CAFC TRADEMARK APPEAL CLOSE-OUT SHEET

DOCUMENTS FOR SCANNING

TO: Angela Pope DATE: 12/18/06

FILE NO.: 76/289,621

CASE NAME: KRB Seed Co. (Pennington Seed)

DATE APPEAL FILED: 11/8/05 DATE DISPOSED: 10/19/06

DISPOSITION: Affirmed

DOCUMENTS ATTACHED:

☑ DECISION ☑ MANDATE ☑ APPELLANT'S BRIEF (BLUE)

☑ APPELLEE'S BRIEF (RED) ☑ REPLY BRIEF (GRAY)

☐ OTHER: _____

NEEDS ABANDONMENT ENTERED ☐ YES ☑ NO

United States Court of Appeals for the Federal Circuit

06-1133
(Serial No. 76/289,621)

IN RE PENNINGTON SEED, INC.
(mark formerly owned by KRB Seed Company, LLC)

Howard A. MacCord, Jr., MacCord Mason PLLC, of Greensboro, North Carolina, argued for appellant.

Stephen Walsh, Associate Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for appellee. With him on the brief were John M. Whealan, Solicitor, and Nancy C. Slutter, Associate Solicitor. Of counsel was Heather F. Auyang, Associate Solicitor.

Appealed from: United States Patent and Trademark Office
Trademark Trial and Appeal Board

United States Court of Appeals for the Federal Circuit

06-1133
(Serial No. 76/289,621)

IN RE PENNINGTON SEED, INC.
(mark formerly owned by KRB Seed Company, LLC)

DECIDED: October 19, 2006

Before MICHEL, Chief Judge, LOURIE, Circuit Judge, and ELLIS,* District Judge.

LOURIE, Circuit Judge.

DECISION

Pennington Seed, Inc. ("Pennington") appeals from the decision of the United States Patent and Trademark Office ("PTO") Trademark Trial and Appeal Board (the "Board") refusing registration of the term "Rebel" as a trademark for a variety of grass seed. In re KRB Seed Co., 76 U.S.P.Q. 2d 1156 (T.T.A.B. 2005). Because the Board correctly determined that the applied-for mark is the generic designation for that variety of grass seed and hence is not entitled to trademark registration, we affirm.

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* Honorable T.S. Ellis, III, District Judge, United States District Court for the Eastern District of Virginia, sitting by designation.

BACKGROUND

On July 25, 2001, KRB Seed Company, LLC (hereinafter referred to as "Applicant") filed an application to register the word "Rebel" as a trademark for grass seed. Applicant had previously designated the term "Rebel" as the varietal (or cultivar) name for a grass seed that was the subject of a plant variety protection ("PVP") certificate, issued on May 14, 1981. The trademark examining attorney refused registration of the applied-for mark under 15 U.S.C. §§ 1051, 1052, and 1127 on the ground that it was a varietal name for a type of grass seed, and thus that the name was the seed's generic designation. Applicant appealed the examiner's decision to the Board and, upon request by the examiner, the Board remanded the appeal to the examiner to address Applicant's claim of acquired distinctiveness under 15 U.S.C. § 1052(f). Upon remand, the examiner refused the registration under 15 U.S.C. § 1052(f) and made final his refusal to register the term "Rebel" as a trademark for grass seed.

Applicant appealed to the Board, and the Board affirmed the examiner's decision. The Board first found that the evidence conclusively established that the term "Rebel" is a varietal name for a type of grass seed. Thus, the Board observed that the only issue before it was whether the PTO's long-standing precedent and policy of treating varietal names as generic was still valid. After reviewing prior case law, the Board concluded that the PTO's policy was still valid. In reaching its conclusion, the Board rejected Applicant's argument that the PTO had incorrectly applied Dixie Rose Nursery v. Coe, 131 F.2d 446 (D.C. Cir. 1942), in which the District of Columbia Circuit determined that the term "Texas Centennial" could not be registered as a trademark because it was the

varietal name for a particular rose. The Board observed that Dixie Rose did not set forth a special test from which to judge genericness, but simply established that varietal names were not subject to trademark protection.

The Board also found support for its decision in the Trademark Manual of Examining Procedure ("TMEP"), which instructs examiners to refuse registration of varietal names because such names do not function as source indicators. Additional support was provided by the International Convention for the Protection of New Varieties of Plants ("UPOV"), which provides, inter alia, that a name for a new plant variety must be designated and that that designation will be its generic name, and by Section 52 of the Plant Variety Protection Act ("PVPA"), 7 U.S.C. § 2422, which requires that an application for a PVP certificate include the name of the plant variety.

The Board further determined that Applicant's reliance on TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001), for the holding that a claimed feature of an expired patent could nevertheless function as a trademark was misplaced. According to the Board, an applicant must provide a name for a variety of plant when applying for a PVP certificate, and that requirement is a clear indication "that the name of the varietal is in the nature of a generic term." In re KRB Seed, 76 U.S.P.Q. 2d at 1159. In light of the case law, the UPOV, the PVPA, and the TMEP, the Board declined to disturb its policy of treating varietal names as generic designations.

Applicant timely appealed, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

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