

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
August 8, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Onion International, Inc.

Serial No. 76660662

Dallas G. Thomsen of Sussman Shank LLP for American Onion International, Inc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Rogers, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

American Onion International, Inc. filed a use-based application on the Principal Register for the mark "Patagonia SweetReds," in standard character format, for "fresh onions," in Class 31. During the prosecution of the application, applicant disclaimed the exclusive right to use the term "SweetReds."

The Trademark Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act of 1946, 15 U.S.C. §§1051, 1052 and 1127, on the ground that "Patagonia" is a varietal name for onions. The Trademark

Manual of Examining Procedure provides the following guidance (emphasis added):¹

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. **They amount to the generic name of the plant or seed by which such variety is known to the public.** These names can consist of a numeric or alphanumeric code or can be a "fancy" (arbitrary) name. The terms "varietal" and "cultivar" may have slight semantic differences but pose indistinguishable issues and are treated identically for trademark purposes.

If the examining attorney determines that wording sought to be registered as a mark for live plants, agricultural seeds, fresh fruits or fresh vegetables comprises a varietal or cultivar name, then the examining attorney must refuse registration, or require a disclaimer, on the ground that the matter is the varietal name of the goods and does not function as a trademark under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. See *In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006) (upholding the USPTO's long-standing precedent and policy of treating varietal names as generic, and affirming refusal to register REBEL for grass seed because it is the varietal name for the grass seed as evidenced by its designation as the varietal name in applicant's plant variety protection

¹ "While the TMEP is not established law, but only provides instructions to examiners, it does represent the PTO's established policy on varietal names that is entitled to our respect. We see no reason to differ with it." *In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1763 (Fed. Cir. 2006).

certificate); *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942), *cert. denied* 318 U.S. 782, 57 USPQ 568 (1943); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231 (TTAB 1963); *In re Cohn Bodger & Sons Co.*, 122 USPQ 345 (TTAB 1959). Likewise, if the mark identifies the prominent portion of a varietal name, it must be refused. *In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993) (Board affirmed refusal to register DELTAPINE, which was a portion of the varietal names Deltapine 50, Deltapine 20, Deltapine 105 and Deltapine 506).

TMEP §1202.12 (5th ed. 2007).

In support of his refusal, the Examining Attorney submitted a printout from the United States Department of Agriculture Vegetable Database indicating that "Patagonia" is a varietal name for onions² and a printout from the UPOV (International Union for the Protection for new Varieties of Plants) database indicating that, effective February 1, 2006, the term "Patagonia" had been accepted as a plant variety name for onions.³

In opposition to the refusal to register, applicant submitted a letter dated November 7, 2007 from Dr. Bill D.

² The printout displayed an October 30, 2006 date.

³ The United States is a party to the UPOV. International Convention for the Protection of New Varieties of Plants of March 1991. H.R. Rep. No. 2927, 103d Cong., 1st Sess. 6377 (1994). See also *In re Pennington Seed Inc.*, 80 USPQ2d at 1763; *In re KRB Seed Co.*, 76 USPQ2d 1156, 1159 (TTAB 2005).

Serial No. 76660662

Dean, the production manager for River Point Farms.⁴ Dr. Dean has a Bachelor and Masters degree, as well as a Ph.D. in horticulture, and he has extensive experience in agriculture. Dr. Dean conducted an investigation into the use of the term "Patagonia" and learned that "the name was proposed for a new onion variety but that it has been 'dropped' from the offerings of Bejo Seed (the originator)." This conclusion is based on an email, dated November 19, 2007, from Rich Pollard at Bejo Seed Company stating that "Patagonia is on the 'discontinue list' so the coast is clear." The primary problems with the information from Rich Pollard are that it does not explain the significance of the "discontinue list," the source and effect of the "discontinue list," and how the "discontinue list" affects the registration of a varietal name by the Department of Agriculture, as well as the UPOV. While Mr. Pollard claims that "Patagonia" is on the "discontinue list," it is still listed as a varietal name by the Department of Agriculture and the UPOV.

⁴ River Point Farms appears to be related to applicant because the letter "is in regard to our [River Point Farms] request to use the name Patagonia for our Sweet Onion program in Chile."

Serial No. 76660662

According to Dr. Dean, the printout from the United States Department of Agriculture Vegetable Database indicating that "Patagonia" is a varietal name for onions does not mean that the term was ever used.

The list of names provided to you by the USDA AMS Seed Regulatory and Testing Branch is used by plant breeders to determine if a name has already been used for a variety they may want to develop or introduce the variety (sic). It does not mean that the name was necessarily ever used in commerce (this information was obtained via private communication with Dr. Chris Cramer of New Mexico State University who is an onion plant breeder).

Whether the name "Patagonia" was ever used in commerce as a varietal name does not have any bearing on whether that name has been registered as a varietal name. The evidence shows that it was registered as a varietal name and that the name still exists on the registry of the USDA and UPOV. Therefore it is still considered to be a varietal name by those agencies.⁵

Dr. Michael Harvey, a USDA Research Geneticist and Professor of Horticulture at the USDA and the University of Wisconsin, gave Dr. Dean a list of onion cultivars

⁵ Applicant has not cited, nor have we been able to find, any requirement that a varietal name must be "used" to be registered by either the USDA or UPOV. See the Plant Variety Protection Act, 7 USC §2321 *et. seq.*, the Plant Variety Protection Act Rules and Regulations, 7 CFR, Part 97, and the UPOV.

