This Opinion is not a
Precedent of the TTAB

Hearing: May 19, 2016 Mailed: May 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PS Court Associates, LP

Serial No. 86321433

Camille M. Miller and J. Trevor Cloak of Cozen O'Connor, PC,
for PS Court Associates, LP.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

Before Bergsman, Heasley and Lynch,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

PS Court Associates, LP ("Applicant") seeks registration on the Principal Register, under Section 2(f) of the Trademark Act of 1946, 15 U.S.C. § 1052(f), of the mark THE PAVILION AT KING OF PRUSSIA (in standard characters) for "real estate services, namely, rental, leasing and management of commercial property, retail shops, restaurants, offices and office space," in International Class 36.[1] Applicant disclaimed the exclusive right to use the phrase "at King of Prussia."

[1] Application Serial No. 86321433 was filed on June 26, 2014, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as May 2000.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the three registered marks listed below, owned by the same entity, all for "shopping center services, namely, leasing and management of retail space," in International Class 36, as to be likely to cause confusion, to cause mistake, or to deceive:

1. Registration No. 2892752 for the mark THE PLAZA KING OF PRUSSIA (typed drawing form). The mark was registered under the provisions of Section 2(f). Registrant disclaimed the exclusive right to use the word "Plaza";[2]
2. Registration No. 2892753 for the mark THE COURT KING OF PRUSSIA (typed drawing form). The mark was registered under the provisions of Section 2(f);[3] and
3. Registration No. 2894595 for the mark KING OF PRUSSIA (typed drawing form). The mark was registered under the provisions of Section 2(f).[4]

"King of Prussia is a census-designated place in Upper Marion Township, Montgomery County" located northwest of Philadelphia, Pennsylvania.[5] At the heart of King of Prussia is the King of Prussia Mall, the largest shopping mall in the United States in terms of leasable space.[6] "King of Prussia" started out as primarily a

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[2] Registered on October 12, 2004; renewed.

[3] Registered on October 12, 2004; renewed.

[4] Registered on October 19, 2004; renewed.

[5] "King of Prussia, Pennsylvania," Wikipedia attached to Applicant's October 22, 2015 Request for Reconsideration (4 TTABVUE 36).

[6] *Id.* (4 TTABVUE 28).

geographic indicator. Registrant registered KING OF PRUSSIA, THE COURT KING OF PRUSSIA, and THE PLAZA KING OF PRUSSIA under the provisions of Section 2(f) of the Trademark Act by demonstrating that the phrase "King of Prussia" had acquired distinctiveness when used in connection with "shopping center services, namely, leasing and management of retail space." Applicant seeks to register its mark, THE PAVILION AT KING OF PRUSSIA, for real estate services it provides in the same mall.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

A. The similarity or dissimilarity and nature of the services.

Applicant is seeking to register its mark for the services listed below:

> Real estate services, namely, rental, leasing and management of commercial property, retail shops, restaurants, offices and office space.

The cited registrations are registered for the services listed below:

> Shopping center services, namely, leasing and management of retail space.

The leasing and management of retail shops and retail space are the same. Therefore, the services are in part identical.[7]

B. Established, likely-to-continue channels of trade.

Because the services described in the application and the cited registrations are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute,* 101 USPQ2d 1022, 1028 (TTAB 2011).

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[7] Under this *du Pont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the recitation of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the recitation of services a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group,* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds,* 110 USPQ2d 1679 (TTAB 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

C. The strength of the registered marks and the number and nature of similar marks in use in connection with similar services.

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).") *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (same); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2016) ("The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use."). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

Because the cited registrations have been registered under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the lack of inherent distinctiveness in the geographic term "King of Prussia" is a nonissue. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.,* 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). However, the registrations under Section 2(f) recognize that the primary significance

of the term "King of Prussia" when used in connection with "shopping center services, namely, leasing and management of retail space" is not the geographic location, but the source of those services.

> A term which is descriptive [or in this case primarily geographically descriptive]. . . may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at §37 (1947). This is what is known as secondary meaning.
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> The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 133, 173 USPQ 820, 823 (SDNY 1972).

