

In Re Application of : 90009521  
APPLICANT : I&T ENTERPRISE, INC.  
MARK : “ST25”

Commissioner for Trademarks  
P.O. Box 1451  
Arlington VA, 22313-1451  
Attention: Examiner

*Re: Applicant’s response to Office Action*

Dear Examiner:

### **REMARKS**

Applicant responds to the initial refusal to register by submitting the following arguments in support of registration.

### **INTRODUCTION**

The examining attorney has refused registration on the Principal Register because the proposed mark is generic or merely descriptive of Applicant’s goods. As discussed below, Applicant respectfully believes that the examiner has failed to meet its burden of showing by clear and convincing evidence that Applicant’s “ST25” mark is either generic or merely descriptive, but that Applicant’s mark is in fact inherently distinctive because it is either suggestive, arbitrary, or fanciful.

In support of the refusal, the examining attorney has its refusal solely based upon the evidence submitted in a Letter of Protest dated June 7, 2021. It should be highlighted that prior to this Letter of Protest, the Examiner had allowed Applicant’s Application for publication without any previous substantive rejections, including any merely descriptiveness rejections.

Furthermore, it should be noted that the Letter of Protest dated June 7, 2021 seems to be self-serving materials submitted by the country of Vietnam in a bad-faith attempt to unfairly restrict, and/or prevent the legal use of the “ST25” in the United States of America.

For the reasons below, the Letter of Protest evidence is irrelevant and does not establish a *prima facie* case of either genericness or merely descriptiveness.

## THE LETTER OF PROTEST EVIDENCE IS IRRELEVANT TO THE APPLICANT'S "ST25" MARK WITHIN THE UNITED STATES

The Letter of Protest cited three pending Trademark Application Serial Nos. 90085988, 90103840 and 90270383 as evidence in support that the "ST25" mark is merely descriptive.

First, Application Serial No. 90085988 (the "988 Application") was filed on the mark "NO. 1 VIETNAM'S ST25 RICE THE WORLD'S BEST RICE," which should be noted that this application was fully reviewed by the assigned Examiner and **did not receive any Section 2(e)(1) rejection** on the "ST25" term portion of the mark. Indeed, the '988 Application was abandoned for failure of the Application to file a response to an outstanding office action requiring issues with the '988's Application's specimen, classification description and disclaimer. Thus, the '988 Application should have no relevance or given any weight to support any Section 2(e)(1) merely descriptiveness rejection arguments.

Second, Application Serial No. 90270383 (the "'383 Application) was filed on a design mark that contained, among other design elements and words, the term "ST25" as part of the design mark. Again, here the '383 Application was also reviewed by the assigned Examiner and also **did not receive any Section 2(e)(1) rejection** on the "ST25" term portion of the mark. Thus, the '383 Application should have no relevance or given any weight to support any Section 2(e)(1) merely descriptiveness rejection arguments.

Although the Third Application, Serial No. 90103840 (the "'840 Application), was filed on the mark "ST25" and did receive an initial Section 2(e)(1) rejection, this should have very little probative value with regards to the review of Applicant's mark. Indeed, Trademark examining attorneys are not bound by the actions of past examining attorneys in prior registrations/applications similar to the application at issue and each case is decided on its own merits. See *In re Ma In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). In addition, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969).

Thus, the ‘840 Application should also have no relevance or given any weight to support any Section 2(e)(1) merely descriptiveness rejection arguments.

The other purported evidence submitted in the Letter of Protests consisting of how Applicant’s “ST25” mark is viewed in Vietnam will be addressed below.

**APPLICANT’S “ST25” MARK IS NOT GENERIC BECAUSE THE CORRECT TEST IS THE PRIMARY SIGNIFICANCE OF THE “ST25” MARK TO RELEVANT PURCHASERS WITHIN THE UNITED STATES NOT VIETNAM**

Pursuant to 15 U.S.C. §1064(3), it is well settled that the correct test for genericness is namely the primary significance of the mark to the relevant public and that a mark shall not be deemed to be generic name of goods/services solely because such mark is used as a name of or to identify a unique product or service. This “primary significance to the relevant public,” test was confirmed to be the correct test by the recent Supreme Court ruling in *Booking.com* case and agreed that “under the Lanham Act, the consumer is king.” *United States Patent and Trademark Office et. Al. vs. Booking.Com B.V.*, 591 U.S. No. 19-46 (2020).

