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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77681936
Applicant	Oliver Wine Co., Inc.
Correspondence Address	CLIFFORD W. BROWNING KRIEG DEVAULT LLP 1 INDIANA SQ STE 2800 INDIANAPOLIS, IN 46204-2017 UNITED STATES cbrowning@kdlegal.com
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Filer's Name	Clifford W. Browning
Filer's e-mail	cbrowning@kdlegal.com
Signature	/cwb/
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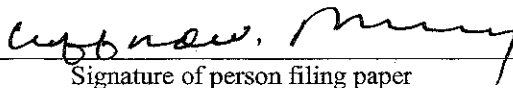
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re trademark registration)	Law Office: 114
application of: Oliver Wine Co., Inc.)	
)	
Serial No. 77/681,936)	Examining Attorney:
)	Shaila E. Settles
)	
Filed: March 3, 2009)	
)	
Mark: AMERICAN HERITAGE)	September 20, 2010

APPLICANT'S EX PARTE APPEAL BRIEF

Electronic Filing Certificate 37 C.F.R. §2.126(c)

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Signature of person filing paper

CITED CASES

In re Budge Manufacturing Company, Inc., 857 F.2d 773, 777, 8 U.S.P.Q. 2d 1259, 1262 (Fed. Cir. 1988) 4

Hamilton-Brown Shoe Company v. Wolf Brothers & Company, 240 U.S. 251, 60, L. Ed. 629, 36 S. Ct. 269 (1916) 6

Wilco Company v. Automatic Radio Manufacturing Company, 255 F. Supp. 625, 151 U.S.P.Q. 24 (D. Mass. 1966) 6

American Plan Corp. v. State Loan & Finance Corp., 365 F. 2d 635, 150 U.S.P.Q. 767 (3d Cir. 1966), cert. denied, 385 U.S. 1011, 17 L. Ed. 2d 548, 87 S. Ct. 719, 152 U.S.P.Q. 844 (1967) 6

Tisch Hotels, Inc. v. Americana Inn, Inc., 350 F. 2d 609, 146 US.P.Q. 566 (7th Cir. 1965) 6

ARGUMENTS

1. Deceptiveness

In the Final Office Action issued January 20, 2010, Examining Attorney Shaila E. Settles refused registration of the mark AMERICAN HERITAGE for "wines" under Section 2(a) of the U.S. Trademark Act, based upon the Examining Attorney's inexplicable belief that the mark AMERICAN HERITAGE, as applied to wines, consists of or includes deceptive matter. The Examiner's Section 2(a) rejection is based upon a tortuous line of reasoning founded upon a 1/2 inch stack of "evidence" that the Examining Attorney downloaded from the Internet, all of which dealt only with the single word HERITAGE, and not the mark of the present application, which is AMERICAN HERITAGE. *See* the Office Action mailed October 21, 2009.

The U.S. Examining Attorney's argument under Section 2(a) is summed up in the following paragraph taken directly from page 2 of her Office Action mailed October 21, 2009:

“Applicant stated in its June 11, 2009, Response to Office action that ‘AMERICAN HERITAGE appearing in the mark has no significance in a relevant trade or industry or is applied to the goods/services listed in the application, or any geographical significance.’ (June 11, 2009, Response to Office action at 1.). Therefore, Applicant's wines are not composed of heritage grapes or heritage grape seeds.”

The U.S. Court of Appeals for the Federal Circuit has set out a three-part test to determine Section 2(a) deceptiveness: (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods? (3) If so, is the misdescription

likely to affect the decision to purchase? *In re Budge Manufacturing Company*, 857 F.2d 773, 8 USPQ 2d 1259 (Fed. Cir. 1988). The U.S. Examining Attorney has wholly failed to make out a *prima facie* on any element of this three-part test.

Taking the Federal Circuit's first element of its three-part test for deceptiveness, is the term AMERICAN HERITAGE misdescriptive of the character, quality, function, composition or use of the wines it identifies? Clearly no wine consumer would believe that Applicant's AMERICAN HERITAGE brand wines are made from "heritage grape seeds," as the Examining Attorney argues. The Examining Attorney obviously has no appreciation for how wines are made. It is common knowledge that grapes for making wines are not grown from seeds, and such a suggestion is factually incorrect. Furthermore, it is common knowledge that most if not all grapes that are grown for wine making in the United States are harvested from grape vines that are decades old, and that most if not all of the grape vines in the United States have been generated from cuttings taken from established grape vines many decades earlier. Therefore, the Examining Attorney's principal argument that Applicant's mark is misdescriptive because Applicant's wines are not composed of "heritage" grapes is also factually incorrect. Furthermore, the mark of the present application is not HERITAGE, but AMERICAN HERITAGE, which mark the Examining Attorney has wholly failed to establish factually is in any way misdescriptive of any character, quality, function, composition or use of the Applicant's AMERICAN HERITAGE brand wines.

Since the Examining Attorney wholly failed to make a *prima facie* case of misdescription, her Section 2(a) based refusal to register AMERICAN HERITAGE fails the *In re Budge* test, and her refusal to register AMERICAN HERITAGE for wines under Section 2(a) must be reversed.

