

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

Applicant: Bristol-Myers Squibb Company
Serial No: 78/222,332
Filed: March 6, 2003
Mark: PRINCETON PHARMACEUTICAL PRODUCTS
Our Ref: BRM 0408478

TTAB

NOTICE OF APPEAL

Box TTAB
FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant, by its undersigned attorney, hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner of Trademarks refusing registration. Applicant is simultaneously filing a request for reconsideration of that decision, a copy of which is attached. Therefore, Applicant requests that this appeal be stayed while the trademark attorney considers that request.

Please charge the fee associated with this appeal to applicant's attorney's Deposit Account No. 23-0825-0576900.

Dated: New York, New York
October 7, 2004

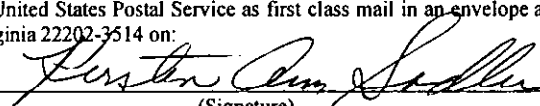
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October 7, 2004
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(Signature)

Kirsten Ann Sadler

October 7, 2004



Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
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Heather D. Thompson
Examining Attorney
Law Office 103

REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant submits this Request for Reconsideration from the April 8, 2004 Final Office Action issued in connection with the above-identified Application, pursuant to 37 C.F.R. Section 2.64(b), which permits such a Request to be made during the six month period between the issuance of a Final Office Action and the expiration of time for filing an appeal.

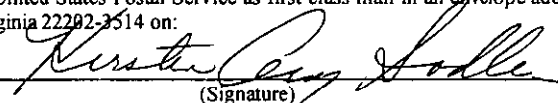
Applicant is the owner of U.S. Reg. No. 1,432,671, which is discussed further in Section II. In the Final Office Action, the Examining Attorney made final the refusal to register the mark PRINCETON PHARMACEUTICAL PRODUCTS, on the asserted basis that it is geographically descriptive. For the reasons set forth below, Applicant respectfully requests that the Examining Attorney reconsider and withdraw this refusal, and pass the mark to publication.

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I. The Mark Does Not Meet the Two-Part Test for Geographical Descriptiveness, As Set Forth by the Examining Attorney

In the Final Office Action, the Examining Attorney enumerated a two-part test for the determination of whether a mark is geographically descriptive: (1) the mark must be the name of a place generally known to the public; and (2) the public must believe that the goods or services identified by the mark originate from this place or location (the “goods-place association”). In re California Pizza Kitchen, 10 U.S.P.Q2d 1704, 1705 (T.T.A.B. 1989).

With respect to the first prong, it is the Examining Attorney’s continued assertion that the primary significance of the term PRINCETON is as a geographic location, namely, a borough in west central New Jersey within Mercer County. The Examining Attorney asserts that “Princeton is first and foremost (based on the definitions of record) a geographical location.” (Final Office Action p. 2). However, these “definitions of record” as provided by the Examining Attorney also state that Princeton is the home of Princeton University, which supports the view that the association with Princeton is as a place of education. In fact, it is Applicant’s continued belief that the primary significance of the term PRINCETON is not geographical, but rather that it is known internationally as the home of Princeton University, as well as other academic institutions, and that it is this association with prestigious academics that is its primary significance.. An internet (Google) search of the term PRINCETON brings up many hits regarding Princeton University, the Princeton Review, the Institute for Advanced Study, the Princeton Theological Seminary, the Princeton Plasma Physics Laboratory, and other esteemed institutions. (See attached Exhibit ___) Clearly, the renown of the term PRINCETON has to do with its being a center of high quality academics, rather than just as a geographic locale, and

Applicant continues to maintain that the Examining Attorney's scant dictionary evidence does not sufficiently refute this.

In addition, the second part of the test outlined by the Examining Attorney, the "goods-place association," is not met in these circumstances. There is no reason that the public would expect the goods recited in the application, i.e., a line of pharmaceuticals, to have their origin in Princeton. The region of Princeton, New Jersey is not particularly known for pharmaceuticals, and therefore consumers are unlikely to draw such an association between the term PRINCETON and a source of pharmaceutical production. In In re Venice Maid Co., Inc., 222 U.S.P.Q. 618 (T.T.A.B. 1984), the TTAB reversed the Examining Attorney's refusal to register VENICE MAID for various canned goods. The Board held that the Examining Attorney failed to make a prima facie evidentiary showing that purchasers would expect the goods recited in the application to have their origin in the geographic locality in the mark. In that case, the Examining Attorney submitted two pieces of evidence: (1) an excerpt from a cookbook that discussed various food specialties of this region of Italy; and (2) a label for a spaghetti sauce that referred to the product as "Industrial Strength Venetian Spaghetti Sauce." In finding that this evidence did not establish a goods-place association, the Board found:

While it is true that large cities are often the point of origin for a wide variety of goods, we are unwilling to sustain the refusal to register in this case simply on the basis that Venice is a large Italian city that could, conceivably, be the source of a wide range of goods, including canned foods. Stated differently, a proper refusal to register here must be based on at least some evidence that Venice is a locality from which canned foods of the sort identified in the application might originate. Id. At 619.

Although Princeton is the home of many research institutes and other academic centers, there is no evidence that it is likely the origin of pharmaceuticals. Moreover, since the region is

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