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Mailed: April 15, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Oliver Wine Co., Inc.

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Serial No. 77681936

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Clifford W. Browning of Kreig Devault for Oliver Wine Co., Inc.

Shaila Evelyn Settles, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Seeherman, Walters and Kuhlke, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Oliver Wine Co., Inc. has filed an application to register on the Principal Register the standard character mark AMERICAN HERITAGE for "wines," in International Class 33.<sup>1</sup> In its response to the first Office Action refusing registration and requesting information about the significance of the mark in the relevant industry, applicant

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<sup>1</sup> Serial No. 77681936, filed March 3, 2009, based on an allegation of a bona fide intention to use the mark in commerce.

added a disclaimer of exclusive rights to HERITAGE apart from the mark as a whole; and made the following statement: "AMERICAN HERITAGE appearing in the mark has no significance in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance."

The examining attorney has issued a final refusal to register on the alternative grounds that, under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), applicant's mark is deceptive in connection with its goods; and that, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

**1. Evidentiary Objection**

In its September 30, 2009, response, Applicant listed five third-party registrations for the mark AMERICAN HERITAGE for, respectively, agricultural seeds,<sup>2</sup> cheeses,<sup>3</sup> canned and frozen vegetables,<sup>4</sup> wood chips and pellets for fuel,<sup>5</sup> and synthetic fiber fabrics,<sup>6</sup> and a registration for AMERICAN HERITAGE

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<sup>2</sup> Registration No. 2719925.

<sup>3</sup> Registration No. 3070751; which includes a claim under Section 2(f) of acquired distinctiveness as to AMERICAN.

<sup>4</sup> Registration No. 1640626.

<sup>5</sup> Registration No. 2769303.

<sup>6</sup> Registration No. 3406289.

FOODS for chicken.<sup>7</sup> Applicant listed only the marks, goods and registration numbers and repeated this list in its brief.

While a mere listing does not properly make registrations of record, the examining attorney issued two office actions subsequent to applicant's response and did not object to the form of applicant's submission until her brief on the case. The examining attorney's objection to consideration of the list of registrations is overruled and we have considered the list for whatever probative value it may have.

## **2. *Alternative Substantive Refusals***

First, while the term "American" appears in the mark and the examining attorney contends that "American" indicates the geographic origin of applicant's wines or the grape varieties of which the wine is composed, neither alternative refusal to register is based on a contention that the mark in its entirety is geographic. The examining attorney has based the refusals on, respectively, Trademark Act Sections 2(a) deceptiveness and 2(e)(1) mere descriptiveness. *See In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003).

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<sup>7</sup> Registration No. 3283735; which includes a disclaimer of FOODS apart from the mark as a whole.

Second, we note that the examining attorney's Section 2(e)(1) refusal is based on her contention that the mark is merely descriptive. The assumption in making such a refusal is that the mark describes, in this case, a significant ingredient of the goods, *i.e.*, a type of grape known as "heritage" grapes.<sup>8</sup> The examining attorney has also addressed the possibility that applicant's goods are not composed of "heritage" grapes, and has made an alternative refusal under Section 2(a) based on deceptiveness. Because the examining attorney has made these refusals in the alternative, we find no inconsistency between the Sections 2(a) and 2(e)(1) refusals. Whether "heritage" merely describes a significant ingredient in wines, *i.e.*, a type of grape, is a threshold question with respect to both alternative refusals. If the answer is "yes" and we find that applicant's wine *does* contain this type of grape, then the Section 2(a) refusal is moot. If the answer is "yes" and we find that applicant's wine *does not* contain this type of grape, then the Section 2(e)(1) refusal is moot.

The examining attorney's alternative positions in the Sections 2(e)(1) and 2(a) refusals depend on a finding that the mark as a whole, AMERICAN HERITAGE, either does or does not merely describe a significant ingredient of applicant's

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<sup>8</sup> The examining attorney did not refuse registration under Section 2(e)(1) on the ground that the mark is deceptively misdescriptive in

wines. In view of the additional factors that must be established in a Section 2(a) deceptiveness refusal,<sup>9</sup> we consider, first, the refusal under Section 2(e)(1).

**3. Section 2(e)(1) Refusal**

*Arguments and Evidence*

The examining attorney contends that AMERICAN HERITAGE is merely descriptive in connection with wine, under Section 2(e)(1), based on the following argument:

1. The individual terms "heritage" and "American" describe significant aspects of wine. In particular, "heritage" is a term of art in the wine and agricultural industries that refers to age, grape varieties and wines derived from grape varieties that are unique and of historic value to their region, and "American" refers to the origin of the grape varieties or wines in the United States;
2. The type and geographic origin of grapes used in making wine is extremely important in wine selection by all consumers;

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connection with wine that does not contain "heritage grapes," and we do not so construe the refusal.

<sup>9</sup> With respect to the Section 2(a) refusal, in addition to establishing that the mark misdescribes a significant ingredient of applicant's wine, the examining attorney would also have to establish that prospective purchasers will believe this misdescription actually describes the goods; and that the misdescription is material to the purchasing decision. *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988).

