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

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|------------------------|--|
| Proceeding             | 79096211   |
| Applicant              | The Newbridge Cutlery Company Limited Co   |
| Applied for Mark       | NEWBRIDGE  |
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| Date                   | 11/12/2012   |

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

In re Application of:           The Newbridge Cutlery Company  
U.S. Serial No.:                79/096,211  
International Reg. No.:        1074030  
Filing Date:                    October 14, 2010  
Mark:                            **NEWBRIDGE** (Logo)  
Law Office:                      116  
Examining Attorney:          John Dwyer

**APPLICANT'S APPEAL BRIEF**

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## I. PROCEDURAL HISTORY

On October 14, 2010, Applicant filed a Request for Extension of Protection to the United States for the mark NEWBRIDGE (Logo) through the International Bureau (“IB”) of the World Intellectual Property Organization under the aegis of the Madrid Agreement and Protocol. The mark bears International Registration No. 1074030 and consists of a design overlaying the word NEWBRIDGE. Registration in the United States was sought for a variety of goods that fall mostly within the broad categories of homeware and silverware. On or about May 18, 2011, the Examining Attorney mailed the first Office Action to the IB, provisionally refusing registration and requiring Applicant to amend the identification of goods and to disclaim NEWBRIDGE on the ground that this term was primarily geographically descriptive of the origin of Applicant’s goods.

In its response dated November 16, 2011, the Applicant amended the description of the goods to satisfy the objections, and argued against the requirement to disclaim the word NEWBRIDGE (the “First Response”). On January 5, 2012, the Examining Attorney issued a final Office Action, maintaining and making final the requirement to disclaim NEWBRIDGE (the “Final Office Action”).<sup>1</sup> Applicant filed a Request for Reconsideration and simultaneously filed a Notice of Appeal to the Board on June 28, 2012. The Request for Reconsideration was denied by the Examining Attorney on July 20, 2012. Subsequently, this appeal was resumed.

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<sup>1</sup> The identifications of goods were amended to the Examining Attorney’s satisfaction in the Request for Reconsideration and are not in issue in this appeal.

## II. THE EXAMINING ATTORNEY'S EVIDENTIARY RECORD

A. In the denial of the Request for Reconsideration, the Examining Attorney attached<sup>2</sup> the following evidence:

1. Articles from Lexis Nexis' database of Combined News and Business Sources that reference Newbridge, Ireland. The attached articles span a period of at least 18 years (beginning in 1994 to the present).<sup>3</sup> All of these articles are from ethnic or minor publications, such as, Kalamazoo Gazette, Topeka Capital Journal, Hartford Courant, Irish Voice, Arkansas Democrat-Gazette, Little Rock AK, etc. Not one of these articles goes beyond a passing mention of "Newbridge, Ireland." This evidence is not probative and should be excluded, as there is no reason to believe that these publications are widely read, or that over a period of 18 years, these articles have caused a sufficient number of U.S. consumers to make a geographic connection between the applied-for mark and Newbridge, County Kildare.

2. Printouts from the travel website "Tourism Ireland" at [www.tourismireland.com](http://www.tourismireland.com) . The website mentions tourism figures for visitors from the U.S to Ireland. This evidence is not probative and should be excluded because how many people in the United States are aware of Ireland is not the issue before the Board. Further, this evidence is not probative of how many, if any, of these visitors to Ireland visited Newbridge, County Kildare, or even gained awareness of this small Irish town.

3. "Tourist Statistical Report" of the Republic of Namibia. This evidence is not probative and should be excluded because it does not go to the issue before the Board regarding recognition among U.S. consumers of Newbridge, County Kildare, Ireland.

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<sup>2</sup> The exhibits adduced by the Trademark Office are not numbered.

<sup>3</sup> The search performed by the Examining Attorney does not appear to be date restricted. However, of the adduced articles, the earliest is from May 1994.

4. Printouts from travel websites at [www.distance-calculator.co.uk](http://www.distance-calculator.co.uk) and <http://kildaire.ie> showing that Newbridge, County Kildare, is a 40-minute drive from Dublin airport and is at a distance of 25 miles out of Dublin. Then again, the latter website also says that County Kildare “is also a couple of hours drive from most parts of Ireland.” This evidence is not probative and should be excluded as there is no indication that American consumers frequented these websites, undertook the drive to Newbridge, County Kildare, or are aware of the town of Newbridge, County Kildare.

