ESTTA Tracking number: **ESTTA633979**
Filing date: **10/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85831682
Applicant	Adlon Brand GmbH & Co. KG c/o FUNDUS FONDS - Verwaltungen GmbH
Applied for Mark	ADLON
Correspondence Address	JENNIFER FRASER NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP PO BOX 2207 WILMINGTON, DE 19801 UNITED STATES trademarks@novakdruce.com, christina.hillson@novakdruce.com, TM@novakdruce.com, jennifer.fraser@novakdruce.com
Submission	Appeal Brief
Attachments	APPLICANTS_APPEAL_BRIEF-85831682-1.pdf(110839 bytes)
Filer's Name	Christina M. Hillson
Filer's e-mail	trademarks@novakdruce.com, jennifer.fraser@novakdruce.com, christina.hillson@novakdruce.com, TM@novakdruce.com, Anseleme.McLorren@novakdruce.com
Signature	/cmh/
Date	10/20/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re:	:	
Trademark Application Serial No.: 85/831,682	:	
	:	
Filed: January 24, 2013	:	
	:	
Mark: ADLON	:	Attorney Docket No. 22407-00118
	:	
	:	
Adlon Brand GmbH & Co. KG c/o FUNDUS	:	
FONDS – Verwaltungen GmbH,	:	
Applicant.	:	
	:	
	:	

APPLICANT'S APPEAL BRIEF

Jennifer Fraser
Christina M. Hillson
Novak Druce Connolly Bove + Quigg LLP
1875 Eye Street, N.W.
Washington, DC 20006
(202) 331-7111
trademarks@novakdruce.com
Attorneys for Applicant

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. STATEMENT OF THE ISSUE 2

III. PROSECUTION HISTORY OF APPLICATION 2

IV. ARGUMENT 4

A. The Evidence Shows ADLON Is, at Best, an Extremely Rare Surname 5

i. The Evidence of Record Does Not Demonstrate the Mark Is a Popular Surname 6

ii. Some of the Evidence Used by the Examining Attorney in Support Is Unreliable 10

iii. Census Information Supports the Conclusion That the Surname Is Extremely Rare 11

iv. The One Allegedly "Famous" Person Is Insignificant 12

B. No Person Connected With Applicant Has the Surname 13

C. The Mark ADLON Would be Perceived by the Consumer as a Trademark 14

i. There Is Significant Evidence That Consumers Will Perceive ADLON as a Trademark 14

D. The Mark Does Not Have the Look and Sound of a Surname 14

i. The Examining Attorney's Arguments Are Inconsistent 15

E. Any Doubt Regarding Whether a Mark Is Primarily Merely a Surname Should be Resolved in Applicant's Favor 16

V. CONCLUSION 17

TABLE OF AUTHORITIES

Page

Cases

In re Benthin Management GmbH
37 USPQ2d 1332, 1334 (TTAB 1995) 16

In re Cardano Risk Management B.V.
Serial No. 85230910, at 4-5 (TTAB June 7, 2012)..... 6

In re Establissements Darty et Fils
222 USPQ 260 (TTAB 1984), *aff'd* 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) 9

In re G R Lane Health Prods. Ltd. Serial No. 85115445 (TTAB July 10, 2013)..... 7, 16

In re G R Lane Health Prods. Ltd., at 6 16

In re Gene Simmons Comics Grp.
Serial No. 78905279, at 3 n.2 (TTAB Sept. 19, 2008) 11

In re Gregory
70 USPQ2d 1792 (TTAB 2004) 9, 12

In re Hall Wines, LLC
Serial No. 78926151, at 5 (TTAB Feb. 10, 2009..... 11

In re J.J. Yeley
85 USPQ2d 1150 (TTAB 2007) 4, 13

In re Joint-Stock Company "Baik"
84 USPQ2d 1921 (TTAB 2007) 5, 6

In re Lorch Schweißtechnik GmbH
Serial No. 85037839 at 3-4, 6 (TTAB Nov. 29, 2012) 6

In re Nick Bovis, Serial No. 77502609 at 4-5 (TTAB Sept. 28, 2010)..... 5, 8, 15

In re Pohan Iron & Steel Co., Ltd.
230 USPQ 79 (TTAB 1986) 16

In re Sava Research Corp.
32 USPQ2d 1380 (TTAB 1994) 4

In re The House of Terrance Proprietary Ltd.
Serial No. 79048704 at 8 (TTAB Jan. 6, 2010) 16

