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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

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| <p>U.S. APPLICATION SERIAL NO. 85831682</p> <p>MARK: ADLON</p> |  |
| <p>CORRESPONDENT ADDRESS: JENNIFER FRASER NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP 1875 EYE STREET NW WASHINGTON, DC 20006</p> | <p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p> |
| <p>APPLICANT: Adlon Brand GmbH & Co. KG c/o FUNDUS FON ETC.</p> | |
| <p>CORRESPONDENT'S REFERENCE/DOCKET NO: 22407-00119</p> <p>CORRESPONDENT E-MAIL ADDRESS: trademarks@novakdruce.com</p> | |

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the applied-for trademark ADLON because the proposed mark is primarily merely a surname under section 2(e)(4) of the Trademark Act. It is respectfully requested that this refusal be affirmed.

STATEMENT OF FACTS

On January 24, 2013, the applicant filed the instant application to register the mark ADLON, under Section 1(b) intent to use, for the following goods and services: "Alcoholic beverages, except beers, in particular wine, sparkling wine, champagne, vodka, rum, brandy, liqueurs" in Class 33; "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" in Class 41; "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" in Class 43 and "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" in Class 44.

In the initial Office action dated May 15, 2013, registration was refused under Trademark Act Section 2(e)(4) of the Trademark Act. The examining attorney informed the applicant that it could register its mark on the Supplemental Register once the application was amended to a Section 1(a) filing basis. Additionally, the examining attorney required applicant to provide a definite identification of goods and services, advised applicant of the multiclass application requirements and required applicant to state the significance of the mark.

On October 23, 2014, applicant submitted a response whereby it stated the significance of the mark and corrected the indefinite nature of the identification of goods and services. Additionally, applicant argued against the refusal of registration.

On November 14, 2013, the refusal to register the applied-for mark under Section 2(e)(4) of the Trademark Act was maintained and made final. Additionally, the examining attorney maintained the option to register the mark on the Supplemental Register upon the application's conversion to a Section 1(a) filing basis.

On May 14, 2014, the applicant filed a Request for Reconsideration arguing against the refusal to register.

On June 8, 2014, the examining attorney denied the Request for Reconsideration and maintained the refusal to register the applied-for mark under Section 2(e)(4) of the Trademark Act.

On October 20, 2014, the applicant filed its appeal brief, and the file was forwarded to the examining attorney for statement on October 23, 2014.

ISSUES

The issue on appeal is whether the mark is unregistrable under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4) because the proposed mark is primarily merely a surname.

ARGUMENTS

The examining attorney asserts that applicant's mark is primarily merely a surname and is, therefore, unregistrable. The primary significance of an applied-for mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); see TMEP §§1211, 1211.01. The following five factors are used to determine whether a mark is primarily merely a surname:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

See In re Binion, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

There is no 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. TMEP §1211.02(a); *see, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term.

1.) THE SURNAME "ADLON" IS NOT RARE

One of the five factors considered in determining whether a mark is primarily merely a surname is whether the term constitutes a rare surname. In this case, ADLON is not a rare surname. ADLON is a surname that can be found referenced and included in major genealogy websites such as Ancestry.com, House of Names, and My Heritage, with My Heritage containing over 100,000 records pertaining to the Adlon surname. *See*, Office Action May 15, 2013, pages 4 - 10. Additionally, the nationwide telephone directories of names, 411.com and Switchboard.com, each retrieve over 100 individuals with the ADLON surname. *See*, Final Office Action November 14, 2013, pages 2- 62. Additionally, the Internet Movie Database IMDb.com provides the following names of actors, producers and writers with the ADLON surname, all engaged in the high profile portion of entertainment industry found in television and film: Felix O. Adlon, Percy Adlon, Gideon Adlon, Eleonore Adlon, Louis Adlon, Randi Adlon, Hedda Adlon, Odessa Adlon, Rocky Adlon and, Pamela Adlon. *See*, Final Office Action November 14, 2013, pages 62. Moreover, members of popular social media and networking outlets such as Facebook, Linked In and Twitter residing in the United States also have the ADLON surname. *See*, Final Office Action November 14, 2013, pages 78 -96. Thus, as this evidence demonstrates, ADLON is not a rare surname.