3. Purchasers of applicant's wines are the general public, encompassing wine consumers of all levels of sophistication and exercising all levels of care in making their purchases;
4. The combination of the two descriptive terms to form the mark AMERICAN HERITAGE results in a descriptive mark in its entirety because the combination does not create a unique impression or otherwise alter the descriptive meaning of the two individual terms.

The examining attorney submitted a substantial amount of evidence from Internet sources.<sup>10</sup> The following is a representative sample of the submitted evidence regarding whether "heritage" is used in the wine and agricultural industries to describe a category of grapes and/or grape varieties (Emphasis added below):

**California Wine and Food:** Web article entitled *Heritage Grapes Harvested from Experimental Vineyard in Oakville*: "Zinfandel grapes from the one-acre **Heritage** Vineyard within UC Davis' Experimental Station in Oakville in the Napa Valley were harvested on September 11th ...

. . . .  
From the 1860s to the early 1990s it was the most widely planted varietal in California; this is why Zinfandel is called 'America's **heritage** grape' ...

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<sup>10</sup> We commend the examining attorney for the extent of the record supporting each of the many points she sought to establish in this case. However, we also advise her that submitting evidence that merely duplicates evidence sent with prior office actions is unnecessary and is strongly discouraged.

**Russian River Valley Winegrowers website:**

"Zinfandel - This **heritage** grape is widely planted throughout California ..."

**Sweetwater Cellars website:** "Sparkling Rosé Grape Juice, Kedem Winery ... The Rosé blends Vincent grapes with two **American heritage** grapes - Niagara and Concord."

**National Women's Wine Competition Top Results & Facts:** "NWWC judges awarded medals to outstanding examples of the 'usual' suspects ... plus more unusual varieties such as Aglianico, Albarino, Semillion, Carignane, Vignoles; [and] **American heritage** grapes such as Catawba and Norton ..."

**JancisRobinson.com website article written by Pennsylvania state viticulturist Mark Chien:** "... And why not use a **heritage** table grape called Alden to make a wonderful fresh, crisp and delicious, light-bodied red wine? At Chrysalis Vineyards Jennifer McCloud is on a mission to make Norton, a red grape from *Vitis aestivalis*, the signature **American** grape since Zinfandel's true origin has been revealed."

**Olympic Peninsula Wineries website:** "Lemberger: Washington's '**Heritage** Grape' - The Lemberger grape is rooted in Washington wine industry history. For more than a quarter century this vigorous grape ... has thrived in vineyards east of the Cascade Mountain range."

The following is representative of submitted evidence concerning whether "heritage" describes a category of fruits and vegetables, including grapes:

**U.S. Department of Agriculture's *Vegetables and Fruits: A Guide to Heirloom Varieties and Community-Based Stewardship*, Volumes 1-3, published in September 1988:** "Most people agree that heirloom vegetables and fruits are those types known through historical documentation or folk history for at least 50 years." The article further states: "For the purposes of this publication, the term 'heirloom' is used broadly and synonymously with such terms as

traditional, vintage, antique, **heritage**, or classic, since each of these terms conveys the age and perceived value of heirlooms, but says little about who grows them ..." (emphasis added)

The following is representative of the submitted evidence concerning whether all wine is labeled by grape variety and geographic origin; and the impact of wine labels on consumers:

**EncycloWine.com** - "Wine labels are important sources of information for consumers. The label is often the only resource a buyer has for evaluating the wine before purchasing it - ... virtually all new world wines are labeled by grape variety and geographic origin.

**eHow.com** - article entitled "*How to Choose a Bottle of Red Wine*" advises consumers to "[s]tart by learning to choose a wine based on your tastes, possible food pairings or a particular wine region or varietal you'd like to explore."

**Practical Winery & Vineyard** website - article entitled *Geographical Branding* states that "[u]se of an appellation of origin on a label requires that the wine be derived 75% from grapes from the appellation, and use of an American Viticultural Area requires an 85% origin. ...."

The examining attorney submitted several definitions of "heritage," the most relevant of which is "2.b. Tradition" from *Merriam-Webster's Online Dictionary*. Applicant submitted the same definition of "heritage" from *Webster's Third New International Dictionary (Unabridged)*.

Applicant argues that

"heritage" means "tradition," which, when combined with "American" and applied to wines, signifies nothing more to a purchasing consumer than the wines are an American Tradition of the wine maker,



being the Applicant. Nowhere within that meaning is there anything that can be appropriately asserted as being deceptive. ... AMERICAN HERITAGE, mean[s] an American Tradition, as applied to wine.

(9/30/2009 Response.) Applicant contends that the examining attorney's position is flawed because there is no consensus in the trade or among consumers as to the meaning of the term "heritage" in connection with wines or grape varieties.

Applicant further asserts that "American" is not geographically descriptive; rather, it is an arbitrary usage in its mark for wines. However, we note in this regard that applicant submitted copies of its labeling permit applications to the federal Alcohol and Tobacco Tax and Trade Bureau ("TTB") and listed, thereon, "American" as a "wine appellation." Applicant also states that "the wine's varietals are 'American Red Wine,' 'American Rose Wine' and 'American White Wine.'" (Reply Brief, p. 4.)

