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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re J. King's Food Service Professionals, Inc.

Serial No. 75931074

Richard S. Shenier of Shenier & O'Connor for J. King's Food Service Professionals, Inc.

Barbara A. Loughran, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hohein, Walters and Rogers, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

J. King's Food Service Professionals, Inc. has filed an application to register the term "MOUNTAIN BLEND" for "coffee."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's goods, the term "MOUNTAIN BLEND" is merely descriptive of them.²

¹ Ser. No. 75931074, filed on February 25, 2000, which is based on an allegation of a bona fide intention to use such term in commerce. The word "BLEND" is disclaimed.

² Although, in the alternative, registration has also been finally refused under the same section of the statute on the basis that the term "MOUNTAIN BLEND" is deceptively misdescriptive of applicant's goods, such issue is moot and need not be further considered, if the

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested.⁴ We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of

refusal on the ground of mere descriptiveness is affirmed, and is not well taken, in the absence of a finding of mere descriptiveness, inasmuch as a deceptively misdescriptive term must plausibly, albeit falsely, convey a merely descriptive significance about the subject goods. See, e.g., In re Woodward & Lothrop Inc., 4 USPQ2d 1412, 1413 (TTAB 1987); and TMEP §1209.04 (3d ed. 2d rev. May 2003).

³ While applicant, by a certificate of mailing, timely filed a reply brief on the last day permitted by Trademark Rule 2.142(b)(1) for doing so, such brief is on legal-size paper rather than letter-size paper as required by Trademark Rule 2.142(b)(2). Recognizing its error, applicant filed a week later a second reply brief which "is slightly modified and is on letter-size paper," but such brief obviously is untimely under Trademark Rule 2.142(b)(1). However, in our discretion, we have treated the latter as a substitute for the former, which will not be given any further consideration.

⁴ In its reply, applicant states with respect to the exhibits attached to the Examining Attorney's brief that it "objects to the Examiner's abstract of the exhibits of record, weighing over a pound, for the following reasons:"

Firstly[,] the yellow highlighting providing [sic] by the Examiner in the original exhibits is not visible; secondly, the Examiner did not provide any identification numbers for these exhibits and it was left to applicant to identify them by providing the first page and identifying number of each exhibit; thirdly, the Examiner has renumbered all the exhibits, rendering the file history obscure; [and] fourthly, copies of records greater than 11 inches in length are truncated, leaving the file history provided by the Examiner incomplete.

Applicant is advised that we have followed the suggestion in its reply that "the Board rely on the original record." We have also considered, however, the "further two-page exhibit from the American Heritage Dictionary" which is attached to the Examining Attorney's brief, not only because applicant states in its reply that it "has no objection" thereto, but because it is well established that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applying the above test, the Examining Attorney maintains that the term "MOUNTAIN BLEND" merely describes a characteristic or feature of applicant's goods, namely, a blend of mountain-grown coffee. In support of her position, the Examining Attorney relies, *inter alia*, upon definitions attached to her brief from The American Heritage Dictionary of the English

Language (4th ed. 2000), which in relevant part (i) define the nouns "mountain" as "[a] natural elevation of the earth's surface having considerable mass, generally steep sides, and a height greater than that of a hill" and "blend" as "[s]omething, such as an effect or a product, that is created by blending" and (ii) set forth the verb "blend" as "[t]o combine (varieties or grades) to obtain a mixture of a particular character, quality, or consistency: *blend tobaccos*." She also refers to "excerpts of eleven (11) articles from the Lexis/Nexis database, showing reference to 'mountain coffee(s)' and coffees grown in mountainous regions," to demonstrate that "the finest coffees are those grown in mountain regions." The most pertinent of such excerpts are as follows (**emphasis added**):

"5 pounds of fresh **mountain coffee** and one live chicken." -- News and Observer (Raleigh, NC), June 23, 2000;

"The Panoramic Route ... is a two-day-minimum scenic though the interior **mountains where coffee beans grow**." -- Record (Bergen County, NJ), March 26, 2003; and

"Timor, which Indonesia invaded in 1975 and annexed the following year, has helped the coffee business. As in El Salvador and Nicaragua, the **mountain-coffee growing regions** in East Timor where insurgents lived remained isolated and free of pesticides and fertilizers." -- Washington Post, July 20, 1998.

