

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark application of:

Applicant: Regenerative Organic Alliance  
 Serial No.: 88745352  
 Mark: REGENERATIVE ORGANIC CERTIFIED  
 Filed: January 2, 2020  
 Examining Attorney: Charles Hiser, Law Office 129

RESPONSE TO OFFICE ACTION

Applicant Regenerative Organic Alliance hereby re-submits the following response that was submitted on February 9, 2022 to the Examining Attorney’s Office Action dated June 2, 2021.

I. Introduction

The Examiner has initially refused registration on the Supplemental Register of Applicant’s certification mark for REGENERATIVE ORGANIC CERTIFIED for:

Raw grains, raw processed or packaged fruits, vegetables; Textiles, yarns, threads, fabrics, fibers and apparel; dairy and eggs; Processed or packaged grains, cereals, food ingredients” (“the Certified Goods”); and

Growing, production and processing of raw, processed or packaged grains, cereals, food ingredients, dairy products, processed or packaged fruits by farmers, growers, ranchers, producers and processors moving from conventional farming to regenerative organic farming, production and processing methods; Production, manufacturing, processing, packaging, distribution, storage, marketing and retail store services featuring raw, processed or packaged fruits, fibers, and dairy products by producers, manufacturers, processors, packers, distributors, restaurants, traders and retailers moving from conventional farming to regenerative organic farming, production and processing methods” (“the Certified Services”)

under Trademark Act Section 23(c) on the grounds that the mark is generic. For the reasons provided below, Applicant submits that the mark is not generic and respectfully requests that the Examiner allow the Application to proceed to registration on the Supplemental Register.

II. Applicant’s Response to The Examiner’s Inquiry for Additional Information.

As an initial matter, Applicant responds to the Examiner’s request for additional information:

1. Applicant hereby submits factsheets, manuals, brochures, advertisements and screenshots of Applicant’s website as it relates to the goods and services in the application, including any materials using the terms in the applied-for mark. Ex. A.

2. There are no other entities that currently certify similar goods and services with regards to regenerative organic farming.
3. The typical consumer of applicant's goods and/or services is a health-conscious consumer who seeks more natural, sustainable and environmentally-friendly goods and services. The certification mark serves to assure shoppers that their purchase makes a positive impact at every level: environmentally, ethically, and socially.

Applicant also invites the Examiner to visit its "Resources" page for additional information, as well as materials containing the certification standards. See <https://regenorganic.org/resources/>.

### III. REGENERATIVE ORGANIC CERTIFIED is Not Generic

The Examiner concludes that Applicant's mark is generic because "regenerative organic" is a "known type of farming practice and consumers would merely see the certification mark as certifying that the goods and services were produced and provided in meeting that specific farming standard."

Applicant respectfully disagrees and argues that Applicant's mark is a revolutionary certification that focuses on three core pillars: soil health, animal welfare, and social fairness. While it may incorporate other more well-known standards like organic farming, it also evaluates farm labor conditions, crop rotation, tillage, animal welfare and other factors. Applicant's standards are the first of its kind to certify such a holistic approach to farming and other production and retail services and consumer goods. It is this unique combination of standards that sets Applicant's certification mark apart.

Moreover, and importantly, consumers do in fact perceive Applicant's mark as certifying that the goods or services bearing Applicant's mark satisfy a specific set of standards *set by Applicant* that go far beyond a "known type of farming practice." Applicant has expended significant effort to develop these standards. As a result, consumers, producers and retailers have grown (and will continue to grow) to recognize Applicant's mark as certifying Applicant's high standards.

#### i. The Public Perceives REGENERATIVE ORGANIC CERTIFIED as Certifying Applicant's Rigorous Standards.

The test for determining whether a mark is generic is its primary significance to the relevant public. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991) (citations omitted). To determine whether a mark is generic, there is a two-step inquiry:

- (1) What is the genus of goods and/or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

*In re Cordua Rests., Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016) (citations omitted); *see also* TMEP §1209.01(c)(i).

The relevant public's perception is the chief consideration in determining whether a term is generic. *In re GJ & AM, LLC*, 2021 USPQ2d 617, at \*5 (TTAB 2021) (citations omitted). Indeed, the Supreme Court recently and unequivocally held that "whether a term is generic depends on its meaning to consumers." *See USPTO v. Booking.com B.V.* ("Booking.com"), 140 S.Ct. 2298, 2305 (2020) ("That should resolve this case: Because 'Booking.com' is not a generic name to consumers, it is not generic.").

Here, the relevant public – farmers, producers, consumers and retailers – recognize Applicant's mark as a certification mark with very specific standards set by Applicant, and not merely a generic term for a type of farming. *See* Ex. B; *id.*, p. 6 ("it's the most rigorous evaluation of farming and business practices that we've seen"). Applicant has invested significant funds and efforts to create and market its standards that incorporate social welfare as well as regenerative and organic agriculture practices. As a result, over 27,000 farmers participate in the program (encompassing over 40 farms), more than 160,000 acres are certified and at least 20 brands are licensed to use the certification mark, with over 168 applicants. *See* Ex. C (Marketing summary).

Applicant also disagrees that its mark is generic since it is also the only organization that certifies "regenerative organic" for farming practices in the US and its certification program, although relatively new, has received widespread media and consumer recognition. *See* Ex. B; *see also In re The Council on Certification of Nurse Anesthetists ("CRNA")*, 85 USPQ2d 1403, at \*30 (TTAB 2007) (CRNA not generic for Certification of Nurse Anesthetists and noting that applicant was the "sole body recognized to certify registered nurse anesthetists in the United States, and that applicant's certification program is recognized by research hospitals and state agencies which govern nursing practice").

