

## **I. DESCRIPTIVENESS REFUSAL**

### **A. The Mark Is Not Merely Descriptive of the Goods in Class 21**

A mark is considered merely descriptive if it immediately conveys knowledge of a quality or characteristic of Applicant's goods. TMEP § 1209.01(b). Applicant's FRIESLING mark is not descriptive of "Glassware, namely, drinking glasses, bottle openers, mugs" in International Class 21 because Applicant's FRIESLING mark does not convey a quality or characteristic of the glassware.

A suggestive term differs from a descriptive term, which immediately tells something about the goods or services, because a suggestive term requires imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985). Even if a term is known and has some significance in a particular field, it is not necessarily associated with different goods if it does not **immediately** describe any particular characteristic, feature, use or purpose of the goods. *See In re Great Northwestern Enterprises, LLC*, Ser. No. 7871887 (TTAB 2004) (TTAB held mark suggestive based on doubts as to whether the phrase "would convey forthwith, without conjecture or speculation, information about any significant attribute" of applicant's goods). For example in *BIC Corps. v. Far Eastern Source Corp.*, the court held: "although the name WITE-OUT is logically related to its use, the phrase without more does not imply a correction product." No. 99-cv-11385, 2000 WL 1855116 (S.D.N.Y. Dec. 19, 2000).

Here, the Examiner asserts that the term FRIESLING references an alcoholic beverage based on frozen Riesling wine. However, the term FRIESLING does not immediately describe any particular quality or characteristic of the glassware goods without the additional application of perception, imagination or reasoning. Similar to the term WITE-OUT in *BIC Corps. v. Far Eastern Source Corp.*, the term FRIESLING may be logically related to the use of Applicant's goods, but the term, without more, does not imply a glassware product.

Since Applicant's FRIESLING mark does not immediately describe a quality or characteristic of Applicant's glassware goods in International Class 21, it is not merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and the refusal should be withdrawn.

### **B. The Mark Is Not Merely Descriptive of the Goods in Class 32**

A mark is considered merely descriptive if it immediately conveys knowledge of a quality or characteristic of Applicant's goods. TMEP § 1209.01(b). Further, "the distinctiveness of a mark cannot be determined in the abstract, but only by reference to the goods or services upon which the mark is used." *Electropix v. Liberty Livewire Corp.*, 178 F. Supp. 2d 1125, 1130 (C.D. Cal. 2001) quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, § 11:64 (4th ed.2000) (The court held that the term "Live Wire" was arbitrary for the services of post-production work in film and television because there was no association between the mark and the quality or nature of Plaintiff's service).

Here, Applicant's FRIESLING mark is not descriptive of "Non-alcoholic beverages" in International Class 32 because the FRIESLING mark does not convey a quality or characteristic of non-alcoholic beverages. The Examiner defined the term FRIESLING as a "wine based cocktail consisting in part of frozen Riesling wine," and provided several exhibits that all referenced alcohol as an essential component of the beverage. Since the descriptiveness of Applicant's FRIESLING mark can only be determined by reference to Applicant's goods, the term FRIESLING, given its association with alcohol, is not descriptive of Applicant's non-alcoholic beverages.

Due to the direct and exclusive reference to alcoholic beverages in the Examiner's assessment of the term FRIESLING, Applicant's FRIESLING mark is not descriptive of "Non-alcoholic beverages" in International Class 32 and the refusal should be withdrawn.

**C. The Mark Is Not Merely Descriptive of the Goods in Class 33**

The context in which the mark is used in connection with the goods, and the possible significance the mark would have to the average purchaser of the goods in the marketplace should be considered. TMEP § 1209.01(b) The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). The average consumer of Applicant's products will be of low sophistication regarding the combination of the word "frozen" with a specific type of wine in connection with "Alcoholic beverages" in International Class 33.

The average consumer would not recognize Applicant's FRIESLING mark as merely descriptive. The Examiner cited Internet evidence from [www.punchdrink.com](http://www.punchdrink.com), and [www.lushlifehg.com](http://www.lushlifehg.com), and stated that "the term FRIESLING references a popular type of alcoholic beverage based on frozen Riesling wine." However, all of the exhibits cited by the Examiner offer clarification of the term FRIESLING by subsequently describing it as "frozen Riesling." Further, the FRIESLING drink and term is considered unconventional as evidenced by the blog post cited by the Examiner where the author indicates that she "actually never knew Friesling was a thing," and that the drink is better known as "frozen Riesling." Thus, while the average consumer might recognize the term "frozen Riesling," the term FRIESLING is unfamiliar to the average consumer as a descriptive term for alcoholic beverages.

Moreover, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" is synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods).

Here, Applicant's FRIESLING mark is a unitary, non-descriptive combination of the words "frozen" and "Riesling," because the average consumer does not recognize FRIESLING to refer to alcoholic beverages. Thus, the combination of terms is so unique that the FRIESLING mark is, at the very least, suggestive for Applicant's "alcoholic beverages" in International Class 33.

Based upon the foregoing, the refusal under Section 2(e)(1) should be withdrawn as to the goods in Classes 21, 32 and 33 the mark should proceed to publication. Prompt action to that end is earnestly solicited.

Respectfully submitted.