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To: Government of Ethiopia (trademarkdocketing@aporter.com)
Subject: TRADEMARK APPLICATION NO. 78589312 - HARRAR - 90784.002
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Attachments:**UNITED STATES PATENT AND TRADEMARK OFFICE****SERIAL NO:** 78/589312**APPLICANT:** Government of Ethiopia***78589312*****CORRESPONDENT ADDRESS:**

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Commissioner for Trademarks
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Alexandria, VA 22313-1451

MARK: HARRAR**CORRESPONDENT'S REFERENCE/DOCKET NO:** 90784.002

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:
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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

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Serial Number 78/589312

This office action responds to applicant's communication of April 24, 2006. In an office action of October 15, 2005, the examining attorney refused registration of the proposed mark under Section 2(e)(1) of the Trademark Act and denied applicant's Section 2(f) claim because the proposed mark appeared to refer to a specific type of coffee. The examining attorney also requested that applicant clarify whether applicant intended to apply for a Trademark or a Certification mark. Applicant is also advised that a Letter of Protest was granted by the Administrator for Trademark Identifications, Classification and Practice in the Office of the Commissioner for Trademarks and the issues raised in that letter are further discussed below.

In its response, applicant traversed the Section 2(e)(1) refusal by arguing that a Section 2(e)(2) refusal was the proper refusal and that the additional evidence submitted was sufficient to show that the term had acquired distinctiveness as a source indicator for applicant's goods. Applicant also confirmed that it intended to apply for a Trademark.

The examining attorney has reviewed applicant's response and the evidence of record. At the outset, the examining attorney notes that the present application is better suited for a Certification mark and strongly suggests that applicant consider amending the application to seek registration as a Certification mark. The evidence of record contains various instances of use of the term HARRAR as a highly descriptive, if not generic, name for a type of coffee. As such, applicant must provide additional evidence to show that the term has acquired distinctiveness and explain the evidence in the record that is contrary to that conclusion. Accordingly, the Section 2(e)(1) refusal is maintained and continued and additional evidence is required to show that the term HARRAR serves as a source indicator for applicant's goods.

Letter of Protest

The Administrator for Trademark Identifications, Classification and Practice in the Office of the Commissioner for Trademarks has granted a Letter of Protest received in connection with this application. The grant of a Letter of Protest simply means that evidence presented in the letter is forwarded to the trademark examining attorney for consideration. See TMEP §§1715 *et seq.* regarding Letters of Protest. The examining attorney has carefully considered the issues raised in the Letter of Protest and has maintained and continued the Section 2(e)(1) refusal and the denial of applicant's Section 2(f) claim.

The evidence provided by the protestor comprises print-outs of websites and copies of copies of excerpts from books in which the term "HARRAR" is used as the generic name for a variety of coffee. The evidence submitted in support of the letter of protest is incorporated to this office action by reference and may be downloaded from the USPTO's Trademark Document Retrieval (TDR) system at <http://portal.uspto.gov/external/portal/tow>. Applicant should enter the serial number of this application in the box labeled NUMBER and click on the SUBMIT button. The Office action can then be viewed by clicking the link labeled "Administrative Response" next to the Mail/Create Date of 17-Aug-2006 in Trademark Document Retrieval (TDR). If applicant has any problems viewing this document, please

contact the trademark examining attorney.

Section 2(f) Evidence is Insufficient

Under Section 2(f), applicant has the burden of proving the acquired distinctiveness of the mark. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). To establish this acquired distinctiveness, a manufacturer must show that, in the minds of the public, the primary significance of a proposed mark is to identify the *source* of the product or service rather than to identify the product or service itself. *See* TMEP §§1212.01 and 1212.03. This has not been done in the present case.

Specifically, the evidence of record shows that the term HARRAR is highly descriptive, if not a generic name for a type of coffee. Applicant has claimed acquired distinctiveness by submitting:

- A claim of use of the term HARRAR as a trademark since 1928.
- Website articles and excerpts that mention the term HARRAR
- Letters from representatives of the coffee industry regarding HARRAR coffee
- A declaration from Getachew Mengistie, the Director General of the Intellectual Property Office of the Federal Democratic Republic of Ethiopia that details the export of the variety HARRAR from Ethiopia to the United States since 1971.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors*, 219 USPQ 916 (TTAB 1983). This evidence is insufficient because in aggregate, the evidence shows use of the term HARRAR as a name of a type of coffee, but does not show use of the term HARRAR as a source indicator. Specifically, the information provided by applicant does not show evidence of the advertising of the term HARRAR or evidence of the term HARRAR functioning as a source indicator. In various instances, applicant's evidence even refers to the term HARRAR in a generic sense by indicating that it is a type of coffee. For example:

