

## RESPONSE TO OFFICE ACTION

To Commissioner for Trademarks:

Mark: PENN STATION

Serial No.: 88/344,464

Our Ref. No.: T33825US00

### **BACKGROUND**

Applicant, National Railroad Passenger Corporation (“Amtrak”), has a pending application for the following mark:

- PENN STATION (Serial 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”).

The Examiner issued an Office Action on June 5, 2019, asserting that PENN STATION was primarily geographically descriptive under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); see TMEP §§1210, 1210.01(a) (“Section 2(e)(2) Refusal”) because they believe that Applicant’s Mark is primarily geographically descriptive of the origin of Applicant’s Services.

Applicant respectfully disagrees with the Examiner’s assessment and submits that PENN STATION is a specific and coined location that is wholly owned by Applicant. As such, Applicant submits that PENN STATION is not primarily a geographic location, but is instead protectable under TMEP § 1210.02(a).

### **SUMMARY OF ARGUMENTS**

Applicant respectfully provides the following summary list of arguments in support of withdrawing the refusal:

- PENN STATION is a coined location that is owned by Applicant.
- TMEP § 1210.02(a) specifically states that coined locations are not *primarily* geographically descriptive, and the Examiner erred in issuing this objection.
- The primary significance of Applicant’s Mark is not geographic, but functions as a source indicator.
- PENN STATION refers to Applicant’s building and is used by Applicant in connection with the offering of goods and services.
- The evidence submitted by the Examiner fails to establish that the mark is primarily geographically descriptive. In fact, the Examiner’s evidence supports Applicant’s position that the location is wholly owned by Applicant, and thus, is registrable.

- USPTO policy and case law require that any doubt should be resolved in favor of Applicant.

Based on the foregoing arguments, which we have elaborated on in more detail below, Applicant respectfully requests that the Examiner withdraw the current objection and approve Applicant's Mark for publication.

## **ANALYSIS**

### **1. SECTION 2(e)(2) REFUSAL – Examiner Incorrectly Concludes that Applicant's Mark is Primarily Geographically Descriptive**

The Examiner refused registration of Applicant's Mark, PENN STATION (Serial No. 88/344,464), as primarily geographically descriptive of the following services:

- "Railroad transportation services; providing specialized facilities for mass transit for the general public; transportation reservation services; transportation information; transportation of goods and passengers" in International Class 39.

The Examiner based the refusal on the conclusion that:

- "[A]pplicant's services are provided in Pennsylvania, and consumers are likely to believe that applicant's services are provided in Pennsylvania because PENN STATION is a railroad station that provides transportation services from Pennsylvania and New York. Therefore, the term PENN is geographically descriptive."

Contrary to the Examiner's conclusion, Applicant submits that PENN STATION is not primarily geographical descriptive for the following reasons:

#### **A. PENN STATION is not primarily geographically descriptive because it refers to Applicant's building, a "Coined Location," and functions as a source indicator**

A mark is primarily geographically descriptive when (1) the primary significance of the mark is a generally known geographic location; (2) the goods or services originate in the place identified in the mark; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark. See TMEP § 1210.01(a). However, in the present case PENN STATION refers to a coined location that is owned by Applicant, Amtrak, and as such the goods and services offered by Applicant at that location primarily function as a source indicator. (***Exhibits A–C***).

A prima facie case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place known generally to the public. *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 959 (Fed. Cir. 1987). "The mere fact that a term may be the name of a place that has a physical location does not necessarily make that term geographic under § 2(e)(2)." TMEP § 1210.02(a). "To support a refusal to register geographic matter, the Trademark Act requires that the mark be primarily geographic, that is, that its primary significance be that of a geographic location." TMEP § 1210.02(b). Thus, "names of amusement parks, residential communities, and business complexes which are coined by the applicant, must not be refused." TMEP § 1210.02(a) (emphasis added) (citing *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991)).