As Professor McCarthy explains,

> Acquired distinctiveness is known as "secondary meaning" not because it is second in importance or in impact, but because it is a meaning acquired second in time. It is a new meaning added second in time to the original primary meaning of the designation. The new "secondary" trademark meaning does not replace or overshadow the original meaning, but adds a new layer of meaning. For example, the original, "primary" descriptive meaning of a word remains free for all sellers to use in a non-trademark sense under the classic fair use rule.

McCarthy on Trademarks and Unfair Competition § 15:1 (4th ed. 2016). *See also Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713,

1729 (Fed. Cir. 2012) ("To establish secondary meaning, or acquired distinctiveness, an applicant must show that 'in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.'").

We now turn to the marketplace strength of the registered marks. The evidence demonstrates that the King of Prussia Mall is well known. The King of Prussia Mall "is the main shopping location for Philadelphia Main Line residents and for the Delaware Valley."[8]

> The mall is a prominent tourist destination in the Philadelphia area, with an estimated 20-25% of visitors as tourists. Several nearby hotels offer mall tourist packages, which typically include mall gift cards. The mall employs over 7,000 people in the area.[9]

In an article posted on Philly.com (December 11, 2000) regarding the plans to redevelop part of the Court at King of Prussia, a part that ultimately became The Pavilion at King of Prussia, one of the other tenants at the Court at King of Prussia is quoted as saying about the renovations, "We're anxious for things to improve so we can experience the flow of traffic that King of Prussia is so famous for."[10] It has been reported that "shoppers spend more the $1 billion a year at the 42-year-old-mall, still

[8] "King of Prussia Mall," Wikipedia attached to Applicant's October 22, 2015 Request for Reconsideration (4 TTABVUE 28).

[9] "King of Prussia Mall," Wikipedia attached to Applicant's October 22, 2015 Request for Reconsideration (4 TTABVUE 31).

[10] April 9, 2015 Response.

the largest on the East Coast and third-largest in the country, according to the International Council of Shopping Centers."[11]

> So what's the attraction?
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> Shoppers cite the mall's location (at the intersection of the Pennsylvania Turnpike, Route 202 and the Schuylkill Expressway) and the number and diversity of its offerings. Among its 400 stores and restaurants are many high-end names-including some, such as Neiman Marcus and Versace, that have no other locations in the Philadelphia region – along with the typical mall fare.
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> The mall says that 20 percent to 25 percent of its customers are tourists, some of whom arrive on the 1,000 tourist busses that visit each year. Five million people live within a 100-mile radius.
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> When Urban Outfitters Inc., the hot Philadelphia retailer, decided to open its first mall store in the area in 2002, it chose King of Prussia.
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> "They have a prime location, terms of transportation, said Richard Hayne, founder and president of Urban Outfitters. "When you look at the numbers of people who have access to the King of Prussia mall fairly easily, it's incredibly powerful."
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> Crate & Barrel has had a store at the mall since 2000.
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> "Once we determine a market makes sense for us, we're looking to open in the center of gravity," said Peter Rusnak, director of real estate for the home retailer.
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> Many chains noted that their King of Prussia store is among their highest in sales. Sue Ertell, a manager at Rampage, a young women's clothing retailer, said the King

[11] Steve's Blog (steveswain.blogspot.com) attached to the April 9, 2015 Response.

> of Prussia store was among its best. "It's in the Top 10 for the company," she said.
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> Patti Rozecki, store manager at upscale baby boutique The Right Start, said it was sometimes a chicken-and-egg issue for retailers.
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> "We are a high-volume store because we're in King of Prussia," she said. "King of Prussia mall is a big attraction."
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> "What King of Prussia has been able to do," said Ernst & Young's Ford, "is take an area that was farm country, redevelop it into a significant regional shopping center, and then turn it into the regional shopping center in the country."[12]

Based on the foregoing, we find that the "King of Prussia Mall" has marketplace strength.

While the term "King of Prussia Mall" has a strong marketplace presence, we must assess whether the term "King of Prussia" has any marketplace strength when used in connection with "shopping center services, namely, leasing and management of retail space." We note that many of the preceding references to the King of Prussia Mall refer to it as King of Prussia, indicating that people shorten the King of Prussia Mall to King of Prussia (*e.g.*, "We're anxious for things to improve so we can experience the flow of traffic that King of Prussia is so famous for" and "We are a high-volume store because we're in King of Prussia. King of Prussia Mall is a big attraction.").

