

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: September 4, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stacked Wines, LLC

Serial No. 85129206

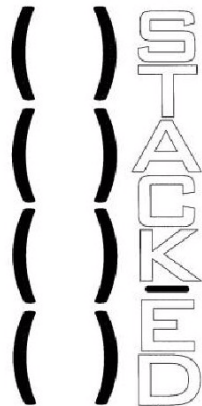
Kathleen G. Mellon of Young Basile Hanlon & MacFarlane PC for Stacked Wines, LLC.

Scott Bibb, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Cataldo, Lykos and Adlin, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On September 14, 2010, Stacked Wines, LLC (“applicant”) filed an intent-to-use application to register the mark displayed below,



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Serial No. 85129206

for “wines and sparkling wines” in International Class 33.¹ Following issuance of a notice of allowance, on December 22, 2011, applicant submitted a specimen of use consisting of a scanned photograph of the goods bearing the mark reprinted below:



Registration has been finally refused in light of the applicant's failure to comply with the examining attorney's requirement for a disclaimer of the word **STACKED** pursuant to Trademark Act § 6(a), 15 U.S.C. § 1056(a), on the ground that the term is merely descriptive of a feature of the identified goods.

¹ The description of the mark is as follows: “The mark consists of the word ‘STACKED’ with an elongated oval between the ‘K’ and the ‘E’ displayed vertically on the right side, and two parallel symmetrically curved broken lines displayed vertically on the left side.” Color is not claimed as a feature of the mark.

Upon final refusal of registration, applicant filed a timely appeal and request for reconsideration which was denied. The case is now fully briefed. For the reasons discussed herein, we affirm the refusal to register.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We must determine the descriptiveness of a mark in relation to applicant's goods, the context in which the mark is being used and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S., supra, citing In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). Descriptiveness of a mark is not considered in the abstract. *In re*

Bayer Aktiengesellschaft, 82 USPQ2d at 1831. In other words, the question is whether someone who knows what the products are will understand the mark immediately to convey information about them. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

The examining attorney contends that the term STACKED is merely descriptive because it immediately conveys a significant feature of applicant's wine, namely that it is sold in "stacked" packaging.² The examining attorney submitted evidence obtained from the Internet consisting of wine blogs, news articles, and excerpts from applicant's own website showing use of the term "stacked" to describe applicant's vertically stacked container for its wines. The examining attorney also argues that registration of applicant's mark will inhibit the ability of competitors to use the term "stacked" to describe their own brand of wine.

Applicant concedes that "its wine is currently packaged in vertically arranged wine glasses...." However, applicant asserts that while the term STACKED may be descriptive of applicant's novel packaging, it does not describe a "characteristic, function or property" of applicant's actual products as identified in its application –

² Insofar as the examining attorney has requested the Board to take judicial notice of the identical entry from the online United Kingdom version of *Oxford Dictionaries*, the request is denied. In any event, the Board cannot rely on that particular version of the *Oxford Dictionaries* because it constitutes a foreign publication. See *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001). Instead, we take judicial notice of the adjective "stacked" from the American English version of the online *Oxford Dictionaries* as "(of a number of things) put or arranged in a stack or stacks," and "stack" as "a pile of objects, typically one that is neatly arranged." The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

wines and sparkling wines. Indeed, applicant maintains that the term STACKED when used in connection with wine is arbitrary. In addition, applicant argues that because its unique method of packaging its wine is the subject of a pending patent and marketed under an entirely different brand name – VINOWARE – the mark STACKED is not merely descriptive. As applicant further explains, because the goods consist of wine, its innovative packaging is not an integral part of the product; rather the goods could be marketed via other traditional methods such as bottles or boxes.

Applicant's contention that the concept of mere descriptiveness does not apply to product packaging is misplaced. In *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 126 USPQ 362 (CCPA 1960), the term MATCHBOX SERIES was found merely descriptive for model toy vehicles sold in boxes having the size and appearance of matchboxes. As the court explained:

It is clear that the word-mark sought to be registered was adopted by reason of the deliberate simulation, by the packaging for the goods, of matchboxes and this is further emphasized by some of the advertising which includes such statements as "Individually packed in small multicolor Matchboxes (21/4¢ long)," "Matchbox Display," and "Best of all, they're packed in these small 21/4¢ matchboxes." Taking full advantage of the advertising possibilities in the word, appellant promotes the line as "The Matchless 'Matchbox' Series" "for hours of 'matchless' fun." It gave away as a promotion a "Ronson" lighter engraved "MATCHLESS AS 'MATCHBOX' SERIES."

