

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pennington Seed, Inc.

Serial No. 76535843

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for Pennington Seed, Inc.

Ronald E. Aikens, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Bucher, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark shown below for "grass seed" in International
Class 31.



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Applicant initially sought registration for its mark pursuant to Section 2(f) alleging that its mark had become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce. The examining attorney required that applicant disclaim the word REBEL on the ground that it is a varietal name and, as such, generic. Trademark Act Sections 1, 2 and 45. 15 U.S.C. §§1051, 1052 and 1127. Pursuant to Trademark Act Section 6, the examining attorney issued a final refusal of registration pending applicant's submission of a disclaimer for the term "REBEL." 15 U.S.C. §1056. In addition, the examining attorney refused registration based on applicant's insufficient claim of acquired distinctiveness. Applicant appealed the examining attorney's final refusal.

During the prosecution and appeal of this application, applicant had other co-pending applications for various REBEL marks which were also on appeal before the Board.

¹ Application Serial No. 76535843, filed on July 30, 2003, under Section 1(a) of the Trademark Act, claiming a date of first use and first use in commerce on August 1, 1998. The mark is lined for the color red. In addition, the application lists Reg. No. 2684924 as a prior registration for the same mark on the

After applicant filed its brief, this appeal was suspended pending determination of the appeal in application Serial No. 76289621 for the mark REBEL which had been refused registration on the basis that it is a generic varietal name. The Board's affirmance in that case was upheld by the Court of Appeals for the Federal Circuit (Federal Circuit) on October 19, 2006. In re Pennington Seed, Inc., 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006).

After the Federal Circuit issued its opinion in Pennington Seed, applicant requested that this application be remanded for consideration of its request for entry of a disclaimer for the word "REBEL." The Board remanded the application and the examining attorney issued an action granting applicant's request for the disclaimer but maintaining the requirement for a proper claim of acquired distinctiveness, stating:

The [request for reconsideration] is incomplete because the applicant has failed either to include a proper claim of acquired distinctiveness with its disclaimer, or to amend to the Supplemental Register ... The applicant has 30 days, or until the end of the six months from the final action, whichever is longer, to comply with the outstanding requirements or refusals. 37 C.F.R. §2.65(b). If applicant fails to comply with the noted requirement of a proper claim of acquired distinctiveness, or does not amend to the Supplemental Register, or fails

Supplemental Register which includes a disclaimer for the word "REBEL."

to respond, the application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

"Request for Reconsideration Granted," December 18, 2007.

Applicant did not file a response and the examining attorney subsequently issued an order denying the request for reconsideration inasmuch as applicant failed to comply with the outstanding requirement.

Inasmuch as applicant submitted the disclaimer, that issue is moot. The only issue remaining on appeal is the requirement to submit a sufficient statement of acquired distinctiveness, which applies to the other elements of the mark.

The application, signed on May 30, 2003 and filed on July 30, 2003, includes the following statements:

The above-identified applicant has adopted and is using [the] trademark shown in the accompanying drawing for GRASS SEED and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of 1946 under Section 2(f). The mark has become distinctive of the applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by the applicant. ... The mark was first used on the above-identified goods at least as early as August 1, 1998, and first used in interstate commerce at least as early as August 1, 1998, and is now in use in such commerce.

The examining attorney found that the claim under Section 2(f) "fails to make a proper claim of acquired

distinctiveness" and "[i]f the applicant chooses to [make a claim under Section 2(f)] by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate. The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." Final Office Action, August 3, 2004 (emphasis in original).

The issue here is the absence of the last clause. The statute provides as follows:

The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. §1052(f). See also Trademark Rule 2.41(b), 37 C.F.R. §2.41.

As noted in the Trademark Manual for Examining Procedure, "[u]se of the precise statutory wording is desirable, but variations may be accepted if they do not affect the essential allegations." TMEP §1212.05(d) (5th ed. 2007). In discussing what constitutes an essential allegation, the TMEP provides:

[U]se of the mark must cover the five years before the date of the statement of five years' use. Thus wording that indicates that the use referred to is before the date of the statement is essential. Its omission can only be excused if the facts in the record clearly show that the use includes the five years before the date of the statement.

Id.

In this case, the statement of record does not include at least one essential element, specifically that the use referred to is for the five years before the date of the claim. Moreover, the facts in the record do not "clearly show that the use includes the five years before the date of the statement." To the extent allegations of use could be relied upon as such "facts in the record," here, they weigh against such a finding inasmuch as the date of first use in commerce in the application is August 1, 1998, but the claim was made on May 30, 2003, two months prior to five years use based on the date of first use.² Moreover, we are not convinced that dates of use standing alone would suffice because the five year statement must be tied to "substantially exclusive and continuous use."

Decision: The refusal to register based on applicant's failure to submit a sufficient claim of

² Even if we were to go by the filing date of the application, July 30, 2003, this also precedes the completion of the five year requirement albeit by two days.

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distinctiveness under Section 2(f) is affirmed. See
Trademark Rule 2.141(b), 37 C.F.R. §2.141(b).