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Subject: TRADEMARK APPLICATION NO. 78222332 - PRINCETON
PHARMACEUTICAL PRODUCTS - N/A

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/222332

APPLICANT: Bristol-Myers Squibb Company

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CORRESPONDENT ADDRESS:

Nadine Flynn
Bristol-Myers Squibb Company
345 Park Avenue
New York NY 10154

BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL

MARK: PRINCETON PHARMACEUTICAL PRODUCTS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

Procedural History

Applicant applied to register the mark PRINCETON PHARMACEUTICAL PRODUCTS on March 6, 2003, alleging a *bona fide* intention to use the mark in commerce in connection with a "house mark for a line of pharmaceutical preparations" in International Class 5. In the first Office action, dated August 25, 2003, the assigned examining attorney refused registration under Section 2(e)(2) of the Trademark Act on the grounds that the mark is primarily geographically descriptive of such goods.¹ By Final Action dated April 8, 2004, the undersigned maintained the refusal on geographic descriptiveness. The applicant submitted a Request for Reconsideration together with

its Appeal on October 13, 2004. In an action dated November 4, 2004, the request was denied and this Appeal resumed.

Issue on Appeal

The sole issue on appeal is whether PRINCETON PHARMACEUTICAL PRODUCTS is primarily merely geographically descriptive of a line of pharmaceutical preparations.

ARGUMENT

I. Applicable Law

A three-part test is applied to determine whether a mark is primarily geographically descriptive of the goods and/or services within the meaning of Trademark Act Section 2(e)(2):

- (1) the primary significance of the mark must be geographic, i.e., the mark names a particular geographic place or location;
- (2) purchasers must be likely to make a goods-place or services-place association, i.e., purchasers are likely to think that the goods or services originate in the geographic location identified in the mark; and
- (3) the mark identifies the geographic origin of the goods and/or services.

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

II. Applicant's Mark is Primarily Geographically Descriptive of the Goods

A. The Primary Significance of the Mark is Geographic

The evidence of record shows that the primary significance of the term "PRINCETON" is geographic. Such evidence includes a definition of "Princeton" as "a borough of central New

Jersey.” (*The American Heritage Dictionary of the English Language*, 4th Ed., 2000.) When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, the goods/place or services/place association will ordinarily be presumed from the fact that the applicant’s goods or services originate in the place named in the mark. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services).

Applicant argues that its evidence established that the association of PRINCETON with academics is of equal or greater significance than the established geographic significance. However, the fact that a term may have other meanings in other contexts (such as academics) does not necessarily negate the basis for refusal as long as the most **prominent** meaning or significance is geographic for the identified goods. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986); TMEP §1210.02(b). That is, the fact that PRINCETON may identify a university or other academic institutions does not diminish the geographic significance of the term. Applicant has put forth *In re Jacques Bernier, Inc.* and *In re Jim Crockett Promotions, Inc.* for the proposition that some geographic terms do not stand as primarily geographic because of other more prominent meanings. But unlike the marks RODEO DRIVE and THE GREAT AMERICAN BASIL, PRINCETON is primarily geographically descriptive *in the context of pharmaceutical products*. Applicant’s reliance on cases involving the term AMERICAN as analogous in this situation is misplaced.

B. Purchasers are Likely to Make a Goods-Place Association

Purchasers must be likely to make a goods-place association, i.e., purchasers are likely to think that the goods originate in the geographic location identified in the mark. Again, evidence of record supports the goods-place association. *See* excerpt from applicant's website (www.bms.com) and Lexis-Nexis articles in which pharmaceutical products and applicant's products specifically, are connected to Princeton, New Jersey. That is, purchasers are likely to believe the applicant's goods will originate in Princeton, for two reasons made clear in the record: (a) because applicant's goods are researched and developed in Princeton and (b) because Princeton is known for pharmaceutical products and pharmaceutical companies. Again, the fact that applicant maintains other research facilities beyond Princeton does not diminish the geographic significance or goods-place association *for this mark* in connection with *these goods*.

C. The Mark Identifies the Geographic Origin of the Goods

Applicant has argued that because the pharmaceutical products to be sold under the subject mark are not necessarily manufactured in Princeton, the mark does not identify the geographic origin of the goods. However, as established by the evidence in the record, the applicant company is based in Princeton and the development and research for the goods takes place in Princeton. The origin of the goods can clearly be connected to Princeton. Again, the Lexis-Nexis articles of record along with the results of a search using the Google search engine, indicate that applicant is headquartered in Princeton and primary research facilities are based there.

D. The Addition of Generic Terms Does Not Obviate the Refusal

The addition of a generic or merely descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. *See In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re Wine Society of America Inc.*, 12

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