Applicant submitted a list and copies of third-party registrations for the mark AMERICAN HERITAGE for a variety of goods, as described *infra*. Applicant also contends that the active status of third-party Registration No. 1783602 for the mark HERITAGE for "wine"<sup>11</sup> belies the grounds for refusal because the mark therein was obviously not refused

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<sup>11</sup> A copy of this registration was included in the first office action as support for the examining attorney's refusal on the ground of mere descriptiveness. The registration was never the basis for a refusal under Section 2(d) and, in fact, in the first Office action the examining attorney stated that a search of Office records had not revealed any registrations that would bar registration of applicant's mark.

registration under either Section 2(e)(1) or Section 2(a) of the Act.

*Applicable Law*

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

*Analysis*

We begin by finding that applicant's statement of the lack of significance of its mark is *not* an admission by applicant that its wines do not contain "heritage" grape varieties from America. Rather, this statement is consistent with applicant's position that "heritage" is not a term of art for grape varieties or wine. Additionally, in view of applicant's statement that its disclaimer of

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"heritage" is not intended as a concession of descriptiveness,<sup>12</sup> and the fact that the examining attorney did not treat it as a concession because she submitted a significant amount of evidence on the issue, we also do not view applicant's disclaimer of "heritage" as a concession that the term is merely descriptive.

Thus, we examine the evidence to determine if the examining attorney has established that "heritage" merely describes a type of grape or wine. In this regard, we find the evidence suggests that "heritage" is used in connection with various different grapes and, rather than clearly describing a particular grape varietal or wine, the connotation is varied. "Heritage" is used variously in the evidence to refer to grapes that have been associated with a particular country or region; to refer to grapes that are from old-stock vines regardless of their origin; or to denote only those grape varieties grown from root stock indigenous to the United States.<sup>13</sup> Therefore, we find that

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<sup>12</sup> Applicant states that its submission of a disclaimer of "HERITAGE" was to address the existence of the registration for HERITAGE, discussed *supra*, not as a concession of descriptiveness. Applicant may voluntarily disclaim otherwise registrable matter in a mark. See *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pat. 1991). We point out that the issue herein is not likelihood of confusion; however, if such were the case, a disclaimer of the registered mark would not avoid confusion.

<sup>13</sup> For example, the evidence suggests that Zinfandel was considered the "heritage" grape in the United States because it was believed to be one of a few, or the only, grape that originated in the United States, although recent DNA studies now suggest otherwise. One article indicated that the search is on for a new heritage grape, meaning a grape whose root stock originated in the United States.

there is no definitive meaning for the term "heritage" in connection with grapes; rather, it has several different connotations. As such, the evidence is insufficient to conclude that "heritage," in the context of the mark AMERICAN HERITAGE for wines, would be understood as describing a specific or significant ingredient of that wine. We find that, consistent with the definition of record, "heritage" at most suggests tradition in the context of AMERICAN HERITAGE for wines.

With regard to the word "American," it can, of course, mean qualities or characteristics that are associated with the United States, or geographic origin of goods or services in this country. See *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT AMERICAN BASH for services of promoting, producing and presenting professional wrestling matches is suggestive of a desirable quality of excellence). However, we find that, in the context of this mark, "American" suggests a tradition that is quintessentially American in nature. We further note that the examining attorney does not take the position that the mark as a whole is geographically descriptive or geographically deceptively misdescriptive under Sections 2(e)(2) or 2(e)(3) of the Trademark Act. As for the Section 2(e)(1) ground on which the examining attorney has refused

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registration, she has not established that AMERICAN is merely descriptive in connection with wine. Despite the fact that applicant listed "American" as a wine appellation in its TTB labeling application, this is insufficient to establish that it is, in fact, a wine appellation or that consumers would so view "American" in applicant's mark. The evidence in this regard is inconclusive.<sup>14</sup>

Considering the mark as a whole, we find that AMERICAN HERITAGE in connection with wines suggests an American cultural tradition of wines, which could be understood, in turn, as an homage to the American wine industry. Because the examining attorney did not establish that "heritage" merely describes a specific ingredient of wine, it is immaterial to our Section 2(e)(1) analysis what grape varieties are in applicant's wines. Moreover, to the extent we have any doubt as to the descriptiveness of the mark in connection with the identified goods, we resolve such doubt in applicant's favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981).

We conclude that the examining attorney has not established that AMERICAN HERITAGE is merely descriptive in connection with the identified goods.

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<sup>14</sup> Moreover, it is clear that the examining attorney has not refused registration under the geographical indication provisions of Section 2(a) of the Trademark Act.

**4. Section 2(a) Deceptiveness Refusal**

Because the examining attorney has not established that consumers would view AMERICAN HERITAGE as describing a significant ingredient of wines, no matter what grapes are contained in applicant's wine the examining attorney cannot prevail on the Section 2(a) alternative ground of refusal. Therefore, we conclude that the examining attorney has also not established that AMERICAN HERITAGE is deceptive in connection with the identified goods.

**5. Decision:**

The refusals to register on the grounds of Sections 2(e)(1) and 2(a) are reversed.