

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79143258
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_20915515266-20150424193304054725_ . Request for Reconsideration - _Argument_ .PDF
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\432\79143258\xml11\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\432\79143258\xml11\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\432\79143258\xml11\RFR0004.JPG
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DESCRIPTION OF EVIDENCE FILE	Argument
GOODS AND/OR SERVICES SECTION (005)(current)	
INTERNATIONAL CLASS	005
DESCRIPTION	
Pharmaceutical and veterinary preparations; foodstuffs and dietetic substances for medical or veterinary purposes; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; beverages adapted for medical purposes; medicinal drinks; medicinal additives	
GOODS AND/OR SERVICES SECTION (005)(proposed)	
INTERNATIONAL CLASS	005

TRACKED TEXT DESCRIPTION

~~Pharmaceutical and veterinary preparations;~~ Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes; ~~foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss;~~ food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; ~~dietetic beverages adapted for medical purposes;~~ dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; ~~dietetic foods adapted for medical purposes;~~ dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, weight loss beverages and health beverages; ~~beverages adapted for medical purposes;~~ beverages adapted for medical purposes, namely, weight loss beverages and health beverages; medicinal drinks; ~~medicinal additives;~~ medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

FINAL DESCRIPTION

Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, weight loss beverages and health beverages; beverages adapted for medical purposes, namely, weight loss beverages and health beverages; medicinal drinks; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

GOODS AND/OR SERVICES SECTION (032)(current)

INTERNATIONAL CLASS	032
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DESCRIPTION

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks (not for medical purposes); beverages enriched with additional minerals (not being for medical use); beverages enriched with added trace elements (not for medical purposes); beverages enriched with added vitamins (not for medical purposes); isotonic beverages not for medical purposes; non-alcoholic malt-free beverages (other than for medical purposes)

GOODS AND/OR SERVICES SECTION (032)(proposed)

INTERNATIONAL CLASS	032
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TRACKED TEXT DESCRIPTION

~~Beers;~~ non-alcoholic beverages, namely, fruit juice, whey drinks, milk drinks, and substitutes thereof; ~~mineral and aerated waters and other non-alcoholic beverages;~~ fruit beverages and fruit juices; syrups and other preparations for making beverages in the nature of syrup substitutes for making beverages;

~~syrops and other preparations for making beverages; energy drinks not for medical purposes; energy drinks (not for medical purposes); beverages in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof enriched with additional minerals not being for medical use; beverages enriched with additional minerals (not being for medical use); beverages enriched with added trace elements in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; beverages enriched with added trace elements (not for medical purposes); beverages enriched with added vitamins in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; beverages enriched with added vitamins (not for medical purposes); isotonic beverages not for medical purposes; non-alcoholic malt-free beverages other than for medical purposes; non-alcoholic malt-free beverages (other than for medical purposes)~~

FINAL DESCRIPTION

non-alcoholic beverages, namely, fruit juice, whey drinks, milk drinks, and substitutes thereof; fruit beverages and fruit juices; syrups and other preparations for making beverages in the nature of syrup substitutes for making beverages; energy drinks not for medical purposes; beverages in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof enriched with additional minerals not being for medical use; beverages enriched with added trace elements in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; beverages enriched with added vitamins in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; isotonic beverages not for medical purposes; non-alcoholic malt-free beverages other than for medical purposes

GOODS AND/OR SERVICES SECTION (033)(current)

INTERNATIONAL CLASS

033

DESCRIPTION

Alcoholic beverages (except beers)

GOODS AND/OR SERVICES SECTION (033)(proposed)

INTERNATIONAL CLASS

033

TRACKED TEXT DESCRIPTION

~~Alcoholic beverages (except beers);~~ [Alcoholic beverages except beers](#)

FINAL DESCRIPTION

Alcoholic beverages except beers

GOODS AND/OR SERVICES SECTION (035)(current)

INTERNATIONAL CLASS

035

DESCRIPTION

Advertising; business management; business administration; business consultancy in relation to distribution; wholesaling and retailing in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages, in particular by means of teleshopping programmes and/or including via the internet; arranging of trading and economical contacts, also over the internet

GOODS AND/OR SERVICES SECTION (035)(proposed)