We believe the current case is analogous to *In re Pebble Beach Co.*, in which the Board held that the term “17 MILE DRIVE,” although recognizable as identifying a specific geographic location and road, is not a ***primarily*** geographic term under Section 2(e)(2) of the Trademark Act because it refers to a location that is wholly owned by applicant and was coined by applicant to refer both to applicant's services and the place where the services were performed. 19 USPQ2d at 1688. The Board held that the fact that “17 MILE DRIVE” is well known, and that people may know the geographic area where it is located, did not make it a geographic term within the meaning of the Act. *Id.* On the contrary, the Board found that the fame of the geographic area established that “17 MILE DRIVE” functioned as a mark, especially considering the term had become recognized by the public as indicating a specific physical location as the result of the applicant's efforts (whether directly through advertising or indirectly through publicity). *Id.* at 1689

The same logic applies here. The phrase PENN STATION is a coined term that is owned by Applicant and while it is associated with a specific place, the primary significance is as a mark and not a geographic descriptor. **(Exhibit D)**. As such, Applicant submits that PENN STATION functions as a mark and consumers are likely to understand that the mark refers to the station itself, and is ***not primarily*** geographically descriptive.

**B. PENN STATION is not primarily geographically descriptive of Applicant's Services, but functions primarily as a source indicator**

The Examiner incorrectly concludes that term PENN is geographically descriptive based on the fact that Penn Station is a railway station that connects New York City with other cities including Philadelphia, Pennsylvania. Thus, “the Applicant's Services are provided in Pennsylvania, and consumers are likely to believe that Applicant's Services are provided in Pennsylvania because PENN STATION is a railroad station that provides transportation services from Pennsylvania and New York.” Given that the USPTO recognizes that it is more difficult to establish a services/place association than a goods/place association, Applicant submits that the relevant purchasers are not likely to associate the services with Pennsylvania even though the mark contains the PENN element.

If a geographic term has another meaning, the Examiner must determine whether the primary significance is geographic. TMEP § 1210.02(b)(i). However, if the most prominent meaning or significance of the mark is not geographic, or if the mark creates a separate readily understood meaning that is not geographic, registration must not be refused. See *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738(TTAB 2016) (reversing a §2(e)(3) refusal of a mark containing the wording MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK, noting that “[w]hile there is no doubt that the term SEATTLE identifies a generally known geographic location, as it is used in the context of Applicant's mark, we do not find that the relevant public would consider it to indicate of the origin of the goods”). Further, a mark that has a popular significance apart from its geographical meaning is not, in most cases, “primarily” geographical. 2 McCarthy on Trademarks and Unfair Competition, § 14:28 at 14-84 (5th Ed. 2019). In this case, Applicant's transportation station is widely recognizable and has a popular significance apart from its offering services to Pennsylvania. **(Exhibit E)**. Thus, the mark has a separate readily understood meaning apart from the geographic element of the mark. Accordingly, Applicant respectfully requests that the Examiner withdraw the 2(e)(2) refusal and approve the application for publication.

**C. The Examiner did not provide sufficient evidence to support that Applicant's Mark is primarily geographically descriptive**

The Examiner has the burden to establish that the mark is ***primarily*** geographically descriptive of the applicant's services. See *In re Roy J. Mankovitz*, 90 USPQ2d 1246, 1251 (TTAB 2009). To meet this legal requirement, the Examiner must present sufficient evidence to show that the mark is ***primarily*** geographically descriptive, which the Examiner has not done. The Examiner has merely presented evidence of the existence of the state of Pennsylvania and that consumers may take trains from Pennsylvania to PENN STATION, which is the name of a location coined by Applicant. Applicant submits that the existence of Pennsylvania does not make Applicant's Mark ***primarily*** geographically descriptive. None of the evidence submitted by the Examiner demonstrates consumer association between Pennsylvania and Applicant's Services. Indeed, the article and Wikipedia page used by the Examiner to support the claim that the station provides services to Pennsylvania actually supports Applicant's position. Both pages indicate that the station is owned by Applicant and that the name of the location was coined by Applicant. **(Exhibit F)**.

