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HERITAGE - OWCO-27 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77681936

MARK: AMERICAN HERITAGE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Oliver Wine Co., Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

OWCO-27

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the following refusals issued by the examining attorney:

- (1) a Trademark Act Section 2(a) Deceptiveness refusal; and (2) a Trademark Act Section 2(e)(1) refusal based on the proposed mark being Merely Descriptive.

FACTS

On March 3, 2009, Applicant, Oliver Wine Co., Inc., filed on the Principal Register under Section 1(b) an application to register the proposed mark "AMERICAN HERITAGE" in standard character form for "Wines."

On May 27, 2009, a refusal under Trademark Act Section 2(e)(1) was issued, 15 U.S.C. §1052(e)(1), on the ground that the proposed mark merely describes an ingredient of applicant's identified goods. In addition to the Section 2(e)(1) refusal, a requirement

for a statement regarding the significance of the wording in the mark was issued, requesting, pursuant to 37 C.F.R. §2.61(b), that applicant explain whether “AMERICAN HERITAGE” or “HERITAGE” has any meaning or significance in the industry in which the goods are manufactured/provided, or if such wording is a “term of art” within applicant’s industry.

On June 11, 2009, applicant filed a Response to Office Action arguing against the Section 2(e)(1) refusal. In addition, applicant entered a disclaimer of the word “HERITAGE” and entered the following statement in response to the requirement for a statement regarding the significance of the mark: “AMERICAN HERITAGE appearing in the mark has no significance in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance.”

On July 9, 2009, the examining attorney issued a new refusal under Trademark Act Section 2(a) on the ground that the applied-for mark consists of or includes deceptive matter in relation to the identified goods. Additionally, the Trademark Act Section 2(e)(1) refusal was maintained and continued as an alternative refusal.

On September 30, 2009, applicant filed a second Response to Office Action, arguing against the Section 2(a) refusal and renewing its arguments against the Section 2(e)(1) refusal. Applicant also restated its disclaimer of the word “HERITAGE.”

On October 21, 2009, a Final Office Action was issued by the examining attorney for the Section 2(a) and Section 2(e)(1) refusals.

On December 30, 2009, applicant filed a Request for Reconsideration after Final Action, arguing against the Section 2(a) and 2(e)(1) refusals.

On January 20, 2010, the examining attorney issued a denial of the request for reconsideration.

The present appeal followed.

ISSUES

1. Whether the proposed mark “AMERICAN HERITAGE” consists of or includes deceptive matter in relation to the identified goods pursuant to Trademark Act Section 2(a), 15 U.S.C. §1052(a).
2. Alternatively, whether the proposed mark “AMERICAN HERITAGE” is merely descriptive in relation to the identified goods pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

ARGUMENT

I. THE PROPOSED MARK CONSISTS OF OR INCLUDES DECEPTIVE MATTER IN RELATION TO THE IDENTIFIED GOODS.

The Trademark Act Section 2(a) refusal should be affirmed because the proposed mark consists of or includes deceptive matter in relation to the identified goods.

Section 2(a) of the Trademark Act provides: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused

registration on the principal register on account of its nature unless it--(a) Consists of or comprises . . . deceptive . . . matter” 15 U.S.C. §1052(a). A mark is deceptive if the following criteria are met: (1) the applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods and/or services, (2) prospective purchasers are likely to believe that the misdescription actually describes the goods and/or services, and (3) the misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase the goods and/or services. *See In re Budge Mfg. Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1010 (TTAB 2006); TMEP §1203.02(b); *see also In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1353, 1356, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a “significant portion of the relevant consumers be deceived”).

A. The applied-for mark consists of or contains a term that misdescribes the character, quality, or composition of the goods.