In addition, the Examining Attorney relies upon copies of "web pages and [a] 'hit list' summary of the 'Google.com' search of 'MOUNTAIN BLEND (and) COFFEE'" to show that "the terms MOUNTAIN BLEND" are commonly used in the coffee industry and in coffee growing countries to indicate a type of coffee blend--

i.e., a blend of coffees made from beans grown in mountain regions." Among other things, such copies variously refer in pertinent part to the following: a "Gunton's Mountain Blend" coffee, which is described as "a blend of some of our best Arabicas coffees" that are "[m]ainly taken from the high grown varieties"; a "Mountain Blend Coffee," which is available from "HudsonsFood.com" as well as six other Internet retailers; a "Mountain Blend" coffee, which is described as "[a] quality blend of Kenya, Costa Rica and Colombian coffees" by "Sophie's Coffee & Tea Co." and is touted as "a blend of exclusively high grown coffees" by "HILL & VALLEY COFFEE LTD"; a "MOUNTAIN BLEND GROUND COFFEE," which is distributed by "Good Food"; a "Special Mountain Blend" coffee, which is described as "[a] classic blend of choice mountain grown beans" and is marketed by "ARAMARK REFRESHMENT SERVICES" and "ARAMARK Coffee Service"; an "African Mountain Blend" coffee, which is available from "Hyman Smith Coffee"; a "High Mountain Blend" coffee, which is offered by "DRURY FINE TEAS & COFFEES"; a "Mountain Blend (*Also in Decaf*)" coffee, which is sold by "Parrot Mountain Coffee Company"; an "Alpine (Full Roast Mountain Blend)" coffee, which is marketed by "java the hut"; and a "Nescafe Mountain Blend Instant Coffee," which is advertised by "Foreign Buyers Club." Furthermore, as the Examining Attorney points out in her brief, that the designation "MOUNNTAIN BLEND" is "indeed at least merely descriptive of the applicant's goods is shown in the applicant's own generic use of the terms 'GOURMET Mountain Blends' in its web site," which among other things references such products as a "Gourmet Mountain

Blends 100% Colombian coffee" and a "Gourmet Mountain Blend coffee."

According to the Examining Attorney, the above evidence demonstrates that combining the words "MOUNTIAN" and "BLEND" to form the designation "MOUNTAIN BLEND" results in a term which merely describes coffee which is "a BLEND of MOUNTAIN grown beans." Nothing in such term, the Examining Attorney maintains, is incongruous, ambiguous or creates a double entendre. In fact, as the Examining Attorney further points out, applicant "has repeatedly acknowledged that the combined terms MOUNTAIN BLEND are merely descriptive of coffee." Specifically, the Examining Attorney accurately notes that, in its appeal brief, applicant states that the "exhibits produced by the examining attorney show, in most instances, that 'MOUNTAIN BLEND' is descriptive of coffee" and that "the examiner flogs a dead horse" inasmuch as applicant has "conceded this point in the disclaimer of 'BLEND.'" Likewise, in its "SUPPLEMENTAL RESPONSE" to the denial of its request for reconsideration, applicant states with respect to the evidence provided by the Examining Attorney that "most [of] the highlighted reference are to 'mountain blend'"; that applicant "has agreed ... that this is descriptive"; and that, in view of applicant's having disclaimed the word "BLEND," "[t]he Examiner flogs a dead horse in proving what is already admitted--that 'mountain blend' is descriptive." In fact, as the Examining Attorney also correctly observes in her brief, throughout such response applicant "affirms that the examiner's evidence has established, and Applicant itself 'agrees', that MOUNTAIN BLEND

is descriptive of coffee." The Examining Attorney consequently concludes that "[i]n light of the abundance of evidence made of record by the examiner, and in view of the Applicant's many express admissions, it is clear that the proposed MOUNTAIN BLEND designation is at least merely descriptive ... of a feature or characteristic of the goods--i.e., coffee ... comprised of, or made from, or blended with, coffee grown in mountain regions."

