

The Impact of Nameness, Race, Orthography, and Population on Trademark Registration of Surnames

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This Article explores a problem in trademark law involving the concept of nameness—the degree to which people recognize a word as a personal name—and specifically the strength of the surname function of a homonym over any other interpretations. If a term has high nameness then the United States Patent and Trademark Office (“U.S.P.T.O.”) will refuse to register it as a trademark under Section 2(e)(4) of the Lanham Act, which prohibits registration of any term deemed “primarily merely a surname.”

The Trademark Trial and Appeal Board (“T.T.A.B.”) has struggled with this concept of nameness, usually referred to as the “look and feel” of a surname, noting the subjective nature of this concept. This Article takes an empirical approach to understand the contours on nameness. In the underlying study, I sampled surnames from the 2000 U.S. Census to determine if anyone had applied to register them as trademarks. If the U.S.P.T.O. examining attorney thinks the term has the look and feel of a surname, then the U.S.P.T.O. refuses to register the trademark. Otherwise Section 2(e)(4) does not serve as a bar to register the trademark.

If the surname had an associated trademark filing, I then checked to see if the term had a non-surname meaning, namely a dictionary entry, a place name, a first name, an abbreviation or acronym, or a foreign-language meaning. The existence of one of these alternate meanings for the term could outweigh the surname function. I also noted if the trademark filing had a design element that could outweigh the surname function. Filtered to remove marks with design elements and surnames with a non-surname usage, the study revealed that 49.19% of the sampled names did not have the look and feel of a surname. Unfiltered, 76.98% of the sampled names did not have the look and feel of a surname.

The study revealed three factors that had significant impacts on surname recognition: (1) the race of the plurality of the people with the surname, (2) the

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