Additionally, it must be noted that the surname "Adlon" routinely appears in the news, articles and other media as to be broadly exposed to the general public, as it is the surname of a famous

American actor, Pamela Adlon. Pamela Adlon, who stars in the popular television programs *Louie* and *Californication*, has acted in numerous television programs and movies since 1983, and has won an Emmy Award. *See*, Final Office Action November 14, 2013, page 64 – 75. Moreover, Pamela Adlon has been interviewed on the nationally reaching news programs Fresh Air on National Public Radio ("NPR"), and appears as the subject in articles in The New York Times, New York Magazine, Slate.com, Huffington Post, and is discussed in other entertainment news outlets such as TV Guide. *See e.g.*, *New York Times* article "Her Life as a Mom, an Actress and a Boy" opening with "Pamela Adlon had a little talk with her 11-year old daughter...." Request for Reconsideration Denied, June 8, 2014, pages 56-60; TV Guide article "*Californication* Star Scores CBS Pilot" opening with "Pamela Adlon may leave Evan Handler for Adam Carolla" *Id* at 61-62; NPR's Fresh Air Interview entitled "Pamela Adlon: From 'Hill' Kid to 'Californication'" *Id* at 39-43; Huffington Post article "Is *Louie* Closer to Literature Than TV?" states "There's a scene in the middle of season two of *Louie* when Louis C.K. is walking through a flea market with Pamela (played by the wonderful Pamela Adlon)" *Id.* at 63-69; *see also*, Request for Reconsideration Denied, June 8, 2014, pages 50-55, 70-75, 8-19, and 20-38. Therefore, even if the surname were to be considered rare, its exposure to the general public as a surname renders it not rare.

Finally, even if ADLON were to be construed as a relatively rare surname, it must be noted that even 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). To this end, 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). Given the presence and volume of this surname in social media, entertainment culture, in national phone directories and its exposure to the general public as a surname, the primary significance of ADLON to the American purchasers will be that of a surname.

2.) THE SURNAME “ADLON” IS CONNECTED TO THE APPLICANT

In this case, ADLON is the surname of an individual associated with the applicant. Specifically, “ADLON” is the surname of the founder of the hotel establishment to which applicant’s goods and services are associated. In this case, applicant states that the Hotel Adlon in Berlin, Germany, is associated with the instant application. Applicant’s Appeal Brief pages 6 and 13. The Hotel Adlon was founded in 1907 by Lorenz Adlon and managed as a hotel by members of the Adlon family through 1967. *See*, Request for Reconsideration Denied, June 8, 2014, page 2 and Applicant’s Appeal Brief page 13. The hotel in this original iteration remained open until 1984. While the original structure was removed, Hotel Adlon was rebuilt in the same location, in the same architectural style and given the exact same name as its predecessor and reopened in 1997. *See*, Request for Reconsideration Denied, June 8, 2014, pages 1 -7. Thus, applicant has striven to maintain a seamless connection to the Hotel Adlon founded by Lorenz Adlon and maintained by the Adlon family.

Such a scenario is not new to the Trademark Trial and Appeal Board, but one that was previously entertained in *In re Cazes*, 21 USPQ2d 1796, (TTAB 1991). In *In re Cazes*, the applicant, Raymonde Marie Cazes, sought registration of the trademark for the name of her restaurant in Paris, BRASSERIE LIPP, that was found by Leonard Lipp. *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991). In this particular case, “the name Lipp was not used for the restaurant until World War I, and that during the entire period that the restaurant has been called BRASSERIE LIPP no one named Lipp has been connected with it.” *In re Cazes*, 21 USPQ2d 1796, 1796-97 (TTAB 1991). In finding that the mark was primarily merely a surname, the Board noted “that at the time the name BRASSERIE LIPP was adopted no one named Lipp was associated with the restaurant. However, the issue is how the mark is perceived, and the perception

would be that of a surname. Further, the fact that the brasserie was founded by a person named Lipp reinforces the surname significance of the mark.” *Id* at 1797.

