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Filing date: **08/25/2011**

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

Proceeding	91200946
Party	Defendant Union Square Optical, Inc.
Correspondence Address	UNION SQUARE OPTICAL INC 9 WEST 14TH STREET NEW YORK, NY 10011 UNITED STATES
Submission	Answer
Filer's Name	Scott D. Brenner, Esq.
Filer's e-mail	sbrenner@brenner-esq.com
Signature	/Scott D. Brenner/
Date	08/25/2011
Attachments	Schwartz.Answer to Opposition.20110825.pdf (11 pages)(88666 bytes)

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

Opposition No. 91200946

Mark: UNION SQUARE OPTICAL

UNION SQUARE EYE CARE LLC,

Opposer,

ANSWER TO
OPPOSITION

UNION SQUARE OPTICAL, INC.,

Applicant.

Applicant, UNION SQUARE OPTICAL, INC., (“Applicant”) herewith respectfully files this Answer to the Opposition filed by UNION SQUARE EYE CARE LLC (“Opposer”), dated July 29, 2011, alleging that:

1. Applicant has no objection to and admits the allegations set forth in paragraph “1” of Opposer’s Notice of Opposition.
2. Applicant has no objection to and admits the allegations set forth in paragraph “2” of Opposer’s Notice of Opposition.
3. Applicant lacks knowledge sufficient to form an opinion as to the truth of paragraph “3” of Opposer’s Notice of Opposition and therefore leaves the Opposer to sufficient proof of such allegations.
4. Applicant lacks first-hand knowledge sufficient to form an opinion as to the truth of Opposer’s allegations in paragraph “4” of its Notice of Opposition and therefore leaves the Opposer to sufficient proof of such allegations. Applicant’s existence, actual conduct of

business in the marketplace, and registration with the New York Secretary of State predates Opposer's existence and any use in commerce by several years.¹ Please see printouts from the New York Secretary of State Website for each of these entities, annexed hereto as Exhibit "A". Applicant has been in the business of selling its optician/optometric services and eyeglasses, contact lenses, etc. since early 1992 at the latest, and Opposer, only recently opening its business in the same neighborhood (2009), attempted to file its own trademark application so as to gain the advantages of such a mark vis a vis Applicant's existing seniority, and cause confusion among consumers in the local and/or national, international marketplace. Opposer holds itself out as primarily an eye care and treatment service but it also promotes an eyeglass and contact lens business that directly competes with Applicant, and that line of business alone in connection with the name is the reason for its trademark filing as well as its current Opposition. It is important to note that aside from the sale of prescription eye glasses and contact lenses, the services of Opposer are similar but not identical - Applicant is essentially a "primary" eye-care service including diagnosis, evaluation and treatment of many eye diseases and conditions, while Opposer's service also includes "tertiary" care services such as surgery and treatment of more serious conditions.

5. Applicant has no objection and admits the allegations set forth in paragraph "5" of Opposer's Notice of Opposition.

6. Applicant objects to and denies the allegations set forth in paragraph "6" of Opposer's Notice of Opposition. Applicant's goods and services do not wholly originate at its geographic location. The eyeglasses and contact lenses sold are not manufactured or sold exclusively from Applicant's place of business. Unlike Opposer's applied for mark (Union Square Eye Care),

¹ Applicant filed for registration with the New York Secretary of State on February 28, 1992, and Opposer filed for registration with the New York Secretary of State on December 29, 2009.

which is descriptive of Opposer's service wholly originating at its geographic location, Applicant sells products which are manufactured and sold at locations other than Applicant's geographic location.

7. Applicant objects to and denies the allegations set forth in paragraph "7" of Opposer's Notice of Opposition. The words "Union Square" carry commercial mystique and have appeal beyond its mere geographic location in a similar fashion as does the word "London" in "London Fog". There are several "live" registered marks making use of the words "Union Square" in the Trademark Electronic Search System. Included are various non-design marks such as "Union Square Photography", "Union Square Café", "Union Square", "union square NYC", "Union Square Events", "Union Square Ventures", "Union Square Hospitality Group", "Union Square Diagnostic Imaging", and "The Handlery Union Square Hotel".