In re United Distillers plc 56 USPQ2d 1220, 1221 (TTAB 2000)..... 7

Mitchell Miller, P.C. v. Miller
105 USPQ2d 1615, 1620-21 (TTAB 2013)..... 5

Statutes

15 U.S.C. § 1052 (e)(4) 2,17

Other Authorities

Hearings on H.R. 4744 Before the Subcomm. Trade-marks of the House Comm. On Patents 76th Con., 1st Sess. (1939) at 40 15

Rules

TBMP § 1207 2

TBMP § 704.12(a) 11

TMEP § 1211.01(a) 14

I. INTRODUCTION

Applicant respectfully submits the ADLON mark is distinctive and is not primarily merely a surname because, at best, it is an extremely rare surname, no person connected with Applicant has the surname, the consumer would perceive the mark as indicating Applicant itself, Adlon Brand GmbH & Co. KG and/or the Hotel Adlon, and the source of its goods/services, and the term does not have the look and sound of a surname. This is an appeal from a denial of a Request for Reconsideration dated June 8, 2014 which refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act as primarily merely a surname. Applicant respectfully requests reversal of the Examining Attorney's refusal to register the mark on the Principal Register.

The Examining Attorney refused registration of Applicant's mark, ADLON, as primarily merely a surname. The goods and services in the application are as follows:

> Class 33: Alcoholic beverages, except beers, in particular wine, sparkling wine, champagne, vodka, rum, brandy, liqueurs;
>
> Class 41: Entertainment of guests, namely, night club services; casinos; entertainment services, namely, providing leisure interest facilities in the nature of swimming pools and fitness gyms; personal trainer services; entertainment services, namely, planning, arranging and conducting exhibitions, training sessions, seminars, congresses and conferences in the field of fashion shows and fashion events; publication of specialist periodicals, magazines, catalogues and books, in particular in the field of beverages, foodstuffs and catering; publication of specialist periodicals, magazines, catalogues and books, in particular in the field of beverages, foodstuffs and catering, or exclusive hotels; party planning services;
>
> Class 43: Bar services; hospitality industry services, namely, provision of temporary housing accommodation, food and beverages; operation of bars; operation of restaurants, cafeterias and self-service restaurants, catering; hotel reservations for third parties; consulting services in the field of hospitality; and
>
> Class 44: Hygienic and beauty care, namely, beauty salon, hair salon, medical spa services, namely, minimally and non-invasive cosmetic and body fitness therapies, health spa services for health and wellness

> of the body and spirit, namely, providing massage, facial and body treatment services, cosmetic body care services, weight loss programs; consulting services in the field of health; provision of sauna facilities; provision of solariums; massage services.

Applicant has appealed the refusal because the mark is clearly not primarily merely a surname and there is no evidence to support such a conclusion. Accordingly, the mark is registrable on the Principal Register.

The Board has stated that "[i]n determining an ex parte appeal, the Board reviews the appealed decision of the examining attorney to determine if it was correctly made." TBMP § 1207. Applicant requests the Board review the Examining Attorney's decision and the evidence of record and determine whether the refusal to register the ADLON mark as primarily merely a surname is proper. Applicant's mark is distinctive, and any doubt should be resolved in Applicant's favor so the mark should be published for opposition.

II. STATEMENT OF THE ISSUE

Whether the Examining Attorney erred in refusing Applicant's trademark, ADLON, as primarily merely a surname under Section 2(e)(4) of the Lanham Act, 15 U.S.C. § 1052 (e)(4).

III. PROSECUTION HISTORY OF APPLICATION

In a May 15, 2013 Office Action, registration of the ADLON mark was initially refused as primarily merely a surname. In support of the refusal, the Office Action enclosed a mere 75 "Switchboard" results for "Adlon Nationwide" and various mentions on "genealogy web sites," which generally try to sell consumers the "Family Crest" and family history for a particular name. The Office Action also attached information from imdb.com (internet movie database) showing approximately 17 "adlon" hits (one of which is hyphenated). On October 23, 2013, Applicant

responded to the Office Action and pointed out that the name is a very rare surname in the United States, does not have the look and feel of a surname, and would not be perceived as a surname by the consumer, as evidenced by other third party registrations for ADLON that were published and allowed on the Principal Register. Thus, Applicant requested withdrawal of the refusal.

