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Subject: U.S. Trademark Application Serial No. 87980485 - CERTIFIED BISON - N/A - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 87980485

**Mark:** CERTIFIED BISON

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**Applicant:** Golden Bison Consolidated, LLC

**Reference/Docket No.** N/A

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the Trademark Examining Attorney's refusal to register the applied for mark "Certified Bison" for bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified. The Examining Attorney refused registration on the Supplemental Register pursuant to Sections 23(c) and 45 of the Trademark Act, 15. U.S.C. §§ 1091 (c),

because the applied for mark is generic and not capable of denoting the source or origin of applicant's goods and distinguishing them from similar goods of others.

## **FACTS**

On January 8, 2018 Applicant applied to register the mark "Certified Bison" in standard characters for bison meat; prepackaged meals consisting primarily of bison meat and vegetables, in Class 29 and restaurant services, in Class 43.

In an Office Action dated April 24, 2018 the Examining Attorney refused registration under Trademark Act Section 2(e)(1) for the mark being merely descriptive in relation to the applicant's goods consisting of and featuring bison meat and restaurant services. The Examining Attorney also issued a disclaimer requirement for the descriptive term "Bison".

On October 18, 2018 Applicant submitted a response to the April 24, 2018 office action where Applicant requested that the goods in Class 29 be divided out of the application. Applicant disclaimed the wording "Bison" and also submitted arguments seeking withdrawal of the merely descriptive refusal. Applicant also amended the application to the Supplemental Register and indicated that an Allegation of Use was separately filed to change the filing basis of the application from Section 1(b) based on a bona fide intent to use the mark in commerce to Section 1(a) based on use of the mark in commerce. The Examining Attorney has subsequently reviewed the Allegation of Use and has accepted it.

On November 12, 2018 the Examining Attorney suspended the application pending the completion of Applicant's request to divide.

On April 3, 2019 the divisional request was completed with the Class 43 services remaining in the parent application (Serial No. 87/747098) and the Class 29 goods assigned a new serial number as the child application (Serial No. 87/980485).

On April 26, 2019 the Examining Attorney issued a supplemental office action where a deceptively misdescriptive refusal and generic refusal were issued.

On October 16, 2019 Applicant submitted a response to the April 26, 2019 office action with arguments that the deceptively misdescriptive and generic refusals be withdrawn.

On November 11, 2019 the Examining Attorney issued a final office action which made final the deceptively misdescriptive refusal and generic refusal.

On May 11, 2020 Applicant submitted a request for reconsideration for the deceptively misdescriptive refusal and generic refusal. Additionally, the identification of goods was amended to: Bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified, in Class 29. Applicant also filed a notice of appeal.

On June 16, 2020 the Examining Attorney denied Applicant's request for reconsideration and the final office action was continued as to the generic refusal only.

On August 20, 2020 Applicant filed an Appeal Brief which appeals the Examining Attorney's final refusal to register the trademark "Certified Bison" for Bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; *see* TMEP §§1209.01(c) *et seq.* Registration is refused because the mark is generic in relationship to the applicant's goods which include certified bison meat and ultimately incapable of distinguishing applicant's goods.

## **ARGUMENTS**

Applicant's mark is "Certified Bison" for Bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified. Applicant's arguments in favor of registration are as follows: (1) The Examining Attorney's generic test is legally erroneous. (2) The relevant public does not perceive the term "Certified Bison" as a common generic term for bison meat and the evidence does not support the finding that the term "Certified Bison" is generic for bison meat. (3) The Examining Attorney failed to consider the mark as a whole when issuing the generic refusal. (4) The evidence shows that the term "Certified Bison", when considered as a whole, is descriptive, not generic and eligible for registration on the Supplemental Register.

**I. MARK IS GENERIC FOR THE GOODS UNDER SECTIONS 23(c) & 45**

The test for determining whether an applied-for mark is generic is its primary significance to the relevant public. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 641, 19 USPQ2d 1551, 1553-54 (Fed. Cir. 1991) (citing *In re Montrachet S.A.*, 878 F.2d 375, 376, 11 USPQ2d 1393-94 (Fed. Cir. 1989)). Making this determination involves a two-step inquiry:

- (1) What is the genus of goods at issue?
  
  
  
  
  
  
  
  
  
  
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods?