The applicant’s proposed mark includes the word “HERITAGE,” which indicates to consumers that the identified wines are derived from “heritage” grapes. According to numerous websites made of record in this case, the word “HERITAGE” is a generic term-of-art in the wine and agricultural industries that refers to grapes, and wines made from grapes, that have been passed down from previous generations for at least 50 years. The following excerpts from the evidence of record demonstrate that “HERITAGE” is a generic term-of-art when used in the wine and agricultural industries:

- **U.S. Department of Agriculture’s** *Vegetables and Fruits: A Guide to Heirloom Varieties and Community-Based Stewardship*, Volumes 1-3, published in September 1988: “Most people agree that heirloom vegetables and fruits are those types known through historical documentation or folk history for at least 50 years.” The article further states: “For the purposes of this publication, the term ‘heirloom’ is used broadly and synonymously with such terms as traditional, vintage, antique, *heritage*, or classic, since each of these terms conveys the age and perceived value of heirlooms, **but says little about who grows them**” (Page 24 of October 21, 2009, Office Action) (emphasis supplied)
- **California Wine and Food:** Web article entitled *Heritage Grapes Harvested From Experimental Vineyard in Oakville*: “Zinfandel grapes from the one-acre Heritage Vineyard within UC Davis’ Experimental Station in Oakville in the Napa Valley were harvested on September 11th . . . Zinfandel has an important role in American cultural history as well as American viticulture. It is the only wine grape varietal considered unique to the U.S. by the federal government . . . From the 1860s to the early 1990s it was the most widely planted varietal in California; this is why Zinfandel is called ‘America’s heritage grape’ . . . The Heritage Vineyard is an unusual and unprecedented collection of Zinfandel selections from historic vines averaging over 80 years of age planted in vineyards all over California.” (Page 3 of October 21, 2009, Office Action) (emphasis supplied)

- **Wine Business Monthly:** Web article entitled *Send in the Clones*: “The Zinfandel Heritage Clone project involved finding, then selecting from among hundreds of old clones, and planting and growing them side-by-side for eventual analysis and comparison. Then the project makes wine from the heritage grapes.” The article goes on to state: “Another aspect of the Heritage Clone Vineyard concept is history. ‘This is kind of like genealogy,’ said Patty Bogle. ‘And it’s a historical preservation project.’” (Page 2 of October 21, 2009, Office Action) (emphasis supplied)
- **UC Davis website page** entitled *News & Information* (discussing the work of Dr. James Wolpert who oversees the Zinfandel Heritage Vineyard): “James Wolpert is a Cooperative Extension viticulture specialist in the Department of Viticulture and Enology . . . Over the past decade, Wolpert and colleagues have identified and collected selections of zinfandel grapevines from old vineyards, many dating back to the end of the 19th century or early 20th century. The project, carried out in partnership with the Zinfandel Advocates and Producers, is intended to conserve potentially valuable zinfandel selections that are at risk of being removed so the grower can plant newer, more productive vineyards.” (Page 10 of October 21, 2009, Office Action)
- **Russian River Valley Winegrowers website:** “Zinfandel – This heritage grape is widely planted throughout California. In the Russian River Valley, new Zinfandel plantings have joined vines planted as early as the late 1800s.” (Page 4 of October 21, 2009, Office Action)

- **Sweetwater Cellars website:** “Sparkling Rosé Grape Juice, Kedem Winery . . . The Rosé blends Vincent grapes with two American heritage grapes – Niagara and Concord.” (Page 5 of October 21, 2009, Office Action) (emphasis supplied)
- **National Women’s Wine Competition Top Results & Facts:** “NWWC judges awarded medals to outstanding examples of the ‘usual’ suspects . . . plus more unusual varieties such as Aglianico, Albarino, Semillion, Carignane, Vignoles; [and] American heritage grapes such as Catawba and Norton” (Page 6 of October 21, 2009, Office Action) (emphasis supplied)
- **JancisRobinson.com website article written by Pennsylvania state viticulturist Mark Chien:** “If you are worried about the future of varietal diversity visit Vynecrest Vineyards in Pennsylvania, Chrysalis Vineyard in Virginia or Jewell Towne Vineyard in New Hampshire . . . And why not use a heritage table grape called Alden to make a wonderful fresh, crisp and delicious, light-bodied red wine? At Chrysalis Vineyards Jennifer McCloud is on a mission to make Norton, a red grape from *Vitis aestivalis*, the signature American grape since Zinfandel’s true origin has been revealed.” (Page 7 of October 21, 2009, Office Action)
- **The Prodigal Borough:** Web article entitled *Verrazano Vineyard? The Only Vineyard in New York City is Underway* (the article re-prints the full text of a New York Times article on the subject): “[I]n the not-too-distant future, Staten Island will bring a little bit of Tuscany to New York, in the

