

**To:** Pacific Poly Gums Holdings Corporation ([trademarkdocket@venable.com](mailto:trademarkdocket@venable.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85638676 - SHEMBERG - 122484.32901  
**Sent:** 11/22/2013 4:35:51 PM  
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85638676

**MARK:** SHEMBERG

**\*85638676\***

**CORRESPONDENT ADDRESS:**

MARCELLA BALLARD  
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NEW YORK, NY 10020-1806

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**APPLICANT:** Pacific Poly Gums Holdings Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

122484.32901

**CORRESPONDENT E-MAIL ADDRESS:**

[trademarkdocket@venable.com](mailto:trademarkdocket@venable.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 11/22/2013**

The trademark examining attorney issued a final Office action on 2 May 2013. On 23 October 2013, applicant responded by filing a notice of appeal to the Trademark Trial and Appeal Board (Board) and a

request for reconsideration of the final. The Board then suspended the appeal and remanded the application to the trademark examining attorney for consideration of the request.

The request presents new evidence that must be addressed. *See* TMEP §715.04(b). Therefore, this new final Office action is being issued to address the new evidence. This new final Office action supersedes the previously-issued final Office action.

Accordingly, applicant must respond to all refusal(s) and/or requirement(s) set forth below within six months of the date of issuance of this Office action. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a). A response to this Office action should be filed with the trademark examining attorney, and not with the Board. Applicant should not respond by filing another appeal. TMEP §715.04(b). The appeal will remain suspended while the application is on remand. TMEP §715.04. If applicant's response does not resolve all issues, the Board will be notified to resume the appeal. *Id.*

#### **SECTION 2(e)(4) REFUSAL – Final Continued**

The examining attorney has considered the applicant's arguments carefully. However, for the reasons enumerated below, she remains unpersuaded. Consequently, the final refusal of registration because the applied-for mark is primarily merely a surname is CONTINUED. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211.

Although "SHEMBERG" appears to be a relatively rare surname, a rare surname may be unregistrable under Trademark Act Section 2(e)(4) if its primary significance to purchasers is that of a surname. *E.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); *see* TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See* TMEP §1211.02(b)(i); *see, e.g., In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); *see* TMEP §1211.01(a)(vi).

In this instance, the fact that SHEMBERG consists of the suffix "-berg" reinforces the primarily merely surname significance of the applied-for mark. The attached dictionary excerpts evidence that names ending with *-berg*...are often thought of as Jewish, but are of [German](#) origin. Clearly, when consumers encounter SHEMBERG, a surname, that has the look and feel of a surname in light of its well-known suffix, they will perceive it as primarily merely a surname.

Moreover, the applicant references the following registrations in support of its argument SHEMBERG should be registered because other surnames have registered: WHITE (Reg. No. 3797617); DRAKE (Reg. No. 4002998); HENRY (Reg. No. 3994864); MONCADA (Reg. No. 3275836); ROSEN (Reg. No. 3113749); ROSEN (Reg. No. 3223809); and ROSEN (Reg. No. 2202467). This argument fails to be persuasive. First, WHITE as a color designation is not primarily merely a surname. Second, DRAKE and HENRY, names also used as given names, are not primarily merely a surname. Third, ROSEN (Reg. No. 2202467) is registered under Section 2(f), presumably because of its primarily merely surname significance. And finally ROSEN (Reg. No. 3113749) includes a design element, thereby obviating the primarily merely surname significance of the mark.

For the foregoing reasons, the final refusal under Section 2(e)(4) is CONTINUED.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Katherine Stoides/  
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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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## Index of Jewish Surnames/Last Names

This is a comprehensive list of Jewish surnames (last names). While this list is extensive, it is not complete. NOTE- THERE ARE A FEW NAMES WITHIN THIS LIST THAT ARE ALSO USED BY SOME GENTILES. Usually, when enough Jews take certain Gentile names, more and more Gentiles stop using those names, but there are cases when old family names survive. The original names were Gentile.