Like the applicant in *In re Cazes*, no one directly connected to the applicant in this case uses the ADLON surname. However, the fact that the establishment and its related services were founded by an individual named Adlon serves to reinforce the surname significance of the mark. Moreover, by rebuilding the hotel in the same location, in the same architectural style and giving it the exact same name as its predecessor, applicant has maintained a continuous connection to the Hotel Adlon founded by Lorenz Adlon and maintained by the Adlon family. *See*, Request for Reconsideration Denied, June 8, 2014, pages 1 -7. Therefore, the fact that no one currently associated with the applicant uses the Adlon surname is of minimal significance in this particular case in light of applicant’s successfully endeavor to maintained its connection to the Adlon family and its surname.

3.) ADLON HAS NO OTHER MEANING OTHER THAN THAT OF A SURNAME

Evidence that a word has no meaning or significance other than as a surname is relevant to determining whether the word would be perceived as primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986); TMEP §1211.02(b)(vi). The previously attached evidence from *Collins Dictionary*, *Merriam Webster Dictionary*, *Macmillan Dictionary*, and *The Columbia Gazetteer of the World* demonstrates that the word ADLON does not appear in dictionaries or gazetteers. *See*, Request for Reconsideration Denied, June 8, 2014, pages 112- 118. The absence of ADLON from these dictionaries and a gazetteer demonstrates that ADLON has no meaning or significance other than that of a surname.

4.) ADLON HAS THE STRUCTURE AND PRONUNCIATION OF A SURNAME

In this case, applicant's applied-for mark has the structure and sound of a surname. 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).

First, the surname ADLON is comprised of two syllables with the terminal syllable ending in "LON". Surnames containing this terminal element are common in the United States and include such surnames such as Dillon, Kaplon, Hanlon, Yelon, Ablon, Scanlon, Fallon, Kellon, Freelon, Nealon, Allon, Millon, Kallon, Donlon, and Carlon. See, Request for Reconsideration Denied, June 8, 2014, pages 76 – 121. The ADLON surname is part of an even greater class of common surnames that are comprised of two syllables and end in "ON", such as like Dalton, Wilson, Acton or Burton. See, Office Action, May 15, 2013, pages 21 – 32. Moreover, it cannot be ignored that ADLON is in fact used as a surname in the United States, as discussed above. See, Discussion of factor (1) The Surname ADLON is not Rare, above. Therefore, as ADLON is structured in the same manner as many surnames found in the United States and contains a terminal element common to many surnames found in the United States, it is also pronounced similarly to surnames commonly used in the United States. As such, applicant's mark has the structure and pronunciation of a surname.

5.) THE MARK IS INSUFFICIENTLY STYLIZED TO REMOVE ITS PRIMARY SIGNIFICANCE FROM THAT OF A SURNAME

In this case, applicant's mark contains no stylization as it is claimed in standard characters. In a standard character mark, an applicant makes no claim to any particular font, style, size, or color. See, 37

C.F.R. §2.52(a); *see also*, TMEP §§807.03,807.03(a). As such, the applied-for mark contains no stylization whatsoever. Therefore, applicant's mark is insufficiently stylized to remove its primary significance from that of a surname.

Therefore, as ADLON is not a rare surname, as an individual bearing the ADLON surname is associated with the applicant, as ADLON has no other meaning apart from surname significance, as ADLON has the structure and pronunciation of a surname and as the applied-for ADLON mark contains no stylization, the primary significance of ADLON to the purchasing public is that of a surname.

APPLICANT'S ARGUMENTS ARE UNPERSUASIVE

Applicant provides several arguments against the refusal. For the reasons provided, below, these arguments are unpersuasive.

