

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
May 11, 2011

Mailed:
September 23, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fire Island Brewing Company LLC

Serial Nos. 77696805 and 77696816

Erik M. Pelton and Mark Donahey of Erik M. Pelton & Associates PLLC for Fire Island Brewing Company LLC

Howard Smiga, Trademark Examining Attorney, Law Office 102
(Karen M. Strzyz, Managing Attorney)

Before Zervas, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On March 23, 2009, applicant, Fire Island Brewing Company LLC, filed applications to register the following marks on the Principal Register for goods identified as "ale; beer" in International Class 32:

FIRE ISLAND BEER COMPANY LIGHTHOUSE ALE¹; and

¹ Application Serial No. 77696805, filed under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a) based on allegations of first use in June 1999 and use in commerce in July 2008, standard characters claimed, and "BEER COMPANY" and "ALE" disclaimed.



2

In each application, the examining attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the wording FIRE ISLAND on the ground that it is primarily geographically descriptive of applicant's goods within the meaning of Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2).

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Primarily geographically descriptive terms are unregistrable, under Trademark Act Section 2(e)(2) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is ground for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re*

² Application Serial No. 77696816, filed under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), based on an allegation of an intention to use the mark in commerce, "BEER CO." disclaimed.

Ser Nos. 77696805; 77696816

Richardson Ink Co., 511 F.2d 559, 185 USPQ 46 (CCPA 1975);
In re Ginc UK Ltd., 90 USPQ2d 1472 (TTAB 2007); In re
National Presto Industries, Inc., 197 USPQ 188 (TTAB 1977);
and In re Pendleton Tool Industries, Inc., 157 USPQ 114
(TTAB 1968).

When the refusal was made final, applicant appealed
and requested reconsideration. After the examining
attorney denied the request for reconsideration, the appeal
was resumed. Briefs have been filed and an oral hearing
was held on May 11, 2011.

We begin by addressing two preliminary matters.
First, the examining attorney requests that the Board take
judicial notice of a registration issued to applicant prior
to issuance of the final office action; however, the Board
does not take judicial notice of registrations. In re
Wada, 48 USPQ2d 1689, 1690 n.2 (TTAB 1998). In view
thereof, the request is denied.

Second, in its brief, applicant requests "in the
alternative" that in the event the Board sustains the
disclaimer requirement, the Board remand the applications
for consideration of whether FIRE ISLAND has acquired
distinctiveness. A request for remand should be made in a
separate filing and must include a showing of good cause.
Trademark Trial and Appeal Board Manual of Procedure (TBMP)

Ser Nos. 77696805; 77696816

§1205.01; 1209 (3d ed. 2011). In this case, applicant buried the request in its brief and did not make the requisite showing of good cause for the remand.

More importantly, throughout prosecution of the applications applicant never requested in the alternative to amend the applications to seek registration, in part, under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), based on acquired distinctiveness of FIRE ISLAND. Such a request should not be made for the first time in its appeal brief. See *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001). Once an application has been considered and decided on appeal it will not be reopened except for the entry of a disclaimer or upon order of the Director. Trademark Rule 2.142(g). See also *In re Societe D/Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784, 1789 (TTAB 2003) (Board has no authority to grant applicant's request made for the first time in its appeal brief to amend application to seek registration on an intent-to-use basis); TBMP §§1217, 1218; Trademark Manual of Examining Procedure (TMEP) §1501.06 (7th ed. 2010) and cases cited therein. In view thereof, the request is denied.

In support of his position that FIRE ISLAND is primarily geographically descriptive of applicant's goods,

the examining attorney submitted the following dictionary definition:

Fire Island a narrow spit off S Long Island, New York; summer resort and lighthouse station $\frac{1}{4}$ - $\frac{1}{2}$ mi. (0.4-0.8 wide; 30 mi. (48 km) long).