The burden of proving genericness falls on the Examiner, who must present "clear evidence of generic use." *CRNA*, 85 USPQ2d at \*21 (citing *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *see also In re Gould Paper Corp.*, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

Here, the Examiner has not presented clear evidence of generic use since all but one of the articles submitted by the Examiner that mention "regenerative organic" reference Applicant.<sup>1</sup> Every article submitted (save one regarding a Brazilian certification mark and two others that do not reference the phrase "regenerative organic" at all) actually references Applicant's certification mark and thus show that the public associate this phrase with Applicant's

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<sup>1</sup> The one article that does not reference Applicant's mark focuses on a Brazilian farmer and his efforts to create a certification mark in Brazil. *See* <https://medium.com/presencing-institute-blog/regenerative-organic-can-feed-the-world-1d7a410d0441>.

certification standards. This is key – that the public does not perceive the REGENERATIVE ORGANIC CERTIFIED mark as generic. *See Booking.com*, 140 S.Ct. 2298 at 2305.

Even assuming that certain third party use refers to a more general farming practice, such use also references Applicant's certification mark. The Board addressed this and concluded that, even if there is evidence where third parties use a generic term and a brand name in the same post, such evidence was sufficient to cast doubt on any finding of genericness, especially where (as there is here) there is extensive evidence of third party use of the mark as a brand name (here, as a certification mark). *In re GJ & AM, LLC*, 2021 USPQ2d at \*33 (evidence of third party use showing use of the term as a brand name and evidence of third party use of the generic term and brand name in the same posting sufficient to create doubt about whether consumers would perceive COOKINPELLETS.COM as a whole as generic).

Ultimately, the relevant public here clearly recognizes that Applicant's certification mark adheres to a specific set of standards that were developed and overseen by Applicant.

ii. Applicant's Mark Must be Viewed in its Entirety.

The Examiner's analysis is also focused on the individual components of Applicant's mark but not the mark as a whole, as required to determine genericness.

The genericness of a mark is determined by examining the mark as a whole rather than examining its constituent parts individually. *See* McCarthy on Trademarks and Unfair Competition, Fifth Ed. § 12:39 (citing *Committee for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814 (9th Cir. 1996) (while individual words in the name of an environmental group—COMMITTEE FOR IDAHO'S HIGH DESERT—are generic terms, the composite is not a generic name); *see also* *Booking.com*, 140 S.Ct. at 2304 (“for a compound term, the distinctiveness inquiry trains on the term's meaning as a whole, not its parts in isolation.”); *Princeton Vanguard, LLC v. Frito-Lay North Am., Inc.*, 786 F.3d 960, 968 (Fed. Cir. 2015) (The analysis must focus on “the public's understanding of the mark as a whole.”).

Certain terms “may connote more than the sum of their parts and we must take care to decide the genericness of these terms by looking to the whole.” McCarthy on Trademarks § 12:39 (citing *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934 (7th Cir. 1986); *see also* *In re Am. Fertility Soc.*, 188 F.3d 1341, 1348 (Fed. Cir. 1999) (“The correct legal test... is to be applied to a mark, or disputed phrase thereof, as a whole, **for the whole may be greater than the sum of its parts**”) (emph. added).

Here, the whole is greater than the sum of its parts. Although Applicant's mark is a composite mark of two (arguably) common words, the wording “REGENERATIVE ORGANIC CERTIFIED” taken together is not generic and requires a different understanding of the phrase,

as a whole. Indeed, one of the articles submitted by the Examiner by the Noble Research Institute clarifies the difference between “regenerative” and “organic.” The Examiner’s evidence does not prove that the composite mark, as a whole, is generic, as required, nor can it since it is evident that the public’s understanding of the mark is to identify a set of standards developed by Applicant that goes beyond just organic or regenerative to include other standards for animal welfare and fair labor, for instance. *See* Exs. A, C; *see also In re Am. Fertility Soc.*, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in reproductive medicine because, where the mark is a phrase, evidence that each separate term is generic is not sufficient). Ultimately, it is Applicant’s unique combination that creates a distinct commercial impression and the public perception of the mark, as a whole, that supports a finding that this mark is not generic.

Lastly, where there is any doubt regarding whether a term is generic, that doubt is to be resolved in Applicant’s favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. *In re GJ & AM, LLC*, 2021 USPQ2d at \*33 (citing *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993) (“in genericness case, Board said: ‘Although the record herein presents a close case, any doubt on the matter should be resolved in applicant’s favor and the mark should be published for purposes of opposition.’”); *CRNA*, 85 USPQ2d 1403 at \*31 (where there is any doubt as to whether a mark is generic, “such doubt should be resolved in applicant’s favor”).

The fact that this application was twice reviewed (see Office Actions dated Feb. 19, 2020 and Sept. 23, 2020) without any finding of genericness supports that there is doubt here; moreover, and importantly, there is substantial evidence that Applicant’s mark is not generic (namely, that consumers perceive that the mark, as a whole, is a certification mark certifying Applicant’s specific standards) and this tilts heavily in favor of finding that this mark is not generic.

#### IV. Conclusion

The underlying goal of a certification mark is to promote buyer reliance on the certification mark as a symbol of quality. *See* McCarthy on Trademarks § 19:94; *see also* TMEP 1306.01(b). Applicant’s mark assures consumers that its licensed products and services satisfy a very specific, rigorous set of standards developed and overseen by Applicant. Applicant submits that the foregoing demonstrates that the evidence submitted does not satisfy the legal standard necessary to find genericness and on such basis respectfully requests that the Examiner allow registration of the mark.

Respectfully submitted,



Luisa M. Bonachea  
VERSO LAW GROUP LLP