

ESTTA Tracking number: **ESTTA1095138**

Filing date: **11/12/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87980485
Applicant	Golden Bison Consolidated, LLC
Applied for Mark	CERTIFIED BISON
Correspondence Address	MARK VB PARTRIDGE PARTRIDGE PARTNERS PC 321 N CLARK STREET, SUITE 500 CHICAGO, IL 60654 UNITED STATES Primary Email: jordan@partridgepartnerspc.com Secondary Email(s): tm@partridgepartnerspc.com 312-634-9502
Submission	Reply Brief
Attachments	20-1112 Certified Bison cl 29 Appeal REPLY FINAL.pdf(191079 bytes)
Filer's Name	Mark V.B. Partridge
Filer's email	mark@partridgepartnerspc.com, tm@partridgepartnerspc.com
Signature	/Mark V.B. Partridge/
Date	11/12/2020

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APPLICANT:	Golden Bison Consolidated, LLC
MARK:	CERTIFIED BISON
SERIAL NO.:	87/980,485
PROCEEDING NO.:	ESTTA1054631
FILING DATE:	January 8, 2018
EXAMINING ATTORNEY:	Giancarlo Castro
LAW OFFICE:	110

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT’S REPLY TO EXAMINING ATTORNEY’S APPEAL BRIEF

Golden Bison Consolidated, LLC (“Applicant” or “Golden Bison”), submits this reply brief to the Trademark Trial and Appeal Board (“TTAB” or the “Board”) in response to the Examining Attorney’s Appeal Brief filed on October 23, 2020 (“Examining Attorney’s Response” or, the “Response”). *See* TTABVUE #10 (Examiners Statement). This appeal concerns the Examining Attorney’s refusal to register Applicant’s CERTIFIED BISON trademark (the “Mark”) in connection with “bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified” in Class 29 on the basis that the Mark is generic.

I. INTRODUCTION

Applicant seeks to reverse the erroneous decision of the Examining Attorney denying registration of the Mark and maintains that the Examining Attorney did not establish by clear and convincing evidence that “Certified Bison” is generic for bison meat and prepackaged meals.

In its Appeal Brief, Applicant argued the following in favor of registration: (1) the Examining Attorney’s test for genericness is legally erroneous; (2) the evidence on record does not establish that CERTIFIED BISON is generic for bison meat or prepackaged meals; (3) the Examining Attorney’s analysis is incomplete and fails to consider the Mark as a whole; and (4) the evidence shows that Applicant’s mark is descriptive and eligible for registration on the Supplemental Register.

In response, the Examining Attorney: (i) failed to address his legally erroneous test for genericness by failing to consider the *Booking.com* Supreme Court case; (ii) failed to explain how the insufficient evidence establishes that CERTIFIED BISON is generic; (iii) ignores Applicant’s argument in regards to considering the mark as a whole; and (iv) ignores Applicant’s argument and evidence supporting that the Mark is capable of serving as an indication of source and entitled to registration on the Supplemental Register.

Applicant further responds in this Reply that (1) the Examining Attorney incorrectly redefined the genus at issue and (2) the Examining Attorney still does not adequately explain how the evidence establishes that CERTIFIED BISON is generic. Therefore, the final refusal should be reversed, and the Board should permit Applicant to register CERTIFIED BISON on the Supplemental Register.

II. THE TERM “CERTIFIED BISON” IS NOT GENERIC FOR APPLICANT’S GOODS.

As stated in Applicant’s Appeal Brief, the critical issue in genericness is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990 (Fed. Cir. 1986) (FIRE CHIEF for magazine not generic); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1345 (Fed. Cir. 1999) (AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services).

A two-step test is applied to determine whether a given term is generic. *Marvin Ginn*, 782 F. 2d at 989-990; TMEP § 1209.01(c). “First, what is the genus of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” *Id.* Both the Applicant and the Examining Attorney agree that this is the test to determine genericness, however, in the Response, the Examining Attorney incorrectly applied step 1 of the test in determining the genus and erroneously applies irrelevant and insufficient evidence to step 2.

A. The Examining Attorney Incorrectly Defined the Genus at Issue which is Adequately Defined as Bison Meat and Prepackaged Meals Consisting of Bison Meat and Vegetables.

