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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant Name: Angelus : Law Office: 113
Serial No.:85/077,515 : Examiner: Kimberly Frye
Filed: July 02, 2010 :
MARK: CAFÉ PUSHKIN :

RESPONSE

To: Commissioner for Trademarks
P.O Box 1451
Alexandria, VA 22313-1451
OLDecom@uspto.gov

Dear Ms. Frye:

This is a response to the Office Action, dated October 19, 2010, by Angelus, a Russian limited liability company (the “*Applicant*”), and by and through its counsel.

On July 02, 2010 the Applicant filed an application for the registration of the mark “CAFÉ PUSHKIN” (“*Applicant’s Mark*”) in connection with the goods and services in International Class 043:

“Services for providing food and drink; cafes; cafeterias; canteens; restaurant services; self-service restaurants; snack-bars; bar services; catering services; food and drink catering; restaurant services with food takeaway services; rental of chairs, tables, table linen and glassware; temporary accommodation; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotels; hotel services; hotel reservations; rental of temporary accommodation; tourist home reservations; information, advisory and consultancy services relating to all the aforesaid services”

The Examining Attorney refused the registration of the mark because Examining Attorney contends that the Applicant’s Mark is “primarily merely a surname.”

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We respectfully and strongly disagree with the Examining Attorney's determination that Applicant's Mark is primary merely a surname and ask the Examining Attorney to reconsider the refusal and allow the registration of the Applicant's Mark in light of the arguments provided below.

1. The Examining Attorney states that **"The primary significance of the 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."**

In re Kahan & Weisz Jewelry Mfg. Corp., it has been recognized that the Section 2(e)(4) is difficult to apply in determining whether a mark is primarily merely a surname.¹ The determination of whether a mark is primarily merely a surname "can be made only after the primary significance of the mark to the purchasing public is determined."² It has been expanded that:

*A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, and 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.*³

The burden is on the United States Patent and Trademark Office ("**USPTO**") to show that the mark is primarily a last name.⁴ Unless it first meets this burden, the applicant need not demonstrate the non-surname significance of the mark.⁵

To determine as to whether a mark is primarily a surname, it is necessary to apply a fact based analysis that includes the consideration of five factors: (1) Is the word a common or rarely used surname?; (2) Does anyone connected with the applicant have that surname?; (3) Does the word have meaning other than the surname?; (4) Does the word look and sound like a surname?; (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-

¹ *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975)

² *Id.*

³ *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Com'r Pat.1955).

⁴ *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d at 832.

surname impression?⁶ For instance, showing that six names similar to the applicant's mark appeared in the Manhattan telephone directory was insufficient to meet the USPTO's burden of demonstrating that the mark is primarily a surname.⁷ On the other hand, 1416 entries of the mark as surname in a nationwide directory demonstrated that the mark is not so rare mandating the conclusion that the mark is merely a last name.⁸

The Examining Attorney based her determination that the Applicant's Mark is primarily merely descriptive on a sole fact the Applicant's mark "appears over 100 times as a surname in a nationwide telephone directory." We disagree. One-hundred surnames *nationwide* is more akin to six surnames in a Manhattan telephone directory than the 1416 nationwide entries that were found to be sufficient for such determination.⁹ Hence, appearance of the surname PUSHKIN one hundred times in the nationwide directory is insufficient to meet the USPTO's burden of demonstrating that the mark is primarily a surname.

Further, the Board's decision in *In re Kahan & Weisz Jewelry Mfg. Corp.* supports our contention that a showing of existence of surname in a phone directory can not be a sole determination of the significance of surname. The Board found that "[a]lthough the use of a telephone directory may be considered a factor in determining whether a mark is primarily merely a surname, we do not find this, standing alone, to be determinative of the issue."¹⁰ Here, the Examining Attorney relied exclusively on the alleged frequency of the mark in a nationwide directory. The Examining Attorney failed to engage in an analysis of the other four factors typically considered in determining whether a mark is perceived primarily as a surname and consequently failed to meet its burden that PUSHKIN is primarily merely descriptive surname and its impression on the consumers. For illustration purposes we conducted a search of the telephone directory of surname "Shakespeare." We found over one hundred (100) surnames

⁵ *Id.*

⁶ *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). The fifth factor is not always included. See *In re Thermo LabSystems, Inc.*, 85 USPQ2d 1285, 1286 (TTAB 2007) ("We normally look to four factors in a surname analysis: (i) whether the surname is rare; (ii) whether anyone connected with applicant has the involved term as a surname; (iii) whether the term has any other recognized meaning; and (iv) whether the term has the "look and feel" of a surname.")

