


CORCORAN, CORCORAN GROUP, and *CORCORAN*

(Serial Nos. 88242626, 88242635, 88164619, 88164623, 88164625, and 88164626)

Response to Office Action

The Examining Attorney has issued identical Office Actions regarding Applicant’s applications for CORCORAN, CORCORAN GROUP, and *CORCORAN* (Serial Nos. 88242626, 88242635, 88164619, 88164623, 88164625, and 88164626, collectively “Applicant’s Marks”), rejecting them on the grounds that each mark is primarily merely a surname under Section 2(e)(4) and suggesting that Applicant amend each application to seek registration under Section 2(f). As addressed in more detail below, Applicant respectfully asserts that these refusals are inappropriate because 1) Applicant’s Marks, as used in connection with the services covered, are inherently distinctive, and 2) a review of the USPTO Registry makes it clear that the surname refusal has been inconsistently applied across CORCORAN formative marks, and that more often than not, no 2(f) claim of acquired distinctiveness has been required. Applicant therefore asserts that no 2(f) claim should be required for Applicant’s Marks and that these refusals should be withdrawn and Applicant’s Marks permitted to pass to publication as filed.

Applicant does not deny that, as the Examining Attorney points out, it owns four (4) CORCORAN formative registrations that already contain a claim of acquired distinctiveness under Section 2(f). However, those marks were registered in 2000, 2001, 2002, and 2008, all between nearly 11 and 19 years ago. Furthermore, Applicant also owns four (4) registrations that do not contain a Section 2(f) claim of acquired distinctiveness, three (3) of which were registered much more recently, in 2015:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>
CORCORAN WEXLER	2576142	June 4, 2002
CORCORAN SUNSHINE	4772592	July 14, 2015
 C S CORCORAN SUNSHINE & Design <i>corcoran sunshine</i>	4844204	November 3, 2015

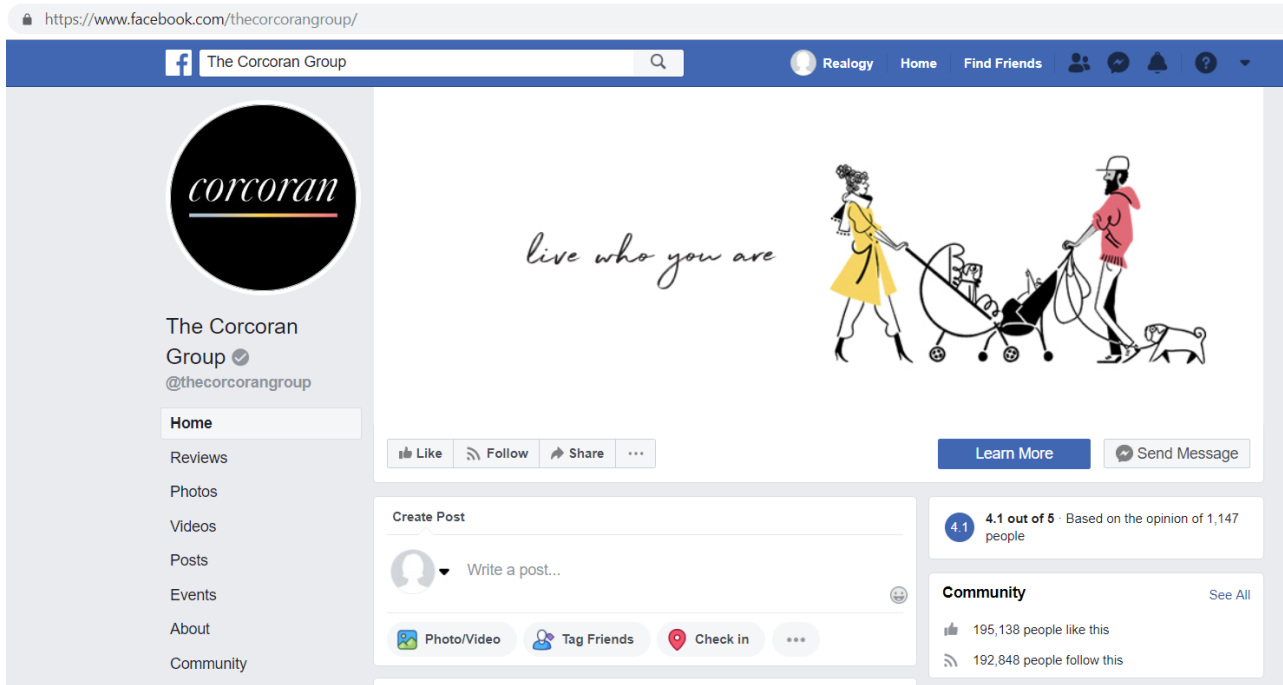
CS CORCORAN SUNSHINE MARKETING GROUP &  Design <i>corcoran sunshine</i> <small>MARKETING GROUP</small>	4844205	November 3, 2015
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The four (4) marks listed above represent exactly half of Applicant’s current CORCORAN formative registrations. So, 50% of the time, the USPTO has not required a 2(f) claim in Applicant’s registrations. Plus, it has been almost eleven (11) years since Applicant was required to enter a Section 2(f) claim of acquired distinctiveness. In those nearly eleven (11) years since Applicant has had to claim acquired distinctiveness, and in the forty-six (46) years since first commencing use of the word CORCORAN in connection with real estate services, Applicant’s business has expanded tremendously and has become extremely well-known throughout the United States. As the Examining Attorney noted, “An applicant’s mark is primarily merely a surname if the surname, when viewed in connection with the applicant’s recited goods and services ‘is the primary significance of the mark as a whole to the purchasing public’”. CORCORAN, as used in connection with real estate related services, is no longer primarily merely a surname. Rather, its primary significance to the purchasing public is as a reference to Applicant. CORCORAN, as used for real estate related services, is now inherently distinctive, and there is significant evidence to support this fact.