[12] *Id.*

It stands to reason that renown of the Court at the King of Prussia Mall, the Plaza at the King of Prussia Mall, and the King of Prussia Mall redounds to the source that manages those shopping centers (*i.e.,* the Registrant of THE COURT KING OF PRUSSIA, THE PLAZA KING OF PRUSSIA, and KING OF PRUSSIA).[13] In this regard, an Ernst & Young executive is quoted in the above-noted blog article as saying "What King of Prussia has been able to do is take an area that was farm country, redevelop it into a significant regional shopping center, and then turn it into the regional shopping center in the country," thus, providing one example where the mall and the management company are referred to as a single entity.

Further supporting the affiliation between a mall and its management company are the excerpts from webpages submitted by the Trademark Examining Attorney in the April 24, 2015 Office Action, where the name of a mall was also used to identify leasing services in that mall, for example, Dolphin Mall, Cherry Hill Mall, Crossgates Mall, The Pavilion at Port Orange, and Southbay Pavilion. Applicant similarly uses its mark THE PAVILION AT KING OF PRUSSIA to refer to the King of Prussia Mall and to its "rental, leasing and management of commercial property, retail shops, restaurants, offices and office space" at that Mall. As Applicant asserted in its brief,

> "By advertising and selling [leasing services] … from the [the King of Prussia mall complex in King of Prussia, PA] as [being AT KING OF PRUSSIA], [Applicant] has made no false representation . . . . If the [Registrant's] sales are diminished, it is because [Registrant is] not the only [provider of leasing services at the King of Prussia mall

[13] As discussed more fully below, Applicant's evidence of third-party use is illustrative of third parties using "King of Prussia" to identify their geographic location, and not as a trademark.

> complex in King of Prussia], and not because of any fraud of the defendant."[14]

We find, therefore, that the renown of the King of Prussia Mall, The Court at the King of Prussia Mall, and The Plaza at the King of Prussia Mall provides marketplace strength to the marks in the cited registrations.

The sixth *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use in connection with similar services. "The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers 'have been educated to distinguish between different such marks on the bases of minute distinctions.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *Veuve Clicquot Ponsardin v. Palm Bay Imports, Inc.*, Opp'n No. 115,438, 2003 WL 21953664 (TTAB 2003)). In this regard, Applicant argues that its evidence of third-party use for similar services proves that the registered marks are entitled to only a narrow scope of protection. Applicant specifically referred to KING OF PRUSSIA BUSINESS CENTER for office space rental, KING OF PRUSSIA OFFICE SPACE for office space rental, and KING OF PRUSSIA OFFICE PROPERTIES for office properties.[15] However, in these

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[14] Applicant's Brief, p. 8 (7 TTABVUE 12) *paraphrasing Del. & Hudson Canal Co. v. Clark,* 80 U.S. 311, 328 (1871).

[15] Applicant's Brief, p. 9 (7 TTABVUE 13) and October 22, 2015 Response (4 TTABVUE 78, 79, and 80). Applicant also referred to Macy's King of Prussia located at The Court at King of Prussia, Nordstrom Rack The Overlook at King of Prussia, Zagg at King of Prussia, King of Prussia Walmart Supercenter, JCPenney at King of Prussia Plaza, Norman's Hallmark at King of Prussia Plaza; but those are all retail stores using King of Prussia to indicate their geographic location and not as part of their trademark. See the fair use discussion in the next section. Likewise, Applicant's Exhibit L is a printout "showing numerous active

examples, the third parties are using the term "King of Prussia" to identify the location of their services , not as part of a trademark (*i.e.*, REGUS is the source of the King of Prussia Business Center, American Executive Centers is the source of the King of Prussia Office Space, and Brandywine Realty Trust is the source of the King of Prussia Office Properties).