The facts of the recent case involving the UGG trademark in *Deckers Outdoor Corporation v. Australian Leather Pty Ltd et. al.* (1:16-cv-03676) are nearly identical in this matter and should be considered controlling precedent along with the *Booking.com* case. On summary judgment, the District Court held that the UGG trademark was not generic for sheepskin boots in the U.S., even if there was some evidence that the UGG term may be viewed generically in Australia, because it held that the proper test for genericness was the primary significance of the mark to the relevant public, which in the UGG case, was deemed to be footwear consumers within the United States. On appeal, the Court of Appeals of the Federal Circuit affirmed the District Court’s ruling (without opinion).

Here, in support of its genericness rejection, the Examiner relies heavily, if not solely, on the evidence submitted with the Letter of Protest filed by the NOIP of Vietnam, which purports to show how the “ST25” term is viewed in Vietnam. In particular, the Letter of Protest consists of a collection of articles referencing the purported history of how the “ST25” brand/variety of rice was created and how the country of Vietnam views the “ST25” term to identify a variety of award-winning rice.

However, it is clear that the evidence with regards to how the “ST25” term is viewed in Vietnam is not relevant to the proper test to determine genericness of a mark within the United States. Applying the correct genericness test, it is irrelevant how the country of Vietnam views and/or uses

the “ST25” mark. Instead, it is how the primary significance of the “ST25” mark is viewed by **relevant purchasers**, which in this case would be any consumers within the United States that purchase rice products. Furthermore, it should be noted that consumers of rice within the United States should not be narrowly confined to just Asian specific demographics but to all ethnicities since rice is well known to be a popular product that is consumed and enjoyed by a broad and diverse purchasing demographic.

Here, there is no evidence of any consumer surveys, customer declarations etc... to show that relevant purchasers/consumers of rice *within the United States*, view the “ST25” as a generic term to identify a type or genus of rice, let alone support a *prima facie case* that Applicant’s “ST25” mark is generic.

Even if for arguendo purposes, the evidence submitted in the Letter of Protest shows a segment of the public in Vietnam view and uses the “ST25” term for something other than a source identifier (which it doesn’t). That is not enough to support a *prima facie case* for genericness. A term is generic when it is used *widely* not as a source identifier but to identify the product itself. “A mark is not generic merely because it has some significance to the public as an indication of the nature or class of an article.... In order to become generic, the principal significance of the word must be the indication of the nature or class of an article, rather than an indication of its origin.” *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7<sup>th</sup> Cir. 1977). Here, the evidence submitted in the Letter of Protest consists of a scattering collection of random internet articles and a purported decision by the Country of Vietnam related to how the ST25 term is viewed as a variety of an award-winning rice in Vietnam. If anything, the Letter of Protest evidence merely shows that the “ST25” term may have some significance to the public in Vietnam to identify a nature or type of rice. However, this is clearly not enough to show that the *principal significance* of the “ST25” mark is generic for rice within the United States. Indeed, “The mere fact that the public sometimes uses a trademark as the name for a unique product does not immediately render the mark generic.” *Elliot v. Google, Inc.*, 860 F.3d 1151, 1156 (9<sup>th</sup> Cir. 2017).

The simple fact is that the Letter of Protest did not include any relevant evidence that the principal significance of “ST25” term is widely viewed by the public to identify a general type or genus of rice because no such evidence exists. In fact, Applicant searched a variety of Vietnamese rice dictionaries and databases, and discovered that none of these sources revealed that the “ST25” term was used generically in the rice context. Indeed, none of these dictionaries or informative

articles specifically addressing Vietnamese rice even mentions the “ST25” term. See below links which are also printed out and attached collectively as “**Exhibit A,**” to this response.

