

This Opinion is not a  
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Port Authority of New York and New Jersey*  
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Serial No. 88005756  
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Daniel D. Frohling and Tatyana V. Gilles of Loeb & Loeb LLP  
for Port Authority of New York and New Jersey.

Christopher M. Nunley, Trademark Examining Attorney,  
Law Office 104 (Zachary Cromer, Managing Attorney).

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Before Kuhlke, Mermelstein and Pologeorgis, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Port Authority of New York and New Jersey, filed an application to register on the Principal Register the mark ONE WORLD COMMONS in standard characters for services ultimately identified as:

Providing facilities for business meetings and business events; providing individual work spaces for business purposes; providing breakout areas for small business meetings and events; retail store services featuring grab and go food and beverage items, sandwiches, salads, snack foods, fresh fruit, candy, assorted cookies and desserts, pastries, hot chocolate, soft drinks, tea, coffee, and other non-alcoholic beverages, energy drinks; food and beverage markets, in International Class 35;

Food and meal delivery service, in International Class 39;

Providing commercial office building amenities, namely, facilities for recreation and exercise, and for entertainment and leisure activities, in International Class 41; and

Providing commercial office building amenities, namely, providing dining services; Providing commercial office building amenities, namely, providing general purpose facilities for business meetings, general purpose facilities for business conferences, conference facilities, social function facilities, cafeteria and catering services, in International Class 43.

The application was filed on June 19, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

The Examining Attorney refused registration based on Applicant's failure to comply with a requirement to disclaim the word COMMONS apart from the mark as shown. 15 U.S.C. §§ 1052(e)(1) and 1056. The Examining Attorney maintains that the word COMMONS is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), when used in connection with Applicant's services.

When the refusal was made final, Applicant appealed and filed a request for reconsideration. The request was denied on November 6, 2019. The appeal was subsequently resumed and is now fully briefed.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. 15 U.S.C. § 1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. *See* TMEP § 1213.01(a) (Oct. 2018). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116

USPQ2d 1262 (Fed. Cir. 2015). Merely descriptive or generic terms are unregistrable under Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *La. Fish Fry*, 116 USPQ2d at 1264 (citing *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005)) (“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an ‘unregistrable component of a mark otherwise registrable.’ 15 U.S.C. § 1056(a)”). *See also In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information of a quality, feature, function, or characteristic of the goods or services in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). The determination of whether a mark is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.” *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a “single feature or attribute” of the goods or services. *Chamber*

*of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Finally, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd without pub. op.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

The Examining Attorney asserts the word COMMONS is merely descriptive of Applicant's services in each of the classes because it immediately describes a feature or purpose of the services, namely, that Applicant provides common areas and common resources to all tenants and their guests. Ex. Att. Brief, 11 TTABVUE 13. Applicant contends the Examining Attorney has failed to prove that COMMONS is merely descriptive. App. Brief, 9 TTABVUE 10.

In support of the refusal, the Examining Attorney relies on: dictionary definitions; Applicant's use of the term in its advertising; third-party registrations that include the word COMMONS disclaimed in the mark; and third-party usage of the term. The Examining Attorney submitted several dictionary definitions for COMMONS set forth below:

A piece of land subject to common use;<sup>1</sup>

A dining hall;<sup>2</sup> and

Land or resources belonging to or affecting the whole of a community.<sup>3</sup>

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<sup>1</sup> *Merriam-Webster* (2018) ([www.merriam-webster.com](http://www.merriam-webster.com)), October 9, 2018 Office Action at 2.

<sup>2</sup> *Id.*

<sup>3</sup> *Oxford Dictionary (US)* ([en.oxforddictionaries.com](http://en.oxforddictionaries.com)) April 17, 2019 Office Action at 2. Applicant's statement that this definition is British, is mistaken, it is clearly referenced as American, or US, English.

The Examining Attorney argues that the definition “a piece of land subject to common use” merely describes “the location or source (i.e., food delivery) of [Applicant’s] services” which are “provided in an area subject to common use.” Ex. Att. Brief, 11 TTABVUE 6. Further, the Examining Attorney asserts that the definition “a dining hall” shows “that commons are not limited to areas provided on the ground” and “is also descriptive of a characteristic or source of the Applicant’s services.” Ex. Att. Brief, 11 TTABVUE 7. In addition, because Applicant’s services, “providing dining services,” encompass the definition of “a dining hall,” COMMONS is immediately merely descriptive of those services. Finally, the Examining Attorney argues the definition, “land or resources belonging to or affecting the whole of a community,” shows the term is merely descriptive for Applicant’s services because Applicant “intends to provide resources (a world-class business and social hub fostering workplace creativity, collaboration, and community) to a defined community (tenants and their guests).” Ex. Att. Brief, 11 TTABVUE 8.