On this record, we cannot conclude that there has been such an impact in the marketplace as a result of the use of the geographic location "King of Prussia" in connection with the leasing and management of retail shops and space, that minor differences between the marks will necessarily enable consumers to distinguish them. Even if we were to assume that this factor weighed against finding a likelihood of confusion, we must keep in mind what the Court of Customs and Patent Appeals, the predecessor or our primary reviewing court, said in *Matsushita Elec. Indus. Co., Ltd. v. Nat'l Steel Constr. Co.,* 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971), in finding likelihood of confusion between uses of NATIONAL in a cancellation proceeding:

> Neither trademarks nor the public are adequately protected unless decisions in cases of this kind are based on a realistic appraisal of the likelihood of purchasers or

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corporations/companies in Pennsylvania comprising the term KING OF PRUSSIA in such entities' trade names." 4 TTABVUE 17. However, there is no evidence that those trade names are used as trademarks or service marks and there is no indication as to the nature of their businesses (*e.g.*, B.C. Rest. Of King of Prussia, Inc., Bailey Employment Service of King of Prussia, and Bike Line King of Prussia). *Cf. Key Chemicals, Inc. v. Kelite Chemicals Corp.,* 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) ("Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word "KEY". The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here."); *In re Thor Tech Inc.,* 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue).

> prospective purchasers being confused as to source regardless of theoretical "weakness" of a mark.

With that in mind, we turn to the similarity of the marks.

D. The similarity of dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.,* 177 USPQ at 567. In comparing the marks, we are mindful that where, as here, the services are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang,* 84 USPQ2d 1323, 1325 (TTAB 2007).

"The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.,* 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.,* 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.,* 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general

rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.,* 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106, 108 (TTAB 1975). In this case, the average consumer is a person or company seeking to lease commercial property, retail shops, restaurants, offices and office space or a property owner seeking management services for commercial property, retail shops, restaurants, offices and office space.

In the case before us, the marks are similar because they all consist of or include the term "King of Prussia." The marks THE COURT KING OF PRUSSIA, THE PLAZA KING OF PRUSSIA and THE PAVILION AT KING OF PRUSSIA have the same structure: that is, a preceding descriptive or suggestive phrase (THE PLAZA, THE COURT, and THE PAVILION) followed by the phrase "King of Prussia," which has acquired distinctiveness and which has a strong marketplace presence when used in connection with Registrant's shopping center services, namely, leasing and management of retail space."

Moreover, Applicant's mark incorporates the entirety of one cited mark, KING OF PRUSSIA. In view of the largely identical services, the fact that the registered mark KING OF PRUSSIA is subsumed by Applicant's mark increases the similarity between the two. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant's mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound

diagnostic apparatus); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant's mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment).

Applicant contends that businesses seeking to lease space will be able to distinguish Applicant's mark from the marks in the cited registrations because "The Pavilion" is the dominant part of Applicant's mark THE PAVILION AT KING OF PRUSSIA and because the word "Pavilion" does not appear in any of the registered marks. In explaining its reasoning, Applicant correctly points out that "At King of Prussia" is geographically descriptive and that because the term "The Pavilion" is the first part of Applicant's mark, consumers will likely consider it to be the most prominent word.[16] However, because the marks must be considered in their entireties, a disclaimer does not remove the term "at King of Prussia" from the mark. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993) ("a disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion."). Applicant's mark therefore incorporates the term "King of Prussia," which has acquired distinctiveness in connection with managing and leasing retail stores and shops. Further, as previously noted, because Applicant's mark THE PAVILION AT KING OF PRUSSIA has the same structure as Registrant's marks THE COURT KING OF

[16] Applicant's Brief, p. 13 (7 TTABVUE 17).

PRUSSIA and THE PLAZA KING OF PRUSSIA, consumers are likely to believe that the managing and leasing of retail stores and shops identified by those marks emanate from a single source or from a source that is somehow sponsored by or affiliated with the owner of the cited registrations.

The evidence demonstrates that The Court at King of Prussia Mall, The Plaza at King of Prussia Mall, and The Pavilion at King of Prussia Mall are perceived to be sections of the King of Prussia Mall and, thus, one entity.

> The two sections that comprise the King of Prussia Mall include the Plaza at King of Prussia, anchored by Lord & Taylor, Dick's Sporting Goods, JCPenney, Neiman Marcus, and Nordstrom; and the Court at King of Prussia, which is anchored by Macy's and Bloomingdale's. The latter includes the Pavilion at King of Prussia.[17]
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> The growth of large-format specialty retailers in the1990s led to the early 2000s conversion of the former Strawbridge's store [Strawbridge & Clothier] at The Court into The Pavilion at King of Prussia, which might be considered the "the third" mall at King of Prussia.[18] The Pavilion connects directly to The Court (though not originally owned by Kravco, it was later acquired and is considered by many as an expansion of the Court). Tenants at The Pavilion include The Cheesecake Factory, Old Navy,

[17] "King of Prussia Mall," Wikipedia entry that Applicant attached to the October 22, 2015 Request for Reconsideration (4 TTABVUE 28).