[Rice varieties planted in Viet Nam | Tập San Việt Học \(viethocjournal.com\),](#)

[Vietnam Rice Varieties for Export | 5451, DT8 and 504 Rice \(wholesalericeph.com\) and](#)

[Types of Rice in Vietnam PDF - Vietnamese Rice PDF - Issuu](#)

If anything, the above Rice “dictionaries” evidence shows that, more likely than not, the primary significance of the “ST25” term is not viewed as a generic identification of a type or genus of rice in Vietnam.

## **THE DOCTRINE OF FOREIGN EQUIVALENTS DOES NOT ALTER THE OUTCOME AND IS INAPPLICABLE TO APPLICANT’S “ST25” MARK**

In essence, the evidence submitted with the Letter of Protest and relied upon by the Examiner is attempting to use the doctrine of foreign equivalents in order to contend that since the “ST25” term is allegedly generic and/or merely descriptive in Vietnam, it also must be generic/merely descriptive here in the United States. However, that is clearly incorrect and not supported by the facts or applicable law.

### **A. The Doctrine of Foreign Equivalents Does Not Apply Where There is No Translation For the Term “ST25”**

“Under the doctrine of foreign equivalents, foreign words from common languages are *translated* into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarities with English word marks.” *Palm Bay Imports, Inc. vs. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005)(emphasis added). In *Palm Bay Imports*, the Court took into consideration that the French word “Veuve” translates into “widow” for the purposes of comparing the similarity of the marks “Veuve Royale,” and “The Widow.” *Id.* at 1377. The Court ruled, however, that the doctrine does not apply where it is “improbable that the average American purchaser would stop and translate” the foreign word into English. In the UGG trademark case, the Court held that the doctrine of foreign equivalents did not apply because there was no need to translate the “UGG” term. Here, as similar to the UGG trademark case, the “ST25” term is not a foreign word that that needs translation into English, and thus the doctrine of foreign equivalents does not apply to Applicant’s mark.

**B. American Consumer Perceptions Control Regardless of Whether a Term Originated in a Foreign Country**

It is well settled that the rule in evaluating terms that originate in foreign countries is that the proper focus remains on consumer perceptions within the United States. See *G. Heileman Brewing Co.*, 873 F.2d at 991. In the UGG trademark case, the Court stated that even if the doctrine of foreign equivalents applied to the “UGG” term, it did not dictate a different analysis because it is the American consumer perceptions of the “UGG” mark that is controlling. The Court in *Deckers Outdoors* concluded in its summary judgment order that generic usage in Australia [of the UGG term] is not enough on its own to infer generic meaning in the United States without evidence that the “UGG” term has a generic meaning to buyers within the United States.

Here, identical to the UGG trademark case, there is no evidence in the record to show that Applicant’s “ST25” mark has a generic meaning to buyers/purchasers within the United States. For the examiner to maintain its genericness and/or merely descriptiveness rejections based solely on the perceptions of consumers *in a foreign country* would destroy a fundamental policy underlying trademark law, the law of territoriality.

**C. Holding that Applicant’s “ST25” Mark is Generic and/or Merely Descriptive Based upon the Perceptions in Vietnam Would Violate the Rule of Trademark Territoriality**

“The concept of territoriality is basic to trademark law, trademark rights exist each country solely according to that country’s statutory scheme.” *Person’s Co., Ltd. v. Christman*, 900 F.2d 1565 1568-69 (Fed. Cir. 1990) See also *Baig v. Coca-Cola Co., No. 08 C 4206*, 2009 U.S. Dist. LEXIS 44184, at \*16 (N.D. Ill May 27, 2009)(“United States trademark law is based on the doctrine of territoriality, which recognizes that “a trademark has a separate legal existence under each country’s laws and is afforded protection by those laws.”