Applicant submits that "having chosen to come to that place for the services, the customer is well aware of the geographic location of the service. This choice necessarily implies that the customer is less likely to associate the services with the geographic location invoked by the mark rather than the geographic location of the service, such as a restaurant." TMEP § 1210.04(b) (citing *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1373–74, 67 USPQ2d 1539, 1541–42 (Fed. Cir. 2003)). In the case of a services/place association, a mere showing that the geographic location in the mark is known for performing the service is not sufficient. *Id.* Instead, the test requires some additional reason for the consumer to associate the services with the geographic location invoked by the mark. *Id.* Here, as the Examiner recognizes, PENN STATION is located in New York, New York. As such, consumers are aware that the location of the service is not in Pennsylvania and that the term "PENN" is not meant to be a geographic descriptor of the station's location or services.

As explained above, the primary significance of Applicant's Mark is not geographic because it has a separate readily understood meaning apart from its services in Pennsylvania, which is as the name of a location coined by Applicant. Further, consumers in New York are not likely to associate Applicant's Services in Pennsylvania. For the aforementioned reasons, the evidence provided by the Examiner is insufficient to support their position and also supports a finding against geographic descriptiveness.

**D. USPTO policy calls for publication of the application**

In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register. However, if the Examiner remains unsure he is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the Trademark Trial and Appeal Board to resolve doubt in Applicant's favor and approve for registration. See *In re Int'l Taste Inc.*, 53 USPQ2d 1604, 1605–06 (TTAB 2000) (finding doubt as to the primary significance of HOLLYWOOD because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, with the doubt resolved in favor of the applicant). Furthermore, Applicant has provided sufficient evidence showing that the mark PENN STATION is not ***primarily*** geographically descriptive of Applicant's Services. Based on the foregoing, Applicant believes that the application is otherwise ready for registration. Applicant respectfully requests that the application be approved again for publication.

**2. No Disclaimer Required – PENN STATION is Unitary and A Disclaimer is Inappropriate**

Applicant submits that the mark PENN STATION is unitary and in the current case, a disclaimer of STATION is not appropriate. The elements of Applicant’s Mark, PENN STATION, which includes the word STATION, are unitary as each of the constituent parts is essential to creating the distinct meaning and commercial impression that Applicant intended. See TMEP § 1213.05 (citing *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991)). A phrase qualifies as unitary in the trademark sense if “the whole is something more than the sum of its parts.” *Id.* This is the case where the mark “say[s] something a little different from what might be expected to be said about the product.” *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm’r Pats. 1954).

Moreover, here, as discussed in detail above, PENN STATION is a coined term and refers to a specific location owned by Applicant. As such, the phrase is unitary by nature. We believe this point is again illustrated in the Board’s decision *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991), where the term DRIVE was not disclaimed in the mark 17 MILE DRIVE even though the location was a road. Similarly, BEACH is not disclaimed in any of the PEBBLE BEACH registrations owned by Pebble Beach Company (examples include RN 3680524, 3518001, 3604966, 358302, etc.). Likewise, Applicant submits in this context that PENN STATION is unitary and as such a disclaimer of STATION would be inappropriate and the requirement should be withdrawn.

**CONCLUSION**

Based on the foregoing, Applicant submits that its PENN STATION trademark is not primarily geographically descriptive. Additionally, the Examiner has not provided sufficient evidence supporting a finding of primarily geographic descriptiveness and any doubt must be resolved in favor of Applicant. Moreover, a disclaimer in this case is inappropriate and Applicant requests that the Examiner withdraw the objections and approve the mark for publication.

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Respectfully submitted on behalf of Applicant:

Jason E. Garcia, Esq.  
Katherine M. Geldmacher, Esq.  
Reed Smith LLP  
Attorneys of Record