8. Applicant objects to and denies the allegations set forth in paragraph "8" of Opposer's Notice of Opposition. "Union Square Optical", taken as a whole, is not merely descriptive but rather distinctive, having been operating and selling its goods and services in commerce under the same mark and business name since April of 1992.

9. Applicant objects to and denies the allegations set forth in paragraph "9" of Opposer's Notice of Opposition, that its longstanding operation, sales and service under its mark and business name "Union Square Optical", since 1992, has obtained no secondary meaning. Applicant aggressively advertizes and markets its goods and services in popular magazines, publications and (all as illustrated) on its website, <http://www.unionsquareoptical.com/>.

10. Applicant objects to and denies the allegations set forth in paragraph "10" of Opposer's Notice of Opposition. Use of the trademark, Union Square Optical is unlikely to cause harm to Opponent. Registration of a mark that includes words connoting a geographic identifier for a

particular good or service, does not prevent others from using the term in connection with other words, unrelated goods/services provided the U.S. consuming public is not likely to be confused as to the source of the goods/services. As set forth above there are several marks which currently make use of the words, "Union Square", such uses appearing upon information and belief to be facially distinctive in their own unique circumstances for goods and services which do not infringe upon each other's intellectual property rights.

11. Applicant objects to and denies the allegations set forth in paragraph "11" of Opposer's Notice of Opposition. Registration should not be refused pursuant to Section 2(e)(2) of the trademark Act of 1946, as amended, 15 U.S.C § 1052(e)(2).

12. Applicant objects to and denies the allegations set forth in paragraph "12" of Opposer's Notice of Opposition. Opposer's assertion that "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 is disingenuous if not wholly conclusory. Between 1992 and the present, Union Square Optical has operated solely for the purpose of providing retail optical store goods and services including optician and optometric services. Applicant's filing of its corporate registration as "Union Square Optical, Inc." with the New York Secretary of State, other state and federal regulatory filings under the same name, and thereafter opening/operating its retail store and advertizing such store all constitute sufficient use in commerce.

13. Applicant objects to and denies the allegations set forth in paragraph "13" of Opposer's Notice of Opposition. Applicant is not an attorney and while that is no excuse simply did not know that the ® symbol is only permissible once the mark is fully registered as opposed to having been filed and accepted by the original examiner. His counsel did not advise him accordingly at the outset upon filing that he had to use the symbol, "TM". However, upon being

later advised by his counsel that it was impermissible, Applicant immediately discontinued its use. There was no prejudice caused and Opposer is simply attempting to mar the Applicant's credibility.

14. Applicant objects to and denies the allegations set forth in paragraph "14" of Opposer's Notice of Opposition. This, again, is proffered in conclusory fashion without factual basis, and for no other purpose but to attempt to adversely impact the Applicant's credibility. Applicant has NEVER falsified examples of customer confusion caused by Opposer's advertizing. As alluded to in the prior paragraph, Applicant used the ® symbol before he was permitted and felt, overall, dissatisfied that his counsel wasn't proactive enough to advise him of what he can and cannot do. Applicant had contacted and began working with alternate counsel but did not yet have an opportunity to decide which counsel he wanted to utilize going forward, and therefore changed the text of a forwarded email to mask the existence of the new attorney. It was not done in any effort to suggest that any counsel made an inappropriate contact (Applicant never made that accusation). Applicant knows that changing an addressee of a forwarded email isn't a proper thing to do but under the circumstances felt compelled to not disclose yet before his current counsel that he had been in contact with new counsel. All of the foregoing having been said, Opposer's counsel appears to be using this opportunistically and attempting to create a larger issue for self-serving purposes.