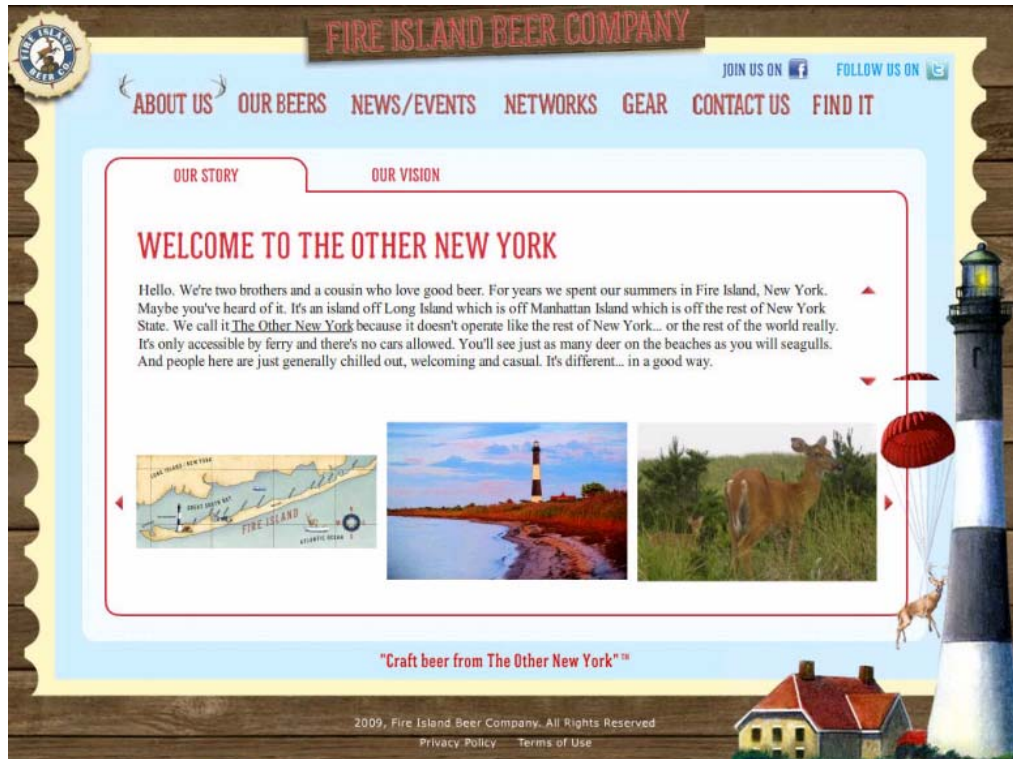
Random House Unabridged Dictionary (1997) at infoplease.com.

In addition, he submitted several pages from applicant's website. Below are examples of text and pictures appearing on the website:

Welcome To FIRE ISLAND BEER COMPANY "Craft beer from The Other New York"

WELCOME TO THE OTHER NEW YORK ... Hello. We're two brothers and a cousin who love good beer. For years we spent our summers in Fire Island, New York. Maybe you've heard of it. It's an island off Long Island which is off Manhattan Island which is off the rest of New York State. We call it The Other New York because it doesn't operate like the rest of New York ... or the rest of the world really. It's only accessible by ferry and there's no cars allowed. You'll see just as many deer on the beaches as you will seagulls. And people here are just generally chilled out, welcoming and casual. It's different... in a good way.

FIRE ISLAND LIGHTHOUSE ALE ... Fire Island is known for being easy going with a lot of character, so Fire Island Lighthouse Ale has been crafted the exact same way. A soft carbonation and light caramel finish make Fire Island Lighthouse Ale easy to drink, yet it has the toasty round body of a classic American Ale to give it real substance. It's a beer for all seasons, all foods and all friends. Or as we like to say, the kind of beer you want to have a beer with.



www.fireislandbeer.com.

Finally, he submitted printouts of pages from third-party websites and a few excerpts are reproduced below:

Fire Island, New York Travel Guide ... Fire Island awaits your arrival, with its pristine sand dune beaches, dazzling nightlife, fine dining, and striking scenery that will take you're your breath away. ... Going out in Fire Island? Know Before you go read "The Fire Island Bar Hop - Get your Drink On!"

www.fireisland.com;

Fire Island is both the name of an island and the name of a census-designated place. The island is one of Long Island's south shore outer barrier islands, approximately 31 miles long. The land area is 8.687 sq. mi. ... and a permanent population of 491 people was reported as of the 2000 census. (There are hundreds of thousands of summertime residents, groupers and daytrippers.)

