

ESTTA Tracking number: **ESTTA488895**

Filing date: **08/14/2012**

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

Proceeding	92055800
Party	Plaintiff City of New York, by and through its Department of Parks and Recreation
Correspondence Address	GERALD E SINGLETON NYC DEPARTMENT OF LAW 100 CHURCH STREET , ROOM 20-093 NEW YORK, NY 10007 UNITED STATES gsinglet@law.nyc.gov, kwinning@law.nyc.gov, ssantani@law.nyc.gov
Submission	Opposition/Response to Motion
Filer's Name	Gerald E. Singleton
Filer's e-mail	gsinglet@law.nyc.gov
Signature	/Gerald E. Singleton/
Date	08/14/2012
Attachments	Skateboarder Memo 08142012.pdf ( 20 pages )(1153938 bytes )

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

CITY OF NEW YORK, BY AND THROUGH  
ITS DEPARTMENT OF PARKS &  
RECREATION,

Petitioner,

v.

SUSOIX LLC,

Registrant.

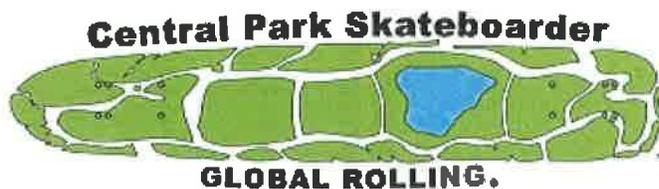
Cancellation No. 92055800

Registration No. : 4022850  
Filing Date : March 1, 2011  
Mark : **CENTRAL PARK  
SKATEBOARDER**  
Classes : 035, 041  
Registration Date : September 6, 2011

**PETITIONER CITY OF NEW YORK'S MEMORANDUM OF LAW  
IN OPPOSITION TO SUSOIX'S PARTIAL MOTION TO DISMISS**

**Preliminary Statement**

Petitioner, the City of New York, by and through its Department of Parks and Recreation (the "City"), respectfully submits this memorandum of law in opposition to Registrant Susoix LLC ("Susoix")'s partial motion to dismiss the City's Petition for Cancellation of Susoix's trademark, CENTRAL PARK SKATEBOARDER (Registration No. 4022850) (the "Mark"), which appears on its website at [www.centralparkskateboarder.blogspot.com/](http://www.centralparkskateboarder.blogspot.com/) as follows:



Central Park is a perfect place for Skating On A Board™ in New York City. A perfect 6.3 mile loop with just enough climbing to maintain fitness.

In response to the instant motion, the City has filed an Amended Petition for Cancellation (“Amended Pet.”) deleting the fraud claim as well as the claim that the personal coaching services offered by Susoix are not in interstate commerce. Accordingly, this memorandum will address the legal sufficiency of the remaining two grounds for cancellation challenged by Susoix, to wit, (i) the Mark falsely suggests a connection with Central Park in New York City, which is an *institution* within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(2)(a); and (ii) the Mark is *primarily geographically descriptive* under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2).

### SUMMARY OF ARGUMENT

Central Park is much more than a geographic location to the millions of people familiar with it. Central Park means concerts, activities, events and facilities and a host of other things that require vast resources and the services of a *large, structured organization* – administered by the City’s Parks Department and the Central Park Conservancy, acting on the City’s behalf – to maintain and operate it.

Susoix appropriated the name, together with a map of the park, to take advantage of the unmistakable connection that the name Central Park conjures in the minds of millions of people, including potential consumers of Susoix’s services. Susoix does not argue otherwise, nor does Susoix assert that the name Central Park is associated with any other organization, place or thing.

Instead, Susoix argues that Central Park is merely a geographic location and therefore not an institution, which argument is wrongheaded and inconsistent with the Board’s long-standing practice of broadly applying Section 2(a)’s institutional protection to similar organizations, particularly governmental agencies. If the Los Angeles Police Department and the United States Postal Service, as well as the Sydney Olympics Games and NAFTA, qualify for protection as

“institutions” under Section 2(a), then it surely cannot be said as matter of law, at least at this preliminary stage, that Central Park is not likewise entitled to such protection.

