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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Newbridge Cutlery Company t/a Newbridge Silverware

Serial No. 79094236

Kanishka Agarwala of Anderson Kill & Olick, P.C. for The Newbridge Cutlery Company t/a Newbridge Silverware.

Kristin Carlson, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Bucher, Wolfson and Masiello, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

The Newbridge Cutlery Company t/a Newbridge Silverware (“applicant”) seeks registration on the Principal Register of the mark NEWBRIDGE HOME (in standard characters) for the following goods, in International Classes 8, 14, 16 and 21:¹

¹ Application Serial No. 79094236 was filed on October 14, 2010, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on a request for extension of protection of International Registration No. 1068849, registered October 14, 2010. A disclaimer to the word “HOME” is of record in the application.

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In International Class 8: Hand tools, namely, razors; cutlery, namely, forks, knives, and spoons; tea spoons; desert spoons; soup spoons; steak knives; carving knives; fish knives; salad forks; pastry forks and all of the foregoing silver-plated.

In International Class 14: Jewelry, precious stones; horological and chronometric instruments, namely, clocks and watches; bracelets; necklaces; rings; cuff links; tie pins; earrings; costume jewelry; key rings made of or plated with precious metals; brooches; personal ornaments made of or plated with precious metals.

In International Class 16: Silver-plated desktop holders for business cards; silver-plated pen holders; silver-plated pens.

In International Class 21: Household or kitchen utensils and containers, namely, spatulas, fish slices in the nature of spatulas, ladles, cooking tongs, colanders, cruet sets, toast racks, flasks, bottle openers; bowls; non-electric candelabra; candlesticks; cocktail utensils, namely, cocktail shakers, cocktail stirrers, cocktail strainers, ice buckets, corkscrews; cooking pots; saucepans; corkscrews; glassware, namely, wine glasses, drinking glasses; crockery, namely, cups, mugs, saucers, plates, serving dishes, bowls, and side-plates; milk jugs; sugar bowls; vases; napkin rings; salt shakers; pepper mills.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that it is primarily geographically descriptive of applicant's goods under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2). Notification of the refusal was transmitted to the International Bureau pursuant to Section 68(c)(1)(A), 15 U.S.C. § 1141h(c)(1)(A).

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When the refusal was made final, applicant appealed and filed a request for reconsideration. The examining attorney denied the request for reconsideration, and the appeal was resumed. We affirm the refusal.²

Applicable Law

The test for determining whether a mark is primarily geographically descriptive is whether (1) the primary significance of the mark is the name of a place known generally to the public, and whether (2) the public would make a goods/place association, that is, believe that the goods identified in the application originate in that place. If these elements are met, and if the applicant's goods in fact originate or will originate in or from the place named in the mark, then the mark is primarily geographically descriptive of the goods. *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008). *See also, In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006); and *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001).

A mark is not "primarily" geographic where the geographic meaning is minor, obscure, remote, or unconnected with the goods. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982) (use of a geographic term in a fictitious, arbitrary or fanciful manner is not "primarily" a geographic designation.)

² As a threshold evidentiary matter, we note that to the extent applicant has objected to the examining attorney's evidence, the objection is overruled. All evidence has been properly submitted during prosecution as attachments to the first and final Office actions and the denial of the request for reconsideration. See Trademark Rule 2.142(d).

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A. Origin of Applicant's Goods

There is no dispute that applicant's goods originate in Newbridge, Ireland. Newbridge is the site of applicant's headquarters; as applicant explains, "all goods are designed in and dispatch from Newbridge," and applicant "manufactures some of its goods in Newbridge, the remainder being manufactured and packaged abroad."³

B. Primary significance of "Newbridge"

Under the first prong of the test for determining whether NEWBRIDGE HOME is primarily geographically descriptive, we consider whether the primary significance of the term "Newbridge" is that of a geographic location. Although applicant's mark is NEWBRIDGE HOME, our primary focus under Section 2(e)(2) is on the term "Newbridge" because the word HOME is merely descriptive of a feature of applicant's goods, namely, that they are for use in one's home.⁴ If "Newbridge" is primarily geographically descriptive, the presence of the descriptive term "home" will not convert the mark NEWBRIDGE HOME into a term that is not primarily geographically descriptive. *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993) (FRENCH LINE (stylized) primarily geographically descriptive of goods and services from France); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637, 1639 (TTAB 1991) (PARADISE ISLAND AIRLINES

³ Response to Office action, October 3, 2011.

⁴ In particular, the International Class 21 identification of goods includes "household or kitchen utensils and containers"; applicant describes its NEWBRIDGE HOME goods as "a beautiful range of gifts for the home presented in gift packaging"; and in recognition of the descriptive nature of the term, applicant has disclaimed exclusive rights to the word HOME.

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primarily geographically descriptive of the transportation of passengers and goods by air).