form of a vineyard being developed at the Staten Island Botanical Garden . . . The wine is also expected to incorporate the kind of heritage grape varieties that would have been known in colonial times. ‘After all, George Washington wasn’t importing wines from Tuscany,’ Mr. Lee said. ‘I’m not sure how it will taste, but we want to reproduce it.’ The interest in heritage grape varieties is one reason the Staten Island delegation came to this part of Tuscany, to meet with Piergiorgio Castellani, a winemaker trying to save indigenous local grape varieties from extinction.” (Page 8 of October 21, 2009, Office Action)

- **Olympic Peninsula Wineries website:** “Lemberger: Washington’s ‘Heritage Grape’ - The Lemberger grape is rooted in Washington wine industry history. For more than a quarter century this vigorous grape . . . has thrived in vineyards east of the Cascade Mountain range.” (Page 11 of October 21, 2009, Office Action)
- **Winescout.info website:** “Heritage Wine – All selected wines in this web site are very good . . . however some wines have an extra value to me. They are uniquely related to their vineyard and region. They express their provenance in their character very strongly and contribute highly to the mind boggling myriad of aromas and tastes the wine world has to offer mankind and that makes wines so fascinating and interesting. These distinctive wines are marked as **Heritage Wine**. They are a precious part of our world’s heritage of tastes.” (Page 17 of October 21, 2009, Office Action)

These excerpts, which serve only as a representative sample of evidence available on the Internet, show winemakers, wine experts, and the general wine consuming public using the term “HERITAGE” as a term-of-art that refers to grape varieties and wines derived from grape varieties that are unique to their region and have been preserved for at least 50 years from earlier periods in history.

In making the following statement, applicant admitted in its June 11, 2009, Response to Office Action, that its wines do not contain heritage grapes: “AMERICAN HERITAGE appearing in the mark has no significance in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance.” (June 11, 2009, Response to Office Action at 1.) This statement was made in response to the following inquiry made by the examining attorney: “Applicant must explain whether “AMERICAN HERITAGE” or “HERITAGE” has any meaning or significance in the industry in which the goods are manufactured/provided, or if such wording is a “term of art” within applicant’s industry.” (May 27, 2009, Office Action at 1.) (emphasis supplied) By saying that “AMERICAN HERITAGE” has no significance in the relevant industry or any geographical significance, applicant is essentially stating that its wines are not derived from heritage grape varieties from America. Therefore, use of the term “HERITAGE” in the mark misdescribes the character, quality, and/or composition of the goods, and a disclaimer of the term does not remedy the misdescription. TMEP §1203.02 (“Neither a disclaimer of the deceptive matter nor a claim that it has acquired distinctiveness under §2(f) can obviate a refusal under §2(a) on the ground that the mark consists of or comprises deceptive matter.”); *See American*

Speech-Language-Hearing Ass'n v. National Hearing Aid Society, 224 USPQ 798, 808 (TTAB 1984); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975).

Applicant argues that “[t]he Examiner’s Section 2(a) rejection is based upon a tortuous line of reasoning founded upon a ½ 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.” (Appeal Brief at 4.) Section 2(a) of the Trademark Act prohibits registration of a trademark that “[c]onsists of or comprises . . . deceptive . . . matter” 15 U.S.C. §1052(a). (emphasis supplied) It is not necessary that the entire mark be shown to be deceptive. *See American Speech-Language-Hearing Ass’n v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984). Rather, “[a] deceptive mark may be comprised of: (1) a single deceptive term; (2) a deceptive term embedded in a composite mark that includes additional non-deceptive wording and/or design elements; (3) a term or a portion of a term that alludes to a deceptive quality, characteristic, function, composition, or use” TMEP §1203(a). (citations omitted)