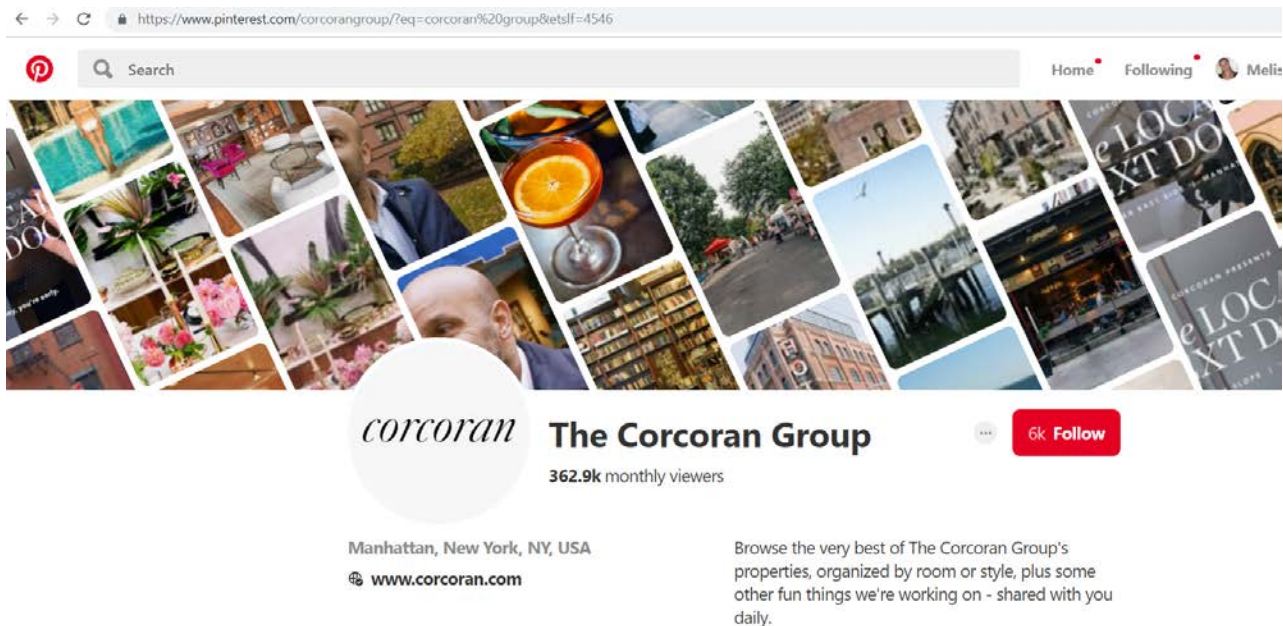
First, an analysis of the USPTO Registry demonstrates Applicant’s dominance in its use of the word CORCORAN. As of March 14, 2019, there are twenty (20) active marks on the USPTO Register that contain the word CORCORAN, six (6) of which are the pending applications for Applicant’s Marks and eight (8) of which are Applicant’s other registrations. Applicant therefore owns fourteen (14) of twenty (20), or exactly 70% of the CORCORAN formative marks on the Registry. This demonstrates Applicant’s clear predominance in its use of the word CORCORAN as a trademark in the United States. Even if we don’t include the newly filed applications, then Applicant owns eight (8) of the fourteen (14) CORCORAN formative registrations, which is still more than half.

