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TTAB: “Prominent Portion” of Varietal Name Cannot Be Registered as Trademark

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Those involved in the field of IP protection for plant varietals should be aware of the recent precedential opinion of the Trademark Trial and Appeal Board (TTAB or board) in *In re International Fruit Genetics LLC* (Serial No 88711192, 22 November 2022) (Lykos ATJ). In line with general public policy fostering competition and preventing monopolies, the board held that proposed marks that constitute the “prominent portion” of a varietal denomination are unregistrable under the Trademark Act, Sections 1, 2 and 45, because they are generic for the varietals they identify (Id at 39).

Background

The applicant applied to register the mark IFG for “fresh fruits and vegetables; live plants; live trees; live grape vines; live plant material, namely, live grape vine material, live plant material and live tree material” (*Id* at 1). The applicant claimed ownership of a prior valid and subsisting trademark registration for the mark IFG for “live plants, namely, table grape vines, cherry trees” (*Id* at 1-2). The USPTO refused registration on the ground that the proposed mark identified the “prominent portion” of a varietal name for the identified goods, and thus did not indicate the source of the applicant’s goods or identify and distinguish them from others (*Id* at 2). On appeal, the board affirmed the refusal to register.

TTAB Decision

The board made a preliminary determination based on the USPTO’s evidence that IFG, standing alone, was not the entire varietal name for the identified goods (*Id* at 23). Rather, IFG was the first component of numerous varietal names for grapes, grapevines, grapevine plants, sweet cherry trees and cherries, which are agricultural and produce products that are encompassed within the scope of the identified goods (*Id*). The three questions before the board were as follows:

1. Is the “prominent portion” of a varietal name barred from registration because it is the equivalent of a generic designation?

2. Does the record show that IFG is a “prominent portion” of the varietal names of record for the identified goods?

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3. Does this constitute an absolute bar to registration given the applicant's prior registration of the same mark, where such registration issued prior to the application ling dates of any of the plant patents or plant breeder's rights and purported prior trademark use? (*Id* at 23-24).

First, the board concluded that the "prominent portion" of a varietal name cannot be registered as a trademark (*Id* at 25). Granting a trademark registration for the "prominent portion" of a varietal name would be anti-competitive, because it would allow one entity to have exclusive trademark rights in a generic term (*Id* at 24-25, applying the logic of *In re Pennington Seed Co* (466 F3d 1053, 80 USPQ2d (Fed Cir 2006)), where the US Court of Appeals for the Federal Circuit affirmed the USPTO's long- standing precedent and practice of treating varietal names as generic). Since varietal names are the equivalent of generic terms, these names are therefore incapable of functioning as source indicators or acquiring distinctiveness under Section 2(f) of the Trademark Act (*Id* at 25).

Next, the board concluded that IFG constitutes the "prominent portion" of the varietal names of record for the identified goods (*Id* at 31). The "prominent portion" of a varietal name is "the dominant portion most likely to be remembered by the purchaser" (*Id* at 29, quoting *In re Delta & Pine Land Co* (26 USPQ2d 1157, 1158 (TTAB 1993)), affirming the refusal to register DELTAPINE, finding that DELTAPINE was the "prominent portion" of various varietal names for plants and seeds Deltapine 50, Deltapine 20, Deltapine 105 and Deltapine 506). The board found that prospective consumers are likely to remember and focus on the initial letter string "I-F-G" and pronounce it when calling for the goods (*Id* at 29, 31-32).

Having determined that IFG is the "prominent portion" of the varietal names of record of the identified goods, the board was left with the question of whether the applicant's prior trademark registration overcame the refusal and concluded that it did not (Id at 32: "The fact that [the a]pplicant owns a valid and subsisting trademark registration consisting solely of the term "IFG" for in-part identical goods does not alter the outcome). The board focused on the fact that the varietal denominations bearing IFG as the prominent portion for the identified goods had already been publicised to consumers via the applicant's plant patents and PVP certificates (*Id* at 33). Even though the applicant could have chosen a designation other than IFG to associate as a brand name and file for trademark protection, the applicant instead risked the integrity of its IFG trademark by using IFG to name new varietals (*Id*). "[The a]pplicant cannot now inhibit current and future public use of those varietal denominations because of its decision-making" (*Id*). Further, "[b]y making a deliberate decision to select IFG as the prominent portion of the varietal names of the identified goods, [the a]pplicant self-abrogated its own trademark rights, exposing its prior trademark registration to potential cancellation in an *inter partes* proceeding" (*Id* at 38-39).

Comment

In light of this precedential opinion, practitioners should be aware that trademark protection will not be extended to the prominent portion of a varietal name. The prominent portion is the dominant term that is most likely to be remembered by the purchaser and used in ordering the goods. In other words, even if the proposed mark does not consist of the full name of any plant varietals specified in the application, the USPTO will likely refuse registration if the proposed mark is found to be a prominent portion of any identified varietals.

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