Applicant also argues that “no wine consumer would believe that Applicant’s AMERICAN HERITAGE brand wines are made from ‘heritage grape seeds,’ as the Examining Attorney argues.” (Appeal Brief at 4.) However, applicant has introduced no evidence to support the assertion that wine consumer would not believe that either AMERICAN HERITAGE or HERITAGE refers to the origin and type of grapes or seeds used to make the identified wine. On the other hand, there is substantial evidence of record showing that “HERITAGE” is a term-of-art that is used to refer to a particular quality of seeds and grapes, namely, seeds and grapes that have been passed down for

many generations and which preserve the genetic diversity of the seed and/or grape varietal. To that end, there is also no evidence of record to support applicant's factual assertion that "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." (Appeal Brief at 4.) Not only has this "common knowledge" not been supported by evidence, but the evidence of record actually warrants the opposite conclusion, which is that grapes passed down for at least 50 years are unique and endangered. Therefore, since applicant's proposed mark uses, or will use, the word "HERITAGE" on wines that do not contain heritage grapes, the proposed mark misdescribes the character, quality, and composition of the wines.

B. Prospective purchasers are likely to believe that the misdescription actually describes the goods.

Prospective purchasers are likely to believe that the misdescription actually describes the goods because "HERITAGE" is a term-of-art widely used by the federal government, winemakers, wine experts, and the wine consuming public to refer to specific grape varieties and wines derived therefrom.

As previously stated, the evidence from the United States Department of Agriculture specifically states that the term "HERITAGE" conveys the age and perceived value of the particular fruits and vegetables "but says little about who grows them". (Page 24 of October 21, 2009, Office Action.) (emphasis supplied) The evidence from the Winescout.info website states that wines uniquely related to their vineyard and

region are marked as “Heritage Wine.” (Page 17 of October 21, 2009, Office Action.) (emphasis supplied) The evidence from the Sweetwater Cellars website shows this entity offering for sale a rosé made from Vincent grapes and “two American heritage grapes – Niagara and Concord.” (Page 5 of October 21, 2009, Office Action) (emphasis supplied) The evidence from The Prodigal Borough website, discussing the new Verrazano Vineyard in Staten Island, New York, states that “[t]he wine is also expected to incorporate the kind of **heritage grape varieties** that would have been known in colonial times.” (Page 8 of October 21, 2009, Office Action) (emphasis supplied) This evidence, all of which is taken from Internet sites directed to and accessible by the wine consuming public, shows the term “HERITAGE” used in a generic context to refer to a type, quality, and age of grape varietal. This particular use of the term occurs throughout the United States, from Washington State to California to New York and Pennsylvania.

A consumer viewing the word “HERITAGE” or the combined words “AMERICAN HERITAGE” on a wine label is likely to believe that the wine is derived from heritage grape varietals, particularly heritage grape varietals from America. The evidence from EncycloWine indicates that “[w]ine labels are important sources of information for consumers. The label is often the only resource a buyer has for evaluating the wine before purchasing it . . . Virtually all New World wines are labeled by grape variety and geographical origin.” (Page 40 of October 21, 2009, Office Action). Further, the excerpt from Wiley InterScience research article entitled *Assessing Consumer Response to Protected Geographical Identification Labeling* states that “[c]onsumers’ attitudes toward quality and desire for cultural identification have generated a growing demand for agricultural products that carry a strong identification with a particular

geographic region.” (Page 38 of October 21, 2009, Office Action) Lastly, the article from eHow on *How to Choose a Bottle of Red Wine* advises consumers to “[s]tart by learning to choose a wine based on your tastes, possible food pairings or a particular wine region or varietal you’d like to explore.” (Page 32 of October 21, 2009, Office Action)

Given that wine consumers are exposed nationwide through web articles, product labels, and advertisements to the use of the term “HERITAGE” as a wine industry term-of-art referring to the age and quality of a grape varietal, and since that term-of-art will be used on applicant’s wine labels as indicated in applicant’s December 30, 2009, Request for Reconsideration, consumers are likely to believe that “HERITAGE” describes the grape varietal from which the wine is derived.

