**Examination Guide 3-17**

**Surname Combined with Wording**

**August 2017**

This examination guide clarifies the policies and procedures for examining marks containing wording in addition to a term that, standing by itself, is primarily merely a surname under §2(e)(4) of the Trademark Act. 15 U.S.C. §1052(e)(4). The guidance provided herein supersedes any previous United States Patent and Trademark Office (USPTO) guidance on this topic to the extent there are any conflicts and will be incorporated in the October 2017 revision of the Trademark Manual of Examining Procedure (TMEP).

Currently, TMEP §1211.01(b)(vi) states that when merely descriptive wording is combined with a surname, the mark is not considered to be primarily merely a surname under §2(e)(4) because merely descriptive wording is capable of functioning as a mark. The Board recently observed this guidance is inconsistent with the Federal Circuit’s directive in *In re Hutchinson Tech.*, 852 F.2d at 554, 7 USPQ2d at 1492. *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1492 n.9 (TTAB 2017) (finding that the mark AZEKA’S RIBS, for “barbecue sauce,” is primarily merely a surname and not registrable on the Principal Register absent a showing of acquired distinctiveness). The Board explained that the proper inquiry is the meaning of the mark as a whole and is not limited to the question of whether the additional matter is capable of functioning as a mark. *Id*.

More recently, the Federal Circuit in *Earnhardt v. Kerry Earnhardt, Inc.*, \_\_ F3d. \_\_\_\_, 123 USPQ2d 1411 (Fed. Cir. 2017) clarified that for marks that contain a surname and additional terms, the additional term(s) must be evaluated to determine whether they are generic *or* merely descriptive. In addition, the meaning of the mark as a whole must be assessed to determine whether adding the additional term to the surname alters the primary significance of the mark as a whole. *Id.* at 1415 (remanding to the Board to determine both whether the term “COLLECTION” in the mark EARNHARDT COLLECTION is merely descriptive and the primary significance of the mark as a whole to the purchasing public).

Accordingly, a mark that includes wording in addition to a term that, standing by itself, is primarily merely a surname, must be considered in its entirety. Merely descriptive terms that have not acquired distinctiveness do not have source-identifying significance and—like generic terms—will typically not detract from the primary surname significance in a mark containing a surname. Therefore, if none of the additional matter combined with the surname is inherently distinctive or has acquired distinctiveness (e.g., it is merely descriptive or incapable), refusal of the entire mark under §2(e)(4) will be appropriate in most circumstances. *Id.*