Serial No. 76660662

published by the American Society of Horticultural Science in 2002 that did not include the term "Patagonia." Dr. Harvey's list was not made of record. Nevertheless, the USDA and UPOV databases evidence registration of "Patagonia" as a varietal name as of 2006. Therefore, even if Dr. Harvey's list was made of record, it would not be relevant because it preceded the USDA and UPOV registrations of "Patagonia" as a varietal name.

Finally, Dr. Dean reported that he communicated with three other notable persons in the agricultural field and that none of them had ever heard of a "Patagonia" variety of onions. Setting aside the hearsay nature of this evidence, the fact that the declarants have not heard of "Patagonia" as a varietal name has no bearing on the fact that it has been registered as a varietal name by the USDA and UPOV. Moreover, the "testimony" of only three witnesses that they have never heard of the term "Patagonia" used as a varietal name for onions is insufficient to rebut the Examining Attorney's evidence that "Patagonia" has been registered as a varietal name by the USDA and UPOV.

Because the Examining Attorney has shown that "Patagonia" has been registered by the USDA and UPOV as a

Serial No. 76660662

varietal name for onions, it is not entitled to trademark registration. *In re Pennington Seed, Inc.*, 80 USPQ2d at 1759. and 1761 ("the varietal name 'Rebel' is generic and hence is not entitled to trademark registration).

Even assuming, *arguendo*, that "Patagonia" is a varietal name for onions, applicant points out that it is seeking to register the mark "Patagonia SweetReds," not just the word "Patagonia." However, applicant has disclaimed the term "SweetReds" in response to the Examining Attorney's contention that "SweetReds" is a variety of onions.⁶ Indeed, the Examining Attorney submitted two websites referencing "sweet red onions" as a variety.⁷ The addition of a highly descriptive term, such as "SweetReds," to a varietal or generic name does not alter the primary significance of "Patagonia" as a varietal name for onions. *Cf. In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986) (the addition of the highly descriptive word "Digital" to the mark CAMBRIDGE DIGITAL and design does not detract from the primary geographic

⁶ October 30, 2006 Office Action.

⁷ Territorial Seed Company (www.territorial-seed.com) (October 30, 2006 Office Action) and a newspaper article retrieved from the LexisNexis database published on September 1, 2006 in what appears to be *Grocery Headquarters* ((May 22, 2007 Office Action). There were also other articles and recipes referencing "sweet red onions" in the two Office Actions.

Serial No. 76660662

significance of the mark); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (the addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness). *See also In re JT Tobacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA held primarily geographically descriptive of wine club membership services); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN ("PIZZA KITCHEN" disclaimed) held primarily geographically descriptive of restaurant services).

Applicant also argues that "Patagonia SweetReds" should be registered because it has registered the mark "Patagonia Sweet Onions"⁸ and the mark "Patagonia SweetReds" is more distinctive than "Patagonia Sweet Onions." Applicant's prior registration does not rebut our finding that the term "Patagonia" is a varietal plant name. We

⁸ Registration No. 3407690, issued April 8, 2008. Applicant disclaimed the exclusive right to use "Sweet Onions."

must decide each case on its own merits. The actions of a different Examining Attorney do not bind this Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Finally, applicant requests that if the Board finds that its mark is not entitled to registration on the Principal Register that it should be registered on the Supplemental Register.⁹ An applicant may take alternative positions with respect to a refusal to register. TBMP §1215 (2nd ed. rev. 2004); TMEP §1202(c) (5th ed. 2007).

As indicated above, during the prosecution of the application, the Examining Attorney adopted the position that the term "SweetReds" is a generic term.¹⁰ With the exception of the excerpt from the Burpee website (www.burpee.com),¹¹ all of the references are to "sweet red onion(s)," not "sweet reds." The excerpt from the Burpee website references hamburger size onions with "sweet, red and white flesh." The Examining Attorney's references show

⁹ Applicant's November 21, 2007 Request for Reconsideration; Applicant's Brief; and Applicant's Reply Brief.

¹⁰ October 30, 2006 Office Action (the term "SweetReds" describes a feature of applicant's goods because "the onions are of the sweet red variety"); May 22, 2007 Office Action ("the addition of the generic SWEETREDS does not overcome the refusal. "Sweet red" is merely the generic designation for a sweet red onion").

¹¹ October 30, 2006 Office Action.

Serial No. 76660662

the term "sweet red" used as an adjective to describe onions. The references do not use the term "sweet reds" as a generic term for an onion (e.g., no recipe calls for one diced sweet red). In fact, there are no references to "sweet reds" *per se*.¹² Accordingly, the evidence shows that the term "SweetReds" is descriptive, but not generic.

In view thereof, applicant's mark "Patagonia SweetReds" is capable of registration on the Supplemental Register.

Decision: The refusal to register "Patagonia SweetReds" is affirmed. However, if, within thirty days from the date of this order, applicant deletes the disclaimer of the term "SweetReds," and disclaims the exclusive right to use the word "Patagonia" apart from the mark as shown, this decision will be set aside and the application will be forwarded to issue on the Supplemental Register.¹³

¹² There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The Examining Attorney has failed to show that "Sweet Reds" is a class of onions.

¹³ Pursuant to Trademark Rule 2.142(g), the Board may permit an application to disclaim matter after rendering an opinion in an *ex parte* appeal.