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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86321433
Applicant	PS Court Associates, LP
Applied for Mark	THE PAVILION AT KING OF PRUSSIA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: PS Court Associates, LP

Serial No.: 86/321,433

Filed: June 26, 2014 Ex Parte Appeal from Section 2(d) Refusal

For: **THE PAVILION AT KING OF PRUSSIA**

Examiner: Seth A. Rappaport

Law Office: 103

**APPLICANT’S REPLY TO EXAMINING ATTORNEY’S APPEAL BRIEF AND  
REQUEST FOR ORAL HEARING**

In response to the Examining Attorney’s Appeal Brief filed on February 2, 2016 (“ EA Appeal Brief”) in connection with this proceeding, Applicant hereby submits this brief reply.

Rather than re-hash the arguments set forth in Applicant’s Appeal Brief, which Applicant hereby incorporates by reference, Applicant takes this opportunity to briefly address the various arguments set forth in the Examining Attorney’s Appeal Brief.

First, the Examining Attorney argues that Applicant’s Mark (THE PAVILION AT KING OF PRUSSIA) is confusingly similar to the cited marks (THE PLAZA KING OF PRUSSIA, THE COURT KING OF PRUSSIA and KING OF PRUSSIA) solely because they share the geographically descriptive wording “KING OF PRUSSIA.” EA Appeal Brief at 4.

Acknowledging that the term “KING OF PRUSSIA” is a geographically descriptive term, *id.* at 5, and, thus, weak, the Examining Attorney argues that Applicant’s Mark is highly similar to the cited marks because the only difference between Applicant’s Mark is the addition of the wording “THE PAVILION AT” prior to “KING OF PRUSSIA.” *Id.* However, in making this argument,

the Examining Attorney ignores the myriad decisions where this Board has held that adding additional matter, even descriptive wording, to a descriptive mark is sufficient to differentiate the junior mark from the senior mark. *See, e.g., In re Shawnee Milling Co.*, 225 U.S.P.Q. 747, 748-49 (TTAB 1985) (“the addition of . . . other material to one of the marks has been held sufficient to render the marks as a whole distinguishable”); *In re Hartz Hotel Services, Inc.*, 2012 WL 1267900, at \*6 (quoting *Standard Brands Inc. v. Peters*, 191 U.S.P.Q. 168, 172 (TTAB 1976) for the proposition that “the scope of protection afforded [weak] marks [is] so limited as to permit the use and/or registration of the same mark for different goods or of a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods”) (emphasis added); *In re Innovative Aftermarket Systems, L.P.*, Serial No. 77198307, slip op. at 7-12 (TTAB June 2, 2009) (finding no likelihood of confusion between SUPERPOLY and SUPER POLYSTEEL both for automotive polish given that POLY is weak and SUPER is laudatory, noting that “in cases ‘where the conflicting marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of . . . other material to one of the marks has been held sufficient to render the marks as a whole distinguishable’” (quoting *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) and citing additional authority for this principle).

After all, “the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to distinguish between them so as to avoid confusion in trade.” *In re Innovative Aftermarket Systems, L.P.*, slip op. at 10-11 (quoting *In re Hunke & Jockheim*, 185 USPQ 188, 189 (TTAB 1975)). Given that here, as the Examining Attorney concedes, “KING OF PRUSSIA” is geographically descriptive and weak, adding “THE

PAVILION AT” to this geographically descriptive term is more than sufficient to differentiate Applicant’s Mark from the cited marks, in accordance with the precedent established by this Board. This is so even though this Board has recognized that even weak marks are entitled to some protection. EA Appeal Brief at 5.

Second, the Examining Attorney argues that because the King of Prussia, PA “geographic location is known almost entirely for the services provided by the applicant and the registrant,” this supports a finding that the marks are confusingly similar and differentiates the instant case from those cited in Applicant’s Appeal Brief. EA Appeal Brief at 6. However, not only is it questionable as to whether King of Prussia, PA is “almost entirely” known for Applicant’s and Registrant’s respective services, as noted below, but also it is far from clear how this fact (even if true) differentiates this case from those cited in Applicant’s Appeal Brief, particularly *In re Altitude Development Corp.* To the contrary, the addition of “THE PAVILION AT” to the geographic descriptor “KING OF PRUSSIA”, just like the addition of “SUMMIT AT” to “BRIAN HEAD” in *In re Altitude Development Corp.*, Serial No. 78943979 (TTAB March 6, 2009), identifies a separate location (the pavilion) within the King of Prussia mall complex and King of Prussia, PA generally. Thus, this case is nearly identical to *In re Altitude Development Corp.*, where the Board found no likelihood of confusion between SUMMIT AT BRIAN HEAD and BRIAN HEAD for nearly identical services. *Id.*

