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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICANT: Spirits of New Merced, LLC

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: YOSEMITE BEER

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

This is an appeal from the trademark examining attorney's final refusal to register applicant's mark, YOSEMITE BEER for "alcoholic beer" under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052 (e)(2), on the ground that the mark is primarily geographically descriptive of applicant's goods.

FACTS

On September 12, 2005, applicant filed an application to register the mark YOSEMITE BEER for "alcoholic and non-alcoholic beer, namely, beer, ale, porter, lager, stout, malt liquor, and root and birch beer" based on an intent to use the mark in

commerce. (Applicant later amended the identification on December 4, 2006.) Subsequently, on November 22, 2005, applicant filed an Amendment to Allege Use for the mark. On, April 3, 2006, the examining attorney issued an Office Action raising the issues of a prior pending application, a Section 2(e)(2) refusal for geographic descriptiveness, a requirement for an acceptable specimen, and a requirement to clarify an entity discrepancy. The examining attorney also informed applicant of its option to amend to the Supplemental Register. Applicant resolved the matter of the prior pending application and the procedural issues on May 2, 2006. On June 15, 2006, the examining attorney issued a final Section 2(e)(2) refusal on the ground that the proposed mark is geographically descriptive of applicant's goods. Applicant filed a response to overcome the Section 2(e)(2) refusal on June 16, 2006. Following other submissions to clarify procedural matters relating to the mark's dates of use and to narrow the identification of goods to "alcoholic beer," the applicant subsequently filed a response on December 8, 2006, that included translation statements for the mark from the Miwok and Sierra Miwok Indian languages. On December 13, 2006, applicant submitted further evidence supporting its arguments to overcome the Section 2(e)(2) refusal as part of a request for reconsideration. Following the examining attorney's denial of applicant's request for reconsideration, this appeal resulted.¹

¹ Please note that the applicant has submitted untimely evidence included with their appeal brief. The examining attorney objects to this evidence under TBMP 1207.01 and requests that the Trademark Trial & Appeal Board not consider this untimely filed evidence in making its decision.

ISSUE PRESENTED

The sole issue on appeal is whether YOSEMITE BEER is primarily geographically descriptive of the origin of applicant's goods, within the meaning of Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052 (e)(2).

ARGUMENT

I. Applicable Law for Section 2(e)(2) Refusals

A three-part test is applied to determine whether a mark is primarily geographically descriptive of the goods and/or services within the meaning of Trademark Act Section 2(e)(2):

- (1) the primary significance of the mark is a generally known geographic place or location;
- (2) purchasers would be likely to make a goods-place or services-place association, i.e., purchasers are likely to believe the goods or services originate in the geographic location identified in the mark; and
- (3) the goods and/or services originate in the place identified in the mark.

See In re MCO Properties, Inc., 38 USPQ2d 1154 (TTAB 1995); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); TMEP §1210.01(a).

II. Applicant's mark is Primarily Geographically Descriptive of the Goods

A. The Primary Significance of the Mark is Geographic

A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning. Applicant contends that the wording YOSEMITE by itself does not identify a geographic location, stating that "there is no such place as Yosemite, California," and that "'Yosemite' standing alone does not hold any independent significance, geographic or otherwise." *Please see Applicant's Appeal Brief, page 5.*

On the National Park Service's webpage for Yosemite National Park, there is a clear separation in spacing and font between the large wording "Yosemite" on the page to identify for readers the park being referred to, and the smaller wording "National Park" and "California" located a distance away from the wording "Yosemite." *Please see Final Refusal, 6/15/2006, attached website <http://www.nps.gov/yose/>.* Further down the webpage, under the heading "need info?" visitors to the website may click on a link labeled "Yosemite In Depth" for "comprehensive trip planning information." *Please see id.* On the Wikipedia webpage discussing Yosemite National Park, the park and surrounding region is referred to by the term "Yosemite" by itself throughout the page. *Please see Final Refusal, 6/15/2006, attached website http://en.wikipedia.org/wiki/Yosemite_%28CA%29.* The websites Yosemite.org and Yosemitepark.com and follow that same pattern, as well. *Please see Final Refusal, 6/15/2006, attached websites*

<http://www.yosemitepark.com/content2hdr.fm?SectionID=17&PageID=11> and <http://www.yosemite.org>. Further, a number of the prior registrations attached to the Final Refusal showing disclaimers of the wording Yosemite apart from the mark as shown display an owner address of “Yosemite, California, 95389.” *Please see Final Refusal, 6/15/2006, attached prior registrations, namely, U.S. Registration No. 1882576, YOSEMITE; U.S. Registration No. 2741174, YOSEMITE’S BADGER PASS; U.S. Registration No. 2715307, YOSEMITE NATIONAL PARK; U.S. Registration No. 2715313, YOSEMITE LODGE; and U.S. Registration No. 2797240, THE MOUNTAIN SHOP AT YOSEMITE.*

