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Subject: U.S. TRADEMARK APPLICATION NO. 85483695 - ROMANÓV - 117237-00100 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85483695

MARK: ROMANÓV



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: The Hyman Companies, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

117237-00100

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register the trademark "ROMANÓV" because the proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act.

FACTS

On November 30, 2011, the Hyman Companies, Inc., (hereinafter referred to as “applicant”), filed an intent to use application to register the mark “ROMANÓV” for decorative eggs made of non-precious metals; jewelry; table clocks; decorative eggs made of precious materials; picture frames; decorative porcelain boxes; scarves and silk scarves. On March 14, 2012 an Office Action was issued and registration was refused due to a likelihood of confusion with prior registration nos. 3759573 and 3960758. Registration was also refused because the mark was primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. 1052(e)(4). On September 14, 2012 the applicant responded to the refusals to register. On October 2, 2012, the application was suspended pending a cancellation proceeding pertaining to prior registration no. 3960758 which was subsequently cancelled and withdrawn as a cite against the applicant. On April 29, 2013 the refusal to register was made final with respect to the refusal under Section 2(d) based upon prior registration no. 3759573 and with respect to the surname refusal under Section 2(e)(4). On October 29, 2013 the applicant filed a Request for Reconsideration arguing against the refusal under Section 2(e)(4) and deleting the Class 25 goods from the application. The Request for Reconsidered was denied with respect to the refusal under Section 2(e)(4). However, the refusal based upon Section 2(d) was withdrawn based upon the amendment to the identification of goods. The sole issue on appeal is whether applicant's mark is primarily merely a surname under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4), and should therefore be denied registration on the Principal register.

ARGUMENTS

A. “ROMANÓV” IS PRIMARILY MERELY A SURNAME AS APPLIED TO THE GOODS.

There is no general rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that is generally considered to be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on specimens; and dictionary definitions of the term and evidence from dictionaries showing no definition of the term. TMEP §1211.02(a).

The following five factors are used to determine whether a mark is *primarily merely* a surname:

- the rareness of the surname;
- whether anyone connected with the applicant has the mark as his or her surname;
- whether the term has any recognized meaning other than as a surname;
- whether the mark has the structure and pronunciation of a surname; and
- whether the mark is sufficiently stylized to remove its primary significance from that of a surname.

TMEP §1211.01. *See In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994) and cases cited therein.

1. The proposed mark is not a rare surname.

The record contains competent, admissible and timely evidence that ROMANÓV is a surname. Although the term ROMANÓV is not a rare surname, a rare surname may be unregistrable under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4), if its primary significance to purchasers is that of a surname. *See In re*

Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (REBO); TMEP §1211.01(a)(v).

Telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term. TMEP Section 1211.02(a). *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985). The issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database, because even the most common surname would represent only a small fraction of such a database. Rather, if a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare and would be perceived by the public as primarily merely a surname. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); see TMEP §1211.01(a)(v). The surname ROMANÓV resulted in well over 100 listings resulting from a search on the website www.411.com as evidenced in the original Office Action dated March 14, 2012. Also attached was an entry from Wikipedia showing the name ROMANÓV referring to the well known House of ROMANÓV dynasty that ruled in Russia for hundreds of years. See original Office Action page 12. This further underscored the name to be a surname referring to a famous family bearing that name. Attached to the final refusal dated April 29, 2013 are the results from the Internet where entries from surname websites are provided to show that the term is a surname with no other meaning. See Final Office Action pages 102-116.

In fact, there is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. TMEP §1211.02(b)(i). *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). Therefore, even a small percentage can reasonably support the logical conclusion that the term, when perceived by the purchasing public within the United States, has a primary significance as a surname because its sole significance is as a surname. In the present case, the number of listings in the telephone directory and the Internet evidence provided support the conclusion that the term's primary significance is that of a surname.

2. Whether anyone connected with the applicant has the mark as his or her surname.

The applicant argues in the response dated September 14, 2012 that there is no one associated with the application with the surname ROMANÓV. The fact that the surname ROMANÓV is not the name of anyone associated with the applicant is but one factor to be considered. The absence of there being an individual or individuals with the surname ROMANÓV associated with applicant by itself does not overcome the validity of the present refusal.

3. The term has no other meaning other than a surname.

ROMANÓV has no dictionary definition or meaning, either obscure or readily recognized. Negative dictionary evidence, that is, absence of the term from dictionaries or atlases, may demonstrate the lack of non-surname significance of a term. See *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). ROMANÓV lacks any readily recognized, imaginary or inferred meaning in ordinary language. The record supports the assertion that the proposed mark is not being used or understood other than as a surname. The applicant has argued that the mark has other meaning in its reference to the House of Romanov. The applicant argues the following:

“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).” See applicant’s Request for Reconsideration page 1.

Unlike, the DA VINCI mark, the term ROMANÓV does not refer to one highly famous individual. Rather, the term does refer to a well-known family dynasty in Russia where many members of this dynasty bore the name Romanov. Hence, consumers would not associate this name with any one particular famous person in history. They would understand the term to refer to a surname that also happens to be the surname of a famous family dynasty in Russia. The fact that the name is well known in reference to this particular Russian dynasty makes it more likely for consumers to believe that the term is a surname with no other significance.

The term ROMANÓV does not appear in the dictionary to mean anything else but as a surname evidenced by the previously referenced attachment from Wikipedia.

3. ROMANÓV has the “structure and pronunciation” of a surname.

The structure and pronunciation of ROMANÓV immediately and without mental leaps of any kind initiates the perceptions of a surname. Specifically, it is perceived by the purchasing public as a surname. ROMANÓV is a term which will easily and readily be perceived as a surname. It has no meaning, definition, or significance of any definable nature, such as in any industry, in geography or in slang or colloquialism. The record supports the surname significance of ROMANÓV. The term suggests nothing other than a last name or family name. It does not have

the appearance of having been coined. The applicant's primary argument against the surname refusal is that the term refers to a famous Russian family with this surname which simply emphasizes the surname significance of the mark. Therefore, a prima facie case has indeed been made in the instant case that "ROMANÓV" is primarily merely a surname.

5. ROMANÓV is in standard character format without additional elements.

The proposed mark consists of wording in standard character format, with no additional characters and no design element. The mark, therefore, does not include any element that would or could detract from, add to or compete with the surname significance of ROMANÓV. The effect of any additional element or elements is moot since there are none in the proposed mark.

CONCLUSION

The proposed mark "ROMANÓV" is a primarily merely a surname as applied to the goods. The examining attorney properly refused registration of the proposed mark pursuant to 15 U.S.C. Section 1052(e)(4). Accordingly, the refusal to register should be affirmed

Respectfully submitted,

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