

This Opinion is not a
Precedent of the TTAB

Mailed: March 23, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Wildlife Friendly Enterprise Network
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Serial No. 86694394
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Betsy P. Bengtson and Larry H. Tronco, Holland & Hart LLP,
for Wildlife Friendly Enterprise Network.

Elizabeth N. Kajubi, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Kuhlke, Hightower, and Heasley,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Wildlife Friendly Enterprise Network seeks registration of the
certification mark shown below:



for (as amended):

“honey; tea; field crops, namely, coffee, corn, potatoes; handicrafts, namely, baskets, home and fashion accessories, wooden carvings; mushrooms,” in Class A; and

“hotel services, hospitality services, tour operator services, travel agency services, tourism services, transportation services, park operations, hotels, lodges, recreational parks,” in Class B.¹

The application has the following certification statement (also as amended):

The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the goods and services will be grown, rendered, handled, delivered and processed in accordance with ecological and conservation farming and sustainable tourism guidelines and standards.

Applicant has disclaimed CERTIFIED, but the Examining Attorney has refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant’s failure to comply with an Office requirement to disclaim CERTIFIED GORILLA FRIENDLY on the ground that the wording is merely descriptive of the identified goods and services in relation to Applicant’s certification activities within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

After the refusal was made final, Applicant appealed and requested reconsideration, which was denied. The appeal then resumed.

We affirm the refusal to register.

¹ Application Serial No. 86694394 was filed on July 15, 2015, based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The description of the mark states: “The mark consists of the words ‘CERTIFIED GORILLA FRIENDLY’ stacked upon each other in all caps. The word ‘CERTIFIED’ is written in a shaded box. The words appear above an image of an adult gorilla and a baby gorilla inside a shaded box. The entire logo is outlined by a rough line forming a rectangle.” Color is not claimed as a feature of the mark.

A. Evidentiary Objections

The Examining Attorney objects that the new evidence attached to Applicant's appeal brief is untimely submitted and asks that we disregard it, citing Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), among other authorities. The evidence consists of what appears to be an entry for "gorilla" from Encyclopedia.com² and an article from Wikipedia.com titled "Gorilla,"³ portions of which also were submitted by Applicant with its request for reconsideration.⁴ Applicant responds to the objection as follows:

The Examining Attorney claims Wikipedia entries submitted by the Applicant in its Appeal Brief to corroborate the incongruous meaning of GORILLA FRIENDLY are untimely because the complete entries were not submitted earlier. This is wrong. The Board can consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. *In re IP Carrier Consulting Grp.*, 84 U.S.P.Q.2d 1028, 1032-33 (T.T.A.B. 2007).⁵

Applicant misconstrues the nature of the Examining Attorney's objection. Trademark Rule 2.142(d) provides: "The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal." We sustain the Examining Attorney's objection to the extent that we have given no consideration to the portions of the Wikipedia.com article submitted for the first time with Applicant's appeal brief. *See, e.g., In re Jimmy*

² 9 TTABVUE 12, displaying the source The Columbia Encyclopedia (6th ed.) and the URL <http://www.encyclopedia.com/plants-and-animals/animals/vertebrate-zoology/gorilla>.

³ 9 TTABVUE 13-24.

⁴ August 18, 2016 Request for Reconsideration at TSDR 5-6, 4 TTABVUE 8-9.

⁵ Reply Brief at 2, 12 TTABVUE 3.

Moore LLC, 119 USPQ2d 1764, 1767 (TTAB 2016). The Board, however, may take judicial notice of evidence from encyclopedias and other standard reference works, including entries from online dictionaries and encyclopedias that exist in printed format. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.3 (TTAB 2016); TBMP § 1208.04 (Jan. 2017). We exercise our discretion to take judicial notice of the entry from Encyclopedia.com attached to Applicant's appeal brief.

The Examining Attorney also observes that Applicant references in its appeal brief three other registrations it owns, but did not make the underlying registrations of record. Applicant responds that these registrations were included in a list submitted with its request for reconsideration, and argues that the Examining Attorney waived objection by failing to raise this issue in her reconsideration letter.