Applicant argues that “Newbridge” is not generally well-known to the average purchaser of its goods, but rather, is unknown to the “mill-run American consumer ... who purchases items such as forks, knives, spoons, silver-plated jewelry, etc.”⁵ However, the town is the second largest in County Kildare and the seventeenth largest in the Republic of Ireland.⁶ It is listed in the *Columbia Gazetteer of the World*,⁷ and appears on the Internet at tourism websites such as the website “www.discoverireland.com,” which describes Newbridge as “a large commercial town with plenty of shops, coffee shops, restaurants, hotels and pubs,”⁸ and “www.newbridgetown.com,” which describes several visitor attractions in Newbridge, one of which is applicant’s silverware visitor centre.⁹ That website also notes Newbridge is home to several museums and gardens and numerous historical and battle sites. Horseracing is described as taking “centre stage” at the Curragh Racecourse in Newbridge, stating that “The County Kildare venue hosts some of the most famous races in the world ...”¹⁰

Under the first element of the Section 2(e)(2) refusal, we find that the primary significance of the mark NEWBRIDGE HOME is that of a generally known geographic place, i.e., the town of Newbridge, in Kildare County, Ireland. The first

⁵ Brief, p. 10.

⁶ At [http://en.wikipedia.org/wiki/Newbridge, County_Kildare](http://en.wikipedia.org/wiki/Newbridge,_County_Kildare); attached to Final Office action dated December 12, 2011.

⁷ At <http://www.columbiagazetteer.org>; attached to Office action dated March 31, 2011.

⁸ Final Office action, exhibit 5.

⁹ Id., exhibit 7.

¹⁰ Id.

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element of the Section 2(e)(2) refusal accordingly is established. *Accord, In re Roy J. Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (“minimal information” sufficient to show “Montecito” is a generally known geographic location).

C. Goods/Place Association

Where there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant’s own goods come from the geographical place named in the mark. *See, e.g., In re JT Tobacconists*, 59 USPQ2d at 1082; *In re Roy J. Mankovitz*, 90 USPQ2d at 1249; *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982). However, if genuine issues remain as to whether the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods, the examining attorney bears the burden of establishing a public association of the goods with that place. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 1999); *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 893 (CCPA 1982); *In re Joint-Stock Co. “Baik”*, 80 USPQ2d at 1309 (“[t]he determination of the goods/place association is made not in the abstract, but rather in connection with the goods or services with which the mark is used and from the perspective of the relevant public for those goods or services.”)

Based on a careful review of the evidence submitted in this proceeding, we find that the relevant segment of the American purchasing public would make the connection between applicant’s goods and the geographic place named in the mark. The town of Newbridge “developed beside the British cavalry barracks from 1816

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onwards.”¹¹ It was a thriving garrison community at the turn of the 20th century until the British army moved out in 1921. Around this time, five craftsmen from Sheffield, England decided to move to Newbridge to revitalize the town, and in 1934 they established Newbridge Silverware, taking the name from the town of Newbridge.¹² Newbridge has been the geographical location from which applicant’s goods have originated for over seventy-five years.

The connection between applicant’s goods and its geographic location of origin are further underscored by applicant’s marketing practice. Applicant sells its goods online to the United States and through retail outlets (in Missouri, Pennsylvania, Michigan, Illinois, and New York) that feature products from Ireland.¹³

Applicant argues that the popularity of the town is driven in large part by applicant’s presence and that its mark “has acquired secondary meaning in the minds of consumers as signifying the applicant.”¹⁴ Applicant has submitted the declaration of its Managing Director, Mr. William Doyle, who states that applicant was the first and is now “the only manufacturer of cutlery, silverware and homeware located in Newbridge, Ireland,” and that applicant has been Ireland’s “premier designer and producer of cutlery, silverware and associated homeware products” for over 75 years, and the “premier supplier of giftware and homeware

¹¹ Final Office action, exhibit 6.

¹² At <http://kildare.ie/newbridge/about-newbridge.asp>, attached to Final Office action dated December 10, 2011; exhibit 2.

¹³ At www.newbridgesilverware.com; attached to Final Office action, exhibit 22.

¹⁴ Applicant’s Request for Reconsideration, p. 11.

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products” for at least the last 10 years.¹⁵ On its website, applicant describes the history of Newbridge and applicant’s role in establishing the town as a center for cutlery and silverware production.¹⁶ Located at the Newbridge Silverware Visitor Centre is the Museum of Style Icons, “a permanent exhibition dedicated to design and style excellence,” which includes pieces from vintage Hollywood movies.¹⁷ Applicant’s Newbridge Silverware Visitor Centre is listed as a major visitor attraction on several travel websites.¹⁸ A chauffeur tour of Kildare County includes a stop at the Newbridge Silverware Visitor Centre, describing on its website: “Ireland is renowned the world over for its production of fine silverware and this tradition is proudly carried on at Newbridge Silverware.”¹⁹ The Wikipedia entry identifies applicant as “the famous Newbridge Silverware plant.”²⁰

The examining attorney’s denial of applicant’s Request for Reconsideration echoes this statement, wherein it notes, “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.” The examining attorney however, contends that the fact that Newbridge, Ireland may

¹⁵ Decl. of William Doyle, attached to applicant’s Request for Reconsideration, exhibit 1.