⁷ *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d at 833.

⁸ *In re Binion*, 93 USPQ2d at 1537.

⁹ *In re Binion*, 93 USPQ2d at 1537.

nationwide (6 Apr. 2011 <<http://www.411.com/>>) (See **Exhibit A**). It is doubtful that Examining Attorney would find the appearance of the surname “Shakespeare” over hundred times nationwide in the telephone directory, as a stand-alone factor, to be determinative of the significance of the surname and the impression it may have on the purchasing public or that “Shakespeare” is primarily merely a surname.

2. Finally, a term is primarily merely a surname if its primary significance to the purchasing public is that of a surname. See *In re Hutchinson Technology, Inc.*, 852 F.2d 552 (Fed. Cir. 1988). Alexander Pushkin has an overwhelming significance worldwide as demonstrated below. The Examining Attorney also states that “...*the fact that a term is shown to have some significance as a historical figure generally will not dissipate its primary significance as a surname. See In re Binion, 93 USPQ2d 1531, 1537-38 (TTAB 2009); In re Thermo LabSystems, Inc., 85 USPQ2d 1285, 1289 (TTAB 2007); Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp., 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970); TMEP §1211.01(a)(iv).*”

The Examining Attorney states that the name has “some historical significance” [emphasis added] that will not dissipate its primary significance as a surname. The Examining Attorney does not elaborate nor support her classification of A. Pushkin as having “some” historical significance, so it is not clear as to what criteria was used to make such arbitrary and superficial determination. We strongly disagree with the Examining Attorney and believe that Alexander Pushkin’s influence extends well beyond Russia’s border and the three million Russian-Americans who call the United States home, but has found its rightful place among the likes of Shakespeare, Edgar Allan Poe, E.E. Cummings and others, to qualify him as a historical figure whose surname is nearly synonymous with his literal and historical presence. “[T]here is no mystery at all: for the people of the Russian culture, Pushkin is like Shakespeare for the British [...]”¹¹

Traditionally, the Trademark Trial and Appeals Board (“**Board**”) has drawn a line between those names considered so widely recognized as to be “almost exclusively associated in terms of commercial impressions with the historical figures” and those names “semihistorical in character.” *In Re Pyro-Spectaculars*, 63 U.S.P.Q.2d 2022 (Trademark Tr. & App. Bd. Apr. 11,

¹⁰ *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d at 833.

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2002). In *In re Pickett Hotel Company*, 229 USPQ 760, 761-2 (TTAB 1986). In *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, the registration of the mark “DA VINCI” was affirmed because “[t]he name Da Vinci, even without the given name Leonardo, comes very near having as its exclusive connotation the world-renowned 15th century artist, sculptor, architect, musician, engineer and philosopher.”¹² Similarly, the name PUSHKIN is nearly synonymous with the world-famous Russian poet. Standing alongside names such as Dostoyevksiy, Tolstoy, Nabokov, Chekhov, not unlike Da Vinci, the surname PUSHKIN is virtually exclusively associated with the most famous Russian poet. The Russian literature, with its numerous Nobel prize laureates, is regarded by many as one of the cornerstones of the modern culture while “Pushkin [...] is the rebellious founder of modern Russian literature, and the country’s greatest early poet, its Shakespeare: all roads snake back to him.”¹³

