

THE NATIONAL LAW REVIEW

Hurdles to Federal Trademark Registration Part 3 - Government Insignia & Surname

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This is part 3 of a 3 part blog. Please [click here to read Part 1 - Generic Marks](#). Please [click here to read Part 2 - Merely Descriptive & Geographically Descriptive](#).

A mark can be refused registration if it bears a significant resemblance to a government insignia. In *In re Shabby Chic Brands LLC*, 122 USPQ2d 1139 (TTAB 2017), Shabby Chic Brands, LLC sought to register an image of “an ornate, feathered crown” for a variety of furniture and decorative housewares. The Trademark Examining Attorney refused registration based on Section 2(b) of the Lanham Act, which prohibits registration of marks that “consist of or comprise the flag or coat of arms or other insignia. . . of any foreign nation.” The Examining Attorney believed the proposed mark resembled the official emblem of the Prince of Wales, according to the illustration filed in accordance with the Paris Convention.



The Board affirmed the refusal to register. Finding that the Prince of Wales’ emblem was an insignia of a foreign nation because of its long association with the heir apparent to the British throne and the United Kingdom’s designation of the emblem as the official emblem of the Prince of Wales, the Board then considered whether the mark was a “simulation of” the emblem because the Board did not find the proposed mark consisted of or comprised the emblem.

While the Board noted several differences between the proposed mark and the emblem, comparing overall commercial impressions showed that the similarities outweighed the differences. The mark featured two of the most dominant elements of the Prince of Wales’ emblem: the crown and three feathers design, which surpassed a combination of “common elements” that might be found in heraldry. The Board also rejected the applicant’s argument that its mark had co-existed with the emblem for 13 years without confusion because Section 2(b) of the Lanham Act was an absolute bar to registration: the absence of confusion is irrelevant and lack of objection from the Prince of Wales plays no part.

Finally, another basis for refusal of trademark registration is if the proposed mark is primarily merely a surname. The applicant in *In re Kunz Management LLC*, Serial No. 86773122 (TTAB 2017), sought registration of “Brasserie Kunz” for “restaurant services, namely, providing of food and beverages for consumption on and off the premises.” The Trademark Examining Attorney refused registration of the mark under Section 2(e)(4) of the Lanham Act, finding the applied-for mark was primarily merely a surname.

Marks that are primarily merely a surname are denied registration except where a showing of acquired distinctiveness under Section 2(f) of the Lanham Act is made. The test for whether a mark is primarily merely a surname looks at whether the mark’s primary significance as a whole to the purchasing public, when viewed in relation to the goods or services for which registration is sought, is that of a surname. Factors in that analysis

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include (1) whether the applicant adopted a principal's name and used it in a way that revealed its surname significant; (2) whether the term had a non-surname "ordinary language" meaning; and (3) the extent to which the term was used by others as a surname.

The applicant tried to argue that when translated from German, Kunz had a non-surname meaning, but the translations submitted were not direct translations of Kunz or Brasserie Kunz; they included other words and lacked any indication of what the translation of the word Kunz by itself was. And since Brasserie was at least merely descriptive of applicant's applied-for restaurant services, nothing about the combination of Brasserie and Kunz changed the meaning of the component terms. In fact, the use of Brasserie underscored that Kunz was a surname and had not acquired distinctiveness. Thus, the TTAB affirmed the registration refusal.

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