

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

GCP

Mailed: September 24, 2012

Cancellation No. 92045971

Evengro Canada,
Inc. (substituted as party
plaintiff)¹

v.

Mastronardi Produce Ltd.

**Before Kuhlke, Wellington, and Wolfson,
Administrative Trademark Judges.**

By the Board:

On May 5, 2006, Evengro Canada, Inc. ("petitioner")
filed a petition for cancellation of a registration owned
by Mastronardi Produce Ltd. ("respondent") for the mark
CAMPARI in standard characters for "fresh tomatoes" in

¹On December 4, 2009, petitioner filed a notice of merger
advising that the original petitioner in this case, Westgro
Sales, Inc., and related companies were amalgamated into one
entity now known as Evengro Canada, Inc. Concurrently with its
notice of merger, petitioner submitted a true and correct copy of
the Certificate of Amalgamation. In view thereof, Evengro
Canada, Inc. is hereby substituted as party plaintiff in this
proceeding. See TBMP § 512 (3d ed. rev. 2012).

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International Class 31.² On October 4, 2007, petitioner filed an amended petition to cancel.

The grounds for cancellation are: (1) respondent's CAMPARI mark is the varietal name for a type of tomato and therefore an unregistrable generic term; (2) respondent was not the owner of the mark when it filed its underlying application; and (3) fraud.

Respondent, in its answer, has denied the salient allegations of the amended petition to cancel.

On March 9, 2009, petitioner filed a motion for summary judgment solely on its asserted claim that respondent's CAMPARI mark is the varietal name for a type of tomato and, thus, the generic name of the goods identified in respondent's subject registration. By order dated August 24, 2011, the Board denied petitioner's motion for summary judgment, finding that a genuine dispute of material fact exists, at a minimum, with respect to the public perception in the United States of the term CAMPARI in relation to tomatoes. The Board also found that, to the extent the registration of the varietal name CAMPARI, which issued to a third party (namely, Enza Zaden) by the

² Reg. No. 3037538, issued on January 3, 2006 on the Principal Register, claiming November 1995, as both the first date of use anywhere and as the first date of use in commerce.

Netherlands Register of Plant Varieties, has any effect in the United States, a genuine dispute of material fact exists as to whether respondent has established prior rights in the term CAMPARI as contemplated under Article 20 of the International Convention for the Protection of New Varieties of Plants (UPOV). By the same order, the Board also denied respondent's cross-motion for summary judgment regarding petitioner's standing because the Board found that petitioner had sufficiently rebutted respondent's motion on this point by raising a genuine dispute as to its standing.

This case now comes before the Board for consideration of (1) petitioner's motion (filed September 22, 2011) for reconsideration³ of the Board's August 24, 2011, order and (2) petitioner's motion (filed November 2, 2011) for leave to submit supplemental evidence in support of its motion for summary judgment. The motions are fully briefed.

We first turn to petitioner's motion for leave to submit supplemental evidence in support of its motion for summary judgment. By way of its motion, petitioner seeks leave to submit a copy of a renewed distribution agreement

³ Petitioner originally filed its motion for reconsideration of the Board's August 24, 2011 order on September 15, 2011. Petitioner filed a corrected version of its motion on September 22, 2011 to correct a date relied upon by petitioner.

between itself and the plant breeder, Enza Zaden USA, Inc., and representative sales invoices, which petitioner contends further support petitioner's standing in this proceeding. Additionally, petitioner seeks leave to submit excerpts from the oral examination of Paul Mastronardi, one of respondent's officers, from a parallel Canadian proceeding, which testimony petitioner alleges conclusively establishes that respondent knew, at the time it filed the underlying application that issued as its involved registration, that Campari was a name of a plant varietal. Petitioner maintains that it came into possession of the foregoing evidence after the briefing deadlines of petitioner's motion for summary judgment and, therefore, petitioner could not have presented this evidence earlier in time.

The Board is not persuaded by petitioner's arguments and therefore denies petitioner's motion for leave to submit supplemental evidence in support of its previously denied motion for summary judgment for the reasons set forth below.

Briefing on the parties' motions for summary judgment concluded on September 11, 2009. The Board issued its order deciding the parties' motions for summary judgment on

August 24, 2011.⁴ Petitioner acknowledges it came into possession of the evidence it now seeks to submit prior to the Board's August 24, 2011 decision. In fact, petitioner entered into the distribution agreement it now seeks to submit as supplemental evidence shortly after the briefing deadlines for the parties' motions for summary judgment, i.e., October 1, 2009. Moreover, the oral examination of Paul Mastronardi occurred on October 28, 2010. The Board presumes that petitioner received copies of the transcripts of the oral examination shortly thereafter. At the very least, petitioner could have sought leave to submit this supplemental evidence prior to the Board issuing its August 24, 2011 decision. Petitioner, however, inexplicably failed to do so. For the Board now to entertain this supplemental evidence after it has already decided the merits of the parties' motions for summary judgment would be improper and unwarranted. Further, to the extent petitioner seeks to submit this supplemental evidence in further support of its motion for reconsideration, such a request is improper because the Board does not consider new evidence in its determination of a motion for

⁴The Board notes that, following the briefing of the parties' motions for summary judgment, this proceeding was suspended for settlement from January 22, 2010 until August 18, 2010.

reconsideration of a prior Board decision. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978).

