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PRECEDENT OF THE TTAB

Hearing: January 10, 2013

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pan American Grain Mfg. Co., Inc.

Serial No. 85035510

Samuel F. Pamias of Hoglund & Pamias PSC for Pan American Grain Mfg. Co., Inc.

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Before Zervas, Kuhlke, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Pan American Grain Mfg. Co., Inc. has applied to register on the Principal Register the mark set forth below for goods identified as “Enriched rice; Rice; Rice flour,” in International Class 30.¹



¹ Application Serial No. 85035510 filed on May 11, 2010 with claims of first use and first use in commerce of September 29, 1967.

No claim is made to the exclusive right to use ARROZ apart from the mark as shown. All agree that “arroz” is the Spanish word for “rice.”

The trademark examining attorney refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that applicant’s mark comprises deceptive matter. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed appeal briefs, and applicant has filed a reply brief. An oral hearing was held on January 10, 2013. We affirm the refusal of registration.

Evidentiary objection.

Applicant submitted its brief with evidence attached, and subsequently filed an “Informative Motion”² containing additional evidence. The examining attorney objected to this evidence on the ground that it is untimely. There is disagreement between the applicant and the examining attorney as to whether all of the evidence so submitted had previously been submitted as part of applicant’s responses to Office actions.

The objection is sustained. We have considered all evidence that applicant submitted prior to the filing of applicant’s notice of appeal but we have not considered evidence filed thereafter. “The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.” 37 C.F.R. § 2.142(d). *See*

² Filed May 2, 2012.

also TBMP § 1207.01 (3rd ed., June, 2012). We have not sought to determine to what extent evidence filed with applicant's brief or its Informative Motion may have been merely duplicative of evidence previously filed. The applicant has the responsibility to make sure that the record is complete prior to filing a notice of appeal. *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n. 32, 1769 (TTAB 2011).

The Merits.

The examining attorney contends that the term VALENCIA, appearing in applicant's mark, is deceptive matter within the meaning of Section 2(a) of the Trademark Act because the term "Valencia" is understood to designate a type of rice and applicant's rice is not Valencia rice. A mark is deceptive if:

- (1) it contains matter that is misdescriptive of the character, quality, function, composition or use of the goods;
- (2) prospective purchasers would be likely to believe that the misdescription actually describes the goods;
- (3) the misdescription would be likely to affect a significant portion of the relevant consumers' decision to purchase the goods.

In re Budge Mfg. Co., 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009).

In order to demonstrate the perception of the term VALENCIA among consumers of rice, the examining attorney has made the following evidence of record:

1. Product listing from <cubanfoodmarket.com> showing a package marked "GOYA California Pearl Rice Arroz Tipo Valenciano." The image is captioned "Goya Valencia style rice 14 oz." Text below (in English and Spanish) reads

“Valencia type rice. The perfect rice for Arroz con Pollo or for that delicious paella. Excelent *[sic]* quality.”