C. The misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase the goods.

The misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase the goods because the term “HERITAGE” would cause a wine consumer seeking to purchase a wine derived from heritage grapes to believe that applicant’s wine contains such grapes.

The relevant consumer in this case is the wine consumer, which includes wine experts, sophisticated non-expert wine drinkers, and casual non-expert wine drinkers. The evidence of record includes wine experts discussing the fact that they purchase and consume wine and articles discussing the preferences of sophisticated and casual wine drinkers.

The use of the term “HERITAGE” on applicant’s wines would affect a significant portion of wine consumers’ decision to purchase the wine because the term “HERITAGE” would communicate to consumers that applicant’s wines are derived from a particular age and quality of grape, namely, “heritage” grapes. The previously discussed evidence indicates that heritage grapes are carefully cultivated, require significant inquiry and research in order to determine whether a grape is truly a “heritage” grape, and importantly, they preserve the genetic diversity of the wine grape varietal and are unique to their geographic region. The evidence also demonstrates that heritage grapes serve the important purpose of preserving the cultural history of the region where the grapes are grown. For instance, the Internet article from the ZAP website entitled *Vineyard Probing Roots of Zinfandel* by Carol Emert discusses the fact that members of the Zinfandel Advocates and Producers organization gather each January to celebrate Zinfandel wine and have an “almost patriotic fervor for the grape” because it is seen as America’s Heritage grape. (Page 12 of October 21, 2009, Office Action)

Additionally, the Winescout.info web article discusses the fact that “[y]ou will find . . . top wines singled out as ‘Heritage Wine.’” (Page 17 of October 21, 2009, Office Action.)

A wine consumers’ decision to purchase wine is often predicated on information on the wine label regarding the grape varietal and the origin of the grape, as the following excerpt from EncycloWine points out: “Wine labels are important sources of information for consumers. The label is often the only resource a buyer has for evaluating the wine before purchasing it . . . Virtually all New World wines are labeled by grape variety and geographical origin.” (Page 40 of October 21, 2009, Office Action). Further, the article from eHow on *How to Choose a Bottle of Red Wine* advises consumers to “[s]tart by

learning to *choose a wine based on* your tastes, possible food pairings or *a particular wine region or varietal you'd like to explore.*" (Page 32 of October 21, 2009, Office Action) Lastly, the abstract from the Wiley InterScience research article entitled *Assessing Consumer Response to Protected Geographical Identification Labeling* states that "[c]onsumers' attitudes toward quality and desire for cultural identification have generated a growing demand for agricultural products that carry a strong identification with a particular geographic region." (Page 38 of October 21, 2009, Office Action)

The evidence of record demonstrates that "HERITAGE" is a term-of-art used nationwide by the wine consuming public to describe the age and quality of grapes and wines derived from those grapes. Since applicant intends to use this term on wines that are not derived from "heritage" grapes, the proposed mark would deceive a significant portion of the relevant consumers. Accordingly, registration should be refused pursuant to Trademark Act Section 2(a).

II. THE PROPOSED MARK IS MERELY DESCRIPTIVE IN RELATION TO THE IDENTIFIED GOODS.

Alternatively, the refusal of registration pursuant to Trademark Act Section 2(e)(1) should be affirmed because the proposed mark is merely descriptive of the goods.

Section 1052(e)(1) of Title 15 of the United States Code prohibits registration of a mark that "when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of" such goods. 15 U.S.C. §1052(e)(1). A mark is merely descriptive if it describes an ingredient, quality, characteristic, function,

feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant seeks registration of the wording “AMERICAN HERITAGE” for wines. However, the wording “AMERICAN HERITAGE” merely describes a feature, ingredient, and/or characteristic of the identified wines because it descriptively conveys that the grapes used to make the wine originate in America and are “heritage” grapes. Alternatively, it descriptively conveys that the seeds from which the grapes were grown were “heritage” grape seeds from America.

