Oral Hearing: May 14, 2019 Mailed: June 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Barrel Distributors

Serial No. 87271602

Mark A. Goodman of Kalicki Collier LLP,
for International Barrel Distributors.

Andrew Leaser, Trademark Examining Attorney, Law Office 117,
(Hellen M. Bryan-Johnson, Managing Attorney).

Before Rogers, Chief Administrative Trademark Judge,
Cataldo and Heasley, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, International Barrel Distributors, filed an application to register on the Principal Register the asserted mark DEEP TOAST in standard characters, identifying "wood barrels" in International Class 20.[1] The application was filed on December 16, 2016 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting January 21, 1998 as a date of first use of the proposed mark anywhere and in commerce. During prosecution, Applicant amended its application

[1] Application Serial No. 87271602.

to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).[2]

The Trademark Examining Attorney has issued a final refusal of registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. § 1051-52, 1127, on the ground that the proposed DEEP TOAST mark is generic and, in the alternative, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that DEEP TOAST is merely descriptive of Applicant's goods and that Applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f).[3] When the refusals were made final, Applicant appealed. Applicant and the Examining Attorney have filed briefs. In addition, Applicant and the Examining Attorney presented arguments during an oral hearing before this panel of the Board.

Acquired Distinctiveness under Section 2(f)

By amending its application to seek registration under Section 2(f), Applicant has conceded that the proposed DEEP TOAST mark is merely descriptive under Section 2(e)(1).[4] *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Thus, we must determine whether Applicant has carried its burden of establishing, by a preponderance of the evidence, a *prima facie* case that the merely descriptive term

[2] Applicant's September 21, 2017 Response to Office Action at 2.

[3] The Examining Attorney also issued several requirements with which Applicant complied.

[4] For this reason, we find unavailing Applicant's argument in its brief that "the applied for mark is closer to being merely suggestive than it is to being generic." (Applicant's brief, 4

has acquired distinctiveness under Section 2(f) and can be registered as a mark. *See Yamaha, supra*; *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

First, we must determine the degree of descriptiveness of Applicant's proposed DEEP TOAST mark in relation to its recited goods. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

We begin by examining Applicant's specimen of record, reproduced in part as Figures 1 and 2 below.

TTABVUE 9). We construe such arguments in the context of Applicant's contention that DEEP TOAST is not generic and has acquired distinctiveness.

Figure 1:

BARREL ASSOCIATES

2015 PRICE LIST

AMERICAN OAK COLLECTION

All prices FOB Cooperage. Freight included for truckload quantities of 150 barrels or more delivered in the Western U.S. Orders placed by March 31, 2015 and requested delivered by June 1, 2015 receive a discount of 5%. Volumes are rounded to nearest gallon. Prices may vary subject to fuel surcharge and cost of raw materials.

FIRE BENT				USD UNIT PRICE	USD CNTR PRICE
	225 L	60 GAL	Bordeaux Transport	$415	$400
	265 L	70 GAL	Barrique	$430	$415
	300 L	80 GAL	Hogshead	$470	$455
WATER BENT				**USD UNIT PRICE**	**USD CNTR PRICE**
	114 L	30 GAL	Bordeaux Transport	$390	n/a
	225 L	60 GAL	Bordeaux Transport	$430	$415
	265 L	70 GAL	Barrique	$445	$430
	300 L	80 GAL	Hogshead	$485	$470
DEEP TOAST				**USD UNIT PRICE**	**USD CNTR PRICE**
	225 L	60 GAL	Bordeaux Transport	$440	$425
	265 L	70 GAL	Barrique	$455	$440
	300 L	80 GAL	Hogshead	$495	$480

OPTIONS

Standard Toasted Heads: $7.50
Water Toasted Heads: $12.50
Thin Stave: $20
36 Month Seasoning: $35 (limited)
Ripple Effect: $35

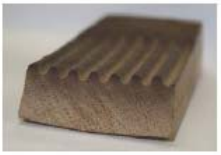

Figure 2:

We next turn to evidence made of record by Applicant and the Examining Attorney. This evidence includes screenshots and articles from the following third-party websites, submitted by the Examining Attorney with his first, second and final Office Actions:[5]

- Caldwell Vineyard, caldwellvineyard.com/Caldwell/Cooperage "You're working with low, slow burning fires and toasting the barrels for a long time to get that really deep toast quality."

