

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 4, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **HMV Group Limited**

Serial No. 75/023,672

Lawrence E. Apolzon of **Fross Zelnick Lehrman & Zissu, P.C.**
for **HMV Group Limited**.

Dominick Salemi, Trademark Examining Attorney, Law Office
107 (**Thomas Lamone**, Managing Attorney).

Before **Hanak**, **Hairston** and **Wendel**, Administrative Trademark
Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

An intent-to-use application has been filed by HMV
Group Limited to register the mark DILLONS for retail
music, video, computer, magazine, book and stationery store
services.¹

¹ Application Serial No. 75/023,672 filed on November 22, 1995
under Section 1(b) of the Trademark Act, based on applicant's
allegation of a bona fide intent to use the mark in commerce.

Registration has been refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(4), on the ground that the mark is primarily merely a surname.

In support of the refusal to register, the Examining Attorney made of record a printout retrieved from the PHONEDISC U.S.A. database (1995 ed.).² This evidence shows listings for around 100 individuals having the surname "Dillon." It is the position of the Examining Attorney that this evidence makes out a prima facie showing that DILLON is primarily merely a surname. Citing *In re Directional Marketing Corporation*, 204 USPQ 674 (TTAB 1979)[DRUMMONDS is primarily merely surname], the Examining Attorney maintains that "adding an "S" to a surname does not remove it from the surname category." (December 18, 1996 Office Action).

Applicant, on the other hand, argues that the addition of the letter "S" changes the character of DILLON. Applicant strongly disagrees with the Board's decision in *Directional Marketing* arguing that there was no evidence in that case to support the Board's conclusions that consumers interpret a mark which ends in "S" as a possessive form of

² The preface to the PHONEDISC U.S.A. database states that the database consists of listings "gathered from address lists and telephone directories including a total of 83,000,000 listings."

a surname and that stores frequently use a possessive letter "S" on the end of their names without an apostrophe. In this regard, applicant submitted the declaration of its Director, who states that the letter "S" at the end of DILLONS is not intended to indicate that the mark is the possessive form, and that it is not common for businesses in applicant's field to use the letter "S" as a possessive form of a mark unless it is preceded by an apostrophe in the form of "'S." With its appeal brief, applicant submitted copies of Yellow Pages listings for "Computer Dealers," "Book Dealers," "Stationers," and "Video Tapes & Discs Dealers" for the purpose of showing that none of the companies listed therein use the possessive form of a mark unless it is preceded by an apostrophe in the form of "'S."³

Whether a mark is primarily merely a surname depends upon whether its primary significance to the purchasing public is that of a surname. In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The Office has the burden of establishing a prima facie case that a term is primarily merely a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652

³ While evidence submitted for the first time with an appeal brief is generally considered untimely (See Trademark Rule 2.142), the Examining Attorney, in his appeal brief, made no objection to the Yellow Pages listings. Thus, we have considered the listings to be properly of record.

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(Fed. Cir. 1985). Provided that the Examining Attorney establishes a prima facie case, the burden shifts to the applicant to rebut the showing made by the Examining Attorney. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239-40 (CCPA 1975).

At the outset, we note that closer scrutiny of the printout retrieved from the PHONEDISC U.S.A. database reveals that this printout covers only those listings with "Dillon" and the first initial "A" (i.e., "Dillon, A" through "Dillon, A W"). In other words, the printout excludes listings with "Dillon" and initials other than "A" as well as "Dillon" and all given names. Inasmuch as there were about 100 listings for "Dillon" and the first initial "A," we may extrapolate from this that, had a complete printout been furnished, the listings for the surname "Dillon" would have totaled over a thousand. Under the circumstances, we find that the PHONEDISC U.S.A. evidence made of record by the Examining Attorney is sufficient to establish a prima facie case that DILLON is primarily merely a surname. We note that applicant has not argued to the contrary. Further, we would add that DILLON clearly looks and sounds like a surname, as in the case of Marshal Matt Dillon of "Gunsmoke" fame.

We are simply not persuaded by applicant's contention that the addition of the letter "S" to DILLON changes the character thereof. While applicant disagrees with the reasoning and decision in *Directional Marketing*, it is nonetheless the law. See also *In re McDonald's Corporation*, 230 USPQ 304 (TTAB 1986) [MCDONALD'S is primarily merely a surname and unregistrable in absence of Section 2(f) claim] and *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) [BURDONS is primarily merely a surname]. As noted in *Directional Marketing* and *Luis Caballero*, businesses frequently use a possessive form of their names or marks without an apostrophe. Applicant's Yellow Page listings are not proof to the contrary. These listings are very limited in scope and were taken from directories in a single geographical area (the Washington metropolitan area). Also, although applicant may not have intended, by use of the letter "S" at the end of the mark, to indicate that the mark is in the possessive form, this is not controlling. In short, we believe that purchasers, when encountering the mark DILLONS for the identified services, will view it as the possessive form of the surname DILLON. We should note that applicant offered nothing to show that DILLONS would be viewed as having any

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other meaning. See *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

In view of the foregoing, we conclude that DILLONS is primarily merely a surname under Section 2(e)(4) of the Act.

Decision: The refusal to register is affirmed.

E. W. Hanak

P. T. Hairston

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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