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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86321169

MARK: GOLDENBERRY



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Volcano Produce, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

Volcano-TM-0

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, Volcano Produce, Inc., has appealed the trademark examining attorney's final refusal to register the mark **GOLDENBERRY** in standard characters for "fresh fruits" pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the grounds that the mark is merely descriptive of the applied-for goods.

**I. FACTS**

On June 26, 2014, Volcano Produce, Inc. applied for the mark GOLDENBERRY in connection with “fresh fruit” in International Class 31 on the Principal Register.

On October 9, 2014, registration was refused pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, for the applied-for mark being a varietal name of a type of fruit, as well under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1127 for failure to provide a specimen of use for an application filed under Section 1(a) of the Trademark Act. In addition, a requirement for information about the goods was issued under 37 C.F.R. §2.61(b).

On April 9, 2015, applicant responded to the initial Office action and provided a specimen of use and responded to the information requirement under 37 C.F.R. §2.61(b).

On April 29, 2015, based on applicant’s response, the varietal refusal under Trademark Act Sections 1, 2, and 45 was withdrawn. However, a refusal under Section 2(e)(1) was issued for the applied-for mark being merely descriptive. In addition, applicant’s specimen was refused under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1127.

On October 29, 2015, applicant responded to the subsequent Office action by providing a substitute specimen of use.

On November 18, 2015, the trademark examining attorney issued a final Office action under Section 2(e)(1) of the Trademark Act and withdrew the Section 1, 2 and 45 refusal based on applicant’s substitute specimen.

On January 11, 2016, applicant filed a request for reconsideration of the Section 2(e)(1) refusal, which was denied on February 1, 2016.

On May 13, 2016, applicant filed the instant appeal.

## **II. ISSUE ON APPEAL**

The sole issue on appeal is whether applicant's mark is merely descriptive of the applied-for goods under Section 2(e)(1) of the Trademark Act.

Applicant states that the mark was refused in the alternative for being generic in the April 29, 2015, Office action; however, the section referred to by the applicant was not a refusal, rather it was an advisory indicating that because the mark *appeared* to be generic, no amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register could be recommended. See Applicant's Brief p. 2. Applicant has never amended the application to the Supplemental Register nor has the instant application ever been refused under Section 23(c) of the Trademark Act. See TMEP 1209.02(a).

### III. ARGUMENT

#### **GOLDENBERRY, WHEN USED IN CONNECTION WITH APPLICANT'S GOODS, IS MERELY DESCRIPTIVE OF A FEATURE OF APPLICANT'S GOODS**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)).

##### **A. Applicant's Mark is Merely Descriptive of a Feature of Applicant's Goods**

Here, applicant's mark is GOLDENBERRY in connection with "fresh fruits." GOLDEN is defined as "colored or shining like gold" and "having a deep yellow color of gold." See the definition from the Oxford Dictionaries and Merriam-Webster, respectively, February 1, 2016 Request for Reconsideration pp.5-6, 14-15. BERRY is defined as "a small roundish juicy fruit without a stone" and "a small fruit...that has many small seeds." See *id.* at pp. 2-3, 8-9. Thus, applicant's mark conveys that the goods are berries that are golden in color. In fact, applicant's goods are berries that are golden in color. See Applicant's

Specimen submitted on October 29, 2015. Moreover, applicant concedes that “[t]he fruit is a berry...” Applicant’s Brief p. 12. However, applicant contends the goods are “yellow in color” and that “[t]here is no ‘golden’ color.” *Id.* On the other hand, multiple dictionary definitions of record indicate that golden is a shade of yellow. Further, applicant also states in its brief, “[t]o be sure, there are many kinds of berries and, as discussed, *infra*, many are yellow or golden in color.” *Id.* at p. 13. Thus, applicant’s mark is merely descriptive of a feature of the goods.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *See, e.g., In re Leonhardt*, 109 USPQ2d 2091 (TTAB 2008) (BOBBLE POPS held merely descriptive for "candy," which the record showed was a lollipop candy featuring a bobble head device); *In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL merely descriptive of publications featuring news and information about Atlanta where THEATL was the equivalent of the nickname THE ATL for the city of Atlanta). Here, the components of the mark comprise a nickname for the type of fruit offered by the applicant. Applicant’s packaging states “goldenberry, also known as uchuva, cape gooseberry or physalis peruviana, is a super fruit native to South America,” which implies that “goldenberry” is one of several names by which the fruit is known. See October 29, 2015, Response to Office action, p.2. Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). In this case, both the individual components and the composite result are descriptive of applicant’s goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Moreover, applicant has not put forth any alternative meanings of the mark that are not merely descriptive of the goods. As a result, applicant’s mark is merely descriptive of applicant’s goods.