Applicant did not refer to these registrations until its request for reconsideration, which was denied, and the Examining Attorney was not required to advise Applicant of the insufficiency because it was too late to cure. *See In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1314-15 n.3 (TTAB 2011); TBMP § 1207.03 (Jan. 2017). Even were we to consider these references, the only information we could consider, "for whatever limited probative value such evidence may have," would be the marks and registration numbers provided by Applicant.⁶ *In re Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013) (quotation omitted). The underlying registrations are not of record, and Applicant has not established that they comprise the word "friendly" without disclaimer.

⁶ See 4 TTABVUE 25.

B. Disclaimer Requirement

A requirement under Trademark Act Section 6 for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive of the goods or services at issue. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1), and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012). Pursuant to Sections 4 and 45 of the Act, 15 U.S.C. §§ 1054 and 1127, certification marks are used to certify various characteristics of goods and services of others and are subject to the provisions relating to the registration of trademarks. The standards used to consider mere descriptiveness of and disclaimer requirements for trademarks and service marks are applicable to certification marks. *In re Nat'l Ass'n of Legal Sec'ys (Int'l)*, 221 USPQ 50, 52 (TTAB 1983); TMEP § 1306.04 (Jan. 2017).

The Examining Attorney alleges that the literal portion of Applicant's mark, CERTIFIED GORILLA FRIENDLY, is merely descriptive of the identified goods and services in connection with Applicant's certification activities. A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services with which it is used. *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). Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average purchaser encountering the goods or services in the marketplace. *See In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1473 (TTAB 2014); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016).

As noted *supra*, Applicant's mark is proposed to certify goods and services "grown, rendered, handled, delivered and processed in accordance with ecological and conservation farming and sustainable tourism guidelines and standards"; the goods to be certified identified in the application are "honey; tea; field crops, namely, coffee, corn, potatoes; handicrafts, namely, baskets, home and fashion accessories, wooden carvings; mushrooms"; and the recited services are "hotel services, hospitality services, tour operator services, travel agency services, tourism services, transportation services, park operations, hotels, lodges, recreational parks."

Among the evidence submitted by the Examining Attorney is:

- A definition of "gorilla" meaning: "a very large typically black-colored anthropoid ape (*Gorilla gorilla*) of equatorial Africa that has a stocky body with broad shoulders and long arms and is less erect and has smaller ears than the chimpanzee."⁷

⁷ November 1, 2015 Office action at TSDR 2 (from merriam-webster.com/dictionary/gorilla).

- Definitions of “friendly” as: “serving a beneficial or helpful purpose” and “COMPATIBLE, ACCOMMODATING <environmentally *friendly* packaging> —often used in combination <a kid-*friendly* restaurant>”⁸
- Pages from Applicant’s website describing the initiative to be offered under its certification mark as aiming “to recognize and reward tourism facilities and operators that do the right thing for gorillas and people through voluntary eco-labelling.”⁹
- A reference to “gorilla-friendly development projects” in the “Gorilla” factsheet on the Primate Info Net Library and Information Service, National Primate Research Center, University of Wisconsin–Madison.¹⁰
- A similar or identical quote referencing “gorilla-friendly development projects” in a blog titled “Why Gorillas are Critically Endangered, and What[']s Being Done to Protect Them.”¹¹
- An October 2006 feature in the SGI Quarterly, “A Buddhist Forum for Peace, Culture and Education,” discussing campaigns to manufacture “‘gorilla-friendly’ products.”¹²

These dictionary definitions and uses demonstrate that consumers understand the phrase “gorilla friendly” to convey information about a feature of the goods and services certified by Applicant: that they are beneficial to, helpful to, compatible with, or accommodating of gorillas. “Gorilla friendly” embodies a common construction with readily recognized significance, as reflected in the examples in the second definition of “friendly,” i.e., “environmentally *friendly* packaging” and “a kid-*friendly* restaurant.” The phrase “gorilla friendly” is merely descriptive in this context and therefore must be disclaimed.

⁸ *Id.* at TSDR 8 (from merriam-webster.com/dictionary/friendly).

