

OFFICE ACTION RESPONSE

Applicant's mark is LIVINGSTON, U.S. Trademark Application Serial No. 88/464,547, for use in connection with, as amended, "Seeds for planting vegetables, herbs and flowers" in International Class 31. ("Applicant's Mark"). Registration of Applicant's Mark was refused based on a finding that LIVINGSTON is a plant varietal name and is therefore generic and does not function as a trademark. The Examining Attorney also refused Applicant's Mark under Section 2(e)(4) based on a finding it is primarily merely a surname. Applicant respectfully disagrees and submits this response to the Examining Attorney's refusal based upon the following arguments.

I. LIVINGSTON IS NOT A PLANT VARIETAL NAME

The Examining Attorney argues LIVINGSTON is a plant varietal name, relying on a handful of Internet screenshots taken from the GRIN, PLUTO, and USDA plant varietal databases containing references to "Livingston." Applicant respectfully disagrees. **"Livingston" is the name of the original breeder of Applicant's plant varieties, A.W. Livingston, and it is not a plant varietal name.** "Livingston" has never been used as a plant varietal name, and certainly not for Applicant's particular seeds for planting vegetables, herbs and flowers. Rather, LIVINGSTON has been used since at least 1898 as a trademark – not a varietal name – for plant seeds originally developed by A.W. Livingston; and consumers distinguish Applicant's seeds from those of others based on its well-known LIVINGSTON trademark.

A. Legal Standard for Plant Varietal Refusal

In order to refuse registration as a plant varietal or cultivar name, the examining attorney must show the wording sought to be registered as a mark for live plants, agricultural seeds, fresh fruits, or fresh vegetables comprises a varietal or cultivar name of the goods and does not function as a trademark under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127. *See Pennington Seed*, 80 USPQ2d at 1761-62 (affirming refusal to register REBEL for grass seed because it is the varietal name for the grass seed as evidenced by its designation as the varietal name in applicant's plant variety protection certificate); *Dixie Rose Nursery*, 55 USPQ at 316 (holding TEXAS CENTENNIAL, although originally arbitrary, has become the varietal name for a type of rose; *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034, 1035 (TTAB 1979) (affirming the refusal to register COMMANDER YORK for apple trees because it is the varietal name for the trees as evidenced by use in applicant's catalogue); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231, 231-32 (TTAB 1963) (upholding the refusal to register CHIEF BEMIDJI as

a trademark because it is the varietal name for a strawberry plant and noting that large expenditures of money does not elevate the term to a trademark; *In re Cohn Bodger & Sons Co.*, 122 USPQ 345, 346 (TTAB 1959) (holding BLUE LUSTRE merely a varietal name for petunia seeds as evidenced by applicant's catalogs).

The Trademark Trial and Appeal Board and the federal courts have acknowledged it can be difficult to find credible evidence establishing plant varietal significance. Many plant trademarks are arbitrary and may not have clear plant varietal significance. The Trademark Manual of Examining Procedure ("TMEP") explains: "Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult area for the examining attorney in terms of gathering credible evidence and knowing when to make refusals." TMEP § 1202.12. Thus, the examining attorney has the burden of proving that a term is generic (or a plant varietal name) by clear evidence. *See, e.g., In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014).

B. LIVINGSTON is the Name of the Breeder, Not a Varietal

Here, there is no plant varietal name called LIVINGSTON. *See* Declaration of Rebecca Sears. LIVINGSTON is a well-known trademark for vegetable, herb and flower seeds, named after the original breeder who first used the mark to identify the seed breeder in the 1850s. *Id.* Livingston is famous for bringing to the market edible tomato varieties. Before his time, tomatoes were thought to be ornamental and perhaps even poisonous. *See* attached Internet article discussing Livingston and the history of the edible tomato.

The GRIN, PLUTO, and USDA database excerpts upon which the Examining Attorney relies refer to "Livingston" as the historically significant breeder, not as a plant varietal name. This is evidenced by the possessive in the tomato plant name LIVINGSTONS BEAUTY, for example. "Livingston" appears before "Beauty" to indicate the tomato was developed by A.W. Livingston in the 1800s. Applicant has further attached an image of a historical catalog cover circa 1987 depicting "Beauty" as a varietal name developed by Livingston in 1886. This shows the varietal

name is “*Beauty*,” not “Livingston,” which merely refers to the breeder. The catalog over also refers to “*Livingston’s Varieties*,” including the varietal names “Gold Ball,” “Rose Peach,” “Royal Red,” etc., further demonstrating “Livingston” is used to identify the breeder and not the plant varieties he developed. **The evidence clearly shows “Livingston” is used as a possessive to identify the original breeder of the tomato, not as a plant varietal name.** The plant varieties shown in the GRIN were never known as “Livingston,” and modern varieties do not use this name. Today, “Livingston” is never used as a plant varietal name for any of Applicant’s plant seeds for vegetables, herbs and flowers.

A.W. Livingston’s name was apparently included in the GRIN, PLUTO, and USDA plant databases by well-meaning individuals for the purpose of identifying Livingston and his company as the *breeder*, not to identify the plants, which use different varietal names as shown in the databases. As a result, these databases appear to contain some old entries which are misleading because they contain the possessive “Livingston’s” when that name is simply used to identify the *breeder* for historical context, and not the plant varieties themselves.

Further, according to Applicant’s knowledge, LIVINGSTON has never been used in connection with a plant patent, utility patent, or certificate for plant-variety protection for Applicant’s vegetable, herb and flower seeds. *See* Sears Decl. Applicant owns and uses the LIVINGSTON trademark, placing it prominently at the top of its webpage and product packaging. *See* Applicant’s specimen, attached hereto; *see also* attached history of the LIVINGSTON brand, including Applicant’s acquisition of the trademark from its predecessor. Consumers encountering LIVINGSTON recognize Applicant’s well-known mark and understand LIVINGSTON seeds come from Applicant and not other seed companies.

Overall, the small number of references to “Livingston” – many of which are in the possessive form -- merely refer to the historically significant breeder of the plants, A.W. Livingston. These references do not establish Applicant’s LIVINGSTON mark is a varietal name. Nor do these references refer to Applicant’s seeds, which are vegetable, herb and flower seeds, not Kentucky Bluegrass, walnut, or almond trees. All of these are excluded in Applicant’s goods ID, which covers only “seeds for planting vegetables, herbs and flowers” Simply put, **LIVINGSTON is the name of the original breeder and Applicant’s trademark, but it is not a varietal name for Applicant’s applied-for vegetable, herb and flower seeds.** Accordingly, the refusal should be withdrawn.

II. LIVINGSTON HAS ACQUIRED DISTINCTIVENESS UNDER SECTION 2(F)

Applicant submits its mark LIVINGSTON has acquired distinctiveness through its (and its predecessor's) continuous and substantially exclusive use of the mark in U.S. commerce for plant seeds for over five (5) years – specifically, since at least as early as 1898, which was more than a century ago. A statement of five years' use will normally be sufficient to establish acquired distinctiveness of a surname. TMEP § 1212.05(a). Applicant's LIVINGSTON seeds are very well-known and consumers associate the LIVINGSTON mark with Applicant and its high-quality seeds. Accordingly, the mark has acquired distinctiveness under Section 2(f) and should be approved for publication on the Principal Register.

III. CONCLUSION

Based on the foregoing, LIVINGSTON is not a plant varietal name, and it has acquired distinctiveness in the minds of consumers through Applicant (and its predecessor's) use of the mark for more than a century. Accordingly, Applicant respectfully requests that the refusals be withdrawn and that Applicant's Mark be published for opposition.