

**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 76/535843

APPLICANT: PENNINGTON SEED, INC.

CORRESPONDENT ADDRESS:  
Howard A. MacCord, Jr.  
MacCord Mason PLLC  
P. O. Box 2974  
Greensboro NC 27402

12-19-05  
  
**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

MARK: REBEL

CORRESPONDENT'S REFERENCE/DOCKET NO: 8326-025

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

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KRB Seed Company, LLC : BEFORE  
 THE

Trademark: REBEL (stylized) :  
 TRADEMARK TRIAL

Serial No.: 76/535,843 : AND

Attorney: Howard A. MacCord, Jr. :  
 APPEAL BOARD

Address: MacCord Mason PLLC : ON APPEAL  
 P.O. BOX 2974  
 Greensboro, NC 27402

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant has appealed the trademark examining attorney's final refusal to register the stylized mark REBEL for grass seed. Registration was refused on the Principal Register because the REBEL component of the Applicant's proposed stylized word mark is a varietal name, also known as a cultivar name, for grass seed. Varietal (or cultivar) names are generic designations and cannot be registered as Trademarks and therefore Applicant was required to be disclaimed apart from the mark as shown. That is, a component of the proposed stylized word mark is unregistrable on the Principal Register under 15 U.S.C. Section 1052(e)(1), TMEP Section 2(e)(1), and the Applicant must disclaim exclusive rights to the generic wording apart from the mark as shown, pursuant to Trademark Act Section 6, 15 U.S.C. Section 1056, TMEP sections 1213.03(a) and (b). For the reasons and authorities cited below, it is requested that the refusal to register be affirmed.

**FACTS AND PROCEEDINGS**

Applicant, KRB Seed Company, LLC, filed a Use-based application seeking registration on the Principal Register under Section 2(f) for the proposed mark REBEL in stylized typed form for use in connection with grass seed, in International Class 31.

In the first Office Action dated April February 11, 2004, the Examining Attorney refused registration based on an informality, seeking explanation of the lining contained within the drawing of the mark.

On October 18, 2004, the Applicant properly responded to the initial Office Action with clarification of the drawing on record.

Simultaneously, however, in a superseding Office Action also dated February 18, 2005, the Examining Attorney refused registration of the Applicant's proposed mark pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), TMEP Section 1209 *et seq.* because the mark was primarily merely descriptive of the goods. The Request for Clarification of the drawing was continued therein, as the Examining Attorney had not yet received the Applicant's February 18, 2004, response to the initial Office Action. Registration on the Supplemental Register was offered, pursuant to Trademark Act Section 23, 15 U.S.C. Section 1091, 37 C.F.R. Sections 2.47 and 2.75(a), TMEP Sections 202.2(b) and 1115. However, the Examining Attorney required a disclaimer of the word REBEL apart from the mark shown pursuant to Trademark Act Section 6, 15 U.S.C. Section 1056, TMEP sections 1213 and 1213.02(a), because "rebel" is the common variety name of family of tall fescue (grass) seed and, as such, the REBEL word component is a varietal or cultivar name describing the applicant's grass seed.

On May 19, 2004, in response to the superseding Office Action, the Applicant once again explained that the mark was lined for the color red, and submitted arguments in favor of registration on the principal register without a disclaimer of the descriptive wording.

On July 28, 2004, the Examining Attorney issued a Final refusal pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) with a continuation of the offer to Register the mark on the Supplemental register Trademark Act Section 23, 15 U.S.C. Section 1091, 37 C.F.R. Sections 2.47 and 2.75(a), TMEP Sections 202.2(b) and 1115, provided the Applicant submit a disclaimer of REBEL pursuant to Trademark Act Section 6, 15 U.S.C. Section 1056, TMEP sections 1213 and 1213.02(a), as the REBEL" component of the proposed mark is a varietal name for grass seed and therefore a generic designation for the Applicant's goods.

On or about August 1, 2004, the Applicant's counsel telephoned the Examining Attorney seeking clarification of the Applicant's request for registration on the Principal Register under Section 2(f).

On August 3, 2004, the Examining Attorney issued a supplemental Final Refusal Office Action noting that the Applicant must submit a properly worded claim when seeking registration based on acquired distinctiveness for continuous use, and explaining that generic matter must be disclaimed even when registration is sought on the Principal Register pursuant to Section 2(f).

