

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Oral Hearing: January 9, 2008 Mailed: March 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Phillips Farms, LLC

Serial No. 78669171

Robert Beiser of Vedder, Price, Kaufman & Kammholz, PC for
Phillips Farms, LLC.

Christina M. Sobral, Trademark Examining Attorney, Law
Office 109 (Dan Vavonese, Managing Attorney).¹

Before Hairston, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Phillips Farms, LLC has applied to register the mark
PETIT-PETITE in standard character form on the Principal
Register for "wine" in International Class 33.²

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground

¹ The above application originally was examined by another
examining attorney, but subsequently was reassigned to the
attorney whose name is shown to prepare the appeal brief.

² Application Serial No. 78669171 was filed on July 13, 2005,
based on applicant's assertion of a bona fide intent to use the
mark in commerce on the goods.

that applicant's mark is merely descriptive of a feature or quality of applicant's goods.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed main briefs on the issue under appeal and applicant has filed a reply brief. In addition, counsel for applicant and the examining attorney presented arguments at an oral hearing held on January 9, 2008.

Applicant contends that its mark is at most suggestive and does not immediately convey to consumers the nature of its goods. Applicant has relied upon printed copies from the Office's TARR database as well as a private database of a number of third-party registrations and applications for marks containing the word "PETIT" or "PETITE" for goods including wine. According to applicant, the noted third-party registrations demonstrate that the terms comprising its mark are not merely descriptive of its goods.

The examining attorney maintains that the mark merely describes a feature or quality of the goods. In support of the refusal, the examining attorney made of record a translation of the word "petit." According to that translation, "petit" is the French word for "petite." In addition, the examining attorney has made of record articles and advertisements retrieved from Internet web

pages. Excerpts from these web pages follow (emphasis added):

January 12, 2006, "**Petite** Sirah is one misunderstood wine."
KETV.com
Lisa Morrison
First of all, there actually is nothing "**petite**" about it...
(www.psiloveyou.org)

Petit Verdot
The **Petit** Verdot grape variety is one of the six approved grapes for making red wines in the Bordeaux region of France...**Petit** Verdot will often be blended as 1% to 3% of the total wine in order to take advantage of some of its most dominant characteristics...
(www.cellarnotes.net)

Petite Syrah Wine
Petite Syrah originates from the Rhone Valley in France.
Petite Syrah is closely related to the Syrah grape. The taste and flavors of **Petite** Syrah and Syrah wines are very similar.
Petite Syrah is not **petite**. It is a robust wine with a dark inky color.
Petite Syrah pairs barbequed steak, ribs, cheese, and other robust foods.
(www.winecountrygetaways.com)

Uncorked: **Petite** Sirah is small in name only.
Petite sirah is not syrah or shiraz, although it is a direct descendant straight from the Rhone. Nor is it **petite**. **Petite** sirah is big, really big, from the juiciest of grapes, like a water balloon filled to bursting with grape and cherry jam...
The Foppianos have bottled **petite** as a varietal for 30 years, and now have it in a third of their

Healdsburg vineyards, which produce 10,000 to 20,000 cases a year....

In the last five years wineries making **petite** under its own name have jumped from 60 to more than 240 wineries....

Many wineries also make **petite** a key element, the dark sweet heart, of the best modern contemporary proprietary blends....

(www.sptimes.com)

Currently Available Wines:

Cerasolo Loosely interpreted in our Italian dialect translates to "Color of the sun." Juice of the Cargnane and **Petite** grapes is quickly separated during fermentation creating a dry blush that has reminiscent flavors of the bolder reds.

(fraswin.securesites.com)

GRIN

(Germplasm Resources Information Network)

PI 549931

Phaseolus vulgaris L. FABACEAE

Cultivar name: **PETITE**

Developed in California, United States

Evidentiary Matters

Before turning to the substantive ground for refusal, we note that applicant has submitted exhibits with both its main brief and reply brief. These exhibits consist of a printed copy from the United States Patent and Trademark Office's Trademark Applications and Registrations Retrieval (TARR) database of a recently registered "PETITE" formative mark along with a portion of the file history thereof (main brief); and print-outs from a number of Internet websites

containing information primarily concerning "petite sirah" wines (reply brief). However, the materials comprising these exhibits have not previously been made of record. Accordingly, these exhibits are manifestly untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). See also TBMP §§ 1203.02(e) and 1207.01 (2d ed. rev. 2004) and the authorities cited therein. We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