Susoix argues that the Mark is not primarily geographically descriptive as to its online wholesale and retail services in Class 35 because the services are offered via a website and, therefore, the primary significance of the Mark is not Central Park, but rather the Internet. This is absurd. Consumers seeing the Mark would reasonably conclude that the services originate and have a place association with Central Park.<sup>1</sup>

### STATEMENT OF FACTS

Central Park is one of the most popular and frequented tourist attractions in the world, with over 35 million visitors annually. Central Park has the distinction of being the first public park built in America and it has been designated as a National Historic Landmark. Central Park is also listed in the U.S. National Register of Historic Places and it was the first site to be named a scenic landmark by the New York City Landmarks Preservation Commission. (Amended Pet. at ¶ 1).

The City has provided park and recreation services at and under the name Central Park since 1857. (*Id.* at ¶ 2). Central Park is the most famous urban park in the United States, and is situated on 843 acres of land in the heart of New York City, extending northerly from 59th Street to 110th Street and cross-town from Fifth Avenue to Eight Avenue. Central Park offers visitors

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<sup>1</sup> The City has alleged that the Mark is primarily geographically descriptive and geographically deceptively misdescriptive as alternative claims because it is not clear where the services will be provided by Susoix. Susoix has admitted that it has not provided any meaningful services to date using the Mark and, recently, it was granted permission to change the filing status for a companion mark (CENTRAL PARK LONGBOARDER GLOBAL ROLLING (Serial No 85/393,670), which is the subject of a separate Opposition Proceeding (Opposition No. 91205879), from Section 1(a) (actual use) to Section 1(b) (intent to use).

a pastoral, naturalistic environment with picturesque gardens, rock formations, lakes, bridges, promenades, fountains, monuments and historic structures. (*Id.* at ¶ 3).

Central Park also has a wide range of facilities and year round recreational activities, including 21 official playgrounds, ball fields, tennis courts, two ice-skating rinks, a swimming pool, and lawn bowling. (*Id.* at ¶ 4). Central Park also has many famous attractions and points of interest, well-known to hundreds of millions of visitors, including the Park Drive, the Lake, the Loeb Boathouse, the Carousel, the Central Park Zoo, the Great Lawn, Tavern on the Green, the Sheep Meadow, Strawberry Fields, Cleopatra’s Needle, Bethesda Fountain, the Reservoir, the Arsenal, the Blockhouse, Belvedere Castle, the Delacorte Theatre, the Wollman Rink and the Lasker Rink and Pool. (*Id.* at ¶ 5). Central Park hosts numerous concerts, festivals and world-class events throughout the year, including, SummerStage® concerts, the New York City Marathon, the Central Park Conservancy Film Festival and the famous “Shakespeare in the Park” live stage productions at the Delacorte Theatre. (*Id.* at ¶ 6).

The City widely advertises and promotes the attractions, facilities and events at Central Park directly and through various partnerships and it maintains a website to provide tourist and event information. (*Id.* at ¶ 7). Central Park is one of the most filmed locations in the world, with footage for over 300 theatrical motion pictures and television shows having been shot in the Park, and it is the subject of many books and artistic works, adding and attesting to its fame, popularity and name recognition with consumers. (*Id.* at ¶ 8). By reason of the City’s longstanding prior use and promotional efforts, Central Park is known to millions of people and singularly associated with the City as an iconic park offering outstanding recreational services and activities. (*Id.* at ¶ 9).

### **The City's Partnership with the Central Park Conservancy**

Since 1980, the Parks Department has worked in partnership with the Central Park Conservancy (the "Conservancy"), a not-for-profit corporation, to ensure the continued maintenance and beauty of Central Park for the millions of visitors it serves. The Parks Commissioner has the duty to manage and care for Central Park, and, in conjunction with the Conservancy, works to preserve the Park's iconic status. (*Id.* at ¶ 10). The Parks Department retains policy control and has discretion over all user permits and events in the Park. (*Id.*).