Applicant limits the definition of COMMONS by arguing that it is “inextricably tied to ‘a piece of land,’” in contrast to its services which are provided “high above the streets of Manhattan.” App. Brief, 9 TTABVUE 12. To illustrate its position that the wording “common use” in the definition for COMMONS does not make all places of common use “COMMONS,” Applicant provided a chart that juxtaposes its common use areas, e.g., “commercial office building amenities, namely, facilities for recreation” with other types of common use area services such as community centers, bowling alley and a casino and asserts that “no consumer would think of

them as ‘commons.’” *Id.* at 12-13. Applicant posits that because all of its facility services are restricted to “commercial office building amenities” it is “less likely that a consumer would consider them a ‘commons.’” *Id.* at 13. Moreover, Applicant argues that its services by their nature are provided to consumers, one person or group at a time. *Id.* at 14. In addition, Applicant points to multiple dictionary definitions including the definition “dining hall” and notes that the evidence of record shows that COMMONS in the relevant context of a dining hall denotes one in a residential school or college.<sup>4</sup> While we consider all of the definitions of record, we make our determination of mere descriptiveness in the context of the applied-for services and “so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018).


Applicant also points to the following six use-based third-party registrations it made of record for marks that include the word “COMMONS” for similar services without a disclaimer of the word “COMMONS.”<sup>5</sup>

- Reg. No. 3594518 for the mark  for “retail and wholesale farmer’s market services featuring produce, baked goods, food, plants, and personal care products,” International Class 45

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<sup>4</sup> Applicant submitted multiple dictionary definitions for the word “COMMONS” with its request for reconsideration, including “commons a (used with a singular verb) a large dining room, especially at a university or college.” Dictionary.com based on *The Random House Unabridged Dictionary* (2019), October 17, 2019 Req. for Recon, 4 TTABVUE 32.

<sup>5</sup> March 27, 2019 Response pp. 28-48. The third-party applications have no probative value other than as evidence that the applications were filed. *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019).

- Reg. No. 4822803 for the mark COWLES COMMONS for “entertainment in the nature of live music concerts; providing recreation facilities, namely, providing a public park for recreation purposes,” International Class 41
- Reg. No. 4733199 for the mark  for “bar and restaurant services; Restaurant and bar services, including restaurant carryout services; restaurant services, namely, providing of food and beverages for consumption on and off the premises,” International Class 43
- Reg. No. 5661723 for the mark FARMER’S COMMONS for “restaurant services,” International Class 43
- Reg. No. 4852595 for the mark THE COMMONS CLUB for “bar and restaurant services,” International Class 43
- Reg. No. 4930740 for the mark THE COMMONS AT OLD PARKLAND for “restaurant and cafeteria services,” International Class 43

In response, the Examining Attorney submitted 24 third-party registrations for purportedly similar types of services where the word “COMMONS” was disclaimed.<sup>6</sup> Applicant distinguishes the Examining Attorney’s evidence asserting they are for different services and that most involve shopping malls, which “relate to land, the development and management of land or the operation of real estate like shopping malls.” App. Brief, 9 TTABVUE 19. A few are for different types of services.

- Reg. No. 4586703 for the mark WIKIMEDIA COMMONS for “providing an on-line publication in the nature of an interactive encyclopedia in the field of general knowledge containing images, moving images, and audiovisual images for educational and entertainment purposes,” International Class 41 (April 17, 2019 Office Action pp. 36-38)
- Reg. No. 4473374 for the same mark for “providing an online searchable database featuring images, moving images, audiovisual images, and text in the field of scientific research; providing a website featuring technology that enables internet users to publicly share images, moving images, and audiovisual images,” International Class 42 (*Id.* pp. 36-39)

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<sup>6</sup> There are a total of 18 different owners out of the 24 registrations.

- Reg. No. 4829999 for the mark NORTON COMMONS for books, newsletters, publications about the Norton Commons planned community, International Class 16, charitable fundraising, International Class 36, hosting social entertainment event, various entertainment services, International Class 41 (*Id.* pp. 42-44)
- Reg. No. 4767484 for the same mark for construction of a planned community, International Class 37, entertainment services, International Class 41 (*Id.* pp. 45-57)
- Reg. No. 5187100 for the mark GA GREEN ACRES COMMONS for retail department store services; promoting the goods and services of shopping center lessees through holiday and special occasion sales promotions, providing informational services in the field of customer service and volunteer-based community service, International Class 35 (*Id.* pp. 48-50)

The Examining Attorney also submitted a few examples of third parties using the word COMMONS asserting the word is used “to identify common areas which provide services similar and/or identical to the applicant’s.”<sup>7</sup> A few representative examples are set out below.

