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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/978475

MARK: YOSEMITE BREWING COM



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Spirits of New Merced, LLC

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant: Spirits of New Merced, LLC : BEFORE THE
Trademark: YOSEMITE BREWING : TRADEMARK TRIAL
COMPANY
Serial Nos: 78756457 and 78978475 : AND
Attorney: Kenneth A. Vogel : APPEAL BOARD
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STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark YOSEMITE BREWING COMPANY on the ground that the proposed mark is primarily geographically descriptive of applicant's goods and services under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052 (e)(2).

FACTS

Applicant filed this application on November 17, 2005, applying to register on the Principal Register, the mark YOSEMITE BREWING COMPANY for "beer not produced from materials originating in Yosemite National Park" and "brewing services, namely, custom manufacturing of alcoholic malt beverages and beer not manufactured in Yosemite National Park." ¹

On May 8, 2006, applicant filed an Amendment to Allege Use.

¹ This wording reflects the identification of goods and services as amended.

In the first Office action dated May 26, 2006, registration was refused under Section 2(e)(2) on the ground that the mark is primarily geographically descriptive of applicant's goods and services. Requirements for an acceptable specimen and amendments to the identification of goods and services were also issued. Applicant was advised that an amendment to the Supplemental Register would be an acceptable response to the Section 2(e)(2) refusal.

On June 20, 2006, applicant submitted a substitute specimen and amended the identification of goods. On June 23, 2006, applicant traversed the Section 2(e)(2) refusal.

On August 14, 2006, clarification regarding the dates of use were required, and the refusal to register under Section 2(e)(2), requirement for an acceptable specimen, and requirement for an amended identification were maintained and continued.

On February 13, 2007, applicant amended the identification of goods and services.

On March 7, 2007, the refusal to register under Section 2(e)(2), the requirement for an acceptable specimen, and the clarification regarding the dates of use was made final.

On April 9, 2007, applicant filed a divisional request. On May 15, 2007, the divisional request was completed resulting in the child application 78978475. On May 30, 2007, applicant filed an amendment to allege use, which was accepted on June 5, 2007 and satisfied the dates of use and specimen requirements.

On August 29, 2007, applicant again traversed the refusal based on Section 2(e)(2) with regard to both applications.

On September 5, 2007, the request for reconsideration was denied and this appeal ensued.² As the appeals involved common issues of fact and law, the examining attorney moved to consolidate the proceedings, and the motion was granted.

ISSUE

The issue on appeal is whether the mark is primarily geographically descriptive of applicant's goods and services under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052 (e)(2).

ARGUMENT

A mark is primarily geographically descriptive when the following is demonstrated:

² In an effort to have the marks registered on the Principal Register, applicant has proposed amending the identifications to "beer not produced from materials originating in Yosemite National Park" and "brewing services, namely, custom manufacturing of alcoholic malt beverages and beer not manufactured in Yosemite National Park" for the first time in its appeal brief. (Applicant's brief at 19.) The proposed amendments are acceptable to the examining attorney. However, as these proposed amendments appear to be merely the first of two alternate positions by applicant (*see* TBMP Section 1215), such amendments will only be entered in the event the Board reverses the refusal to register.

The examining attorney hastens to add that, though the proposed amendments have been treated as being entered for the purpose of this brief, such amendments in no way affect the registrability of the marks in question.

In the event the refusal is affirmed, the examining attorney presumes that applicant's second alternate position of amending the applications to seek registration on the Supplemental Register (Applicant's brief at 20) will be implemented, and the first alternate position of amending the identifications will not be considered.

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods and services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place and services-place association; that is, purchasers would be likely to believe that the goods and services originate in the geographic place identified in the mark.

TMEP §1210.01(a); *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1309 (TTAB 2006).

**APPLICANT'S MARK IS PRIMARILY GEOGRAPHICALLY
DESCRIPTIVE OF THE GOODS AND SERVICES**

**(A) THE PRIMARY SIGNIFICANCE OF THE MARK IS
GEOGRAPHIC**

A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning. Yosemite is the name that refers to the well-known geographic region encompassing Yosemite National Park. Commonly used nicknames for geographic locations are generally treated as equivalent to the proper geographic name of the place identified. TMEP §1210.02(a); *see, e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998).