A. The word “AMERICAN” is descriptive of the geographic origin of the grapes and/or wine.

The word “AMERICAN” describes the geographic location from which the wines and/or grapes emanate. *See, e.g., In re The Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (holding AMERICA’S FRESHEST ICE CREAM incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (holding AMERICA’S BEST POPCORN! and AMERICA’S FAVORITE POPCORN! merely descriptive); *Kotzin v. Levi Strauss & Co.*, 111 USPQ 161 (Comm’r Pats. 1956) (holding AMERICA’S FINEST JEANS and AMERICA’S FINEST for overalls incapable). If the word AMERICAN in the mark primarily identifies the United States as the origin of the goods and/or services, then it is primarily geographically descriptive. *Am. Diabetes Ass’n, Inc. v. Nat’l Diabetes Ass’n*, 533 F. Supp. 16, 214 USPQ 231 (E.D. Pa. 1981), *aff’d*, 681 F.2d 804 (3d Cir. 1982); *In re Monograms Am., Inc.*, 51 USPQ2d 1317 (TTAB 1999); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986); TMEP §1210.02(b)(iv).

The website article from California Wine and Food entitled *Heritage Grapes Harvested From Experimental Vineyard in Oakville* refers to zinfandel grapes as “America’s heritage grape” because it was thought to have originated in America and “has an important role in American cultural history as well as American viticulture.” (Page 3 of October 21, 2009, Office Action) Similarly, the evidence from Sweetwater Cellars shows the wording “AMERICAN HERITAGE” being used to refer to two types of grapes. (Page 5 of October 21, 2009, Office Action) The evidence from the National Women’s Wine Competition shows the wording “AMERICAN HERITAGE” being used to refer to a type of grape varietal. (Page 6 of October 21, 2009, Office Action) In each

case, the word “AMERICAN” is used to refer to the geographic origin of the grapes used to make the wine.

The geographic origin of grapes is extremely important in wine selection, as the evidence from eHOW (*Page 27 of the October 21, 2009, Office Action*) and EncycloWine (*Page 35 of the October 21, 2009, Office Action*) points out. This makes it highly likely that consumers will view the word “AMERICAN” as referring to the geographic origin of the wine and the geographic origin of the grapes used to make the wine. Moreover, since applicant is based in the United States, as evidenced by the trademark application for Serial No. 77/681,936, this conclusion is even more likely.

As in the *Monograms America* case, applicant has introduced no evidence, other than potential connotations for the term AMERICAN, to support the conclusion that “AMERICAN” has a meaning other than geographic origin. *Monograms Am., Inc.*, 51 USPQ2d 1317 (“The word AMERICA is obviously well known to the United States public as the name of a geographic location . . . [A]pplicant has produced no evidence of other potential connotations for the term AMERICA standing alone. Thus, we have no reasonable basis for holding that AMERICA . . . is capable of any other interpretation.”) Applicant has listed a small number of third-party registrations in its brief, arguing that because these marks were permitted to register, applicant’s mark should also register. However, these registrations do not present an alternative connotation for the word “AMERICAN” *in applicant’s mark*, and, importantly, they should not be considered because applicant did not properly make the registrations of record. “The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record.” TMEP

§710.03 (citing *In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).) “To make registrations of record, soft copies of the registrations or the electronic equivalent thereof (i.e., printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted.” TMEP §1207.01(d)(iii) (citing *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983)).

Even if the Board were to consider applicant’s third party registrations, the information, on its face as presented in applicant’s brief and in the Response to Office Action, does not indicate whether the word “AMERICAN” was disclaimed or whether the marks were registered on the Principal Register under Section 2(f), leaving applicant’s assertions with respect to these registrations unfounded.

Further, third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. An applied-for mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

Therefore, because “[t]he word AMERICA is obviously well known to the United States public as the name of a geographic location,” *Monograms Am., Inc.*, 51 USPQ2d 1317, and the use of the term “AMERICAN” on wine packaging is likely to cause consumers to believe that the term refers to the geographic origin of the grapes, the word

“AMERICAN” should be deemed descriptive, particularly since there is no evidence of record to contradict such a conclusion.

B. The word “HERITAGE” is a descriptive, and likely generic, term-of-art in the wine and agricultural industries, as it refers to a type of grape varietal and a type of wine.