INTERNATIONAL

CLASS	035
TRACKED TEXT DESCRIPTION	
<p>Advertising; business management; business administration; business consultancy in relation to distribution; <u>business consultancy in relation to others engaged in the business distribution industry;</u> wholesaling and retailing in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages, in particular by means of teleshopping programmes and/or including via the internet; <u>wholesale retail store services, retail store services and online retail store services in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages;</u> arranging of trading and economical contacts, also over the internet; <u>arranging of trading and economical contacts, also over the internet, and conducting trade show exhibitions as well as online trade show exhibitions in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages</u></p>	
FINAL DESCRIPTION	
<p>Advertising; business management; business administration; business consultancy in relation to others engaged in the business distribution industry; wholesale retail store services, retail store services and online retail store services in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages; arranging of trading and economical contacts, also over the internet, and conducting trade show exhibitions as well as online trade show exhibitions in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages</p>	
ADDITIONAL STATEMENTS SECTION	
COLOR(S) CLAIMED (If applicable)	The color(s) red, yellow and white is/are claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of The mark consists of a polygon carrier appearing in red with red chevrons at the top and bottom with yellow shading and the wording "BÖRNER GERMANY" appearing in red within the carrier. The center portion of the carrier is white.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/ekb/
SIGNATORY'S NAME	Elizabeth K. Brock
SIGNATORY'S POSITION	Attorney for Applicant; Michigan bar member; attorney with Harness, Dickey & Pierce, PLC
DATE SIGNED	04/24/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	

SUBMIT DATE	Fri Apr 24 19:45:25 EDT 2015
TEAS STAMP	USPTO/RFR-209.155.152.66-20150424194525981931-79143258-53039644b757cdceebbf77746616cfb4ae30c2d79d19c82f135051cd61f9a738-N/A-N/A-20150424193304054725

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **79143258** has been amended as follows:

EVIDENCE

Evidence in the nature of Argument has been attached.

Original PDF file:

[evi_20915515266-20150424193304054725_.Request.for.Reconsideration.-.Argument.PDF](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 005 for Pharmaceutical and veterinary preparations; foodstuffs and dietetic substances for medical or veterinary purposes; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; beverages adapted for medical purposes; medicinal drinks; medicinal additives

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Pharmaceutical and veterinary preparations;~~ [Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss;](#) ~~foodstuffs and dietetic substances for medical or veterinary purposes;~~ [foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss;](#) food for babies; dietary supplements for humans

and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; ~~dietetic beverages adapted for medical purposes~~; dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; ~~dietetic foods adapted for medical purposes~~; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, weight loss beverages and health beverages; ~~beverages adapted for medical purposes~~; beverages adapted for medical purposes, namely, weight loss beverages and health beverages; medicinal drinks; ~~medicinal additives~~; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

Class 005 for Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, weight loss beverages and health beverages; beverages adapted for medical purposes, namely, weight loss beverages and health beverages; medicinal drinks; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 032 for Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks (not for medical purposes); beverages enriched with additional minerals (not being for medical use); beverages enriched with added trace elements (not for medical purposes); beverages enriched with added vitamins (not for medical purposes); isotonic beverages not for medical purposes; non-alcoholic malt-free beverages (other than for medical purposes)

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Beers~~; non-alcoholic beverages, namely, fruit juice, whey drinks, milk drinks, and substitutes thereof; ~~mineral and aerated waters and other non-alcoholic beverages~~; fruit beverages and fruit juices; syrups and other preparations for making beverages in the nature of syrup substitutes for making beverages; ~~syrups and other preparations for making beverages~~; energy drinks not for medical purposes; ~~energy drinks (not for medical purposes)~~; beverages in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof enriched with additional minerals not being for medical use; ~~beverages enriched with additional minerals (not being for medical use)~~; beverages enriched with added trace elements in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; ~~beverages enriched with added trace elements (not for medical purposes)~~; beverages enriched with added vitamins in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; ~~beverages enriched with added vitamins (not for medical purposes)~~; isotonic beverages not for medical purposes; non-alcoholic malt-free beverages other than for medical purposes; ~~non-alcoholic malt-free beverages (other than for medical purposes)~~

