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THE TTAB

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Poulsen Roser ApS

Serial No. 76399744

Louis K. Ebling of Greenebaum Doll & McDonald PLLC for
Poulsen Roser ApS.

Brendan McCauley, Trademark Examining Attorney, Law Office
114 (Margaret Le, Managing Attorney).

Before Hairston, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Poulsen Roser ApS has filed an application to register
in typed drawing form SHENANDOAH for "live roses and live
clematis."¹

The trademark examining attorney has refused to
register the applied-for mark on the ground that it is a

¹ Application Serial No. 76399744, filed April 24, 2002, alleging
with respect to live roses, a date of first use anywhere and date
of first use in commerce of February 7, 2002; and with respect to
live clematis, alleging a bona fide intent to use the mark in
commerce.

varietal (or cultivare) name for applicant's roses and because varietal or cultivare names are generic designations and cannot be registered as trademarks. Sections 1, 2 and 45 of the Trademark Act. When the refusal was made final, applicant appealed to this Board. Applicant and the examining attorney have filed briefs, but no oral hearing was requested.

It is well settled "that varietal names are generic designations and cannot be registered as trademarks." In re Delta and Pine Land Co., 26 USPQ2d 1157, 1159 n. 4 (TTAB 1993) and cases cited therein. The sole issue before this Board is whether SHENANDOAH is a varietal (generic) name for a type of living rose.

In support of his refusal, the examining attorney has made of record photocopies of the relevant pages from the following: Modern Roses volumes 6, 9, and 10; Modern Roses XI The World Encyclopedia of Roses (2000); and a printout from a website entitled "Roses Help Me Find." The four reference works each have a listing for the term "Shenandoah." The most recent entry from Modern Roses XI reads as follows:

'SHENANDOAH', LC1, dr, 1935; bud long, pointed; flowers crimson, large, semi-dbl., exhibition form, intense fragrance; foliage large, glossy; vigorous, climbing (10 ft) growth; [Etoile de Hollande X Schoener's Nutkana]; Nicolas; C-P

While in different formats with slight variations, the above entry contains virtually the same information as do the entries contained in Modern Roses 6, 9 and 10.² In addition, the website "Roses Help Me Find" contains essentially the same definition.

In view of this evidence, the examining attorney maintains that SHENANDOAH is a varietal name for live roses.³

Citing in re Merrill, Lynch, Pierce, Fenner & Smith, Inc., 5 USPQ2d 1141, 1143 (Fed. Cir. 1987), applicant argues that genericness must be proven by a substantial

² With respect to listings in the Modern Roses works, we note that data is arranged in the following manner:

Listing of main entries will generally be by 'variety denomination' or code name (i.e., the cultivar name appears in single quotes with the first three letters in capitals indicating breeder and the remainder in small caps) with the ARS exhibition name identified in bold typeface carrying a trademark symbol if requested by the registrant. (e.g. 'ANTopp').

The ARS approved exhibition name will appear in bold face type. In a small number of cases the lack of a code name will automatically default to the fancy name becoming both the registered cultivar name (single quotes, small caps) and the ARS exhibition name (bold), e.g. 'ADRIENNE BERMAN'.

³ Also in support of the refusal, the examining attorney submitted a copy of a Board decision which is not designated as citable precedent. The Board disregards citation to any non-precedential decision (unless it is asserted for res judicata, law of the case, or other issues not involved herein). See TBMP §101.03 and cases cited therein.

showing based on clear evidence which is not present in this case. In particular, applicant argues that the examining attorney's evidence is inadequate to establish that SHENANDOAH is a varietal name for roses.

With respect to the Modern Roses reference works, in particular, applicant argues:

First, the [Modern Roses] text is published by The American Rose Society, which comprises rose enthusiasts, not professional rose breeders. Second, a number of entries appear in the publication as trade names or even as registered trademarks, making it unclear as to whether a particular entry identifies a varietal name or other name: The preface to the publication explicitly notes that "the absence of "TM" or "@" symbols in this publication should not be regarded as an indication that these words, designations, or names are not trademarks." Logically, the fact that this publication admittedly includes trademarks disqualifies it as an authoritative source to "prove" that a given term is a varietal name and not a trademark. This publication is not relied upon in horticultural taxonomy as an authoritative source, and no evidence has been provided establishing the authority of the publication as such. Put simply, this publication is created by rose enthusiasts for broader, informal reference purposes. Thus, Applicant asserts that the information contained in this reference is not by itself reliable as proof positive of use of a name as a varietal name. (emphasis in original) (Response to Office action dated 2/24/03)

