From: Dwyer, John

Sent: 7/20/2012 12:43:12 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 79096211 - NEWBRIDGE - 101089.MED01 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 4

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Attachment Information:
Count: 7
Files: lex1.jpg, lex2.jpg, lex3.jpg, lex4.jpg, lex5.jpg, lex6.jpg, 79096211.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 79096211

MARK: NEWBRIDGE

CORRESPONDENT ADDRESS:
KANISHKA AGARWALA
ANDERSON KILL & OLICK, P.C.
1251 AVENUE OF THE AMERICAS
NEW YORK, NY 10020

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: The Newbridge Cutlery Company Limited Co ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:
101089.MED01
CORRESPONDENT E-MAIL ADDRESS:
ipg@andersonkill.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/20/2012
INTERNATIONAL REGISTRATION NO. 1074030

On January 5, 2012, a final Office action was issued refusing registration of the applied-for mark based upon a requirement for clarification of the identification of goods and a requirement for a disclaimer of NEWBRIDGE as primarily geographically descriptive. On June 28, 2012, applicant responded by filing a notice of appeal to the Trademark Trial and Appeal Board (Board) and a request for reconsideration of the final refusal. The Board then suspended the appeal and remanded the application to the trademark examining attorney for consideration of the request

The trademark examining attorney has carefully reviewed applicant's request for reconsideration. The amended identification of goods is accepted and made part of the record. However, with regard to the disclaimer requirement, the examining attorney is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). Accordingly, the requirement for a disclaimer of NEWBRIDGE, made final in the Office action dated January 5, 2012, is maintained and continues to be final. *See* TMEP §§715.03(a), 715.04(a).

Specifically, applicant argues that the geographic location Newbridge, County Kildare, Ireland "is not well-known to the relevant public in the United States." See Request for

Reconsideration dated 06/28/2012 at 4. However, the previous Office actions contained sufficient evidence to establish that Newbridge is not obscure or remote. An additional twenty articles from publications are attached hereto which make reference to Newbridge, Ireland. In light of the combined evidence, Newbridge is not obscure or remote.

Applicant also seeks to compare Newbridge with Windhoek from *In re Namibia Breweries Ltd*. See Request for Reconsideration dated 06/28/2012 at 6. However, the Board determined that Windhoek was not primarily geographically descriptive in part due to the lack of any evidence in the record indicating "that Windhoek (or Namibia, or southern Africa) is a common or likely tourist or travel destination for American consumers. . . ." *In re Namibia Breweries Ltd*., Ser. Nos. 77761812 and 77761817, 2011 TTAB LEXIS 309, *14-15 (Sept. 12, 2011) (To view and print this unpublished decision, visit http://ttabvue.uspto.gov/ttabvue/ and insert the serial number(s) specified). In the present case, the evidence attached to the previous Office actions demonstrated that Newbridge has numerous tourist attractions and is even "world renowned" for its production of fine silverware. In addition, the attached evidence establishes that visitors from the United States form the second largest group of visitors to Ireland, with somewhere between 870,000 to 885,000 U.S. citizens visiting Ireland annually. Comparatively, the attached tourism report for Namibia indicates that in 2010, the last year for which statistics were available, only 17,826 U.S. citizens visited Namibia. See page 10 of the attached excerpt of the report (due to the length of the report, only the first sixteen pages, which contain the relevant information, have been attached; however, the entire report may be found at http://www.namibiatourism.com.na/uploadedFiles/NamibiaTourism/Global/Downloads_Modules/Research_Center/Tourist%20Statistical%20Report%20(MET,%202010).pdf). Thus, Ireland is a vastly more popular tourist destination for U.S. consumers than Namibia. Further, 77% of U.S. travelers in Ireland in 2009 chose to visit the region of Dublin. Newbridge is located in close proximity to Dublin, specifically, less than 30 miles away. The attached evidence further demonstrates that day tours are provided from Dublin to Kildare County, with stops in Newbridge. This evidence indicates that U.S. consumers travelling in Ireland are likely to gain exposure to Newbridge. (See attachments).

