

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Oak Park Brewing Company, Inc.

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Serial No. 86329948

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for Oak Park Brewing Company, Inc.

Brendan McCauley, Trademark Examining Attorney, Law Office 114,
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Before Zervas, Ritchie and Kuczma,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Oak Park Brewing Company, Inc. (“Applicant”) seeks registration on the
Principal Register of the following mark for “beer” in International Class 32:¹

¹ Application Serial No. 86329948 was filed on July 7, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon an allegation of a *bona fide* intention to use the mark in commerce.



The description of the mark entered into the record when Applicant filed its application states,

The mark consists of “oak park” in large stylized lettering above “Brewing Company” in smaller, stylized lettering, above “Sacramento CA” in smaller, stylized lettering; “est. 2013” is in small lettering beneath the “K” of “park” and surrounded by the leg of the letter “R” also in “park.”

Applicant disclaimed all of the wording in the mark in its initial application.

Before discussing the refusal and requirements in this appeal, we provide highlights of the prosecution history.

On May 14, 2015, the Examining Attorney issued an Office Action which made final a refusal to register the mark under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2), on the ground that the mark as a whole is geographically descriptive of a neighborhood in Sacramento, California known as Oak Park. In addition, the Examining Attorney advised that all of the wording in the mark may not be disclaimed and that the terms BREWING COMPANY and EST. 2013 should be disclaimed.

On November 13, 2015, Applicant filed a notice of appeal and a request for reconsideration, in which it sought to amend the drawing as follows:



In addition, Applicant indicated that that it “presently provides goods manufactured, packaged, and shipped from its Sacramento, California location in Oak Park” (in response to the Examining Attorney’s requirement regarding information about the goods) and Applicant also entered the disclaimer “No claim is made to the exclusive right to use ‘BREWING COMPANY’ and ‘EST. 2013’ apart from the mark as shown.” Applicant submitted the following amendment to the description of the mark, “The mark consists of ‘oak park’ in large stylized lettering above ‘Brewing Company’ in smaller, stylized lettering; ‘est. 2013’ is in small lettering beneath the ‘K’ of ‘park’ and surrounded by the leg of the letter ‘R’ also in ‘park.’” However, Applicant added:

If the Examiner is not inclined to accept Applicant’s request to amend its mark to remove the “SACRAMENTO CA” portion, Applicant amends the application to insert the following description. This wording is above “SACRAMENTO CA” in a smaller stylized lettering with a dot between “SACRAMENTO” and “CA”. “Est. 2013” is in

small stylized lettering beneath the letter “K” in “PARK”
and surrounded by the leg of the letter “R” also in “PARK.”²

We therefore construe Applicant’s amendments to its description of the mark statement, and by extension to its mark, to be made *in the alternative*.

On December 2, 2015, the Examining Attorney issued a non-final Office Action refusing to accept the amended drawing as a material alteration of the original mark, and continuing the geographic descriptiveness refusal. In a June 2, 2016 response, Applicant submitted additional evidence, argued against the geographic descriptiveness refusal, and argued in favor of acceptance of the new drawing. Applicant did not revise its amended description of its mark.

In the following second final Office Action dated June 23, 2016, the Examining Attorney made final the geographic descriptiveness refusal, refused to accept the amended drawing as a material alteration of the mark and required a description of the mark that conforms with the originally-filed mark.

This application therefore comes up before us for decision on the following three issues: (i) whether the proposed amended mark is a material alteration of the originally filed mark; (ii) whether the description of the mark is appropriate; and (iii) whether the mark is geographically descriptive under Section 2(e)(2) for Applicant’s identified goods.

² November 13, 2015 Resp., TSDR 6.