2. Product listing from <mahatmarice.com> showing a package marked “Mahatma VALENCIA SHORT GRAIN ENRICHED RICE.” The product description states, “Valencia (Short Grain). 14 oz (397g) Valencia rice takes its name from Valencia, a province of Spain. ... Valencia rice is also known as short grain rice, pearl rice, or occasionally as round rice. ... Mahatma Valencia rice is grown in the U.S.A.
3. Product listing from <amazon.com> showing a package marked “DENOMINACION DE ORIGEN ARROZ DE VALENCIA SANTO TOMAS.” Product description states, “2.2 pound bag of this delicious Spanish Valencia Rice! ... Some of the best arroz in Spain! –This premium quality rice produces enhanced flavor and texture! - Ability to absorbs *[sic]* a large volume in liquid...and flavor.” (Ellipsis in original.)
4. Product listing from <deliciasdeespana.com>, showing a package marked “ARROZ Dacsa el Arroz de Valencia.” The product description states, “Valencia Rice ‘Dacsa’ ... Rice with Denomination of Origen *[sic]* “Arròs de Valencia.” Rice that grows in Comunidad Valenciana has peculiar characteristics that are portrayed in its quality. In order to get the Denomination of Origen *[sic]*, the cultivation of rice has to be environmentally friendly, but also follow traditional handling, watering and harvesting of the crops. Valencia Rice is the best choice for paella, no doubt about it!”
5. Cached website from <arrozjmontoro.com> displaying a seal stating, “ARROS DE VALENCIA DENOMINACIO D’ORIGEN CONSELL REGULADOR.” The web site states that the offered rice bears the designation “Arròs de Valencia” and states that “The ‘Arròs de Valencia’ comes from the Parque Natural de la Albufera nature park and from many other wetlands of the Valencia region.”
6. Article from <ehow.com> entitled “Type of Rice to Use in Paella,” stating, “Paella cooks recommend that people who want to cook paella dishes use a medium grain rice.” ... Spanish rice is also known as paella rice. The preferred traditional Spanish rice for paella dishes is Valencia rice. Valencia rice is a medium grain rice that absorbs flavors.”
7. Article from <cookinglight.com> entitled “Spanish Flavor,” stating, “Rice: Spanish rice, sometimes called Valencia rice, is a short grain variety with a firm texture that readily absorbs flavors from other ingredients, making it

ideal for paellas. We used white Calasparra rice, although any brand of Italian Arborio will work.”

8. Entry from <recipetips.com> for “Valencia Rice,” stating, “A short to medium-grain rice variety that is cultivated in many areas of Spain, but takes its name from the province and city of Valencia, which is the largest rice growing region in Spain. It is slightly sticky when cooked and yet the grains separate easily, which makes it perfect for the popular Spanish paella dishes that originated in Valencia. It is available in specialty shops and through mail order.
9. Article from <spanishfood.about.com> entitled “Spanish Regional Cuisine of Valencia,” stating, “Although Valencia is known for the high quality rice it grows and rice dishes, such as the now world-famous paella, the traditional gastronomy of the region has much more to offer. ... Valencia is well-known for two of its crops – oranges and rice. In fact, the Valencians are so proud of the high quality rice they grow that there is a Denomination of Origin for rice! The rice-producing zone is around the “Parque Natural de la Albufera” in the province of Alicante, but other areas include Beniparrell, La Alcudia, Oliva, Prego and Sagunto in Alicante.
10. Excerpt of entry for “Rice” from <foodsubs.com>, including the following sub-entry: “**Spanish rice = paella rice** *Notes:* This is a medium-grain rice that’s perfectly suited to making paella. Varieties include **Granza rice**, and the highly regarded (but difficult to find) Valencia rice. *Substitutes:* risotto rice (This is very similar and is a good choice for making paella.) OR short-grain rice.”
11. Entry for “Valencia” from <columbiagazetteer.org>, stating, “Valencia is called the ‘garden of Spain’ for its intensive cultivation under irrigation that was started by the Moors. Citrus and other fruits, rice, vegetables, cereals, olive oil and wine are now produced.”³

The evidence shows that the term VALENCIA is perceived by U.S. consumers of rice as indicating a type of rice that has particular qualities that make it suitable for certain kinds of cooking. Some sources cited by the examining attorney indicate

³ Items numbered 2 and 8 were made of record with the examining attorney’s Office action of June 29, 2010. Items numbered 4, 5, 9, 10, and 11 were made of record with the Office action of January 30, 2011. Items numbered 1, 3, 6, and 7 were made of record with the examining attorney’s final Office action of August 29, 2011.

