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Dated: Nov-23, 2004

Signed Jill K. O'Hara  
Jill K. O'Hara

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trademark application of

Applicant: Meadowood Associates

Serial No.: 78/257,698

Mark: THE NAPA VALLEY RESERVE

Filed: June 3, 2003

Examining Attorney: Esther Borsuk, Law Office 112

11-26-2004

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U.S. Patent & TMO/TM Mail Rcpt Dt. #74

TO THE COMMISSIONER FOR TRADEMARKS:

**REQUEST FOR RECONSIDERATION OF  
FINAL OFFICE ACTION MAILED MAY 26, 2004**

Applicant, Meadowood Associates, hereby submits the following request for reconsideration of the Examining Attorney's Office Action dated May 26, 2003.

**AMENDMENTS**

1. Please amend the application by inserting a claim under Section 2(f) as follows:  
The mark THE NAPA VALLEY RESERVE has become distinctive of the services through the extensive unsolicited media attention the mark and services have received in the popular press.

**REMARKS**

I. **Applicant's Mark Is Distinctive**

In the final refusal, the Examiner maintained the earlier refusal based on descriptiveness on the basis that the term "RESERVE" is generic for the services at issue such that when combined with the geographic term "NAPA VALLEY" and the word "THE," the mark is still merely descriptive of the services. Applicant respectfully disagrees.

The Examiner's conclusion that the term "RESERVE" is generic when used with "retail

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1 store services and retail services by telephone featuring wine and related products at discounted  
2 prices to wine club members" is incorrect. In order to establish that a term is generic, the  
3 Examiner must show: 1) the class of services the Applicant provides; and 2) that the relevant  
4 public understands the designation to primarily refer to that class of services. In re American  
5 Fertility Society, 188 F.3d 1341 (Fed. Cir. 1999). The Examiner has provided no evidence  
6 whatsoever that "reserve" is understood by the relevant public to refer primarily to retail wine  
7 store services. Thus, the Examiner has failed to meet the burden of proving that "RESERVE" is  
8 generic by clear evidence. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 987 (Fed.  
9 Cir. 1987).

10 Indeed, the Examiner has not even provided sufficient evidence to demonstrate that the  
11 term is descriptive of retail wine store services. The Examiner asserts that "RESERVE is generic  
12 for a type of high quality wine." However, as the definition from the Epicurious.com's Wine  
13 Lover's Companion dictionary submitted with Applicant's April 26, 2004 response indicated:  
14 "Even though th[e] term [reserve] is found on U.S. wine labels, it has no legal definition, which  
15 means it can't be relied on to have any special meaning." Thus the term does not even have  
16 descriptive significance when used on wine, as it has no meaning.

17 Accordingly, it is completely unclear how the Examiner can then make a leap of logic to  
18 assert that the term has a descriptive connotation when used, not with wine, but with retail wine  
19 store services. The Examiner fails to even indicate what "RESERVE" describes in relation to  
20 retail wine store services.

21 On the other hand, Applicant has clearly explained that the meaning of THE NAPA  
22 VALLEY RESERVE is the name of its property where the retail wine store services are offered  
23 and has provided evidence to such effect. Enclosed herewith are several media references to  
24 THE NAPA VALLEY RESERVE which clearly evidence that the mark identifies a place.  
25 Indeed, several of the articles refer to Applicant's property as "The Reserve" further evidencing  
26 that the term "reserve" as used in the mark refers to the property, not to laud a wine.

27 It is well settled that Applicant's mark must be looked at as a whole to determine  
28 descriptiveness, rather than dissecting it into its individual elements. Concurrent Technologies

1 Inc. v. Concurrent Technologies Corp., 12 USPQ2d 1054, 1057 (TTAB 1989). While the  
2 Examiner continues to disregard this standard by taking a "divide and conquer" approach, clearly  
3 the mark THE NAPA VALLEY RESERVE, when considered as a whole, especially in the  
4 context of the promotional materials provided to the Examiner with the earlier response and the  
5 media references provided with this request for reconsideration, refers to the name of the  
6 Applicant's property.

7 Had Applicant's mark been THE NAPA VALLEY GROVE or THE NAPA VALLEY  
8 MANOR or THE NAPA VALLEY VILLA, there would be no issue as these different place  
9 nouns are neither descriptive of retail wine store services nor wine. However, because the term  
10 "RESERVE" has the meaning a "reservation of land" and is also used on wine labels as a  
11 laudatory term for wine, the Examiner has taken this term out of the context of the composite  
12 mark and concluded that the term is descriptive, or worse, generic, and therefore that the mark in  
13 its entirety must also be descriptive. This is putting form over substance and ignoring the clear  
14 meaning of the mark as a whole -- the property where Applicant offers its services. Accordingly,  
15 Applicant requests that the Examiner reconsider the final refusal as to inherent distinctiveness of  
16 the mark.

17 **II. Applicant's Mark has Acquired Distinctiveness**

18 While Applicant maintains its position that its mark is inherently distinctive, it has also  
19 added a claim of acquired distinctiveness under Section 2(f). The kind and amount of evidence  
20 necessary to establish that a mark has acquired distinctiveness in relation to services depends on  
21 the nature of the mark and the circumstances surrounding the use of the mark in each case.

22 Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572 (Fed. Cir. 1988).

23 The retail wine store services under the mark THE NAPA VALLEY RESERVE will only  
24 be provided to between 350 and 400 customers at membership fee of \$100,000 per customer,  
25 plus \$1,000 in annual dues and \$45 per bottle for each wine made. Accordingly, for the mark to  
26 have acquired secondary meaning in the minds of the relevant consumers has not taken more  
27 than the unsolicited publicity which Applicant has received since first offering its services.

28 Media references to the services under THE NAPA VALLEY RESERVE mark have

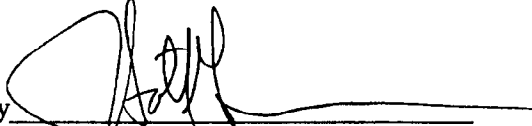
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1 included stories in *The Robb Report*, a well-known luxury living publication, *Luxury Living*,  
2 *Elite Traveler*, *Newsweek*, *7x7 Magazine*, *Papercity*, *Wine Spectator*, *Savor Wine Country*, *San*  
3 *Francisco Business Times*, and on the network MSNBC. Copies of these media references are  
4 attached hereto. As these media stories have obviously reached a wide range of consumers,  
5 specifically those in the luxury market that can afford to be one of the 350 to 400 customers for  
6 the services, the mark obviously has also acquired secondary meaning and distinctiveness  
7 amongst the relevant consumers. Accordingly, the mark should also be registered under Section  
8 2(f).

9 For the foregoing reasons, Applicant respectfully requests that the Examiner reconsider  
10 the final refusal and pass the application through to publication.

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12  
13 Respectfully submitted,

14 OWEN, WICKERSHAM & ERICKSON, P.C.

15  
16 By   
17 J. Scott Gerien

18 Date: November 23, 2004

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