Initially, it must be noted that applicant only provides arguments in relation to four of the five factors used in determining whether a mark is primarily merely a surname. Applicant states "[t]here are four relevant factors in this case that should be considered in determining whether the mark is not primarily a surname." *See*, Applicant's Brief, pages 4 - 5. Applicant identifies these factors as "1) whether the surname is rare; 2) whether another connected with applicant has the surname; 3) whether the term has a recognized meaning other than as a surname; and 4) whether the term has the look and sound of a surname." *See Id.*, page 5. The fifth factor in the inquiry, which applicant fails to address, is whether the applied-for mark is sufficiently stylized to remove its primary significance from that of a surname. *See In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01. In this case, applicant's mark has been claimed in standard

characters. Generally, when the mark at issue is claimed in standard characters, the “stylization” factor is neutral. See, *In re Productos Urman, S.A. de C.V.*, 2008 TTAB LEXIS 698 (Trademark Trial & App. Bd. Mar. 20, 2008). However, the potential neutrality of this factor does not make it irrelevant to the inquiry as applicant would suggest. Rather, the application of this fifth factor demonstrates that applicant’s mark is insufficiently stylized to remove its primary significance from that of a surname. Therefore, this fifth factor, along with the remaining four factors, is applicable in this surname inquiry.

Applicant argues that it "owns the trademark right in the Hotel ADLON in Berlin" and that "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." Applicant's Brief, pages 6 and 13. In the same vein, applicant argues that "the ADLON mark is distinctive." See, Applicant's Appeal Brief, pages 1 - 2. First, as applicant failed to assert acquired distinctiveness during the prosecution of its application, applicant's assertion on appeal that the mark is distinctive is misplaced. Additionally, TMEP §1212.08 states that "[t]he applicant may not rely on use other than use in commerce that may be regulated by the United States Congress in establishing acquired distinctiveness. Evidence of use solely in a foreign country, or between two foreign countries, is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746 (TTAB 1999)." TMEP §1212.08. As applicant has failed to provide any evidence that "ADLON" has been used as a trademark in the United States by applicant or that applicant is the owner of ADLON trademark registrations in the United States, it can only be assumed that applicant is relying on foreign use of the applied-for mark as the basis for its assertions. Moreover, applicant's filing basis for its application is Section 1(b), revealing that at this point in time applicant has only a bona fide intent to use its applied-for mark in commerce. As applicant has provided no evidence to support its assertion that its applied-for mark has long been used a trademark in the United States and applicant failed to assert a claim of distinctiveness during the prosecution of the

application, applicant's argument that the mark is distinctive and would not be viewed as primarily merely a surname is without merit.

Applicant argues that the fame of the Hotel Adlon would cause an association between it and the applied-for mark ADLON, thus removing the applied-for mark's primary significance from that of primarily merely a surname. See, Applicant's Appeal Brief pages 1 - 2. To this end, applicant states that the Hotel Adlon in Berlin, Germany, has won awards, that it is featured in television programs such as *Das Adlon: Eine Familiensaga* ("The Adlon: A Family Saga") and *Adlon verpflichtet - Geschichte und Geschichten eines Hotels* ("Adlon Committed - History and Stories of a Hotel") and that it "is associated with a number of events involving the U.S. Embassy in Germany and was mentioned in the remarks delivered during the groundbreaking ceremony for the new U.S. Embassy in Berlin." Applicant's Brief, page 14, and Request for Reconsideration after Final Action, May 14, 2014, page 17. This assertion that the alleged fame of the Hotel Adlon alters the primarily merely a surname perception of the applied-for mark ADLON fails for two reasons.

First, evidence of a term's recognition and fame is only relevant to prove acquired distinctiveness under Trademark Act Section 2(f), and is not pertinent to a determination of surname significance. See *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP primarily merely a surname despite applicant's evidence of the mark's fame, noting that applicant did not make a Section 2(f) claim and, without a formal claim of distinctiveness, "evidence of fame [could not] serve as the basis for allowing registration of applicant's mark"); *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986) (holding McDONALD'S primarily merely a surname despite applicant's evidence of secondary meaning, noting that, absent a claim of secondary meaning under Section 2(f), "registration must be refused"); TMEP §1211.02(b)(vii). As such, applicant's position that fame can alter a mark's status as primarily merely a surname is unfounded.