Class 032 for non-alcoholic beverages, namely, fruit juice, whey drinks, milk drinks, and substitutes thereof; fruit beverages and fruit juices; syrups and other preparations for making beverages in the nature of syrup substitutes for making beverages; energy drinks not for medical purposes; beverages in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof enriched with additional minerals not being for medical use; beverages enriched with added trace elements in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; beverages enriched with added vitamins in the nature of fruit juice, whey drinks, milk drinks, and substitutes thereof not for medical purposes; isotonic beverages not for medical purposes; non-alcoholic malt-free beverages other than for medical purposes

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 033 for Alcoholic beverages (except beers)

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Alcoholic beverages (except beers);~~ [Alcoholic beverages except beers](#)

Class 033 for Alcoholic beverages except beers

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for Advertising; business management; business administration; business consultancy in relation to distribution; wholesaling and retailing in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages, in particular by means of teleshopping programmes and/or including via the internet; arranging of trading and economical contacts, also over the internet

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Advertising; business management; business administration; ~~business consultancy in relation to distribution;~~ [business consultancy in relation to others engaged in the business distribution industry;](#) ~~wholesaling and retailing in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages, in particular by means of teleshopping programmes and/or including via the internet;~~ [wholesale retail store services, retail store services and online retail store services in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages;](#) ~~arranging of trading and economical contacts, also over the internet;~~ [arranging of trading and economical contacts, also over the internet, and conducting trade show exhibitions as well as online trade show exhibitions in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages](#)

Class 035 for Advertising; business management; business administration; business consultancy in relation to others engaged in the business distribution industry; wholesale retail store services, retail store services and online retail store services in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages; arranging of trading and economical contacts, also over the internet, and conducting trade show exhibitions as well as online trade show exhibitions in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

ADDITIONAL STATEMENTS

Color Claim

The color(s) red, yellow and white is/are claimed as a feature of the mark.

Description of mark

The mark consists of The mark consists of a polygon carrier appearing in red with red chevrons at the top and bottom with yellow shading and the wording "BÖRNER GERMANY" appearing in red within the carrier. The center portion of the carrier is white.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /ekb/ Date: 04/24/2015

Signatory's Name: Elizabeth K. Brock

Signatory's Position: Attorney for Applicant; Michigan bar member; attorney with Harness, Dickey & Pierce, PLC

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79143258

Internet Transmission Date: Fri Apr 24 19:45:25 EDT 2015

TEAS Stamp: USPTO/RFR-209.155.152.66-201504241945259

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N/A-N/A-20150424193304054725

This is in response to the Office Action dated October 24, 2014 in which the Examining Attorney made final her requirement that Applicant disclaim the term “BÖRNER GERMANY” based on an allegation that the mark is geographically descriptive. (In the previous response, Applicant disclaimed the term “GERMANY” but maintains there is no basis to require disclaimer of the term “BÖRNER.”) The Examining Attorney also required Applicant to amend the goods and enter a color claim; Applicant has addressed both, but also amended the previously accepted description of the mark, because it is red, not orange (as claimed in the underlying International Registration). Regarding the amendments to the goods, Applicant was also required to amend the goods in co-pending Application Ser. No. 79144291 for the word mark BÖRNER, and has submitted the same proposal in both cases for consistency. The Examining Attorney is encouraged to review the co-pending Ser. No. 79144291 for the word mark BÖRNER; there was no allegation that BÖRNER identified a location. For the reasons below, Applicant respectfully requests that the Examining Attorney withdraw the requirement to disclaim the term “BÖRNER” because it is not geographically descriptive.

As an initial note, Applicant’s mark is not “Borner, Germany” as if identifying a city and country; this is Applicant’s mark:



“BÖRNER” does not have geographic significance, and Applicant’s mark is akin to FORD USA or BMW GERMANY.

Applicant is also the owner of co-pending Application Ser. No. 79144291 for the word mark BÖRNER, and the following BÖRNER / BORNER / BOERNER registrations:

- 1713090,
- 3891699,
- 1505416 (expired),
- 1501746 (expired),
- 2191761 (expired),
- 2191762 (expired), and
- 3022466 (expired).

Upon information and belief, Applicant has never received a refusal – much less a repeated refusal – based on an allegation that BÖRNER / BORNER / BOERNER is primarily geographically descriptive in these *eight* current and prior cases.