Applicant also submitted evidence with its March 10, 2006 Response to Office Action supporting the use of the term “Yosemite” by itself as conveying a location. The town of Merced, California, where applicant is located, has official city letterhead (as labeled by applicant), a lodging guide, a destination guide, and an official chamber of commerce map, all of which bear the claim “Gateway to Yosemite.” *Please see named materials attached to applicant’s Response to Office Action, 3/10/2006.* The city of Merced’s website is listed in the Merced Conference & Visitor Bureau as www.yosemite-gateway.org. *Please see applicant’s Response to Office Action, 3/10/2006, listing of local hotels put forth by the Merced Conference and Visitor Bureau.* Applicant also stated in that response that Merced’s official city motto is “Gateway to Yosemite,” and that the information included with the response showed an association of “Merced with Yosemite for more than a century.” All of these materials clearly indicate that the “Yosemite” referred to is Yosemite National Park.

Based on the aforementioned evidence, the use of the term “Yosemite” may be viewed as a commonly used nickname or shorthand to refer to Yosemite National Park. Commonly used nicknames are generally treated as equivalent to the proper geographic name of the place identified. *See, e.g., Texas Farm Prod. v. Lone Star Producing*, 144 USPQ 312 (E.D. Tex. 1964) (LONE STAR symbolizes Texas); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 245 (TTAB 1976) (OLD DOMINION is “the accepted nickname for the State of Virginia”).

Yosemite National Park itself covers an area of 1,189 square miles, has been a national park since 1890, is visited by over three million people each year, and was designated a World Heritage Site in 1984. *Please see Final Refusal, 6/15/2006, attached websites <http://www.nps.gov/yose/> and http://en.wikipedia.org/wiki/Yosemite_%28CA%29.* The term “Yosemite” clearly conveys geographic significance and meaning on its own, even when shown without the additional wording “National Park.”

Applicant also states that the word “Yosemite” has meanings derived from Native American tribal languages, specifically, “those who kill” in the Miwok Indian tribe language and “grizzly bear” in the Sierra Miwok Indian language. *Please see Applicant’s Response to Office Action, December 8, 2006.* The evidence shows that the primary significance of the term “Yosemite” is geographic because of the size and popularity of Yosemite National Park, as discussed above. Additionally, the average American consumer is not familiar with definitions of words derived from Native American tribal languages. The fact that a term may have other meanings in other contexts does not necessarily negate the basis for refusal as long as the most prominent meaning or

significance is geographic for the identified goods and/or services. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986); TMEP §1210.02(b)(i). In this case, the prominent meaning and significance of the term “Yosemite” is geographic.

B. Purchasers are Likely to Make a Goods-Place Association

When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, the goods/place or services/place association will ordinarily be presumed from the fact that the applicant’s goods or services originate in the place named in the mark. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services).

The question, then, of whether a term is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act depends on whether or not the mark identifies the place from which the goods or services originate. Goods may be said to “originate” from a geographic location if they are manufactured, produced or sold there. TMEP §1210.03.

Applicant argues that the purchasing public would not make a goods-place association between its alcoholic beers and Yosemite National Park because the park

does not produce commercial goods or services, and the ingredients of the goods are not grown in or produced in the Park. Applicant does concede that the Park does support commercial enterprises in the form of licensed vendors who provide services to Park visitors.

The previously mentioned prior registrations attached to the Final Refusal disclaiming the wording YOSEMITE, as well as others of the attached prior registrations, required the disclaimer for such goods and services provided by vendors for visitors to the park. Even though these goods and services were not produced directly by the Park or from ingredients grown in the Park, the disclaimer was still required based on the association of these goods and services provided by vendors in and around the Park.

Please see prior registrations attached to the Final Refusal, 6/15/2007.

The goods need not be produced directly within the Park or from ingredients grown in the Park in order to be said to “originate” from there. Applicant’s broad identification of “alcoholic beer” includes no limitations or restrictions on its locations of sale or channels of trade. When an application describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive ... There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold”); TMEP §1207.01(a)(iii). Therefore, applicant’s goods, as identified, are presumed to be

potentially available for purchase at any location providing such goods, including restaurants and establishments immediately surrounding Yosemite National Park.