[18] Applicant argues that this sentence proves that "the public separately identifies THE PAVILION AT KING OF PRUSSIA from THE COURT KING OF PRUSSIA and THE PLAZA KING OF PRUSSIA" by acknowledging that the three sections are "separate and distinct." Applicant's Brief, p. 14 (7 TTABVUE 18). We disagree. In the context of the Wikipedia entry, the Court at King of Prussia, the Plaza at King of Prussia, and the Pavilion at King of Prussia are considered to be parts of the King of Prussia Mall. In this regard, Applicant admits that "the building that Applicant leases comprises part of the King of Prussia mall complex." Applicant's Brief, p. 15 (7 TTABVUE 19).

> H&M, Urban Outfitters, DSW Shoes, Five Below, and Morton's Steakhouse and many more.[19]

The King of Prussia Mall webpage at the Visit Philly website (visitphilly.com/shipping/Philadelphia/king-of-prussia-mall) treats the Court, the Plaza and the Pavilion as the three parts of the King of Prussia Mall. The webpage states that "The Plaza is home to 250 stores, The Court 125, and The Pavilion 11, creating a grand total of nearly 400 fabulous stores and restaurants," and that "[t]hroughout its three centers, King of Prussia offers 11 ATM machines."[20]

A news article posted on the Philly.com website on December 11, 2000 announced plans for developing The Pavilion At King of Prussia Mall with the headline, "Plan Set For Mall's Empty Building The Former Strawbridge's In King Of Prussia Will Have Restaurants And Shops. Target Opening Is August."[21] The article associated the renovation with The Court At King Of Prussia.

> Bigger stores, white-table-cloth restaurants, and some glassy architectural flair are on the drawing board for the Court at King of Prussia, under plans to redevelop the building that formerly housed the Strawbridge's store at the region's largest mall.
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> Kravco Co., the manager of the entire mall complex, has already begun interior demolition work in the building, said Lloyd Miller, Kravco's vice president of leasing.
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> * * *
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> The building which has been vacant since Strawbridge's left in early 1999, has more than 200,000 square feet, or about 4 1/2 acres, of gross leasable space. It accounts for

[19] Applicant's Request for Reconsideration (4 TTABVUE 30),

[20] April 24, 2015 Office Action.

[21] April 9, 2015 Response.

> roughly one-fifth of the total area at the Court at King of Prussia.
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> * * *
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> "We want the Court to be a destination again. It hasn't been a destination for a long time," Phelps said. "If we didn't [have a good client base], we couldn't have survived."
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> In contrast to the more "classic" tone of the Court and the Plaza at King of Prussia, the redeveloped building will have more glass, more flair, and larger, multilevel stores, according to Kravco's chairman, Wayne Snyder. The site will be marketed as the Pavilion at the Court.[22]

Because the authors of this article about The Court at King of Prussia Mall, The Plaza at King of Prussia Mall, and The Pavilion at King of Prussia Mall, and presumably their readers, perceive all of those locations to be part and parcel of the King of Prussia Mall, retailers, restaurateurs and other businesses looking for space also are likely to believe that KING OF PRUSSIA, THE COURT KING OF PRUSSIA, THE PLAZA KING OF PRUSSIA, and Applicant's THE PAVILION AT KING OF PRUSSIA for managing and leasing of retail stores and shops emanate from a single source, or are somehow associated or affiliated with one another. Likely consumer confusion about association or affiliation may suffice to show likelihood of confusion:

> Thus, the issue in these cases is whether Society's HR and design marks, when used in connection with association services, namely, promoting the human resource management profession and the interests of members of the human resource management profession, so resemble Hilson's previously used HR and design mark for providing psychological and personality examinations for individuals and applicants for jobs and employees of private and municipal concerns, *that consumers would be likely to believe that the services originated with or were somehow*

[22] April 9, 2015 Response.

