

# Caution flag on stock-car legend's name, race goes on

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Talk about incongruous. Can you imagine the esteemed judges of the Trademark Trial and Appeal Board taking time to watch stock-car racing? I can't. They're probably preoccupied enough with the cases before them.

So it's little wonder they didn't accord the name Dale Earnhardt as having quite too much fame—especially in relation to the sale of goods unrelated to racing cars.

That's one safe conclusion we can draw from the TTAB's recent non-precedential decision in *Teresa H. Earnhardt v. Kerry Earnhardt, Inc.*, Opposition Nos. 91205331 and 91205338 (February 26, 2016). Another is the complexity of determining likelihood of confusion when it comes to family names that aren't exactly, well, familiar.

Teresa (néé Houston) Earnhardt, third wife and widow of stock-car racing driver Dale Earnhardt, had opposed two recent applications filed by her stepson Kerry Earnhardt's company. The latter had sought to register the mark *Earnhardt Collection* for furniture and custom construction of homes.

Ms. Earnhardt's opposition rested on two grounds: first, likelihood of confusion with the already registered marks *Earnhardt* and *Dale Earnhardt* for various goods and services, and, second, violation of the bar on the registration of surnames.

Dale Earnhardt was a stock-car racing icon from the 1970s until his death on the final lap of the Daytona 500 in 2001. Earnhardt was known as a particularly aggressive driver, and it's hard to conceive of him being interested in using his name on beanbag chairs, plates, figurines, ornaments, ornament plates, clocks, and tabletop figurines.

But that's exactly what Ms. Earnhardt was able to establish priority of use for. Under the common law mark *Dale Earnhardt*, the goods and services in the pleaded registration were "primarily memorabilia/novelty items, clothing, and professional automobile racing services." Interestingly, though, she did

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not offer any testimony or evidence that the goods and services in the registrations were related to those of her stepson. The Board therefore concluded that her stepson's goods and services were not related to her own.

Next, Ms. Earnhardt claimed that the mark *Dale Earnhardt* was famous. But, again because of lack of evidence, the Board held that it had no compelling evidence to support a conclusion that the mark was famous for use in connection with any particular goods.

As to the likelihood of the parties' continuing to use certain channels of trade, the Board concluded that the involved goods and services were not sold in the same marketing milieu. In fact, the Board held that Ms. Earnhardt's customers were likely to be impulse buyers of Dale Earnhardt apparel and memorabilia, whereas her stepson's customers would more likely purchase furniture and custom homes while exercising some degree of care. (That begs the question of whether a stock-car driver's name adds a certain *je ne sais quoi* for buyers of chairs and tables. Maybe the pieces have racy lines?)

The Board did find *Earnhardt* to be the dominant portion of Kerry Earnhardt's mark, however, and therefore it did conclude that the involved marks were similar in appearance, sound, connotation, and commercial impression.

Attorneys for Ms. Earnhardt also argued that the family relationship between the parties is an additional factor that supported a finding of likelihood of confusion. They rested their argument in part on the TTAB's 2014 decision in *Harry Winston Inc. et al., v. Bruce Winston Gem Corp.*

This long-running trademark dispute between New York jeweler Harry Winston Inc., and the company established by the founder's son had been spurred by the latter's having used his father's famous name to market gems and fine jewelry. An administrative panel had ruled that Bruce Winston Gem Corp.'s using the name Bruce Winston to promote rival goods would confuse customers; so Bruce Winston Gem Corp. then sought to register the mark Bruce Winston for bracelets, gemstones, earrings and other fine jewelry.

That registration the TTAB denied. The Board also rejected the company's counterclaims seeking to cancel Harry Winston's trademarks. The Board said that the family relationship between father and son was significant in the outcome of the case, and noted that Bruce Winston had acknowledged that his father's name is part of his own public identity. (According to the ruling, when asked what being Bruce Winston meant to him in relation to his business, Winston had answered, "Son of a famous jeweler.") The TTAB held that because Harry Winston was a well-known figure and his company's mark Harry Winston is famous in the field of jewelry, the relationship

between Harry Winston and Bruce Winston creates a higher degree of public excitement than would a relationship that did not involve a famous name.

In that case, both parties were in the jewelry business. In the case at issue here, Ms. Earnhardt's stepson's goods and services are not related to car racing, and Kerry Earnhardt had taken steps to associate the mark *Earnhardt Collection* with himself, his family, and his company, rather than with his father or Ms. Earnhardt. Thus, the Board felt that the relationship between the parties did not affect the likelihood of confusion determination.

Balancing the relevant *du Pont* factors, the Board found that Kerry Earnhardt's mark was not likely to cause confusion with Ms. Earnhardt's.

As for the surname objection, the Board explained that the Earnhardt surname ranked as number 16,852 in the U.S. Census database, with 1559 appearances. It held that while not a common surname, Earnhardt is not so rare that it would not be regarded as a surname for surname refusal purposes. This was more obvious because Earnhardt is the surname of persons connected with both parties. In addition, held the Board, Earnhardt has no other recognized meaning and has the "look and feel" of a surname.

Ms. Earnhardt also contended that *Collection* on its own was merely a generic term, and that the two-word mark should still be considered a surname. That didn't get the checkered flag, either: the Board felt that it had to evaluate the mark *Earnhardt Collection* as a whole phrase, for while *Collection* may be descriptive of the manner in which some furniture is marketed, it is not generic. Likewise with home design, the word does not refer to any class or category.

For this holding, the Board relied on the Federal Circuit's ruling in *In re Hutchinson Technology, Inc.*, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988), in which the majority found that Hutchinson Technology was not primarily merely a surname because the term technology was not generic. So the Board dismissed the surname refusal claim as well.

This decision is interesting for two reasons. First, the reference to family relations being a part of the Board's analysis is noteworthy and unusual. Second, the fact that the Board felt that *Collection* made enough of a distinctive difference to help *Earnhardt* avoid a surname refusal should wave a yellow caution flag before all trademark attorneys: When applying to register a surname, add an additional term to it even if that term seems descriptive. It may still be enough to overcome a surname refusal. And that could get your registration across the finish line.

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