Some simple Internet research also supports Applicant’s assertions. When one types the ‘Corcoran’ alone into Google, the very first result is Applicant’s website and the third result is TheRealDeal.com’s page dedicated to Applicant. Furthermore, as of March 14, 2019:

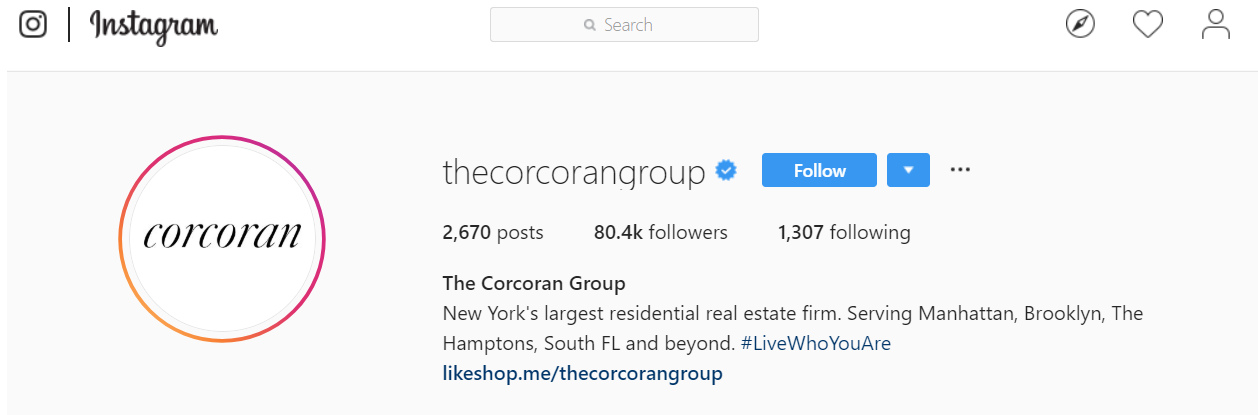
1. Applicant's Facebook page is followed by 192,848 people and liked by 195,138 people:



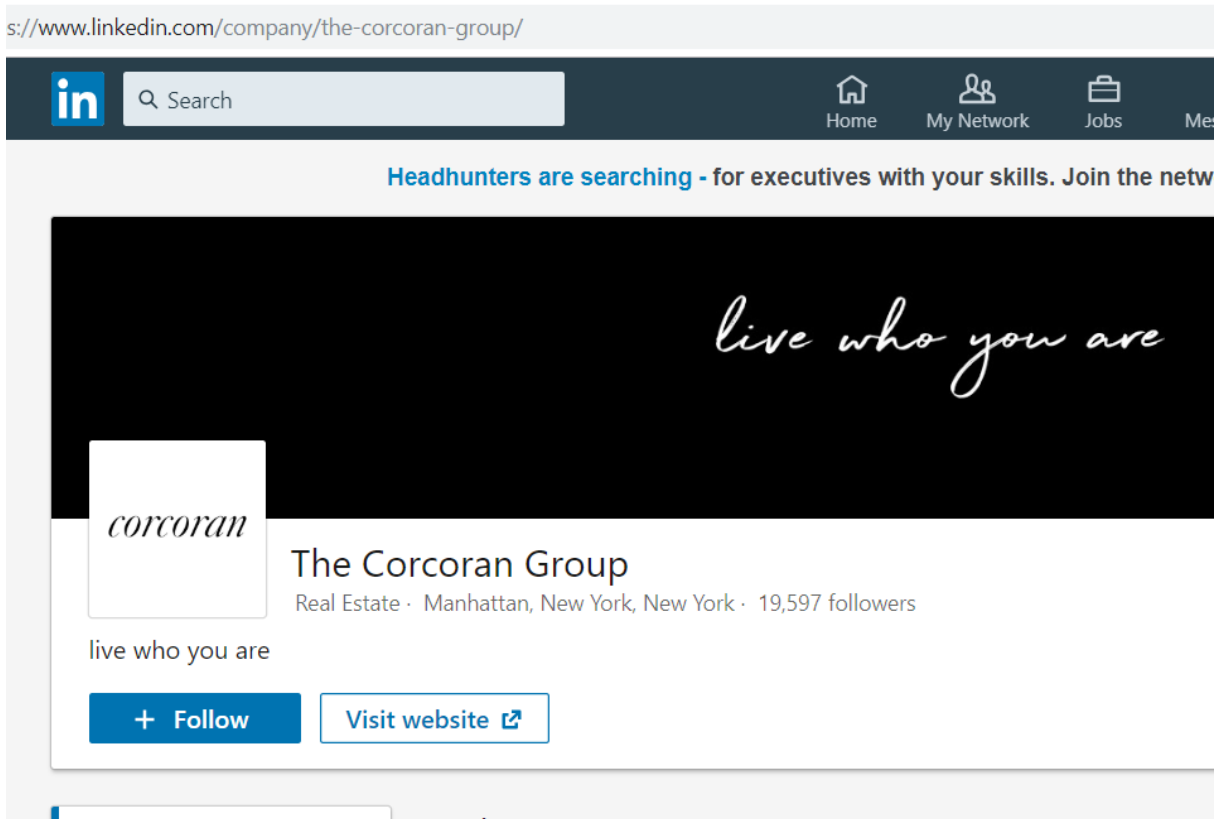
2. Applicant has over 362,000 monthly viewers on Pinterest:



3. Applicant has over 80,000 followers on Instagram:



4. Applicant's LinkedIn page has almost 20,000 followers:



5. Applicant's YouTube channel has almost 10,000 subscribers, and many of the videos posted there have over 5,000 or 6,000 views each. Plus, there are videos with 17k, 26k, 34k, 109k, 155k, 167k, and 224k views each and at least one video with over a million views, as shown on the next page:


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6,422 views · 1 year ago








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 28 & 29 Payne Avenue, North Haven, New York The Corcoran Group ✓ 1.9K views · 3 years ago	 41 Halsey Lane, Water Mill, New York The Corcoran Group ✓ 6.7K views · 3 years ago	 192 Columbia Heights, Brooklyn Heights, Brooklyn, New York The Corcoran Group ✓ 26K views · 3 years ago	 3 Pierrepont Place, Brooklyn Heights, Brooklyn, New York The Corcoran Group ✓ 34K views · 3 years ago	 870 United Nations Plaza, Apt. 24DE, Midtown East, New York The Corcoran Group ✓ 17K views · 3 years ago
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 Marcel Uses Corcoran.com to Find the Perfect Pet-Friendl... 1.1M views · 6 years ago CC	 Behind the Scenes of the 2014 Live Who You Are... 224K views · 4 years ago	 2458 National Drive, Mill Basin, Brooklyn, New York 167K views · 5 years ago	 1 Main Street, Apt. 16, DUMBO, Brooklyn, New York 155K views · 5 years ago	 684 Broadway, Penthouse 12E, Greenwich Village, New York 109K views · 6 years ago
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All of this evidence very clearly demonstrates that Applicant is extremely well-known and well-regarded and that consumers associate the word CORCORAN with Applicant, the source of real estate related services.