Second, even if fame were pertinent to a determination of surname significance, the fame of Hotel Adlon that applicant believes has been imparted unto the applied-for mark ADLON serves only to reinforce the surname significance of the applied-for mark. For example, the nature of the television shows applicant alludes to as a source of transferred fame - *Das Adlon: Eine Familiensaga*, or "The Adlon: A Family Saga" and *Adlon verpflichtet - Geschichte und Geschichten eines Hotels* or "Adlon Committed - History and Stories of a Hotel" - likely discuss that Lorenz Adlon founded the Adlon Hotel and that the Adlon family managed the hotel for multiple generations. Request for Reconsideration after Final Action, May 14, 2014, page 17. Consequently, these elements which impart fame also reinforce the surname significance of the term ADLON.

Applicant argues that no one with the ADLON surname is associated with this application. This argument is unpersuasive. As discussed, above, the Hotel Adlon was founded by Lorenz Adlon in 1907 and was managed by members of the Adlon family through 1967. *See*, Request for Reconsideration Denied, June 8, 2014, page 2 and Applicant's Appeal Brief page 13. While the original structure was removed, this hotel was rebuilt in the same location, in the same architectural style and given the exact same name, the Hotel Adlon. *See*, Request for Reconsideration Denied, June 8, 2014, page 1 and Applicant's Appeal Brief, page 13. Thus, applicant sought to maintain a seamless connection to the original Hotel Adlon founded by Lorenz Adlon and maintained by the Adlon family. In this manner, applicant has sought the association of the ADLON surname with its mark, goods and services. As such, there is a viable and obvious connection with individuals bearing the ADLON surname to the applicant and its applied-for mark. As noted in *In re Cazes*, which is discussed in greater detail, above, the fact that an establishment maintains the surname of its founder reinforces the surname significance of the mark. *See In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991). As such, applicant's argument is unpersuasive.

Applicant also argues that the applied-for mark ADLON does not have the structure and pronunciation of a surname because the English language contains other non-surname two syllable words ending "ON". *See*, Applicant's Appeal Brief, pages 14 - 15. To support its assertion, applicant provides the following examples of English words ending in "ON" (but not the terminal syllable "LON" as is found in applicant's mark): bacon, bison, lemon, apron and Amazon. *See*, Applicant's Brief, page 15. By applicant's reasoning, any surname that is comprised of two syllables that ends in "ON" cannot have the structure and pronunciation of a surname because other words in the English language without surname significance that are structured similarly. Applicant's supposes that, in order to satisfy this prong of the surname inquiry, surnames must be wholly different or unrelated in structure, composition, sound and appearance to any other word in the English language. Under applicant's standard, this particular prong of the surname inquiry could never be satisfied, as a search of the many words comprising the English language will likely render non-surname terms containing the same number of syllables or similar syllabic elements as those found in surnames. Rather, the reasonable inquiry is whether the applied-for mark has a sound and structure similar to that of other recognized surnames in the United States, such that the applied-for mark would be perceived by consumers as a surname. As the examining attorney has demonstrated, ADLON is structured similarly to other surnames commonly found in the United States, such as Dillon, Kaplon, Hanlon, Yelon, Ablon, Scanlon, Fallon, Kellon, Freelon, Nealon, Allon, Millon, Kallon, Donlon, Carlon Dalton, Wilson, Acton or Burton. *See*, Request for Reconsideration Denied, June 8, 2014, pages 76 - 121 and Office Action May 15, 2013, pages 21 - 32. Thus, given that its structure and pronunciation are similar to other surnames commonly found in the United States, ADLON has the structure and pronunciation of a surname.

CONCLUSION

Therefore, as ADLON is not a rare surname, as it is the surname of an individual and family connected with the applicant, as it has no recognized meaning other than as a surname, as it has the structure and pronunciation of a surname, and claims no stylization to remove its primary significance from that of a surname, the applied-for mark ADLON is primarily merely a surname and would be perceived as such by the purchasing public. In light of the foregoing, the examining attorney properly refused registration of the applied-for mark pursuant to 15 U.S.C Section 1052(e)(4). Accordingly, it is respectfully requested that this refusal be affirmed.

Respectfully submitted,

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