Amendment of Drawing

Trademark Rule 2.72(b)(2), 37 C.F.R. § 2.72(b)(2), provides that in an application based on a *bona fide* intention to use a mark in commerce under Section 1(b) of the Act, an applicant may amend the drawing of the mark if “[t]he proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.” The test for determining whether a proposed amendment is a material alteration has been articulated as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa Int’l Service Ass’n v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). The crucial questions are whether the proposed amendment retains “the essence of the original mark” and whether it creates “the impression of being essentially the same mark.” *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). That is, “the new and old forms of the mark must create essentially the same commercial impression.” *Id.*, quoting *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988). *See also In Re Guitar Straps Online*, 103 USPQ2d 1745 (TTAB 2012).

The record includes evidence that there are several geographic locations named “Oak Park” in the United States. There is an “Oak Park” in Alabama; San Diego, California; Tampa, Florida; Georgia; Chicago, Illinois; Indiana; Michigan; Minnesota; North Dakota; Omaha, Nebraska; Portland, Oregon; Kansas; and Emeryville, California.³ One “Oak Park” is particularly notable, Oak Park, Illinois, adjacent to Chicago, Illinois:

Oak Park [Illinois] attracts architecture buffs and others to view the many Frank Lloyd Wright designed homes found in the village, alongside homes reflecting other architectural styles. The largest collection of Wright-designed residential properties in the world is in Oak Park. A distinct focus on historic preservation of important architectural styles began in the 1970s and continues, with many buildings marked as historically significant, and so far, three historic districts defined. Other attractions include Ernest Hemingway’s birthplace home and his boyhood home, the Ernest Hemingway Museum, the three Oak Park homes of writer and Tarzan creator Edgar Rice Burroughs, Wright’s Unity Temple, Pleasant Home, and the Oak Park-River Forest Historical Society.⁴

We find that the removal of “SACRAMENTO · CA” changes the commercial impression of the original mark in that it no longer refers to Oak Park of Sacramento, California, but rather may refer to another Oak Park, including Oak Park, Illinois with its collection of Frank Lloyd Wright buildings, historically significant buildings and the Hemingway museum. For those who do not know the geographic designations, the commercial impression of OAK PARK, without the designation “SACRAMENTO · CA,” may be arbitrary, as a park dominated by oak trees.

³ www.dity-data.com, April 22, 2015 Resp., TSDR 6; June 2, 2016 Resp., TSDR 6-71.

⁴ https://en.wikipedia.org/wiki/Oak_Park,_Illinois. June 2, 2016 Resp., TSDR 7-12.

Thus, Applicant's attempt to amend the drawing would result in material alterations to the proposed mark, as originally filed, and is prohibited under Trademark Rule 2.72. The Examining Attorney's rejection of the alternative drawing is affirmed.

Requirement for an acceptable description of the mark

TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 808.02 (Jan. 2017) provides that "[i]f a description of a mark is placed in the record, the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission." In addition, "[t]he description should describe all significant aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description." *Id.* Further, "[g]enerally, amending the description of the mark is liberally permitted, so long as the drawing supports the description. In rare cases where the amendment of the description constitutes a material alteration of the mark on the drawing or of the description filed with the original application, amendment will not be permitted." TMEP § 808.03(e).

Because the designation "SACRAMENTO · CA" contributes to the commercial impression of the mark, it is a significant aspect of the mark. Therefore, the amended description of the mark is not appropriate. The Examining Attorney's rejection of the alternative description of the mark is also affirmed.

Geographic Descriptiveness

The test for determining whether a term is primarily geographically descriptive is whether:

- 1) the mark sought to be registered (or a portion thereof) is the name of a place generally known to the public,
- 2) the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered originate in that place, and
- 3) the source of the goods or services is the geographic region named in the mark.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448 (Fed. Cir. 2015).

See also, *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). The relevant public is the purchasing public in the United States of the types of goods or services identified in the application. *In re Newbridge Cutlery*, 113 USPQ2d at 1449. The Federal Circuit explained,

Regarding the first prong of the test, that the population of the location is sizable and/or that members of the consuming public have ties to the location ... is evidence that a location is generally known. By contrast, that the geographic meaning of a location is “minor, obscure [or] remote” indicates that the location is not generally known. ... Of course, there are many probative factors to the question of whether a location is generally known

Id.