- Copper & Kings, copperandkings.com/smoking-brrels/ "You can just char a barrel in a few minutes and you will have a perfectly acceptable barrel, but we

[5] March 21, 2017 Office Action at 5-11; September 22, 2017 Office action at 6-7; March 24, 2018 Final Office Action at 7-12.

think that slowing the process down and ensuring that you have both toast and char is crucial… we are a bit more aware of subtle differences we can make just by adjusting the way in which we toast and char. We enjoy going for a long, deep toast over natural fires and only then allowing the barrel to ignite."

- DRM.reCoop, drmrecoop.com/our-process.html "Our radiant element toasting machine uses a convection element that applies a uniform deep toast."

- Kagan Cellars, kagancellars.com/2012/10/wine-blending-sessions-spring-2011/ "So, the Kagan Cellars 2010 Syrah spent 8 months in a 1-year-old, Redmond French oak barrel with a deep toast, and 10 months in a 1-year-old, François Frères French oak barrel with a medium toast."

- Oregon Barrel Works, oregonbarrelworks.com/alternatives.html "The tank staves are slow toasted using a convection style roaster, insuring a uniform, deep toast."

- reWine Barrels, rewinebarrels.com/process.html "Our barrels are slowly toasted with an electric element for an average of two hours which allows for a truly deep toast."

- Bouchard Cooperages, bouchardcooperages.com/usa/news/barrel_lore.html "Vincent theorized that the more you toast or char a barrel, the lower the level of astringency. However, this depends on the penetration of the heat in the barrel stave and whether it is well-seasoned wood. … a medium, deep toast normally offers a creamy, smooth flavor throughout the life of the barrel (three to four cycles of white wine)"

- Andrew Adams, *Replicating the Barrel with New Alternatives*, WINES & VINES, Apr. 2017, winesandvines.com/sections "Oak Solutions Group touts its new Cuvee 4 and Cuvee 5 staves as producing barrel-like extraction in a tank. The staves are toasted on one side with a unique infrared toast and left untoasted on the other side. By exposing the wine to both toasted and untoasted wood, international sales director Kyle Sullivan said it creates a similar dynamic in the tank to what occurs in the barrel when wine pushes past the depth of the toast into the barrel's interior surface. 'We are toasting one side with a pretty deep toast and getting a pretty deep transformation of compounds and leaving the other side virtually untoasted,' he said."

- Atlas Barrel, https://atlasbarrel.com/greg-and-carl "We toast & char the barrels to your desired specifications. We take great pride in using 100% Minnesota white oak. Known to have one of the highest content of the

vanillin compound in all oak species in the world. … Deep Toast—bring out deeper, toffee & coffee flavors."

- Barrel Builders Napa Valley, https://barrelbuilders.com/cooperage/new-barrels/ "In our proprietary 'Ambre' toasting, the fire is kept very low so the temperature of the wood doesn't exceed 170°C, much lower than the normal 220-240°C. The barrel is wet down several times during the toasting to further slow the toasting and dissolve out some of the harsher tannins. The result is a deep toast barrel specifically designed for long term aging of big reds.

The Examining Attorney further made of record dictionary definitions: DEEP – "extending far inward from an outer surface;"[6] and TOAST – "to heat and brown (bread, for example) by placing in a toaster or an oven or close to a fire."[7]

Based upon the evidence of record, we find that DEEP TOAST is highly descriptive of a feature of Applicant's "wood barrels," namely, that the barrel staves are heated and charred to achieve certain flavors of wines aged therein. We further note that much of the third-party evidence and Applicant's own specimen reproduced above as Figure 2 describe "deep toast" as a process, a "proprietary production regime" or the result of such processes. Indeed, in Applicant's response to the Examining Attorney's requirement to explain the mark's significance, Applicant responds: "'Deep Toast' is a proprietary process to make the barrel taste a certain way by virtue of HOW Applicant toasts the barrel."[8] As a result, the record in this application calls into question the extent to which DEEP TOAST will be perceived as a trademark for wood barrels, as opposed to denoting a process the

[6] March 24, 2018 final Office Action at 14-15; retrieved from yourdictionary.com, citing the American Heritage Dictionary of the English Language (5th ed.) accessed on March 24, 2018.

[7] *Id*.

barrels undergo in preparation for their use in winemaking.[9] We find, therefore, that DEEP TOAST is highly descriptive as used in connection with Applicant's goods and, as a result, Applicant needs a commensurately high degree of evidence to show that DEEP TOAST has acquired distinctiveness for its goods. *See Yamaha,* 6 USPQ2d at 1008 ("in general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.").