Although Pushkin may not be, arguably, as widely-regarded in the United States as in Russian and Europe, his legacy and influence could not be underestimated in the United States. His works have been translated virtually in every world’s language from more common English, Chinese, French, German, and Italian languages to Swahili and Hebrew although “unfortunately Pushkin’s poetry cannot be well translated [...] though it is not the fault of the translators.”¹⁴ In 1887, the New York Times, in marking the fiftieth anniversary of his death, referred to Pushkin as “Russia’s greatest poet.”¹⁵ In 1999, Pushkin’s poem *Yevgeny Onegin* was adapted into a motion picture starring mainstream actors, including Ralpa Fiennes and Liv Tyler, and released in the United States.¹⁶ Furthermore, in 2000, a 10-foot tall monument to honor Pushkin was erected in Washington, D.C. Then-mayor Anthony Williams declared the day of the formal groundbreaking as “Alexander Pushkin” day in Washington, D.C. and President Clinton sent a congratulatory message that was read at the ceremony. Presidential affinity for Pushkin goes

¹¹ *The Cult of Pushkin*, NY TIMES, October 2, 2005, <http://query.nytimes.com/gst/fullpage.html?res=9501E1DC1230F931A35753C1A9639C8B63&ref=aleksandrpushkin>

¹² *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d at 833.

¹³ *When Poets Rocked Russia’s Stadiums*, NY TIMES, June 2, 2010, <http://www.nytimes.com/2010/06/03/books/03poets.html?ref=aleksandrpushkin>

¹⁴ *The Cult of Pushkin*, NY TIMES, October 2, 2005, <http://query.nytimes.com/gst/fullpage.html?res=9501E1DC1230F931A35753C1A9639C8B63&ref=aleksandrpushkin>

¹⁵ *Russia’s Greatest Poet*, NY TIMES, Apr 24, 1887 at 11.

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beyond President Clinton: President Obama quoted a line from Pushkin's poetry in a recent speech on U.S.-Russian relations.¹⁷ These instances are not intended to be an exhaustive list of Pushkin's influence in the United States as they are merely a small sample of Alexander Pushkin's notoriety in the U.S. There are academic scholarship and grants named after Alexander Pushkin,¹⁸ and there are two pages of the titles of recent articles published by The New York Times referring to Alexander Pushkin.¹⁹ Even in Scotland, which champions its own famous writers, Pushkin Prizes (named after the Russian poet and not any person found in a phone book) are awarded to its young writers.²⁰

Additionally, the surname PUSHKIN is quite uncommon, despite the Examining Attorney's contention to the contrary. A simple internet search performed, using search engine GOOGLE and term "PUSHKIN," reveals a long string of references devoted exclusively to the Russian poet Alexander Pushkin or information relating virtually exclusively to him on at least first five pages (6 Apr. 2011 <<http://www.google.com/>>) (See **Exhibit B**).

Further, the Examining Attorney sites cases which are vastly distinguishable from the case at hand. *In re Binion* involved an applicant's attempt to register the mark "BINION'S" for casino and gaming services. In affirming the application's rejection, the Board found that "Mr. Binion's personal history is in any way so extraordinary that he warrants treatment under the 'historical person' exception to the surname refusal."²¹ Although Mr. Binion played a significant role in the development of the gaming industry in Las Vegas, "his notoriety in this regard is not so remarkable or so significant that he is a historical figure as contemplated by the case law."²² In *In re Thermo LabSystems, Inc.* the Board affirmed the rejection of "WATSON" as a trademark for computer software used in laboratory information management. The applicant argued that "WATSON" referred to James Dewey Watson who discovered the helical structure

¹⁶ See Internet Movie Database at <http://www.imdb.com/title/tt0119079/>.

¹⁷ *Obama, Pushkin, Bullwinkle, and Badenov*, USA TODAY, July 7, 2009, <http://content.usatoday.com/communities/theoval/post/2009/07/68493752/1>.

¹⁸ See, e.g., *Alexander Pushkin Grant 2011, USA*, scholarship-positions.com, November 3, 2010, <http://scholarship-positions.com/alexander-pushkin-grant-2011-indiana/2010/11/03/>

¹⁹ See, e.g., http://topics.nytimes.com/topics/reference/timestopics/people/p/aleksandr_pushkin/index.html

²⁰ See, e.g., <http://www.pushkinprizes.net/>

²¹ *In re Binion*, 93 USPQ2d at 1538.