Yosemite National Park, located near the eastern border of central California, is the size of Rhode Island, covering nearly 1,200 square miles, and is visited by over 3 million tourists a year. (www.americanparknetwork.org attached to the Office action dated March 7, 2007 and incorporated herein.) On each of the three websites of record featuring park, the term “Yosemite” appears in large letters at the top of the webpage, separated from other written material. (www.americanparknetwork.org, www.nps.gov/yose, and www.yosemitepark.com attached to Office action dated March 7, 2007 and incorporated herein.) Vacation rental and other accommodations are merely referred to as “Yosemite Lodging.” (See evidence attached to the Office action dated September 5, 2007 and incorporated herein.)

Furthermore, these websites include the following references to the geographic location, Yosemite:

“Five distinct areas” attract well over 3 million visitors each year to Yosemite”
(www.americanparknetwork.org)

“Have questions about visiting? Traveling to Yosemite;” “Yosemite receives most of its precipitation in the months of January, February, and March;” and
“Did you know? That 95% of Yosemite is designated Wilderness?”
(www.nps.gov/yose)

“Though songs, poems, and photographs have sought to convey the essence of California vacations in Yosemite, only your senses will tell the true story.”

(www.yosemitepark.com)

These references are highly similar to those cited by the Board in its determination “that the term ‘Yosemite’ is a well recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in general.” *In re Spirits of New Merced, LLC*, No. 78710805, ____ USPQ2d ____, slip op. at 6 (TTAB Dec. 12, 2007).

Furthermore, treatment of the term “Yosemite” as primarily geographically descriptive is consistent with Office practice as shown by third party registrations showing the term “Yosemite” disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. (Registration Nos. 1882576, 2497462, 2370876, 2652898, 2853802, 2741174, 2715307, 2715313, and 2797240, attached to the Office action dated September 5, 2007 and incorporated herein.) Of these registrations, there are five whose owners’ addresses are in “Yosemite, California.”

The addition of the wording “brewing company” to the primarily geographically descriptive term “Yosemite,” does not obviate the primarily geographically descriptive nature of the mark. The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term’s primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., In re JT Tobacconists*, 59 USPQ2d 1080

(TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991). The wording "brewing company" merely describes the nature of applicant's entity as a company that brews beer.

While applicant argues that the term "Yosemite" means "those who kill" or "the killers" in the Native American Miwok tribal language (Applicant's brief at 14), there is "no evidence that the general public would be familiar with the derivation of 'Yosemite' or that this meaning would be anything but obscure to them." *In re Spirits of New Merced, LLC*, No. 78710805, ____ USPQ2d ____, op. slip at 10 (TTAB Dec. 12, 2007). If the most prominent meaning or significance of a mark is geographic for the goods and services in the application, as is the case here, the fact that the mark may have other meanings in other contexts does not alter its geographic significance in the context of the application. *See e.g., In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1697 (TTAB 1992); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986); TMEP §1210.02(b)(i).

For the foregoing reasons, the primary significance of applicant's mark is geographic.

(B) THE GOODS AND SERVICES FOR WHICH APPLICANT SEEKS REGISTRATION ORIGINATE IN THE GEOGRAPHIC PLACE IDENTIFIED IN THE MARK

A product that is produced or a service that is provided near the geographic place named in the applied-for mark is sufficient to support a finding that the goods and services originate in that geographic location. *See, e.g., In re Spirits of New Merced, LLC*, No. 78710805, ____ USPQ2d ____, slip op. at 18 (TTAB Dec. 12, 2007) (holding

YOSEMITE BEER primarily geographically descriptive of beer produced and sold in Merced, California, a city located 80 miles from Yosemite National Park, where the goods originated in an area “located near YOSEMITE”); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1310-11 (TTAB 2006); *see also Warwood v. Hubbard*, 228 USPQ 702, 702-03 (Mont. 1985).

The Trademark Trial and Appeal Board has stated that the purpose of Trademark Act Section 2(e)(2) is “to leave geographic names free for all businesses operating in the same area to inform customers where their goods or services originate.” *In re Spirits of New Merced*, No. 78710805, ____ USPQ2d ____, slip op. at 19 (citing *In re MCO Props. Inc.*, 38 USPQ2d 1154, 1156 (TTAB 1995)).

