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

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Applicant	The Hyman Companies, Inc.
Applied for Mark	ROMANÃ#V
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APPLICANT: The Hyman Companies, Inc.
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BRIEF OF APPLICANT IN SUPPORT OF REGISTRATION

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STATEMENT OF ISSUE FOR REVIEW

Did the Examining Attorney err in finding that Applicant's mark, ROMANÓV, is primarily merely a surname?

STATEMENT OF THE CASE

This action arises from the final refusal to register Applicant The Hyman Companies' ("Hyman") trademark, ROMANÓV. The Examining Attorney's refusal was made pursuant to Section 2(e)(4) of the Lanham Act, on the basis that ROMANÓV is primarily merely a surname.

Hyman objects to the Examining Attorney's final refusal and responds that ROMANÓV is not primarily merely a surname, but rather has substantial non-surname significance. Therefore, Hyman's mark is entitled to registration.

BACKGROUND

Hyman is a well-known retailer of costume jewelry, all of which is made to resemble real jewelry. Hyman sells its costume jewelry through its more than 95 LANDAU® boutiques in the United States.

On November 30, 2011 Hyman filed for registration of its mark, ROMANÓV, with the United States Patent and Trademark Office. On or about March 14, 2012, Hyman received an Office Action refusing registration of the mark as allegedly primarily merely a surname, with the Examining Attorney relying solely on listings from the <411.com> website for support, and based on a

likelihood of confusion with the marks in U.S. Registration Nos. 3,759,573 and 3,960,758. Although the Examining Attorney included the website screenshots to show that ROMANÓV has some limited surname significance, the Examining Attorney did not present any evidence that ROMANÓV is primarily merely a surname.

Hyman filed a timely Response to the Office Action on September 14, 2012 in which Hyman submitted arguments that ROMANÓV -- not being the name of any person connected with Hyman, and being a name of historical significance -- is not primarily merely a surname. Additionally, Hyman submitted evidence in support of its arguments, including evidence of historical figures with the name ROMANÓV. See Exhibit A attached to Hyman's September 14, 2012 Response to Office Action ("Response to Office Action"). Hyman also noted that it had filed a cancellation of Registration No. 3,960,758 (Cancellation No. 92056003), and presented arguments against the likelihood of confusion with Registration No. 3,759,573.

The Examining Attorney issued a Suspension Notice on October 2, 2012 suspending action pending the termination of Cancellation No. 92056003, and continuing the surname refusal and the likelihood of confusion refusal regarding Registration No. 3,759,573.

Upon resolution of Cancellation No. 92056003 in favor of Hyman, the Examining Attorney made her surname and likelihood of

confusion refusals final in an Office Action dated April 29, 2013. Accordingly, on October 29, 2013, Hyman filed a Request for Reconsideration and a contemporaneous notice of appeal. In its Request for Reconsideration, Hyman reiterated and amplified its earlier arguments regarding the non-surname significance of ROMANÓV, and deleted the International Class 25 goods from its application, thereby obviating any potential likelihood of confusion with Registration No. 3,759,573.

The Examining Attorney restated her position that the primary significance of ROMANÓV is as a surname and refused Hyman's plea for reconsideration, without even acknowledging that "[a] term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person." T.M.E.P. § 1211.01(a)(iv).

Having exhausted all possible recourse with the Examining Attorney, Hyman is pursuing the present appeal.

ROMANÓV IS NOT PRIMARILY MERELY A SURNAME

In the face of Hyman's evidence of the non-surname significance of ROMANÓV, the Examining Attorney has, nonetheless, steadfastly adhered to her position, based primarily on information from websites about the ROMANÓV name, showing that ROMANÓV is primarily merely a surname. Hyman submitted evidence to the Examining Attorney of the primary significance of ROMANÓV as a historical name, but the Examining

Attorney failed to explain why she elected to ignore this persuasive evidence.

In direct conflict with the applicable law the Examining Attorney failed to consider Applicant's evidence that the primary significance of ROMANÓV to the relevant purchasing public is not as a surname, despite the website screenshots she provided. In fact, in refusing Applicant's Request for Reconsideration, the Examining Attorney stated that "[t]he term is clearly a surname and **has no other meaning**. Consumers encountering the mark will clearly understand the term to refer to a surname." Because the Examining Attorney has failed to correctly apply the applicable standard, and because Hyman's mark, ROMANÓV, is not primarily merely a surname with respect to the purchasing public, the Board must reverse the Examining Attorney's surname refusal and remand the case to the Examining Attorney for approval for publication.

I. The Applicable Surname Standard

According to Section 2(e)(4) of the Lanham Act, Hyman is entitled to registration of its mark unless the mark is primarily merely a surname. The determination of whether a mark is primarily merely a surname must focus on:

the impact the term has or would have on the purchasing public because "it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it

is, and it is only that, then it is primarily merely a surname."

