

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the Application of)
SMART GARDENING PRODUCTIONS, LLC)
Serial No. : 78/324,912)
Filed : November 7, 2003)
For : SMART GARDENING)

Date: September 23, 2005

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Trademark Examining
Attorney: S. Jackson

BRIEF FOR APPLICANT



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Table of Authorities

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3 Callman on Unfair Competition, Trademarks and Monopolies § 18:10 (4th ed. 2004)
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2 McCarthy, Trademarks and Unfair Competition §11:17 (4th ed. 2005)4

Introduction

Applicant hereby appeals from the Trademark Examining Attorney's January 24, 2005 final refusal to register applicant's above-identified mark ("the Rejection"), and respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney's decision.

Applicant's Trademark/Service Mark

Applicant seeks registration on the Principal Register of its mark:

SMART GARDENING

for entertainment in the nature of an on-going television program about designing, growing, maintaining and utilizing both indoor and outdoor home landscapes, in International Class 41.

The Rejection

The Examining Attorney finally refused registration indicating that the mark so resembles the marks shown in U.S. Registration No. 2,513,316 as to be likely, when used in connection with the identified services, to cause confusion, or to cause mistake, or to deceive. For the reasons discussed below, applicant believes that, when used in connection with the identified services, there is no likelihood of confusion, mistake or deception between applicant's mark and U.S. Registration No. 2,513,316. Accordingly, applicant requests that the Examining Attorney's final refusal to register be withdrawn and that the application proceed to publication.

Summary of Argument

Applicant requests that the Board reverse the Rejection because the mark SMART GARDENING is registrable in that there is no likelihood of confusion, mistake

or deception between applicant's mark and the marks shown in U.S. Registration No. 2,513,316. Applicant believes that there is no likelihood of confusion between its mark and the cited registration based upon (1) the weakness of the registered mark, (2) the cumulative effect of the differences in the marks, services and subject matter, and (3) the dissimilar channels of trade associated the respective marks.

Argument

(A) "SMARTGARDEN" is a weak mark

The cited registration for "SMARTGARDEN," as applied to "educational services, namely, conducting classes and seminars in the fields of gardening and horticulture" and "promoting public awareness of the need to use the best practices in the fields of gardening and horticulture" as set forth in U.S. Registration No. 2,513,316, is a weak mark. Here, the registrant's mark is a compound word including the laudatory modifier "SMART" and the noun "GARDEN," which is descriptive of the subject matter of the registrant's services, namely gardening and horticulture.

Applicant respectfully points out that marks including a laudatory modifier, such as "SMART," are considered at least vaguely laudatory and, as such, are held to be descriptive or highly suggestive of a desirable characteristic or quality of the services. See 3 Callman on Unfair Competition, Trademarks and Monopolies § 18:10 (4th ed. 2004); and 2 McCarthy, Trademarks and Unfair Competition §11:17 (4th ed. 2005). Such marks are used to have a positive effect on a purchaser or consumer. McCarthy, supra. When compounded with an underlying descriptive word such as "GARDEN," the laudatory modifier "SMART" creates a mark that, if not descriptive, is certainly highly suggestive of a desirable characteristic or quality of the associated services. The

modifier "SMART" is a laudatory term that conjures up a positive psychological expectation for consumers. In particular, the use of "SMART" as part of a compound word suggests a better or improved version of the modified noun, in this case "GARDEN." The compound "SMARTGARDEN" is understood by consumers in this country to mean that there is something additional or positive about the services with which the mark is used – that the mark is associated with services related to a better way to garden. Thus, "SMARTGARDEN" is at least highly suggestive of the registrant's services, namely conducting classes and seminars and promoting public awareness in the fields of gardening and horticulture. Applicant submits that, as a highly suggestive or descriptive mark, "SMARTGARDEN" is a weak mark and, as such, is entitled to only limited protection.

(B) "SMART GARDENING" is distinguishable from "SMARTGARDEN"

A line of cases have held that the addition of other matter to a highly suggestive mark, even if such other matter is suggestive, descriptive or laudatory, may be sufficient to distinguish the marks and avoid confusion in trade. See Plus Prods. v. Star-Kist Foods, Inc., 220 U.S.P.Q. 541, 544 (TTAB 1983) ("MEAT PLUS" sufficient to distinguish "PLUS"); Industrial Adhesive Co. v. Borden, Inc., 218 U.S.P.Q. 945, 951 (TTAB 1983) ("BOND-PLUS" and "WONDER BOND PLUS" not confusingly similar for adhesives); Standard Brands Inc. v. Peters, 191 U.S.P.Q. 168 (TTAB 1976) ("CORN-ROYAL" registrable over "ROYAL").

Because a merely descriptive or highly suggestive term is a weak mark, the scope of protection extended to such a mark is limited. Due to the limited protection granted a weak mark, the subsequent use and/or registration of a composite mark

comprising that mark plus other matter is permissible. This is true, even for substantially similar goods, notwithstanding the fact that such other matter may be equally suggestive or even descriptive. In Industrial Adhesive, 218 U.S.P.Q. at 947, the holder of the registration for the "BOND-PLUS" mark for adhesives opposed applicant's "WONDER BOND PLUS" mark, also for adhesives. The basis for the opposition was that "WONDER BOND PLUS," "when applied to the goods of applicant, [would be likely] to cause confusion or to cause mistake or to deceive." The Board stated that, notwithstanding the relatedness of the products, contemporaneous use of "WONDER BOND PLUS" and "BOND-PLUS," would not be likely to cause confusion because

Opposer's "BOND-PLUS" mark is so highly suggestive of adhesive products that it may be regarded as a "weak" mark such that addition of other matter, even of a suggestive or laudatory character, would in our judgment be capable of distinguishing "BOND-PLUS" from other adhesive marks in the minds of the consuming public.