> *associated with or sponsored by the same entity*. Although confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection. See: J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 24.O3 [3] (3d ed. 1992). We would hasten to add, however, that in our opinion, the present proceedings do not involve a classic case of likelihood of confusion or so-called "forward confusion." McCarthy, *Trademarks and Unfair Competition*, supra at Section 23.1 [5]. It is our belief that the cases now before us are not ones where customers familiar with the senior user's (Hilson's) services rendered under its mark would be likely to mistakenly think, upon encountering the junior user's (Society's) mark, that the junior user's (Society's) services are from the same source as or are connected with the senior user's (Hilson's) services. Rather, *the issue in these proceedings involves* "reverse confusion", that is, *whether or not consumers purchasing the senior user's (Hilson's) services would mistakenly believe that they are getting services sponsored by or affiliated with the junior user (Society).* (Emphasis added).

Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1429 (TTAB 1993). *See also See In re Azteca Restaurant Enterprises Inc.,* 50 USPQ2d 1209, 1211 (TTAB 1999) ("The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks."); *In re National Novice Hockey League, Inc.,* 222 USPQ 638, 641 n.7 (TTAB 1984) ("It may be appropriate at this point to note, as has been observed by one commentator, that the statutory concept of 'likelihood of confusion" denotes any type of confusion, including not only source confusion but also "confusion of affiliation; confusion of connection; or confusion of sponsorship.'" (quoting T. J. McCarthy, op.

cit, 24.3.B (4 ***McCarthy on Trademarks and Unfair Competition*** § 24:6 (4th ed. 2016))); *Roush Bakery Products Co., Inc. v. Ridlen,* 190 USPQ 445, 448 (TTAB 1976) (customers of opposer's HILLBILLY bread and rolls and likely to believe that applicant's restaurant, using essentially the same mark, is approved or sponsored by, or is affiliated with opposer; the likelihood of confusion is aggravated by applicant's sales of bread which is precisely opposer's product); *Saks & Co. v. TFM Industries Inc.,* 5 USPQ2d 1762, 1764 (TTAB 1987) ("the use of the phrase BY FIRE ISLANDER may only tend to increase and not decrease the likelihood of confusion, mistake or deception by suggesting that applicant is the source of or affiliated with at least some of the women's sportswear featured in opposer's catalogs and retail department stores.").

Applicant argues that it cannot be precluded from using the geographical term "King of Prussia" as part of its mark.

> In any event, the fact remains that both Applicant and Registrant offer services <u>located in King of Prussia, PA at the King of Prussia mall complex</u>. 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 ten[ets] of trademark law.[23]

[23] Applicant's Reply Brief, pp. 3-4 (10 TTABVUE 4-5) (emphases in original). *See also* Applicant's Brief, p. 15 (7 TTABVUE 19 ("The fact of the matter is, the building Applicant leases comprises part of the King of Prussia mall complex. Applicant must be able to use 'AT

However, the term KING OF PRUSSIA in the cited registrations has acquired distinctiveness when used in connection with "real estate services, namely, rental, leasing and management of commercial property, retail shops, restaurants, offices and office space." That means that Registrant has acquired proprietary rights in that term in connection with Registrant's services based on Registrant's substantially exclusive and continuous use of "King of Prussia." Moreover, since the registrations are incontestable, they serve as conclusive evidence of Registrant's exclusive right to use the marks in commerce. Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b). Moreover, Applicant acknowledges that "AT KING OF PRUSSIA" in its mark does not merely refer to the town, but also refers to the location of its business at The King of Prussia Mall, a reference to Registrant's retail space.[24]

To the extent that Applicant is making a fair use argument, that provision of the Trademark Act provides an infringement defense allowing fair use of a term descriptively, and not as a mark.

> Such conclusive evidence of the right to use the registered mark shall be subject … to the following defenses or defects: … (4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.

KING OF PRUSSIA' to denote this fact [that Applicant's building is part of the King of Prussia Mall].").

[24] Applicant's Brief, pp. 2 n.2 and 7 (7 TTABVUE 6 and 11); Applicant's Reply Brief, pp. 3-4 (10 TTABVUE 4-5).

