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**Subject:** U.S. Trademark Application Serial No. 87856799 - SOHO INK - KOI-TM027 - Examiner Brief  
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**Attachments**

**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 87856799

**Mark:** SOHO INK

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**Applicant:** INK PROJECTS LLC

**Reference/Docket No.** KOI-TM027

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's final refusal to register the mark "SOHO INK" on the grounds that such wording is primarily geographically descriptive of the origin of applicant's goods and services identified in Classes 2, 8 and 44 under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2), 1056(a). Applicant has also appealed the final requirement to disclaim "SOHO" for the goods in Class 25.

**I. FACTS**

On March 30, 2018, applicant, Ink Projects LLC, a limited liability company organized under the laws of New York, filed an application to register the mark "SOHO INK" on the Principal Register for goods and services in Classes 2, 8, 25 and 44. Prosecution of the application spanned several years, a summary of which was provided by the applicant in its brief. In sum, the first Office Action issued on April 16, 2018, in which the Office required an amendment to the identification of goods in Classes 2 and 8 and a disclaimer of the term "INK." Applicant complied, and in a series of subsequent actions, the Office issued a refusal under Section 2(e)(2) of the Trademark Act, asserting that the mark was primarily geographically descriptive for all goods and services, and a disclaimer of "INK" in Classes 2, 8 and 44 and a disclaimer of "SOHO" for the goods in Class 25 was required.

Applicant submitted the required disclaimer for "INK" and offered arguments in favor of registration with respect to the Section 2(e)(2) refusal and against the required disclaimer of "SOHO" in Class 25. A final refusal was issued on December 31, 2020, maintaining the refusal to register the mark under Section 2(e)(2) as to Classes 2, 8 and 44 only, and continuing the requirement of a disclaimer of "SOHO" as to Class 25. On June 30, 2021, a Notice of Appeal and a Request for Reconsideration were filed.

## **II. ISSUES ON APPEAL**

There are two issues for disposition on appeal: whether the wording "SOHO INK" is primarily geographically descriptive of the origin of the goods and services in Classes 2, 8 and 44; and whether the term "SOHO" must be disclaimed as geographically descriptive of the origin of the goods in Class 25. 15 U.S.C. Section 1052(e)(2), 1056(a).

## **III. ARGUMENT: THE PROPOSED MARK IS PRIMARILY GEOGRAPHICALLY DESCRIPTIVE**

Registration of the proposed mark "SOHO INK" must be refused because it is primarily geographically descriptive of the origin of applicant's goods and services identified in Classes 2, 8 and 44. It is well settled that a mark is primarily geographically descriptive when the following is

demonstrated:

- (1) The primary significance of the mark to the purchasing public is a generally known location;
- (2) The goods or services originate in the place identified in the mark; and
- (3) The purchasing public would be likely to believe that the goods or services originate in the geographic place identified in the mark; that is, to make a goods-place or services-place association.

*See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*5 (TTAB 2020) (citing *In re Nantucket, Inc.*, 677 F.2d 95, 96-97, 213 USPQ 889, 891 (C.C.P.A. 1982)); TMEP §1210.01(a). Taken in turn, the first element of the test is whether the primary significance of the mark is a generally known geographic location. The record includes sufficient evidence that the term "SOHO" is well known as a defined and well-known location in New York City. Specifically, the previous examining attorney provided the following evidence:

January 14, 2019 Office Action

- A description of the SOHO neighborhood as a "famously arty neighborhood of the '70s and '80s [that] has evolved into one of New York City's prime shopping districts" . . . "SoHo (an acronym for South of Houston Street)." <https://www.nycgo.com/boroughs-neighborhoods/manhattan/soho>; TSDR January 14, 2019 at 3.
- A Wikipedia entry describing the origin of name "SoHo" as "the area being "South of Houston Street", a name coined in 1962 by Chester Rapkin,[4] an urban planner and author of The South Houston Industrial Area study." [https://en.wikipedia.org/wiki/SoHo,\\_Manhattan](https://en.wikipedia.org/wiki/SoHo,_Manhattan). TSDR January 14, 2019 at 3.

