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## Brewery Trademark Opposers Left Drowning in their Sorrows

### Federal Circuit Affirms Holding Allowing Trademark on Surname

On November 26, 2018, the Federal Circuit affirmed a decision of the Trademark Trial and Appeal Board (TTAB) approving the applied-for trademark “Schlafly” of a craft beer brewery that is the surname of the brewery’s founder, Thomas Schlafly.

Separate oppositions to the applied-for mark had been brought by two of Schlafly’s relatives: the estate of his aunt Phyllis Schlafly, a well-known conservative activist, and Bruce Schlafly, a physician. Each of the oppositions claimed (1) that the applied-for mark was primarily a surname, and thus ineligible for registration as a trademark and (2) that the evidence submitted by the applicant was inadequate to establish secondary meaning to support registration of the trademark under 15 U.S.C § 1052(f).

The Federal Circuit dismissed both of these grounds for opposition. First, the Federal Circuit affirmed the TTAB’s understanding of the bar against surnames serving as trademarks, accepting that a surname *can* be registered as a trademark if it has acquired distinctiveness in the relevant market under 15 U.S.C. § 1052(f). As such, the registration of the “Schlafly” mark for several types of beer in this case would turn on whether the applicant had submitted enough evidence to establish secondary meaning of the mark in the beer market.

On appeal, the opposers separately argued that the applicant had failed to submit consumer survey evidence demonstrating secondary meaning and, thus, the TTAB was precluded from finding that the applied-for mark had acquired distinctiveness. The Federal Circuit rejected this argument, holding that secondary meaning can be demonstrated in a number of ways, such as through ownership of prior registrations of the same mark in similar goods or services, five years of substantially exclusive and continuous use in commerce, or other appropriate evidence. In this case, the Federal Circuit found that the TTAB had considered and evaluated fifteen different forms of evidence in reaching the conclusion that the applied-for “Schlafly” mark had acquired distinctiveness. As such, the Federal Circuit found that the failure to conduct or submit consumer survey evidence does not prevent the applicant from obtaining the applied-for mark.

Finally, the opposers argued that the word “Schlafly” is significant to the public primarily as the surname of Phyllis Schlafly. They urged the court to adopt a new test called a “change in significance” test whereby a surname could not be registered as a trademark without showing a change in the significance of the name to the public from primarily a surname to a source identifying mark for specific goods. The Federal Circuit declined to adopt such a test, pointing out that the applied-for mark was found to have acquired distinctiveness under 15 U.S.C. § 1052(f), and thus it was unnecessary to conduct any further testing.