptive marks, which are only registrable upon a showing of secondary meaning. Trademark law places personal name marks into this category, and a registrant claiming protection for a mark found by the Patent and Trademark Office to be “primarily merely a surname” will be refused registration.

Surname marks can be protected as trademarks only upon proof that, through their use in the marketplace, they have acquired distinctiveness and secondary meaning. The key to achieving registration of a surname mark is whether the public will likely perceive the term to be a surname, or whether it has

had such an impact upon a substantial part of the buying public as to have acquired “secondary meaning.” That is, the public has come to recognize the personal name as a symbol that identifies and distinguishes the goods or services of only one seller (McCarthy 2003, §13:2).

As explained in *Visser v. Macres* (1963),

Secondary meaning grows out of long association of the name with the business, and thereby becomes the name of the business as such; is acquired when the name and the business become synonymous in the public mind; and submerges the primary meaning of the name as a word identifying a person ... in favor of its meaning as a word identifying that business.

Registration of surnames is difficult and disfavored, possible ONLY upon a demonstration of secondary meaning, as defined in *Visser*. Generally, proof that a name has acquired secondary meaning and should have trademark status is determined by survey evidence of consumer awareness of the name and its association with a particular business.

There are two primary rationales under the law for requiring secondary meaning for personal name marks. First, such marks are “descriptive,” that is, merely describe some attribute of the product, rather than pinpoint one source of all goods described by the mark. Second, no one seller should have the right to prevent others from using a descriptive term to describe their goods honestly. McCarthy (2003, §13:4) explains of the first rationale that

[p]rior to the acquisition of secondary meaning, customers will take the personal name as being merely

descriptive of the name of the maker or seller of the goods, and not indicative of any single manufacturer or seller who happens to have that personal name.

So consumers are likely to take Smith's Used Cars as a business in which a person called Smith sells cars, rather than a business, like Romano's Macaroni Grill, with distinctive features recognized even by those who have never eaten at one or another incarnation of the restaurant franchise.

MacSweeney Enterprises, Inc. v. Tarantino (1965) describes the second rationale in terms of the alleged 'right' to use one's own name in one's own business, to "family pride of name." This rationale carries considerable credence in modern law, though it is a qualified right: if a senior user has acquired rights in a surname mark, then a junior user – even one with the same name – must take care not to use the mark in a way that will not cause confusion for customers. In other words, "[p]ersons with names that are the same as ... strong personal name trademarks have no 'right' to confuse the public by engaging in certain businesses under their name" (McCarthy 2003, §13:8). Thus, the (ostensible) overriding principle behind commercial appropriation of words for trademarks – consumer protection through avoiding marketplace confusion – holds true in the case of personal surname marks as well.

The Lanham Act specifically disallows registration of a mark that is "primarily merely a surname." The statutory word "'primarily' refers to the main significance of a word as a word, not to its significance as a trademark due to advertising and promotion" (McCarthy 2003, §3:28). Evidence of secondary meaning must always be submitted on the record to register such a surname as a mark. This can be accomplished in several ways. For example, applicants may claim distinctiveness based upon five years' use of their marks, or by demonstrating through dictionary evidence that the name or mark has an alternative, recognized meaning other than as a surname. Surnames may also be registrable if

they are “rare” or do not create the impression of being a surname.

As set forth in the Trademark Trial and Appeal Board (TTAB) case, *In re Benthin Management GmbH* (1995), the factors relevant to the question of whether a mark is primarily merely a surname are (1) the degree of a surname’s rareness, (2) whether anyone connected to the application has the surname in question, (3) whether any other recognized meaning exists for the surname, (4) whether the mark has the “structure and pronunciation” of a surname, and (5) the style of the lettering of the mark. In making its determination of surname significance, the TTAB will consider each of these factors; any one factor can be dispositive, though none necessarily is. McCarthy (2003, §13:30), in analyzing and explaining the significance of these factors, says only of the fourth factor, regarding the “structure and pronunciation” or “the look and sound” of a surname, that “this is a subjective factor, estimating the likely perception of customers [of] the term.”