Pursuant to agreements between the City and the Conservancy, the Conservancy has been designated as the official manager of Central Park with responsibility for the day-to-day maintenance and operation of the Park. (*Id.* at ¶ 11). Presently, 90 percent of the Park's maintenance and operations staff is employed by the Conservancy, which provides 85 percent of Central Park's \$42.4 million annual park wide expense budget through its fundraising and investment revenue. (*Id.*).

### **The City's Prior Ownership of CENTRAL PARK Mark**

In 2005, the City filed an application with the U.S. Patent and Trademark Office to register its distinctive Central Park signage (the "CENTRAL PARK Mark") in International Class 19 (non-luminous, non-mechanical signs made out of laminated plastic) based on first use in 1983 and first actual use in commerce in 2004. The CENTRAL PARK Mark was registered on the Principal Register on March 27, 2007 and issued Registration No. 3,221,347, which the City owns. (*Id.* at ¶ 12). A photocopy of Petitioner's certificate of registration for the CENTRAL PARK Mark is attached to the Amended Petition as Exhibit A.

The CENTRAL PARK Mark is widely associated with the Petitioner, has been prominently featured in media coverage, promotional activities and national distribution of

licensed goods carrying the design. (Amended Pet. at ¶ 16). The CENTRAL PARK Mark and its associated goodwill are valuable assets of the City and the Parks Department. (*Id.* at ¶ 17).

Through many years of use by Petitioner, the CENTRAL PARK Mark has come to represent the highest standards of public service, recreational and parks services, programming and free concert events as well as the highest quality of goods such as caps, t-shirts and other apparel items with which the Mark is associated. (*Id.* at ¶ 18). As a result of Petitioner's exceptional reputation and the media attention and other publicity that Central Park have received over many years, the CENTRAL PARK Mark has acquired tremendous goodwill and value, and is recognized as uniquely designating Petitioner and its goods, services, events, venues and apparel. (*Id.* at ¶ 19).

## ARGUMENT

### I

#### **CENTRAL PARK IS AN "INSTITUTION" UNDER SECTION 2(a) OF THE TRADEMARK ACT**

##### **Section 2(a) of the Trademark Act Prohibits Registration of a Mark That Falsely Suggests a Connection with an Institution**

Section 2(a) of the Trademark Act prohibits registration of a mark that "[c]onsists of or comprises . . . matter which may disparage or *falsely suggest a connection with* persons, living or dead, *institutions*, beliefs, or national symbols . . . ." 15 U.S.C. § 1052(a) (emphasis added). The word "institution" in this section has been broadly interpreted to have an expansive scope that includes governmental agencies and organizations formed for a public or social purpose. Central Park clearly is an "institution" within the meaning of Section 2(a).

In the leading case, *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1375 (Fed. Cir. 1983), the Federal Circuit Court of Appeals noted that Section 2(a) was intended to protect "the name of an individual or institution which was not a

‘technical’ trademark or ‘trade name’ upon which an objection could be made under Section 2(d).” *Id.* To be afforded protection under Section 2(a), the name sought to be appropriated must be unmistakably associated with a particular personality or “persona,” and the circumstances must indicate that the name points uniquely to that personality or persona. *Id.* at 1377.

Following the principles set forth in *Notre Dame*, the Board has stated that a plaintiff asserting a claim of false suggestion of a connection under Section 2(a) must demonstrate that:

- (1) the mark is the same as, or a close approximation of, the name or identity previously used by plaintiff;
- (2) the mark would be recognized as such, in that it points uniquely and unmistakably to plaintiff;
- (3) plaintiff is not connected with the activities performed by applicant under the mark; and
- (4) plaintiff’s name or identity is of sufficient fame or reputation that, when the mark is used on applicant’s goods or services, a connection with the plaintiff would be presumed.