Applicant also contends that "[t]here is no goods/place association" in this case. See Request for Reconsideration dated 06/28/2012 at 8. However, a prima facie showing that a public association exists between applicant's goods and the geographic place named in the mark is sufficient to support a refusal. The named geographic location need not even be well-known or noted for the goods, but only likely to be associated with applicant's goods. *See* TMEP §§1210.04, 1210.04(a); *see, e.g.*, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1989). Here, the geographic location named in the applied-for mark more than meets this test because the evidence attached to the previous and current Office actions demonstrates that Newbridge, Ireland has been well-known, even famous, for decades due in part to its cutlery and silverware industry.

Finally, applicant argues that it is the applicant itself which is renowned for the manufacture of the homeware and silverware products, rather than the geographic location of Newbridge, Ireland. See Request for Reconsideration dated 06/28/2012 at 9-10. Applicant refers to several third-party registrations that include geographic locations in the marks and appears to contend that the geographic locations in the third-party marks were once little known but have achieved renown due to the success of the mark owners. *Id*. at 9-10. However, the record shows that U.S. Reg. No. 1198186 for the mark POLAND SPRING and U.S. Reg. No. 0545056 for the mark CORNING, both of which are noted by applicant in its request for reconsideration, have been registered under Section 2(f) based on a showing of acquired distinctiveness due to the primarily geographically descriptive nature of the marks. Applicant also points to U.S. Reg. No. 0951941 for the mark WATERFORD, for which the original registrant is listed as having its address in Waterford, Ireland. However, the attached examples of ten additional registrations owned by the same registrant all have the term WATERFORD registered under Section 2(f) based on a showing of acquired distinctiveness due to the primarily geographically descriptive nature of the term. Thus, these third-party marks were nonetheless found to be primarily geographically descriptive by the USPTO. Therefore, that Waterford, Ireland may have gained renown due to the registrant's presence in that location, or similarly, that Newbridge, Ireland may have gained renown due to the applicant's presence in that location, does not subtract from the geographic descriptiveness analysis. What remains relevant in the analysis is (1) that the primary significance of the mark is a generally known geographic place or location, (2) that the goods originate in the geographic place named in the mark, and (3) that purchasers are likely to believe that the goods originate in the geographic place identified in the mark. TMEP §1210.01(a); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1309 (TTAB 2006). How the geographic location came to gain its significance is of no moment in the analysis. In this case, each of the three factors listed above have been established through the evidence of record. Therefore, applicant's request is denied.

Accordingly, the Trademark Trial and Appeal Board has been notified to resume the appeal. *See* TMEP §715.04(a).

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Big Win for Laois Over Dublin Irish Voice February 1, 2012 - February 7, 2012

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February 1, 2012 - February 7, 2012

SECTION: SPORTS: SPORTS DIGEST; Pg. 29 Vol. 26 No. 5 ISSN: 0895-4534

LENGTH: 1165 words

HEADLINE: Big Win for Laois Over Dublin

BYLINE: Dervan, Cathal

BODY:

... being honest. Going on current form for the last two or three years, that is where we are. We have to work our way back up. It is not going to happen overnight."

GUShHtS

THE final of the O'Byrne Cup between **Kildare** and DCU has been refixed for Friday, February 17, in Portlaoise after heavy rain called the original fixture in **Newbridge** last Sunday to be postponed . . .

PORTADOWN soccer player Shane McCabe has quit the Irish League club to concentrate on Gaelic football with the Fermanagh squad managed by Peter Canavan . . .

SEANIE Johnston is a ...

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
View: KWIC
Date/Time: Friday, July 20, 2012 - 10:22 AM EDT

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Ethel T. Judge Courier News (Bridgewater, New Jersey) December 27, 2011 Tuesday

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Courier News (Bridgewater, New Jersey)

December 27, 2011 Tuesday

SECTION: OBITUARIES

LENGTH: 234 words

HEADLINE: Ethel T. Judge

BODY:

Survivors include her Son, Tom Judge and his wife Judye and their children Brian and Jared of Princeton, NJ Daughter, Terry Roche and her husband Patrick and their children: Olivia and her husband Paul, Carolyn, Sinead, Patrick and John of **Newbridge, Ireland** Son, Martin Judge and his wife Elsebet of Copenhagen, Denmark Daughter, Kathy and Woody Wood of Annandale, NJ sister, Dorris Huth of Rego Park, NY Great Grandson Eoghan. She was predeceased by sisters ...