A November 14, 2013 final Office Action continued the refusal and included references to various sources, which include numerous duplicative names and, for example, an imdb.com excerpt which shows only ten Adlon names from 1945- 2011, in apparent support that ADLON is primarily merely a surname. The November 14, 2013 Office Action further maintained that ADLON has the structure and pronunciation of a surname because it is comprised of two syllables and ends in "-on." The final Office Action also admitted that no one of "that stature" with the name ADLON is associated with Applicant's business. On May 14, 2014, Applicant submitted a Request for Reconsideration re-emphasizing the rareness of the surname and submitting significant evidence that shows the ADLON mark is perceived by the consumer as a trademark and is well known as "The Hotel Adlon" and is thus not primarily merely a surname and again pointing out the scarcity of any alleged evidence of the popularity of ADLON as a surname. Additionally, Applicant timely filed its Notice of Appeal.

On June 8, 2014, Applicant's Request for Reconsideration was denied. In this denial, the Examining Attorney supplied a new basis for rejection in her denial of Applicant's Request for Reconsideration (p. 2). In the November 14, 2013 Office Action, the Examining Attorney provided the following as one basis for rejection: "[i]n this case, the surname is comprised of two syllables and ends in 'on.' There are numerous surnames which are structured similarly." The Examining Attorney then went on to provide purported examples of different surnames which include, among others, Landon, Barton and Wilson. In her June 8, 2014 denial of Applicant's Request for

Reconsideration, the Examining Attorney altered the basis for rejection stating "it, like many surnames in the United States, is comprised of two syllables and ends in '-LON'" and included purported examples such as Dillon, Millon, Allon and Kellon. These words are different because of the double "-llon" which is different than the ending syllable "-lon" and/or "-on." Thus, it appears that the Examining Attorney altered the rationale in explaining the alleged perception to try to support the rejection, namely, changing it from a two-syllable structure ending in "-on" to a two-syllable structure ending in "-lon," using examples which are arguably inconsistent with both bases. This presented a new issue based on significantly different evidence and the Examining Attorney should have issued an "Examiner's Subsequent Final Refusal" as suggested by TMEP Section 715.03 providing for a six-month response period. Not only does this illustrate the differing perception of the structure of the mark, weighing in favor of reversing the refusal, but, in the event the Board is not persuaded to reverse the final refusal, remand is appropriate to provide the Applicant with an opportunity to respond to the new evidence and basis for rejection.

This Appeal was resumed on July 21, 2014 and Applicant obtained a 30-day extension of time to file its Brief, which is timely submitted herein.

For the reasons explained below, the references and arguments in the Office Actions are not persuasive that the term Adlon is perceived in the United States as primarily merely a surname and Applicant requests the Board reverse the refusal.

IV. <u>ARGUMENT</u>

As explained by the Trademark Trial and Appeal Board, various factual considerations are relevant in determining whether a term will be perceived as primarily merely a surname. *See e.g., In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994); *In re J.J. Yeley*, 85 USPQ2d 1150 (TTAB 2007). There are four relevant factors in this case that should be considered in determining

the mark is not primarily merely a surname. The relevant factors are: 1) whether the surname is rare; 2) whether another connected with the applicant has the surname; 3) whether the term has a recognized meaning other than that of a surname; and 4) whether the term has the look and sound of a surname. *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013); *In re Joint-Stock Company "Baik,"* 84 USPQ2d 1921 (TTAB 2007) (finding the surname "Baik" to be an "extremely rare surname" based on a listing of 456 individuals with that surname in the Verizon superpages.com database). As discussed below, these factors clearly confirm the mark is not likely to be perceived as primarily merely a surname and weigh in favor of registration of the ADLON mark on the Principal Register. Accordingly, Applicant respectfully requests the refusal be reversed.