Therefore, under the rule of territoriality, a mark can be valid in one country and generic/merely descriptive in another and owned by different parties in different countries. See, e.g. *Carcione v. Greengrocer, In., No. Civil 78-561*, 1979 U.S. Dist. LEXIS 9188, at \*3 (E.D. Cal. Oct. 12 1979)(*GREENGROCER found to be a valid trademark in the U.S. while generic in the U.K.*); *Person’s Co., Ltd.*, 900 F. 2d at 1568-69 (holding that the petitioner owned the PERSON’S mark Japan, while the respondent owned it for the same goods in the United States). The territoriality rule

is a bedrock principle of trademark law and provides important protection for brand owners in the United States and worldwide.

Thus, Applicant's right in the "ST25" mark in the United States has been and remains independent of whatever status the "ST25" term might have in Vietnam or any other parts of the world.

### **APPLICANT'S "ST25" MARK IS NOT MERELY DESCRIPTIVE UNDER SECTION 2(E)(1)**

A mark is merely descriptive under Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. "Whether a particular mark is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the possible significance that the mark is likely to have to the average/relevant purchaser encountering the goods or services in the marketplace." See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012).

Here, Applicant's "ST25" mark does not immediately convey any ingredients, qualities, or characteristics of the applied for goods, which is rice. And as discussed above, there has been no evidence in the record which shows that relevant purchasers of rice within the United States give the "ST25" any primary significance other than serving as a source identifier. Thus, there is no evidence, or not enough evidence in the record, to establish a *prima facie* case that the Applicant's mark is merely descriptive for the applied for goods (rice).

### **EVIDENCE OF RELEVANT PURCHASERS OF RICE WITHIN THE UNITED STATES SHOW THAT THE APPLICANT'S "ST25" MARK IS NOT GENERIC OR MERELY DESCRIPTIVE AND IS INHERENTLY DISTINCTIVE BECAUSE IT IS VIEWED AS A BRAND OF RICE.**

If anything, Applicant's "ST25" should be considered, at minimum, suggestive, because an average/relevant purchaser of rice within the United States would require some additional imagination, thought, or perception in order to reach a conclusion that the "ST25" mark is related to the nature of the goods (rice). See *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). Applicant's "ST25" mark could also be viewed as arbitrary since it uses common letters and numbers

but in a unique/different way with regards to rice. Either way, Applicant's mark is inherently distinctive when applied to rice products within the United States.

Indeed, Applicant hereby submits numerous customer declarations who attest under oath that they have come to identify and view Applicant's "ST25" mark as a brand of high-quality and delicious brand of rice which they look for when making their purchasing decisions. Attached as "**Exhibit B,**" are the collection of these customer declarations.

In summary, these customers all claim that they do not view the "ST25" mark to identify a general type of rice like jasmine, or basmati nor do they believe the "ST25" mark describes any characteristics or features of the rice. Moreover, these customers claim that the "ST25" mark helps them avoid confusion from other brands of rice which ensures that they are purchasing the correct brand of rice that they want. Lastly, it should be noted that some of the declarants are not Asian and thus, it further solidifies Applicant's argument that the relevant purchasers should be all purchasers/consumers of rice within the United States and should not be limited to a certain demographic.

The evidence of these relevant purchasers/customer declarations establish a *prima facie* case that Applicant's "ST25" is not generic and/or merely descriptive and is either suggestive, arbitrary, or fanciful for the applied for goods of rice. Thus, Applicant has shown that the primary significance of the "ST25" to relevant purchasers of rice within the United States is to serve as a source identifier.

## **CONCLUSION**

In view of the above, Applicant's Mark is not generic or merely descriptive. Applicant's Mark is inherently distinctive or has become highly distinctive by the Applicant's use. All of the above is persuasive evidence that Applicant's "ST25" mark is used as a source identifier and that the relevant purchasers view Applicant's "ST25" Mark as a brand of rice within the United States.

Applicant respectfully requests the Examining Attorney to withdraw any pending rejections and move this Application toward allowance.

DATE: December 6, 2021

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