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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pan American Grain Manufacturing
v.
Goya Foods, Inc.

Cancellation No. 92044086
to Registration No. 2742689
issued on July 29, 2003

Eugenio C. Romero, Esq. for Pan American Grain Manufacturing.

Stephen L. Baker of Baker and Rannells for Goya Foods, Inc.

Before Hohein, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Pan American Grain Manufacturing has filed its petition to cancel the registration of Goya Foods, Inc. for the word mark VALENCIA RICE for "rice," in International Class 30.[1]

As grounds for the petition, petitioner asserted that respondent's mark, when applied to respondent's goods so

[1] Registration No. 2742689, issued on July 29, 2003, and was filed as an application on March 17, 2000, based on use in commerce, alleging first use anywhere and in commerce as of January 2, 2000.

resembles petitioner's previously used mark VALENCIA for rice as to be likely to cause confusion, under Section 2(d) of the Trademark Act. Petitioner also asserted as a ground, in the alternative, that VALENCIA is a generic term for a type of rice.

Respondent, in its answer, denied the salient allegations of the claims and asserted, affirmatively, that petitioner has no ownership rights in "the mark," that petitioner has no rights in "the mark" superior to those of respondent, that the respective consumers of the parties' goods are discriminating purchasers, and respondent asserts estoppel, laches and acquiescence.

The Record

Petitioner submitted all of its evidence by notice of reliance. However, under Trademark Rule 2.122(e), 37 CFR § 2.122(e), only certain types of evidence are amenable to submission by notice of reliance, namely, "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue."

Respondent's answers to Interrogatories, as submitted by petitioner, and the portions of third-party application

serial no. 75362423 are properly of record.[2] See Trademark Rule 2.120, 37 CFR § 2.120. However, the documents produced by respondent in response to a document production request are not properly of record by notice of reliance and have not been considered. See Trademark Rule 2.120 (j)(3)(ii), 37 CFR § 2.120(j)(3)(ii). Likewise, the excerpts from Internet websites are not properly of record by notice of reliance and have not been considered. *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, n.3 (TTAB 2004); and *Raccioppi v. Apogee Inc.* 47 USPQ2d 1368 (TTAB 1998). *See also TBMP* Section 704.08 (2d ed. rev. 2004) ("The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed from the Internet"). Petitioner makes reference to several of its submissions as having been submitted earlier by either petitioner or respondent in connection with motions filed during this proceeding. Such materials are not part of the record at trial unless properly introduced at trial and have not been considered except as noted herein.

[2] The excerpts from the third-party application include a refusal by the examining attorney to register VALENCIA for rice. The print-outs from the Lexis/Nexis database attached thereto do not contain legible references to Valencia. Petitioner's argument is not well taken to the extent that it argues that the Board must find Valencia Rice generic herein because the examining attorney issued a refusal on the ground of mere descriptiveness in the application. The Board is not bound by the decisions of examining attorneys and, moreover, the Board must decide each case on its own facts. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Therefore, the record consists of the pleadings; the file of the involved registration; the responses of respondent to petitioner's interrogatories, excerpts from a third-party application file, printouts of pages from a cookbook and dictionary definitions, all made of record by petitioner's notice of reliance. Respondent submitted no evidence and only petitioner submitted a brief on the case.

Preliminary Matters

First, because respondent submitted no evidence or brief, we consider its equitable defenses of estoppel, laches and acquiescence to be waived and we have given them no consideration. We also note that these defenses are unavailing in relation to opposer's claim of genericness.

Second, petitioner's evidence is directed entirely to its claim that respondent's mark is generic for a type of rice. In its brief, petitioner states that its "grounds for requesting … cancellation will be strictly limited to the claim for genericness of the term 'Valencia rice' …." (Brief, p. 1.) Therefore, we consider petitioner's claim under Section 2(d) to be waived and we have given it no further consideration. Similarly, respondent's affirmative assertions in its answer pertain to the likelihood of confusion claim and have been given no further consideration.

Factual Findings

Respondent first used Valencia Rice in connection with rice in February 1992. (Interrogatory Response no. 3 "Int. Res. 3".) Respondent does not advertise or promote Valencia Rice except occasionally "with a group of rice products including GOYA Valencia Rice, GOYA Basmati Rice, GOYA Arborio Rice, and GOYA Jasmine Rice." (Int. Res. 7.) Respondent sells its goods at wholesale to distributors, independent brokers and operators of retail grocery stores and supermarkets in a number of states throughout the United States. (Int. Res. 11.)

The Classic Mediterranean Cookbook by Sarah Woodward (1995) includes a section entitled "Grains" which lists "couscous, bulgur wheat, polenta and rice." In connection with "rice" the book pictures three different rice grains and labels them as "Valencia rice," "Basmati rice," and "Arborio rice." *Webster's New World Dictionary of Culinary Arts* (1997) contains a definition of "Valencia rice" as "a short- to medium-grain rice that does not become creamy when cooked: has a nut-like flavor and is used principally for paella."

Analysis

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The class or category of goods in this case is "rice," as identified in the involved registration. The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra*.

The dictionary and cookbook references to “Valencia Rice” clearly support the conclusion that the relevant public, i.e., the general consumer, will understand the term “Valencia Rice” as identifying a type of rice. The use of the term “Valencia Rice” by respondent in its response to Interrogatory No. 7 is consistent therewith. Therefore, we conclude that respondent’s mark, VALENCIA RICE, is generic in connection with rice. While our conclusion would be better supported if petitioner had properly submitted its

evidence into the record, we find the existing record sufficient to warrant our conclusion that the mark is generic in connection with the identified goods.

Decision: The petition to cancel is granted.