*In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods may be defined by an applicant's identification of goods. See *In re Cordua Rests., Inc.*, 823 F.3d at 602, 118 USPQ2d at 1636 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1552); see also *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361, 1363, 92 USPQ2d 1682, 1682, 1684 (Fed. Cir. 2009).

In this case, the application identifies the goods as “Bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified,” which adequately defines the genus at issue. The fact that the genus is often derived from the identification of the goods and/or services in the application is based on the premise that the identification accurately reflects an applicant’s actual use of the applied-for mark. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437-38 (TTAB 2005) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods. *The Loglan Inst. Inc. v. The Logical Language Grp.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553).

In this case, the relevant public comprises ordinary consumers who purchase applicant’s goods, because there are no restrictions or limitations to the channels of trade or classes of consumers.

Applicant argues “...the Examining Attorney provided no evidence that the public commonly uses or understands CERTIFIED BISON as the generic name for a genus of bison meat goods or prepackaged meals consisting of bison meat and vegetables” and that “[N]one of the evidence provided by the Examining Attorney uses the term “certified bison” for bison meat or prepackaged meals consisting of bison meat and vegetables. The Examining Attorney merely cites definitions and generic uses of the constituent terms instead of conducting an inquiry into the meaning of the disputed term as a whole.”<sup>1</sup> Applicant’s website contains a Frequently Asked Questions page that provides information to consumers as to what “Certified Bison” is, specifically, bison products that are “...produced under strict ranching,

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<sup>1</sup> August 20, 2020 Appeal Brief, p. 13.

animal welfare, food safety, and processing standards.” (as certified by the Bison Council)<sup>2</sup> An applicant’s own website and marketing material is also probative and can be “the most damaging evidence” in showing how the relevant public perceives a term. *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957 (TTAB 2018) (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d at 966, 114 USPQ2d at 1831; *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987)).

Furthermore, evidence of the public’s understanding of the term “may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366, 127 USPQ2d 1041, 1046 (Fed. Cir. 2016) (quoting *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987)); TMEP §1209.01(c)(i). In addition, competitor use has been found probative on the issue of genericness. *See BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1570, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) (“The cases have recognized that competitor use is evidence of genericness.”) (citing *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1578, 13 USPQ2d 1444, 1446 (Fed. Cir. 1990)); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at \*9 (TTAB 2019) (“We find probative the generic uses of the [applied-for mark] by competitors”) (citing *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d at 1370, 127 USPQ2d at 1048).

The Examining Attorney concedes that there is no USDA (United States Department of Agriculture) grading or certification for bison meat, however, the term “Certified Bison” is used by vendors, food manufacturers and food quality entities (baby food from Thrive Market; Corrales Growers Market in

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<sup>2</sup> [www.certifiedbison.com/faqs-info](http://www.certifiedbison.com/faqs-info)



New Mexico via LaMont's Buffalo; and the Global Animal Partnership that provides standards for certain meats such as bison to be certified as to animal welfare and other qualities) to identify bison of a high, health, humane or desirable quality.<sup>3</sup> This evidence establishes that "certified bison" is a generic term for purchasers of bison meat who are seeking to purchase bison of a particular quality that has been certified according to a particular standard.

The trademark examining attorney has established by clear and convincing evidence that the applied-for mark is generic; thus the USPTO's evidentiary burden has been met. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *see also In re Hotels.com LP*, 573 F.3d 1300, 1302, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009) (USPTO "must demonstrate generic status by clear evidence") (citing *Am-Pro Protective Agency, Inc. v. United States*, 281 F.3d 1234, 1239-40 (Fed. Cir. 2002) (explaining that "clear evidence" is equivalent to "clear and convincing evidence")); TMEP §1209.01(c)(i).

## **CONCLUSION**

The issue under Trademark Act Section 23(c) and 45 is whether Applicant's mark is generic in relationship to the proposed goods. For the reasons above, a finding of the mark being generic is proper. It is respectfully requested that registration on the Supplemental Register under Trademark Act Sections 23(c) and 45 be affirmed because the applied-for mark is generic and thus incapable of distinguishing applicant's goods.

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<sup>3</sup> June 16, 2020 Action Denying Request for Reconsideration, TSDR pp. 2-13; 18-20.

Respectfully submitted,

*/Giancarlo Castro/*

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