*See, e.g., In re MC MC S.r.l.*, 88 USPQ2d 1378,1379 (TTAB 2008); *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re Sloppy Joe’s Int’l Inc.*, 43 USPQ2d 1350, 1353 (TTAB 1997); *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993); *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428 (TTAB 1985).

Here, the Mark falsely suggests a connection with Central Park because: (1) the Mark is composed of the same name with a map of Central Park being an integral element of the Mark; (2) the Mark would be recognized by consumers as pointing uniquely and unmistakably to

Central Park; (3) Central Park is not connected with the services to be provided by Susoix under the Mark; and (4) the fame and reputation of Central Park is such that, when the Mark is used with Susoix's services, a connection with Central Park would be presumed.

The City will be able to establish each of these elements with respect to Central Park. The only issue at this preliminary stage is whether Central Park cannot be considered an "institution" as a matter of law. Susoix contends that Central Park is merely a location, and not entitled to any protection under Section 2(a). That position is legally untenable.

There can be no room for doubt that Central Park qualifies for protection as an "institution" under a long line of Board decisions. The Board often has sustained refusals to register marks under Section 2(a), where the marks in question falsely suggest a connection with a government or governmental entity or agency. *See, e.g., In re Brumberger Co., Inc.*, 200 USPQ 475 (TTAB 1978) (representation of the US mailbox was held not to be an insignia of the United States. However, the refusal to register the mark under Section 2(a) because of a false connection with the United States Postal Service was affirmed); *In re U.S. Bicentennial Society*, 197 USPQ 905 (TTAB 1978) (holding U.S. BICENTENNIAL SOCIETY, for ceremonial swords, to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government); *In re National Intelligence Academy*, 190 USPQ 570 (TTAB 1976) (holding NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, to falsely suggest a connection with the United States government). *See also NASA v. Record Chemical Co., Inc.*, 185 USPQ 563, 566-67 (TTAB 1967) (NASA is a juristic person and has standing to oppose marks which may damage the agency); *Federal Bureau of Investigation v. M. Bril & Co.*, 172 USPQ 310, 313

(TTAB 1971) (FBI is a juristic person with capacity to oppose marks pursuant to Section 2(a) and 2(d)).

In *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009), the Board affirmed a refusal to register the mark U.S. CUSTOMS SERVICE for attorney services because it falsely suggests a connection with the United States Customs and Border Protection, formerly known as the United States Custom Service, a government agency. The Board noted that the term “institution” as used in Section 2(a), “includes government agencies.”

The Board has “held that the question of whether a proposed mark falsely suggests a connection with the [ ] government, or a branch or agency thereof, ‘must be determined on a case-by-case basis in connection with the specific goods or services with which [the proposed mark] is used and the impact of such use upon the relevant section of the purchasing public.’” See *In re Parisi*, Ser. Nos. 75291235 and 75354127, 2004 TTAB LEXIS 367 (TTAB Feb. 25, 2004), quoting *National Intelligence Academy, supra*, 190 USPQ at 572.

In *Herrick*, the applicant argued that Section 2(a) did not apply because the agency name had been changed and the mark included some added design elements. As the Board made clear in *Herrick*, however, the fact that a mark “includes design elements does not avoid the commercial impression that the mark is the same or a close approximation to the former name and/or current identity of the United States Custom and Border Protection.” 91USPQ2d at 1507, citing *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 (TTAB 1997) (hereafter referred to as “NAFTA)) (“One cannot overcome a refusal based on a false suggestion of a connection merely by adding a design element to an entity or institution’s identity.”).

In this case, Susoix uses not only the name Central Park as the predominant element of the mark, but it also has included a map of the park as an integral graphic element, thereby

reinforcing the suggestion of a connection. These elements permit an inference to be drawn that Susoix intends to create a connection with the City and Central Park. *See NAFTA*, 43 USPQ2d at 1287, *quoting Notre Dame*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983) (“Evidence of such intent [applicant intended to create a false suggestion of a connection] would be highly persuasive that the public will make the intended false connection.”).