April 26, 2020 Office Action

- A map showing the applicant's location in SoHo. <https://www.mapquest.com/us/new-york/soho->

*ink-387528100* TSDR April 26, 2020 at 8.

In the final Office action dated December 31, 2020, the examining attorney made of record pages from the applicant's website that showed its address as 285 Lafayette Street, New York, New York. Further, the website pages included a map, clearly showing applicant's location below Houston Street, and located in Soho. TSDR December 31, 2020 at 2, 17. Thus, the second element of the refusal is clearly met, as the evidence establishes that the relevant goods and services originate in Soho.

The third element of the requisite test is whether a consumer would be likely to believe that the goods or services originate in the geographic place identified in the mark. A goods-place or services-place association may be presumed where (1) the location in the mark is generally known to the purchasing public, (2) the term's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the named location in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) (finding a services-place association was presumed between applicant's restaurant services and California because the services originated in California). Thus, the third element is met because Soho is a well-known place with no competing significance and the actual site of applicant's establishment. A consumer receiving a tattoo in a Soho tattoo parlor would immediately understand the connection between the place named in the mark and the location of the establishment. *In re Nantucket, Inc.*, 677 F.2d 95, 102, 213 USPQ 889, 895 (C.C.P.A. 1982) (Nies, J., concurring) (“[W]e must start with the concept that a geographic name of a place of business is a descriptive term when used on the goods of that business. There is a public goods/place association, in effect, presumed.” (internal footnote removed)).

Finally, the inclusion of the term "INK" does not diminish the primary geographic significance of the term "SOHO." The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term's primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*6-7 (TTAB 2020) (holding CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a

well-known harbor in Charleston, South Carolina); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (holding HOLLYWOOD LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory).

The Office has clearly met the burden for establishing that the mark is primarily geographically descriptive, as the evidence shows that the term "SOHO" identifies a generally known location, that the goods and services in Classes 2, 8 and 44 are performed or originate in the Soho establishment, and that consumers of said goods and services would immediately understand that they originate in Soho. The selection of the term "SOHO INK" to identify an establishment located in Soho, New York cannot be considered suggestive, random or arbitrary. Businesses and competitors should be free to use such descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). The Trademark Trial and Appeal Board has stated that the purpose of Trademark Act Section 2(e)(2) is "to leave geographic names free for all businesses operating in the same area to inform customers where their goods or services originate." *In re Spirits of New Merced*, 85 USPQ2d at 1621 (citing *In re MCO Props. Inc.*, 38 USPQ2d 1154, 1156 (TTAB 1995)).

The second issue for disposition is whether applicant must enter a disclaimer of "SOHO" for the goods identified in Class 25. *See* 15 U.S.C. §1052(e)(2); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); TMEP §§1210.01(a), 1210.06(a), 1213.03(a). The record is replete with evidence that Soho is a generally known geographic place or location; that the goods in Class 25 originate in Soho; and that a public association of the goods with the place is presumed. *See In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1858 (TTAB 2014) (citing *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007)); TMEP §§1210.02(a) 1210.04. As the term "SOHO" is geographically descriptive of the origin of the goods in Class 25, a disclaimer is the appropriate requirement, and applicant's compliance should be required.

Because the evidence of record demonstrates that the geographical significance of "SOHO" is its primary significance and the place is neither obscure or remote, and because applicant's goods and services originate in the geographical place named in the mark, purchasers would be likely to assume

that the goods and services originate in Soho. Thus, the refusal issued for Classes 2, 8 and 44 and the disclaimer required for Class 25 should be affirmed.

#### IV. APPLICANT'S ARGUMENTS

The applicant has framed several arguments in response to the issues presented on appeal. First, it claims that the Office failed to demonstrate the requisite association between the goods and services and the geographic location named Soho. As discussed earlier, the Office has established the presumption of a goods-place or services-place association because the facts and the evidence clearly show that (1) the location Soho is generally known to the purchasing public, (2) Soho's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the distinct and famous neighborhood in New York called Soho in that applicant's place of business, as shown by its own website, is located within Soho. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988); *see also In re Nantucket, Inc.*, 677 F.2d 95, 102, 213 USPQ 889, 895 (C.C.P.A. 1982).

