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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Farmer Bros. Co.

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Serial No. 74/488,107

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Billy A. Robbins and Clark D. Gross of Robbins, Berliner & Carson for applicant.

Darlene D. Bullock, Trademark Examining Attorney, Law Office 101 (Chris Wells, Managing Attorney)

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Before Rice, Hanak, and Quinn, Administrative Trademark Judges.

Opinion by Rice, Administrative Trademark Judge:

Farmer Bros. Co. has filed an intent-to-use application to register the mark EARL GREY'S BEST for teas.<sup>1</sup>

Registration has been refused under Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1), on the ground that EARL GREY'S BEST, when applied to teas, is merely descriptive of them. Specifically, the Examining Attorney maintains that

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<sup>1</sup> Application Serial No. 74/488,107 filed February 8, 1994 under the provisions of Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b), based upon applicant's allegation of a bona fide intention to use the mark in commerce.

Earl Grey is a well-known flavor or blend of tea, that the word "best" is laudatory, and that the mark as a whole gives the commercial impression that applicant's tea is the best blend of Earl Grey tea.

In support of the refusal to register, the Examining Attorney has made of record a dictionary definition of the word "best,"<sup>2</sup> and 25 story excerpts from the NEXIS database offered to show that Earl Grey is a famous blend or flavor of tea.<sup>3</sup>

Applicant agrees that Earl Grey is a well-known flavor or type of tea. However, applicant maintains that the combination of two or more admittedly descriptive elements may result in a composite which is not descriptive; that this is true of applicant's mark; and that considered as a whole, the mark EARL GREY'S BEST, because of its possessive structure, suggests that the product bearing the mark is the best an individual (or perhaps a titled aristocrat) named Earl Grey has to offer--that the product is the finest or best that is owned or produced by an individual named Earl Grey. Under the circumstances, it is applicant's position that while the mark may also convey an impression which may possibly be descriptive, as argued by the Examining

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<sup>2</sup> The Examining Attorney's evidence shows that the adjective "best" is defined in Webster's II New Riverside University Dictionary (1984) as, *inter alia*, "exceeding all others in excellence, achievement, or quality: most excellent" and "most satisfactory, suitable, or useful: most desirable."

<sup>3</sup> The Examining Attorney, citing the NEXIS story excerpts, notes that Earl Grey tea was named for the Earl of Grey, a British prime minister in the 1830's.

Attorney, it is not "merely" descriptive. Applicant also argues that competitors and the industry have no need to use EARL GREY'S BEST, rather than Earl Grey, to describe teas having the distinctive Earl Grey flavor.

In support of its position, applicant cites the Examining Attorney's NEXIS evidence, which includes no instances of use of EARL GREY'S BEST or even EARL GREY'S in reference to tea. In addition, applicant has made of record a photocopy of a tea bag and tea bag box for Earl Grey tea sold by Bigelow, offered to show the manner in which a competitor refers to its Earl Grey tea;<sup>4</sup> a computer printout of information concerning a third-party registration, namely, Registration No. 1,492,470 issued on the Principal Register to Celestial Seasonings, Inc. for the mark EXTRAORDINARY EARL GREY (EARL GREY disclaimed) for herb tea;<sup>5</sup> and a dictionary definition offered to show that the

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<sup>4</sup> Both the tea bag and the box bear at their top the mark BIGELOW, in stylized capital letters, and thereunder, in large letters, the designation "Earl Grey" and then, in smaller letters (except for the word TEA) the wording "Named after a British nobleman this TEA is renowned in international circles."

<sup>5</sup> In order to make a third-party registration properly of record in a proceeding such as this, a soft copy of the registration itself, or the electronic equivalent thereof, i.e., a printout of a registration taken from the electronic records of the Patent and Trademark Office's own data base, must be submitted. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In the present case, the printout submitted by applicant is not a printout from the automated system of the Patent and Trademark Office. Instead, it appears to be a printout from a private company's data base. However, the Examining Attorney has not objected to the third-party registration on this basis, but rather has offered arguments relating to the probative value of the registration. Accordingly, we have considered the registration in our determination of this case. We add that our decision would be the same even if we excluded this registration.

"possessive" designates or pertains to denoting ownership or some relation felt as analogous.<sup>6</sup>

A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re American Screen Process Equipment Co.*, 175 USPQ 561 (TTAB 1972). The question of whether a mark is merely descriptive must be determined not in the abstract, 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. See *In re Abcor Development Corp.*, *supra*. The combination of two descriptive terms may result in the creation of a valid mark where the combination creates a new and different commercial impression from that of its individual components, and the new and different commercial impression thus created is not itself merely descriptive in significance. See *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *In re Disc Jockeys Inc.*, 23

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<sup>6</sup> The term "possessive" is defined in Webster's Collegiate Dictionary (5th ed.) as, inter alia, "Gram. Designating or pertaining to the case in English denoting ownership or some relation felt as analogous ...."

USPQ2d 1715 (TTAB 1992); and In re Ron Matusalem, Inc., 196 USPQ 458 (TTAB 1977).

In the present case, we agree with applicant that because of its possessive structure, the mark EARL GREY'S BEST, when applied to tea, immediately conveys the fanciful impression that Earl Grey is a living individual, and that the tea on which the mark is used is his best tea. Thus, although the mark may also convey descriptive significance, i.e., that this is the best of the Earl Grey teas, we conclude that the mark is not *merely* descriptive. To the extent that we have any doubt on the matter, we resolve that doubt, as we must, in favor of applicant.

Decision: The refusal to register is reversed.

J. E. Rice

E. W. Hanak  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board

Quinn, Administrative Trademark Judge, dissenting:

I respectfully dissent.

I begin with applicant's acknowledgment that Earl Grey is a well-known flavor or type of tea. Indeed, the NEXIS evidence clearly establishes this fact. Thus, when this flavor or type name is combined with "best", as used in connection with tea, the combination is merely descriptive. That is, EARL GREY'S BEST is laudatorily descriptive of tea that is purported to be the best blend or best tasting Earl Grey tea.

In saying this, I recognize that Earl Grey tea was named for the Earl of Grey. However, I question how many of the relevant purchasers will even be aware of this fact. Rather, I believe it more likely that average purchasers in a supermarket will ascribe the commonplace meaning to Earl Grey as applied to tea, that is, a flavor or type of tea. I think that this is especially likely given that these consumers will see Earl Grey being used as a flavor or type of tea by a variety of producers.

I simply do not find that the possessive structure, in the words of the majority, "immediately conveys the fanciful impression that Earl Grey is a living individual, and that the tea on which the mark is used is his best tea." To the contrary, I agree with the Examining Attorney that the mark immediately conveys information about a quality of the tea, namely, that the tea is the "most excellent" or best Earl Grey flavor or blend on the market. Thus, I would prefer

that a laudatorily descriptive mark such as applicant's be kept available to competitors. See: *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978).

I would affirm the refusal to register.

T. J. Quinn  
Administrative Trademark  
Judge, Trademark Trial  
and Appeal Board