

**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 78/324912

APPLICANT: Smart Gardening Productions, LLC

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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

MARK: SMART GARDENING

CORRESPONDENT'S REFERENCE/DOCKET NO: SGP 401

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

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.

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's final refusal to register the trademark 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" on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in U.S. Registration Number 2513316, SMARTGARDEN, for "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." It is respectfully requested that this refusal be affirmed.

FACTS

Applicant filed Application Serial Number 78324912 on November 7, 2003, under Section 1(b),

applying to register on the Principal Register the mark SMART GARDENING, for “entertainment services, namely producing an ongoing television program about designing, growing maintaining and utilizing both indoor and outdoor home landscapes.” In the Initial Office Action dated May 27, 2004, registration was refused under Section 2(d) on the ground that the mark, when used in connection with the recited services, so resembles the mark in U. S. Registration No. 2513316 as to be likely to cause confusion, to cause mistake, or to deceive. The applicant was also required to clarify the recitation of services and to disclaim the descriptive wording, “gardening.”

On December 2, 2004, the applicant argued against the refusal to register the mark under Section 2(d) likelihood of confusion with regard to U.S. Reg. No. 2513316, proposed an amended recitation of services, and submitted a disclaimer statement.

On January 24, 2005, the amended recitation of services and disclaimer statement were accepted. The refusal to register under Section 2(d) likelihood of confusion with regard to U.S. Reg. No. 2513316, however, was continued and made FINAL.

On September 29, 2005, the applicant filed its appeal brief, and the file was forwarded to the examining attorney for statement on October 7, 2005.

#### ISSUE

The issue on appeal is whether the mark, when used in connection with the recited services, so resembles the mark in Registration No. 2513316 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

#### ARGUMENT

BECAUSE THE MARKS WILL BE APPLIED TO CLOSELY RELATED SERVICES, REGISTRATION OF SMART GARDENING, WHICH CREATES A HIGHLY SIMILAR COMMERCIAL IMPRESSION AS SMARTGARDEN, IS LIKELY TO CREATE CONSUMER CONFUSION AS TO SOURCE.

#### A.) SIMILARITY OF THE MARKS

THE MARKS CREATE THE SAME COMMERCIAL IMPRESSION

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the services, to cause confusion, mistake or to deceive the potential consumer as to the source of the services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The applicant applied to register the mark SMART GARDENING. The registered mark is SMARTGARDEN. The commercial impression created by the applicant's mark, SMART GARDENING, is highly similar to the registered mark, SMARTGARDEN.

The applicant's mark, SMART GARDENING, and the registered mark, SMARTGARDEN, both share

the wording, SMART GARDEN. This Board has repeatedly held that marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See e.g., *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), aff'd 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii). Here, the shared wording in the applicant's mark and the registrant's mark are highly similar. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), cert. denied, 351 U.S. 973, 109 USPQ 517 (1956). Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Electrical Ass'n*, 222 USPQ 350 (TTAB 1983).

The fact the wording GARDENING has been disclaimed in the applicant's mark, SMART GARDENING, will not obviate the likelihood of confusion. The marks must be considered in their entireties when determining whether there is likelihood of confusion. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001); *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991). Purchasers are not aware of disclaimers that reside only in the records of the U.S. Patent and Trademark Office.

Thus, when compared in their entireties, the marks are similar in both connotation and commercial impression in light of the common term, "smart garden." Accordingly, the two marks are sufficiently similar that if they were contemporaneously used on related services, confusion as to the source or

sponsorship of such services would be likely.

## B.) SIMILARITY OF THE SERVICES

### APPLICANT'S RECITED SERVICES ARE CLOSELY RELATED TO THE REGISTRANT'S SERVICES.

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

As provided above, the applicant's recited services, as amended, are "entertainment in the nature of an on-going television program about designing, growing, maintaining and utilizing both indoor and outdoor home landscapes." The registrant's services are "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." The applicant's recited services are substantially related to the registrant's services. The examining attorney makes reference to, and incorporates herein, a sample of representative third party registrations included with the January 24, 2005 Final Refusal. The relevant parts of some of the third party registrations, which demonstrate the related nature of the services, read as follows (emphasis added by the examining attorney):

**Registration No. 2598205** – "educational services, namely, *conducting classes and seminars* in the field of self improvement; entertainment services, namely, producing radio programs, *television programs*, live theatrical performances, audio recordings, and videos in the field of self improvement."