5. A website entitled “Gregan Tours Ireland”, of a privately guided tour company based in County Kildare at [www.gregantoursireland.com](http://www.gregantoursireland.com) and a website of Ganter Chauffeur Drive, a similar private tour company based in Ireland, at <http://ganterchauffeurdrive.ie/day-tours/retail-tour/>. This evidence is not probative and should be excluded as there is no indication that American consumers frequented these websites, took these tours, or are aware of the town of Newbridge, County Kildare.

6. Printouts of the United States registration details of WATERFORD trademarks that were registered under Section 2(f) subsequent to WATERFORD being registered for glassware in 1972 by a company based in Waterford, Ireland. The original 1972 registration was not on the basis of acquired distinctiveness under Section 2(f). The attached evidence is irrelevant and not probative, and should be excluded.

B. In the final Office Action the Examining Attorney attached the following evidence:

1. A website entitled “Newbridge Town, County Kildare, Ireland” at <http://newbridge.ie>, which is operated by the Kildare County Council (Exhibit no. 1.) It is noted on the website that “silverware is crafted at the famous Newbridge Silver plant.” This evidence is not probative and should be excluded because there is no reason to believe that this website is

frequented by consumers of homeware and silverware in the United States. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

2. A website entitled “About Newbridge” at <http://kildare.ie>, which is operated by the Newbridge Town Council. This evidence is not probative and should be excluded because there is no reason to believe that this website is frequented by consumers of homeware and silverware in the United States. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

3. A website with the Wikipedia entry for “Newbridge, County Kildare”, which makes mention of the Applicant as follows, “Cutlery and silverware is crafted at the famous Newbridge Silverware plant.” However, this evidence is not probative and should be excluded because there is no reason to believe that this website is frequented by consumers of homeware and silverware in the United States, that is, “unsophisticated” consumers. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

4. A website of the Whitewater shopping center in Newbridge at [www.whitewatersc.ie/Newbridge-and-Co-Kildare](http://www.whitewatersc.ie/Newbridge-and-Co-Kildare). This evidence is not probative and should be excluded because there is no reason to believe that this website, which is operated and authored by a local Newbridge entity, is frequented by consumers in the United States.

5. Travel websites located at [www.discoverireland.com/gb/ireland-paces-to-go/placefinder/n/newbridge-kildare](http://www.discoverireland.com/gb/ireland-paces-to-go/placefinder/n/newbridge-kildare), and [www.irishtourist.com/kildare/towns/newbridge](http://www.irishtourist.com/kildare/towns/newbridge), both operated by private entities in Ireland and both of which indicate that Newbridge, County Kildare, is a place in Ireland to a visitor to this website who serendipitously drills down to this

webpage. But these webpages make no mention of cutlery, silverware or homeware.

Furthermore, this evidence is not probative and should be excluded because there is no reason to believe that this website is frequented by consumers in the United States resulting in exposure of any significance to Newbridge, County Kildare, Ireland. To the extent that this evidence is admissible, it shows that homeware and silverware are not the traditional industries of Newbridge, County Kildare, Ireland.

6. A travel website at [www.newbridgetown.com/things-to-see.asp](http://www.newbridgetown.com/things-to-see.asp), entitled “Visitor attractions in Newbridge and Kildare, [www.newbridgetown.com/things-to-do.asp](http://www.newbridgetown.com/things-to-do.asp), entitled “Things to do in and around Newbridge”, and [www.newbridgetown.com/accommodation-in-newbridge.html](http://www.newbridgetown.com/accommodation-in-newbridge.html), which is operated by an entity in Ireland. This evidence is not probative and should be excluded because there is no reason to believe that this website is frequented by consumers in the United States resulting in exposure of any significance of Americans to Newbridge, County Kildare, Ireland.