**“BÖRNER” IS NOT PRIMARILY GEOGRAPHICALLY DESCRIPTIVE -
The Test For Establishing That A Mark/Term is Primarily Geographically Descriptive**

In the first Office Action, the Examining Attorney required Applicant to disclaim “BÖRNER GERMANY” on the basis that “it merely describes the geographic origin of the goods.” As Applicant stated in its prior response, the Examining Attorney’s only explanation were attachments from “National Geospatial-Intelligence Agency” at www.geographic.org, purporting to show a location in Germany named “Borner.” Applicant stated:

Applicant is unfamiliar with the database used by the Examining Attorney, and was unable to access and search at that URL. Applicant then attempted to recreate the Examining Attorney’s results using Google Maps, but was only able to locate Applicant’s own address, not the geographic location identified by the Examining Attorney. Next, Applicant searched Wikipedia for “Borner, Germany” and received the following result: “The page ‘Borner, Germany’ does not exist.”

The Examining Attorney did not cite or follow the relevant TMEP 1210.01(a), entitled “Geographically Descriptive Marks – **Test**.” (emphasis added). Applicant emphasizes that there is a *test* to establish primary geographic distinctiveness, which Applicant explained in this prior response. Again, in its prior response, Applicant noted:

The following three part test is applied to determine whether a mark is *primarily* geographically descriptive of the goods within the meaning of §2(e)(2):

- (1) the *primary* significance of the mark is a generally known geographic place or location; and
- (2) the goods or services originate in the place identified in the mark; and
- (2) purchasers would be likely to make a goods-place association, i.e., purchasers are likely to believe the goods originate in the geographic location identified in the mark. (“Note: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association.”)

See TMEP 1210.01(a); *In re MCO Properties, Inc.*, 38 USPQ2d 1154 (TTAB 1995); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989).

Rather than withdrawing this requirement with respect to the term “BÖRNER,” the Examining Attorney has made this disclaimer requirement final, *still without following or even mentioning the three-part test*. The Examining Attorney is respectfully reminded that TMEP 1210.01(a) states, “To establish a prima facie case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show” (1) that the *primary* meaning of the mark is a *generally known* geographic area, and (2) the goods originate here, and (3) the location is *not remote or obscure*, so that purchasers are likely to make a *goods-place association*. (emphasis added).

The Examining Attorney has not followed the test, has made little to no showing that “BÖRNER” is a location under prong (1), and *no showing whatsoever* that the goods originate in this location under prong (2), or that purchasers are likely to made a goods-place association under prong (3). Given that the Examining Attorney has not made this *prima facie* showing – the Examining Attorney’s burden, explicitly under TMEP 1210.01(a) – it is not required or even relevant that Applicant “has not presented any evidence showing any alternate meanings of the

“BÖRNER” wording, as the Examining Attorney asserts. This is not Applicant’s burden nor is it the test.

Instead of applying the test for primary geographic descriptiveness, the Examining Attorney proffers more “evidence” that “BÖRNER” is a location, primarily consisting of *Applicant’s own street address*. Applicant is located in Landschied-Niederkail, Germany – this is the city. Applicant’s street address is Industriegebiet Börner 1, which translates to “Börner Industrial Area 1.” Applicant’s street is named after Applicant; not vice versa. If Google Inc. names the street on its campus “Google Street”, this does not make “GOOGLE” a geographic location.

Moreover, the additional “geographic evidence” notably still does not include any commonly used sources, such as Wikipedia, Google Maps or Mapquest – the “evidence” consists of more obscure websites, including a Norway (.NO) domain.

Accordingly, as the appropriate test has not been applied, nor has sufficient evidence been produced, the disclaimer requirement - based on an allegation that the term “BÖRNER” is primarily geographically descriptive - should be withdrawn.

**RECENT BINDING FEDERAL CIRCUIT DECISION –
Board Refusal Overturned Where Examining Attorney Used Appropriate Test And
Proffered More Evidence**

The Examining Attorney is urged to consider the recent Federal Circuit case, *In re the Newbridge Cutlery Company*, 113 USPQ2d 1445 (Fed. Cir. 2015), in which the Federal Circuit overturned the Board’s decision to affirm the Examining Attorney’s refusal to register the NEWBRIDGE HOME mark as being primarily geographically descriptive. This case is widely regarded as raising the burden on the Office in demonstrating that a mark is primarily geographically descriptive.