¹⁶ At www.newbridgesilverware.com, attached to first Office action, exhibit 2.

¹⁷ At www.kildare.ie, attached to Final Office action, exhibit 2. In 2009, the Museum served as a venue for a travelling collection of memorabilia associated with the singer Michael Jackson; also in 2009 a collection of personal items belonging to Barbra Streisand was on exhibit at the Museum. At www.lexis.com; attached to Final Office action, exhibit 13. Music-related memorabilia from the “Icons of Music II” exhibit went on temporary display in 2011. Id., exhibits 11 and 12.

¹⁸ See, e.g., at www.newbridgetown.com/things-to-see.asp; www.discoverireland.ie.

¹⁹ At www.greganchauffeurireland.ie, attached to Office action dated December 12, 2011, exhibit 9. See also, at www.gregantoursireland.com, a tour description of the Kildare County Day Tour, highlighting the “Newbridge Silverware & Style Icon Museum.” Attached to Denial of Request for Reconsideration, exhibit 17.

²⁰ At <http://en.wikipedia.org>; final Office action exhibit 3.

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have gained renown due to the applicant's presence in that location "does not subtract from the Section 2(e)(2) analysis."²¹ In a footnote, the examining attorney advised applicant that the Office would not consider an amendment to claim the benefit of Section 2(f) of the Trademark Act, "since applicant appears to have entered its goods into commerce in the United States only relatively recently."

Despite the renown of applicant's silverware company, and given that there is no amendment in the record to register the mark under the provisions of Section 2(f), we find that the evidence supports a finding that the relevant purchasing public would primarily view the mark NEWBRIDGE HOME as indicating the geographical source of the goods. To the extent the evidence of record creates a genuine issue regarding the primary significance of Newbridge in the minds of American "homeware" consumers, such that a goods/place association cannot therefore be presumed from the fact that the goods come from Newbridge, the examining attorney has presented evidence sufficient to establish that American consumers of these products would in fact make such an association. Moreover, the town of Newbridge is not sufficiently remote, minor, or obscure that the goods/place association would not be made. *Cf., In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73, 75 (TTAB 1983) (despite Germany's reputation as a producer of beer, the small town identified by the mark AYINGER BIER was sufficiently remote so that no goods/place association would be made); *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926, 927-28 (TTAB 1984) (geographic significance of JEVER was obscure; held registrable for beer made in Jever, Germany); *In re Brouwerij*

²¹ Denial of applicant's Request for Reconsideration, p. 3 (unnumbered).

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Nacional Balashi NV, 80 USPQ2d 1820 (TTAB 2006) (BALASHI sufficiently obscure or remote to average American beer consumer).

Applicant further argues that the primary significance of the term NEWBRIDGE is not geographic because it has another meaning which derives from the joinder of the words “new” and “bridge.” Applicant contends that the mark is used 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.’”²² Applicant’s Request for Reconsideration, p. 6, exhibit 12 shows several printouts from websites for unrelated goods and services, where a phrase (such as “your bridge to financial freedom”) or a picture (such as that of a bridge) suggests the connotation advanced by applicant. However, the fact that a term may have other meanings does not necessarily alter the primacy of its geographical significance. *See, e.g., In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986) (that “MANHATTAN” is the name of an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City.) Here, the primary meaning of “Newbridge” is that of a geographic location. The third-party non-geographic uses of “Newbridge” as connoting a “new bridge” do not show otherwise. Likewise, the fact that the Office has granted third-party registrations for marks that include “Newbridge”²³ without requiring a disclaimer of that term do not show that “Newbridge” is not primarily geographic in this instance. None of the third-party registrations, or the third-party websites, are for related goods or services.

²² Applicant’s Appeal Brief, p. 12.

²³ Request for Reconsideration, exhibit 13.

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There is nothing in the record to show that the goods or services involved in any of these registrations or websites come from any place named “Newbridge.” Even if some of the goods or services involved emanated from a place named “Newbridge,” this would not be dispositive. “That there is more than one place bearing the name or that one place is better known than another is not dispositive. The issue is not the fame or exclusivity of the place name, but the likelihood that a particular place will be associated with particular goods.” *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985).

Based on the evidence of record herein, we find, under the second element of the Section 2(e)(2) refusal, that a goods/place association exists between applicant’s goods and the geographic place named in the mark.

Decision: Applicant’s mark NEWBRIDGE HOME is primarily geographically descriptive of applicant’s goods. The refusal to register the mark under Trademark Act Section 2(e)(2) is affirmed.