A. The Evidence Shows ADLON Is, at Best, an Extremely Rare Surname

The case law indicates that under 100 listings is typically a rare surname under the first factor of a surname analysis. The first factor demonstrates whether the mark is popular enough such that the second through fourth factors should be addressed to determine whether the mark will be perceived as primarily merely a surname. *See In re Nick Bovis,* Serial No. 77502609 at 4-5 (TTAB Sept. 28, 2010) [non-precedential] (stating that the purpose behind refusing registration to a surname is not to "prevent the registration of surnames per se" because if a "surname is extremely rare, there are very few, if any, people who can possibly be affected by the registration of that surname as a mark. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant.").

As Judge Seeherman pointed out in her concurrence in *In re Joint-Stock Company "Baik,"* "in a case such as this involving a very rare surname, we cannot assume that the purchasing public

will view the mark as a surname based on exposure to the surname use." 84 USPQ2d 1921, 1923-24 (TTAB 2007). The Board has favorably cited Judge Seeherman's opinion in several cases. *See, e.g.*, *In re Cardano Risk Management B.V.*, Serial No. 85230910, at 4-5 (TTAB June 7, 2012). In *Cardano*, similar to the subject case, the Examining Attorney established only about 100 instances of the surname with a number of duplicates in addition to some publications referring to persons with the surname. The Board found, based on the facts of *Cardano*, that the name CARDANO was "extremely rare" and relied on Judge Seeherman's concurrence and accorded the extreme rarity of the surname great weight and reversed the examining attorney's refusal. In a similar case, the Board found that even where the examining attorney produced documents of 35-40 people with the name in question including internet sources such as Facebook and Flickr, the fact that only 470 listings could be found for that surname in a Lexis database was sufficient to establish that the surname was "extremely rare" and reversed the refusal. *In re Lorch Schweißtechnik GmbH*, Serial No. 85037839 at 3-4, 6 (TTAB Nov. 29, 2012). Similarly, the Examining Attorney for the subject application has produced relatively few instances of the surname ADLON and a hodge-podge of obscure and unreliable internet references and publications to persons with the surname ADLON, and thus the refusal should be reversed.

If ADLON is a surname, it is an extremely rare surname and the term ADLON has long been used as a trademark by Applicant and its predecessor companies, and is not perceived by the consumer as primarily merely a surname.

i. The Evidence of Record Does Not Demonstrate the Mark Is a Popular Surname

ADLON is an extremely rare surname. The May 15, 2013 Office Action claims the mark ADLON is primarily merely a surname based on only 75 "Switchboard" results for "Adlon Nationwide" and various mentions on "genealogy web sites," which generally try to sell consumers

the "Family Crest" and family history for a particular name (for example, www.houseofnames.com). On myheritage.com, for example, there are only 85 people with the surname Adlon claimed and, because these people are not listed, it is reasonable to assume many of these are duplicative of the Switchboard results as is typical on these websites. Moreover, it is not clear evidence of whether those people on a genealogy website are in the United States. Genealogy websites are also in the business of selling family information based on one criteria: a surname, so it is not surprising they will include as much information as they can gather worldwide. Even taking this into account, the data still illustrates the surname is rare.

The Office Action also attaches information from a web source (www.imdb.com) stating it displays "200 results for 'adlon;'" however, only the first 16 are for "Adlon" and the rest are for various other names, such as "Leonor Watling" and "Taylor Atelian" (and one name is hyphenated with Adlon-Meyerhöfer, and the umlaut suggests such name might not be for a person in the United States). It is also not clear if those persons are in the United States and the Office Action does not include any complete biographical data to confirm the location of those individuals such that it can be said to illustrate the perception of the mark in the United States. Accordingly, this purported evidence clearly does not support the contention ADLON is a common surname and further indicates how unreliable these websites are. The case law is clear that a mere 75 or 85 results indicates a surname is very rare. *See In re G R Lane Health Prods. Ltd.,* Serial No. 85115445 (TTAB July 10, 2013) [non-precedential] (stating the PTO's evidence of "87 entries is not substantial evidence that the term JAKEMAN is a common surname. In fact, it supports the conclusion that the surname JAKEMAN is a very rare surname in the United States.") (*citing In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000) ("Hackler" held to be a rare surname despite 1,295 listings in phone directories).

