

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86103952
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has made "final" a refusal that the Applicant's mark THE PIZITZ BUILDING is primarily merely a surname under Section 2(e)(4) of the Trademark Act. The Applicant respectfully submits that the record does not support this ground for refusal, and that it must be withdrawn.</p> <p>In the Office action, the Examiner contends that the evidence "shows that Pizitz is not used in any other way than as a surname". This simply is not the case. The Applicant has made of record ample evidence that the name THE PIZITZ BUILDING has been associated for decades with a prominent structure of great historical significance in the city of Birmingham, Alabama. As the Examiner is aware, a term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. TMEP Section 1211.01(a)(iv); citing <i>Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.</i>, 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci). While THE PIZITZ BUILDING may not be nationally or internationally famous, it is renowned in the market that the Applicant intends to serve under its mark. This alone should place the mark beyond the reach of Section 2(e)(4).</p> <p>In an effort to support of the claim that the existence of another non-surname meaning of the Applicant's mark does not preclude a surname refusal, the Examiner cites the case <i>Mitchell Miller, P.C. v. Miller</i>, 105 USPQ2d 1615, 1620-21 (TTAB 2013). That case involved a surname -- namely, "Miller" -- that is the sixth most frequently occurring surname from the United States Census 2000. <i>Id.</i> at 1619-20. The record also reflected substantial use of the name in connection with rendering legal services, which were the services of interest to both parties. Clearly, any other significance of the term was overwhelmed by its use as a surname.</p> <p>In contrast, the term "Pizitz" at issue in the matter at hand is a rare surname. Indeed, the Examiner essentially concedes as much in the initial Office action, stating that "'Pizitz' appears to be a relatively rare surname" after a search of national phone listings yielded only about 50 "hits". Office action of February 18, 2014 at p. 1. This rarity alone is another basis for withdrawing the refusal to register. When coupled with the evidence of the historical significance of the wording THE PIZITZ BUILDING in the geographic area in which the Applicant's services are to be rendered, it is readily apparent that the refusal cannot be sustained.</p> <p>Based upon the foregoing, the Applicant respectfully submits that the Examiner must withdraw the refusal to register and approve the application for publication. In the alternative, it is submitted that the mark has acquired distinctiveness by virtue of the longstanding use of the name THE PIZITZ BUILDING in connection with the physical structure and location that will be associated with the services to be rendered under the mark by the Applicant.</p>	
ADDITIONAL STATEMENTS SECTION	

SECTION 2(f)) Claim of Acquired Distinctiveness, BASED ON EVIDENCE	The mark has become distinctive of the goods/services, as demonstrated by the attached evidence.
2(f) EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	e2f-65114175178-102017179_20150316101904.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\861\039\86103952\xml7\RFR0002.JPG
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Scott J. Major/
SIGNATORY'S NAME	Scott J. Major
SIGNATORY'S POSITION	Attorney of record, VA bar member
SIGNATORY'S PHONE NUMBER	703-465-5356
DATE SIGNED	03/16/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Mar 16 10:22:43 EDT 2015
TEAS STAMP	USPTO/RFR-65.114.175.178-20150316102243517046-86103952-530ddc2e6d9b087af987c79afccaa9e61eaa9fca250f93b578cfa1b408013a5f5-N/A-N/A-20150316102017179295

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

Application serial no. **86103952** has been amended as follows:

ARGUMENT(S)

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

The Examining Attorney has made "final" a refusal that the Applicant's mark THE PIZITZ BUILDING is primarily merely a surname under Section 2(e)(4) of the Trademark Act. The Applicant respectfully submits that the record does not support this ground for refusal, and that it must be withdrawn.

In the Office action, the Examiner contends that the evidence "shows that Pizitz is not used in any other way than as a surname". This simply is not the case. The Applicant has made of record ample evidence that the name THE PIZITZ BUILDING has been associated for decades with a prominent structure of great historical significance in the city of Birmingham, Alabama. As the Examiner is aware, a term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. TMEP Section 1211.01(a)(iv); citing *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci). While THE PIZITZ BUILDING may not be nationally or internationally famous, it is renowned in the market that the Applicant intends to serve under its mark. This alone should place the mark beyond the reach of Section 2(e)(4).

In an effort to support of the claim that the existence of another non-surname meaning of the Applicant's mark does not preclude a surname refusal, the Examiner cites the case *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1620-21 (TTAB 2013). That case involved a surname -- namely, "Miller" -- that is the sixth most frequently occurring surname from the United States Census 2000. *Id.* at 1619-20. The record also reflected substantial use of the name in connection with rendering legal services, which were the services of interest to both parties. Clearly, any other significance of the term was overwhelmed by its use as a surname.

In contrast, the term "Pizitz" at issue in the matter at hand is a rare surname. Indeed, the Examiner essentially concedes as much in the initial Office action, stating that "'Pizitz' appears to be a relatively rare surname" after a search of national phone listings yielded only about 50 "hits". Office action of February 18, 2014 at p. 1. This rarity alone is another basis for withdrawing the refusal to register. When coupled with the evidence of the historical significance of the wording THE PIZITZ BUILDING in the geographic area in which the Applicant's services are to be rendered, it is readily apparent that the refusal cannot be sustained.

Based upon the foregoing, the Applicant respectfully submits that the Examiner must withdraw the refusal to register and approve the application for publication. In the alternative, it is submitted that the mark has acquired distinctiveness by virtue of the longstanding use of the name THE PIZITZ BUILDING in connection with the physical structure and location that will be associated with the services to be rendered under the mark by the Applicant.

ADDITIONAL STATEMENTS

Section 2(f) Claim of Acquired Distinctiveness, based on Evidence

The mark has become distinctive of the goods/services, as demonstrated by the attached evidence.

Original PDF file:

[e2f-65114175178-102017179_. 20150316101904.pdf](#)

Converted PDF file(s) (1 page)

[2\(f\) evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Scott J. Major/ Date: 03/16/2015

Signatory's Name: Scott J. Major

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

Signatory's Phone Number: 703-465-5356

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: 86103952

Internet Transmission Date: Mon Mar 16 10:22:43 EDT 2015

TEAS Stamp: USPTO/RFR-65.114.175.178-201503161022435

17046-86103952-530ddc2e6d9b087af987c79af

ccaa9e61eaa9fca250f93b578cfa1b408013a5f5

-N/A-N/A-20150316102017179295

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application -

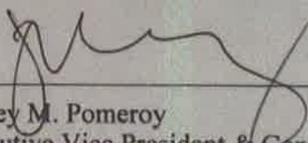
Mark: THE PIZITZ BULIDING
Serial No.: 86103952
Filed: October 29, 2013
Applicant: Bayer Properties,
Class: 36
Law Office: 106

CLAIM UNDER SECTION 2(F)

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or any resulting registration, declares that the referenced mark has acquired distinctiveness by virtue of the use for more than 20 years of the name THE PIZITZ BUILDING by the Applicant, its predecessors-in-interest, the press and the general public in and around the city of Birmingham, Alabama in connection with the physical structure and location that will be associated with the services to be rendered under the mark by the Applicant; that he is properly authorized to execute this application on behalf of the applicant; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

BAYER PROPERTIES, LLC

Date: March 16, 2015



Jeffrey M. Pomeroy
Executive Vice President & General Counsel