Ripeness of Issue Under Appeal

In its reply brief, applicant raises for the first time an argument that the refusal to register under Section 2(e)(1) that is the subject of this appeal is not ripe because the instant application was filed based upon Section 1(b) of the Trademark Act; and that, because no specimen of use is yet of record, the examining attorney incorrectly "conducted a preliminary review and found that the mark PETIT-PETITE is descriptive for wine, all wines, in all market conditions, absent the realities of the mark used in commerce" (reply brief, p. 10).

However, applicant cites to no authority for its apparent contention that the examining attorney may not

issue a refusal to register based upon mere descriptiveness in an application asserting Section 1(b) "intent to use" as a filing base prior to applicant's filing of an allegation of use. Applicant's reliance upon *Eastman Kodak Co. v. Bell & Howell Document Management Products Co.*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993) in support of its position is misplaced. In *Eastman Kodak*, the Federal Circuit upheld a decision by the Board on summary judgment dismissing consolidated oppositions without prejudice to the initiation of a later cancellation proceeding on the ground that the underlying question of whether the marks at issue are merely descriptive or registrable without a showing of secondary meaning could not, under the circumstances, be determined prior to use of the mark and the filing of a statement of use. *Id.* at 1914. However, *Eastman Kodak* involved an inter partes proceeding and allowed the third-party plaintiff future recourse in the form of a cancellation proceeding. That case does not stand for the proposition that an examining attorney is precluded from raising the issue of mere descriptiveness ex parte in an "intent to use" application until after the filing of an allegation of use.

Accordingly, applicant's contention that the instant refusal to register is not ripe for appeal is without basis

in law.

Refusal to Register Under Section 2(e)(1)

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. See Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052. See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In the instant case, the evidence made of record by

the examining attorney is insufficient to support a finding that, as applied to applicant's goods, the mark PETIT-PETITE would immediately describe, without conjecture or speculation, either "wine" or a significant characteristic or feature thereof. We agree with the examining attorney that excerpts from articles taken from the Internet may be competent evidence in an ex parte proceeding of how a mark may be perceived by the public. See *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058 (TTAB 2002). In this case, however, most of the instances in which "petite" appears are in the context of direct references to "Petite Sirah" (or "Petite Syrah") grapes and wine or "Petit Verdot" grapes. As such, these articles do not demonstrate that the term "petite," by itself or in the context of the mark PETIT-PETITE, is merely descriptive of wine. The single Internet article from fraswin.securesites.com that makes reference to "Petite" grapes outside the context of Sirah or Verdot grapes is insufficient to make a prima facie case that consumers in the United States would view PETIT-PETITE as merely descriptive of a feature or characteristic of applicant's wine. Similarly, the references in the U.S. Department of Agriculture's (USDA) GRIN database to "petite" grapes does not convince us otherwise. First, it is not clear that ordinary consumers would be aware of, let

alone consult, the GRIN database or be familiar with the varietal names listed therein. Second, even if such familiarity may be presumed, the evidence of record still falls short of demonstrating that PETIT-PETITE merely describes applicant's goods, namely, wine, or a feature or characteristic thereof.

The third-party registrations submitted by the applicant did not influence our decision herein. Such third-party registrations tend to support a finding that the term "petit" or "petite" translates into "little" and may be registered on the Principal Register with, or without, a disclaimer thereof as applied to wines and other beverages.³ Thus, such third-party registrations were of little probative value in determining the registrability of the mark at issue in this case. Further, and as often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if prior registrations had some characteristics similar to

³ We note that the third-party applications submitted by applicant are only evidence that an applicant has filed for registration of a mark and, as such, are of extremely limited probative value. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

[applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.") *See also In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001).

In short, the evidence submitted by the examining attorney falls short of demonstrating that PETIT-PETITE merely describes a feature or characteristic of applicant's "wine."

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. *See In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Decision: The examining attorney's refusal of registration is reversed. Accordingly, the involved application will be forwarded for publication for opposition in due course.