WHEREFORE, Applicant respectfully requests that the Board overrule the opposition and grant the application for registration of the UNION SQUARE OPTICAL mark.

Applicant appoints as its attorney for purposes of this proceeding and its application generally, Scott D. Brenner, Brenner Law Offices, 66 Reade Street, Second Floor, New York, NY 10007, PH:(646) 330-4725, FAX:(646)417-6422 ; sbrenner@brenner-esq.com, and

respectfully requests that all correspondence and pleadings in this proceeding should be delivered to him at the foregoing address via email or fax unless mail is required.

Respectfully submitted,

Dated: New York, New York
August 25, 2011

BRENNER LAW OFFICES

By: 

Scott D. Brenner, Esq. (SB 4264)
66 Reade Street, Second Floor
New York, New York 10007
Phone: (646) 330-4725
Fax: (646) 417-6422
Email: sbrenner@brenner-esq.com

Exhibit A

NYS Department of State

Division of Corporations

Entity Information

The information contained in this database is current through August 24, 2011.

Selected Entity Name: UNION SQUARE OPTICAL, INC.

Selected Entity Status Information

Current Entity Name: UNION SQUARE OPTICAL, INC.

Initial DOS Filing Date: FEBRUARY 28, 1992

County: NEW YORK

Jurisdiction: NEW YORK

Entity Type: DOMESTIC BUSINESS CORPORATION

Current Entity Status: ACTIVE

Selected Entity Address Information

DOS Process (Address to which DOS will mail process if accepted on behalf of the entity)

STEVEN M. TANENBAUM, ESQ.

167 MAIN STREET

WOODBIDGE, NEW JERSEY, 07095

Registered Agent

NONE

This office does not record information regarding the names and addresses of officers, shareholders or directors of nonprofessional corporations except the chief executive officer, if provided, which would be listed above. Professional corporations must include the name(s) and address(es) of the initial officers, directors, and shareholders in the initial certificate of incorporation, however this information is not recorded and only available by [viewing the certificate.](#)

***Stock Information**

# of Shares	Type of Stock	\$ Value per Share
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200	No Par Value	
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*Stock information is applicable to domestic business corporations.

Name History

Filing Date	Name Type	Entity Name
FEB 28, 1992	Actual	UNION SQUARE OPTICAL, INC.

A **Fictitious** name must be used when the **Actual** name of a foreign entity is unavailable for use in New York State. The entity must use the fictitious name when conducting its activities or business in New York State.

NOTE: New York State does not issue organizational identification numbers.

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NYS Department of State

Division of Corporations

Entity Information

The information contained in this database is current through August 24, 2011.

Selected Entity Name: UNION SQUARE EYE CARE LLC
Selected Entity Status Information

Current Entity Name: UNION SQUARE EYE CARE LLC

Initial DOS Filing Date: DECEMBER 29, 2009

County: NEW YORK

Jurisdiction: NEW YORK

Entity Type: DOMESTIC PROFESSIONAL SERVICE LIMITED LIABILITY COMPANY

Current Entity Status: ACTIVE

Selected Entity Address Information

DOS Process (Address to which DOS will mail process if accepted on behalf of the entity)

UNION SQUARE EYE CARE LLC
PO BOX 100
NEW YORK, NEW YORK, 10159

Registered Agent

NONE

This office does not require or maintain information regarding the names and addresses of members or managers of nonprofessional limited liability companies. Professional limited liability companies must include the name(s) and address(es) of the original members, however this information is not recorded and only available by [viewing the certificate.](#)

***Stock Information**

# of Shares	Type of Stock	\$ Value per Share
No Information Available		

*Stock information is applicable to domestic business corporations.

Name History

Filing Date	Name Type	Entity Name
DEC 29, 2009	Actual	UNION SQUARE EYE CARE LLC

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NOTE: New York State does not issue organizational identification numbers.

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