

RESPONSE TO OFFICE ACTION

To Commissioner for Trademarks:

Mark: PENN STATION

Serial No.: 88/344,464

Our Ref. No.: T33825US00 (343249.20115)

RESPONSE TO OFFICE ACTION NO. 2

Applicant respectfully submits the following response to the office action issued on November 2, 2019. While Applicant maintains that the Examiner is in error and that the proposed mark is not geographically descriptive, Applicant has submitted an allegation of use and 2(f) claim of acquired distinctiveness. Applicant submits that the Application is now acceptable and in condition for approval on the principal register.

BACKGROUND

Applicant's pending application for PENN STATION covers the following goods:

- PENN STATION (Ser. No. 88/344,464) ("Applicant's Mark") for "Railroad transportation services; providing specialized facilities for mass transit for the general public; transportation reservation services; transportation information; transportation of goods and passengers" in Class 39 ("Applicant's Services").

On June 5, 2019, Examiner issued a non-final office action refusing registration on the grounds that the mark is "primarily geographically descriptive" in nature and thus not eligible for registration on the principal register without a showing of acquired distinctiveness. Applicant responded against the refusal on October 11, 2019, submitting that the PENN STATION mark is the name of a "coined location" owned by Applicant, and thus not primarily geographically descriptive per TMEP § 1210.02(a). On November 2, 2019, the Examiner issued a subsequent final office action maintaining the geographically descriptive objection.

Applicant believes the Examiner's conclusion is in error, and that as a "coined location," the PENN STATION mark cannot be primarily geographically descriptive. The original station took the name of its owner and builder, the Pennsylvania Railroad in 1910. As such, the mark's primary significance is not geographic. However, in the interest of moving this application along, Applicant submits the following explanation in support of its request for registration on the Principal Register based on acquired distinctiveness under Section 2(f).

ACQUIRED DISTINCTIVENESS CLAIM

Applicant has submitted an allegation of use prior to submission of this response. Applicant respectfully requests that the Examiner approve the allegation of use and accept a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). Specifically, Applicant submits that the proposed mark PENN STATION has been in use since at least as early as 1971, and the term PENN in PENN STATION is reference to Pennsylvania Railroad, the original owner of the station and thus Applicant owns trademark rights in the phrase. As such, Applicant submits that it has made a *prima*

facie showing of acquired distinctiveness based on five years' use of the same mark with sufficiently similar or related goods or services. See TMEP 1215.05; and 37 C.F.R. §2.41(a)(2). In this response, Applicant states that "[t]he mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." Applicant has thus made its *prima facie* case for acquired distinctiveness under TMEP § 1212.05.

Applicant, National Railroad Passenger Corporation ("Amtrak"), states for the record that it has made substantially exclusive and continuous use in commerce of the PENN STATION mark for at least 49 years. This period is nearly ten times the five-year-period required to establish a *prima facie* case of acquired distinctiveness under Section 2(f). In support of its claim, Applicant submits Amtrak timetables showing use of the mark in connection with train schedules and related information dating back to at least 1971. **Exhibits A–E.** The station serves Long Island Rail Road, New Jersey Transit commuter rail, and the New York City subway (MTA) in addition to Amtrak's own trains. **Exhibit F.** More than 10 million passengers travel through the station each year, with more than 650,000 commuters passing through its concourses every day. **Id.** Amtrak's long-term use of the PENN STATION mark and the station's extensive ridership has led consumers to recognize the PENN STATION mark as a trademark and identifier for Applicant's services in the transportation industry. Accordingly, Applicant's Mark has acquired the requisite distinctiveness for registration.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the Examiner accept its claim of acquired distinctiveness for the PENN STATION mark and permit Applicant's Mark to proceed to publication.

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Respectfully submitted on behalf of Applicant:

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