- In the letter from Christy Thorns of Allegro Coffee Company, Ms. Thorns indicates that her company has sold Ethiopian coffee since the mid-1980s and that she personally remembers, "learning to recognize the coffee types of Yirgacheffe, Sidamo, and Harrar." (Please refer to applicant's Exhibit 2).
- Mohamed Moledina of Moledina Commodities indicates, "In regard to the coffee names Yirgacheffe, Sidamo, and Harrar: All of these names are well-known in the coffee industry, and have been for many years. Each is deeply and indelibly associated with certain coffee flavor and characteristics. All of the coffee types associated with these names are valued, and respected as unique." (Please refer to applicant's Exhibit 3).
- In speaking of Harrar, Sidamo, and Yirgacheffe, Norman T. Killmon of The Roasterie says, "I first recall hearing about and tasting Ethiopian coffees from these regions some twenty years ago when I worked for the Coca-Cola Company Foods Division, which packaged coffees under several brand names such as "Butternut" and "Maryland Club." (Please refer to applicant's Exhibit 4).
- Willem J. Boot of Boot Coffee Consulting indicates, "Each is deeply associated with certain coffee flavor characteristics. All of the coffee types associated with these names are value, and respected as unique." (Please refer to applicant's Exhibit 5).
- Applicant's evidence of Coffee Exports from Ethiopia identifies that the destination of the coffee is

the USA and that the variety of the coffee is Harrar (washed and unwashed). (Please refer to applicant's Exhibit 7).

With regard to the website and book evidence attached by applicant, the examining attorney objects to this evidence as applicant has not provided copies of the websites or books indicated, but merely provided a portion of the text in each reference. Furthermore, much of this evidence, especially the evidence found from book references, shows the historical significance of the term HARRAR and the historical significance of the HARRAR region to the coffee growing industry, but does not show evidence that the term has acquired distinctiveness as a source indicator for coffee.

The evidence submitted by applicant is not sufficient to indicate that the term HARRAR has acquired distinctiveness. While the evidence shows that HARRAR is a well-known name for a type or variety of coffee, the evidence does not show that HARRAR is a recognized brand of coffee. The evidence of record also indicates that the term HARRAR is a type or variety of coffee and is a term commonly used in the coffee industry to refer to a coffee with a specific aroma and flavor. The evidence of record shows that the term HARRAR appears in various coffee dictionaries and is identified as a type or blend of coffee by various retailers, as opposed to being identified as a brand of coffee. In addition, it does not appear that applicant has used the common law trademark symbol TM to provide notice to the public that the term HARRAR is being used as a trademark.

Applicant has argued that a Section 2(e)(1) refusal is improper and the proper refusal in this case under Section 2(e)(2) of the Trademark Act. The examining attorney respectfully disagrees. The evidence of record establishes usage of the term HARRAR to refer to a specific type, blend or variety of coffee. As such, applicant may not seek registration of the term HARRAR on the Principal Register apart a showing of acquired distinctiveness.

In response to this refusal, applicant may wish to (1) submit evidence of sales and advertising that shows applicant's efforts to associate the term HARRAR with coffee; (2) evidence that consumers recognize the term HARRAR as a source indicator for applicant's goods; and (3) Evidence of licensing agreements which allow third parties to use the term "HARRAR" in association with the sale of its coffee in support of its claim of acquired distinctiveness.

Additional Information Requested

Trademark Rule 2.61(b) states "The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application". The Trademark Trial and Appeal Board has upheld a refusal of registration based on the applicant's failure to provide information requested under this rule. *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990)(failure to submit patent information regarding configuration).

In order to allow for proper examination of the application, including the final determination of descriptiveness, the applicant must submit additional information about the goods and services. TMEP § 814. As such, applicant must respond to the following inquiries:

- (1) Can applicant explain the instances in the record where the term HARRAR is used as the name of a type, variety, or brand of coffee?
- (2) Does applicant have any licensing agreements with third parties to use the term HARRAR in association with the sale of coffee?
- (3) Is applicant aware of use of the term HARRAR as a varietal name for coffee?

- (4) How does applicant exercise control over use of the term HARRAR?
- (5) Do HARRAR coffee plants grow exclusively in the HARAR/HARRAR region of Ethiopia?
- (6) Is applicant aware of HARRAR coffee plants growing in places other than Ethiopia?
- (7) Is applicant aware of use of the term HARRAR to refer to coffee by individuals other than applicant, its licensees, and assignees?

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Jennifer L. Williston/
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HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

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GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

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