Additionally, the November 14, 2013 Office Action indicates only that very few people have the surname "Adlon" and not that the name "Adlon" is prolific enough to rise to the level required to demonstrate primarily merely a surname. The excerpts from the directories of names 411.com and switchboard.com retrieve over 100 individuals with the Adlon surname. However, a number of these names appear to be duplicates both within each directory and between both directories. For example, just a cursory review of the switchboard.com evidence indicates at least two entries for Deborah A. Adlon of Harrisburg, PA 55-59 years old (P. 24, 27). A cursory review of the 411.com evidence also returns Deborah A. Adlon, Harrisburg, PA, 55-59 years old (P. 54, 57). Another example of this duplicative "evidence" demonstrating the "prolific" nature of the ADLON surname is Jon Adlon of Washington, DC, 50-54 years old (P. 23, 29, 53, 59). See also "Virginia Adlon" (P. 14, 41) and "Bruce E. Adlon" (P. 15, 39, 42, 69) among many other duplicates. It should not be assumed that this evidence represents more than 100+ people have the surname Adlon. *See, e.g., In re Nick Bovis* at *2 (finding that the possible duplication of names in the excerpted whitepages.com search does not lead to an assumption that the reportedly retrieved results represent the number reported by the examining attorney). Further, in view of the fact that it is unclear whether the 411.com and switchboard.com pages are mutually exclusive (and likely are not), the listings of the two separates searches should not be added together to increase the number of Adlon surnames. *Id*. Thus, it appears likely the evidence shows fewer than 100 entries, and, in the past, fewer than 100 entries do not typically support such a refusal. Out of the entire U.S. population of approximately 320 million people, under 100 listings illustrates "ADLON" is extremely rare such that it would not be perceived as a surname.

As the November 14, 2013 Office Action points out, these were nationwide telephone directories used to develop the evidence. Yet, these nationwide telephone directories returned

numerous duplicative results further indicating that the name Adlon is rare. *Compare In re Establissements Darty et Fils,* 222 USPQ 260 (TTAB 1984), *aff'd* 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (finding that only 32 listings in nine telephone directories demonstrated a widely used surname based on the assumption that the name would appear in more telephone directories). Thus it is reasonable to conclude that the 411.com and switchboard.com excerpts submitted in the Office Action provide the overall picture of the Adlon name in the United States. Arguably the most "well known" Adlon, Pamela Adlon, shows up in both the submitted 411.com and switchboard.com searches provided in the Office Action, which further shows the duplicativeness of the search excerpts.

The remaining excerpts also help demonstrate just how rare the name is in the United States. For example, according to Wikipedia there are 5,826,213 personalities in the Internet Movie Database. http://en.wikipedia.org/wiki/Internet_Movie_Database#cite_note-2. Yet, the excerpts include only 10 people with "Adlon" as their surname and some of these people are credited back to the 1940's and 50's and it is not clear if these persons are in the United States. (An expanded search of IMDB returned 16 total names). The November 14 Office Action also highlights the allegedly most "famous" ADLON, Pamela Adlon, for the proposition that individuals in the entertainment industry use the surname ADLON. However, Pamela Adlon used her maiden name for close to the first 20 years of her career and has only adopted her married name in the past ten years. Furthermore, she is not a box office movie star, but instead plays supporting roles, is a voice actress, and is arguably not well-known. Her most recognizable role is as a voice character for a recently canceled cartoon.[1] These accolades do not rise to the level found in *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004) where the Board found that 1087 listings for ROGAN indicated the surname

[1] The undersigned is familiar with the show, but had never heard of nor noticed the voice actress' name.

was rare, but the name received media attention as the name of a Congressman and former PTO Director, among other "celebrities."

ii. Some of the Evidence Used by the Examining Attorney in Support Is Unreliable

Another factor to consider is that the websites used for references in the Office Action are not reliable evidence of consumer perception in the United States. IMDB, Facebook, Twitter and Linkedin are not exclusive to the United States and therefore any of the results from those searches incorporate people outside the United States and are skewed. For example, if a surname was more popular with people of another heritage in a different country, this would not illustrate the perception in the United States. In any case, the minimal evidence provided supports the contention that the name "Adlon" is rare and in fact, evidences that the surname is extremely rare worldwide. Moreover, the Examining Attorney had to go looking for surname evidence which also is not representative of the everyday perception of consumers. Stated differently, the Examining Attorney's use of genealogy databases, for example, will necessarily find surnames but such does not illustrate that is the perception of consumers. There is very little presence and volume of the surname in social media, entertainment culture, and in national phone directories which demonstrates that ADLON is a rare surname.