7. A website at [www.kildare.ie/tourism/thingstodo/tourist-guide.asp?ID=165](http://www.kildare.ie/tourism/thingstodo/tourist-guide.asp?ID=165) entitled “County Kildare”, operated by a partnership of Kildare-based agencies, which highlights the fame associated with Applicant’s showroom, restaurant, and its Museum of Style Icons to a visitor to this website who serendipitously drills down to this webpage. This evidence is not probative of the fact that “Newbridge” is primarily geographically significant to American consumers of homeware and silverware, and should be excluded as there is no reason to believe that this website is frequented by consumers in the United States. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

8. Again, a travel website of Gregan Chauffeur Drive, operated by a private tour company based in Ireland, at <http://greganchauffeurireland.ie/chauffeur-ireland-kildare-tour.htm>. This evidence is not probative and should be excluded as there is no indication that American consumers frequented these websites, took these tours, or are aware of the town of Newbridge, County Kildare. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

9. A travel website at [www.discoverireland.ie/Arts-Culture-Heritage/newbridge-silverware-visitor-centre/45211](http://www.discoverireland.ie/Arts-Culture-Heritage/newbridge-silverware-visitor-centre/45211) operated by Failte Ireland, which is the Irish Tourism Board. This website highlights the fame associated with Applicant's visitor center. This evidence is not probative of the fact that "Newbridge" is primarily geographically significant to American consumers of homeware and silverware, and should be excluded as there is no reason to believe that this website is frequented by consumers in the United States. To the extent that this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

10. Five articles from Lexis Nexis' database of the entirety of and "U.S. Newspapers and Wires" database that reference Newbridge, Ireland.<sup>4</sup> These articles are mostly from ethnic and minor publications, such as, Irish Voice, Hartford Courant, etc. Not one of these articles goes beyond making a passing mention of "Newbridge, Ireland." Further it should be noted that three of these five articles are in the context of the Applicant's own Museum of Styles Icons and go towards a showing of the Applicant's renown. The articles from Times-Union and Philadelphia Inquirer attached by the Examiner make mention of "Newbridge, Ireland" in

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<sup>4</sup> The search performed by the Examining Attorney does not appear to be date restricted.

passing in a single sentence.<sup>5</sup> In fact, the article in Irish Voice mentions the Applicant, not a geographic locale. The entirety of this evidence is not probative and should be excluded, as there is no reason to believe that these publications are widely read, or that these five articles have caused a sufficient number of U.S. consumers to make a geographic connection between the applied for mark and Newbridge, County Kildare, Ireland. To the extent that a part of this evidence is admissible, it shows the renown and brand recognition of the Applicant and its marks.

11. Selections of webpages from the Applicant's website at [www.newbridgesilverware.com](http://www.newbridgesilverware.com).

C. In the first Office Action, the Examiner relied on the following evidence:

1. The entry for "Newbridge" from Wikipedia, which indicates that Newbridge is a place in County Kildare, Ireland, but makes no mention that Newbridge is known for homeware and silverware. In fact it first lists "rope making" and "carpet manufacturing" as the industries for Newbridge. The Wikipedia entry then mentions that cutlery and silverware is manufactured at Applicant's plant. This evidence shows the renown and brand recognition of the Applicant and its marks, but does not detract in any manner from the fact that "Newbridge" is not of primarily geographic significance to consumers in the United States.

2. A webpage from Applicant's website at [www.newbridgesilverware.com](http://www.newbridgesilverware.com).

### III. ISSUES ON APPEAL

Applicant appeals the Examining Attorney's refusal to extend protection to the United States/register the trademark NEWBRIDGE (Logo) (the "Mark") on the ground that

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<sup>5</sup> It is, further, not clear whether the reference in the articles to "Newbridge, Ireland" is to Newbridge, County Kildare, or to Newbridge, County Galway, or to Newbridge, County Londonderry in Ireland.

NEWBRIDGE is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act and requiring Applicant to disclaim this term. The issues on appeal before the Board are, whether (i) the primary significance of “Newbridge” is that of the name of a place generally known to the relevant American purchasing public, and (ii) the relevant American purchasing public would make a goods/place association.

#### IV. ARGUMENT

##### A. History Of The Applicant And The Mark

As Newbridge, County Kildare, entered the 1930's it was a town in crisis. The Irish Government, aware of the problem throughout Ireland, encouraged the setting up of new manufacturing enterprises in the non-traditional areas outside the major cities. Newbridge Cutlery was established in 1934 – over 75 years ago – in a section of the old military barracks. The plan was to manufacture silver-plated knives and forks for the home market, the traditional industries of this region being rope-making and agriculture. At the time that Applicant set up its manufacturing unit, there were no other cutlery or silverware manufacturers in Newbridge. Applicant's founders were pioneers of this industry in Newbridge. They brought over a few men skilled in the art of making cutlery from Sheffield, and they in turn trained and taught the local labor force an entirely new trade and craft. The Applicant grew quickly and, over the years, Applicant added silverware and other items of homeware to its offerings. *See* Request for Reconsideration at pp. 2-4 and Exhibit no. 14 thereto. *Also see* Exhibit no. 21 to the Request for Reconsideration.