that VALENCIA describes rice that was grown in Valencia, Spain, and that the term may indicate that the rice bears an official “denomination of origin” (*e.g.*, item No. 9). Other sources indicate that VALENCIA is perceived as describing a category of “Spanish rice” or “paella rice” that is similar in type to rice traditionally cultivated in Valencia, Spain (*e.g.*, items Nos. 6 and 7). The record shows that some rice is marketed as rice grown in Valencia, Spain under the denomination of origin “Arròs de Valencia” (*i.e.*, the brands DACSA, SANTO TOMAS, and MONTORO). However, other brands (GOYA and MAHATMA) are clearly grown domestically but are marketed as Valencia rice or rice of the Valencia “style” or “type.” We need not decide whether authentic Valencia rice is grown only in Valencia, Spain; we express no opinion on that point. However, the evidence indicates that in the U.S. marketplace, VALENCIA, as applied to rice, is perceived as an indicator of the *type* of the goods. That applicant’s goods are not of the type designated by the term VALENCIA was established during prosecution of the application, when applicant asserted that “the rice packed, sold and distributed by Pan American is not rice of the Valencia type....”⁴

In an analysis under Section 2(a), we must consider what information customers believe they derive from the term VALENCIA, and whether that information would materially affect their decision to purchase the goods. The evidence indicates that Valencia rice is considered to be especially suitable for certain Spanish dishes. GOYA rice is touted as “The perfect rice for Arroz con Pollo

⁴ Applicant’s response filed December 29, 2010.

or for that delicious paella.” SANTO TOMAS rice is described as having “Ability to absorb a large volume in liquid... and flavor.” DACSA brand is promoted with the statement, “Valencia Rice is the best choice for paella, no doubt about it!” Internet discussions of Spanish cooking state:

The preferred traditional Spanish rice for paella dishes is Valencia rice. (Item 6.)

Spanish rice, sometimes called Valencia rice, is a short grain variety with a firm texture that readily absorbs flavors from other ingredients, making it ideal for paella. (Item 7.)

It is slightly sticky when cooked and yet the grains separate easily, which makes it perfect for the popular Spanish paella dishes.... (Item 8.)

Spanish rice “is a medium-grain rice that’s perfectly suited to making paella. Varieties include... Valencia rice.” (Item 10.)

This evidence indicates that customers perceive Valencia rice as having certain characteristics that affect its suitability for use in certain dishes (in particular, paella). Moreover, the quality of Valencia rice is described in highly laudatory terms (“preferred,” “ideal,” “perfect,” “perfectly suited,” “highly regarded”). This indicates that customers are likely to find rice marked VALENCIA more appealing or desirable than other rice products, and that the designation would be a material factor in a customer’s decision to purchase the rice and rice products on which the designation appears. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992).

Applicant urges us to view its trademark in its entirety, including the design element and the grammatical relationship among the component words ARROZ

VALENCIA G. We agree that if the mark as a whole has characteristics that counteract the misdescriptive nature of the term VALENCIA, then the mark would not be deceptive. *See, for example, A.F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459 (TTAB 1962) (the term CALF in the mark COPY CALF not deceptive for goods of artificial leather). Nonetheless, it is also well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark. *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTB 1984). We see nothing in the design element of applicant's mark or in the letter G, which is segregated from the other wording, that would affect the interpretation of the term VALENCIA in the context of applicant's entire mark. As to the grammatical presentation of the wording ARROZ VALENCIA, applicant urges that the only proper way to designate "Valencia rice" of the type that originates in Valencia, Spain would be to use the words "ARROZ DE VALENCIA." We disagree. Markings that appear on commercial products frequently lack any grammatical context. The words ARROZ and VALENCIA appearing on a package of rice would likely project the same meaning regardless of whether they were presented in a complete sentence (e.g., "This is Valencia rice"), or as the two-word phrase "arroz Valencia," or as two isolated words presented far apart from each other. There is nothing in applicant's mark, viewed in its entirety, to contradict the impression that the word VALENCIA designates the type of the rice on which the mark appears.