In *United States Postal Service v. Lost Key Rewards, Inc.*, 102 USPQ2d 1595 (TTAB 2010), the Board sustained an opposition under Section 2(a) by the United States Postal Service (“USPS”) to a mark with a blue round-top mailbox. The Board concluded that the mark falsely suggested a connection to the USPS, even though the mark did not name the agency and the mailbox had no markings on it. *Id.* The Board found that the mailbox “is a famous mark and a symbol that is ubiquitous and uniquely indicative of the USPS.” *Id.* Consistent with its practice of affording Section 2(a) a broad scope, the Board stated that “Section 2(a) refers to a false suggestion of a connection with a person or institution, which includes government agencies.” *Id.* The Board concluded that “[t]here is no question that the USPS is an institution within the meaning of Section 2(a)” *Id.*

In *Lost Key Rewards*, the Board found that the connection between a thing, i.e., a mailbox, and a governmental agency, although not named in the mark, was enough to invoke Section 2(a). In this case, the connection between Central Park, on the one hand, and the City and the Parks Department on the other hand, should likewise suffice because Central Park is singularly associated with the City and the Parks Department. There can be no dispute that the City and the Parks Department, whether considered separately or as a whole, are institutions within the meaning of Section 2(a). Accordingly, even if the Board accepts the notion that Central Park is just a park, or a location, and is not itself an “institution”, Central Park’s

indisputable connection to the City requires a denial of Susoix's motion to dismiss the Section 2(a) claim.

The Board also has expressed the view that countries and states are entitled to protection as "institutions" under Section 2(a). See *In re Prosynthesis Laboratories, Inc.*, Ser. No. 77902555, 2012 TTAB LEXIS 116 (Mar. 23, 2012) ("for purpose of this opinion, we will assume that China is a person or institution within the meaning of Trademark Act § 2(a)"); *University of Southern California v. University of South Carolina*, Opp. No. 91125615, 2003 TTAB LEXIS 367 (TTAB July 31, 2003) (observing that the state of South Carolina would have been the proper party to assert the institution claim). There can be no doubt that the City is also entitled to protection under Section 2(a).

In *In re Shinnecock Smoke Shop*, 571 F.3d 1171 (Fed. Cir. 2009), the Federal Circuit Court of Appeals affirmed the Board's conclusion that the Shinnecock Indian Nation is an "institution" that falls within Section 2(a)'s protection. The Court took note of the Board's "general practice" of broadly construing the term "institution", citing the Board's decisions involving Indian tribes, the Sydney Olympics and the North American Free Trade Agreement. See *In re Julie White*, 73 USPQ2d 1713, 1718 (TTAB 2004) (finding that "each federally recognized Apache tribe is necessarily either a juristic person or an institution"), *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (finding that the SYDNEY 2000 Olympic Games qualifies as an "institution"); *NAFTA, supra* (finding that the North American Free Trade Agreement is not just an agreement and qualifies as an "institution").

In *Urbano*, the Board stated: "While we do not consider the Olympic Games, per se, to be an 'institution,' it is only common sense that an event of such magnitude, which occurs on a regular and ongoing basis, requires a substantial organizational structure to support and organize

it.” 51 USPQ2d at 1779. The Board concluded “that the entire organization which comprises the Olympic Games, as a whole, qualifies as an ‘institution’ within the meaning of Section 2(a) of the Trademark Act.” *Id.*

In *NAFTA*, the Board noted that the legislative history of Section 2(a) indicates that the reference to “institution” therein “was designed to have an expansive scope.” *See Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. (1939)*, included as an appendix to *Notre Dame, supra*, 703 F.2d at 1378. In line with this expansive scope, the Board rejected the argument that NAFTA is simply a treaty agreement and not an “institution.” In concluding that NAFTA qualifies for protection as an “institution”, the Board focused on the many committees, groups, commissions, panels and offices that would have to be set up in different countries to implement the treaty.