The language of the *Benthin* case sheds little more light on the TTAB’s interpretation of this factor. Besides explaining that this factor is “decidedly subjective in nature,” the case quotes *In re Industrie Pirelli Societa per Azioni* (1988), as stating that “certain rare surnames look like surnames, and certain rare surnames do not ... ‘Pirelli’ falls into the former category, while ‘Kodak’ falls into the latter.” The *Benthin* court then merely explains that, “in our judgment, Benthin does not have the clear look and sound of a surname like Pirelli does, nor does it have the clear look and sound of an arbitrary [in this case invented] term like Kodak does.”² Clearly, then, under the *Benthin* decision, the “look and sound” of a trademark that may determine its surname status will be left to the subjective discretion of the TTAB (or other judicial body), with little guidance to aid in the determination of what exactly constitutes “look and sound” for surname trademark purposes.

For purposes of the law, the above factors are neutral; they may not be quite so neutral in a wider, sociolinguistic sphere. Certainly, they do not confront certain anomalies directly and may lead to outright inconsistencies, as the subjective criteria that already exclude *Pirelli* from immediate registration and allow registration of *Kodak* and *Benthin* imply. To begin, the general principle of excluding from registration terms that are “primarily merely surnames” makes little sense alongside the factors used to determine what counts as falling into the general category, since those names used ONLY as surnames may be those most available for registration – those names that are ONLY surnames, that otherwise seem arbitrary or fanciful, are oddly not PRIMARILY, MERELY surnames.

This inconsistency leads, at least potentially, to some unpleasant consequences. Like *Kodak* and *Benthin*, the Provençal surname *Radigue* (see Hanks and Hodges [1996], s.v. **Radigue**) is more or less absolutely NOT primarily merely a surname: it is very rare; it bears no other meaning besides that of a surname (in fact, its origin is unknown); and American consumers, at least, would not recognize it as possessing the look or sound of a surname. One might take it as a French common noun, even if one knew some French, since few non-native French speakers know most French nouns. This conclusion would be obviated in the course of appeal, since one need only look the word up in dictionaries to discover, first that it isn't a French common noun and, second, that it is a French surname. A decision about registrability would depend on how the TTAB weighed relatively the *Benthin* factors against the fact that *Radigue* is a surname. It is important to note that, given many opportunities to weigh facts more heavily than factors, the TTAB has sometimes refrained from doing so, and sometimes not, a result that that some bearers of some names might find unfair.³

Imagine that a family of *Radigues* emigrates to the United States and, upon establishing themselves, open a family restaurant – they call it *Radigues' Family Restaurant*. For

the most part, they serve the sort of food expected by local residents; they include Provençal dishes among their daily specials. Imagine also that an already established restaurant chain has registered the word *Radigue* for that chain (perhaps expecting to serve Provençal dishes, perhaps not). Arguably, *Radigue* is not excluded from registration by ANY of the five factors developed to determine *Benthin*. Thus the term could be registered and, further, the chain could contest the family's right to use its name, especially if the chain opened a restaurant in the same community, due to its senior use of a form of the name. Thus the factors would controvert a very important principle for which surnames are generally excluded from registration, that no one would lose the right to his or her surname for commercial purposes, at least until secondary meaning had been established.

Had the family opened their restaurant before the chain had applied for registration, the legal issues and circumstances would be considerably more complicated. The chain would be interested in achieving secondary meaning for *Radigue*. If it opened restaurants under that name, the Radigues might seek an injunction to circumscribe use of their name in commercial competition. Yet, if *Radigue* could successfully continue use of its name long enough, and with commercial success, they might overcome the Radigues' common law rights, and at least would be able to compete against the Radigues in the same commercial domain, and might even be able to circumscribe the Radigues' use of their name to the original location and original restaurant, preventing them from developing a chain under their own name – not exactly an infringement of opportunity, but also not the commercial surname viability that the Radigues, or most other Americans, might expect.