... .. The island has very limited access by automobile for day use, from Long Island by the Robert Moses Causeway on its western end to Robert Moses State Park ... Motor vehicles are not permitted on the approximately 20 miles in between ... Essentially the island and its resort towns are accessible only by the numerous ferries. ... In popular culture ... Fire Island is repeatedly referenced on the NBC sitcom Will and Grace. Many references are made to the adventures had by Will Truman and Jack McFarland during their vacations on the Fire Island. The impression given in the references is that gay people are welcome and there is a loosening of one's inhibitions when there. ... Fire Island serves dual meanings as both a vacation destination and a homoerotic euphemism in "Dress Your Family in Corduroy and Denim" by David Sedaris. In the story "Blood Work," David describes an instance in which he is mistaken for an erotic housekeeper and his would-be John makes frequent and emphatic mention of FIRE ISLAND as a secret code. Ignoring the awkward advances and a travel brochure featuring scantily clad men, David's only response is to ask "do you bring your Mother to Fire Island?"

En.wikipedia.org; and

Fire Island National Seashore Long Island, New York ...Rhythmic waves, high dunes, ancient maritime forests, historic landmarks and glimpses of wildlife - Fire Island has been a special place for diverse plants, animals and people for centuries. Far from the sounds and pressures of nearby big-city life, Fire Island National Seashore's dynamic barrier island beaches offer solitude and camaraderie, and spiritual renewal to civilization-weary people. Things To Do ... Fire Island Lighthouse

www.nps.gov.

In traversing the refusal, applicant "does not dispute that Fire Island is a generally known geographic location.

Ser Nos. 77696805; 77696816

However, the geographic meaning of 'FIRE ISLAND' is too minor and unconnected to Applicant's goods to be the primary significance of the mark. The use of the word 'primarily' in the phrase 'primarily geographically descriptive' means that registration should not be refused if the geographic meaning is minor, obscure, remote or unconnected with the goods in question." Br. p. 5. More specifically, applicant argues that:

Applicant's FIRE ISLAND Marks are not primarily geographically descriptive because the term "FIRE ISLAND" as used in Applicant's marks does not primarily serve as a geographical indicator. Rather, Applicant's use of "FIRE ISLAND" suggests that Applicant's beer and ale goods share certain qualities commonly associated with Fire Island itself. Furthermore, because Fire Island does not have a beverage production or distribution industry, and tourism is essentially the only industry on the island, there is no reason to believe that consumers would assume a goods/place association exists.

Br. p. 4.

Relying on cases such as *In re Jacques Bernier, Inc.*, 894 F.2d 389, 13 USPQ2d 1725, 1727 (Fed. Cir. 1990) where a term is suggestive of a quality of the goods, such as FIFTH AVENUE for luxury cars, HYDE PARK for clothing and RODEO DRIVE for perfumes, applicant contends that:

[T]he primary significance of 'FIRE ISLAND' is the connotation attached with the island itself, specifically the laid back and uninhibited vacation atmosphere among several small but diverse communities of neighbors who are

physically and psychologically disconnected from the typical anxieties of daily New York life.

Br. p 6.

Further, applicant argues that Fire Island is known as a tourist destination "accessible only by ferry lacking any appreciable industries other than those related to tourism [and] [g]iven this reputation among the relevant public, consumers are not likely to conclude that Applicant's goods originate from Fire Island ... [thus,] evidence that Fire Island is a well known vacation location actually reduces the likelihood that consumers are likely to make a goods/place association between applicant's mark and Applicant's beer and ale goods." Br. pp. 12-13. As such, applicant asserts that it would be incongruous for consumers to believe that Applicant's goods originate on Fire Island. Reply Br. p. 1.

In support of its position applicant submitted, inter alia, the declaration of Mr. Thomas Fernandez, applicant's Vice President and Manager and one of applicant's founders. Excerpts from Mr. Fernandez' declaration are set forth below:

3. The inspiration for FIBC grew out of our hobby of making our own home-brew beer while vacationing on Fire Island. When we decided to start brewing beer professionally, we chose to name our company and beer after Fire Island to suggest the friendly and easy-going attitude of

the island and its people. We still visit our vacation home on Fire Island, and some of the recipes we developed while home-brewing there have matured into beers currently offered for sale under the applied-for marks.