Applicant also states that the beers being sold under the mark are brewed and sold at its restaurant in Merced, California, which is approximately 80 miles from Yosemite National Park, and due to that distance, it should not be subject to a geographic refusal. However, applicant's statements and submitted evidence showing a direct connection between Merced and Yosemite National Park show that applicant is located in the Yosemite region. This connection is further supported by evidence submitted by applicant with its March 10, 2006 response showing a webpage for YARTS, or the Yosemite Area Regional Transportation System, which includes transportation from Merced to Yosemite National Park. *Please see applicant's evidence attached to Response to Office Action, 3/10/2007, <http://www.yarts.com>.* A term can be considered geographic even when it does not suggest exact geographic boundaries, i.e., if it refers to a "subdivision of the earth – regions, nations, counties, town[s], rivers, lakes, and other natural and artificial geographic units." *Burke-Parsons-Bowlby v. Appalachian Log Homes*, 871 F.2d 590, 594, 10 USPQ2d 1443, 1445 (6th Cir. 1989) (APPALACHIAN found to be a geographic term). Additionally, applicant may expand its number of restaurants, and establish a restaurant directly proximate to Yosemite National Park serving beer under the proposed mark.

Applicant's goods are currently manufactured, produced and sold in the Yosemite regional area, in a location that bills itself as the "Gateway to Yosemite." Applicant's goods may also potentially be sold directly around Yosemite National Park. Therefore, consumers are likely to make a goods-place association.

In establishing a prima facie case for a goods-place association, the examining attorney need only show a “reasonable basis” for concluding that the public would make the goods/place association. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). Thus, the examining attorney need not show that Yosemite National Park or the Yosemite region is known for its production of beer, or that consumers would actually make the association. Rather, where, as here, it has been shown that the primary significance of the mark is geographic and the place is not obscure or remote, it is sufficient to show that the applicant’s goods originate in the area named in the mark. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (if a geographic term in a mark is neither remote nor obscure and the geographic significance is the primary connotation of the term, and where the goods actually or will actually originate from the geographic place designated in the mark, a public association of the goods with the place may ordinarily be presumed.) The remaining question is whether applicant’s goods originate from Yosemite.

C. The Mark Identifies the Geographic Origin of the Goods

Applicant has indicated throughout the application process that it is located in Merced, California, and that Merced is strongly connected to Yosemite National Park. According to materials distributed by Merced’s chamber of commerce, “Merced has claimed the title ‘Gateway to Yosemite’ for more than a century and the Merced Visitors Bureau brings in many of the Yosemite bound visitors.” *Please see applicant’s Response to Office Action, 3/10/2006, informational brochure put forth by The Greater Merced Chamber of Commerce.* Applicant is located in Merced, California, which strongly

identifies itself as providing access to Yosemite and being part of the Yosemite region, and the applicant has stated that its goods come from its Merced, California establishment. Therefore, the record is clear that the applicant is located in the Yosemite regional city of Merced, and that the goods originate from there. Under these circumstances, nothing more need be shown by the examining attorney to establish a goods/place association. See *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986).

D. The Addition of a Generic Term Does Not Obviate the Refusal

The addition of a generic or highly descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. See *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986); *In re Application of Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982); TMEP §1210.02(c)(ii).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).
Generic terms are by definition incapable of indicating a particular source of the goods or

services, and cannot be registered as trademarks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Applicant’s amended identification of goods narrowed the scope of the original identification to the single entry of “alcoholic beer.” The wording BEER in the mark is therefore merely the generic term for the goods and does not obviate the geographic significance of the mark. Applicant has properly disclaimed this generic wording.

E. Applicant Argues Other Instances of Approval for Marks of a Similar Nature

Applicant has argued throughout the application process that its proposed mark bears similarity to a number of other previously registered marks that involve the names of geographic locations, especially national parks or sites within national parks, and were allowed to register on the Principal Register without a disclaimer on the geographic portion or a statement of Section 2(f) acquired distinctiveness.

Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

Each case involving a potential Section 2(e)(2) geographic refusal requires the examining attorney in that case to compare the facts at hand with the appropriate test for

geographic descriptiveness. The fact that other marks including geographic locations in their names have passed this test based on the evidence presented in those cases has no bearing on the current application.

CONCLUSION

The examining attorney has demonstrated that: (a) the primary significance of YOSEMITE is geographic; (b) prospective purchasers are likely to think that applicant's products originate in the Yosemite region; and (c) the mark identifies the geographic origin of applicant's goods. As such, the mark has been shown to be primarily geographically descriptive of the origin of the applicant's goods. Accordingly, the undersigned contends that the refusal to register the mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052 (e)(2) is proper and should be affirmed.

Respectfully submitted,

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