To try to support the refusal, the Examining Attorney produced a number of internet sources for persons allegedly having the surname ADLON. These included printouts from Facebook profiles and Twitter accounts. The reliability of these sources is also suspect because there is no means for verifying that the information regarding the "surname" (or account name) is correct. Regardless, the nature of this "evidence" is also concerning and wholly unreliable and inappropriate. Most of it merely refers to websites where individuals have posted general details of their daily life including comments about the weather, classes, vacations and even comments of a

sexually-charged nature. This handful of putative sources lacks persuasive value that the surname ADLON is not rare and lacks any significant relevance or verifiable reliability. Thus, these sources should not be considered and, if considered, should be accorded little to no weight.

iii. Census Information Supports the Conclusion That the Surname Is Extremely Rare

Census data confirms the rare nature of the mark ADLON and this evidence can be considered by the Board. The Board may take judicial notice of a fact that is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." TBMP § 704.12(a). The Board may take judicial notice of census data. *In re Gene Simmons Comics Grp.*, Serial No. 78905279, at 3 n.2 (TTAB Sept. 19, 2008) (judicially noticing the frequency of a surname based on U.S. census data). The United States Census Bureau has published data on the frequency and demographics of surnames from the 2000 census for surnames with at least 100 occurrences. Genealogy – Data – Frequently Occurring Surnames from Census 2000 – U.S. Census Bureau, *available at* http://www.census.gov/genealogy/www/data/2000surnames/names.zip. The alleged surname "ADLON" does not appear as an entry in the list which includes over 150,000 names. This Board has found that, based on the rarity of a surname as demonstrated by the evidence including census data, a surname may be found to be "extremely rare" even where it is listed as occurring more than 100 times. *In re Hall Wines, LLC*, Serial No. 78926151, at 5 (TTAB Feb. 10, 2009) (finding the surname to be "extremely rare" where it ranked 20,391st in the country according to U.S. census data). Here, ADLON is not even ranked and would be ranked beyond 150,000. Thus, ADLON is an "extremely rare" surname based on the census data and previously discussed evidence and the Examining Attorney's refusal should be reversed.

iv. The One Allegedly "Famous" Person Is Insignificant

The Board has previously held that although a surname may be rare, if it is broadly exposed to the general public, for example through news reports or known celebrities, the surname may not be rare in terms of public perception. *In re Gregory* at 8-10 (TTAB May 12, 2004). In *In re Gregory*, the Board referred to numerous well-known persons with the surname in question, including elected politicians, a former director of the USPTO, a baseball player and several individuals in the entertainment industry including a comedian and an actor. *Id.* at 8-9. Here, the Examining Attorney has failed to produce sufficient evidence to establish a prima facie case that ADLON is not a rare surname. Although the Examining Attorney refers to an actress by the name of Pamela Adlon among other lesser known persons, these references do not rise to the level of those in *In re Gregory*. The Examining Attorney, aside from referencing other results for persons with the surname Adlon on the IMDB website, focuses her attention on Pamela Adlon and her career in an apparent attempt to shoehorn this case into the *In re Gregory* mold. However, a closer inspection of Ms. Adlon's history, as evidenced by the record, undermines the significance of this evidence and any claim that her use of the surname would have a significant impact on public perception.

According to the IMDB website, Ms. Adlon went by her maiden name of Seagall until at least 2003 and used variations of that name, *i.e.* Seagall-Adlon until at least 2005. In addition, although Ms. Adlon has a number of television credits, she has predominantly supplied voices for characters in animated television series and not as a box office movie star similar to those referenced in the *In re Gregory* record. Thus, Ms. Adlon is not well-known for purposes of a surname analysis and the public is not likely to perceive ADLON as anything but an "extremely rare" surname (and in fact the evidence confirms it will not likely be perceived as a surname at all).

The dearth of evidence of the surname found in the nationwide phone directories and the limited evidence of the surname in social media and entertainment demonstrates that the surname is rare. This conclusion is strengthened by previously registered ADLON marks that show the consumer would not perceive ADLON as a surname (TESS copies enclosed in Applicant's October 23, 2013 Response).