²² *Id.*

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of the DNA molecule.²³ Although Mr. Watson made a significant contribution to science, the Board recognized a difference “between being an individual that has made a historically significant contribution to science and being an individual that has achieved such renown as to become an historical figure.”²⁴ The Board noted that, “there was no evidence that the purchasers of applicant's goods regard [Mr. Watson] as an historical figure.”²⁵ Moreover, the name Watson is far from unique: there are numerous persons of arguable historical significance with the surname Watson.²⁶

Here, Alexander Pushkin is significantly more famous than James Dewey Watson, and incalculably more famous than Jack Binion. Alexander Pushkin (1799-1837) is considered by many to be the greatest Russian poet, the father of modern Russian literature, and “widely regarded as the best stylist ever to write in the Russian language.”²⁷ He was also a controversial political figure who clashed with the Tsarist government and was eventually exiled for his political views. Pushkin wrote such classics as *The Bronze Horseman*, *The Captain's Daughter*, *Boris Godunov*, and *Yevgeny Onegin* (among many others). In addition to his literary works, many Russian scholars credit Pushkin with having, in effect, created the Russian literary language.²⁸ Russian devotion to Pushkin is ubiquitous: “Every literate Russian can quote Pushkin and hum a tune from Glinka [an opera adapted from Pushkin's work].”²⁹ Statues dedicated to Pushkin dominate public squares in Russia's two major cities, Moscow and St. Petersburg.³⁰ It is little wonder that Russians still say: “Pushkin is our everything.”³¹

Although James Dewey Watson is relatively well-known within the scientific community, his historical significance is tied to a single discovery which, although important in his field, is not generally well-known. Jack Binion's significance is even more limited: he is a

²³ *In re Thermo LabSystems, Inc.*, 85 USPQ2d 1285, 1286 (TTAB 2007).

²⁴ *Id.* at 1289.

²⁵ *Id.*

²⁶ *Id.* (“A surname that would not be evocative of a particular historical individual but, rather, would be more evocative of numerous individuals, does not qualify for registration as a historical name and is merely a surname of numerous individuals with varying degrees of historical significance”)

²⁷ Lee, Gary, *The Power of Pushkin*, WASH. POST., February 10, 1987 at B1.

²⁸ TERRAS, VICTOR, *HANDBOOK OF RUSSIAN LITERATURE*, 357 (1990).

²⁹ Holland, Bernard, *A Visit With Mother Russia and Her Children*, NY TIMES, Dec 4, 2007 at E1.

³⁰ *Obama, Pushkin, Bullwinkle, and Badenov*, USA TODAY, July 7, 2009, <http://content.usatoday.com/communities/theoval/post/2009/07/68493752/1>.

Las Vegas casino owner and poker-enthusiast. Neither of these persons has made social contributions to the world's civilization event remotely equivalent to Alexander Pushkin's nor attained Pushkin's global following.

Furthermore, unlike in *In re Thermo LabSystems, Inc.*, the prospective purchasers of Pushkin Café's service certainly regard Alexander Pushkin as a historical figure. As a Russian restaurant in New York City, the prospective Pushkin Café diner would likely be of Russian descent or clientele looking for a glimpse or a taste of the Russian culture. In fact, it is virtually impossible to find a person of Russian descent or anyone even remotely familiar with Russian culture or the world literature in general, who does not appreciate Alexander Pushkin's unique and stellar historical significance and would not associate the name Pushkin with the famous poet.

Moreover, numerous historical figures do not share the surname PUSHKIN. PUSHKIN is sufficiently uncommon of a surname as to be solely associated with Alexander Pushkin (6 Apr. 2011 <<http://www.google.com>) (See **Exhibit B**).