On December 21, 2004, Applicant submitted documentation of an Assignment of the mark resulting in a change in ownership from KRB Seed Company, LLC to Pennington Seed, Inc.

On December 30, 2004, the Applicant filed an appeal. The Applicant did not submit a properly

worded claim of continuous use.

On February 25, 2005, the Applicant filed its Appeal Brief.

On April 20, 2005, the examining Attorney filed a Motion for Suspension of Proceedings Pending Disposition of Applicant's Prior Filed Application, Serial No. 76/535843, for the mark REBEL, in typed form, for grass seed.

On May 10, 2005, proceedings herein were suspended.

On September 19, 2005, the Trademark Trial and Appeal Board affirmed the refusal to register the mark REBEL in the Prior Filed Application, Serial No. 78/535843, finding that the Applicant's proposed mark REBEL is a varietal name and therefore generic and unregistrable.

On October 18, 2005, the proceedings herein were resumed.

#### ISSUE ON APPEAL

Whether the word component of the stylized, word mark "REBEL," determined to be generic when used in connection with grass seed, must be disclaimed apart from the mark as shown prior to registration on either the Principal Register under Section 2(f) or the Supplemental Register, pursuant to Trademark Act Section 6, 15 U.S.C. Section 1056, TMEP sections 1213.03(a) and (b).

#### INCORPORATION BY REFERENCE OR JUDICIAL NOTICE

The Examining Attorney incorporates by reference and respectfully requests that the Trademark Trial and Appeal Board take judicial notice of its decision in *In Re KRB Seed Company, LLC* (TTAB 2005), as this application is a copending application. Attached hereto is a copy of the referenced decision. The Board may take judicial notice of a fact that is not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. Trademark Trial and Appeal Board Manual of Procedure § 704.12(a). Such notice may be taken at any stage of a Board proceeding, even at the time of decision on appeal from the Board's decision therein. Fed. R. Evid. 201(b) and *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999); TBMP § 704.12(d)

ARGUMENT

**I. “REBEL” Is A Varietal Name For Grass And Is Therefore Generic When Used In Connection With The Applicant’s Goods, Which Are Grass Seeds.**

During the prosecution of the application for registration on the Principal Register of the asserted mark REBEL, in stylized form, for grass seed, the Examining Attorney presented extensive arguments and evidence in support of finding the word “REBEL” generic when used in connection with the goods. This point is now moot as the Trademark Trial and Appeal Board has determined that, indeed, the word “REBEL” is generic when used in connection with grass seed products. Nevertheless, presented herein are arguments and supporting case law reference in support of the Examining Attorney’s argument and the Board’s finding that “REBEL” is generic for grass seed.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant good. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath, Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

The applicant applied to register the stylized mark REBEL for grass seeds. The examining

attorney provided the applicant with evidence that the term "Rebel" is a varietal name for grass seed. Trademark Act §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127; Trademark Act §6, 15 U.S.C. §1056; TMEP §§1202.12, 1213 and 1213.03(a).

Furthermore, the history of "tall fescue," establishes that tall fescue was discovered in 1923 and the REBEL variety was created in the 1970's. The Applicant claims its first use of "REBEL" in any form was in 1980. (See Examining Attorney's Final Refusal at p. 4 and attached evidence, Craig W. Edminster, *Selection of Grass for Sports Fields in the 21<sup>st</sup> Century*, [http://www.intlseed.com/documnts/info\\_grass\\_for\\_sports\\_fields.htm](http://www.intlseed.com/documnts/info_grass_for_sports_fields.htm) , last visited December 14, 2005). As such, the applicant's "adoption" of the "REBEL" name for its own tall fescue was 10 years after the variety was created. Adverse possession laws do not apply to varietal names. That is, the applicant's 20 years use of the "REBEL" name for tall fescue has not given rights in the applicant above others. The name "REBEL" was generic for the particular variety of tall fescue for nearly 10 years before the applicant's claimed use began.