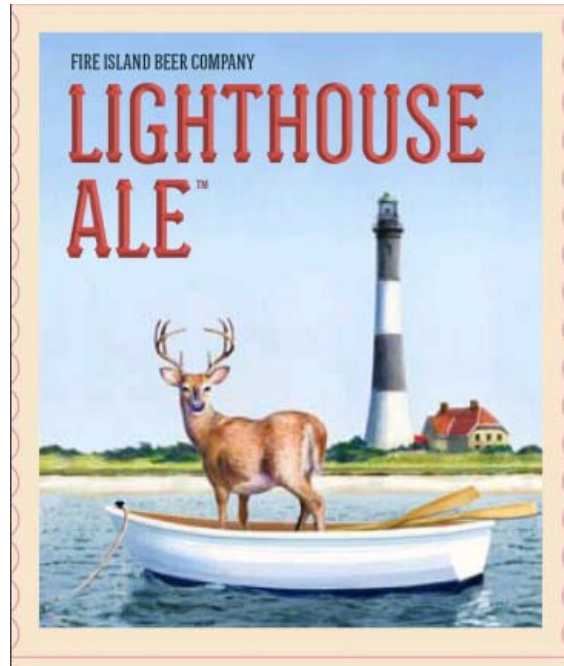
4. ... FIBC does not maintain brewing, distribution, or warehousing operations on Fire Island because there is little or no industry on Fire Island apart from tourism. Furthermore, such activities are made impractical by strict limitations on access to the island by trucks and other automotive vehicles.

5. FIBC beer and ale is currently brewed under contract in upstate New York by Olde Saratoga Brewing Company, Saratoga Springs, NY. Olde Saratoga Brewing ships most FIBC beer directly to Manhattan Beer Distributors of Bronx, NY for distribution throughout New York's five Burroughs, Long Island, and Chester County. FIBC maintains a small wholesale warehouse in Brightwaters, NY, where a small inventory is maintained for tastings and other promotional events held throughout the region. The bulk of FIBC's remaining administrative activities are conducted in the co-founders' home offices located in Manhattan, NY, and Hamden, CT.

6. FIBC beer is available for purchase through beer retailers and restaurants on Fire Island, as it is elsewhere in our distribution region. FIBC also hosts tastings and other promotional events on and off Fire Island.

Fernandez Declaration, Request for Reconsideration (June 8, 2010).

Applicant's labels submitted in Application Serial No. 77696805 are shown below:




Hello Friend,

My nephew works on Wall Street. Last summer I had a "come to Jesus" with him and he stayed with me a whole month. The first night he checked his crackberry about a zillion times. During the days we'd hang at the beach and have some Lighthouse Ales. Two weeks into it, I asked if he could make us a reservation at my favorite restaurant. He casually said, "O.K., let me turn my phone on."


12 Fluid Ounces
FIRE ISLAND BEER COMPANY LIGHTHOUSE ALE™

"CRAFT BEER FROM THE OTHER NEW YORK"™
www.fireislandbeercompany.com

Brewed and bottled by Fire Island Beer Co., Saratoga Springs, NY
CT • ME • VT • DE • MA • NY • IA • OR 54 / MI 196



8 50313 00200 6



GOVERNMENT WARNING: (1) ACCORDING TO THE SURGEON GENERAL, WOMEN SHOULD NOT DRINK ALCOHOLIC BEVERAGES DURING PREGNANCY BECAUSE OF THE RISK OF BIRTH DEFECTS. (2) CONSUMPTION OF ALCOHOLIC BEVERAGES IMPAIRS YOUR ABILITY TO DRIVE A CAR OR OPERATE MACHINERY AND MAY CAUSE HEALTH PROBLEMS.

