

What's in a name? TTAB refuses registration of OLIN mark
United States - **Knobbe Martens**

Examination/opposition
Enforcement

October 30 2017

- **Olin argued that OLIN mark was not primarily merely a surname because it has acquired distinctiveness**
- **TTAB held that whether a mark is primarily merely a surname or has acquired distinctiveness are two separate inquiries**
- **Board found against Olin on both grounds and refused registration of OLIN**

In the recent case of *In re Olin Corporation* the Trademark Trial and Appeal Board (TTAB) affirmed the examining attorney's Section 2(e)(4) refusal to register the OLIN mark for a number of chemicals in Class 17 on the grounds that the mark was primarily merely a surname and lacked acquired distinctiveness under Section 2(f) of the US Trademark Act.

Facts

Section 2(e)(4) of the Trademark Act allows an examining attorney to deny the registration of a mark on the principal register if the mark is primarily merely a surname. However, an applicant can overcome a surname refusal by claiming and demonstrating that the surname has acquired distinctiveness under Section 2(f) of the Trademark Act.

In the appeal, Olin appeared to argue that the OLIN mark was not primarily merely a surname because it has acquired distinctiveness. However, the board held that whether a mark is primarily merely a surname or has acquired distinctiveness to overcome a surname refusal are two separate inquiries. In previous cases the board has similarly rejected arguments that acquired distinctiveness voids the initial surname significance of the mark. The board stressed the requirement that an applicant make a specific claim of secondary meaning under Section 2(f) when responding to a Section 2(e)(4) surname refusal.

In this case, although Olin never specifically requested registration under Section 2(f) the examining attorney framed his arguments in response to the surname refusal as if Olin had tried to argue over the surname refusal and alternatively made a claim of acquired distinctiveness.

Decision

The board considered whether the mark was primarily merely a surname under Section 2(e)(4). Generally, a term is considered primarily a surname if, when viewed in relation to its goods or services, the primary significance to purchasers is that of a surname. In order to evaluate whether the primary significance of the mark was merely that of a surname, the board looked at the following four factors, none of which were considered conclusive or exclusive evidence of the purchasing public's perception of surname significance:

- Was the mark rarely encountered as a surname?
- Was the mark the surname of anyone connected with Olin?
- Does Olin have any recognised meaning other than as a surname?
- Does the mark have the structure and pronunciation of a surname?

First, the board considered evidence including a public records search and the 2010 US Census, which showed that the name Olin was frequently encountered and thus more likely to be perceived by the public as a surname. The board determined that because Olin had acknowledged the company's founder – Franklin Olin – on its website, this further supported the idea that the public viewed Olin as primarily a surname. The board heard that there were no dictionary entries for the term 'olin' and this supported a finding that Olin had no other recognised meaning other than a surname. Finally, the board found that Olin had the structure and pronunciation of a surname but held that this had little significance in light of all other evidence in the case. The board therefore concluded that Olin was primarily merely a surname under Section 2(e)(4).

The board then considered whether the OLIN mark had acquired distinctiveness under Section 2(f) and would therefore be registrable as a trademark, despite the finding that it was primarily merely a surname. In this case Olin filed an intent-to-use application, but the board noted that in order to establish a *prima facie* case of acquired distinctiveness in an intent-to-use application Olin would need to show that the OLIN mark had acquired distinctiveness for sufficiently similar or related goods to those in the present application. In

that case, the acquired distinctiveness could transfer to Olin's applied-for goods when used in connection with the mark. The board described the following three tests for establishing whether a mark has acquired distinctiveness for sufficiently similar or related goods:

- ownership of prior registrations;
- five years' substantially exclusive and continuous use in commerce; and
- other evidence.

First, the board looked at Olin's existing registrations and determined that the goods involved with active registrations for the same OLIN mark were not sufficiently similar to those listed in the present application. The board then looked to see whether Olin had sufficiently demonstrated that it had used the OLIN mark in a manner to show acquired distinctiveness in connection with similar or related goods and services. Olin provided declarations noting that the OLIN mark had been used with its historic products (ie, chlorine, hydrochloric acid, potassium hydroxide, sodium hydroxide, sodium hydrogen and sodium chloride) for five years. Even if accurate, the board noted that Olin had failed to satisfy the requirement that use of the OLIN mark on these products was substantially exclusive, which is a requirement under Section 2(f) in addition to continuous use for five years. Finally, the board examined Olin's other evidence of acquired distinctiveness and determined it was insufficient.

In light of Olin's failure to show acquired distinctiveness under Section 2(f), the board therefore affirmed the examining attorney's decision that the OLIN mark was primarily merely a surname.

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