In addition to all of this, it is clear that the USPTO has not been consistent in applying the surname refusal or 2(f) requirement to marks containing the term CORCORAN, even beyond Applicant's Marks, which were already mentioned above. This inconsistency supports Applicant's argument that it should not have to limit its pending Applications by adding a Section 2(f) claim. Of the remaining six (6) active CORCORAN formative marks that are not owned by Applicant, none of these marks are on the Supplemental Register and only two (2) of them contain a Section 2(f) claim; meaning two-thirds of them do not. That means that, at least for the currently active marks owned by parties other than Applicant, 66.66% of the time, the USPTO has not required a claim of acquired distinctiveness under Section 2(f) when the word CORCORAN is used in trademark applications. This is true even though two of the marks were filed by applicants whose names made it abundantly clear that Corcoran was being used as a surname. The four (4) marks without a Section 2(f) claim are listed below:

<u>Mark</u>	<u>Reg. No.</u>	<u>Initial Applicant/Registrant Name</u>
CORCORAN BRAND OF QUALITY (Stylized) ("BRAND OF QUALITY" disclaimed) 	0844614	<u>Joseph F. Corcoran</u> Shoe Co., Inc.
CORCORAN FORCE	1706913	Acme Boot Company, Inc.
CORCORAN MARAUDER	1947361	H.H. Brown Shoe Company, Inc.
CORCORAN COMPLIANCE CONNECTION (COMPLIANCE disclaimed)	4389293	<u>Suzanne L. Corcoran</u> and <u>Kevin J. Corcoran</u>

Furthermore, the CORCORAN BRAND OF QUALITY, CORCORAN FORCE, and CORCORAN MARAUDER marks are all actually now owned by the same party, who also owns the two remaining active marks for CORCORAN, Reg. Nos. 1981238 and 1550264, which do contain Section 2(f) claims. At the time that CORCORAN MARAUDER was filed, it cited

prior registrations for CORCORAN FORCE and CORCORAN, Reg. No. 1550264, and when CORCORAN FORCE was filed, it cited prior registrations for CORCORAN BRAND OF QUALITY and again, CORCORAN, Reg. No. 1550264, thus making the connection between all of these marks, as well as the connection to the initial owner Joseph F. Corcoran Shoe Co., Inc. quite clear. And yet, no 2(f) claim was consistently required for these marks. Furthermore, the same series of companies that have owned these various related marks have also owned a now abandoned application for CORCORAN MG, which was approved and Allowed without a 2(f) claim, a now cancelled registration for CORCORAN MACH, which was registered without a 2(f) claim, and a now abandoned application for CORCORAN MACH IV, again approved without a 2(f) claim. So, that makes a total of six (6) marks where these parties were not required to enter a 2(f) claim for their CORCORAN formative marks.

Given all of this history, it would be unfair and inconsistent to require Applicant to limit its current pending applications with Section 2(f) claims. Therefore, the fact that the four (4) most recently registered CORCORAN formative marks, three (3) of which are Applicant's, were registered without requiring a Section 2(f) claim further supports Applicant's argument that such a claim it should not be required here. An Applicant should be able to rely on the USPTO's recent decision-making, especially in relation to its own marks, for some degree of consistency.

Based on all of the above, Applicant respectfully requests that the Examining Attorney withdraw the Office Actions issued for each of Applicant's Marks and permit them to pass to publication as filed.