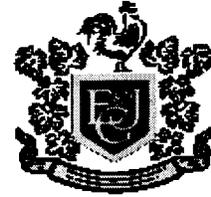


TTAB

E. & J. GALLO WINERY

Paul W. Reidl
Associate General Counsel



May 25, 2005

VIA EXPRESS MAIL

Commissioner for Trademarks
Box TTAB No Fee
P. O. Box 1451
Alexandria, VA 22313-1451

**Re: HALF MOON BAY, S/N 78208591 and
HALF MOON BAY (& Design), S/N 78208878**

Dear Sirs:

Enclosed is Applicant's Reply to Examining Attorney's Appeal Briefs.

Thank you in advance for your prompt attention to this matter.

Very truly yours,

Handwritten signature of Paul W. Reidl in cursive.

Paul W. Reidl



05-25-2005
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

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CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

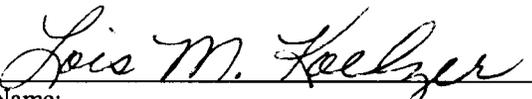
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Date of Deposit: May 25, 2005

I hereby certify that APPLICANT’S REPLY TO EXAMINING ATTORNEY’S APPEAL BRIEFS is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” under 37 CFR § 1.10 on the date of deposit indicated above and is addressed as follows:

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Name: _____

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Howard Smiga, Esq.
Trademark Law Office 102
Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

Executed on May 25, 2005, at Modesto, California.


Name:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Name of Applicant:	Joseph W. Cotchett
Application Serial Numbers:	78208591 and 78208878
Filing Date of Applications:	January 29, 2003 January 30, 2003
Marks:	HALF MOON BAY HALF MOON BAY WINERY (& Design)

**APPLICANT'S REPLY TO
EXAMINING ATTORNEY'S
APPEAL BRIEFS**

INTRODUCTION

In his Appeal Briefs¹, the Examining Attorney reiterates the substantive arguments made in the office actions. For the reasons discussed in Applicant's Appeal Brief, the Examining Attorney fails to meet his burden of establishing that Applicant's marks are primarily geographically descriptive. *In re Stephen Dossick, M.D.*, 2003 TTAB LEXIS 421, 13 (T.T.A.B. 2003). Numerous courts have held that just because a trademark has *some* geographic significance, it is not necessarily *primarily* geographically descriptive. The primary significance of the proposed marks in this case is not geographic, because when the typical American wine drinker considers the words "Half Moon Bay," she is most likely to picture herself enjoying Applicant's product on a moonlit night by the water, or to conjure up images of care-free relaxation and pleasure, or to imagine an anonymous bay having a semi-circular shape. Furthermore, the multitude of places known as "Half Moon Bay" throughout the world ensures

¹ The Examining Attorney responded to Applicant's Appeal Brief concerning the two marks with two separate Appeal Briefs. Because the arguments put forth in the Examining Attorney's two Appeal Briefs are basically the same, Applicant submits a single reply.

that consumers will not make a connection between Applicant's specific geographic location and the proposed mark. Accordingly, the Final Refusal to allow the mark HALF MOON BAY, Serial No. 78208591, to proceed to publication, and the cancellation of the Notice of Allowance with respect to Applicant's mark HALF MOON BAY WINERY (& Design), Serial No. 78208878, must be reversed.

The Examining Attorney also raises two evidentiary objections in his Appeal Briefs. Neither of these objections has any merit.

ARGUMENT

I. The Board Should Consider Third Party Registrations Cited in Applicant's Appeal Brief.

Applicant attached to its Appeal Brief two printouts of registrations from the USPTO's electronic records. "To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted." T.B.M.P. §1208.02. In his Appeal Briefs, the Examining Attorney contends that these registrations are untimely and should not be considered by the Board.

The Board should consider the registrations with regard to App. No. 78208878, because the Examining Attorney has waived any objection. Applicant first cited these registrations in his October 16, 2003 office action response to the Examining Attorney's first office action concerning this application. On January 12, 2004, the Examining Attorney issued another office action that did not object to the manner in which the registrations were cited. On January 18, 2005, the Examining Attorney issued another office action (after canceling the Notice of Allowance), which also did not mention the third party registrations. T.B.M.P. §1207.03

provides: “If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form.” *See also* T.B.M.P. §1208.02; *In re Boyd Gaming Corporation*, 57 U.S.P.Q.2D (BNA) 1944, 1945 n4 (2000) (“Applicant indicated in its response to the first Office action that some of these marks had been registered, indicating the registration numbers. Although applicant has not submitted copies of any third-party registrations, the Examining Attorney did not object to applicant’s reference to these registrations and in fact made no mention of these marks at all. Accordingly, we have considered them to be of record.”)