Applicant was and is the only manufacturer of cutlery, silverware and homeware in Newbridge. *See* Exhibit no. 1 to the Request for Reconsideration – a declaration of William Doyle, the Managing Director of the Applicant. For over 75 years, Applicant has been Ireland's premier designer and producer of cutlery, silverware and associated homeware. *Id.* Its marks are

well-known for homeware, cutlery, silverware, giftware and jewelry throughout Ireland and in other countries. *See* Request for Reconsideration at pp. 2-4.

**B. The Mark Is Not Geographically Descriptive**

A mark is primarily geographically descriptive if the following is demonstrated by the Trademark Office:

(i) the Mark's primary significance is a geographic place that is generally known to the relevant American public;

(ii) the goods for which registration is sought in fact originate in the geographic place identified in the applied-for mark; and

(iii) the relevant American purchasing public will make a goods/place association, that is, they would believe that the goods identified in the application originate in the geographic place named in the mark.

*See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 3 U.S.P.Q.2d 1450, 824 F.2d 957, 960 (Fed. Cir. 1987); *In re Brouwerij Nacional Balashi NV*, 80 U.S.P.Q.2d 1820,1821 (TTAB 2006).

1. The primary significance of NEWBRIDGE is not geographic

To the American purchasing public, the primary significance of Newbridge is not geographic because: (i) the small town of Newbridge, County Kildare, is relatively remote and obscure; (ii) there exist several geographic places called "Newbridge", including at least two others in Ireland alone – Newbridge being a common name for towns and settlements connected by a newly constructed bridge; (iii) "Newbridge", being a conjoining of "new" and "bridge", is commonly used as a trademark in a non-geographical sense by a very large number of entities in the U.S. and abroad; and (iv) there are several registrations for marks containing the term "Newbridge" in the United States, none of which have required a disclaimer of Newbridge.

Applicant's customers are the average purchasers of homeware, cutlery, and silverware, not the unusually well-traveled person, or silverware aficionado. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 3 U.S.P.Q.2d 1450, 1452, 824 F.2d 957 (Fed. Cir. 1987), a case in which the applied for goods came within the umbrella of cosmetics, the court held:

In dealing with all of these questions of the public's response to word symbols, we are dealing with the supposed reactions of a segment of the American public, in this case the mill-run of cosmetics purchasers, not with the unusually well-traveled...

*Id.* The mill-run American consumer of most of the applied-for goods is an average member of the populace who purchases items such as forks, knives, spoons, silver-plated jewelry, etc.

There is nothing in the record that establishes that the American customer described above, has any notion of the geographic significance of Newbridge. Newbridge is a town of approximately 17,000 persons (2006 census) in County Kildare, Ireland, which grew around barracks built in 1816. Its major industries are rope making and agriculture. *See* entry for "Newbridge" in Columbia Gazetteer of the World attached as Exhibit no. 21 to the Request for Reconsideration. It also houses the headquarters of the agency responsible for the exploitation of peat resources in Ireland. *Id.* Newbridge is not even in the top 10 largest cities in Ireland. *See* Exhibit nos. 10 and 11 to the Request for Reconsideration. Thus, while there is evidence that Newbridge, County Kildare is a geographic locale in Ireland with modest industry, it does not mean that "Newbridge" is primarily geographically significant to a U.S. purchaser of the applied-for goods.

There is no evidence of record that suggests that Newbridge has been raised in the consciousness of the average American consumer so as to render it primarily geographically significant. *See In re Namibia Breweries Limited*, 2011 TTAB LEXIS 309 (TTAB Sept. 12,

2011) (“That is, it must be shown that relevant purchasers would *readily recognize* that the allegedly geographical designation at issue (be it the mark as a whole or the relevant portion thereof) is in fact the name of a geographical place...”)(emphasis added.) The record is devoid of any evidence that consumers in the U.S. would “readily recognize” Newbridge to be the name of a geographical place. In fact the evidence clearly shows that the primary significance of “Newbridge” to the relevant American public is minor because of the remoteness and obscurity of Newbridge as a geographic location.