Applicant argues further that its mark has been used over many years in an arbitrary manner as a source indicator, and that it has acquired public recognition or “secondary meaning” as such. In our analysis under Section 2(a), we must consider the perceptions of prospective customers. If, as perceived by relevant customers, a term has descriptive meaning with respect to the goods, then it is not “arbitrary” as to those goods, despite the intentions of applicant. As to public recognition of the mark, applicant has not presented evidence of the ways in which members of the public perceive and interpret the mark.⁵ Consequently, there is nothing in the record to contradict the examining attorney’s evidence showing that “Valencia” designates a type of rice.

Applicant also argues that VALENCIA has recognized meanings other than as a type of rice: applicant argues that VALENCIA may be a surname, a female given name, the name of a region in Venezuela, or the Spanish equivalent of the English word “valence.” There is no aspect of applicant’s mark that would lead a customer to interpret VALENCIA in any of these alternative ways. Nor is there any evidence in the record to show that applicant’s goods and mark have been promoted in such a way as to promote such interpretations, or to show that customers do in fact interpret the mark in these ways. We must consider that applicant’s mark will appear on or in close proximity to a package of rice or rice flour. In that context, the evidence of record indicates that VALENCIA will be

⁵ We further note that proposed marks prohibited under Section 2(a) are not afforded the option of registration under Section 2(f) on the basis of acquired distinctiveness.

interpreted as an indicator of the type of rice on which it appears, or the type of rice from which the flour on which it appears was made.

In a related vein, applicant argues that rice “is not the only product for which [Valencia, Spain] is known. In fact, the Valencia region in Spain is known for its oranges. Therefore, consumers are not going to make an automatic relation with the name of Valencia and a particular good, namely rice.”⁶ That Valencia is known for oranges is shown in the record.⁷ What is lacking in the record is any evidence supporting applicant’s contentions as to how customers would interpret the term VALENCIA. As a result, the examining attorney’s evidence indicating that relevant customers know Valencia rice as a particularly desirable type of rice remains unrebutted.

Finally, applicant has submitted a copy of its Puerto Rico registration of the trademark VALENCIA, Reg. No. 14,556. Applicant argues that Puerto Rico trademark law is derived primarily from the Lanham Act and notes that under this standard of examination the Puerto Rico Department of State found the mark VALENCIA to be inherently distinctive.⁸ Applicant further urges that under the laws of Puerto Rico “a valid certificate of registration shall stand as prima facie evidence of the trademarks validity.”⁹ It is well established that the Board gives no probative weight to state or foreign registrations because the Board’s determination

⁶ Applicant’s brief at 16.

⁷ See entry for Valencia from The Columbia Gazetteer of the World, submitted with the examining attorney’s Office action of January 30, 2011.

⁸ Applicant’s brief at 18.

⁹ *Id.*

regarding the registrability of a mark under the Trademark Act is predicated on the facts before us in this application, not on the basis of a decision by the Puerto Rico Department of State on an unknown set of criteria. *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240, 243-244 (TTAB 1963) (“COUPON” held merely descriptive of cigarettes containing premium redemption coupons despite state registration). *See also In re Anania Associates*, 223 USPQ 740, 742 (TTAB 1984) (rejecting argument that a state registration should be taken as *prima facie* evidence of distinctiveness); *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 n.2 (TTAB 1984). The procedural and administrative facts underlying such registrations are unknown to the Board and accordingly there is no reasonable ground upon which to interpret them.

The term VALENCIA, interpreted as we discuss above, is misdescriptive of the applicant’s goods. When the term VALENCIA is set forth on packaged rice, prospective purchasers would be likely to believe that this misdescriptive term describes the contained goods, because the evidence shows that customers perceive the term as designating a type of rice. As VALENCIA is perceived as designating a product of premium quality that is particularly suited to certain uses, the appearance of this misdescriptive term on the product would be likely to materially affect such customers’ decision to purchase the goods. Accordingly, on the record before us, we find that the term VALENCIA appearing in applicant’s mark is deceptive matter within the meaning of Trademark Act § 2(a), 15 U.S.C. § 1052(a).

Decision: The refusal to register is affirmed.