

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Application of: ERIE PHOTOGRAPHY
Application Serial No.: 90700505
Date of Response: August 10, 2022
Mark: ERIEPICS (standard characters)
Examining Attorney: Jacqueline Abrams
Law Office 101

RE: Response to Office Action dated February 10, 2022

Dear Examining Attorney Abrams:

This correspondence is in Response to an Office Action, dated February 10, 2022, wherein the Examining Attorney has refused registration on the Principal Register for Application Serial No. 90/700,505 (the "Application") to ERIEPICS (standard characters) based on Section 2(e)(2) – Primarily Geographically Descriptive. The Examining Attorney has alleged that the "term ERIE is geographically descriptive of the origin of the applicant's services."

A refusal to register on the ground that the applied-for mark is primarily geographically descriptive is appropriate if:

- (1) the mark sought to be registered is the name of a place known generally to the public[;] . . .
- (2) the public would make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that place [;] . . . [and]
- (3) the source of the goods is the geographic region named in the mark.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015). In the present case, the mark ERIEPICS is not primarily geographically descriptive.

Although, Erie, PA is a geographic location known to the public, the public would not automatically believe that the service for which the mark is sought to be registered originate in Erie. As indicated on Applicant's website, www.erie-pics.com, cited by the Examining Attorney, the services provided by Applicant do not necessarily originate in Erie, PA, nor are they limited to Erie, PA. As stated on the website,

Erie Photography™, ErieWedPhotos™ & EriePics™ proudly offers a large variety of Photography in Erie, PA, and the surrounding area. We are there for every pivotal moment of your life. Because those moments added together to tell the story of your life, we are there to document it for you. Indeed, you'll want to capture everything from your Engagement to your Wedding Celebration. Also, your pregnancy, newborn portraits, and cake smashing for your child's first birthday! Furthermore, we'll be there for school photos, family photography, Holiday Pictures, Senior Portraits, and even Graduation Photos in your Cap & Gown. Above all, each moment in your life sparks a memory. And that memory saved in images shines brightly as part of the epic story that is your life.

www.erie-pics.com. Applicant's services under the applied for mark are performed and originate from anywhere the customer seeks to have Applicant capture a pivotal "moment of your life", which may include Erie, PA or may not. The term "ERIE" in the mark ERIEPICS is merely suggestive of the location of the origin of the services applied for, but it is not geographically descriptive thereof, and therefore is entitled to trademark protection. George & Co., LLC v. Imagination Entertainment Ltd., 575 F.3d 383, 393–94 (4th Cir.2009).

The term ERIE is also suggestive of numerous geographical locations that are unaffiliated with Erie, PA. For example, there is Lake Erie, Erie, Colorado and Erie, Michigan. Merriam-Webster's Dictionary defines the term ERIE as:

1: a member of an American Indian people living south of Lake Erie in the 17th century

2: the extinct and probably Iroquoian language of the Erie people

"Erie." *Merriam-Webster.com Dictionary*, Merriam-Webster, <https://www.merriam-webster.com/dictionary/Erie>. Accessed 10 Aug. 2022. As is clear from the few examples provided above, the term ERIE in Applicant's ERIEPICS is suggestive, not descriptive, of the location of origin of the services applied for.

Further, there are numerous marks registered on the Principal Register that include the term "ERIE", for example, US Registration No. 4871344, for ERIE AUTO PLUS, U.S. Registration No. 4781532, for ERIEBANK, U.S. Registration No. 4077183, for ERIE FEDERAL CREDIT UNION, and U.S. Registration No. 5375543, for ERIE AUTO. The aforementioned marks are only a few of the marks that have been registered on the Principal Register and are suggestive of the origination of the services applied for. Applicant's ERIEPICS mark, like the aforementioned marks, is a suggestive mark, and therefore entitled to registration.

Should the Examiner Attorney find Applicant's arguments unpersuasive, the application has been amended to the Supplemental Register as suggested in the Office Action. Therefore, the Section 2(e)(2) refusal should be withdrawn.

It is respectfully submitted that the present application is in condition to be passed to registration and such action is solicited.

Respectfully submitted,

/s/ Darryl W. Shorter
Darryl W. Shorter

Dated: 08/10/2022