

Note To The File

Serial Number: 90022683
Date: 11/15/2022 2:20 pm
Created by: Lisa Papale



SINCE B 1608 BUSHMILLS THE ORIGINAL IRISH WHISKEY OLD BUSHMILLS

Changed

- Issued Examiner's Amendment and Entered Changes

From: Halstead, Erica <Erica.Halstead@wbd-us.com>

Sent: Tuesday, November 15, 2022 1:04 PM

To: Papale, Lisa <Lisa.Papale@USPTO.GOV>

Subject: FW: Trademark Applications for SINCE 1608 B BUSHMILLS THE ORIGINAL IRISH WHISKEY OLD BUSHMILLS (Serial No. 90022683) and SINCE 1608 B BUSHMILLS RED BUSH IRISH WHISKEY OLD BUSHMILLS (Serial No. 90023047)

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Dear Lisa,

Thank you for your email.

Our client agrees to disclaim "SINCE 1608" and to withdraw the Section 2(f) claim in part for each application as requested below.

Kindly issue Examiner's Amendments for the referenced applications.

Thank you,

Erica

Erica Halstead

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From: Papale, Lisa <Lisa.Papale@USPTO.GOV>

Sent: Thursday, November 10, 2022 1:03 PM

To: TM Docketing <TMDocketing@wbd-us.com>

Cc: Nektalov, Michael <Michael.Nektalov@wbd-us.com>; Basile, Cathy <Catherine.Basile@wbd-us.com>; Docketing NYC <DocketingNYC@wbd-us.com>

Subject: Trademark Applications for SINCE 1608 B BUSHMILLS THE ORIGINAL IRISH WHISKEY OLD BUSHMILLS (Serial No. 90022683) and SINCE 1608 B BUSHMILLS RED BUSH IRISH WHISKEY OLD BUSHMILLS (Serial No. 90023047)

Ms. Abelman,

I am the Trademark Examining Attorney at the U.S. Patent and Trademark Office examining your client's applications for SINCE 1608 B BUSHMILLS THE ORIGINAL IRISH WHISKEY OLD BUSHMILLS (Serial No. 90022683) and SINCE 1608 B BUSHMILLS RED BUSH IRISH WHISKEY OLD BUSHMILLS (Serial No. 90023047), and I wanted to discuss the following remaining issue with you.

Disclaimer Requirement: The composite wording "SINCE 1608" should be disclaimed because it is merely informational matter, indicating to consumers the year in which the applicant began producing its whiskeys. Unlike the other applications and registrations where the wording 1608 appears on its own and could be perceived as an arbitrary term, the unitary wording SINCE 1608 clearly indicates informational matter to consumers and, thus, must be disclaimed, as in Registration No. 6649292. As always, while your client would still have exclusive rights to the entire mark, the Office does not allow applicants to claim exclusive rights to terms that others might need to describe their own goods. Please let me know if you agree to the following amended statement being added to the record:

No claim is made to the exclusive right to use the wording "SINCE 1608" and "IRISH WHISKEY" apart from the mark as shown.

Withdrawal of Section 2(f) in Part Claim: For the reasons set forth in the Disclaimer Requirement above, the wording 1608 as it appears in the above-referenced marks is part of a unitary informational term; as such, the Section 2(f) claim, in part, should be withdrawn. Please let me know if you agree to the removal of this claim.

If you agree to the above amended disclaimer and to the withdrawal of the Section 2(f) in part claim, I can make the changes for you via Examiner's Amendment, and your client's application may proceed toward registration. Otherwise, I will send out Final Office actions for these two files.

Please let me know if you have any questions I can answer for you.

Thank you!

Best,

Lisa Papale