Applicant is located in Merced, California. Applicant indicates that its beer is “brewed on-site at the Applicant’s brewpub, and is consumed exclusively at the brewpub.” (Applicant’s brief at 10.) A definition of Merced indicates that it is a “center for tourism” and “Yosemite National Park is nearby.” (The Columbia Encyclopedia, Sixth ed., 2001-05 attached to the Office action dated March 7, 2007 and incorporated herein.) Merced is located approximately 80 miles from Yosemite and is the starting point for tours of Yosemite, as well as the location of accommodations for tourists visiting Yosemite. (See map from maps.yahoo.com and internet evidence from via-adventures.com/Yosemite attached to the Office action dated March 7, 2007 and incorporated herein.) Furthermore, tourist information websites indicate that Merced is the “Gateway to Yosemite.”

(www.yosemite-gateway.org and www.visitwc.com/destinations/merced attached to the Office action dated March 7, 2007 and incorporated herein.)

While applicant has proposed limiting the identifications to further reflect that the goods are not composed of ingredients originating in Yosemite National Park, and that the claimed services are not performed within the boundaries of Yosemite National Park, such limitations do not affect the registrability of the marks at hand. The examining attorney has demonstrated that the term YOSEMITE identifies a geographic region exceeding the actual boundaries of the national park, and that the applicant's goods and services originate from a place within the identified region.

Because applicant's goods and services originate in Merced, which is tied to Yosemite both economically and by its proximity, the goods and services originate in the place named in the mark, Yosemite.

**(C) PURCHASERS WOULD BE LIKELY TO BELIEVE THAT
THE GOODS AND SERVICES ORIGINATE IN THE
GEOGRAPHIC PLACE IDENTIFIED IN THE MARK**

When there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the goods and services with the place is presumed if an applicant's goods and services originate in the place named in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in

California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (holding DENVER WESTERNS primarily geographically descriptive of western-style shirts originating in Denver).

Applicant argues that because the “park does not conduct or permit any commercial manufacturing” and “national parks do not produce beer, nor are national parks known for beer,” consumers are not likely to believe that applicant’s goods and services originate in Yosemite. (Applicant’s brief at 10) Applicant has, however, provided no evidence in support of these assertions. In order to establish a goods-place or services-place association, the evidence of record need only show a “reasonable basis” for concluding that the public is likely to believe that the mark identifies the place from which the goods and services originate. *See In re JT Tobacconists*, 59 USPQ2d 1080, 1083-84 (TTAB 2001); *In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1661-62 (TTAB 1986); *see also* TMEP §1210.04; *cf. In re Loew’s Theatres, Inc.*, 769 F.2d 764, 767-68, 226 USPQ 865, 867-68 (Fed. Cir. 1985).

Because applicant’s goods and services originate in the place named in the mark, the public association of the goods and services with the place is presumed. Because the goods and services are provided exclusively in the place named in the mark (Applicant’s brief at 10), consumers have a reasonable basis to believe that the goods and services originate in the place in the mark.

**(D) THIRD PARTY REGISTRATIONS SUBMITTED BY
APPLICANT ARE NOT RELEVANT TO THE CURRENT
APPLICATION**

Applicant has argued that its proposed mark bears similarity to a number of other previously registered marks that involve the names of geographic locations, especially national parks or sites within national parks, and were allowed to register on the Principal Register without a disclaimer on the geographic portion or a statement of Section 2(f) acquired distinctiveness. (Applicant's brief at 15.)

Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

Each case involving a potential Section 2(e)(2) geographic refusal requires the examining attorney in that case to compare the facts at hand with the appropriate test for geographic descriptiveness. The fact that other marks including geographic locations in their names have passed this test based on the evidence presented in those cases has no bearing on the current application.

CONCLUSION

Applicant's mark is primarily geographically descriptive because the primary significance of the mark is a generally known geographic place or location, the goods and services for which applicant seeks registration originate in the geographic place identified in the mark, and purchasers would be likely to believe that the goods and services originate in the geographic place identified in the mark. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(e)(2) be affirmed.

Respectfully submitted,

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