We now turn to the evidence submitted by Applicant in support of its Section 2(f) claim of acquired distinctiveness. As noted above, it is Applicant's burden to prove acquired distinctiveness. *See Yamaha*, 6 USPQ2d at 1006; *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant…."). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008.

Applicant claims that its mark has acquired distinctiveness based upon continuous use for twenty years: "Applicant has attached a marketing article used by Applicant showing use of the Mark in 1998. Applicant could furnish additional evidence if necessary."[10] However, a claim that Applicant has been using the subject matter for a long period [of substantially exclusive use] may not be sufficient to demonstrate that the mark has acquired distinctiveness. *See In re Gibson Guitar*

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[8] Applicant's March 22, 2018 Response to Office Action at 14.

[9] The issue of whether DEEP TOAST *can* function as a trademark is not before us. The question presented is whether it *is* now functioning as a mark because it has acquired distinctiveness.

Corp., 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use insufficient to support a finding of acquired distinctiveness). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970), and more evidence is required where a term is so highly descriptive that purchasers seeing the matter in relation to the goods would be less likely to believe that it indicates source in any one party. *See In re Bongrain Int'l Corp*., 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include, in addition to the length of use of the asserted mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. However, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning. *In re Boston Beer Co. L.P*., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of "The Best Beer In America.").

Applicant also submitted a two page summary of the results of a Google search of "deep toast wine barrel." Applicant asserts:

> The Google search results referenced above provide additional evidence of acquired distinctiveness, as the top results for the mark are Applicant's webpages. This search engine position is tantamount to unsolicited media coverage, as it shows that Applicant's webpage is

[10] *Id*. at 15. The "marketing article" was also included with the original application as part of Applicant's specimen of record.

> recognized as the most relevant resource related to the phrase "Deep Toast."[11]

The Google search results have little probative value as evidence, inasmuch as they are merely truncated listings and not full search results. They do not show the context in which the term "deep toast" is used or provide a clear definition of the term or indicate the manner in which the term is perceived by consumers. The first six listings direct readers to premierwinecask.com, and indicate only that Premier Wine Cask represents, *inter alia*, Applicant and its barrels, including DEEP TOAST barrels. The six listings on the second page discuss the term "deep toast" used in relation to various beers. Accordingly, the references do not support a finding that consumers recognize Applicant as an indicator or source for wooden barrels under the DEEP TOAST mark. *See In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (deeming list of Google search result summaries to be "of little value in assessing the consumer public perception of the ASPIRINA mark" because they provide "very little context of the use of ASPIRINA"); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) ("search summary of results from the Google search engine" given no consideration); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google search results entitled to little probative weight). Despite Applicant's assertion, the search results do not serve as "unsolicited media coverage" in support of Applicant's claim of acquired distinctiveness. Accordingly, while we have considered this evidence, it is of little value in assessing consumer public perception of DEEP TOAST as applied

[11] Applicant's brief, 4 TTABVUE 9.

to wooden barrels. There is little, if any, additional evidence in the record that would support Applicant's claim of acquired distinctiveness.

In short, the evidence submitted by Applicant suggests that it, as well as third parties, use the term "deep toast" to denote certain processes used in heating and charring wooden barrels for use in winemaking, or the degree of heating and charring produced thereby. Applicant's use of DEEP TOAST does not appear to be substantially exclusive. Aside from Applicant's assertion of 20 year of use of the term both to denote a process and as a mark, there is little probative evidence that consumers will view DEEP TOAST as identifying Applicant as the source of wooden barrels. Thus, the evidence falls rather short of demonstrating that DEEP TOAST, as used in connection with such goods, has acquired distinctiveness under Section 2(f). Missing from the record are sales or advertising figures and context therefor, marketing materials, and internet website impressions, and direct evidence in the form of, for instance, surveys or affidavits asserting source-indicating recognition by which we may determine that DEEP TOAST has come to indicate source in Applicant.

We find as a result that with this highly descriptive mark, Applicant has not met its burden of showing acquired distinctiveness. *See Yamaha,* 6 USPQ2d at 1008.

Decision: The refusal to register under Trademark Act Section 2(e)(1), on the ground that DEEP TOAST is merely descriptive of Applicant's goods and that Applicant's evidence is insufficient to show acquired distinctiveness of the mark

under Section 2(f), is affirmed.[12]

[12] Having affirmed the refusal of registration under Section 2(e)(1) and on the failure to establish acquired distinctiveness, we need not consider the alternate refusal of registration on the ground of genericness.