There is nothing in the small town of Newbridge, County Kildare, that would render it anything other than an obscure and remote geographic location to the average American purchaser of the goods for which registration is sought. The evidence relied upon by the Examining Attorney, consisting of printouts of pages from the websites of the Kildare County Council, the Newbridge Town Council, WhiteWater shopping mall located in Newbridge, NewbridgeTown.com, and Irish travel-oriented websites are not probative of a showing that a significant number of relevant American purchasers would know of the geographic significance of NEWBRIDGE as being Newbridge, County Kildare, Ireland. There is no evidence that shows that Newbridge, County Kildare, is a popular tourist destination for Americans or has been advertised and promoted as such, or is visited frequently by travelers from the United States on business, or is visited by American scholars with any regularity, or is economically or culturally significant to the average American consumer. There is further no evidence on record that shows that Newbridge, County Kildare, is the home of international institutions, or is associated with sports teams that participate in international sporting events.

Further, Newbridge is not found in commonly available political maps of Ireland on the Internet. *See e.g.* printouts of maps available from the following websites, collectively, at

Exhibit no. 10 to the Motion for Reconsideration: CIA World Factbook, [www.infoplease.com](http://www.infoplease.com), [www.worldatlas.com](http://www.worldatlas.com), [www.mapsoftheworld.com](http://www.mapsoftheworld.com), [www.lonelyplanet.com](http://www.lonelyplanet.com), and [www.geology.com](http://www.geology.com). Newbridge, County Kildare, is not Ireland's largest city, or even in the top ten largest cities of Ireland; it is not Ireland's capital; its population was approximately 17,000 people in 2006; and is not the nation's administrative, educational, communications, or economic center. Newbridge is not even listed amongst Ireland's "Major cities." See a printout of the CIA World Factbook for Ireland at Exhibit no. 11 to the Request for Reconsideration.

The Examiner also has relied upon sporadic, scattered, and passing references to Newbridge, Ireland in a few articles in the complete Lexis databases of "U.S. Publications" and "U.S. Newspapers." While some of the articles refer to the activities of the Applicant and go towards a showing of the Applicant's renown, the remainder are from inconspicuous publications. To be sure, not one of these articles reports on Newbridge, County Kildare, Ireland, instead all of these articles make only a fleeting reference to it. Such references do not sufficiently raise Newbridge in the consciousness of an average American consumer of the goods for which Applicant seeks registration. See *In re Namibia Breweries Limited*, 2011 TTAB LEXIS 309 (TTAB Sept. 12, 2011), in which the TTAB stated:

For example, there is no evidence that Windhoek, Namibia (or Namibia in general) is commonly mentioned or reported on in the American press or other mass media such that, as a result of such coverage, American consumers will have been exposed to the designation "Windhoek" and thus would know of its geographical significance when they encounter applicant's marks.

There is no evidence indicating that the general public would understand NEWBRIDGE as an indicator of geographic origin or that they would be aware of the geographic town or county named "Newbridge." Newbridge simply does not have geographic appeal to an average American consumer of homeware, cutlery, crockery and silverware.

The primary significance of “Newbridge” is not a geographic location also because the term “Newbridge” consists of the joining of two common words of the English language, namely, “new” and “bridge.” The conjoined word is used as a mark or trade name by innumerable businesses in the United States and around the globe, usually to denote/evoke a path from a position of lack to one of fulfillment, or a means of joining the consumer with his/her goals by means of a “bridge” that is “new.” Amongst others, Newbridge is used by educational institutions, retirement homes, banks, churches, doctors and brokers. A simple search on Google for the term “Newbridge” will show that the non-geographic uses of “Newbridge” as connoting a “new bridge” overwhelmingly outnumber the use of “Newbridge” as a geographic location.<sup>6</sup> *See* a very small selection from a vast array of providers of services and goods using “Newbridge” as their trademark in the context of bridging a gap at Exhibit no. 12 to the Request for Reconsideration. Thus a customer encountering NEWBRIDGE will not consider the mark to be primarily geographically significant.

