

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Troon LTD.**

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Serial No. 74/696,177

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**Eric S. Hyman** of Blakely, Sokoloff, Taylor & Zafman for  
TROON LTD.

John C. Tingley, Trademark Examining Attorney, Law Office  
102 (Myra Kurzbard, Managing Attorney).

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Before Cissel, Seeherman and Wendel, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 3, 1995, applicant filed the above-referenced  
application to register the mark "KILBY" on the Principal  
Register. The application was based on applicant's  
assertion that it possessed a bona fide intention to use  
the mark in commerce on "film, video games, pre-recorded  
video tapes, computer software, clothing, mugs, lunch  
boxes, posters, book covers and toys." The identification-

of-goods clause was subsequently amended to read as follows: "motion picture film containing dramatic presentation, pre-recorded video tapes containing dramatic presentation and computer software for use in multimedia entertainment."

This application is now before the Board on appeal from the final refusal to register under Section 2(e)(4) of the Act on the ground that the mark sought to be registered is primarily merely a surname.

In support of the refusal to register, the Examining Attorney made of record a list of people whose surname is "Kilby." The list was the product of a search the Examining Attorney conducted of the PHONEDISC USA database. It shows that there are 1,453 entries for people who have the surname "Kilby."

Applicant contends that the primary significance of "KILBY" to the purchasing public is not that of a surname. In support of its contention, applicant submitted telephone directories from three southern California areas. None shows even a single individual whose surname is "Kilby." Applicant argues further that the number of hits from the PHONEDISC database shows that "Kilby" is a quite rare surname in view of the fact that the total database contains over eighty-three million names.

Along with the final refusal to register, the Examining Attorney made of record excerpts from the Nexis® database of periodical publications. The results of the search of that database show that "KILBY" was located over thirty-seven hundred times. Most of the examples provided by the Examining Attorney show "Kilby" used as a surname. The search results also include references to "Kilby Street," "Kilby Avenue," and the "Kilby patent."

Applicant attached to its brief copies of more information from the same Nexis® search the Examining Attorney had conducted. Those excerpts include references to the "Kilby correctional facility" and examples of "Kilby" as a given name or a middle name. Ordinarily, the record closes with the filing of the notice of appeal, and such late-filed evidence would not be considered unless the application had been remanded to the Examining Attorney under Trademark Rule 2.142(d) for consideration of it. In this case, because the Examining Attorney did not object to the additional evidence, and in fact made arguments as if it had been considered, the Board has considered it as if it had been properly made of record.

The Examining Attorney also filed a brief, but no oral hearing was requested. Accordingly, we have decided this

appeal on the written record and arguments of applicant and the Examining Attorney.

The sole issue before us in this appeal is whether the mark applicant intends to use, "KILBY," is primarily merely a surname within the meaning of Section 2(e)(4) of the Lanham Act. The test for resolving this issue is well settled. A term is unregistrable under this section of the Act if its primary significance to the relevant purchasing public is that of a surname. In re BDH Two, Inc., 26 USPQ2d 1556 (TTAB 1993); In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The Examining Attorney has the burden of establishing this. In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 832, 184 USPQ 421 (CCPA 1975); In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985).

The Examining Attorney met his burden in the instant case. The evidence submitted from the PHONEDISC search, as well as the excerpts from the Nexis® database, establish that the primary significance of "KILBY" is that of a surname to the ordinary consumers who are the potential purchasers of the goods set forth in the application. Although it cannot be characterized as a common surname, such as "Smith" or "Jones," the evidence shows that this surname appears in directories and newspapers throughout

the country. Additionally, the mark "KILBY," unlike the mark "GARAN," has the appearance and sound of a surname, rather than an arbitrary term. See: In re Garan, 3 USPQ2d 1537 (TTAB 1987); and In re Industrie Pirelli, 9 USPQ2d 1564, (TTAB 1988). In sum, the evidence of record shows that "Kilby" is a surname, and that it would be perceived as one by consumers.

Although applicant contends that the consuming public would not understand the primary significance of "KILBY" to be as a surname, applicant has offered no persuasive alternative connotations or significance for the term. The evidence that "Kilby" is used on rare occasions as a given or middle name is not inconsistent with its primary significance as a surname. Surnames are sometimes used in this manner, just as surnames are used as key parts of the names of streets, housing developments, correctional facilities and so forth, indicating the surnames of the people for whom they are named. In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975).

In order to prevail in the face of the prima facie case of surname significance made by the Examining Attorney, applicant's burden was to establish that the significance of "KILBY" would not be primarily merely that of a surname, but applicant did not meet this burden. In

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the absence of persuasive evidence that the surname sought to be registered would have some other significance to the prospective purchasers of applicant's films, tapes and software or that it would be likely to be viewed as an arbitrary term, we have no basis upon which to disagree with the Examining Attorney. Accordingly, the refusal to register is affirmed, and registration to applicant is refused.

R. F. Cissel

E. J. Seeherman

H. R. Wendel  
Administrative Trademark Judges  
Trademark Trial & Appeal Board

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