In re Isabella Fiore LLC, 75 U.S.P.Q.2d 1564, 1565 (T.T.A.B. 2005), quoting, In re Harris-Intertype Corp., 518 F.2d 629 (C.C.P.A. 1975), quoting, Ex parte Rivera Watch Corp., 106 U.S.P.Q. 145 (Comm'r 1955) (emphasis in original). So, unless the primary significance of a mark, in association with a particular product is only that of a surname, the mark cannot be held to be primarily merely a surname.

In In re Benthin Management GmbH, 37 U.S.P.Q.2d 1332 (T.T.A.B. 1995), the T.T.A.B. articulated four factors that are relevant to the determination of the impact a word has on the purchasing public: (1) the rareness of the surname, (2) whether or not anyone connected with the applicant actually has the surname, (3) non-surname significance or meanings of the word, and (4) whether the word has the look and feel of a surname. Id. at 1333. However, these factors are only "among the factors to be considered." In re United Distillers plc, 56 U.S.P.Q.2d 1220, 1221 (T.T.A.B. 2000). The ultimate question remains the same -- what significance does the word carry with the purchasing public?

The burden initially rests with the Examining Attorney to make a prima facie case that the mark is primarily merely a

surname. The burden then shifts to the applicant to rebut this showing. T.M.E.P. § 1211.02(a); In re Petrin

Corp., 231 U.S.P.Q. 902 (T.T.A.B. 1986). There is no rule as to the kind or amount of evidence that must be submitted to make a prima facie showing that a word is primarily merely a surname; rather the entire record is examined and a case-by-case determination is made. T.M.E.P. § 1211.02(a). Relevant evidence includes telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the word is a surname; the manner of use on specimens; dictionary definitions of the word; and evidence from dictionaries showing no definition of the word. Id. While the T.T.A.B. has consistently held to this standard, it has also made clear that listings in a telephone directory cannot, standing alone, meet the Examining Attorney's burden of showing that a mark is primarily merely a surname. In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831 (C.C.P.A. 1975).

II. Under the Appropriate Standard
ROMANÓV Is Not Primarily Merely a Surname

When the entire record is considered, it is clear that the Examining Attorney has failed to make a prima facie case that ROMANÓV is primarily merely a surname; that Applicant has shown affirmatively that ROMANÓV is not primarily merely a surname; and that in responding to Applicant's arguments, the Examining

Attorney has ignored the relevant precedent. Accordingly, the Board must reverse the Examining Attorney's refusal and remand the case to the Examining Attorney for approval for publication.

A. The Examining Attorney Has Failed
To Make a Prima Facie Showing That
ROMANÓV Is Primarily Merely a Surname

The burden of showing that ROMANÓV is primarily merely a surname initially rests with the Examining Attorney. In support of her assertion that ROMANÓV is primarily merely a surname, the Examining Attorney initially referred Applicant to a listing from <411.com>, which purportedly "establish[ed] the surname significance of the surname ROMANOV." While it may be true that these listings establish some surname significance of the mark, the listings provided by the Examining Attorney do nothing to demonstrate that the surname significance is the primary significance of the word ROMANÓV to the purchasing public. In fact, the screenshots provided by the Examining Attorney from <411.com> indicate only that "100+" individuals in the website's database have the surname "ROMANOV." The <whitepages.com> database, which powers <411.com>, includes "more than 180 million U.S. adults" according to its website. This statistic certainly does not prove that the primary significance of the word ROMANÓV is mere surname significance.

When presented with Applicant's substantial evidence of the other significances of the word ROMANÓV, the Examining Attorney

simply reiterated her position in her final refusal and supplemented her evidence with evidence from the Internet that people use ROMANÓV as a surname.

In her first Office Action, the Examining Attorney correctly notes that the standard for a surname refusal is the "primary significance of the mark to the purchasing public." However, as discussed more fully below, she then ignores her responsibility of putting on a prima facie case by merely proving that ROMANÓV is a surname, not that the surname significance is the "primary significance to the purchasing public." Mere reference to directory listings is not sufficient to carry the Examining Attorney's burden. In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d at 832-33. Similarly, the Examining Attorney cannot be saved by her reference to additional evidence that still merely shows that people use ROMANÓV as a surname. By failing to present any evidence that the surname significance is the primary significance, the Examining Attorney has failed to carry her burden and her refusal must be reversed.

B. Hyman Has Shown That ROMANÓV
Is Not Primarily Merely a Surname

Even if the scant evidence produced by the Examining Attorney is considered sufficient to make a prima facie case that ROMANÓV is primarily merely a surname, Applicant has rebutted that prima facie showing and shown that the actual

significance of ROMANÓV to the purchasing public of Applicant's costume jewelry is other than as a surname. Hyman has shown that under each of the four Benthin factors, as well as based on other evidence, the primary significance of the word ROMANÓV to the purchasing public is not as a surname.

The most critical evidence Hyman has produced is the evidence of the meanings of the word ROMANÓV other than as a surname. Hyman has shown that ROMANÓV identifies historical figures of major importance to the relevant purchasing public. Additionally Hyman has shown that no one connected with Applicant bears the surname ROMANÓV.