Again, there are several geographic locations called “Newbridge”, including at least three in Ireland itself, rendering none of these locations particularly distinctive. *See* printout from Wikipedia of “Newbridge” at Exhibit no. 7 to the Request for Reconsideration, showing at least 21 locations in Ireland, England and Australia named “Newbridge.” *Also see In re Eastern National*, 2001 WL 1547936 (TTAB Nov. 29, 2001) (the term “Independence Park” “is not particularly distinctive” because there were Independence Parks in at least ten states.) Usually, the presence of a newly-constructed (at the time) bridge would give an area the name of

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<sup>6</sup> The use by third parties of the trade name or trademark “New Bridge” (as two separate words) has not been included, although there is no material difference between “New Bridge” and “Newbridge” insofar as this discussion of primarily geographic and other significance is concerned. The fact remains that Newbridge is a mere conjoining of “new” and “bridge” which is very commonly used in a non-geographic sense.

Newbridge. *See* printouts from Wikipedia of Newbridge, Bath (“The area is named after the New Bridge over the River Avon outside Bath, built in 1734”) and Newbridge, County Galway (The English name Newbridge comes from the village’s iconic bridge over the Shiven River.”), collectively, at Exhibit no. 8 to the Request for Reconsideration. Indeed, the traditional Gaelic name of the area that is now also known as Newbridge, County Kildare, is An Droichead Nua (trans. The New Bridge.)<sup>7</sup> Moreover, Mirriam-Webster’s Geographical Dictionary (3d edn.) does not even have an entry for Newbridge, County Kildare. Its only entry for “Newbridge” refers to Abercarn, a coal-mining region in Wales, formerly known as Newbridge. *See* Exhibit no. 9 to the Request for Reconsideration, which is a copy of the relevant page referred to in the entry for “Newbridge.” That Welsh town had a population of approximately 17,500 persons in 1981.

No less importantly, the Trademark Office has granted registration to several marks containing the term “Newbridge.” *See* a printout from the USPTO’s computerized TESS database of a selection of a total of 15 live registrations (excluding Applicant’s applications) for marks containing the term “Newbridge” at Exhibit no. 13 to the Request for Reconsideration. In not a single one of these registrations has a disclaimer for “Newbridge” been required. These registrations are for goods and services such as consultancy, surgical implants, pre-recorded media in the field of education, books and magazines, trousers, retirement home, banking, education, etc. “A mark that has a popular significance apart from its geographical meaning is not, in most cases, ‘primarily’ geographical.” *In re International Taste Inc.*, 53 U.S.P.Q.2d 1604, 2000 WL 177409, \*2 (TTAB 2000), *citing*, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:28 (4th Ed. 1999) and *World Carpets, Inc. v. Dick*

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<sup>7</sup> Similarly, there are towns aplenty with names such as Newcastle, Newmarket, Newtown, etc. in Ireland and elsewhere, rendering no particular town called, say, “Newcastle” particularly distinctive.

*Littrell's New World Carpets*, 438 F.2d 482, 168 USPQ 609 (5th Cir. 1971) (“The word ‘primarily’ should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote or unconnected with the goods.”); *In re Eastern National*, 2001 WL 1547936, \*2 (same).

In sum, there is no evidence showing that Newbridge is generally known to the American public or is anything other than remote and obscure to the ordinary American customer of the applied-for goods. This obscurity is compounded by the fact that “Newbridge” is in overwhelmingly common use by businesses throughout the world in a non-geographic sense; there are several towns across many nations named “Newbridge”, rendering none of them particularly distinctive; and the USPTO has granted registration to at least 15 marks containing the term “Newbridge”, without requiring a disclaimer of the term.

2. There is no goods/place association

Newbridge is not only a remote and obscure to the average American purchaser of homeware, cutlery, crockery and silverware, there is no goods/place association between Newbridge and homeware, cutlery, crockery and silverware. The average American consumer of these goods will simply not associate these goods with Newbridge, County Kildare.