Section 33(b)(4) of the Trademark Act, 15 U.S.C. § 1115(b)(4). Therefore, in this application to register a mark, where Applicant clearly has identified "AT KING OF PRUSSIA" as part of its mark, the fair use defense to infringement is inapplicable.[25]

Finally, Applicant relies on the Board decision in *In re Altitude Development Corp.*, Serial No. 78943979, 2009 WL 722044 (TTAB 2009) (non-precedential) as persuasive authority for the proposition that Applicant's addition of THE PAVILION to a geographic indicator, AT KING OF PRUSSIA, is sufficient to distinguish Applicant's mark from the registered marks. First, while parties may cite to non-precedential decisions, such decisions are not binding on the Board and the Board does not encourage this practice. *In re Fiat Group. Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593 (TTAB 2014); *In re Procter & Gamble Co.,* 105 USPQ2d 1119, 1121 (TTAB 2012); *In re Luxuria s.r.o.,* 100 USPQ2d 1146, 1151n.7 (TTAB 2011); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011). Second, on the last page of that decision, the Board signaled the decision has little persuasive value when it wrote, "We hasten to point out, however, that on a different and more complete record, we might arrive at a different result on the issue of likelihood of confusion." Unlike in *In re Altitude*, in this case, as we have noted several times, the Court at King of Prussia, the Plaza at King of Prussia, and the Pavilion at King of Prussia are considered to be parts of the King of Prussia Mall,

[25] As indicated above, a disclaimer does not remove the disclaimed matter from the mark. *See In re Shell Oil Co.,* 26 USPQ2d at 1688-89.

thereby adding to the commercial impression that they emanate from or are somehow sponsored by or affiliated with one entity.

In view of the foregoing, we find that Applicant's mark is similar to the marks in the cited registrations in terms of appearance, sound, connotation and commercial impression.

E. The conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing.

Applicant asserts, without any corroborating evidence, that "because the customers who purchase such services, namely, leasing of office and retail space, are sophisticated and will take great care before making a purchasing decision,"[26] "[s]uch cautious consumers would not be confused into believing that Applicant, Applicant's Mark or Applicant's services are associated with Registrant, Registrant's marks or Registrant's respective services, under the circumstances, particularly given the other reasoning discussed above."[27] We first note that Applicant's and Registrant's identifications of services, which lack limitations, control, rather than the services as offered in the marketplace. *See Cunningham*, 55 USPQ2d at 1846. Thus, the office and retail leasing services may be offered to all types of businesses, including small businesses whose decision-making personnel may vary widely in terms of experience, care and sophistication. Therefore, although the consumers who lease retail or office space presumably are business people, they are not necessarily sophisticated.

[26] Applicant's Brief, p. 11 (7 TTABVUE 15).

[27] *Id.*

Regardless, the evidence noted in the previous section shows that people writing about the King of Prussia Mall perceive the Court at King of Prussia Mall, the Plaza at King of Prussia Mall and the Pavilion at King of Prussia Mall to be part and parcel of the King of Prussia Mall. Thus, it is likely that even "sophisticated consumers" will believe that THE PAVILION AT KING OF PRUSSIA MALL "rental, leasing and management of commercial property, retail shops, restaurants, offices and office space" services are rendered by or associated with the King of Prussia Mall management company.

In view of the foregoing, we find this *du Pont* factor to be neutral.

F. The nature and extent of any actual confusion and the length of time during which there has been concurrent use without evidence of actual confusion.

Applicant asserts that there have been over ten years of concurrent use without any known instances of confusion.[28] The alleged contemporaneous use of Applicant's and Registrant's marks for a period of ten years without actual confusion is entitled to little weight, especially in an *ex parte* context. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist

[28] Applicant's Brief, p. 12 (7 TTABVUE 16).

or that there was no likelihood of confusion);*J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965).

G. Balancing the factors.

Because the marks are similar, the services are largely identical, move in the same channels of trade and are rendered to the same class of consumers, we find that Applicant's mark THE PAVILION AT KING OF PRUSSIA for "real estate services, namely, rental, leasing and management of commercial property, retail shops, restaurants, offices and office space" is likely to cause confusion with the registered marks KING OF PRUSSIA, THE COURT KING OF PRUSSIA, and THE PLAZA KING OF PRUSSIA all for "shopping center services, namely, leasing and management of retail space."

Decision: The refusal to register Applicant's mark THE PAVILION AT KING OF PRUSSIA is affirmed.