1. ROMANÓV Identifies Historical Figures

A mark, like ROMANÓV, that identifies historical figures may not be held primarily merely a surname. 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). Foremost among the historical figures that ROMANÓV calls to mind to the relevant purchasing public are 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. Three extremely famous Romanovs from this dynasty were Peter the Great (1672 - 1725), Catherine the Great (1729 - 1796), and Nicholas II (1868 - 1918). Applicant has linked the commercial impression of its products with these famous historical figures of the House of Romanov.

Not surprisingly, consideration of Applicant's evidence can lead to only one conclusion -- the pertinent purchasing public of costume jewelry associates the ROMANÓV mark with the famous figures in the House of Romanóv.

2. The Remaining Benthin Factors Support a Finding that ROMANÓV is Not Primarily Merely a Surname

In addition to the non-surname meanings attributable to ROMANÓV, discussed above, the remaining Benthin factors weigh in favor of finding that ROMANÓV is not primarily merely a surname.

Specifically, it is undisputed that no one associated with Applicant has the surname ROMANÓV. While this is not determinative of the issue, it does weigh in favor of a finding that ROMANÓV, as used with Applicant's goods, is not primarily merely a surname.

Further, the PTO has consistently registered marks for words that have some surname significance and similar surname popularity to ROMANÓV without a showing of acquired distinctiveness. Among these names are Hughes, Marshall, Fisher, Morris, Carter, and Murray, all of which have more of the look and feel of a surname than ROMANÓV.

Hyman consistently uses its mark, ROMANÓV, in a way that detracts from the surname significance of the mark. The ROMANÓV mark is used in a way and targeted to an audience such that it immediately creates an association with the House of Romanóv, the ruling family of Russia.

C. In Rebutting Applicant's Evidence the Examining Attorney has Misconstrued the Law and Misapplied the Law to the Facts

In her April 29, 2013 Office Action the Examining Attorney made final her surname refusal without even acknowledging Applicant's substantial evidence. In her two Office Actions and her refusal of Applicant's Request for Reconsideration, the Examining Attorney never offered any evidence or explanation as to why the primary significance of ROMANÓV is as a surname. Instead, she only repeated the uncontested point that ROMANÓV is a surname. In so doing, the Examining Attorney misconstrued the applicable law and misapplied the law to the facts of this case.

When confronted with Hyman's evidence of the other significance of ROMANÓV, the Examining Attorney never considered

that ROMANÓV is so significant as the name of the famous members of the House of Romanov that it cannot be held to be primarily merely a surname. Moreover, the Examining Attorney ignores the fact evidenced in the screenshots she provided from Wikipedia in her April 29, 2013 Office Action that the House of Romanov has been famous for its family jewelry and decorative eggs, which in 2008 had a value estimated at USD \$2.6 million. When the word ROMANÓV is considered in connection with jewelry and decorative objects, consumers immediately think of the House of Romanov, not a mere surname.

The Examining Attorney has failed to consider that "it is that impact or impression [on the purchasing public] which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, and it is only that, then it is primarily merely a surname." Ex parte Rivera Watch Corp., 106 U.S.P.Q. at 149 (emphasis in original).

Although the Benthin factors are instructive in determining the significance of a word, the standard is still the effect that the mark has on the purchasing public. As recognized by the T.T.A.B. in the case In re Isabella Fiore LLC, a word is not primarily merely a surname unless the only impact it has on the purchasing public is as a surname. Where, as is the case with ROMANÓV, the mark has other significant meanings, and one non-

surname meaning that is particularly significant to the public the product is marketed to, it cannot be said that the only impact that word has on the purchasing public is as a surname.

In applying this standard to the facts of this case, the Examining Attorney failed to appreciate the effect of Applicant's evidence. Hyman has shown that the significance of ROMANÓV to the relevant purchasing public is not primarily merely a surname.

* * * *

In the final analysis, it is clear that ROMANÓV is not primarily merely a surname. Hyman has shown that ROMANÓV is not the surname of anyone connected with applicant, and that ROMANÓV is a reference to the House of Romanov, which was the imperial dynasty that ruled Russia from 1613 to 1917, and was famous for its family jewelry and decorative objects worth millions of dollars. The significance of ROMANÓV to the purchasing public is Peter the Great, Catherine the Great, or Nicholas II, not primarily merely a surname.

CONCLUSION

For the foregoing reasons, Applicant, The Hyman Companies, Inc., respectfully requests that the T.T.A.B. reverse the Examining Attorney's surname refusal, and remand the case to the Examining Attorney for approval for publication.

Respectfully submitted,

THE HYMAN COMPANIES, INC.

Dated: January 22, 2014 By:

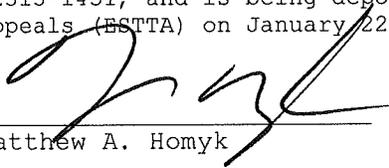


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