B. No Person Connected With Applicant Has the Surname

The November 14 Office Action correctly states that no one with the surname "Adlon" is connected with the Applicant. The original Hotel Adlon in Germany was built in 1907 by Lorenz Adlon, but nobody associated with the Adlon name has managed the hotel since 1967. Further, the hotel was almost completely destroyed during World War II and finally demolished in the 1980's. The hotel was rebuilt and reopened in 1997 after the land was purchased by a group wholly separate from the Adlon family. Therefore, Applicant submits that there is no direct connection between the existing Hotel Adlon and the family that built the hotel in 1907.

Further, the term ADLON has no significance or meaning in the trade, other than to indicate the source of Applicant's services. In fact, Applicant's name is Adlon Brand GmbH & Co. KG, and, therefore, the designation ADLON has significance as identifying Applicant itself rather than as merely a surname. *See In re J.J. Yeley*, 85 USPQ2d 1150 (TTAB 2007) (finding that because the mark J.J. YELEY had primary significance as identifying J.J. Yeley the applicant and the race car driver, this primary significance outweighed the surname significance). The term ADLON would appear to the average consumer as a coined term as used with the services identified in this application. Applicant owns the trademark rights in the Hotel ADLON in Berlin. Moreover, Applicant belongs to a group of companies which was associated with its rebuilding. This factor weighs in favor of registration of the mark.

C. The Mark ADLON Would be Perceived by the Consumer as a Trademark

Often a word will have a meaning or significance in addition to its significance as a surname. The issue is to determine the primary meaning of the term to the consumer. *See* TMEP § 1211.01(a). In this case, the consumer would perceive the mark ADLON as indicating Applicant itself, Adlon Brand GmbH & Co. KG and/or the Hotel Adlon, and the source of its goods/services

i. There Is Significant Evidence That Consumers Will Perceive ADLON as a Trademark

If there is any association of the term ADLON in the United States, consumers perceive the mark ADLON as associated with "The Hotel Adlon" as shown in the web pages enclosed in the May 14, 2014 Request for Reconsideration, and not as primarily merely a surname. The Hotel Adlon receives numerous awards and recognitions each year as shown in the summary of recent Awards and Ratings. Further, The Hotel Adlon is associated with a number of events involving the U.S. Embassy in Germany and was mentioned in remarks delivered during the groundbreaking ceremony for the new U.S. Embassy in Berlin. The Hotel Adlon has also been featured in movies and TV shows. This significant evidence demonstrates that the mark is perceived by the consumer in the context of "The Hotel Adlon" rather than as a surname. For U.S. consumers to discern any surname significance, this might require the name be seen as, for example, "Adlon's Hotel," which is not the case.

D. The Mark Does Not Have the Look and Sound of a Surname

The ADLON mark would not be perceived as primarily merely a surname. The dictionary does not define the term "Adlon," but this factor is at best neutral considering the lack of evidence demonstrating that "Adlon" is a widely used surname. Similarly, the contention that the term "Adlon's" structure and pronunciation is that of a surname is not persuasive and is contrary to the evidence, as also illustrated by the differing explanation of the syllabic breakdowns in the Office

Actions. Almost every single word is a surname, as stated in *In re Nick Bovis* at 4 (quoting Hearings on H.R. 4744 Before the Subcomm. Trade-marks of the House Comm. On Patents, 76th Con., 1st Sess. (1939) at 40. As noted in *Bovis*, this factor has become almost nonsensical and application of the factor in the instant case is reflective of the Board's statement in *Bovis*. *Bovis* at 3 ("Using the examining attorney's approach, we could say that BOVIS has the look and feel of a common noun because "book" and "bone" begin with the letters "Bo," or because "trellis" and "clematis" end in "is"). If it was the Board's intention to find that a surname is inherently primarily merely a surname if it does not have another meaning, as the Examining Attorney appears to suggest, the Board would not have espoused a 4-factor test. Further, the Congressional record demonstrates that it was not the intent of Congress to prevent the registration of surnames *per se.* *Bovis* at 4.