"In order for a mark to be considered primarily merely descriptive under Section 2(e)(2), it must be shown that (1) the mark's primary significance is a generally known

geographic location; and (2) that the relevant public would be likely to make a goods/place association, that is, would be likely to believe that the goods originate in the place named in the mark." In re Spirits of New Merced LLC, 85 USPQ2d 1614, 1616 (TTAB 2007). See also In re Brouwerij Nacional Balashi NV, 80 USPQ2d 1820, 1821 (TTAB 2006); In re JT Tobacconists, 59 USPQ2d 1080 (TTAB 2001); and TMEP 1210.01(a) ("To establish a prima facie case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that: (1) the primary significance of the mark is a generally known geographic location, (2) the goods or services originate in the place identified in the mark ; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.")

"[W]here there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term is neither obscure nor remote, a public association of the goods or services with the place may ordinarily be presumed from the fact that the applicant's goods or services come from the geographical place named in the mark." JT Tobacconists, 59 USPQ2d at 1082. See also In re Handler Fenton Western, Inc., 214 USPQ 848, 850 (TTAB

Ser Nos. 77696805; 77696816

1982). However, if the term is remote or obscure, the public is unlikely to make a goods/place association. In *re Societe Generale Des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987); *Balashi*, 80 USPQ2d 1820.

We begin by finding that the relevant purchasing public for the goods at issue (beer and ale) consists of average American beer purchasers. *Balashi*, 80 USPQ2d at 1829.

Fire Island is a popular summer resort and National Park. Applicant does not contest and the evidence shows that FIRE ISLAND is a generally known geographic location. As to its primary significance, the descriptive wording "BEER COMPANY" and the additional word LIGHTHOUSE in the mark in Application Serial No. 77696805, and the descriptive wording "BEER CO." and the design element of a deer leaping over beer kegs in the mark in Application Serial No. 77696816 do not detract from the geographic significance of the wording FIRE ISLAND. These elements do not create an incongruity or imbue it with another meaning; if anything, the word LIGHTHOUSE enhances the geographic significance, giving the impression of a specific location, for example, the lighthouse on Fire Island shown below.



www.nps.gov, attached to December 8, 2009 Office Action.

Moreover, we are not convinced by the evidence of record that FIRE ISLAND presents circumstances similar to HYDE PARK for clothing such that its geographic significance is overtaken by another meaning that directly suggests an attribute of the goods, i.e., that the beer is "laid back" and "uninhibited." The third-party usages of record simply describe a vacation destination, both in terms of the place itself and its clientele. The examples do not show use of the term as, for example, a modifier with the proposed alternate meaning such that the relevant consumers, beer drinkers, are more likely to perceive that meaning.³

Finally, based on this record, including the online travel guides, FIRE ISLAND is not obscure or remote to the American public. In re Nantucket Allserve Inc., 28 USPQ2d 1144, 1145 (TTAB 1993).

³ The one example makes reference to a more specific meaning used in one book. See infra wikipedia excerpt attached to December 8, 2009 Office Action ("Fire island serves dual meanings as both a

We now consider whether the goods come from the place identified in the mark, namely, Fire Island, and whether the public would make a goods/place association. As noted above, when goods come from a specific geographic location, that is normally enough to find a goods/place relationship. In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652, 1655 (Fed. Cir. 1993) ("We likewise hold that the Board did not clearly err in finding that 'France, a major manufacturing and commercial nation, would be perceived as the source of the numerous goods and services listed in the applications of the mark is primarily geographical'").

In general, in cases where the Board has found a goods/place association, the goods were produced in that location, or sufficiently nearby to be considered as part of the region. In Merced, 85 USPQ2d at 1617-1622, the applicant produced its beer in the city of Merced on-site at its brewpub. The Board found that consumers would regard Merced and Yosemite Park as part of the same geographic area. The fact that both the city of Merced and applicant promoted an association with Yosemite, and beverages are served in Yosemite underpinned the determination that "[c]onsumers would likely believe that

vacation destination and a homoerotic euphemism [in a book by David Sedaris].")

applicant's beer had its origin in or was **in some way connected** to Yosemite. Merced, 85 USPQ2d at 1623 (emphasis added.) See also In re Joint-Stock Co. "Baik" 80 USPQ2d 1305, 1310 (TTAB 2006) (vodka produced in city of Irkutsk near Lake Baikal and made with water from Lake Baikal); JT Tobacconists, 59 USPQ2d 1080 (point of origin of applicant's goods is Minnesota).⁴

Applicant's goods are manufactured in Saratoga Springs, New York. Thomas Fernandez Declaration. Therefore, this case is not similar on its facts to those cases where the goods are manufactured in the named location or near enough to be considered as that location. Unlike the facts in Merced or Joint-Stock "Baik," there is nothing in the record to connect the locations of Fire Island and Saratoga Springs to each other.