3. Identification of Services:

The Examining Attorney asserts that the identification of goods and services is "indefinite" and therefore unacceptable. The Examining Attorney further provides a suggested language for the amendment. Applicant concurs and accepts Examining Attorney's suggested modifications, and the Applicant hereby adopts the following description of the goods and services:

providing food and drink; cafes; cafeterias; canteens; restaurant services; self-service restaurants; snack-bars; bar services; catering services; food and drink catering; restaurant services with food takeaway services; rental of chairs, tables, table linen and glassware; temporary accommodation; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotels; hotel services; hotel reservations; rental of temporary accommodation; tourist home reservations; information, advisory and consultancy services relating to all the aforesaid services

4. Disclaimer:

³¹ Kishkovsky, Sophia, *For Everyone, Non-Russians too, There's a Personal Pushkin*, NY TIMES, June 5, 1999 at 9.

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The Examining Attorney advises to disclaim the term “CAFÉ” as this word appear generic in the context of the description of the Applicant’s Mark. This term was disclaimed in the original application and we agree with the Examining Attorney that such disclaimer is appropriate and the Applicant confirms the original disclaimer of the term “CAFÉ” in the Application.

5. Conclusion:

Accordingly, in light of the foregoing, Applicant respectfully asserts that Applicant’s Mark PUSHKIN is not primary merely a surname, and therefore requests that Applicant’s Mark proceed through to registration. To find otherwise would be akin to a determination that “Shakespeare” is also primarily merely a surname.

Very truly yours,



Dmitri Dubograev, Esq.

EXHIBIT A




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Alene Shakespeare [PHONE](#)
 49 Trosper Ln Lander, WY

Alexander Shakespeare [PHONE](#)
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EXHIBIT B



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Alexander Pushkin - Wikipedia, the free encyclopedia
 Alexander Sergeyevich Pushkin June 6 [O.S. May 26] 1799 – February 10 [O.S. January 29] 1837) was a Russian author of the Romantic era who is considered by ...
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 Although the vast majority of African Americans are unfamiliar with Pushkin's monumental works, most students of literature are at least aware of his ...
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The Pushkin Page - The Alexander Pushkin Home Page
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turgenev
chaucer

works, most students of literature are at least aware of his ...
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Jan 16, 2003 ... At an exam in January, Pushkin publicly declaims "Recollections at Tsarskoe Selo," which synthesizes the styles of G. R. Derzhavin and K. N. ...
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A delegation from the sister-city of Zerbst – Pushkin – took part in the ... A deputy head of Pushkin region of Saint-Petersburg Tatiana Bogolyubova noted ...
www.pushkin-town.net/pushkin/eng/index.htm - Cached - Similar

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1799 Pushkin was born in Moscow on May 26, 1799. Although his family had lost most of their political influence by the time of Pushkin's birth, he was ...
essaymania.com
1837 The Pushkin-d'Anthes duel took place on January 27, 1837. Real life continued to mirror Pushkin's verse drama, as he was fatally shot by d'Anthes.
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Tsarskoe Selo (Pushkin), St. Petersburg, Russia

Tsarskoe Selo, near Saint Petersburg, is one of Russia's most famous visitor attractions, the summer residence of the Romanov Tsars. More on Tsarskoe Selo ... www.saint-petersburg.com/pushkin/ - Cached - Similar

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Pushkin's Biography

Aleksandr Sergeevich Pushkin was born in Moscow on May 26, 1799 (Old Style). In 1811 he was selected to be among the thirty students in the first class at ... educ.jmu.edu/~pleckesg/Pushkin/Bio.html - Cached

Pushkin

On the other hand, Pushkin once wrote that 'poetry is a fiction and has nothing in common with the prose of real life,' and the paradox of Eugene Onegin is ... www.arlindo-correia.com/pushkin.html - Cached - Similar

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Pushkin (Russian: Пушкин) is a town under jurisdiction of Saint Petersburg, Russia. It is located 24 kilometers (15 mi) south from the center of St. ... en.wikipedia.org/wiki/Pushkin_(town) - Cached - Similar

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Alexander Lipnitsky comes to **Pushkin House** to talk about the history of the formation of "Akvarium" and "Zvuki Mu"; the history of the development of rock ...
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A. S. Pushkin

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English version - Государственный институт русского языка им. А.С. ...

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A Novel in Verse by Alexandr **Pushkin**, Translated from the Russian, with a commentary, by Vladimir Nabokov Bollingen Foundation, Volume I, xxvi + 345, ...
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