Applicant, on the other hand, relies upon essentially two arguments to support its contention that the term "MOUNTAIN BLEND" is nonetheless registrable on the Principal Register with a disclaimer only of the word "BLEND." First, applicant urges that because a prior third-party registration for the mark "MOUNTAIN BLEND" and design, as reproduced below,



for "coffee" issued on the Principal Register with a disclaimer solely of the word "BLEND,"⁵ the Examining Attorney herein is likewise "required by stare decisis" to allow applicant the registration which it seeks inasmuch as "the marks are identical,

⁵ Reg. No. 1,430,441, issued on February 24, 1987, based upon Canadian Reg. No. 30311, dated May 24, 1985, and subsequently cancelled pursuant to Section 8(a) of the Trademark Act, 15 U.S.C. §1058(a). The file history for such registration, which applicant has made of record, indicates among other things that the registrant was also the owner of a registration for the mark "MOUNTAIN BLEND COFFEE" for "coffee," which issued on the Supplemental Register on February 28, 1978. That registration, which was based upon Canadian Reg. No. 242/52332, dated May 28, 1931, has expired for failure to renew such.

the goods are identical, and the question of law is identical." Second, applicant asserts that because the record shows that (i) its "search for 'MOUNTAIN COFFEE' ... revealed that in each instance the term is preceded by the name of a particular and geographically descriptive mountain--GREEN MOUNTAIN (Vermont), BLUE MOUNTAIN (Jamaica), KONA PURPLE MOUNTAIN (Hawaii), VALE MOUNTAIN (Colorado), [and] MONARCH MOUNTAIN (Idaho)" and (ii) "[n]o dictionary contains a definition of 'MOUNTAIN COFFEE,'" the word "MOUNTAIN" is not descriptive of coffee and thus the merely descriptive term "MOUNTAIN BLEND" is registrable with a disclaimer of the descriptive word "BLEND."

We agree, however, with the Examining Attorney that the preponderance of the evidence establishes that the term "MOUNTAIN BLEND" is merely descriptive of applicant's goods and that its contentions that such term is nevertheless registrable with a disclaimer of the word "BLEND" are unavailing. In particular, the record shows that, as used by applicant and others, the term "MOUNTAIN BLEND" merely describes any coffee blend containing, in whole or significant part, coffee which possesses the desirable trait of being mountain grown. Nothing in such term is ambiguous, incongruous or suggestive of a double entendre, and nothing therein requires the exercise of imagination, cogitation or mental processing, or necessitates the gathering of further information, in order for the merely descriptive significance thereof to be immediately apparent. Plainly, to coffee drinkers, the term "MOUNTAIN BLEND" immediately conveys that a principal feature or characteristic of applicant's goods is that they

constitute a blend of mountain grown coffee. Such term is accordingly merely descriptive of applicant's goods within the meaning of the statute. See, e.g., Remington Products Inc. v. North American Philips Corp., 892 F.2d 1576, 13 USPQ2d 1444, 1446-48 (Fed. Cir. 1990) [omission of word "PERSONAL" from mark "TRAVEL CARE" does not avoid descriptiveness of mark as used in connection with personal care products for travel use].

As to applicant's contention that the Examining Attorney is nonetheless bound by the doctrine of stare decisis to allow applicant the registration which it seeks, the Examining Attorney points out in her brief that, as stated by the Board in *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1410 (TTAB 1988):

The doctrine of stare decisis may be defined as the policy of courts to stand by precedent and not to disturb a settled point. See: *Black's Law Dictionary*, 5th ed. (1979). Essentially, this doctrine provides that, when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle, and apply it to all future cases, where the facts are substantially the same, regardless of whether the parties and properties are the same. *Id.* It is clear, however, that this doctrine is one of policy and whether a previous holding of the court shall be adhered to, modified, or overruled is within the court's discretion under the circumstances of the case before it. *Id.*

While, of course, any registration on the Principal Register is entitled under Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), to certain *prima facie* presumptions, including that the registration as issued is valid, applicant has not cited a single judicial decision upholding the validity, against an attack on the basis of mere descriptiveness, of the specific prior

registration upon which it relies herein. Nor has applicant, as the Examining Attorney notes in her brief, "brought to light any decision in support of its theory" that "a decision by another examiner during the ex parte prosecution of an application" is entitled, under the doctrine of stare decisis, to preclusive effect in the examination of a latter application. Instead, as the Examining Attorney further correctly observes, applicant's citation in its initial brief to *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977), "establishes that such determinations are not preclusive and that each case must be decided on its own merits" (underlining in original). In view thereof, our principal reviewing court recently reaffirmed the longstanding rule that allowance of prior third-party marks is not determinative of the registrability of an applicant's mark, stating in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), that "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court".

Furthermore, and in any event, the Examining Attorney notes in her brief that "the facts, issues and circumstances ... relied upon by applicant differ significantly from those presented here." Among other things, the Examining Attorney points out that, "due to the passage of time and the changes brought by technology, the evidence now available to the examiner to establish the merely descriptive nature of the terms MOUNTAIN BLEND is vastly different from that which was available" when the

mark "MOUNTAIN BLEND" and design, which is the subject of Reg. No. 1,430,441, was registered. She also contends that such mark, unlike the designation which applicant seeks to register, is presented "in a highly stylized script format" and contains "a distinctive design element," which are factors which would permit registration thereof on the Principal Register even if all wording, and not just the word "BLEND," were disclaimed.

Moreover, with respect to the registration for the mark "MOUNTAIN BLEND COFFEE," which is the subject of Reg. No. 1,086,720, she notes that the fact that such registration issued on the Supplemental Register, instead of the Principal Register, is evidence which "supports the examiner's present finding that MOUNTAIN BLEND" for coffee is at least merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act." See, e.g., Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) ["when appellant sought registration of SUPER BLEND [for motor oil] on the Supplemental Register, it admitted that the term was merely descriptive of its goods"]. In addition, the Examining Attorney points out that another third-party registration which is of record and is "perhaps more on point is the recent issuance [on February 19, 2002] of Registration No. 2541059 for [the mark] FORT ROYAL MOUNTAIN BLEND (in typed form) for coffee, wherein the terms MOUNTAIN BLEND are disclaimed apart from the mark as a whole." Such a disclaimer, being an admission by the registrant, constitutes evidence of the merely descriptive nature of the words "MOUNTAIN BLEND." Id. ["when appellant ... disclaimed said

term in applications for registrations of compound marks [featuring the term SUPER BLEND for motor fuel and gasoline], it again admitted the merely descriptive nature of the ... [term] and acknowledged that it did not have an exclusive right therein at that time"].

Lastly, with respect to applicant's contention that, in the absence of any dictionary evidence that the word "MOUNTAIN" is itself merely descriptive of coffee, the admittedly merely descriptive term "MOUNTAIN BLEND" is registrable with a disclaimer of the descriptive word "BLEND," the Examining Attorney is again correct that such a disclaimer is insufficient to permit registration. The reason therefore is that where, as here, a mark is not registrable because, as a whole, it is merely descriptive of the applicant's goods, it is well settled that a disclaimer of either all or only a portion of such mark will not make it registrable. See, e.g., *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991). Thus, as the Examining Attorney properly points out in her brief:

In the instant case, the subject mark ... consists, in its entirety, of the words MOUNTAIN BLEND, in typed form with no additional wording or design elements. As stated in TMEP Section 1213.06, an applicant may not disclaim all of the elements of a mark. There must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, which would make the composite registrable after the import of the disclaimer is taken into account. *See In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415 (Comm'r Pats. 1954).

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Hence, the Applicant cannot disclaim only one element of the unitary MOUNTAIN BLEND designation, nor can the Applicant disclaim the unitary MOUNTAIN BLEND designation in its entirety, since the subject mark is comprised, in its entirety, of only the words MOUNTAIN BLEND, in typed form.

Decision: The refusal under Section 2(e)(1) is affirmed.