There is considerable uncertainty about the status of surnames embedded in American trademark law, especially, as McCarthy notes, in application of the “structure and pronunciation” factor, which is so subjective as to result in

fairly arbitrary distinctions among names. For instance, *Grayson* would appear to have the look and sound of a surname, partly because of the patronymic suffix, but what about *Greaves*, a variant of *Grayson*?⁴ Certainly *Greaves* is rare compared to *Grayson*, though it probably has the structure and pronunciation of a surname in sufficient degrees to prevent immediate registration.

Smith, *Taylor*, *Chamberlain*, and *Stewart* all have other than surname meanings, though there aren't many practicing chamberlains or stewards in 21st-century America. But to what extent do *Farrar*, *Souter*, or *Milne* have other meanings? That is, how are archaic or obsolete meanings, even for common occupations, calculated among the factors? Does it matter that *Souter* and *Milne* are recognizable because they have famous holders, even though they are otherwise so rare as to be unknown? What about a name like *Flesher*, very rare, unpleasant in its connotations, and supplanted by a later name, *Butcher* – certainly it has the look and the sound of a surname, but in the current onomastic climate it looks and sounds invented. Do *Rouse/Rowse/Russell*, which all derive from the same root, have the same status in terms of structure and sound? What about *Powell* (from Welsh *ap Howell*), pronounced the way you'd expect, versus pronounced as *Pole*? There is a famous case of brothers (one a great English novelist, the other formerly a chief justice of the Queen's Bench), who pronounced *Powell* differently, one *Pole*, the other *Powell* – does it make a difference to the "sound" and "look" requirement that the word would usually be pronounced one way, according to spelling, but also in a way contrary to modern expectations of how to pronounce certain spellings?⁵ What about fictional names that have the look and sound of surnames, such as *Fitzherman*, with patronymic structures and familiar parts, that for reasons of etymology aren't historical surnames? Are such words arbitrary and fanciful, or is their creativity trumped by the look and feel factor?

Such questions can only be answered by a close examination of existing and future case law; to date, there has been precious little written by legal scholars to address the confusion that still exists as to what makes a trademark “primarily merely a surname,” and nothing at all to question the inconsistent treatment of non-Western European surnames in trademark law.

In a pre-*Benthin* law review article, Spencer T. Smith (1973, 28-29) proposes the following legal test: “A mark will be ‘primarily merely a surname’” only when the relative popularity of the mark as a surname (very well known, commonplace, or rare) exceeds the relative familiarity of the non-surname significance of the mark (very well known, moderately well known, not well known, or none). Where the relative popularity of the mark as a surname is equal to or less than the relative familiarity of the non-surname significance of the mark, the mark is not “primarily merely a surname” and is registrable on the Principal Register.

Smith optimistically states that his proposed rule “not only yields the correct results but introduces into this area of the law a sense of predictability, the absence of which to date has resulted in the issuance of numerous apparently diverse and irreconcilable decisions.” The proposed rule obviously takes into account none of the sociolinguistic issues addressed herein, however, and, were it to do so, it would fail to introduce the desired “sense of predictability” into registrability decisions.

Both general principles and anomalies lead to the same conclusions about the status of surnames, not only in American law, but also in American culture. The law is redolent of particular onomastic attitudes, at once holding up a mirror that more or less accurately reflects American perceptions of onomastic hierarchies and expressing, perhaps even helping to perpetuate, those hierarchies in concrete commercial and legal contexts.

For the less Anglo-American (or at least European) one's name, the more susceptible it is to immediate registration. Finno-Ugric names seem arbitrary or fanciful to speakers brought up homonymic *Smith* and *smith* or *Brown* and *brown*: in the world of immediate registration, it's hard to be a Wesson, let alone a Rakoczy, even though Rakoczy is a surname minimally represented in the United States.⁶ But in cases where secondary meaning counts, would one prefer to attempt registration of *McDonald's*, with its in-your-face Anglo-American patronymic structure, or *Rakoczy's*? Which name will most likely promote consumer recognition of the mark (and the commercial success) essential to achieving secondary meaning? The less European (and, probably, the less Anglo-American), the more susceptible one's name is to immediate registration, and the less useful in pursuing secondary meaning as a means to eventual registration.