In any event, the fact remains that both Applicant and Registrant offer services located in King of Prussia, PA at the King of Prussia mall complex. Applicant cannot be precluded from identifying this fact and using King of Prussia in its purely geographically descriptive sense by denoting its services under the mark THE PAVILION AT KING OF PRUSSIA (emphasis added). To hold otherwise would render it impossible for Applicant to identify the geographic

location at which it provides services and would grant the registrant an exclusive monopoly on using the term KING OF PRUSSIA to describe the location of its services. To give the registrant this exclusive right at the exclusion of Applicant goes against the very tenants of trademark law.

Third, the Examining Attorney attempts to downplay Applicant's substantial evidence showing that "KING OF PRUSSIA" is used by numerous third parties and, thus, is a weak indicator of source, EA Appeal Brief at 7, arguing that "none of the marks cited by the applicant are marks that are registered as trademarks or service marks with the Office" and that there is no evidence that the businesses coexist without an agreement to avoid confusion. *Id.* These arguments are quickly dismissed. Applicant notes initially that it is evidence of third party uses, not registrations, that is pertinent to determine whether a mark is weak. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (if the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.") (emphasis added); TMEP § 1207.01(d)(iii) (noting that "the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion") (emphasis added).

Applicant submitted evidence that over 220 businesses use the name "KING OF PRUSSIA" and are located in or around the King of Prussia, PA area and provided numerous examples showing third party uses of third party marks including the term KING OF PRUSSIA. Such evidence plainly shows that KING OF PRUSSIA is diluted and weak (and calls into question the Examining Attorney's assumption that "the [King of Prussia] geographic location is known almost entirely for the services provided by the applicant and the registrant." EA Appeal

Brief at 6). Finally, regarding the Examining Attorney's argument that there is no evidence that the businesses coexist without an agreement, EA Appeal Brief at 7, there is no evidence that they coexist with an agreement either and the Examining Attorney bears the burden of proof in proving likelihood of confusion. *See In re Flowserve Management Co.*, Serial No. 86033484, slip op. at 3 n.4 (noting that even though Applicant presented no arguments concerning certain *du Pont* factors, they were not deemed conceded and the "Office still bears the burden of proof.").

The fact is that Applicant submitted substantial evidence showing that there are multiple third parties using trademarks/service marks comprising the term KING OF PRUSSIA. Such evidence is more than sufficient to show that KING OF PRUSSIA is weak.

Finally, the Examining Attorney argues that even though the consumers of the Applicant's and Registrant's services are sophisticated, this fact alone does not mean that they are immune from source confusion. EA Appeal Brief at 10. However, in making this argument, the Examining Attorney ignores prior Board decisions where the Board has weighed this factor against a finding of a likelihood of confusion, particularly where the marks at issue share only geographical descriptors or other descriptive terms. *See, e.g., In re Sanyet Ferdinand*, Serial No. 77965837, slip op. at 10-11 (TTAB Sept. 7, 2012) (finding no likelihood of confusion between PERFUME PARIS and Design for retail store services featuring perfumes and PERFUME PARIS and Design for distributorship services in the field of perfumes because "the sophisticated purchasers who would be the only overlapping customers for the parties' services would not assume that, merely because marks include[] the words PERFUME(S) and PARIS, that the marks indicate that the services emanate from the same source").

The fact is that the customers here are sophisticated and will not be confused into believing that the services are similar, particularly where the only commonality between the marks at issue is the geographic descriptor KING OF PRUSSIA.

In short, for the reasons discussed in more detail in Applicant's Appeal Brief, and as set forth herein, there is no likelihood of confusion between Applicant's Mark and the cited marks. Accordingly, Applicant respectfully requests that this Board reverse the Examining Attorney and withdraw the refusal to register of Applicant's Mark.

In addition, Applicant takes this opportunity to formally request an oral hearing in connection with this proceeding.

Respectfully submitted,

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