**Registration No. 2645985** – "educational services, namely, *conducting classes and seminars* in the field of self improvement as it relates to individual harmony with nature and the planet; entertainment services, namely, producing radio programs, *television programs*, live theatrical performances, audio recordings, and videos in the field of self improvement as it relates to individual harmony with nature and the planet."

**Registration No. 2819145** – “*promoting public awareness of the need for integrity in government and the protection of the public trust against government and judicial abuse and to promote justice and public service ethics; and providing on-going television and radio programs in the field of legal affairs to educate the American public about the conduct of government and judicial officials.*”

**Registration No. 2835724** – “*educational services, namely, arranging and conducting classes and seminars in the fields of health, nutrition, exercise, healthy lifestyles, dietary supplementation, diet, weight loss and weight management, behavioral modification, emotional well-being, and care of the skin, hair and nails; entertainment services in the nature of on-going radio and television informational programs in the field of health, nutrition, exercise, healthy lifestyles, dietary supplementation, diet, weigh loss and weight management, behavioral modification, emotional well-being, and care of the skin, hair and nails.*”

**Registration No. 2869902** – “*entertainment in the nature of on-going educational television and radio programs in the field of music, religion, and animation for children and families; live instrumental and vocal musical performances; educational services, namely conducting classes and seminars in the field of religion.*”

**Registration No. 2909663** – “*promoting public awareness of the need for family planning and related reproductive health care issues by promoting the accessibility of effective means of voluntary fertility control, contraception, family planning and related reproductive health care by means of conducting advanced research, coordinating and supporting the delivery of family health services in community-based organizations, directing funding for providers of family health services, and conducting education, training and community outreach programs; promoting public awareness of the need for family planning and related reproductive health care issues to health professionals and policy makers; promoting public awareness of the need for family planning and related reproductive health care issues by promoting effective public policy decisions that ensure and expand access to high quality family planning and related reproductive health care services; and educational services, namely, conducting seminars, conferences, classes and workshops in the field of family health care and family planning, and distributing course materials in connection therewith; clinical education services and community health education services, namely conducting seminars, conferences, classes and workshops in the fields of reproductive health care and family planning, and distributing course materials in connection therewith; entertainment services, namely, production of radio shows, television shows and motion pictures, and conducting on-line exhibitions and displays, all in the fields of voluntary fertility control, contraception, sexually transmitted diseases, and related reproductive health and family planning issues.*”

These third party registrations have probative value to the extent that they serve to suggest 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. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

The subject matter of the applicant’s services and the registrant’s services, namely, landscapes,

gardening and horticulture, are also related. The examining attorney attached internet evidence illustrating the relatedness of the services and the services' subject matter. In particular, the examining attorney has included website captions from [www.merrifieldgardencenter.com](http://www.merrifieldgardencenter.com), which assert that the services listed therein, namely, television programs and conducting classes and seminars in the field of gardening and landscaping, are of a kind that may emanate from a single source. The third-party registrations and Internet evidence provided by the examining attorney have the combined effect of showing that the services listed therein, namely, television programs, conducting classes and seminars, and promoting public awareness in conjunction with related subject matters, are commonly marketed under the same service marks.

C.) THE CITED REGISTRATION IS ENTITLED FULL PROTECTION

The applicant makes reference to the registered mark, SMARTGARDEN, as being "very weak." The applicant avers that the mark is highly suggestive or descriptive; and is thus a weak mark entitled to only limited protection. The examining attorney has found this averment unpersuasive. Even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

CONCLUSION

The applicant's mark, SMART GARDENING, on its face, is confusingly similar to the mark in U.S. Reg. No. 2513316, SMARTGARDEN, in that both marks feature the wording "SMART GARDEN." In addition, both the applicant's mark and registrant's mark are used in conjunction with substantially related services, as demonstrated by evidence provided by the examining attorney. Furthermore, the applicant has failed to properly demonstrate that the registrant's mark is undeserving of protection. As such, it is highly likely that the applicant's mark, SMART GARDENING, and the registrant's mark, SMARTGARDEN, will cause consumer confusion.

For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act §2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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