Second, the applicant asserted that the proposed mark "is more than a geographic location," and has come to evoke a particular "style or artistic nature." *Id.* Applicant also posits that there are other meanings that reduce the geographic significance of mark, and also that it is a colloquial nickname. However, if the most prominent meaning or significance of a mark is geographic for the goods and/or services in the application, the fact that the mark may have other meanings in other contexts does not alter its geographic significance in the context of the application. *See In re Opryland USA Inc.*, 1 USPQ2d 1409, 1412-13 (TTAB 1986); TMEP §1210.02(b)(i). Further, commonly used nicknames for geographic locations are generally treated as equivalent to the proper geographic name of the place identified. TMEP §1210.02(a); *see, e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive where evidence showed "Carolina" is a nickname for either North or South Carolina); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 245 (TTAB 1976) (holding OLD DOMINION is "the accepted nickname for the State of Virginia").

The applicant relies on *In re Gale Hayman, Inc.* to support the assertion that the "mere fact that applicant's current location is located in New York is not dispositive." The facts in *Haynman* are easily distinguishable, and render applicant's argument unpersuasive. In *Heynman*, the TTAB stated that proximity alone could not establish a goods/place association when the applicant's principal office was located in Century City, near to, but not on Sunset Boulevard. *In re Gale Haynman, Inc.* 15 USPQ2d 1478 (TTAB 1990). The Board stated that "Sunset Boulevard itself would have to be associated with the products in such a way that the consuming public would be likely to assume that Sunset Boulevard was the place in which the perfume and cologne originated." *Id.* The facts in the present case show that the applicant is actually located in Soho, and as such, a goods/place association can be presumed. See *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1858 (TTAB 2014) (citing *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007)); TMEP §§1210.02(a) 1210.04. Further, the TTAB has more recently stated that "a product that is produced or a service that is provided near the geographic place named in the applied-for mark is sufficient to support a finding that the goods and/or services originate in that geographic location. See, e.g., *City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at \*9-10 (TTAB 2020) (holding CITY OF LONDON primarily geographically descriptive of gin distilled within and bottled near the city limits of London).

Applicant also states that the record is devoid of any evidence that consumers would associate the goods and services with the location of the goods and services. The idea that an ordinary consumer would fail to assume a goods-services-place association in this case strains credulity, as applicant's shop is located in Soho, the tattoo services are performed in Soho, and the goods at issue are sold in Soho. This argument also ignores the basic precept stated earlier, that a goods-place or services-place association may be presumed where (1) the location in the mark is generally known to the purchasing public, (2) the term's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the named location in the mark. TMEP §1210.04; see, e.g., *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988).

Finally, applicant attached eighty registered marks for "SOHO" that do not include a disclaimer of the term at issue. The registrations have little, if any, probative value for several reasons. First, out of the

eighty registrations attached as evidence, twelve have been cancelled. Out of the sixty-eight remaining, sixty of the registrations are for companies located outside of New York, some in places as far away as Australia and Florida. Of the remaining eight that are actually located in New York, not one originates from Soho. Further, none of the registrations are for similar goods or services, and some of them have distinctive elements. None of the registrations submitted by the applicant show the term SOHO plus a descriptive term for goods or services that originate in Soho.

Accordingly, the proposed mark "SOHO INK" is primarily geographically descriptive of the origin of the applicant's goods and services in Classes 2, 8 and 44 and must be refused, and the term "SOHO" is descriptive of the geographic origin of the goods in Class 25 and must be disclaimed.

## **V. CONCLUSION**

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register the proposed mark "SOHO INK" in Classes 2, 8 and 44 and the requirement for a disclaimer of "SOHO" in Class 25 should be affirmed under Trademark Act Section 2(e)(2).

Respectfully submitted,

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**United States Patent and Trademark Office (USPTO)**

**USPTO OFFICIAL NOTICE**

Examining attorney's appeal brief has issued  
on October 12, 2022 for  
**U.S. Trademark Application Serial No. 87856799**

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

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