According to applicant, "[v]arietal names are generally denominated through Latin binomial naming: the first term in the binomial nomenclature is capitalized and identifies the plant genus, and second non-capitalized term

identifies the species. In this instance, the varietal name given to the hybrid species sold by Applicant under its SHENANDOAH mark is POULege, hence, the term "POUL" in the name refers to the genus of the variety, and "ege" refers to the particular species." (footnote omitted). In addition, applicant maintains that the examining attorney failed to locate information in the sources referenced in the Trademark Manual of Examining Procedure with respect to showing that a term is a varietal name, e.g., laboratories and repositories of the United States Department of Agriculture, plant patent information from the USPTO, and a variety name search of plants certified under the Plant Variety Act. Finally, applicant argues that its own evidence refutes the examining attorney's contention that SHENANDOAH is a varietal name for roses. In this regard, applicant submitted product labels for its roses; printouts from the United States Plant Variety Protection Office database which show an entry for "Shenandoah" tall fescue grass; pages downloaded from applicant's Internet homepage which show that applicant offers several roses as part of its "National Parks Rose Collection" including "Shenandoah™ Poulege (N)"; pages downloaded from the website plantsdatabase.com which give detailed information on the "Floribunda Rose Everglades (1999; aka Soren Kanne,

POULege)"; pages downloaded from the website of the Canadian plant breeders' rights office which reflects a Canadian registration for the POULege hybrid strain; pages downloaded from the website helmefindroses.com confirming registration for the POULege varietal name by the applicant in Canada; pages downloaded from the websites of two nurseries which offer for sale applicant's SHENANDOAH roses; and copies of applicant's promotional materials for its "National Parks Rose Collection." Finally, applicant argues that the evidence in this case is not clear and that any doubt must be resolved in its favor.

After careful consideration of the record and arguments herein, we find that the evidence submitted by the examining attorney establishes that SHENANDOAH is a varietal name for roses.

The examining attorney has submitted pages from four separate editions of Modern Roses and a website all of which list SHENANDOAH as a varietal (generic) name for a type of rose. With respect to applicant's specific criticism of the examining attorney's reliance on the Modern Roses works, we recognize that no reference work is infallible. Moreover, it is not uncommon for reference works (e.g., dictionaries) to contain disclaimers of the nature of that set forth in the preface in the Modern Roses

works. Nonetheless, applicant has offered no evidence which suggests that the Modern Roses works are in error when they list Shenandoah as a varietal (generic) name for roses. If applicant believed that these works were in error, he could have contacted the editors or publishers to have letters of correction issued. We note that Modern Roses XI is described as "The Most Comprehensive Listing of Roses in the World." Further, applicant has offered no affidavits or declarations from buyers of roses— such as individual rose growers, landscapers or nurserymen— to the effect that they view SHENANDOAH as a trademark of applicant, and not as a varietal (generic name). Applicant's failure to submit such evidence as to how purchasers of roses in the United States perceive SHENANDOAH is significant. See *Delta Pine Land Co.*, 26 USPQ2d ["Such evidence (affidavits or declarations) showing how the asserted mark is actually perceived ... by the relevant public would have been helpful to applicant's case."]

In addition, we disagree with applicant's contention that the listing in Modern Roses is entitled to little weight because this work is published by the The American Rose Society, whose members are rose enthusiasts rather than professional rose breeders. Genericness is determined

from the standpoint of the relevant purchasers of the goods and rose enthusiasts are obviously purchasers of roses.

The examining attorney has acknowledged that he was unable to locate evidence with respect to SHENANDOAH in the sources listed in the TMEP. However, we do not view this as fatal to the examining attorney's case. The sources listed in the TMEP are mere examples of publications and databases on which examining attorneys may rely. Examining attorneys certainly are not prohibited from relying on publications and databases not listed therein.

Further, the fact that SHENANDOAH is the varietal name for a type of grass does not mean that it cannot also be the varietal name of a type of rose. Applicant has submitted no evidence which shows that a varietal name may be used to identify only one type of plant.

The use of SHENANDOAH by applicant and commercial nurseries on labels and promotional materials is not persuasive of a different result herein. Applicant's intent that SHENANDOAH function as a trademark is not controlling. Similarly, any rights that applicant may have in SHENANADOAH in Canada is not dispositive of whether it is entitled to registration in the United States.

Finally, although it appears that POULege is the varietal name accorded by applicant to its roses, it is not unusual for a product to have more than one generic name. In this case, the evidence submitted by the examining attorney establishes that the relevant purchasers would perceive SHENANDOAH as the varietal name of applicant's roses.

Decision: The refusal to register is affirmed.