

ESTTA Tracking number: **ESTTA422537**

Filing date: **07/29/2011**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

|   |   |
|---|---|
| Name  | Union Square Eye Care LLC   |
| Granted to Date of previous extension                       | 08/03/2011  |
| Address   | 235 Park Avenue South, 2nd Floor<br>New York, NY 10003<br>UNITED STATES |
| Party who filed Extension of time to oppose                 | Union Square Eye Care, LLC  |
| Relationship to party who filed Extension of time to oppose | Typographical error   |

|                      |   |
|----------------------|---|
| Attorney information | David W. Phillips<br>LeClairRyan<br>830 Third Avenue, Fifth Floor<br>New York, NY 10022<br>UNITED STATES<br>trademarks@leclairryan.com Phone:(212) 890-4230 |
|----------------------|---|

**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85157322  | Publication date       | 04/05/2011 |
| Opposition Filing Date | 07/29/2011  | Opposition Period Ends | 08/03/2011 |
| Applicant              | Union Square Optical, Inc.<br>9 West 14th Street<br>New York, NY 10011<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

|   |
|---|
| Class 035. First Use: 1992/04/00 First Use In Commerce: 1992/04/00<br>All goods and services in the class are opposed, namely: Retail optical store services    |
| Class 044. First Use: 1992/04/00 First Use In Commerce: 1992/04/00<br>All goods and services in the class are opposed, namely: Optician and optometric services |

**Grounds for Opposition**

|  |   |
|--|---|
| The mark is primarily geographically descriptive | Trademark Act section 2(e)(2)   |
| Other  | (1) Failure by Applicant to use UNION SQUARE OPTICAL in commerce in its application filed |

|  |   |
|--|---|
|  | pursuant to Section 1(a) of the Trademark Act of 1946; (2) Misuse by Applicant in its mark of the federal registration symbol |
|--|---|

|             |   |
|-------------|---|
| Attachments | Notice of Opposition.pdf ( 5 pages )(744312 bytes ) |
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                     |
|-----------|---------------------|
| Signature | /David W. Phillips/ |
| Name      | David W. Phillips   |
| Date      | 07/29/2011          |

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

In the Matter of Application Serial No. 85/157,322  
Published in the Official Gazette on April 5, 2011  
Mark: UNION SQUARE OPTICAL

UNION SQUARE EYE CARE LLC,

Opposer,

v.

UNION SQUARE OPTICAL, INC.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Opposer, Union Square Eye Care LLC (“Opposer”), believes that it will be damaged by the registration of the trademark UNION SQUARE OPTICAL as shown in the above-referenced trademark application and hereby opposes the same. As grounds for opposition, Opposer alleges that:

1. Applicant, Union Square Optical, Inc. (“Applicant”), a New York corporation operates a single-location optical store and optician’s office located at 9 West 14th Street, New York, New York 10011, a block southeast and in walking distance of the well known intersection called Union Square in New York City, New York. Applicant provides services under the name UNION SQUARE OPTICAL to New York City, as evidenced in Applicant’s web page regarding its boutique at [www.unionsquareoptical.com/service.html](http://www.unionsquareoptical.com/service.html).

2. Applicant has filed an application for registration of the mark UNION SQUARE OPTICAL in International Class 35 for “retail optical store services” and in International Class

044 for “optician and optometric services”. This application was published for opposition on April 5, 2011, and Opposer has timely filed for and the Trademark Trial and Appeal Board has granted an extension of time to file an opposition until August 3, 2011.

3. Opposer, a New York professional limited liability company, provides ophthalmology and optical shop services from an office located at 235 Park Avenue South, 2nd Floor, New York, New York 10003, within 2 blocks northwest and in walking distance of Union Square in New York City, New York.