For the first time in the prosecution of the Mark and this Appeal, the Examining Attorney defines the genus as “bison meat; prepackaged meals consisting primarily of bison meat and vegetables, **all of the aforementioned bison meat being certified.**” Examining Attorney’s Response, at 7 (emphasis added). Prior to the Examining Attorney’s Response, the Applicant and the Examining Attorney agreed that the genus at issue is bison meat. *See* August 8, 2020 Applicant’s Appeal Brief, TTABVUE #8, at 12 (“... genus of bison meat goods or prepackaged meals consisting of bison meat and vegetables”); November 11, 2019 Final Office Action, TSDR

p. 1 (“the applied-for mark is generic as used in connection with the following goods: Bison meat”). The Examining Attorney’s addition of “all of the aforementioned bison meat being certified” significantly changed the Examining Attorney’s rationale for genericness, resulting in a new argument made by the Examining Attorney.

This new argument includes additional analysis of the previously-submitted evidence that Applicant has not yet had the opportunity to rebut. As such, Applicant objects to the Examining Attorney redefining the genus at issue and asserts that the genus is properly defined as bison meat or prepackaged meals consisting of bison meat and vegetables. *See In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2D (BNA) 1660, 1665 (TTAB 2007) (“It is poor examination practice not to make all the evidence and arguments of record during examination, before the briefing stage. . . [and] an applicant has the option of filing a reply brief to object to an examining attorney's late-raised argument”).¹

B. The Evidence Does Not Establish That the Mark is Generic For Bison Meat and Prepackaged Meals Consisting of Bison Meat and Vegetables.

Applicant maintains that the Examining Attorney did not establish by clear and convincing evidence that “Certified Bison” is generic for bison meat and prepackaged meals. The evidence cited by the Examining Attorney in the Response falls into two categories: (1) Applicant’s website and (2) third-party internet evidence.

¹ Regardless of the definition of the genus, which is disputed by the parties, Applicant maintains that the Examining Attorney has failed to provide clear and convincing evidence that CERTIFIED BISON is generic for either interpretation of the genus. As such, if the Board agrees with the Examining Attorney and allows the genus to be redefined, Applicant reserves its right to adequately argue before the Board that the relevant public *still* does not perceive CERTIFIED BISON as a generic term for bison meat; prepackaged meals consisting primarily of bison meat and vegetables, all of the aforementioned bison meat being certified.

1. Applicant's Website Does Not Show that the Public Perceives CERTIFIED BISON as a Generic Term.

The Examining Attorney cites Applicant's website to attempt to show how the relevant public perceives the term CERTIFIED BISON. Examining Attorney's Response, at 7-8. Specifically, the Examining Attorney states that the "Frequently Asked Questions page provides information as to what 'Certified Bison' is, specifically, bison products that are '...produced under strict ranching, animal welfare, food safety, and processing standards.'" *Id.* This statement quoted by the Examining Attorney merely describes the high level of quality a consumer can expect to be associated with CERTIFIED BISON products and does not show the meaning that relevant consumers attribute to the words CERTIFIED BISON standing alone. The high quality standard that Applicant provides in its products is unique to the Applicant. The Examining Attorney has presented no evidence of any other party meeting the high level of quality associated with CERTIFIED BISON. Thus, the high standard imposed by the Applicant is actually an attribute of Applicant's CERTIFIED BISON brand, where the Mark serves as a source identifier for this esteemed brand, rather than an attribute of a generic standard adopted by others in the industry or the relevant public.

The case that the Examining Attorney relies upon to conclude that an applicant's own website and marketing material "can be the most damaging evidence" in showing how the relevant public perceives a term does not apply in this appeal. *Id.* at 8 (citing *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957 (TTAB 2018)). The applicant in *In re Mecca Grade Growers, LLC* sought to register MECHANICALLY FLOOR-MALTED as a trademark for "[m]alt for brewing and distilling" and "[p]rocessing of agricultural grain." 125 USPQ2d at 1951. The court ultimately concluded that MECHANICALLY FLOOR-MALTED was a generic term incapable of trademark registration; in part based on the applicant's own admission that "floor-malted" refers to a type of

malt for brewing and distilling and is a process performed by others. *Id.* at 1958. But, in doing so, the court importantly notes that the purchasers there were *not* members of the general public who “might not be familiar with the process,” but were customers “in the brewing and distilling business who are likely to know exactly what MECHANICALLY FLOOR-MALTED malt is” and how it is processed. *Id.* Since the court held that purchasers were not members of the general public and had specialized knowledge and familiarity with the term sought to be protected, it is implied, however, that had the purchasers been the general public without specialized industry knowledge or familiarity, the application would have been granted. In the instant matter, Applicant’s relevant purchasers are the general public without familiarity or specialized knowledge to know what CERTIFIED BISON means without the efforts and standards *created by the Applicant*. But for the Applicant’s efforts, CERTIFIED BISON would have no meaning whatsoever.