In view thereof, petitioner's motion for leave to submit supplemental evidence in support of its motion for summary judgment is denied.

We next turn to petitioner's motion for reconsideration of the Board's August 24, 2011, order. In support of its motion, petitioner argues that the Board erred by second-guessing the validity of a 16-year-old varietal designation that it must accept as valid on its face. Specifically, petitioner contends that the Board failed to accord sufficient weight to the registration of CAMPARI on the Netherlands Register of Plant Varieties in denying petitioner's motion for summary judgment. Further, petitioner maintains that the Board lacks subject matter jurisdiction over the varietal designation registration as well as personal jurisdiction over the varietal name registrant and plant breeder Enza Zaden. Moreover, petitioner argues that the Board erred when it failed to credit, as a matter of law, the undisputed June 20, 1995, date on which Enza Zaden designated the Campari varietal name. To establish a material dispute for trial as to its alleged prior rights, and thereby defeat petitioner's motion for summary judgment, respondent was required to

proffer admissible evidence of its rights prior to June 20, 1995, which petitioner contends respondent failed to do. Petitioner also maintains that respondent cannot claim any trademark usage of the term Campari prior to November 16, 1995, the date of an invoice which respondent submitted in support of its opposition to petitioner's motion for summary judgment, the authenticity of which petitioner nonetheless contests. In view thereof, petitioner contends that the Board erred in not fixing respondent's earliest possible use date as of November 16, 1995.

Additionally, petitioner maintains that there is no precedent for a national trademark authority, such as this Board, to apply the "prior rights" exception found in Paragraph 4 of Chapter VI, Article 20 of UPOV which reads as follows:

Prior rights of third parties shall not be affected. If by reason of a prior right, the use of the denomination of a variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the authority shall require the breeder to submit another denomination for the variety.

Petitioner claims that it was legal error for the Board to assert a prerogative to adjudicate prior rights under Paragraph 4 inasmuch as the validity of a denominated varietal designation is a matter for UPOV authorities only,

because UPOV expressly provides for challenges to varietal designations.

Petitioner also argues that, in denying petitioner's motion for summary judgment, the Board wrongly entertained the notion of public perception of the term CAMPARI since varietal names are generic irrespective of consumer perception.

Finally, petitioner contends that the Board erred in not granting respondent's cross-motion for summary judgment on the issue of petitioner's standing in favor of petitioner, as the non-moving party, because petitioner maintains that there is no genuine dispute of material fact that petitioner has standing to pursue this case. Specifically, petitioner maintains that the record contains undisputed evidence that (1) petitioner and its predecessor in interest have sold Campari tomato seeds from at least as early as 2002 through the close of the briefing on summary judgment and (2) petitioner is the seller of seeds and other agricultural goods. In view of the foregoing, petitioner argues that it has standing as a matter of law to challenge respondent's CAMPARI registration on the grounds of genericness.

It has often been stated that the premise underlying a request for reconsideration under Trademark Rule 2.144 is

that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. See TBMP § 518 (3d ed. rev. 2012) and authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. See *Amoco Oil Co., supra*. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate changes. See *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

We first note that, contrary to petitioner's assertions, the Board did not opine upon or adjudicate the validity of the varietal name registration owned by Enza Zaden in denying petitioner's motion for summary judgment. The Board recognizes that it does not have jurisdiction to invalidate a varietal name registration. The Board does, however, have the jurisdiction to determine whether a party has prior rights in a mark in the United States for purposes of determining whether a federal registration issued by the USPTO should be cancelled when prior rights is an issue in such a

determination. See generally Trademark Act §§ 17, 18, 20, and 24; 15 U.S.C. §§ 1067, 1068, 1070, and 1092.

Further, while petitioner maintains that there is no precedent for a national trademark authority to apply the "prior rights" exception found in Paragraph 4 of Chapter VI, Article 20 of UPOV and, therefore, it would be legal error for the Board to adjudicate such prior rights under this treaty provision, petitioner fails to cite to any legal authority which would preclude the Board from making such a determination.

Moreover, the Board construes the "prior rights" exception found in Paragraph 4 of Chapter VI, Article 20 of UPOV as a provision which permits grandfathering prior rights which may exist within member countries such that a trademark holder in the United States is not charged with contesting all possible UPOV filings in other member countries in order to protect its prior trademark rights in the United States.⁵ By this construction, the Board, by finding a genuine dispute of material fact as to respondent's prior rights, has not made a determination that such prior rights could invalidate the

⁵To the extent that petitioner disagrees with the Board's interpretation of the provisions in Paragraph 4 of Chapter VI, Article 20 of UPOV, that question is preserved for any possible appeal.

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Netherlands varietal name registration or even the rights provided under UPOV to that registration.

We further note that Paragraph 1 of Chapter VI, Article 20 of UPOV provides that:

The variety shall be designated by a denomination which will be its generic designation. Each member of the Union shall ensure that, subject to paragraph 4, no rights in the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right.

Thus, pursuant to Paragraph 1 above, the United States, as a signatory to UPOV,⁶ ensures the free use of the denomination of a variety unless there are prior rights in the denomination. In fact, petitioner concedes that Paragraph 1 of Chapter VI, Article 20 of UPOV is subject to a third-party's prior rights. See p. 8 of petitioner's motion for reconsideration.

Given the foregoing and contrary to petitioner's arguments, the Board maintains that a genuine dispute exists as to whether respondent has established prior rights in the United States in the term CAMPARI based upon the record before

⁶The United States is a member of the International Convention for the Protection of New Varieties of Plants (UPOV) and adheres to the 1991 text of UPOV, which is implemented by, *inter alia*, the United States Plant Variety Protection Office. Manual of Patent Examining Procedure ("MPEP") Section 1612 (8th ed. rev. 2004); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:36 (4th ed. 2011).

us. As noted above, petitioner argues that respondent has not used the mark CAMPARI any earlier than November 16, 1995, a date subsequent to the June 20, 1995 designation by Enza Zaden of the Campari varietal name. We note, however, that in the declaration of Paul Mastronardi, submitted in support of respondent's opposition to petitioner's motion for summary judgment, he declares:

1. In December 1994, Mastronardi chose the trademark CAMPARI for tomatoes. Enza Zaden was not involved in the selection of the trademark;
2. Mastronardi first sold tomatoes under the CAMPARI trademark in 1995;
3. Attached as Exhibit A to my declaration is an invoice dated November 16, 1995, to R.A.M. Produce in Detroit, Michigan for CAMPARI tomatoes;
4. In 1995, Mastronardi sold approximately \$15,000 worth of CAMPARI tomatoes in the U.S.

By his declaration, Mr. Mastronardi does not specify when in 1995 respondent first sold tomatoes under the Campari trademark. Further, Mr. Mastronardi, in his declaration, does not declare that respondent first used its CAMPARI trademark for tomatoes on November 16, 1995, as petitioner contends; rather, the November 16, 1995 invoice was submitted to demonstrate trademark use of the CAMPARI mark by respondent

during 1995. Accordingly, based upon the foregoing and because the Board does not decide questions of fact on summary judgment, the Board's finding that a genuine dispute of material fact exists as to when respondent first used the CAMPARI mark as a trademark in 1995, and if such use commenced prior to the June 20, 1995 designation by Enza Zaden of the Campari varietal name, was not in error.

Moreover, the question of whether respondent has established prior rights in the term CAMPARI necessarily includes consideration of the public's perception of the term CAMPARI in relation to tomatoes at the time respondent first used the term CAMPARI and any time thereafter. In other words, even if respondent establishes prior rights in the United States such that the UPOV registration does not render the term generic in the United States, the question of whether that term has become generic since respondent's first use would also require consideration of the public's perception of the term CAMPARI. Accordingly, consumer perception may be critical in the Board's final disposition of this case and, therefore, the Board's finding that a genuine dispute of material fact with respect to the public perception in the United States of the term CAMPARI in relation to tomatoes was not in error.

With regard to the Board's denial of respondent's cross-motion for summary judgment regarding petitioner's standing, upon further consideration and based upon the evidence submitted by the parties in support of their respective motions for summary judgment, we find that there are no genuine disputes of material fact that petitioner has standing to bring this action and therefore grant summary judgment in favor of petitioner on this issue.

The record demonstrates that petitioner is undisputedly a purveyor of tomato and vegetable seeds and that it was selling tomato seeds under the Campari moniker at the time this proceeding was instituted. See Supplemental Declaration of David Gingrich and attached exhibits submitted in support of petitioner's motion for summary judgment.

In summary, petitioner's motion for reconsideration of the Board's August 24, 2011 denial of petitioner's motion for summary judgment on its pleaded claim that respondent's CAMPARI mark is the varietal name for a type of tomato, and, thus, the generic name of the goods, is denied; petitioner's motion for reconsideration of the Board's decision on standing is granted and petitioner's standing is established.

Respondent is allowed until twenty days from the mailing date of this order in which to file a response to petitioner's

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motion (filed September 16, 2011) for leave to take discovery and testimonial depositions by oral examination.

Proceedings otherwise remain suspended pending the disposition of petitioner's motion for leave to take discovery and testimonial depositions by oral examination.

Finally, as a reminder, the parties are precluded from filing any further motions for summary judgment on petitioner's claim that respondent's CAMPARI mark is the varietal name for a type of tomato and, thus, the generic name of the goods identified in respondent's subject registration.