IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No: 88/310648

Applicant: Hudson Square District Management Association, Inc.

Trademark: HUDSON SQUARE (standard characters)

Class: 39

File No.: 481.6(US39)

Response to Office Action

Applicant respectfully responds to the Office Action dated May 2, 2019 as follows.

Refusal to Register Under Section 2(e)(2)

The Examining Attorney has issued a refusal to register under Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), contending that the applied-for mark is "primarily geographically descriptive of the origin of applicant's services." Applicant respectfully disagrees with the refusal to register for the reasons noted below:

Trademark Manual of Examining Procedure ("TMEP") Section 1210.01(a) provides the relevant test for a refusal to register on the basis that a mark is "primarily geographically descriptive." That test is as follows:

> (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. Note: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association.

Here, the mark HUDSON SQUARE is not a generally known geographic location, and thus the first prong of the test is not satisfied. The evidence provided by the Examining Attorney is relatively scant, and a very small fraction of that evidence originates in a source other than Applicant. Of the seven (7) pages of evidence, only three pages are from a source other than Applicant, and those pages consist of a map and a Wikipedia® article. Neither of those is compelling evidence that HUDSON SQUARE is generally known by consumers as a geographic location.

Because there is no such evidence, it is not reasonable to conclude that consumers would make a services/place association, and thus the third prong is not satisfied. There is no evidence that the public is likely to believe that the services originate in a particular place. TMEP Section 1210.04. Because the mark does not identify a geographic place that is commonly known, such a belief could not reasonably be formed.

For these reasons, Applicant respectfully requests that the refusal to register be withdrawn.

Claim in the Alternative:
Acquired Distinctiveness Under Section 2(f)

In the alternative, Applicant hereby submits a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). In support of this claim, Applicant also notes as follows:

Applicant does business as HUDSON SQUARE BID, pursuant to an approval granted by the New York City Council for Applicant's activities as a Business Improvement, and has used that designation for the past ten (10) years, and continues to do so. *See* Exhibit A. No other party provides such services. This is consistent with Applicant's position that the term HUDSON SQUARE uniquely identifies Applicant and its services.

Applicant's prior registrations consisted of the term HUDSON SQUARE CONNECTION. The dominant portion of that mark – to the consuming public -- is the term HUDSON SQUARE, notwithstanding the disclaimer of that term in the previous registrations (Nos. 4,326,019 and 4,682,379).

As presented in its design format that would commonly be seen by consumers in the marketplace, that mark strongly emphasized the term HUDSON SQUARE, with the term CONNECTION in a much smaller font, as shown below.

Applicant's use of the mark HUDSON SQUARE -- as its trademark shown in the present application, as the dominant component of the registered mark HUDSON SQUARE CONNECTION, and as the dominant component of Applicant's assumed name HUDSON SQUARE BID -- has been continuous and exclusive for the past ten (10) years.

Moreover, the mark HUDSON SQUARE CONNECTION in the previous registrations is the essentially the same as the applied-for mark. Those marks would certainly be considered confusingly similar to one another if they were owned by different parties. It is the "legal equivalent" of the prior registration because it creates the same continuing commercial impression. TMEP Section 1212.04(b). The dominant portion of the registrations is the term HUDSON SQUARE, which is identical to the applied-for mark. The term CONNECTIONS is a suggestive one, but relatively more common. See Exhibit B, which is a representative sample of such CONNECTION-formative service marks registered in Classes 35, 39, 41, and 44. (More than 1000 such registrations exist in the USPTO's records.)

A verified statement concerning the longstanding use of the mark, in various forms, will follow.

Conclusion

Applicant respectfully requests that the refusal under Section 2(e)(2) be withdrawn. If the refusal is not withdrawn in response to the above arguments, Applicant requests that the claim of acquired distinctiveness be accepted, so that the application can be approved for publication in due course.

Respectfully submitted,

Date: October 31, 2019

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