

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: AUSTIN HOME & GARDEN SHOW  
Serial No.: 88368504  
Filing Date: April 2, 2019  
Applicant: Marketplace Events, LLC  
Trademark Tracy Whittaker Brown  
Examining Attorney: Law Office 111

**RECITALS**

This communication responds to the Office Action mailed May 15, 2019 concerning App. Ser. No. 88368504 (the “Application”) for the mark AUSTIN HOME & GARDEN SHOW (“Applicant’s Mark”).

The Trademark Examining Attorney has rejected applicant’s claim of acquired distinctiveness, Trademark Act Section 2(f) based on five years’ substantially exclusive and continuous use of the mark in commerce. Applicant respectfully disagrees with this rejection for the reasons identified below.

**RESPONSE**

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as prima facie evidence that the mark has acquired distinctiveness as used in commerce with the applicant’s goods or services. While the statute does not require the USPTO to accept five years’ use as prima facie evidence of acquired distinctiveness, the evidence is typically accepted unless the mark is highly descriptive.

Examples of highly descriptive marks include nearly generic marks such as RADIO CONTROL BUYERS GUIDE, PROTECTIVE EQUIPMENT (for burglar and fire alarms and fire alarm surveillance services) and ALPINE SPRING WATER. For these marks, which are borderline generic, the primary significance of the terms in the mind of consumers would likely be the product, not the producer. There is very little about the marks that would distinguish the producers from competitors. It makes sense to require additional evidence of acquired distinctiveness before granting the owners exclusive rights to the terms. AUSTIN HOME & GARDEN SHOW is certainly capable of identifying a particular consumer show in Austin produced by a particular show producer.

The secondary meaning requirement “subjects geographic terms to a ‘market test’ of that competitor need, since substantial use of the terms by competitors will prevent secondary meaning from ever arising.” Robert Brauneis & Roger E. Schechter, *Geographic Trademarks and the Protection of Competitor Communication*, Vol. 96 TMR (2006). Here, there are other variations of the trademark competitors might use to identify similar services, such as AUSTIN

HOME & LANDSCAPE SHOW, AUSTIN HOME SHOW, AUSTIN HOME AND REMODELING SHOW, etc. Applicant’s combination of terms is easily capable of acquiring distinctiveness. In light of this, AUSTIN HOME & GARDEN SHOW is certainly capable of identifying a particular consumer show in Austin produced by a particular show producer.

Further, the US Patent and Trademark Office generally doesn’t treat geographically descriptive marks as “highly descriptive.” *See John Edward Guzman d/b/a Club Ed Surf School and Camp v. The New Santa Cruz Surf School, LLC*, Opposition No. 91220843 (October 13, 2017) (SANTA CRUZ SURF SCHOOL “has an ordinary level of descriptiveness and that a declaration attesting to substantially exclusive and continuous use of a designation as a mark in commerce for the five years before the date on which the claim of distinctiveness is made may establish acquired distinctiveness of Applicant’s designation.”)

And, the fact that no one else has used the designation in question for five years provides good evidence of lack of competitor need for the wording.

Finally, Applicant requests that the Examining Attorney treat this application in a manner consistent with the registrations identified below, Certificates of Registration are attached hereto as Exhibit A, by Applicant that are conceptually similar to the applied for mark in which the USPTO accepted five years’ use as prima facie evidence of acquired distinctiveness.

The U.S. Patent and Trademark Office rules and regulations reflect a policy of consistency. *See* TMEP 702.03(a)(ii) (requiring that companion applications be treated consistently unless it would be clear error to do so) and TMEP 713.01 (requiring examining attorneys assigned to applications previously assigned to a different examining attorney to act consistently with the first examining attorney unless clearly inappropriate to do so). While these provisions are not directly applicable to the present situation, the general policy of consistency suggests that the previous determination of the U.S. Patent and Trademark Office be given weight. Applicant respectfully requests that the Examiner treat this application in the same manner that is consistent with the registrations below and accept Applicant’s 2(f) claim as submitted.

Registrations owned by Applicant that include a 2(f) claim where five years’ use was accepted as prima facie evidence of acquired distinctiveness:

<b>Trademark</b>	<b>Registration Number</b>	<b>Registration Date</b>
ATLANTA HOME SHOW	1428673	10 Feb 1987
ATLANTA HOME SHOW and Design	5631876	18 Dec 2018
AUSTIN SPRING HOME & GARDEN SHOW	3271844	31 Jul 2007
BIRMINGHAM HOME + REMODELING SHOW	4738123	19 May 2015
BIRMINGHAM HOME SHOW	4525853	06 May 2014
BUFFALO HOME & GARDEN SHOW	2695004	11 Mar 2003
BUFFALO HOME SHOW	5680602	19 Feb 2019
CINCINNATI HOME & GARDEN SHOW	1997851	03 Sep 1996
DENVER HOME SHOW	4712260	31 Mar 2015
DES MOINES HOME + GARDEN SHOW	4653027	09 Dec 2014
FAIRGROUNDS SOUTHERN IDEAL HOME SHOW	5678357	19 Feb 2019

FALL ATLANTA HOME SHOW & OUTDOOR LIVING EXPO	5631721	18 Dec 2018
INDIANA FLOWER & PATIO SHOW	5208977	23 May 2017
INDIANAPOLIS HOME SHOW	4667724	06 Jan 2015
JACKSONVILLE HOME + PATIO SHOW	4734595	12 May 2015
JOHNSON COUNTY HOME & GARDEN SHOW	4536855	27 May 2014
MINNEAPOLIS HOME + GARDEN SHOW	4653026	09 Dec 2014
MINNESOTA HOME & PATIO SHOW	5627898	11 Dec 2018
NORTH ATLANTA HOME SHOW	5626817	11 Dec 2018
NORTH ATLANTA HOME SHOW & OUTDOOR LIVING EXPO	5631722	18 Dec 2018
OKLAHOMA CITY HOME + GARDEN SHOW	4653025	09 Dec 2014
ORLANDO HOME SHOW	4652781	09 Dec 2014
PHILADELPHIA HOME SHOW	4716473	07 Apr 2015
RALEIGH FALL HOME SHOW	4636061	11 Nov 2014
RALEIGH SPRING HOME SHOW	4636060	11 Nov 2014
RICHMOND HOME & GARDEN SHOW	3906475	18 Jan 2011
RICHMOND HOME SHOW	5160219	14 Mar 2017
SOUTHERN IDEAL HOME SHOW	5299653	03 Oct 2017
SOUTHERN SPRING HOME & GARDEN SHOW (Logo)	5226641	20 Jun 2017
SOUTHERN SPRING HOME & GARDEN SHOW	5203593	16 May 2017
TACOMA HOME AND GARDEN SHOW	1690471	02 Jun 1992
THE OKC HOME + OUTDOOR LIVING SHOW	5684030	26 Feb 2019

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Applicant believes that it has resolved all outstanding issues with the Application at this time, but encourages the Trademark Examining Attorney to reach out to Kelly Weiner at [kweiner@kellyweinerlaw.com](mailto:kweiner@kellyweinerlaw.com) or 212.360.2307 with any questions