**B. GOLDENBERRY Immediately Conveys Knowledge About a Feature of the Applied-For Goods and is Understood By Consumers to Describe the Applied-For Goods**

A mark is also merely descriptive if “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods.” *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Here, the evidence of record makes clear that GOLDENBERRY immediately conveys to consumers that the goods are berries that are golden in color. On the other hand, applicant states “[a] fair degree of one’s imagination is required to make the leap from the mark to what goods are involved.” Applicant’s Brief p. 12. Applicant does not state what imagination or thought a consumer must engage in to reach a conclusion about the nature of the goods. The evidence of record, however, makes clear not only that the mark immediately conveys knowledge of a feature of the mark but also that consumers associate the words “goldenberry” and “golden berry” with the applied-for goods. Below are examples from the record of this wording being used in various media outlets to describe the applied-for goods, namely, fresh fruit.

- “Ask in the market and you will hear of Goldenberries, which is descriptive, though it sounds like strayed in from a rather lush fairy tale.” *The Economic Times*, See February 1, 2016 Denial of Request for Reconsideration p.29.
- “Once you learn about aronia berries and golden berries, both of which are increasingly available in stores and online, you’ll be chomping at the bit to sample them.” *People.com*, See November 18, 2015 Final Office action pp. 2-7.
- “The Pichuberry has become popular throughout the world, and has many alternate names. It is commonly referred to as a gooseberry, golden berry, Peruvian cherry, and ground berry.” *Fox News Latino*, see *id.* at pp. 31-34.

- “Fresh goldenberries aren’t common outside of South America, but the dried variety is available at most supermarkets.” HuffingtonPost.com, *see id.* at pp. 16-17.
- “Goldenberries: Also known as Cape gooseberries, these nutrient-dense sweet-and-tart alleged superfruits grow in high-altitude South American and India, where folk-medicine practitioners have long used them to combat jaundice.” HuffingtonPost.com, *see id.* at p. 27.
- “European explorers introduced [the ground cherry] to South Africa in the 1800s and that’s how it got one of its common names, the Cape gooseberry. It’s also known as the Inca berry, golden berry or my favorite, Amour en cage, or love in a cage. Vermont Public Radio, *see id.* at p. 38.
- “Golden berries, also known as *Physalis peruviana*, is South American fruit that’s highly concentrated with nutrients and bioactive compounds.” Global Healing Center Natural Health & Organic Living, *See* April 29, 2015, Office action pp.22-24.
- “Golden berries recommended by Dr. Oz for their fat burning properties, are among the superfoods that people all over the world have begun to incorporate into their daily meal plans.” RawGuru.com, *see id.* at pp.28-30.
- “Goldenberries contain anti-inflammatory bioflavonoids and are also a good source of vitamins A (great for eye health!) and C...Have I enticed you to try them for yourself? Whole Foods stocks Navitas Naturals Goldenberries (\$6) and Kopali Organic Goldenberries (\$4), but you can easily order them online.” PopSugar.com, *see id.* at pp.32-33.
- “Though new to the market in the U.S., golden berries have a long history of exportation and use in Europe, the Middle East, and China.” RenegadeHealth.com, *see id.* at pp.55-56.
- “You’re eating your acai berries, right? What about your goji berries? Okay, then, try this one – are you eating your goldenberries? Maybe not.” International Business Times, *See* February 1, 2016, Denial of Request for Reconsideration pp. 37-39.