The word “HERITAGE” is a term-of-art in the wine and agricultural industries that refers to the type and quality of grape. As the U.S. Department of Agriculture points out in its publication entitled *Vegetables and Fruits: A Guide to Heirloom Varieties and Community-Based Stewardship*, Volumes 1-3, published in September 1988: “Most people agree that heirloom vegetables and *fruits* are those types known through historical documentation or folk history for at least 50 years . . . For the purposes of this publication, the term ‘heirloom’ is used broadly and synonymously with such terms as traditional, vintage, antique, ***heritage***, or classic, since each of these terms conveys the age and perceived value of heirlooms, **but says little about who grows them**” (Page 24 of October 21, 2009, Office Action) (emphasis supplied) The remaining evidence of record, which includes the excerpts below from various website articles, also demonstrates that the word “HERITAGE” is a term-of-art in the wine and agricultural industries:

- **California Wine and Food** web article entitled *Heritage Grapes Harvested From Experimental Vineyard in Oakville*: “Zinfandel grapes from the one-acre Heritage Vineyard within UC Davis’ Experimental Station in Oakville in the Napa Valley were harvested on September 11th . . . Zinfandel has an important role in

American cultural history as well as American viticulture. It is the only wine grape varietal considered unique to the U.S. by the federal government . . . From the 1860s to the early 1990s it was the most widely planted varietal in California; this is why Zinfandel is called ‘America’s heritage grape’ . . . The Heritage Vineyard is an unusual and unprecedented collection of Zinfandel selections from historic vines averaging over 80 years of age planted in vineyards all over California.” (Page 3 of October 21, 2009, Office Action) (emphasis supplied)

- **Wine Business Monthly** web article entitled *Send in the Clones*: “The Zinfandel Heritage Clone project involved finding, then selecting from among hundreds of old clones, and planting and growing them side-by-side for eventual analysis and comparison. Then the project makes wine from the heritage grapes.” The article goes on to state: “Another aspect of the Heritage Clone Vineyard concept is history. ‘This is kind of like genealogy,’ said Patty Bogle. ‘And it’s a historical preservation project.’” (Page 2 of October 21, 2009, Office Action) (emphasis supplied)
- **UC Davis website page entitled *News & Information* (discussing the work of Dr. James Wolpert who oversees the Zinfandel Heritage Vineyard)**: “James Wolpert is a Cooperative Extension viticulture specialist in the Department of Viticulture and Enology . . . Over the past decade, Wolpert and colleagues have identified and collected selections of zinfandel grapevines from old vineyards, many dating back to the end of the 19th century or early 20th century. The project, carried out in partnership with the Zinfandel Advocates and Producers, is intended to conserve potentially valuable zinfandel selections that are at risk of being

removed so the grower can plant newer, more productive vineyards.” (Page 10 of October 21, 2009, Office Action)

- **Russian River Valley Winegrowers website:** “Zinfandel – This heritage grape is widely planted throughout California. In the Russian River Valley, new Zinfandel plantings have joined vines planted as early as the late 1800s.” (Page 4 of October 21, 2009, Office Action)
- **Sweetwater Cellars website:** “Sparkling Rosé Grape Juice, Kedem Winery . . . The Rosé blends Vincent grapes with two American heritage grapes – Niagara and Concord.” (Page 5 of October 21, 2009, Office Action) (emphasis supplied)
- **National Women’s Wine Competition Top Results & Facts:** “NWWC judges awarded medals to outstanding examples of the ‘usual’ suspects . . . plus more unusual varieties such as Aglianico, Albarino, Semillion, Carignane, Vignoles; American heritage grapes such as Catawba and Norton” (Page 6 of October 21, 2009, Office Action) (emphasis supplied)
- **JancisRobinson.com website article written by Pennsylvania state viticulturist Mark Chien:** “If you are worried about the future of varietal diversity visit Vynecrest Vineyards in Pennsylvania, Chrysalis Vineyard in Virginia or Jewell Towne Vineyard in New Hampshire . . . And why not use a heritage table grape called Alden to make a wonderful fresh, crisp and delicious, light-bodied red wine? At Chrysalis Vineyards Jennifer McCloud is on a mission to make Norton, a red grape from *Vitis aestivalis*, the signature American grape since Zinfandel’s true origin has been revealed.” (Page 7 of October 21, 2009, Office Action)

