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Mailed: November 6, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beaverton Foods, Inc.

Serial No. 76624790

Request for Reconsideration

Kevin M. Hayes of Klarquist Sparkman, LLP for Beaverton Foods, Inc.

David Taylor, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Hohein, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On September 17, 2007 (with a certificate of mailing dated September 13, 2007) applicant filed a timely request for reconsideration of the decision issued on August 13, 2007, in which the Board affirmed the refusal to register applicant's mark NAPA VALLEY MUSTARD CO. (in standard character form) under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark is geographically deceptive.

Applicant argues that the Board's decision is incorrect because 1) the "finding of materiality ... is factually and legally incorrect" in that "[f]actually the evidence of record in this case does not support a finding of materiality" and "[l]egally, the Board's inference of materiality from its allegation that the Napa Valley is known for mustard (which it is not) is improper"; and 2) the Board did not "adhere to the pronouncement by Congress ... that nothing shall prevent the registration of a qualifying primarily geographically deceptively misdescriptive mark." Request pp. 1-2.

We first address applicant's second argument regarding the application of Section 2(a) of the Trademark Act and the inapplicability of Section 2(f) of the Trademark Act. Applicant points to the Board's decision that the exception in Section 2(f) "clearly applies only to pre-NAFTA 'primarily geographically deceptively misdescriptive' marks, but not to pre-NAFTA 'geographically deceptive marks'" and argues that "the statute itself does not state that the exception in 2(f) applies only to marks meeting the pre-NAFTA definition of [primarily geographically deceptively misdescriptive], but not the pre-NAFTA definition of geographically deceptive." Further applicant argues that "the plain meaning of 'nothing ... shall

prevent' can have no other meaning than - nothing, including section 2(a), shall prevent the registration of a qualifying [primarily geographically deceptively misdescriptive] mark." Request pp. 9-10.

Contrary to applicant's position, the statute does in fact state that "the exception in 2(f) applies only to marks meeting the pre-NAFTA definition of [primarily geographically deceptively misdescriptive]." Under the statute, only those primarily geographically deceptively misdescriptive marks "which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement [NAFTA]" are protected by the grandfather clause. 15 U.S.C. §1052(f). Geographically deceptive marks could not become distinctive "before the date of the enactment of" NAFTA, therefore, the exception clearly does not apply to such marks.

In addition, applicant argues that "the inconsistency in the statute caused by the Board's Decision supports Applicant's reading of the statute [because] under the Board's decision, [a primarily geographically deceptively misdescriptive mark] has a different meaning under Section 2(f) than under section 2(e)(3). According to applicant, this is because "the Board is reading out the element of

materiality from [primarily geographically deceptively misdescriptive marks] under Section 2(f) by finding a [primarily geographically deceptively misdescriptive mark] registrable under section 2(f) only if the element of materiality is lacking [but] the Board's Decision does not state that it also eliminates the element of materiality from primarily geographically deceptively misdescriptive marks under section 2(e)(3), which prevents the registration of [primarily geographically deceptively misdescriptive marks] that did not become distinctive prior to NAFTA." Applicant consequently maintains that "the effect of the Board's decision is to create two definitions for the same phrase ... in the same section of the same statute." Request p. 10.

The element of materiality is not written in the statute but rather is part of a test developed by case law. In *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), the Court determined that the test to be used under Section 2(e)(3) should include the element of materiality. Our decision interpreting the grandfather clause in section 2(f) does not create an inconsistency; rather it adheres to the Court's test for pre-NAFTA primarily geographically deceptively misdescriptive marks, the marks subject to the grandfather clause, which did not

include a materiality element. In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 867 (Fed. Cir. 1985).

We turn next to applicant's argument regarding the findings of fact concerning the materiality element in the mark. We first note that applicant did not argue the merits of the refusal during examination or on appeal. While, the Board decided not to view that as a concession and considered the refusal on its merits, there is nothing to rebut the prima facie case established by the examining attorney.

Applicant argues that the evidence of record is insufficient to support a prima facie case that Napa Valley is known for mustard or that the origin of mustard in the Napa Valley is material to the purchasing decision. Upon a review of the evidence of record we find no error in the Board's conclusions.

First, we note that applicant did not dispute that NAPA VALLEY is a geographic term and, by seeking registration under Section 2(f), has conceded that the mark as a whole is geographically misdescriptive. Thus, the only element applicant may question at this point is the element of materiality. Applicant particularly notes that the excerpt from a website that states "The beautiful Napa Valley produces some of the finest array of gourmet foods.

We have selected our favorite Napa Valley Mustards for you to enjoy," www.oakvillegrocery.com, is merely routine puffery and not sufficient to make out a prima facie case for materiality. This excerpt does not stand alone but rather must be viewed in the context of all of the evidence of record. Viewing the record as a whole, we find no error in our decision that the examining attorney's conclusion that the geographic term NAPA VALLEY is material to the purchasing decision is supported by the evidence of record and has not been rebutted by applicant.

Further, applicant argues that the Board has made an improper inference of materiality by "merely inferr[ing] materiality in this case based on its allegation that the Napa Valley is known for mustard." The Board did not infer materiality, but rather made a finding that the origin of the Napa Valley is material to the purchasing decision for applicant's goods, namely, mustard. See Decision p. 15 "...we find that NAPA VALLEY is a well known geographic location and that it is also sufficiently known for mustard and other gourmet items for such location to be a material factor in the purchasing decision." See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive for the goods

identical to Venetian products and to those related to such products based on atlas and gazetteer excerpts showing that Venice was a well known center for the manufacture of glass, lace, etc.).¹

The purpose of reconsideration is to point out errors made by the Board in reaching its decision. The basis for the finding that the involved mark is geographically deceptive is clearly articulated therein and we do not find any error in reaching that finding. In view thereof, applicant's request for reconsideration of the Board's decision is denied, and the decision of August 13, 2007 stands.

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¹ In California Innovations, the Court noted that "[a]lthough the court in Save Venice did not expressly address the materiality issue, because it was not officially recognized in this context, the court emphasized that 'all of the applicant's goods are associated with traditional Venetian products'," and thus "the record in Save Venice satisfies the test for deception." California Innovations, supra at 1857.