The St. Charles City-County Library District provides meeting rooms for use by local community groups and organizations as a service to the community. The Community Commons at the Spencer Road Library is an extraordinary gathering space. It houses fully equipped large and small meeting rooms for organizations, businesses, and individuals.

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Whether you're working on the next *big thing* or just getting an idea off the ground, The Commons on Champa brings together the entrepreneurial resources and support to help you make a real impact.

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<sup>7</sup> November 6, 2019 Reconsideration Letter p. 1.

<sup>8</sup> *Id.* p. 2 (<http://www.communitycouncilstc.org>).

<sup>9</sup> *Id.* p. 3 ([www.thecommons.co](http://www.thecommons.co)).





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**Business Learning Commons – UW Madison Campus**

Initially, the Learning Commons project came out of practical need: When the first collaborative learning classroom proved to be a huge success after it opened in 2015, the School realized it was running out of active learning spaces. The Campus turned to Potter Lawson to help reimagine the heart of the School of Business and transform space on three floors into an active learning, flexible and forward thinking commons space.

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We find most of the examples to be somewhat ambiguous inasmuch as they may be interpreted as trademark usage. Such use may point to dilution but has less probative value in measuring mere descriptiveness.

Applicant argues that:

[T]he Examining Attorney’s argument fails because, at root, its logic is that Applicant’s amenity floor is a commons and, thus, COMMONS is descriptive of anything that is provided there (e.g., ‘retail store services featuring grab and go food and beverage items...’) or emanates from there (e.g., ‘food and meal delivery service’). In fact, no evidence of record supports the notion that Applicant’s floor is a commons and, failing such proof, the Examining Attorney may not logically assume (in his favor) a fact that is at or near the core of the issue. The Examining Attorney’s argument also fails because it is far from clear that, if a term is descriptive of a place, it must be descriptive of everything done there or that emanates from that place.

App. Brief, 9 TTABVue 20-21.

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<sup>10</sup> *Id.* p. 5 ([www.sierracommons.org](http://www.sierracommons.org)).

<sup>11</sup> *Id.* p. 4 ([www.potterlawson.com](http://www.potterlawson.com)).

<sup>12</sup> *Id.* p. 6 ([www.thecommonscolumbus.com](http://www.thecommonscolumbus.com)).

These arguments are not persuasive. Applicant's services specifically include "providing facilities for business meetings and business events; providing individual work spaces for business purposes; providing breakout areas for small business meetings and events," in International Class 35, "providing commercial office building amenities, namely, facilities for recreation and exercise, and for entertainment and leisure activities," International Class 41, and "providing commercial office building amenities, namely, providing general purpose facilities for business meetings, general purpose facilities for business conferences, conference facilities, social function facilities," International Class 43. These are areas for common use. The dictionary definition using the word "land" certainly refers to the area in a town called a commons, i.e., "land ... belonging to or affecting the whole of a community." However, when applied to the provision of facilities, the main aspect of which is the provision of a common use area, COMMONS is merely descriptive as it immediately informs the consumer there is a common use area. As explained in Applicant's advertising it provides "a 25,000F amenity space exclusively for tenants of One World Trade and their guests" and "this premium floor serves as a world-class business and social hub fostering workplace creativity, collaboration, and community."<sup>13</sup> It provides "flexible conference, meeting and event rooms, common areas, game room, and cafe coupled with state-of-the-art technology and services."<sup>14</sup> As noted above, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the

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<sup>13</sup> October 9, 2018 Office Action p. 3 ([www.onewtc.com](http://www.onewtc.com)).

<sup>14</sup> *Id.*

entire class. *In re Analog Devices Inc.*, 6 USPQ2d at 1808. The examples of bowling alleys and casinos etc. are inapposite. The feature of those services is the recreational activity provided. Here, for many of Applicants' applied-for services the main feature is the provision of the space.

However, with regard to the "food and meal delivery service" in International Class 39, this record does not support a mere descriptiveness finding. The connection to the meaning "dining hall" typically in a college is too attenuated to merely describe a feature of the services as coming from a COMMONS.

**Decision:** The refusal to register is reversed as to International Class 39 and affirmed as to International Classes 35, 41 and 43. However, if Applicant submits the required disclaimer within 30 days of the mailing date of this decision, the requirement will be met and the application will proceed in all four classes. Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). If the disclaimer is submitted, the wording will read as follows: No claim is made to the exclusive right to use "COMMONS" apart from the mark as shown in Classes 35, 41, 43. *See* TMEP § 1213.08(a)(i). In the event Applicant fails to submit the disclaimer, the application will proceed with the Class 39 services only.