The case of Colt International, manufacturer and purveyor of ventilation equipment, well illustrates the commercial motives, reflected in the ultimate registration of trademarks, as described here. According to Room (1982, s.v. *Colt*),

The firm was founded in 1925 not by a Mr Colt but by his business partner, later the company's chairman, I. J. O'Hea. Mr O'Hea chose the name of his partner, W. H. Colt, rather than his own as he regarded it a less awkward one. Ironically – and somewhat amusingly in the circumstances – Mr Colt's real name was actually Gleischner, and he had adopted his wife's maiden name on coming to England for virtually the same reasons that prompted Mr O'Hea not to use his own name for the company.

The story of Colt International is a British, not an American one, but the terms of onomastic preference and prejudice aren't much different – one's chances of commercial success in the 1920s in England were better if they weren't marked by either a German or an Irish name. When in Rome, adopt a

Roman surname – that is, if you hope to be a commercial success. Of course, Rome was no melting pot, and the inconsistencies potential in the use of surnames as trademarks in America derive uniquely from incongruities of American culture and American law.

How might the law address such an array of questions, so many invitations to inconsistency? Stringent, narrow application of the factors outlined earlier would help, as would promotion of naming or branding strategies other than the wholesale appropriation of surnames. Surnames are easily reanalyzed and adapted into fanciful, arbitrary, non-descriptive marks. For instance, *Amikar* is formed (somewhat mysteriously) on the names of the brothers, Lamy and Émile Akar, who produced the car known by that name. *Ampex*, a mark for a certain type of videotape, was formed acronymically from the name of its inventor, Alexander Mathew Poniatoff. J. T. Bancroft and Sons clipped and blended *Bancroft* and *nylon* to arrive at *Ban-Lon*. Campbell Paterson introduced his instant liquid coffee under the name *Camp*, partly to represent his name; but the coffee was advertised (and labeled) with pictures of a Scots army officer, in camp, enjoying a cup of it, so that the visual accompaniment shifted the mark from its otherwise obvious onomastic association. One can find many examples of marks thus manufactured from names and elements of names that do not pull surnames out from under those who bear them and into anonymous, but inaccessible corporate, commercial uses.⁷ The more assiduously the law resists the use of unaltered surnames, the better applicants will satisfy the five factors and the less likely they will trample the good names of unsuspecting, powerless persons, as a result of commercial use – surely, there are those who wish currently that they did not bear the names *Boeing* or *Halliburton*, whatever they think of the American military-industrial complex or the policies of one or another American administration.⁸ In other words, the questions asked earlier

need not be answered, if formation of trademarks simply avoided use of surnames *qua* surnames as marks.

Saul Henchman, the protagonist of Anthony Powell's novel *The Fisher King* (1986, 89), observes that, "[j]ust as crystallization of surnames was one of the steps in human civilization, their relinquishment gradually increases as we revert to savagery." Surely, American trademark law's treatment of surnames won't lead us backwards into savagery, but we mustn't dismiss Henchman's subtler point, that surnames express social relations historically, perhaps perpetually, integral to civilization. What's in a name? In fact, much more than one initially expects to find there, nothing less than the complex, historically sedimented negotiations among individuals, families, and society at large, with the attendant commercial rough-and-tumble. It is a truism to say that all persons are created equal, though their names are not. Still, surnames have significance to those who bear them, as well as to those who use them commercially, and a corporation's gain can be a family's loss, so the nexus of onomastics, sociolinguistics, and law warrants further scrutiny.

Notes

¹In this article, we observe the legal convention of placing trademarks in all capital letters, in order to distinguish terms thus specialized from other italicized lexical items.