...
"Matchbox" is, of course, a common English word defined by Webster's Dictionary as "A box for holding matches." A matchbox is still a matchbox if the matches are removed and a toy is put in their place. We think the word is just as descriptive of a box which is made to look as much like a matchbox as is feasible so that the toys packaged in it can appropriately be designated as a "Matchbox Series" of toys.

As further evidence of descriptiveness, in the toy merchandising field specifically, opposers' evidence shows that for nearly 5 years, from 1939 into 1943, when the war put an end to it, it marketed a "Match Box Construction Set" which was in the size and shape of a safety-match box with a metal drawer and a paper sleeve, also described as "The Vest Pocket Builder—100 Toys in One."

Clearly, there is legal precedent for finding packaging of a product merely descriptive.

We also find instructive *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915, 1916 n.4 (TTAB 1986), in which the Board, in upholding a requirement for a disclaimer of the term "SQUEEZE N' SERV" as being merely descriptive of goods identified as "ketchup," noted that "whether it is the package itself, or the ketchup, or both which is (are) squeezed, is immaterial" inasmuch as "it is understood that this kind of food is necessarily sold in packages" and "hence the package is as much a part of the goods as the ketchup." In other words, a consumer would not be able to purchase applicant's wine, or for that matter any brand of wine, unless it is sold in a container of some sort – whether it is the traditional method of selling wine by the bottle or applicant's more recently developed methodology of vertically "stacked" single-serve packaging. In this case, the goods and packaging are necessarily intertwined, and it is therefore entirely appropriate to consider whether the term STACKED describes a feature of the packaging for the goods. *Cf. In re Metcal Inc.*, 1 USPQ2d 1334 (TTAB 1986) (holding SOLDER STRAP merely descriptive of self-regulating heaters in the form of flexible bands or straps); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982) (holding TOOBS merely descriptive of bathroom and kitchen fixtures in the shape of tubes).

According to the record, applicant's wine is sold in a container consisting of four disposable single-serve wine glasses stacked in a vertical arrangement. Applicant's specimen touts the novelty of the packaging. "Wine in a glass of its own!" As further clarified by the excerpt from applicant's own website:

WHAT IS STACKED? Get hip in a sip with STACKED: Wine in a glass of its own! STACKED was innovated for simple style, top quality taste, and ultra convenience for the home, the park, or the arena.

...

(R)EVOLUTIONARY PACKAGING. Stacked offers quality wine without the hassle of a bottle, corkscrew, or stemware. STACKED is a bottle of wine separated into four stemless wine glasses....STACKED is the perfect wine solution for a picnic, barbeque, tailgating party, concert, festival or simply for a glass at home without opening an entire bottle.

...

STACKED's exclusive Vinoware container was designed by engineers to offer the look and feel of a wine glass. Vinoware is made with a high quality plastic that is shatterproof and lightweight, while also protecting wine from oxidation and spoilage.

May 4, 2012 Office Action (excerpt from stackedwines.com). *See, e.g., In re Chamber of Commerce of the U.S.*, supra (Board relied in part on evidence obtained from applicant's own web site to find the mark NATIONAL CHAMBER merely descriptive of various chamber of commerce services).

We therefore find that applicant's proposed mark STACKED is merely descriptive of applicant's goods because it immediately refers to a significant feature of applicant's particular brand of wine -- that it is sold in vertically "stacked" disposable single-serve wine glasses. While we acknowledge that applicant may be the first to use the term STACKED in relation to wine, this does not remove its descriptive significance. *See In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Serial No. 85129206

Decision: The refusal to register in the absence of a disclaimer of STACKED is therefore affirmed.

However, this decision will be set aside if, within two months of the mailing date of this order, applicant submits to the Board a proper disclaimer of STACKED. *See* Trademark Rule 2.142(g). The standardized disclaimer format is as follows: No claim is made to the exclusive right to use the word STACKED apart from the mark as shown.