i. The Examining Attorney's Arguments Are Inconsistent

In the May 15 and November 14, 2013 Office Actions, Examining Attorney contended that ADLON had the look and sound of a surname because of the "-on" ending. After Applicant countered that, by way of illustration to show this is not an apt comparison and there are numerous terms that end in "-on" that are clearly not surnames, such as wonton, crouton, minion, demon; bacon; lemon; bison; apron, amazon, and Exxon, to name only a very few, the Examining Attorney eventually changed position in the June 8, 2014 Denial of Request for Reconsideration and contended that ADLON had the look and sound of a surname because of the "-lon" ending. This demonstrates the unreliability of the position, especially in view of the evidence presented which includes various references to surnames including "-llon," such as Dillon, Millon, Kellon, Allon, and Fallon. A word ending in "-llon" is clearly distinguishable from a word ending in "-lon/-on" and these examples of different names, including some that are associated with well-known

celebrities, do not support the position that the consumer would perceive ADLON as primarily merely a surname.

Additionally, this Board has repeatedly found that the mere fact that a mark has the same structure as other surnames is insufficient to support refusal. *See e.g., In re G R Lane Health Prods. Ltd.*, at 6 [non-precedential] ("[w]hole it can hardly be disputed that surnames end with the suffix . . . the same could be said for first names . . . we are unable to make any definitive determinations as to whether applicant's mark has the "look and sound" of a surname . . . ."); *see also In re The House of Terrance Proprietary Ltd.,* Serial No. 79048704 at 8 (TTAB Jan. 6, 2010) [non-precedential] ("[i]n view of the facts the[at] 'Renate' is an extremely rare surname and that it is also a given name, the examining attorney has not met her burden of demonstrating that 'Renate' has the look and feel of a surname"). As in *In re G R Lane Health Prods. Ltd.*, where the Board found the suffix "-MAN" could be found in given names such as Norman or Herman, the suffix "-LON," may be used in given names such as Dillon, Marlon or Waylon. Thus, not only has the Examining Attorney failed to meet her burden to establish the "look and sound" element but, as the Board noted in *In re The House of Terrance Proprietary Ltd.*, the mark, in this case "ADLON," has significance other than as a surname which likewise vitiates the Examining Attorney's basis for rejection that "ADLON" has significance primarily merely as a surname.

E. Any Doubt Regarding Whether a Mark Is Primarily Merely a Surname Should be Resolved in Applicant's Favor

In refusing registration under Section 2(e)(4), the burden is on the Office to establish that a mark is primarily merely a surname. *In re Pohan Iron & Steel Co., Ltd.,* 230 USPQ 79 (TTAB 1986). Where this burden has not been met, or where there remains doubt, such doubt is to be resolved in favor of the applicant. *See In re Benthin Management GmbH,* 37 USPQ2d 1332, 1334 (TTAB 1995). It is respectfully submitted that where a surname is so rare that the evidence shows

less than 100 people residing in the entire United States using that name, the limited use of the surname should not prohibit registration of the term on the Principal Register as a trademark for the goods and services at issue. This conclusion is strengthened in this case, where the evidence is questionable and when previously registered ADLON marks show the consumer would not perceive ADLON as a surname.

Accordingly, it is respectfully requested that the refusal of registration under Trademark Act Section 2(e)(4) be reversed.

V. CONCLUSION

Applicant respectfully requests the Board reverse the refusal under Section 2(e)(4), and allow Applicant's mark, ADLON, to register on the Principal Register. The ADLON mark is, at best, an extremely rare surname and the mark is perceived by the consumer as a trademark and a source indicator and is thus not primarily merely a surname. Additionally, the sparse evidence of record does not establish the mark is primarily merely a surname, and thus there is no reliable evidence showing that ADLON is perceived by the relevant public as a surname. Accordingly, Applicant's mark should be published for opposition.

Respectfully submitted,

Adlon Brand GmbH & Co. KG c/o FUNDUS FONDS – Verwaltungen GmbH

Dated: October 20, 2014

By: /s/ Jennifer Fraser

Jennifer Fraser
Christina M. Hillson
Novak Druce Connolly Bove + Quigg LLP
1875 Eye Street, N.W.
Washington, DC 20006
(202) 331-7111
trademarks@novakdruce.com

Attorneys for Applicant