On the other hand, applicant contends that the evidence of record is merely a “hodge-podge of non-academic articles, along with a ‘Wikipedia’ entry, the latter of which clearly is not a scholarly, peer-reviewed article.” Applicant’s Brief p. 12. However, articles from the online Wikipedia® encyclopedia may be used to support a refusal or requirement, provided that an applicant has an opportunity to rebut such evidence and the first use of a Wikipedia article was in a non-final Office action. *See In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007); TBMP §1208.03; TMEP §710.01(b). Further, although the articles of record are not scholarly works or peer-reviewed journals, the articles span a wide range of sources, from news websites, to business publications, to pop culture magazines, to health blogs, which would cover a large cross-section of consumers. Material obtained from the Internet is generally accepted as competent evidence. *See In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d at 1642. Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination. Accordingly, the evidence of record supports that the mark would be perceived by purchasers as being merely descriptive of a type of fresh fruit.

Applicant also contends that because the mark does not appear on a “List of Types of Berries from A to Z” from the GardeningChannel.com nor in a list of USDA List of Approved Names that the mark cannot be either generic or merely descriptive of the goods. *See Applicant’s Brief pp. 12-13.* However, this evidence does not *per se* demonstrate that the mark is suggestive. The news articles, blog posts and magazine articles referenced above make clear that “goldenberry” is perceived by the public as being commonly used name to describe the goods as issue.

Applicant also contends that “competitors do not need to use the name or mark GOLDENBERRY, to describe their goods.” Applicant’s Brief p. 15. Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). In the instant case, a number of companies use “goldenberry” or variants thereof to describe the goods at issue.

Below are examples of various companies from the evidence of record.

- Health Warrior is launching a line of protein bars featuring lemon goldenberries, “which is quickly becoming a crowd favorite,” according to Shane Emmett, the co-founder and CEO of Health Warrior. *See* November 18, 2015 Final Office action p. 42-44.
- Sunfood Super Foods sells “Golden Berries.” *See* April 29, 2015 Office action pp. 12-13.
- BF Bulkfoods sells “Golden Berries.” *See id.* at p.14.
- Navitas Naturals sells organic “goldenberries.” *See id.* at p. 15.
- Terrasoul Superfoods sells organic dried “Golden Berries.” *See id.* at p. 20.
- Essential Living Foods sells organic, raw Goldenberries. *See id.* at pp. 47-48, 52.
- “Golden berry” has been used in a patent application to describe an ingredient in a patent application for a drink and preparation method. *See id.* at pp. 2-5.

Accordingly, the evidence of record makes clear that competitors use the term “goldenberry” to describe their goods and that consumers understand “goldenberry” to describe the goods at issue.

Finally, applicant argues that the overwhelming majority of the evidence submitted by applicant shows the “Cape Gooseberry” is the common name for the fruit at issue. *Id.* at 12. Indeed, the evidence of record does show that Cape Gooseberry is another name used in connection with the applied-for goods. However, “golden berry,” “goldenberry,” “Physalis peruviana,” and “physalis” are all also used to describe the applied-for goods. Further, the *Dictionary of Food: International Cooking Terms from A to Z*, states that Cape Gooseberry is “[a] cherry-sized, yellow-fleshed, slightly sour fruit of a plant *Physalis peruviana* originally from Peru...[a]lso called *physalis*, *goldenberry*.” October 9, 2015, Office action, p. 9 (emphasis added). Moreover, applicant’s specimens state that applicant’s goods are the *Physalis peruviana*. See Applicant’s specimens dated April 9, 2015, and October 29, 2015. Most notably, applicant’s website lists “Goldenberrys” as a type of fruit, describing the *Physalis Peruviana* fruit as “[a]lso known as the Uchuva, Golden Berry, or Inca Berry is native to South America.” See October 9, 2015, Office action, pp. 12-14. Thus, the evidence of record makes clear that the applicant’s goods, which include the *Physalis peruviana*, are commonly described as a goldenberry.

#### **IV. CONCLUSION**

The evidence of record demonstrates that the applied-for mark is merely descriptive of the applied-for goods. Thus, the refusal under Section 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

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