2. Descriptiveness

In the Final Office Action issued January 20, 2010, Examining Attorney Settles also refused registration of the mark AMERICAN HERITAGE for wines under Section 2(e)(1), based upon the Examining Attorney's factually unsupported belief that the mark AMERICAN HERITAGE merely describes a feature, ingredient, and/or characteristic of the Applicant's wines. The same factual reasoning set forth in section **1. Deceptiveness**, above, applies here, as well, and therefore here also the Examining Attorney has wholly failed to state factually how the mark AMERICAN HERITAGE applied to wines immediately describes an ingredient, quality, characteristic, function, feature, purpose or use of the Applicant's wines.

The opposite conclusion is also supported by the fact that there are nearly sixty (60) registered marks on the Principal Register of the U.S. Trademark Office that include the terms AMERICAN and HERITAGE, including the following six (6), none of which were denied registration under Sections 2(a) or 2(e)(1) of the U.S. Trademark Act, even though each would have fallen victim to the Examining Attorney's reasoning set forth in her Final Office Action issued in this case:

AMERICAN HERITAGE for "agricultural seeds, namely, grass seeds, forage seeds, vegetable seeds, fruit seeds, field crop seeds, tree seeds, and flower seeds," U.S. Registration No. 2,719,925.

AMERICAN HERITAGE for "processed cheese, natural cheese, and cream cheese," of U.S. Registration No. 3,070,751.

AMERICAN HERITAGE for "food products, namely canned and frozen vegetables, sold in commercial and institutional trade channels," of U.S. Registration No. 1,640,626.

AMERICAN HERITAGE for "wood chips and wood pellets for use as fuel; wood shavings packaged for use as a fire starter in fireplaces, grills and campfires; and fireplace logs," of U.S. Registration No. 2,769,303.

AMERICAN HERITAGE for "synthetic fiber fabrics; textile fabrics for home and commercial exteriors; fabrics for use in the manufacturing of awnings and outdoor shelters," of U.S. Registration No. 3,406,289.

AMERICAN HERITAGE FOODS for "chicken," of U.S. Registration No. 3,283,735.

As for the Examining Attorney's suggestion that the word AMERICAN in Applicant's mark is geographically descriptive, the contrary conclusion is supported by *McCarthy on Trademarks and Unfair Competition*,

"American" Composite Marks. One of the most-used marks appears to be AMERICAN. On the whole, courts have held that the addition or variation of any element of AMERICAN, no matter how slight, will remove it from the geographically descriptive category for American-based sellers. For example, AMERICAN GIRL shoes [*Hamilton-Brown Shoe Company v. Wolf Brothers & Company*, 240 U.S. 251, 60, L. Ed. 629, 36 S. Ct. 269 (1916)], ALL AMERICAN on radios [*Wilco Company v. Automatic Radio Manufacturing Company*, 255 F. Supp. 625, 151 U.S.P.Q. 24 (D. Mass. 1966)], AMERICAN PLAN CORPORATION for insurance services [*American Plan Corp. v. State Loan & Finance Corp.*, 365 F. 2d 635, 150 U.S.P.Q. 767 (3d Cir. 1966), cert. denied, 385 U.S. 1011, 17 L. Ed. 2d 548, 87 S. Ct. 719, 152 U.S.P.Q. 844 (1967) (no secondary meaning required for protection)] and AMERICANA for hotel services [*Tisch Hotels, Inc. v. Americana Inn, Inc.*, 350 F.2d 609, 146 US.P.Q. 566 (7th Cir. 1965) (held arbitrary and a strong

mark)], were held arbitrary uses. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:11 at pp. 14-49 to 14-50 (4th Ed. 2009)(footnote number omitted, and footnoted cases have been inserted).

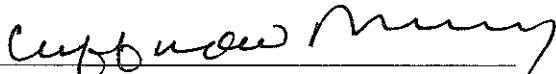
This “AMERICAN” composite mark principal quoted from *McCarthy* helps explain why the six existing Registrations of marks containing AMERICAN HERITAGE cited above have been granted by the U.S. Trademark Office. It also provides further support for Applicant’s registration of the mark AMERICAN HERITAGE for wines, for Applicant’s the use of AMERICAN HERITAGE on wines is also an arbitrary usage of AMERICAN. It should also be noted in the record that the Applicant has already disclaimed the exclusive right to use HERITAGE separate and apart from the mark as a whole.

Since the Examining Attorney wholly failed to make a *prima facie* case of mere descriptiveness of AMERICAN HERITAGE for wines, her Section 2(e)(1) based refusal to register AMERICAN HERITAGE for wines must also be reversed.

CONCLUSION

For all of these foregoing reasons, Applicant respectfully requests the reversal of the of the Examining Attorney’s Section 2(a) and 2(e)(1) refusals to register Applicant’s mark AMERICAN HERITAGE for wines.

Respectfully submitted,

By: 
Clifford W. Browning
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204
(317) 238-6203