The Federal Circuit begins by tracing the history of the primarily geographically descriptive refusal, concluding that:

The 1946 Lanham Act *steered away from* the prior practice of looking a word up in an atlas or gazetteer and then refusing registration if there was any place on earth called by that word.

In re the Newbridge Cutlery Company, at 1447 (internal citations omitted) (emphasis added). In the instant BÖRNER GERMANY & Design application, by finding a handful of obscure references to “BÖRNER,” the Examining Attorney would not only disregard the three-prong test, but apply a standard that was overturned nearly 70 years ago by the Lanham Act.

Turning to the test itself and the Federal Circuit’s review, the Board correctly applied the 3-prong test for establishing a *prima facie* showing of primary geographic descriptiveness. However, the evidence proffered was insufficient to establish even prong (1). (Applicant notes that Newbridge Cutlery Co. was actually located in a city called Newbridge, Ireland - as opposed to the instant case, in which the street is named after the applicant.)

In *Newbridge*, under prong (1), the Board concluded that Newbridge, Ireland is a place generally known by the public based on its rank as the second largest town in County Kildare and the seventeenth largest in Ireland, its presence in the well-known *Columbia Gazeteer*, and

its presence on Wikipedia and tourism websites. The Federal Circuit found this evidence insufficient to establish prong (1), stating, “[t]he conclusion that Newbridge, Ireland, a town of less than twenty thousand people, is a place known generally to the relevant American public is not supported by substantial evidence. [...] Likewise, the fact that Newbridge, Ireland is mentioned on some internet websites does not show that it is a generally known location.” Accordingly, as required by the Federal Circuit, which binds this Office, the Examining Attorney did not establish by “substantial evidence” that a town of twenty thousand people – that appeared in Wikipedia – is a generally known geographic place or location under prong (1).

In the instant application, the evidence consists of Applicant’s street address (with the street referencing Applicant itself) and five obscure websites, including one website Applicant cannot access and one .NO (Norway) website. Under *Newbridge*, the fact that the term “BÖRNER” (Applicant does not concede it is a location at all) “is mentioned on some internet websites does not show that it is a generally known location.” Conversely, Applicant’s assertion that “BÖRNER” was not found as a location using common sources such as Wikipedia and Google Maps is relevant: “That Newbridge, Ireland is not generally known is supported by the fact that certain maps and atlases do not include it. *Id.* at 1451. Accordingly, prong (1) of the three part test has not been met, as in *Newbridge*, where even more compelling evidence was produced.

Returning to the *Newbridge* case, the Federal Circuit held that:

to the relevant consuming public the mark NEWBRIDGE is not *primarily* geographically descriptive of the goods, which is what matters. [...] Prong one of the for primarily geographic marks is therefore not met. Accordingly, we need not and do not separately consider whether a goods/place association exists.

Id. (emphasis in original).

In the instant application, there is not even a reliable source to indicate that “BÖRNER” is a location *at all*, much less “a place known generally to the relevant American public” a required by prong (1) of the three-part test. As even less evidence is available than in *Newbridge*, the disclaimer requirement based on an assertion of primary geographic descriptiveness should be withdrawn.

CONCLUSION

The requirement that “BÖRNER” should be disclaimed because it is primarily geographically descriptive should be withdrawn. Applicant has stated that the term has no geographic significance. The Examining Attorney failed to apply the proper three-prong test for determining whether a term is primarily geographically descriptive, and assuming *arguendo* that test was implied, has not shown sufficient evidence to establish the first prong, and no evidence whatsoever to establish a goods-place association. Moreover, in a Federal Circuit case that is binding on the Office, the court reversed and remanded the Board’s affirmance of an Examining Attorney’s similar refusal – a refusal that used the appropriate three-prong test and submitted better, more relevant evidence. For these reasons, the disclaimer requirement as to the term “BÖRNER” should be withdrawn.

Applicant urges the Examining Attorney to contact the undersigned to discuss options for approving this Application for publication. Applicant has filed a Notice of Appeal contemporaneously with the filing of this Request for Reconsideration.

19528147.1