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
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Bright Lights Shine for McCallany Irish Voice March 16, 2011 - March 22, 2011

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Irish Voice

March 16, 2011 - March 22, 2011

SECTION: Pg. 36 Vol. 25 No. 11 ISSN: 0895-4534

LENGTH: 1748 words

HEADLINE: Bright Lights Shine for McCallany

BYLINE: Drew, April

BODY:

... son, McCallany's father knew there was only one thing that could sort him out - a strict Catholic education.

"He was determined I was going to have an Irish education so he sent me to a boarding school in **Newbridge,** Co. **Kildare,** the same one he himself went to," McCallany said, admitting it was the last place on earth he wanted tobe.

McCallany was familiar with the Irish school system by then. When he turned five Holt and his brother, Michael, were ...

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
View: KWIC
Date/Time: Friday, July 20, 2012 - 10:23 AM EDT

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IN FOCUS: NIALL BRENNAN Irish Voice October 20, 2010 - October 26, 2010

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October 20, 2010 - October 26, 2010

SECTION: INTELLIGENCER; Pg. 20 Vol. 24 No. 42 ISSN: 0895-4534

LENGTH: 632 words

HEADLINE: IN FOCUS: NIALL BRENNAN

BYLINE: Drew, April

BODY:

FULL TEXT

OCCUPATION:Proprietor of MaU Brennan Stables in Florida.

Tell us about yourself.

"I grew up in **Newbridge**, Co. **Kildare,** on a farm just outside of town. My father, Liam Brennan, formerly a champion jockey in **Ireland** in the late 1950s, was then training and used part of the farm for stables and schooling grounds. His brother Dennis continued to farm the rest of the land that my grandfather had left them.

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
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FRANZ, Patricia (Chisholm) Hartford Courant (Connecticut) October 4, 2010 Monday

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Hartford Courant (Connecticut)

October 4, 2010 Monday
STATEWIDE EDITION

SECTION: CTNOW; Pg. B2

LENGTH: 221 words

HEADLINE: FRANZ, Patricia (Chisholm)

BODY:

... 20, 1955 at St. Mary's Church in Coventry, and recently celebrated their 55th anniversary. In addition to her husband, she is survived by two sons and a daughter, Michael Franz and his wife Catherine of **Newbridge, Ireland**, Peter Franz and his wife Marjorie of Norwalk, and Mary Anne Franz and her partner Carol Keogh of Stratford, 5 loving grandchildren; Rory, Daniel and Katie Franz of **Ireland**, John and Jennie Franz of Danbury. She was predeceased by her brother Raymond Chisholm.

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
View: KWIC
Date/Time: Friday, July 20, 2012 - 10:25 AM EDT

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Patricia Chisholm Franz New Jersey native, wife, mother, grandmother, 81 The Star-Ledger (Newark, New Jersey) October 4, 2010 Monday

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The Star-Ledger (Newark, New Jersey)

October 4, 2010 Monday
STATE/ROP EDITION

SECTION: NEWS; Pg. 022

LENGTH: 299 words

HEADLINE: Patricia Chisholm Franz New Jersey native, wife, mother, grandmother, 81

BODY:

... parishioner of St. Thomas the Apostle Church in Norwalk, as well as a member of their Rosary Society.

In addition to her husband, she is survived by two sons and a daughter, Michael Franz and his wife, Catherine, of **Newbridge, Ireland**, Peter Franz and his wife, Marjorie, of Norwalk, Conn., and Mary Anne Franz and her partner, Carol Keogh, of Stratford, Conn., and five loving grandchildren, Rory, Daniel and Katie Franz of **Ireland**, and John and Jennie Franz of Danbury, Conn. She is also survived by three nieces, one nephew, and several cousins. She was predeceased by her brother, Raymond Chisholm.

Pat will be missed by all of us who were ...

Source: **News & Business > / . . . / > US Newspapers and Wires**
Terms: **(newbridge) w/25 (kildare or ireland)** (Suggest Terms for My Search)
View: KWIC
Date/Time: Friday, July 20, 2012 - 10:25 AM EDT

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