⁹ February 18, 2016 Final Office Action at TSDR 60 (from wildlifefriendly.org/gorilla-friendly-tourism/).

¹⁰ September 8, 2016 Reconsideration Letter at TSDR 117 (from pin.primate.wisc.edu/factsheets/entry/gorilla/cons).

¹¹ February 18, 2016 Final Office Action at TSDR 56 (cached pages from a post on nikela.org dated December 8, 2015).

¹² *Id.* at TSDR 63 (from sgiquarterly.org/feature2006Oct-6.html).

Applicant makes four arguments that the wording is not descriptive:

1. GORILLA FRIENDLY does not have any meaning that is recognized or well-understood by the public.
2. GORILLA FRIENDLY “is ambiguous when applied to Applicant’s goods and services and could mean many different things to different consumers.”
3. The terms GORILLA and FRIENDLY are incongruous and therefore not merely descriptive.
4. Other FRIENDLY marks have been registered without disclaimer.¹³

Applicant’s arguments are unavailing. First, it is well-established that a term may be merely descriptive even if Applicant is the first or only user of it. *See In re Fat Boys Water Sports*, 118 USPQ2d at 1514; *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983). A phrase need not be “widely understood”¹⁴ in order to be merely descriptive.

With respect to Applicant’s second argument, based on the dictionary definitions of record, we find that consumers would immediately understand GORILLA FRIENDLY to convey that the goods and services subject to Applicant’s certification mark are deemed to be beneficial to, compatible with, or accommodating of gorillas. A mark need not immediately convey an idea of each and every specific feature of the services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the services. *See In re Gyulay*, 3 USPQ2d at 1010; *In re Fat Boys Water Sports*, 118 USPQ2d at 1512. “The question is not

¹³ Appeal Brief at 2, 9 TTABVUE 3.

¹⁴ *Id.* at 3, 9 TTABVUE 4.

whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech. Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

We also are not persuaded by Applicant’s third argument. Considered in the context of the mark as a whole and the identified goods and services, the wording GORILLA FRIENDLY presents no incongruity. Regardless whether gorillas at times behave aggressively toward one another¹⁵ and are “not generally portrayed in media as warm and loveable animals,”¹⁶ there is no incongruity in certifying that certain goods and services are provided “in accordance with ecological and conservation farming and sustainable tourism guidelines and standards” – that is, that they are beneficial, accommodating, or “friendly” to gorillas. The physical capabilities and social habits of gorillas are not relevant. The combination of the descriptive terms “gorilla” and “friendly” evokes no new and unique commercial impression; rather, each component merely retains its descriptive significance in relation to Applicant’s certification activities, forming a composite that is merely descriptive as a whole. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

¹⁵ *See* August 18, 2016 Request for Reconsideration at TSDR 6, 4 TTABVUE 9 (excerpt from Wikipedia.org article).

¹⁶ Appeal Brief at 6, 9 TTABVUE 7.

Finally, we address Applicant's argument that other marks comprising FRIENDLY have been registered without disclaimer of that term. Third-party registrations featuring the same or similar goods or services are probative evidence on the issue of descriptiveness where the relevant term is disclaimed, registered under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006), *aff'd per curiam*, 223 Fed. Appx. 984 (Fed. Cir. 2007).

The Examining Attorney submitted printouts of 42 existing third-party registrations incorporating the word FRIENDLY that either disclaim that word, are registered on the Supplemental Register, or issued with a claim of acquired distinctiveness pursuant to Trademark Act Section 2(f).¹⁷ Perhaps most relevant among these are the following certification mark registrations (with goods, services, and certification statements paraphrased), all registered on the Principal Register except the second mark listed:



1. (Registration No. 3092532), with a claim of acquired distinctiveness as to BIRD FRIENDLY, certification mark for coffee produced from plantations with a diversity of shade trees conforming to cultivation, production, processing and marketing standards.

¹⁷ February 18, 2016 Final Office Action at TSDR 13-52; September 8, 2016 Reconsideration Letter, at TSDR 2-107.

