

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85483695
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In an Office Action dated April 29, 2013, the Examining Attorney issued a final action refusing to register Applicant's mark pursuant to Section 2(e)(4) of the Lanham Act on the basis that it is allegedly merely a surname, and pursuant to Section 2(d) on the grounds that there is a likelihood of confusion with the mark contained in Registration No. 3,759,573. Applicant submits the following response in support of its registration.</p>	
<p>I. <u>NO LIKELIHOOD OF CONFUSION</u></p>	
<p>The Examining Attorney has made final her refusal to register Applicant's mark because she considers it to be confusingly similar to the mark, N. ROMANOV, as represented in U.S. Registration No. 3,759,573.</p>	
<p>Applicant hereby deletes the following goods from its identification of goods:</p>	
<p>--scarves; silk scarves (Int'l Class 25)--.</p>	
<p>Considering that the remaining goods in Applicant's application are distinct from the Class 25 goods in Registrant's identification of goods, there is no potential for a likelihood of confusion between</p>	

Applicant's mark and Registrant's mark. Therefore, Applicant respectfully requests the Examining Attorney to withdraw her refusal and to pass Applicant's mark on to publication.

II. NOT PRIMARILY MERELY A SURNAME

The Examining Attorney has made final her refusal to register Applicant's mark ROMANÓV on the basis that it is allegedly primarily merely a surname. In its Response to Office Action submitted to the U.S. Patent and Trademark Office on September 14, 2012, Applicant provided a thorough, persuasive explanation of how the surname refusal is improper under the circumstances because the term "ROMANÓV" refers to "historical persons" under T.M.E.P. § 1211.01(a)(iv). However, in her April 29, 2013 Office Action, the Examining Attorney failed to acknowledge Applicant's argument in favor of registration, and simply repeated her assertion that Applicant's mark is merely a surname with evidence from the Internet that "ROMANÓV" is a surname. Applicant does not dispute that "ROMANÓV" can be a surname; in fact, Applicant's argument presupposes that "ROMANÓV" is a surname, specifically one of the most famous surnames in Russian history and Western culture. Based on the following underscored and reiterated arguments, Applicant respectfully requests the Examining Attorney to withdraw her refusal to register.

A term with surname significance may not be held primarily merely a surname if that term also identifies a historical place or person. T.M.E.P. § 1211.01(a)(iv); see Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp., 314 F. Supp. 329, 165 U.S.P.Q. 459 (S.D.N.Y. 1970) (DA VINCI found not primarily merely a surname because it primarily connotes Leonardo Da Vinci).

Applicant's mark suggests several historical figures from the House of Romanov, which was the imperial dynasty that ruled Russia from 1613 to 1917. In fact, the Examining Attorney's Internet evidence provided in her April 29, 2013 Office Action repeatedly mentions the House of Romanov, including a reference to the "Russian ruling dynasty" in the dictionary entry for "Romanov" on page 114; the "ruling dynasty of Russia" in the Infoplease encyclopedia entry for "Romanov" on page 117; and "Indeed Romanovs ruled Russia for three hundred four years." in the Answers article on page 120. As previously explained, three extremely famous Romanovs from this dynasty were Peter the Great (1672 - 1725), Catherine the Great (1729 - 1796), and Nicholas II (1868 - 1918). Applicant intends to link the commercial impression of its products with these famous historical figures of the House of Romanov.

It is apparent, not only from the information provided by Applicant, but also from the Internet evidence provided by the Examining Attorney, that the primary significance of the term "ROMANOV" cannot be said to be merely that of a surname. Applicant's mark ROMANOV is a clear reference to the famous House of Romanov, which famously ruled Russia for over three hundred years. The mark ROMANOV therefore is not primarily merely a surname under Trademark Act § 2(e)(4).

III. CONCLUSION

Since Applicant has complied with the remainder of Examining Attorney's issues, Applicant respectfully requests the Examining Attorney to withdraw her refusal and to pass Applicant's mark on to publication.

GOODS AND/OR SERVICES SECTION (006)(no change)

GOODS AND/OR SERVICES SECTION (014)(no change)

GOODS AND/OR SERVICES SECTION (020)(no change)	
GOODS AND/OR SERVICES SECTION (021)(no change)	
GOODS AND/OR SERVICES SECTION (025)(class deleted)	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Timothy D. Pecsénye/
SIGNATORY'S NAME	Timothy D. Pecsénye
SIGNATORY'S POSITION	Attorney of record, Pennsylvania bar member
SIGNATORY'S PHONE NUMBER	215-569-5619
DATE SIGNED	10/29/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Oct 29 14:45:34 EDT 2013
TEAS STAMP	USPTO/RFR-38.98.220.16-20 131029144534885786-854836 95-50044577dc35639e6eca8e ab2966fd6bb3faf38d8b9f31a d899e290d6c57bd9bafc-N/A- N/A-20131029143350001094

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85483695** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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merely a surname, and pursuant to Section 2(d) on the grounds that there is a likelihood of confusion with the mark contained in Registration No. 3,759,573. Applicant submits the following response in support of its registration.

I. NO LIKELIHOOD OF CONFUSION

The Examining Attorney has made final her refusal to register Applicant's mark because she considers it to be confusingly similar to the mark, N. ROMANOV, as represented in U.S. Registration No. 3,759,573.

Applicant hereby deletes the following goods from its identification of goods:

--scarves; silk scarves (Int'l Class 25)--.

Considering that the remaining goods in Applicant's application are distinct from the Class 25 goods in Registrant's identification of goods, there is no potential for a likelihood of confusion between Applicant's mark and Registrant's mark. Therefore, Applicant respectfully requests the Examining Attorney to withdraw her refusal and to pass Applicant's mark on to publication.

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repeated her assertion that Applicant's mark is merely a surname with evidence from the Internet that "ROMANÓV" is a surname. Applicant does not dispute that "ROMANÓV" can be a surname; in fact, Applicant's argument presupposes that "ROMANÓV" is a surname, specifically one of the most famous surnames in Russian history and Western culture. Based on the following underscored and reiterated arguments, Applicant respectfully requests the Examining Attorney to withdraw her refusal to register.

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Examining Attorney, that the primary significance of the term "ROMANÓV" cannot be said to be merely that of a surname. Applicant's mark ROMANÓV is a clear reference to the famous House of Romanov, which famously ruled Russia for over three hundred years. The mark ROMANÓV therefore is not primarily merely a surname under Trademark Act § 2(e)(4).

III. CONCLUSION

Since Applicant has complied with the remainder of Examining Attorney's issues, Applicant respectfully requests the Examining Attorney to withdraw her refusal and to pass Applicant's mark on to publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 025 for scarves; silk scarves

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Timothy D. Pecsénye/ Date: 10/29/2013

Signatory's Name: Timothy D. Pecsénye

Signatory's Position: Attorney of record, Pennsylvania bar member

Signatory's Phone Number: 215-569-5619

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85483695

Internet Transmission Date: Tue Oct 29 14:45:34 EDT 2013

TEAS Stamp: USPTO/RFR-38.98.220.16-20131029144534885

786-85483695-50044577dc35639e6eca8eab296

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