The "Applicant concedes that REBEL has been used as [a] varietal name, but disputes that such usage requires a conclusion that the mark is generic and subject to a disclaimer," believing that the "facts show trademark usage." (App. Br. 2). To this end, the Applicant argued that Examining Attorney misinterpreted *Dixie Rose*, that the court in *Kellogg Company v. the National Biscuit Company*, 305 U.S. 111, 39 USPQ 296 (1938), created an unnecessarily harsh rule prohibiting trademark protection where an applicant procured another form of intellectual property protection prior to applying for a trademark, and contends that current trademark law does not warrant adherence to such courses of prosecution.

The Examining Attorney and more importantly, the Board found these and similar arguments to be unpersuasive.

A varietal or cultivar name is used in a plant patent to identify the variety. Thus, even if the name was originally arbitrary when initially created to describe the particular variety of grass seed, it now describes to the public a plant of a particular sort, and not a plant from a particular source. *See Dixie Rose Nursery v. Coe*, 131 F.2d at 447, 55 USPQ at, 316 (D.C. Cir. 1942), cert. denied 318 U.S. 782, 57 USPQ 568 (1943).

The Office finds that no amount of "trademark usage" of "REBEL" will grant exclusive rights to the Applicant in the word "REBEL" when it is used in connection with grass seed products.

However, despite the applicant's evidence of usage and claims that the USPTO'S treatment of

varietal names as generic and unregistrable being inconsistent with current intellectual property law, the Board affirmed the findings in the Applicant's Prior Filed Application, Serial No. 76/535843, ruling that:

. . . the policy of the USPTO is in accord with the [Plant Variety Protection Act (§ 7 U.S.C. 2422), the International Convention for the Protection of New Varieties of Plants] and case law since 1942, all of which codify and implement the common sense notion that when a new plant is created it must be called something, and that when others begin to sell it after expiration of the breeder's protection period they need to call it by the name that it is known or otherwise consumers will not know what they are buying . . . Indeed, the use of a different term in connection with a particular variety could be deceptive, hence, the requirement under Article 7 of UPOV that persons offering the variety for sale even after expiration of the 'breeder's right' *must* use the denomination (varietal name) of that variety.

Therefore, inasmuch as we reiterate the correctness of the case law that 'varietal names are generic designations and cannot be registered as trademarks,' and inasmuch as applicant's proposed mark is a varietal name, we find that it is generic and unregistrable; and applicant's arguments and evidence of acquired distinctiveness cannot overcome such a finding.

(*In Re KRB Seed Company, LLC* (TTAB September 19, 2005) at 11-12)(citations omitted).

The wording "Rebel" is incapable of functioning as a trademark because it is a term for live plants or agricultural seeds comprising a varietal or cultivar name. §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. *See Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942), *cert. denied* 318 U.S. 782, 57 USPQ 568 (1943); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231 (TTAB 1963); *In re Cohn Bodger & Sons Co.*, 122 USPQ 345 (TTAB 1959).

For the reasons and authorities cited above, it is requested that the Examining Attorney's determination that the word "REBEL" is generic when used in connection with grass seed, pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), and the recent decision in the prior filed, copending case for REBEL" (*In Re KRB Grass Seed Company, LLC*, (TTAB July 20, 2005)) be affirmed.

**I. Exclusive Rights To The Generic Component Of the Proposed Stylized Word Mark "REBEL" Cannot Be Obtained Through Acquired Distinctiveness And Therefore Must Be Disclaimed Apart From The Mark As Shown.**

**A. Trademark Law Has Consistently Required That Generic Terms Be Disclaimed Before Registration Is Allowed.**

In its original application, the applicant sought to register its stylized mark REBEL, on the

Principal Register under 15 U.S.C. 1052(f), Trademark Act Section 2(f), asserting that it had acquired distinctiveness in the word "REBEL" when used in connection with grass seed.

According to TMEP Section 1212.02(b), procedurally, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive (and thus not registrable on the Principal Register absent proof of acquired distinctiveness). Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984).

As noted above, the Applicant concedes that REBEL has been used as a varietal name and has enjoyed "plant variety protection." (Br. At 13). The Board has held consistently that varietal (or cultivar) names for relevant goods, such as grass seeds, fail to function as trademarks, pursuant to Trademark Act Sections 1, 2 and 45, 15 U.S.C. Sections 1051, 1052 and 1127, and therefore cannot be registered as trademarks. *See In Re Delta & Pine Land Co.*, 26 USPQ2d 1157, 1159 n.4 (TTAB 1993); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *Dixie Rose Nursery v. Coe*, 131 F.2d at 447, 55 USPQ at 316 (D.C. Cir. 1942), cert. denied 318 U.S. 782, 57 USPQ 568 (1943).