The CIA World Factbook lists the following as the industries of Ireland: “pharmaceuticals, chemicals, computer hardware and software, food products, beverages and brewing; medical devices.” *See* Exhibit no. 11 to the Request for Reconsideration at p.6 thereof. It states that Ireland’s exports are: “machinery and equipment, computers, chemicals, medical devices, pharmaceuticals; food products, animal products.” *Id.* at p. 7. None of these encompass the applied-for goods, which fall under the rubrics of homeware, cutlery, silverware, and jewelry and the American public will not associate Ireland or, particularly, Newbridge with these goods.

In order to establish a goods/place association in the mind of the ordinary American customer, the Examining Attorney has relied on a selection of webpages from Applicant's website and certain third party websites. The Applicant's website refers to its own fame and renown as a source of the applied for goods, not that of Newbridge, County Kildare. Insofar as third party websites are concerned, in the Final Office Action the Examining Attorney has proffered the website of the Kildare County Council ([www.newbridge.ie](http://www.newbridge.ie)), the website of the Newbridge Town Council ([www.kildare.ie](http://www.kildare.ie)), and the website of Gregan Chauffeur ([www.greganchauffeurireland.ie](http://www.greganchauffeurireland.ie)), an Ireland-based business that offers tours of County Kildare. This evidence is not probative of a goods/place association in the minds of the ordinary American consumer, as it is not authored by an American entity, and there is no reason to believe that ordinary American consumers frequent these websites, or that the contents of these websites have been utilized by such consumers, or that the contents thereof have caused Newbridge, County Kildare to enter the consciousness of Americans such that they would make a goods/place association.

Applicant was and continues to be even after more than 75 years of existence the only manufacturer of the applied-for goods in Newbridge. *See* Declaration of Applicant's Managing Director at Exhibit no. 1 to the Request for Reconsideration. Applicant has achieved renown as a source of quality goods. The Examiner has not adduced any evidence showing that there is a cutlery or silverware industry, or a manufacturer of those goods in Newbridge other than the Applicant. *See In re Brauerei Aying Franz Inselkammer KG*, 217 U.S.P.Q. 73 (TTAB 1993) (AYINGER BIER ("BIER" disclaimed) held not primarily geographically descriptive of beer from Aying, West Germany, where the examining attorney did not provide any evidence

refuting the alleged obscurity of Aying or establishing that it is known, separate and apart from any labels, as a beer producing area.)

To the extent that the evidence relied upon by the Examiner is probative of anything, it establishes not that there is a goods/place association, but that given the success and concomitant renown of the Applicant and its NEWBRIDGE marks over a 75-year period, consumers recognize the NEWBRIDGE marks as applied to homeware and silverware as Applicant's marks, not a geographic location. Thus, for the sake of argument, even if sufficient numbers of ordinary American consumers are somehow familiar with the third party references cited by the Examining Attorney, that evidence shows that upon encountering Applicant's mark these consumers will not make a goods/place association, but a goods/source association. The Applicant's website speaks of the fame associated with the Mark and the references therein to "Newbridge Silverware" are to itself, not to silverware made in Newbridge.

Applicant has essentially *created* and it *is* the cutlery and silverware industry in Newbridge. See printouts from the website [www.newbridgehistory.org](http://www.newbridgehistory.org) for the topic "Industry" at Exhibit no. 14 to the Request for Reconsideration. This third party website lists three entries for rope and carpet manufacturers, one for the Board of Peat and only one for Cutlery – under the former name of Applicant. Therefore, if one were to remove the Applicant and its renown from the picture, Newbridge, County Kildare, Ireland would be left with the carpet manufacturers, its market for agricultural produce and the Irish Peat Board. The references to Newbridge in the evidence proffered by the Examining Attorney in the context of homeware, silverware and jewelry are to the Applicant, not to the geographic locale. Thus, it is the Applicant that is known, not the geographic area. None of the proffered evidence would make Newbridge known to the average American consumer of homeware and silverware as a geographic location, or

would cause them to make a goods/place association with these goods. There is simply no goods/place association and there is nothing in the record that would support such a conclusion.

**V. CONCLUSION**

In view of the foregoing, it is clear that Newbridge is a remote or obscure geographic location to American consumers of homeware, cutlery, crockery, silverware and jewelry, there is no goods/place connection between Newbridge and the goods for which Applicant seeks registration, and the USPTO has not met its burden of establishing prima facie that the applied for mark is primarily geographically descriptive. Applicant respectfully requests that the disclaimer requirement be withdrawn.

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Respectfully submitted,



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