2. CAT FRIENDLY PRACTICE (Registration No. 4255567), registered on the Supplemental Register in standard characters and with PRACTICE disclaimed, certification mark for veterinary services meeting operational standards for feline care.



3. (Registration No. 4291456), with CAT FRIENDLY PRACTICE disclaimed, certification mark for veterinary services meeting operational standards for feline care.



4. (Registration No. 4461457), with CAT FRIENDLY PRACTICE disclaimed, certification mark for veterinary services meeting operational standards for feline care.



5. (Registration No. 2516238), with ELDER FRIENDLY disclaimed, certification mark for compliance with standards for commercial establishments serving the age 50+ consumer market.



6. (Registration No. 4330158), with in relevant part a 2(f) claim as to CERTIFIED ASTHMA & ALLERGY FRIENDLY, certification mark for goods that have been tested regarding allergen and irritant particle removal and reduction.



7. (Registration No. 3431647), with ASTHMA FRIENDLY disclaimed, certification mark for toys, pillows, and bedding and accessories that meet prescribed standards.



8. (Registration No. 3850680), with all wording disclaimed, certification mark for foods and beverages.
9. **CAFB CERTIFIED AGE-FRIENDLY BUSINESS** (Registration No. 4092708), in standard characters and with **CERTIFIED AGE-FRIENDLY BUSINESS** disclaimed, certification mark for consultation and assistance to senior citizens regarding financial, medical and social issues that specifically affect senior citizens.



10. (Registration No. 4562216), with **APPROVED FOOD PRODUCT** and **FODMAP FRIENDLY** disclaimed, certification mark for various foods, beverages, and dietary supplements.



11. (Registration No. 4214412), with **MEETS INTERNATIONAL WATER QUALITY COUNCIL STANDARDS** and **CERTIFIED WATERSHED FRIENDLY** disclaimed, certification mark for real property, goods, and services meeting standards for watershed quality optimization and helping reduce water pollution runoff.

Applicant, in turn, submitted copies of eight third-party registrations from which the term **FRIENDLY** was not disclaimed, including one certification mark: **BABY-FRIENDLY** (Registration No. 4566897), registered on the Principal Register without disclaimer for “Maternal breastfeeding support and education,” with the following certification statement:

The certification mark, as used by entities authorized by the certifier, certifies that the hospital, maternity center or health care facility complies with standards implementing the Baby-Friendly Hospital Initiative by, among other requirements, not accepting free or low cost breast milk

substitutes and by implementing the Ten Steps to Successful Breastfeeding program to provide an optimal environment for breastfeeding mothers.¹⁸

Although it appears that “-friendly” formative marks often have been treated as merely descriptive by the Office, the third-party registrations do not determine the outcome here. A decision to allow another application is not controlling. *See, e.g., In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007). Rather, the Board must assess each mark on its own facts and record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); *see also In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (“Although consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us.”). The evidence in this case establishes that the phrase “gorilla friendly” is merely descriptive in association with Applicant’s certification activities for the identified goods and services, and therefore must be disclaimed.

C. Conclusion

We have carefully considered all arguments and evidence of record, including any not specifically discussed. We conclude that GORILLA FRIENDLY is merely descriptive of the identified goods and services in relation to Applicant’s certification activities and must be disclaimed pursuant to Trademark Act Section 6(a).

¹⁸ August 18, 2016 Request for Reconsideration at TSDR 7-19, 4 TTABVUE 10-22.

Decision: The refusal to register Applicant's mark in the absence of a disclaimer of CERTIFIED GORILLA FRIENDLY under Section 2(e)(1) is affirmed.

However, this decision will be set aside if, within thirty days of the mailing date of this order, Applicant submits to the Board the required disclaimer of CERTIFIED GORILLA FRIENDLY. *See In re Country Music Ass'n Inc.*, 100 USPQ2d 1824, 1835 (TTAB 2011); Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g); TBMP § 1218 (Jan. 2017). The disclaimer should be worded as follows: "No claim is made to the exclusive right to use 'CERTIFIED GORILLA FRIENDLY' apart from the mark as shown." TMEP § 1213.08(a)(i) (Jan. 2017).