Furthermore, citing an FAQ section on a website for the proposition that the term CERTIFIED BISON is generic is simply a non sequitur—taking time and space to explain what CERTIFIED BISON is would be a waste of Applicant’s effort and unnecessary information for its customers if the general public already knew that CERTIFIED BISON was generic. If the term CERTIFIED BISON was generic, Applicant’s website would simply inform the consumer “We support Certified Bison.” Consequently, by explaining what CERTIFIED BISON is, Applicant’s website demonstrates that the term is in fact not generic.

2. Third-Party Evidence Cited by the Examining Attorney Does Not Show that the Public Perceives CERTIFIED BISON as a Generic Term.

The Examining Attorney again cites third-party websites to establish that CERTIFIED BISON is generic for bison meat and prepackaged meals without explaining how this evidence leads to that conclusion. But this time, the Examining Attorney goes a step further and states that

CERTIFIED BISON is “used by vendors, food manufacturers and food quality entities to identify bison of a high, health, humane, or desirable quality.” Examining Attorney’s Response, at 9-10. However, absolutely none of the evidence provided actually uses the term “certified bison” to refer to “bison of a high, health, humane or desirable quality” so the use of this evidence in itself is irrelevant and insufficient to identifying CERTIFIED BISON as generic for bison meat and prepackaged meals.

First, the Examining Attorney attempts to justify the inclusion of this evidence by stating that “competitor use has been found probative on the issue of genericness.” Examining Attorney’s Response, at 8. However, none of the websites cited by the Examining Attorney are competitors of Applicant’s, *e.g.*, Thrive Market is a members-only online grocery store, LaMont’s Buffalo is a company that provides guided bison hunts and does not provide bison meat, and Global Animal Partnership is a company that provides standards for human growing practices and it does not sell bison meat products.

Second, none of the cited websites establish what the Examining Attorney asserts they do: 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.” Examining Attorney’s Response, at 9. The first piece of cited evidence, Thrive Market, has the term “bison” in connection with a type of baby food product, but does not use the term “certified,” and is marketed towards ordinary consumers of baby food, and not for purchasers seeking bison of a particular quality that has been certified. The second piece of evidence, Corrales Growers Market, does have the term “USDA certified bison,” although “USDA certified bison” does not even exist (as conceded by the Examining Attorney). Furthermore, the vendor selling this supposed “USDA certified bison” makes no claims as such on its own website. The third piece of evidence, the

Global Animal Partnership, has the term “bison” and the term “certification” used separately from each other, does not use the term “certified bison” to identify bison of a high, health or humane or desirable quality, and does not provide bison meat products to consumers seeking bison of a particular quality that has been certified. As such, contrary to the Examining Attorney’s position, no evidence has been entered to establish that CERTIFIED BISON is a generic term.

Further, even if the genus is redefined as the Examining Attorney posits and the evidence is deemed “relevant”, the supplied evidence is still insufficient to support his refusal on genericness grounds. As explained in Applicant’s Appeal Brief, aptness is insufficient to prove genericness, and, for the reasons stated herein, the evidence provided by the Examining Attorney is not sufficient to render applicant’s mark an unprotectable generic term. *Am. Fertility Soc’y*, 188 F.3d at 1347; *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987).

III. CONCLUSION

Based on the foregoing, Applicant respectfully requests that the TTAB reverse the Examining Attorney’s refusal to register Applicant’s Mark. CERTIFIED BISON is neither used nor understood by consumers as the generic term for a genus of meat products or prepackaged meals. Instead, it is descriptive and eligible for registration of the Supplemental Register.

Dated: November 12, 2020

Respectfully submitted,

By: /s/ Mark V.B. Partridge
Mark V.B. Partridge
Jordan Arnot Leahey
Francyn Brown
PARTRIDGE PARTNERS P.C.
321 North Clark Street, Suite 500
Chicago, Illinois 60654

Attorneys for Applicant