

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: NYC & Company, Inc.
Marks: NYC BROADWAY WEEK design
Serial No. 88298600
Office Action Mailing Date: April 12, 2019

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Examining Attorney: Thomas Young, Law Office 120

DECLARATION OF NATALIE KOEPFF

NATALIE KOEPFF, under penalty of perjury, declares and says:

1. I am the Senior Vice President and General Counsel of NYC & Company, Inc. ("NYC & Company"). I have held this position since January 2019. From November 2008 to January 2019, I have held various positions from Senior Director to Deputy General Counsel of NYC & Company. Pursuant to contract, NYC & Company is the exclusive licensing agent for the trademarks of New York City and its agencies. Prior registrations for NYC stylizations are owned by NYC & Company, including U.S. Registration Nos. 3574986, 3667168 and 3846983. Copies of Applicants prior registrations featuring the NYC stylization are attached as Exhibit A hereto.

2. The NYC BROADWAY WEEK mark reflected in Application Serial No. 88298600 was first used in commerce since January 2019 in conjunction with our domestic and international marketing, promotion and advertising campaigns, and from its date of first use until the present, the mark has been in substantially exclusive and continuous use in commerce for those services. Goods and services provided under the mark are available locally in New York City, throughout the United States and world-wide through 18 representatives in 25 foreign countries. The mark is used to identify

NYC & Company and to draw visitors to New York City from other locations in the United States and abroad. Consumers access or learn of NYC & Company's services through our website, media and other advertising in New York City, the United States and abroad.

3. As General Counsel, it is my responsibility to oversee various legal issues involving Applicant. Accordingly, because Applicant is the exclusive licensing agency for the trademarks and service marks of the City, I work closely with the City's Corporation Counsel or Law Department.

4. The City is the owner of various stylized NYC marks as referenced in the accompanying Response to Priority Office Action dated August 13, 2019 and filed in conjunction with this Declaration.

5. The NYC stylization featured in the mark is used pursuant to license between the City and the Applicant. A copy of the License Agreement dated August 7, 2012 with respect to the NYC stylized marks is attached as Exhibit B hereto. The License Agreement indicates that NYC & Company is entitled to retain ownership of NYC stylizations and to file further applications as was the City entitled to do.

6. The NYC stylization and other marks are the subject of an Assignment Agreement between the City and NYC & Company dated August 20, 2012 and attached as Exhibit C hereto. I am informed that the Assignment has been recorded with the United States Patent and Trademark Office in connection with relevant registrations to reflect what NYC stylization are owned by the City and used under license by NYC & Company.

7. Further, the City and NYC & Company have entered into a Consent Agreement dated July 2014 regarding use of marks including the NYC stylization featured in the instant Application which is attached as Exhibit D. As set forth in the Consent Agreement attached as Exhibit D, the City consents to the registration of the Mark with the United States Patent and Trademark Office for the services claimed in the Application. Paragraph 4 of the Consent Agreement expressly states that registrations for NYC stylizations by NYC & Company were contemplated.

8. To date, the Applicant has not experienced any actual confusion arising from the co-existence in commerce of the NYC Marks and the Mark or other stylized NYC marks registered to NYC & Company for services its provides under license.

9. Further, and to the best of my knowledge, my colleagues at the Corporation Counsel or Law Department have not experienced any complaints of actual confusion in the co-existence in commerce of the aforementioned marks.

10. Given the close relationship between the City and NYC & Company, in the unlikely event that any actual confusion should occur, both my legal team at NYC & Company and our colleagues at the Corporation Counsel or Law Department will work closely together to remedy them as stated in paragraph 3 of the Consent Agreement attached as Exhibit D.

11. In order to avoid any confusion or mistake as to ownership of the Mark, NYC & Company clearly describes on its website and other promotional materials what its relationship is with the City and the Mark is used to indicate that NYC & Company is the official licensed agent of the City: <https://business.nycgo.com/about->

us/who-we-are/. Use of the Mark is by Applicant and identifies Applicant alone. No evidence of confusion as to NYC & Company's ownership and use of the Mark has occurred.

12. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the applications or any resulting registrations, declares that he is authorized to execute this instrument on behalf of applicant and that the facts set forth in this Application are true; that all statements made of his own knowledge are true; and that all statements made on information and belief are believed to be true.

Dated: New York, New York
August 13, 2019


NATALIE KOEPF