Likewise, Central Park is not just a location. Like the Olympic Games and NAFTA, Central Park depends on a vast organization and it should qualify for protection as an “institution.” Central Park hosts numerous recurring events attracting millions of people. The maintenance and operation of Central Park requires a substantial organizational structure dedicated to a specific purpose and a collaborative effort by many different groups.

In determining whether a claimant qualifies for protection as an “institution”, the Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). For example, in *NAFTA*, the Board took judicial notice of the following definition of “institution” from Black's Law Dictionary (5th ed. 1979):

Political law. A law, rite, or ceremony enjoined by authority as a permanent rule of conduct or of government. An organized society, established either by law or the authority of individuals, for promoting any object public or social.

A system or body of usages, laws, or regulations, of extensive and recurring operation, containing within itself an organism by which it effects its own independent action, continuance, and generally its own further development. Its object is to generate, effect, regulate, or sanction a succession of acts, transactions, or productions of a peculiar kind or class. We are likewise in the habit of calling single laws or usages “institutions,” if their operation is of vital importance and vast scope, and if their continuance is in a high degree independent of any interfering power.

Central Park fits within this definition. It is an organization devoted to a particular public and social purpose. It has its own administration and employees. It has its own police force and rules and regulations. It has many concessions and amenities, and numerous historic sites and cultural attractions, including film festivals, music concerts, sporting and recreational events, and educational programs. It is known to millions of people for, among other things, its world famous zoo (the “Central Park Zoo”), for its world class running races (e.g., the NYC Marathon) and its amenities (e.g., Tavern on the Green).

Central Park also fits neatly within other definitions of the term “institution”, which emphasize the public purpose and character of an organization.

- The Oxford Advanced American Dictionary defines institution as “a large important organization that has a particular purpose.”  
[www.oaadonline.oxfordlearnersdictionaries.com/dictionary/institution](http://www.oaadonline.oxfordlearnersdictionaries.com/dictionary/institution).
- The Merriam-Webster Online Dictionary defines “institution” as “something or someone firmly associated with a place or thing” and as “an established organization or corporation (as a bank or university) especially of a public character.”  
[www.merriam-webster.com/dictionary/institution](http://www.merriam-webster.com/dictionary/institution).
- Dictionary.com defines “institution” as “an organization, establishment, foundation, society, or the like, devoted to the promotion of a particular

cause or program, especially one of a public, educational, or charitable character.”

[www.dictionary.reference.com/browse/institution](http://www.dictionary.reference.com/browse/institution).

The Board also may consider dictionary definitions in assessing whether the Mark points uniquely to Central Park. In this case, the existing dictionary definitions of Central Park point exclusively to Central Park in New York City.

- The American Heritage Dictionary of the English Language (Fifth Edition 2011 online edition) defines “Central Park” as “An extensive recreational area of New York City extending north to south in central Manhattan. The land, acquired in 1856, was developed according to plans drawn up by the landscape architects Frederick Law Olmsted and Calvert Vaux.”

[www.ahdictionary.com/word/search.html?q=central+park](http://www.ahdictionary.com/word/search.html?q=central+park);

- Dictionary.com (2012) defines “Central Park” as “a public park in central Manhattan, New York City. 840 acres (340 hectares).”

[www.dictionary.reference.com/browse/central+park?s=t](http://www.dictionary.reference.com/browse/central+park?s=t);

- The American Heritage® New Dictionary of Cultural Literacy (Third Edition 2005 Houghton Mifflin Company) defines “Central Park” as “A large park in Manhattan, half a mile wide and over two miles long.”

[www.dictionary.reference.com/browse/central%20park](http://www.dictionary.reference.com/browse/central%20park).

