

**THIS OPINION IS
NOT A PRECEDENT
OF THE T.T.A.B.**

Mailed: August 31, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SJP, LLC

Serial No. 76620345

Neil F. Markva for SJP, LLC.

Dominick Salemi, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Bucher, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

SJP, LLC has appealed from the final refusal of the
examining attorney to register the mark SILVERLEAF
PLANTATION (in standard character form) on the Principal
Register for services ultimately amended to "real estate
management services, namely, the operation of a planned
community" in Class 36; and "land development services,
namely, construction of a planned community development of

mixed use, gated and ungated residential, office, retail, and industrial properties" in International Class 37.¹

In his final Office action, the examining attorney has refused to register applicant's mark in view of his requirement pursuant to 15 U.S.C. §§ 1052(e)(1) and 1056(a) that applicant disclaim the term PLANTATION.

Applicant filed an appeal brief and a reply to the Examining Attorney's brief. We reverse the refusal to register.

Before turning to the merits of this case, we address several evidentiary matters.

First, on June 21, 2006, after applicant had filed a notice of appeal and after the Board had instituted this appeal, applicant filed an amendment to allege use. On July 5, 2006, the Board suspended the appeal and "remanded to the Trademark Examining Attorney for examination of the amendment to allege use." The Board's order specified that "[a]fter the Examining Attorney's issuance of either an acceptance and/or ultimate denial of the amendment, the

¹ Application Serial No. 76620345 was filed on November 12, 2004, based on applicant's bona fide intention to use the mark in commerce. In a statement of use approved by the examining attorney on August 7, 2006, applicant asserts first use anywhere and first use in commerce on September 30, 2004. On April 4, 2007, the examining attorney approved applicant's amendment (filed July 27, 2006) amending the application to one for concurrent use.

file should be returned to the Board, the appeal will be resumed and the Board will take appropriate action." In an action dated August 8, 2006, the examining attorney stated:

Applicant's amendment to allege use has been approved; however, please see the following below:

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the point(s) at issue in the final action. TMEP §715.03(a). Accordingly, applicant's request for reconsideration is denied and the requirement for a disclaimer of PLANTATION is hereby continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

In the interests of completeness, a few Lexis/Nexis Research database stories concerning "plantation-style" homes and developments have been included.

The examining attorney then provided ten Nexis excerpts with his Office action. Because the Board had remanded the application back to the examining attorney only for consideration of the amendment to allege use,² and not for further examination, and applicant never filed a request

² The examining attorney states that the additional evidence was being provided "[i]n the interests [sic] of completeness"; he did not indicate that he was providing the additional evidence in connection with any issue raised by the specimen accompanying the amendment to allege use.

for reconsideration,³ the examining attorney's submission of the ten Nexis excerpts was improper. Applicant, however, discussed these Nexis excerpts in its briefs and even submitted the full texts of a handful of the Nexis excerpts. We find that applicant has waived any evidentiary objection to the examining attorney's Nexis excerpts, including any objection applicant may have had regarding the fact that three of the excerpts are from foreign publications and one is from a wire service. See TBMP § 1208.01 (2d ed. rev. 2004) and cases cited therein. Cf. *In re Bayer Aktiengesellschaft*, 488 F.3d 960 (Fed. Cir. 2007) ("Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark.")

The second evidentiary issue concerns applicant's submission with its supplemental brief of the full text of three excerpts submitted by the examining attorney. The three articles are (i) "Mauritius: Paradise relocated [;] This jewel in the Indian Ocean is opening up to second-home buyers" by Graham Norwood from the March 15, 2006 edition

³ Applicant offered that the examining attorney considered applicant's original brief filed June 26, 2006 as a request for reconsideration.

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of *The Independent* (London); (ii) "Going Places" by Paula Crouch Thrasher from the January 25, 2004 edition of *The Atlanta Journal-Constitution*; and (iii) "Water Parks make a splash in planned communities" by Huma Khan from the April 25, 2002 edition of the *Houston Business Journal*. Pursuant to *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (applicant's submission with its brief of two augmented portions of two excerpts of articles from the Nexis database which the examining attorney submitted with his final refusal appropriate for consideration), we have considered the full text of these three articles.

The third evidentiary issue before us concerns the remaining evidence first submitted by applicant with its initial, supplemental and reply briefs. Applicant's submissions with its briefs are late because all evidence must be made of record prior to the filing of an appeal or with a request for reconsideration prior to the end of the period for appeal. Trademark Rule 2.142(d), 37 C.F.R. 2.142(d). Additionally, the examining attorney has objected to this evidence. Therefore, except for the definitions from print dictionaries submitted with applicant's initial and reply briefs, of which we take judicial notice, see *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB

1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions), we have not considered such remaining evidence filed with applicant's briefs.