²According to Room (1982, s.v. *Kodak*), George Eastman, who patented the cameras and registered KODAK, wrote a lengthy account of how he "invented" KODAK as an arbitrary and fanciful term; as indicated in the quotations from *Pirelli* and *Benthin*, however, *Kodak* is a surname so infrequent that essentially no one recognizes it as one – certainly Eastman did not. Thus it is a surname without the "look and sound" of one, registrable without regard for whether the Kodaks of Anytown hoped to open a photographic studio.

³In the case of *In re Petrin Corp.* (1986), PETRIN for construction services was found to have primary surname significance based upon an extremely small number of telephone listings and despite

the fact that the word *Petrin* was made up and named no one in the applicant's organization. Similarly, in *Pirelli* (1988), PIRELLI for rubber heels and soles for shoes was held to be primarily merely a surname despite its rarity. By contrast, in *In re Garan, Inc.* (1987), the TTAB found that GARAN for hosiery was not primarily merely a surname where the word was adopted as a coined word with no one bearing that name associated with the company, despite the fact that a very small number of telephone listings for persons with that name was indeed found by the trademark examiner.

⁴For the history and "family" relationships of these and all other surnames discussed here, consult Hanks and Hodges (1996).

⁵Variation in pronunciation of this name isn't unique to the case mentioned here (see Chancellor [1993]), nor is it unique to this name, of course.

⁶Our discussion focuses, appropriately, we believe, on the relation between use of a surname as a trademark and bearing a trademarked surname. In other words, the problems we describe in this article are synchronic. Admittedly, though, part of what can make a surname important to its bearer is the family tradition or history of bearing the name. Often, though, American immigrants have changed their surnames on arrival or subsequently, usually in the direction of Anglo-American sounds and forms. The traditional value of the surname as a family "possession" or "chattel" (for many American immigrants, the sort of chattel that "they" can't take away from you even when they take everything else) is diluted by the tendency to adapt "foreign" surnames in order to melt into American culture. Mencken (1936, 474-505) provides an engaging and historically important account of such changes. That many immigrants gave up old names for new ones doesn't change the fact that, at any time, commercial interests pursued in the law might affect one's use of one's name, old or new. That changes tended to assimilate the "foreign" to the Anglo-American supports our concern that Anglo-American surnames are more commercially viable than "foreign" ones and more likely, as a result, to end up registered via secondary meaning.

⁷The examples presented here, and many more, can be found in Room (1982). Many of the entries in Room's book concern British or other European trademarks and would not seem to apply here, as beyond the jurisdiction of American trademark law. Nevertheless, such examples illustrate ways of avoiding the ambiguities of American trademark law regarding surnames as we identify them here and, as such, are relevant, indeed.

⁸When Jordan W. Lambert, one of the founders of William R. Warner and Company (now Warner Lambert), “invented” and marketed a new antiseptic, he did so under the registered mark LISTERINE, formed on the name of Sir Joseph Lister, who invented antiseptics. Lister objected to the use of his name for a product with which he was unassociated, but we all know how the story ended (see *Room* [1986], s.v. *Listerine*). LISTERINE illustrates two cases at once. First, like the holder of *Boeing*, or any other controversial commercial name, Lister could not protect his (very good and important) surname from associations of which he did not approve, for whatever reasons. Of course, any one of us might feel guilty or uncomfortable by onomastic association: some McCarthys must have wished that they weren’t during the McCarthy era. But trademarks are regulated, whereas our surnames are not: one might have wished that Senator Joseph McCarthy would change his politics, but one could not reasonably expect him to change his name. Second, Lister’s case resembles that of the fictional Radigues: though he invented the first antiseptics, Lister could not have named a late creation LISTERINE, as that mark was already registered by someone who simply (and legally) appropriated the name and its positive associations. Of course, today, Lister’s lawyers would have urged him to apply for a trademark LISTERINE before anyone else could get hold of it, but would he have succeeded in registering it? LISTERINE more readily appears to have to look and sound of a surname when the applicant for it actually bears the surname *Lister*, a hurdle among the five factors that Tom Warner, Dick Lambert, and any number of other-surnamed Harrys wouldn’t have to jump.

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