In sum, Central Park is an “institution” within the meaning of Section 2(a). As such, the only entities that can register a mark that suggests a connection with Central Park are the City itself, as the owner of the park, and parties authorized by the City, such as the Conservancy. *See In re Los Angeles Police Revolver and Athletic Cub, Inc.*, 69 USPQ2d 1630 (TTAB 2003)

(rejecting argument that the mark “TO PROTECT AND SERVE” falsely suggested a connection with the Los Angeles Police Department, given the “long history of a ‘symbiotic’ relationship between the applicant and the LAPD) (“Because there is an actual commercial connection between the applicant and the LAPD, the record does not demonstrate that the mark falsely suggests a connection with the LAPD”). In this case, there is no commercial connection between Susoix and the City that would permit Susoix to associate and connect itself to Central Park.

Based on the foregoing, Susoix’s partial motion to dismiss the City’s Section 2(a) claim should be denied.

## II

### **THE MARK IS PRIMARILY GEOGRAPHICALLY DESCRIPTIVE WITH RESPECT TO SUSOIX’S ONLINE RETAIL SERVICES**

Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), prohibits registration on the Principal Register of a mark that is primarily geographically descriptive of the goods or services named in the application.

“In order for a mark to be considered primarily merely descriptive under Section 2(e)(2), it must be shown that (1) the mark's primary significance is a generally known geographic location; and (2) that the relevant public would be likely to make a goods/place association, that is, would be likely to believe that the goods originate in the place named in the mark.” *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1616 (TTAB 2007). *See also In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, 1821 (TTAB 2006); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); and TMEP 1210.01(a) (“To establish a prima facie case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that: (1) the primary significance of the mark is a generally known geographic location, (2) the goods

or services originate in the place identified in the mark; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.”).

A place does not have to be noted for a product to establish that a term is geographically descriptive. *See JT Tobacconists, supra*, 59 USPQ2d at 1084 (“There is no requirement . . . that the State of Minnesota be noted for cigars and cigar products in order for a mark such as ‘MINNESOTA CIGAR COMPANY’ to be held primarily geographically descriptive.”). Furthermore, a geographic term can indicate any geographic location on earth, including rivers, mountain ranges and parks. *See McCarthy on Trademarks and Unfair Competition* § 14:3 (4<sup>th</sup> ed. 2007); *In re Spirits of New Merced LLC*, 85 USPQ2d 1614 (TTAB 2007) (YOSEMITE BEER primarily geographically descriptive for beer brewed in Merced, California near Yosemite National Park); *Warwood v. Hubbard*, 228 USPQ 702 (Mont. 1985) (YELLOWSTONE OUTFITTERS primarily geographically descriptive of outfitting services offered in the region around Yellowstone National Park).

Susoix does not dispute that Central Park is a generally known geographic location and that the relevant public would be likely to make a goods/place association. Instead, Susoix argues that, as a matter of law, the City will be unable to satisfy the second element of the claim, i.e., that the services originate in the place identified in the mark.

Although by no means clear from its memorandum, Susoix seems to be arguing that the “place of origin” for any goods/services sold “online” is the Internet, as opposed to the geographic place associated with, and identified in, the mark. Presumably, Susoix would argue that Section 2(e)(2) has no application to online merchants, as a matter of law, because the place of business is the Internet. Stated differently, Susoix seems to be saying that, despite its use of

the words Central Park and a map of Central Park, it is not possible for the relevant public to make a services/place association with respect to the Mark in Class 35 as a matter of law.

Susoix's argument ignores the primary geographical significance of the Mark. The place identified in the Mark is Central Park, not the Internet. It is folly to focus on the Internet as the place of business; the focus must be on the commercial impression on consumers created by the Mark and the context and circumstances surrounding its use. The appropriate inquiry is "whether the public would reasonably identify or associate the goods sold under the mark with the geographic location contained in the mark." See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001).