The Board should also consider the registrations with regard to App. No. 78208591. Applicant acknowledges that the Board “ordinarily” does not consider “additional” evidence filed after the appeal is filed. 37 C.F.R. §2.142(d). *See also* T.M.E.P. §710(c) (providing that “new” evidence introduced at the time of the appeal will “generally” be excluded from the record). These provisions make clear that the Board wields some discretion to consider evidence filed on appeal. The present case is an appropriate time for the Board to exercise this discretion, because Applicant cited these registrations in his October 16, 2003 office action response concerning App. No. 78208591, as well. For this reason, the printouts can hardly be considered “additional” or “new.” In an ex parte proceeding, the Board is expected to “tolerate[] some relaxation of the technical requirements for evidence and focus[] instead on the spirit and essence of the rules of evidence.” T.B.M.P. §1208. The registrations should be considered.

II. The Board Should Consider the Existence of Half Moon Bays Around the World.

Applicant cited in his Appeal Brief five web pages demonstrating the existence of numerous Half Moon Bays around the world. "Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings." T.B.M.P. §1208.03. In his Appeal Briefs, the Examining Attorney objects to Applicant's reference to these web pages because Applicant did not attach printouts therefrom. The exclusion of this evidence is essential to the success of the Examining Attorney's argument because it allows him to assert (incorrectly) that there is one and only one Half Moon Bay in the world, and that is the village in California located on the Pacific Ocean's Half Moon Bay.

The Board should not succumb to such sophistry. Applicant cited the five web pages identifying Half Moon Bays around the world in his October 16, 2003 office action responses.² The Examining Attorney did not object in his subsequent office actions concerning either application. In fact, the Examining Attorney of App. No. 78208878 accepted this evidence and, in reliance thereon, withdrew the objection and passed the application for publication. Thus, assuming *arguendo* that Applicant is required to attach printouts of entire web sites in order to bring web pages into evidence,³ the Examining Attorney has waived this objection. In *In re HID Corporation*, 2002 TTAB LEXIS 185, 1 (T.T.A.B. 2002), the Board explained:

The Examining Attorney has also objected to the list of applicant's prior registrations which applicant appended to its response filed September 26, 2000 as

²Applicant also cited a page from the Half Moon Bay Coastside Chamber of Commerce & Visitors Bureau website in its Appeal Brief in support of its contention that Half Moon Bay, California boasts numerous types of lodging. Applicant had not previously cited this webpage in any of its office actions responses, but the Examining Attorney attached a printout from this site (albeit a different page) to his January 18, 2005 office action.

³Neither the section of the Trademark Manual of Examining Procedure that the Examining Attorney cites, T.M.E.P. §710.01(b), nor the cases that he cites, supports this proposition.

being improperly submitted. The Examining Attorney did not, however, raise this objection in the action following the submission of the list, but rather waited until the filing of the brief. As such, we find the Examining Attorney to have waived the objection and accordingly, the prior registrations have been taken into consideration.

See also The Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 U.S.P.Q. (BNA) 579, 580, n.5 (T.T.A.B. 1979) (“[O]pposer has not objected to the [inadmissible] materials listed in applicant’s notice but to the contrary has specifically stated in its brief on the case that ‘applicant has submitted certain printed publications and records on its behalf.’ In view thereof, the materials in question are deemed to have been stipulated into the record for whatever probative value they may have.”)

Moreover, the Board can take judicial notice of the five Half Moon Bays outside of California because their existence is “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” T.M.B.P. §2.122(b). The Board can simply consult an atlas. *See Pinocchio’s Pizza, Inc. v. Sandra Incorporated*, 11 U.S.P.Q.2D (BNA) 1227, 7 n.6. (T.T.A.B. 1989) (“We take judicial notice of the fact that Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C.”); *In re Classic Beverage, Inc.*, 1988 TTAB LEXIS 16, n.2 (T.T.A.B. 1988) (“While we ordinarily would not consider any evidence submitted for the first time with the brief on appeal, these listings are from recognized reference works [dictionary, thesaurus] of the type of which we can take judicial notice.”).

CONCLUSION

For the reasons noted above, Applicant respectfully submits that the Board should overrule the Examining Attorney’s evidentiary objections, agree with the Examining Attorney

who initially passed App. No. 78208878 for publication, and find that the marks are not primarily geographically descriptive.

Respectfully submitted,

Paul W. Reidl

Paul W. Reidl
Attorney for Applicant