The fourth evidentiary issue concerns four lists of registrations designated as "live" containing the term PLANTATION submitted by applicant with its March 30, 2006 response to an Office action. The lists were created from the Office's TESS database. They are as follows:

1. 144 registrations containing the term PLANTATION;
2. 29 registrations with PLANTATION disclaimed;
3. 7 registrations for International Class 37 services with PLANTATION disclaimed; and
4. 3 registrations for International Class 36 services with PLANTATION disclaimed.

To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted. However, because the examining attorney did not advise applicant that the listing of registrations is insufficient to make the registrations of record at a point when applicant could have corrected the error, the examining attorney has stipulated the lists of registrations into the record. See TBMP § 1208.02 (2d ed.

rev. 2004). The lists have very limited probative value because the Board only considers what is contained within the lists and they do not include the claimed goods and services. Even the International Class 36 and 37 listings have limited probative value because there are other services in such International Classes than the services listed in applicant's application and we cannot assume that listed registrations are for identical services, even if the marks for such registrations contain the term PLANTATION.

We now turn to the merits of the examining attorney's refusal. A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. *In re Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293 (CCPA 1959). It is settled that "[t]he question is not whether

someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316 - 1317 (TTAB 2002). See also *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990). As the Board has explained:

... the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537 (TTAB 1998).

The examining attorney has included the following dictionary definition of "plantation" from *The American Heritage Dictionary of the English Language* 4th ed. (2000) with his initial disclaimer requirement:

1. An area under cultivation.
2. A group of cultivated trees or plants.
3. A large estate or farm on which crops are raised, often by resident workers.

4. A newly established settlement; a colony.

He also has submitted the following excerpts of articles from the Nexis database:⁴

The Independent (London), March 15, 2006
... hotel within the complex will provide restaurants, other sports facilities and shops, in what the builder promises will be a "plantation-style development" on the island's eastern coast. ... properties in the "plantation-style" development will be sold through Erna Low ...

The Atlanta Journal-Constitution, January 25, 2004
Nestled among lush mangroves with more than half of the plantation-style development[,] a dedicated wildlife preserve and estuary, the 600-unit resort with 18 swimming pools offers sailing and fishing, beachside ...

Port Douglas and Mossman Gazette (Australia), November 7, 2002
... plunge pools, and a pool bar along with a gymnasium, café and shops. "It's Queensland-inspired, mixed with a plantation-style development," Mr. Berensten said.

Houston Business Journal, April 26, 2002
... complex, which includes the water park, sand volleyball court, eight-court tennis complex, children's playground, a southern plantation-style community center and an outdoor amphitheater.

⁴ One of the examining attorney's excerpts is from a U.S. newswire service and another is from a foreign newswire service. These articles - excerpts of which are not set forth in this decision - are given minimal consideration because we do not know to what extent, if any, the underlying articles have been distributed to the purchasing public in the United States. See TBMP 1208.01 (2d ed. rev. 2004) and cases cited therein.

Washingtonian, May 1993

Hilton Head is commonly thought of as a single entity, but the island is, in fact, a collection of plantation-style communities, such as Sea Pines, Palmetto Dunes, and Port Royal.

The Jackson Sun, June 5, 2005

... since built[,] the Jackson Area Chamber of Commerce building, the Jackson Family Practice and Central Distributors and currently is finishing a plantation-styled home on McClellan Road.

Plain Dealer, April 1, 2001

The couple moved into their cedar-sided Colonial in 1997. "Our builder, Calvin Smith, was fascinated with the Civil War era and the Southern plantation-styled homes," said Irish-Snyder.

The Commercial Appeal (Memphis), September 12, 1996

On Wednesday, family members gathered nearby at the Snowden Hose in Horseshoe Lake, the family's plantation-styled home that had been converted into a bed and breakfast.

In first making his disclaimer requirement in his March 15, 2006 Office action, the examining attorney found PLANTATION to be merely descriptive because "it informs the public of the type of property [applicant] is operating." In his August 8, 2006 Office action, the examining attorney added evidence concerning "plantation-style homes and developments" without explaining how PLANTATION is merely descriptive of the services in light of this evidence. Subsequently, in his brief, the examining attorney stated that PLANTATION should be disclaimed because the "[u]se of

'plantation' to identify [applicant's] services, merely serves to inform the potential purchasing public that the applicant's planned communities, whether managed or the subject of its development services, involve 'plantation-styled' buildings." Brief at unnumbered p. 1. At p. 4 of his brief, he states that "the term, when applied to objects such as buildings are designed to evoke something of a fairly large character fashioned in a tropical style." Brief at unnumbered p. 4.