Id. at 951.

Applicant respectfully asserts that, in line with the holdings of Plus Prods., Industrial Adhesive, and Standard Brands, the addition of other matter to the highly suggestive mark of the registrant is sufficient to avoid likelihood of confusion in the present case. The compound "SMARTGARDEN" is highly suggestive or descriptive, as a matter of fact. Therefore, a composite mark, such as applicant's, which includes a highly suggestive term "SMARTGARDEN," plus other matter, namely, "ing," results in the creation of a mark – "SMART GARDENING" – that is distinguishably different from "SMARTGARDEN." The cited registration should not block registration of applicant's mark, within the rule set forth in the cases cited above.

(C) Applicant's Services are Distinct from Registrant's Services

Due to the weakness of registrant's "SMARTGARDEN" mark, and its corresponding narrow scope of protection, applicant submits that, independent of any differences in the marks, even slight differences between applicant's and registrant's respective services will be sufficient to avoid a likelihood of confusion in the present case.

Applicant's services are sufficiently distinct from the services provided by the registrant to avoid any likelihood of confusion between "SMART GARDENING" and "SMARTGARDEN." In particular, applicant respectfully asserts that the Examining Attorney has not shown that the respective services provided by applicant and the registrant, namely "entertainment in the nature of an on-going television program" and either "educational services" or "promoting public awareness," are "of a kind that may emanate from a single source." In the Rejection, the Examining Attorney provided copies of seven third-party registrations in support of the contention that "the services listed therein, namely, television programs, conducting classes and seminars, and promoting public awareness in conjunction with related subject matters, are of a kind that may emanate from a single source." Applicant respectfully contends that the evidence proffered by the Examining Attorney is insufficient to show that the services are related.

As an initial matter, applicant points out that two of the proffered registrations, namely U.S. Registration Nos. 2,734,041 and 2,819,145, are irrelevant to the case at hand because these registrations are not directed to entertainment services. The Examining Attorney has provided no support for any contention that any of the identified

services associated with either of these registrations might be classified as "entertainment services."

Applicant respectfully submits that a mere handful of examples showing entertainment services and educational services emanating from the same source do not establish that consumers would associate such services, even when comprising related subject matter, as being likely to emanate from the same source. Five examples of these distinct services emanating from the same source are insufficient to show that the consuming public associates such services as being "of a kind that may emanate from a single source." Furthermore, the Board has recognized that entertainment services and educational services are not necessarily of a kind that may emanate from a single source. See In re Professional Training Institute, Inc., 1996 TTAB LEXIS 512 (TTAB June 10, 1996). In particular, the board noted that the consuming public would not necessarily assume that entertainment services, namely, conducting and sponsoring collegiate athletic competitions and activities, would emanate from the same entity that provides educational services, namely, conducting classes, workshops, seminars, and conferences in the field of business. Id.

Further, none of the proffered registrations are directed towards the subject matter of the applicant's services, namely, "an on-going television program about designing, growing, maintaining and utilizing both indoor and outdoor home landscapes." Although the Examining Attorney has cited a single Web site (www.merrifield.com) as illustrative of "the relatedness of television programs and classes and seminars in the field of gardening and landscaping," applicant respectfully submits that a single Web site is not sufficient to show that consumers would associate

entertainment and educational services as being of a kind that may emanate from a single source. In particular, a single Web site is insufficient to show that consumers would associate the above described services (television programs or conducting classes and seminars and promoting public awareness) as being services that might emanate from a single source, even when such services are directed to such subject matter as designing, growing, maintaining and utilizing landscapes or gardening and horticulture.

(D) The Associated Trade Channels are Dissimilar

The Rejection fails to cite any support for the presumption that entertainment in the form of an ongoing television program and educational classes and seminars are marketed in similar trade channels. Moreover, applicant notes that its services are likely to be marketed in different trade channels than the services marketed under the registered mark. Applicant's television programming is likely to be marketed to broad-based home television viewers seeking home entertainment. In contrast, registrant's educational classes and seminars are likely to be marketed to professional horticulturalists seeking professional training. Even assuming that the consumer groups overlap to some extent, they do not shop at the same locations for these dissimilar services because the services are marketed in different trade channels.

Conclusion

In view of the foregoing, applicant respectfully requests that the Examining Attorney's refusal of registration be reversed and that the present application be approved for publication. The cumulative effect of the differences in the marks, the differences in the services, the differences in the subject matter of the services, and

the different channels of trade, leads inevitably to the conclusion that there would be no likelihood of confusion. Thus, applicant believes that, when used in connection with the identified services, there is no likelihood of confusion, mistake or deception between applicant's mark and the marks shown in U.S. Registration No. 2,513,316. Accordingly, applicant respectfully requests that the Examining Attorney's final refusal to register be withdrawn and that the application be allowed with directions to forward it to publication for purposes of opposition.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on September 23, 2005.



Christie A. Doolittle

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Karnstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicant