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RESPOND TO NEW YORK

Administrator for Trademark Identifications,
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Commissioner for Trademarks
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Re: Serial numbers	**78614104**	**78614119**
	78622413	**78614088**
	78622405	**78614073**
	78622390	**78614031**
	78622385	**78614013**
	78622375	**78622456**
	78622367	**78622446**
	78622364	**78622438**
	78622358	**78622428**
	78622346	**78622420**
	78614246	**78622400**
	78614141	**78688025**
	78614126	

Dear Sir or Madam:

We submit this Letter of Protest on behalf of an unincorporated association of Hasidic Jews, members of the "Bobov" community, headquartered and located primarily in New York State. We respectfully suggest that this Letter of Protest sets forth a prima facie basis for refusal of registration of the above-referenced alleged trademarks, such that publication for opposition without consideration of the issues raised herein would constitute clear error by the PTO.

Descriptiveness

These applications relate to four alleged trademarks: (a) "BOBOV," (b) "AD'MOR M'BOBOV," (c) "AV'DAK BOBOV," and (d) "BOBOVER REBBE."

We submit that the foregoing proposed marks are descriptive, incapable of acquiring secondary meaning, and, therefore, unregistrable.

The word "BOBOV" is derived from the origins of the "Bobov Hasidic" community in the town of Bobova, Poland (found at http://en.wikipedia.org/wiki/Bobov, June 21, 2006). In fact, "BOBOV" is merely the Yiddish rendering of "Bobova." We urge the Administrator to decline registration of "BOBOV" because "BOBOV," the name of the Hasidic dynasty in question and the main element of the majority of the referenced applications, is an unregistrable descriptive term. It has not acquired, and cannot acquire, distinctiveness, given that it describes *adherents* to a religious way of life and *members* of a faith community and does not identify a single source of goods or services.

In this regard, and as referenced in the enclosed information, we note that "Bobover Hasidim" are, by definition, members of the Bobov community. "Bobover Hasidim" may, during times when there is only one leader of the Bobov Hasidim, mean a follower of that leader, but this need not necessarily be the case. Now, for example, it is not the case, as the Bobover community has been divided into two groups since March 2005, each following a different leader. Yet, all the former followers of the unitary leadership remain, quite literally, "Bobover Hasidim," or, as they are referred to colloquially, "Bobovers."

Another usage of the term "BOBOV" is as a noun, describing "Bobovers" in the plural. A contemporary example is found in the factual situation described in the enclosed *New York Times* article, dated March 26, 2005, excerpted here:

> The Bobover rebbe died on Wednesday. It was the day before Purim, the most joyously theatrical holiday on the Jewish calendar and a particularly dear one to the Bobov Hasidim, who are perhaps the largest of the Hasidic sects in Borough Park, Brooklyn. Each year, the Bobov stage elaborate spoofs of the story of Esther, called Purimspielen, to gladden the heart of their grand rabbi.
>
> But the rebbe, Naftali Halberstam, was dead, and even worse, a succession battle loomed. He had left no sons, but he had a younger half-brother, Benzion Halberstam, and two sons-in-law.

Benzion Halberstam and one of the sons-in-law, Mordecai D. Unger, each claimed to be the anointed successor.

The article goes on to make varied descriptive use of the word "BOBOV, " without distinguishing as to which claimant to the Bobov leadership the use of the term would follow, to wit:

- *Afterward,* ***hundreds of Bobov*** *swarmed 15th Avenue, singing a Purim song and completely blocking traffic.*
- *By midmorning, many witnesses said, punches flew between the Halberstam and Unger camps in the granite-walled worship hall of the grand* ***Bobover synagogue*** *on 15th Avenue in Borough Park.*

(Emphasis added.) In each of these uses, and, in fact, in all of the uses of the variations on the term "BOBOV" in the specimens submitted by the applicant, as well as in the enclosed article, the term "BOBOV" is entirely descriptive and is not susceptible to acquiring distinctiveness. The description refers to, and describes, adherents to a cultural, familial, and religious tradition, not to any individual institution nor to the leadership of any individual person.

This convention is consistent across other Hasidic groups. Thus, utilizing, for convenience's sake, entries in Wikipedia, on which applicant has relied extensively in its submissions, the following usages, merely exemplary, indicate the descriptive nature of the names of Hasidic sects:

- *Today there are two Grand Rebbes of Alexander, one in Bnei Brak, E. Israel, and one in America in the Boro Park section of Brooklyn, New York.* (Found at http://en.wikipedia.org/wiki/Aleksander_%28Hasidic_dynasty%29, June 21, 2006).
- *After the passing of Rabbi Moshe[,] three of his sons and one of his sons-in-law were declared Grand Rabbi by their [respective] congregations. Rabbi Aaron Teitelbaum became the Satmar Rebbe in Kiryas Joel and Wiliamsburg, Rabbi Lipa Teitelbaum is Zenta Rebbe in Williamsburg, Rabbi Zalman Leib Teitelbaum also became Satmar Rebbe in Williamsburg, and Rabbi Chaim Shia Halberstam became Satmar Rebbe in Monsey.* (Found at http://en.wikipedia.org/wiki/Satmar_%28Hasidic_dynasty%29, June 21, 2006).

See also the enclosed *New York Times* article discussing succession disputes among various Hasidic sects.

These usages demonstrate that, like "Satmar Hasidim" and "Alexander Hasidim," the term "Bobov Hasidim" is meant to refer to the community of persons associated with "Bobov," just as the word "BOBOV" itself lends similar descriptive meaning to institutions, customs, and other concomitant elements of a given Hasidic group's way of life. Indeed, dictionaries utilize these terms as descriptions, not as source-identifying trademarks, as well. Thus, the American Heritage® Dictionary of the English Language defines the term "Lubavitcher" as "A member of a Hasidic community founded in Russia in the late 18th century that stresses the importance of religious study." (See enclosed.) There is no reference in the definition to a "single source," a particular leader or institution (and indeed Lubavitch Hasidim have split more than once), nor to membership in any particular entity amenable to trademark ownership. Rather, the word defines "a . . . community."

For this reason, "BOBOV," a descriptive, non-distinct term which defines members of the Bobov Hasidic community, should not and cannot be registered as a trademark by any particular person, institution, group, or sub-group within or without the Bobov community. Indeed, while the customs of Bobover Hasidim are not at all a religion separate from so-called ultra-orthodox Judaism as practiced by many non-Bobovers, the rule enunciated by Professor McCarthy at § 9.7 of his definitive trademarks treatise, that "The name of a religion may become an unprotectable generic name of any religion that follows certain principles," clearly applies here, merely substituting "sub-group within a religion" for the word "religion."

The Acronym Applications

All 25 "BOBOV" applications referenced above incorporate the term "BOBOV." Nine of them consist only of that term alone. Five of the referenced applications (78622413, '405, '400, '390, and '385), however, add the title "AV'DAK" to the term "BOBOV" ("AV'DAK BOBOV"). Similarly, another five (78622375, '367, '364, '358, and '346) add the title "AD'MOR" ("AD'MOR M'BOBOV"), and yet another five (78622456, '446, '438, '428, and '420) add the title "REBBE" ("BOBOVER REBBE"). We submit that registration should not be granted to these proposed marks because they are descriptive religious titles and are neither amenable to trademark protection nor to secondary meaning.

"BOBOV," as explained above, is the Yiddish-language derivative of the name of the city in Poland called "Bobova" (in Polish), and is a descriptive term not admitting of registration.

The title "AV'DAK" is the English transliteration of a Hebrew-language acronym for a title of a Rabbinic functionary, "*Av Beis Din, K'hal*," meaning the Chief Justice (literally, Head of Court) of the community/congregation (in this case, of Bobov). As such, it is a Hebrew-language common noun which refers to the chief judicial officer in a community/congregation who is charged with the responsibility of interpreting and administering the tenets of Jewish law in the community/congregation and overseeing a range of other and related religious functions.

Likewise, the title "AD'MOR" is also the English transliteration of a Hebrew-language acronym for another title of a Rabbinic functionary, "*Adoneinu, Moreinu v'Rabbeinu*," meaning, literally, Our Master, Our Teacher, and Our Rabbi. As such, it, too, is a Hebrew-language common noun which refers to, and is associated exclusively with, the head of a community/congregation within the Hasidic branch of the Jewish religious world and denotes a spiritual leader of followers and who personifies great qualities of piety, spirituality, and learning.

Similarly, an alternative appellation for a leader of a Hasidic group (*i.e.*, "AD'MOR"), in both the Hebrew and Yiddish languages, is "REBBE," and this term, therefore, is an exact English translation.

The terms "AV'DAK BOBOV," "AD'MOR M'BOBOV," and "BOBOVER REBBE" are merely composite phrases which signify and constitute religious titles and functions associated with the religious leaders of the Bobov community and which are no more susceptible to trademark protection than are the descriptive, titular acronyms standing alone.

Attached are a number of articles that discuss these common, descriptive usages, demonstrating that these acronyms have achieved usage in Hebrew as common nouns, specifically titles used for persons. The two Hebrew-language acronyms describe, respectively, any chief judge or any Hasidic *rebbe*. Being simply descriptive, they cannot in any way add to the descriptive nature of the "BOBOV" device itself, any more than the English titles "Chief Judge," "Grand Rabbi," "King," "Queen," or "Prince" are amenable to trademark protection or

secondary meaning. Quite obviously, the same applies to the title "REBBE" itself.

Constitutional Considerations

Registration of the proposed marks also should be refused for constitutional reasons. As is evident from the attached articles, the Bobov community has been subject to a schism since March 2005, and all issues between the two groups involved in the schism are currently the subject of proceedings in a Jewish court of law (*Beth Din*), which is charged with determining all matters in issue, including entitlement to use of the terms which are the subjects of this Letter. Indeed, issues such as these are inherently and quintessentially religious in nature and are only capable of being determined by a religious tribunal. We submit that the Administrator should be loath to permit the Patent and Trademark Office to become embroiled in an internecine controversy that is, in essence, a religious dispute with constitutional overtones.

Given the foregoing, it is submitted as well that the applications should be refused registration because the entire Bobov controversy is enmeshed in First Amendment complications. It is well established that the trade names of religious organizations may be granted trademark protection. TE-TE-MA Truth Foundation—Family of URI, Inc. v. World Church of Creator, 297 F.3d 662 (7th Cir. 2002), cert. denied, 537 U.S. 1111 (2003). Courts deciding subsidiary issues that merely coincide with intramural religious disputes may do so despite the coexistence of such disputes, as long as they are ultimately applying nothing more than "'neutral principles' of secular law without undue entanglement in issues of religious doctrine." Merkos L'inyonei Chinuch, Inc. v. Otsar Sifrei Lubavitch, Inc., 312 F.3d 94 (2nd Cir. 2002).

Here, however, the PTO is not being asked in any way to decide who owns a given Bobov-associated building, institution, or charity fund. It is simply being asked to decide, based on the thin submissions of the applicant here, "Who is 'AV'DAK BOBOV,' who is 'AD'MOR M'BOBOV,' and who is the 'BOBOVER REBBE?'" and, more generally, who is entitled to the name "BOBOV," and, therefore, ultimately, who is a "BOBOVER." Again, quoting Professor McCarthy, "it may be an encroachment on religious freedom for a court to deprive a party of trademark rights because it did not conform to certain religious tenets." *Id.* at 9-18. The PTO should simply not allow itself to be put in the position of enforcer for one side in an internal dispute as to leadership – one which, moreover, is only capable of being decided by a religious tribunal

applying religious law - placing dissenting members of an ancient religious group at risk of serious statutory penalties and massive legal fees merely to describe themselves as what they are: Hasidim of "BOBOV."

The situation presently before the PTO recalls, and has strong analogies in, a dispute over the succession of the late Skolyer Rebbe, following his passing in 1979. In litigation in the Federal District Court, arising under the New York Religious Corporations Law and the New York General Business Law (Congregation Beth Yitzchok v. Briskman, 566 F. Supp. 555 (E.D.N.Y. 1983)), the Court was, as in this case, confronted with issues that were inextricably intertwined with, and dependent upon, the question of who was the successor to the Skolyer Rebbe. As Judge McLaughlin put it:

> Such an examination in this case leads ineluctably to the conclusion that resolution of the allegations in the complaint first demands that I determine the proper succession to the post of Skolyer Rebbe. As tempting as that invitation may be, it does not appear to be the proper role of a federal court.

Nor, we would add, is it the role of the Administrator for Trademarks to determine the analogous questions in the case of Bobov. *A fortiori*, when all the relevant questions are presently being decided in the only tribunal that is capable of deciding them, namely a Jewish court of law (*Beth Din*). In the Skolyer case, Judge McLaughlin dismissed the proceedings for want of justiciability. The same conclusion should be applied, by analogy, in this instance.

The constitutional principles, underscoring the inadmissibility of involvement in inherently religious issues, were reiterated just a matter of months ago, by the Appellate Division of the Second Department, Supreme Court of New York, in the Matter of Congregation Yetev Lev D'Satmar, Inc., 2006 NY Slip Op. 05627 (enclosed).

Finally, we submit that the development of the law regarding the use of the names of American Indian tribes as trademarks is instructive herein and further demonstrates why the applications must be refused registration. The Indian Arts and Crafts Act, 25 U.S.C. §§ 305 *et seq.*, forbids selling a good "in a manner that falsely suggests it is . . . an Indian product." § 305e(a). The constitutionality of this narrow, remedial legislation, meant to protect consumers at large as well as Native Americans, was recently upheld by the Seventh Circuit

Court of Appeals in Native American Arts, Inc. v. The Waldron Corporation, --- F.3d ---, 2005 WL 475357 (March 2, 2005) (7th Cir.). Significantly, however, Congress saw fit to pass specific legislation authorizing the PTO to address the special situation of Indian tribes, recognizing that the Lanham Act itself did not equip the PTO to enforce false advertising principles regarding Indian tribes – even though the government maintains an official registry of Indian tribes. Needless to say, the U.S. government does not, and constitutionally could not, maintain a list of Hasidic sects by which it could step in to enforce "Hasidic genuineness" in the provision of goods and services provided by Hasidic groups.

Even regarding the genuineness of Indian goods, the Lanham Act could not serve as an enforcement mechanism. Congress recognized the need for a special legislative mandate. Yet, in essence, what the applicant here seeks is to make the PTO precisely what Congress recognized it could not be in the case of the Indian tribes: An arbiter of genuineness as to ethnic, cultural, or religious claims. The constitutional barriers to such a scenario are themselves ample reason to deny registration.

Pending Litigation

An alternative basis for refusal, or at least suspension, of registration is the aforementioned fact that there is now pending litigation in the Supreme Court of the State of New York, Kings County, Index No 12509/05, and, concomitantly, in a Jewish court of law (*Beth Din*) involving the competing Bobov groups. The existence of this litigation is obviously relevant to the right of the applicant to register the marks in the applications that are the subject of this Letter of Protest because among the subjects of the litigation is who has the right to the very titles which are the proposed marks for which applicant has applied herein.

On May 13, 2005, a hearing was held before the Honorable Herbert Kramer, at which time the parties stipulated to resolve all disputes pertaining to who has the right to the title of Grand Rabbi of Bobov in a *Beth Din*. (See p. 3 of the May 13, 2005, transcript, a copy of which is attached hereto.) In fact, the parties currently are involved in *Beth Din* proceedings to decide, *inter alia*, who has the right to the aforementioned titles, which are the subjects of this Letter, and Judge Kramer has retained ultimate jurisdiction over the matter pursuant to New York Civil Practice Law and Rules Article 75. (See transcript at pp. 9-10.)

Accordingly, the pending litigation in New York[1] and in the *Beth Din* directly affects the applicant's right to register the marks herein, and, therefore, the registration should be refused or, at least, the application suspended.

Conclusion

For the foregoing reasons, it is respectfully submitted that the Administrator should deny registration to the referenced applications.

Very truly yours,

Ronald D. Coleman

[1] We note that Mr. Abraham Leser, author of the declaration of acquired distinctiveness submitted in response to the Office Action in connection with these applications, is a named defendant (as "Avrum A.") in the New York Supreme Court litigation.