We find that the examining attorney has not made a prima facie case that PLANTATION is a merely descriptive term in the context of applicant's services under any of the bases he has asserted during the prosecution of the application.

To the extent that the examining attorney maintains that PLANTATION is merely descriptive of a "type of property," we disagree. With respect to the first two definitions of "plantation" noted above, i.e., "an area under cultivation" and "a group of cultivated trees or plants," the examining attorney has not established that planned communities contain "a group of cultivated trees or plants," or "area[s] under cultivation." The same holds true of the "type of property" referenced in the third definition of "plantation," namely, a "large estate[s] or

farm[s] on which crops are raised, often by resident workers"; there is no evidence that planned communities contain or comprise such large estates or farms on which crops are raised. Further, if the examining attorney intended to base his disclaimer requirement on the assertion that applicant's services are provided in connection with land which was once part of a plantation, we are not persuaded. There simply is no evidence that the purchasing public would view the term PLANTATION in applicant's mark as informing purchasers of a previous use of the land that now contains the planned community.

Similarly, under the fourth definition of "plantation" set forth above, i.e., a "newly established settlement; a colony," we are not persuaded that the term is merely descriptive of a "type of property." *The American Heritage Dictionary of the English Language* (4th ed. 2000) defines "settlement" in relevant part as "a small community."⁵ Under this definition, the connotation of the term "plantation" would be "a newly developed small community,"

⁵ The definition of "settlement" submitted by applicant with its brief is from *WordNet 2.1 Vocabulary Helper*. This definition was not made of record prior to the filing of the notice of appeal and the Board does not take judicial notice of online dictionaries. See TBMP § 1208.04 (2d ed. rev. 2004). Thus, we give no further consideration to this definition from *WordNet 2.1 Vocabulary Helper*. Rather, we take judicial notice of the definition of "settlement" from *The American Heritage Dictionary of the English Language*.

but in the context of a colony. Applicant's services certainly do not entail the creation or management of colonies. Also, the Nexis excerpts submitted by the examining attorney do not support this connotation.

Rather, the excerpts in which the phrase "plantation style development" appears suggest large scale developments for many people, with "restaurants, other sports facilities and shops," *The Independent*; 600 units with 18 swimming pools, *The Atlanta-Journal Constitution*; and plunge pools, pool bar, gymnasium, café and shops, *Port Douglas and Mossman Gazette*.

In view of the foregoing, we find that there is no specific meaning of PLANTATION as used in connection with "a type of property."

To the extent that the examining attorney maintains that PLANTATION is merely descriptive of a style of building, housing or architecture that will exist in planned communities which applicant develops or manages, we disagree. There is nothing in the juxtaposition of PLANTATION next to SILVERLEAF that would indicate to the purchasers of applicant's services that PLANTATION is a reference to a housing style that exists in the planned communities. If such purchasers would even come to the realization that the term in applicant's mark is a

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reference to a housing style, this would only be after much thought and consideration and would not be immediate. Also, the insignificant amount of evidence in the record, i.e., just two Nexis excerpts referring to "plantation style[d] home[s]" from the *Plain Dealer* and *The Commercial Appeal*, and the one excerpt referring to a "southern plantation-style community center" from *Houston Business Journal*, does not establish prima facie that there is a style of building or home known as "plantation-style" buildings or homes.

Applicant has correctly pointed out that the examining attorney's Nexis excerpts all show use of "plantation-style" rather than just "plantation"; that the public's understanding of "plantation-style" is unknown and uncertain; and that there is no dictionary definition of "plantation-style." We add too that "style" is necessary in addition to "plantation," and possibly even the word "homes," to provide the meaning ascribed to by the examining attorney, and that without the term "style" and even "homes" in the mark, the purchasing public will not perceive the meaning advocated by the examining attorney.

As another argument in support of his disclaimer requirement, the examining attorney stated that "the term, when applied to objects such as buildings are designed to

evoke something of a fairly large character fashioned in a tropical style." Brief at unnumbered p. 4. Applicant is not seeking registration of its mark in connection with buildings, and there is no evidence that purchasers would consider the term PLANTATION in applicant's mark as referring to buildings. Also, even if the impression of PLANTATION in applicant's mark evokes "something of a fairly large character fashioned in a tropical style," this "something" is simply too intangible to make an immediate association with applicant's services.

In view of the foregoing, we find that the examining attorney has not established that "plantation" merely describes a significant characteristic, feature or function of applicant's applied-for services and therefore has not established that the term is merely descriptive of such services. See *In re MBAssociates*, 180 USPQ at 339.

Decision: The requirement for a disclaimer of "PLANTATION" is reversed.