*Estate of P.D. Beckwith v. Comm'r of Pats.*, 252 U.S. 538, 1920 C.D. 471 (1920), and other disclaimer decisions before the Trademark Act of 1946 dealt with disclaiming descriptive or generic matter. Section 6 of the Act referred initially to "unregistrable matter" and, since the 1962 amendment, now refers to "an unregistrable component."

Typically an unregistrable component of a registrable mark is the name of the goods or services,

other matter that does not indicate source, or matter that is merely descriptive or deceptively misdescriptive of the goods or services, or primarily geographically descriptive of them.

If a mark is comprised in part of matter that, as applied to the goods/services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register. *See In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) ("[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f)."); *see also In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) ("Section 6 is equally applicable to the Supplemental Register."); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (mark comprising stylized lettering of BALSAM, with disclaimer of "BALSAM," found registrable on Supplemental Register for hair conditioner and hair shampoo); *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) ("Section 6 of the Trademark Act of 1946, which provides for the disclaimer of 'unregistrable matter', does not limit the disclaimer practice to marks upon the Principal Register.").

Here, the "REBEL" component of the asserted mark has been found generic when used in connection with grass seed. (*See In Re KRB Grass Seed Company, LLC*, (TTAB July 20, 2005)). Generic terms are unregistrable for failing to indicate the source of goods. Unregistrable terms must be disclaimed even when registration on the Principal Register is sought pursuant to Trademark Act Section 2(f) because generic terms cannot acquire distinctiveness. Therefore, the REBEL component of the asserted mark must be disclaimed.

**B. Generic Terms Must Be Disclaimed Before Registration Is Allowed For Public Policy Reasons.**

Even if during the prosecution of the asserted mark ample evidence had not been provided establishing that the REBEL component is generic and the Board had determined that despite being a

varietal name, the term "REBEL" also was not generic, allowing the applicant to acquire distinctiveness in the varietal name would be against public policy.

The Applicant contends that its grass seed is unique, that it has used REBEL extensively and has licensed the use of REBEL to others such that the licensee's use inures to the benefit of the Applicant, and that some \$400,000,000 worth of grass seed has been sold under the name REBEL since 1979, during which time \$25,000,000 has been spent on marketing REBEL as a source of grass seed. Finally, the applicant argues that as the "Rebel" variety of grass seed is also known as "festuca arundinacea schreber," and "Bartes" is a synonym for "Rebel," and that the applicant's particular use of the term "REBEL" coupled with the alternative names, proves that REBEL is not generic and that exclusive rights in the name should be afforded the applicant.

Trademark law has dealt consistently and required fairness with respect to the use of generic terminology. Once a term has been properly deemed generic, either through an administrative rulemaking process or rule of law, the word is open for all to use.

It would be against public policy for the Office to rule that a word legally established as generic for a particular set of goods and legally available for use by all consumers with respect to those goods, has now been so well used by one particular consumer over and above all the other users of the same word when referring to those goods, that the rights that were reserved by all should now reside in one.

For the reasons and authorities cited above, it is requested that the Examining Attorney's determination that exclusive rights to the generic word "REBEL" be disclaimed apart from the mark as shown, pursuant to Trademark Act Sections 2(e)(1) and 6, 15 U.S.C. Sections 1052(e)(1) and 1056, be affirmed.

**CONCLUSION**

For the foregoing reasons and authorities, the examining attorney submits that the refusal to register Applicant's proposed mark on the basis that a component of the proposed mark is generic with respect to the identified recited goods, thereby requiring a disclaimer of such component apart from the proposed mark as shown, should be affirmed.

Respectfully submitted,

/Ronald E. Aikens/  
Trademark Attorney, Law Off. 103  
(571) 272-9268 (wk)  
(571) 273-9268 (fax)(not for Official resp.)  
Ron.Aikens@USPTO.gov (not

Michael Hamilton  
Managing Attorney  
Law Office - 103