- **The Prodigal Borough website article entitled Verrazano Vineyard? The Only Vineyard in New York City is Underway (the article re-prints the full text of a New York Times article on the subject):** “[I]n the not-too-distant future, Staten Island will bring a little bit of Tuscany to New York, in the form of a vineyard being developed at the Staten Island Botanical Garden . . . The wine is also expected to incorporate the kind of **heritage grape varieties** that would have been known in colonial times. ‘After all, George Washington wasn’t importing wines from Tuscany,’ Mr. Lee said. ‘I’m not sure how it will taste, but we want to reproduce it.’ The interest in heritage grape varieties is one reason the Staten Island delegation came to this part of Tuscany, to meet with Piergiorgio Castellani, a winemaker trying to save indigenous local grape varieties from extinction.” (Page 8 of October 21, 2009, Office Action)
- **Olympic Peninsula Wineries website:** “Lemberger: Washington’s ‘Heritage Grape’ - The Lemberger grape is rooted in Washington wine industry history. For more than a quarter century this vigorous grape . . . has thrived in vineyards east of the Cascade Mountain range.” (Page 11 of October 21, 2009, Office Action)
- **Winescout.info website:** “Heritage Wine – All selected wines in this web site are very good . . . however some wines have an extra value to me. They are uniquely related to their vineyard and region. They express their provenance in their character very strongly and contribute highly to the mind boggling myriad of aroma’s and tastes the wine world has to offer mankind and that makes wines so fascinating and interesting. These distinctive wines are marked as ****Heritage**

Wine**. They are a precious part of our world's heritage of tastes.” (Page 17 of October 21, 2009, Office Action)

These excerpts demonstrate that “HERITAGE” is a generic, term-of-art, which is likely why applicant entered a disclaimer of the term.

C. The individual components of the merely descriptive term “AMERICAN HERITAGE” retain their descriptive meaning in relation to the identified goods.

The combined words “AMERICAN HERITAGE” create a composite mark that is itself descriptive. A mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression”).

In the present case, both the individual components and the composite result are descriptive of applicant's wines and do not create a unique, incongruous or

nondescriptive meaning in relation to the goods. Specifically, the combined words “AMERICAN HERITAGE” are used by wine makers, wine experts, and wine consumers to refer to the geographic origin and type of grape used to make the wine. As discussed previously, the website article from California Wine and Food entitled *Heritage Grapes Harvested From Experimental Vineyard in Oakville* refers to Zinfandel grapes as “America’s heritage grape” because it was thought to have originated in America and “has an important role in American cultural history as well as American viticulture.” (Page 3 of October 21, 2009, Office Action) In the same vein, the evidence from Sweetwater Cellars shows the wording “AMERICAN HERITAGE” being used to refer to two types of grapes. (Page 5 of October 21, 2009, Office Action) The evidence from the National Women’s Wine Competition shows the wording “AMERICAN HERITAGE” being used to refer to a type of grape varietal originating in America. (Page 6 of October 21, 2009, Office Action) In each case, the wording “AMERICAN HERITAGE” is used to refer to the geographic origin of the grapes used to make the wine and the type and quality of the grapes, i.e. grapes from America that have been passed down for at least 50 years.

Because each word in the composite mark retains its descriptive meaning, the mark as a whole is descriptive. Accordingly, the refusal under Section 2(e)(1) should be affirmed.

III. CONCLUSION

For the reasons outlined above and based on the substantial evidence made of record, applicant’s proposed mark “AMERICAN HERITAGE” is deceptive under

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), and should be refused registration. Alternatively, the mark should be refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), because the proposed mark “AMERICAN HERITAGE” merely describes a feature, ingredient, and/or characteristic of the identified wines.

Accordingly, it is respectfully requested that the refusal of registration be affirmed pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a). Alternatively, the refusal of registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), should be affirmed.

Respectfully submitted,

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