There are also **exclusively Jewish names such as Levi, Cohen, Stein**; variations, prefixes such as "**Eisen**," "**Lev**" "**Rabin**," "**Roth**," suffixes such as "**baum, berg, witz, feld, lieb, thal, stein**," and middle, (before the last name)- "**Ben**" and "**Bar**," to cite a few examples. Most of the names listed below are almost exclusively used by Jews. In addition, many Jews take Gentile names in order to hide their Jewish identity. Many Jewish names also have to do with extreme wealth, money, "**Gam**" (**tax collector**), "**Goveh**" (**treasurer**), "**Gold**" "**Goldberg**" (**mountain of gold**), **Silver, Silverstein** (**silver stone**), **Greenberg**, and so forth.

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German Surnames - Meanings & Origins

What Does Your German Last Name Mean?

By Kimberly Powell

Ads: German Genealogy German Language German Translations German How To

With roots in the Germanic middle ages, German surnames have been around since the 1100s. They are often very easy to identify, if you either know a little German, or know which clues to look for. Names that contain the vowel clusters 'au' and 'oi' indicate unisex (Eichmieder -> Schroder), providing a clue to German origins.

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Geographical Surnames - Derived from the location of the homestead from which the first bearer and his family lived (Lein Meier - Lein from by the meadow). Other geographical surnames in Germany are derived from the state, region, or village of the first bearer's origin, often reflecting a division in tribes and regions, i.e. low German, middle German and upper German. (Paul Cullen - Paul from Kueln/Cologne). Surnames preceded by 'von' are often clues to geographical surnames, not necessarily a sign that an ancestor was of nobility as many mistakenly believe. (Jacob von Bremen - Jacob from Bremen)

German Farm Names
A variation on locality names, farm names are names which came from the family farm. The thing which makes them different, however, is that when a person moved onto a farm, he would change his name to that of the farm (a name which usually came from the farm's original owner). A man might also change his surname to his wife's maiden name if he inherited a farm. This practice obviously results in a dilemma for genealogists, with such possibilities as children in one family being born under different surnames.

German Surnames in America
After immigrating to America, many Germans changed ("Americanized") their surname to make it easier for others to pronounce or merely to feel more a part of their new home. Many surnames, especially occupational and descriptive surnames, were changed to the English equivalent of the German.

- BECKER - BAKER
• ZIMMERMANN - CARPENTER
• SCHWARTZ - BLACK
• NIEN - LITTLE

When a German surname did not have an English equivalent, the name change was usually based on phonetics - spelled in English the way it sounded.

- SCHAFFER - SHAFER
• VEICHT - FIGHT
• GUHR - GERH

Top 50 Common German Surnames - Meanings & Origins

- 1. MOLLER 26. LANGE
2. SCHMIDT 27. SCHMITT
3. SCHNIEDER 28. WERNES
4. FISCHER 29. BRANDE
5. MEYER 30. MEIER
6. WIEBES 31. SCHMID
7. WAGNER 32. LEHMANN
8. BECKER 33. SCHULZE
9. SCHULZE 34. MAIER
10. HOFFMANN 35. SCHULER
11. SCHAEFER 36. HERRMANN
12. KOCH 37. WALTER
13. BAUER 38. KORTIG
14. RICHTER 39. HAYES
15. BAILEY 40. BURGER
16. SCHROEDER 41. EATSER
17. WOLF 42. EUCHS
18. NEUMANN 43. PETERS
19. SCHWARZ 44. HOLLER
20. ZIMMERMANN 45. SCHOLZ
21. HUBER 46. LANG
22. BRAUN 47. WEBB
23. HOFMANN 48. JUNG
24. SCHMITZ 49. HAHN
25. LAERTMANN 50. VOGEL

More Surname Meanings & Origins

- How to Trace the Origin of Your Surname
• Glossary of Surname Meanings & Origins

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**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **11/22/2013** FOR U.S. APPLICATION SERIAL NO. 85638676

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

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**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/22/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

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