When the goods are not actually produced in the location, we look to other points of contact that may be sufficient to consider the origin of the goods to be from the location (otherwise the mark may be primarily

⁴ In Balashi, while the goods were produced at the location, the location was found to be too remote for consumers to make the goods/place association. Balashi, 80 USPQ2d 1820.

geographically deceptively misdescriptive) and for evidence that consumers would be likely to make that association.⁵

In Nantucket Allserve, where the beverages were not produced in Nantucket, the Board found sufficient connection to the location based on the following facts: (1) the headquarters and research and development were located in Nantucket; (2) the labels included a picture of Nantucket Town and statements such as "Born on the Faraway Isle, Nantucket Nectars were created during the long winter months of 1990. Their flavor embodies the wholesome quality of the Island whose name they bear," and listed Nantucket, MA as the company address; (3) applicant sold its beverages at its store in Nantucket; and (4) some ingredients may have come from Nantucket.

The Board concluded that:

[I]ndividuals seeing applicant's labels on applicant's soft drinks would make a goods/place association between applicant's product and Nantucket, and would assume that applicant's soft drinks have their origin on Nantucket. Indeed, the labels state that applicant's soft drinks were "born on the Faraway Isle." While it is true that applicant's NANTUCKET NECTARS soft drinks are manufactured in Worcester, Massachusetts, applicant's corporate headquarters and, perhaps more importantly, applicant's center for research and development are located on Nantucket. ... Thus, **a principal origin**, if not

⁵ In this case, the examining attorney did not make a refusal in the alternative that FIRE ISLAND is primarily geographically deceptively misdescriptive under Section 2(e)(3).

the principal origin, of applicant's products is Nantucket.

Nantucket Allserve, 28 USPQ2d at 1145 (emphasis added).

At the other end of the spectrum, the Board has not found the requisite goods/place association where the only point of contact was the individual applicant's address listed in the application. In re Roy J. Mankovitz, 90 USPQ2d 1246, 1250 (TTAB 2009) (MONTECITO DIET not primarily geographically descriptive). Noting that "the mere fact that applicant sleeps in Montecito is not necessarily enough to establish a goods/place relationship," the Board continued:

In this case, however, not only do we not have any evidence that books and publications originate in Montecito, but we have no specific evidence that applicant's publications will originate in Montecito. We add that there is also no evidence that the public would believe that applicant's on-line journals and health information services originate from applicant's home or even some other location in Montecito.

Id. at 1249-1250. See also In re John Harvey & Sons Ltd., 32 USPQ2d 1451, 1454 (TTAB 1994) ("The mere fact that applicant's headquarters are in Bristol, England does not mandate a finding here that a goods/place association should be presumed").

The record in this case establishes that Fire Island has a very small year round population of approximately 491

individuals. In the summer months approximately 820,865 people visit the island. See App. Req. for recon. Exh. D, fireisland.info. During this time only pedestrian and bicycle traffic is allowed on the island and access to the island is primarily by ferry. See December 8, 2009 Office Action, nps.gov. However, the record also includes evidence of commercial activity on Fire Island, including several bars, restaurants and stores. See, e.g., App. Req. for Recon. Exh. E Business Directory and Shops; December 8, 2009 Office Action, nps.gov.

Clearly this is not a case where there is evidence that it is a well-known geographic location, such as France, from which we could assume that a wide variety of goods and services originate. However, Fire Island as discussed above, is not obscure or remote and there is nothing in the record to support a finding that it would be incongruous or otherwise unexpected for the purchasing public to expect that bars, restaurants and stores on the island would sell beer or to believe that beer, produced, for example, from a brewpub, originates on Fire Island. See *Merced*, 85 USPQ2d at 1622 (evidence shows the park not devoid of commercial activity). In fact, based on applicant's evidence of commercial enterprises on FIRE ISLAND, including bars and restaurants, it is reasonable to

believe that a brewpub is on the island and offers its own label.