Turning to the first prong of the test for geographic descriptiveness, the Examining Attorney submitted the evidence including the following to demonstrate that Oak Park of Sacramento is a generally known geographic location:

- a Wikipedia web page about Oak Park stating,

“Oak Park is informally bounded by U.S. Route 50 to the North, Stockton Blvd. to the East, CA-99 to the West and Fruitridge Road to the South. It is situated within the city limits and provides easy access to the ever growing/changing Downtown of Sacramento. The streets intersect with avenues and there is one main street that runs through all of Oak Park, Martin Luther King Jr. Boulevard, formerly known as Sacramento Boulevard.”

“As of 2008 Oak Park faces a variety of challenges sustaining the beginnings of its comeback due in part to an increase in foreclosures and an area wide decline in property values. Its future is in the hands of activists like Kevin Johnson, community groups like the Oak Park Neighborhood Association, the South Oak Park Community Association (SOPCA) established in 2014. Community policing efforts, the demand for affordable housing close to the University of California Davis Medical Center and the overall impact that the real estate market will play in the future.”⁵

- Newsreview.com article titled “Oak Park’s new kicks: On the neighborhood’s latest revitalization effort [-] Millions of investment dollars, new housing, restaurants, even a brewery will arrive in the troubled neighborhood. Can Oak Park escape its ‘ghetto’ stigma?” stating,

“A cadre of entrepreneurially minded locals is working to help Oak Park ascend from the ashes as the neglected and sketchy cousin of Curtis Park and Land Park into a hub of urban life and culture.”

“This was the state of Oak Park for decades – a once heralded enclave of affluence and social activism slowly declined into a forest of foreclosed homes, shuttered businesses and vacant lots after a mass exodus in the 1960s, when many of the well-heeled class sought residence in inexpensive suburban tract homes.”

⁵ http://en.wikipedia.org/wiki/Oak_Park,_Sacramento,_California, Oct. 23, 2014 Office Action, TSDR 2-4.

“It was more than 150 years ago that Oak Park emerged as the first suburb of Sacramento. The neighborhood, which is broken into two sections, north and south Oak Park, today houses a combined 10,842 people. It was originally developed with an elaborate and distinct architectural style of Victorian, Craftsman and cozy bungalow homes.”

“Today, Oak Park is still trying to shake off the stigma of poverty and crime.”⁶

- *Merriam Webster* entry for Sacramento California indicating that the population of Sacramento in 2000 was 407,018.⁷
- Web pages containing information from the Oak Park Neighborhood Association including the history of this location, stating,

“As the blight of vacant and dilapidated buildings increased, so did crime. Prostitution, drugs and gang activity moved into the most stressed areas. Crime is usually associated with a high percentage of home rentals. As of the 2000 U.S. Census, 35 percent of Oak Park’s housing units were owner occupied. That compares with a rate of 50 percent across the City of Sacramento, 58 percent in the county and 57 percent statewide.”

“As a response to the blight problems, the Sacramento Redevelopment Agency began buying up properties in the Oak Parle business district. A good number of the old original buildings were demolished and some of these properties were turned into public housing projects. However, there still remain a good number of vacant business properties and vacant lots, principally along Broadway.”

“Jobs are returning to the Oak Park Vicinity. The UC Davis Hospital continues to expand and the Shriner’s Hospital has opened. Related businesses

⁶ Oct. 23, 2014 Office Action, TSDR 15.

⁷ Oct. 23, 2014 Office Action, TSDR 5.

and offices have sprung up along Stockton Boulevard and service businesses have followed. Decrepit motels have been turned into refurbished apartment buildings and business buildings have become preservation and tax act projects.”⁸

The Examining Attorney also submitted a handful of complete news articles and excerpts from 888 news stories which contain the term Oak Park in relation to Sacramento, California. Several, but not many, of these excerpts are from major newspapers such as the *New York Times*. Many of these excerpts are from local newspapers.⁹ At best, these stories reflect that a former mayor of Sacramento, who played in the National Basketball Association, grew up in Oak Park of Sacramento.

Applicant, in turn, submitted *inter alia* three, live, use-based registrations which include the term Oak Park. A fourth registration includes a disclaimer of the term Oak Park.¹⁰ These registrations have limited probative value because prior registrations are not binding on Board determinations as the USPTO must examine each application on its own merits based on the record in the application under consideration, and the Board is not bound by the decisions of other examining attorneys in other applications. *See In re Cordua Restaurants, Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark

⁸ Oct. 23, 2014 Office Action, TSDR 19-20.

⁹ The following, taken from the *Whittier Daily News* (July 5, 2010) is typical; “House explodes in Oak Park Sacramento – at least one firefighter is in the hospital after a vacant house exploded in a Sacramento neighborhood, possibly because of a gas leak.” May 14, 2015 Office Action, TSDR 1.

¹⁰ A fifth registration including the term Oak Park has been canceled; we do not consider this cancelled registration. *See In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant); TBMP § 1208.02 (Jan. 2017).

applications for compliance with each and every eligibility requirement”); *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court”).

When we consider the evidence as a whole, we are not persuaded that “Oak Park” identifies a geographic location “known generally to the American purchasing public” of beer. *See In re Newbridge Cutlery*, 113 USPQ2d at 1450 (“That Newbridge is the second largest town in County Kildare and the seventeenth largest in the Republic of Ireland reveals nothing about what the relevant American purchaser might perceive the word ‘Newbridge’ to mean and is too insignificant to show that Newbridge is a place known generally to the American purchasing public”). Rather, we find that Oak Park in Sacramento is minor and obscure, and as such it is not a generally known geographic location. The impression created by the evidence as a whole is that Oak Park in Sacramento, with one main street, was at one point an important suburb of Sacramento, which fell into decline with gang activity, crime, prostitution and illicit drugs, but is now attempting a revival. While Sacramento, California is not an insignificant city, with a population of approximately 400,000, there is nothing to indicate that the specific area of Oak Park has any significance outside of Sacramento, California. At best, the record indicates that one professional basketball player grew up there, a fact probably not generally known to the American beer-drinking public.

In *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 3 USPQ2d at 1452, the Federal Circuit stated:

There can be no doubt that the PTO has established that Vittel is in fact the name of a small town in the Voges mountain region of France where there is a resort with mineral springs - a spa - where the water is bottled and thence distributed somewhere, but how many people in this country know that? Certainly Vittel is remote and we deem the evidence produced by the PTO insufficient to show that it is not obscure. We think the evidence is inadequate to show that the bulk of cosmetics purchasers, or even a significant portion of them, would upon seeing the word Vittel on a bottle of skin lotion or the like, conclude that it is a place name and that the lotion came from there, rather than simply a trademark or trade name of a manufacturer like Chanel, Bourgois, or Vuitton.

See also, *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926, 927-28 (TTAB 1984) (“JEVER” and design for “beer” produced in the German town of Jever has an obscure geographical meaning and is not primarily geographically descriptive), *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73, 75 (TTAB 1983) (“AYINGER,” in “AYINGER BIER” (“BIER” disclaimed) for “beer” produced in the German town of Aying, has a minor, remote or obscure geographical significance and not is primarily geographically descriptive).

Because the Examining Attorney has failed to prove the first prong of the test for geographic descriptiveness, the Section 2(e)(2) refusal to register cannot stand and is reversed.

Decision: The refusal to register Applicant’s mark under Section 2(e)(2) is reversed. The refusal to accept the proposed alternative drawing because it is a

material alteration of the original drawing is *affirmed*, as is the refusal to accept the proposed alternative description of the mark.

The application will move forward to the intent-to-use division of the Office to await the filing of a Statement of Use for the mark as originally filed by Applicant, with its original description of the mark.