In *In re Fire Island Brewing Company LLC*, Serial Nos. 77696805 and 77696816, 2011 WL 4871865 (TTAB Sept. 23, 2011), the Board sustained a refusal to register the mark FIRE ISLAND BEER COMPANY LIGHTHOUSE ALE based on the applicant's failure to disclaim FIRE ISLAND on the ground that it is primarily descriptive of the applicant's beer under Section 2(e)(2). Instructive to this case, the Board stated:

When the goods are not actually produced in the location, we look to other points of contact that may be sufficient to consider the origin of the goods to be from the location (otherwise the mark may be primarily geographically deceptively misdescriptive) and for evidence that consumers would be likely to make that association.

Opinion at 16-17, 2011 WL 4871865, at \*7 (footnote omitted).

Here, there are many points of contact from which consumers might make a services/place association with Central Park. The services here will originate from a company that has a significant connection to New York and Central Park. The only business address for Susoix is in New York City and its website contains many pictures of skateboarders and longboarders in Central Park. Susoix offers personal coaching services on its website and it

would be reasonable to conclude that the services will be provided in Central Park or are in some way connected to Central Park.

The Petition alleges that Susoix has not provided any meaningful services to date using the Mark. All available information, however, indicates that Susoix's services will originate in or around Central Park. Susoix's website repeatedly refers to Central Park and states "Central Park is a perfect place for Skating On A Board™ in New York City." See [www.centralparkskateboarder.blogspot.com/](http://www.centralparkskateboarder.blogspot.com/). In that regard, "it is well settled that the requisite goods/place association may be presumed if the applicant's own goods originate or will originate in or from the place named." *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008).

Again, it is significant that the Mark includes a map of Central Park. A map or outline of a geographic area is treated the same as the actual name of the geographic location if it is likely to be perceived as such. See *In re Canada Dry Ginger Ale, Inc.*, 86 F.2d 830, 32 USPQ 49 (C.C.P.A. 1936) (map of Canada held to be the equivalent of the word "Canada").

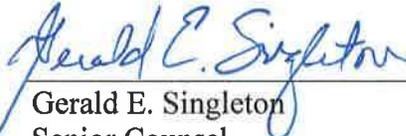
Given the available information, Susoix's partial motion to dismiss the City's Section 2(e)(2) claim should be denied. Alternatively, in the absence of a developed factual record, the City submits that it is premature to make a determination that the City's claim of primary geographic descriptiveness under Section 2(e)(2) does not lie as a matter of law.

**CONCLUSION**

For all of the foregoing reasons, the City respectfully submits that Susoix's partial motion to dismiss should be denied.

Dated: New York, New York  
August 14, 2012

MICHAEL A. CARDOZO  
Corporation Counsel of the City of New York  
Attorney for Petitioner  
100 Church Street, Room 20-093  
New York, New York 10007  
(212) 788-0760

By:   
\_\_\_\_\_  
Gerald E. Singleton  
Senior Counsel

**CERTIFICATE OF SERVICE**

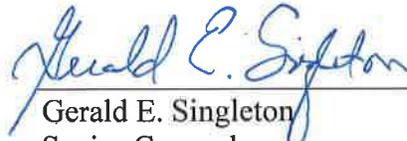
I hereby certify that a true and complete copy of the foregoing Petitioner City Of New York's Memorandum Of Law In Opposition To Susoix's Partial Motion To Dismiss has been served on Registrant by electronic transmission as mutually agreed upon by the parties by transmitting a copy thereof to:

Stuart Gillespie  
215 Walter St. NE  
Albuquerque, New Mexico 87102  
Stu Gillespie [stugillespie1@gmail.com]

Dated: New York, New York  
August 14, 2012

MICHAEL A. CARDOZO  
Corporation Counsel of the City of New York  
Attorney for Petitioner  
100 Church Street, Room 20-093  
New York, New York 10007  
(212) 788-0760

By:

  
\_\_\_\_\_  
Gerald E. Singleton  
Senior Counsel