The question then is whether there are enough points of contact between applicant and the location to create a sufficient nexus such that use of the term in connection with its beer and ale is primarily geographically descriptive. In this case, the points of contact that serve to establish Fire Island as the origin of the goods and to create a goods/place association in the minds of the consumers are: (1) recipes for some of applicant's goods were developed on Fire Island; (2) applicant's website and labels tout the connection to Fire Island (including pictures and maps of the island and statements such as "Craft beer from The Other New York"); (3) the goods are sold on Fire Island in stores and restaurants; (4) applicant maintains inventory in a warehouse across the bay from Fire Island and conducts tastings and promotional events in the area, including on Fire Island; and (5) applicant's owners maintain a presence on Fire Island through their home.⁶

⁶ While this factor alone may not be sufficient to establish a goods/place association it may be included in considering the totality of the circumstances. Further, with regard to the location of applicant's administrative office in Manhattan, aside from Manhattanites vacationing on Fire Island, there is insufficient evidence upon which to find that Fire Island is

Weighing against finding a goods/place association are the facts that the goods are bottled in Saratoga Springs, New York and that address appears on its labels. While consumers might not believe that applicant's beer and ale are mass produced and bottled on Fire Island, (obviously a difficult task when the only mode of transportation is a bicycle or a red wagon) certainly it is reasonable to believe the beer originates from there in the sense that Nantucket was "a principal origin if not the principal origin" of Nantucket Nectars or was in "some way connected to" Fire Island. Merced, 85 USPQ2d at 1622. In this case, the goods were developed on Fire Island, applicant sells and promotes its product on Fire Island, and applicant underscores its connection to Fire Island in its advertising and on its labels - "Craft Beer **from** the Other New York" (emphasis added). Nantucket Allserve, 28 USPQ2d at 1146. Weighing the evidence of record, we find that there is a sufficient connection to establish that applicant's goods originate from Fire Island and consumers would make the goods/place association.

The purpose of Section 2(e)(2) of the Trademark Act is "to leave geographic names free for all businesses

linked with Manhattan in the way that Yosemite is linked with the city of Merced.

operating in the same area to inform customers where their goods or services originate." Merced, 85 USPQ2d at 1621. There is no question that Fire Island is a term that applicant's competitors are entitled to use to describe the geographical origin of their beer or ale. Id. The examining attorney need not show that the public would actually make the asserted association; rather, the examining attorney need only show a "reasonable basis" for concluding that the public would make the goods/place association. Merced, 85 USPQ2d at 1623. Given the nexus between applicant and Fire Island and the existence of commercial activities on Fire Island relevant to applicant's goods, the circumstances in this case establish a goods/place association between applicant's goods and Fire Island and consumers would likely believe that applicant's beer and ale had its origin in or is in some way connected to Fire Island. Merced, 85 USPQ2d at 1623.

In view of the above, we conclude that FIRE ISLAND for use in connection with applicant's beer and ale is primarily geographically descriptive.

Applicant correctly states that in cases of refusals under Section 2(e)(2) we must resolve doubt in favor of applicant; however, we have no such doubt in this case. In re International Taste Inc., 53 USPQ2d 1604, 1605-06 (TTAB

2000); John Harvey, 32 USPQ2d at 1455. Cf. In re Merrill Lynch Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (on issue of mere descriptiveness, reasonable doubts are resolved in favor of the applicant).

Thus, the disclaimer requirement is appropriate. In view of the above, the requirement to provide a disclaimer for the word FIRE ISLAND is affirmed in each application.

Decision: The refusal to register based on the requirement for a disclaimer of FIRE ISLAND is affirmed in each application. However, if applicant submits the required disclaimer of FIRE ISLAND in each application to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement.⁷ See Trademark Rule 2.142(g), 37 C.F.R. §2.142.

⁷ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use FIRE ISLAND is claimed apart from the mark as shown." TMEP 1213.08(a) (5th ed. 2007).