4. Opposer has filed an application for registration of the mark UNION SQUARE EYE CARE and design in International Class 044 for “ophthalmology services; diagnosis and treatment of eye diseases and conditions; physician services in the field of ophthalmology, namely, strabismus diagnosis, treatment and surgery, oculoplastic surgery, ophthalmic plastic surgery, neuro-ophthalmology, diagnosis, medical and surgical treatment of retinal and vitreous diseases, uveitis and ocular immunology, cataract surgery, refractive surgery, eye examinations, medical and surgical eye care, glaucoma treatment and surgery, macular degeneration treatment, laser surgery, cosmetic facial surgery, diabetic eye disease evaluation and treatment, treatment of corneal and external eye diseases, contact lens and specialty contact lens fitting, pediatric eye examinations, care and surgery, and emergency eye care”. An Office Action issued on May 20, 2011 against this application citing Applicant’s application as a possible bar to registration of Opposer’s mark, and requiring a disclaimer of UNION SQUARE EYE CARE in Opposer’s application “because it merely describes the geographic location and common commercial name of the applicant’s services”.

5. “Optical” is a common descriptive or generic term in the eye care industry and has been disclaimed by Applicant.

6. Applicant is located within walking distance of Union Square. The term “Union Square” contained in Applicant’s mark merely describes the geographic location of Applicant’s business from which Applicant’s goods and services originate.

7. The primary significance of “Union Square” to the relevant public is as a geographic identifier or description for the intersection known as Union Square in New York City, New York.

8. Taken as a whole, UNION SQUARE OPTICAL is merely descriptive when used in connection with Applicant’s goods and services.

9. Upon information and belief, Applicant’s mark has not obtained secondary meaning for a variety of reasons, including among other reasons the sheer number of businesses using the name UNION SQUARE in New York City and elsewhere, and a prior co-existing use by a business of the name and mark UNION SQUARE VISION CENTER, in New York City.

10. If Applicant obtains the registration herein opposed, Applicant would obtain a prima facie exclusive right to use of the term “Union Square”. Such registration would be a source of damage and injury to Opposer (and others) who currently use, have applied to register marks containing, will use, or will apply to register marks containing the descriptive designation “Union Square” to describe the origin of their own products and services, since it may prevent them from registration of their marks and subject them to an infringement suit.

11. In light of the above facts, registration should, therefore, be refused pursuant to Section 2(e)(2) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(e)(2).

12. On information and belief, UNION SQUARE OPTICAL was not used in commerce by Applicant in connection with the services designated in Applicant’s application at the time of filing the application or at any time prior to the filing of the application and

registration should therefore be refused pursuant to Section 1(a) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1051(a).

13. Applicant has further improperly used the registered symbol ® in violation of law to falsely represent that its trade name UNION SQUARE OPTICAL was a federally registered service mark, and in an effort to dissuade other uses of the name UNION SQUARE.

14. Applicant has further in an effort to intimidate Opposer into believing that Applicant had a valid claim under the Lanham Act, falsified allegations of confusion by consumers and others, and has gone as far as falsifying an email to change the recipient of the email and the content of the emails to make it appear that Opposer's counsel had an unethical contact directly with Applicant.

WHEREFORE, Opposer respectfully requests that the Board sustain this opposition and deny the application for registration of the UNION SQUARE OPTICAL mark.

The Commissioner is hereby authorized to charge the filing fee for this Notice of Opposition and any additional fees to our Deposit Account No. 501563. Opposer appoints as its attorneys in this proceeding David W. Phillips and Tara A. Branscom of the firm LeClairRyan, 830 Third Avenue, Fifth Floor, New York, New York 10022 (212) 890-4230; [trademarks@leclairryan.com](mailto:trademarks@leclairryan.com), to whom all correspondence in this proceeding should be addressed.

Respectfully submitted,

DATED: New York, New York  
July 29, 2011

**LECLAIRRYAN**

*/s/ David W. Phillips, Esq.*

By: \_\_\_\_\_  
David W. Phillips, Esq. (DP 2099)  
830 Third Avenue, 5<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 430-8020  
Fax: (212) 430-8079  
Email: [trademarks@leclairryan.com](mailto:trademarks@leclairryan.com)

Tara A. Branscom, Esq.  
10 South Jefferson Street, Suite 1800  
Roanoke, Virginia 24011  
Phone: (540) 510-3046  
Fax: (540) 510-3050  
E-mail: [trademarks@leclairryan.com](mailto:trademarks@leclairryan.com)

Attorneys for Opposer Union Square Eye Care LLC