

This Opinion is not a  
Precedent of the TTAB

Mailed: August 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re A-Plant 2000 ApS*

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Serial No. 79162833

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Brie A. Crawford of Crawford Intellectual Property Law LLC  
for A-Plant 2000 ApS.

Saima Makhdoom, Trademark Examining Attorney, Law Office 101,  
Ronald R. Sussman, Managing Attorney.

—  
Before Kuhlke, Lykos and Heasley,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

A-Plant 2000 ApS (“Applicant”), located in Skörping, Denmark, seeks to register  
on the Principal Register the mark displayed below

**Norđïc**

for goods ultimately identified as “[h]orticultural and forestry products, namely, live  
shrubs, flowering plants in the nature of perennials, and groundcover plants; natural

plants and flowers” in International Class 31.<sup>1</sup> NORDIC has been disclaimed apart from the mark as shown.<sup>2</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark **NORDIC** in standard characters for “live plants, namely holly cultivars” in International Class 31,<sup>3</sup> that, when used on or in connection with Applicant’s identified goods, it is likely to cause

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<sup>1</sup> Application Serial No. 79162833, filed January 19, 2015, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f (“Madrid Protocol”), requesting extension of protection for International Registration No. 1241448. During prosecution, Applicant deleted the services originally identified in International Class 44. The original description of the mark as “[t]he mark consists of the word ‘Nordic’, spelled in Icelandic letters,” was amended to “[t]he mark consists of the word ‘Nordic’ in partially stylized characters.” Color is not claimed as a feature of the mark. The application does not include a translation statement.

<sup>2</sup> In arguing against the Examining Attorney’s initial refusal to register the mark as primarily geographically descriptive, Applicant took the position in the alternative that it was “willing to disclaim the term ‘Nordic’” ... “but that the stylized design creates a separate commercial impression apart from the words.” October 26, 2015 Response; TSDR 2. The Examining Attorney, in maintaining the refusal, stated that “[t]he mark does not comprise of a distinct design element. Therefore, the mark cannot proceed to registration with a disclaimer of the term NORDIC.” December 14, 2015 Office Action; TSDR 1. The disclaimer was neither formally accepted nor entered in the record, meaning that Applicant was entitled to argue this position in the alternative on appeal. *See* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1215 (“Alternative Positions”) and cases cited therein. We think this issue has now been resolved by Applicant and the Examining Attorney in their appeal briefs since Applicant reiterated its offer and the Examining Attorney replied with the statement that “[s]ince the applicant has voluntarily disclaimed the term NORDIC in the mark, the only issue on appeal is whether the mark contains a distinctive design element which would enable the applicant to traverse the refusal to register the mark on the Principal Register.” Examining Attorney’s Brief, 6 TTABVUE 15. Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g) provides in relevant part that “[a]n application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer... .” As such, it is unnecessary to remand the application to the Examining Attorney for formal consideration and entry of the disclaimer; rather, we deem the Applicant’s offer as now formally accepted by the Examining Attorney and entered in the record.

<sup>3</sup> Registration No. 3858935, issued on October 12, 2010 on the Principal Register; alleging February 15, 1978 as the date of first use anywhere and in commerce; Sections 8 and 15 affidavit and declaration accepted and acknowledged.

confusion or mistake or to deceive, and is primarily geographically descriptive of the origin of the goods under Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(2)(e)(2).<sup>4</sup>

The appeal is now fully briefed.

### **I. Section 2(d) Refusal**

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis two key considerations are the similarities between the marks and the similarities between the goods. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). However, we also have before us a consent agreement from Applicant and Registrant. A consent agreement presented in an effort to overcome a Section 2(d) refusal falls under the *du Pont* factor concerning the market interface between Applicant and Registrant. *du Pont*, 177 USPQ at 567; *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1959 (TTAB 2016). That is to say, consent agreements are but one *du Pont* factor to be taken into account with all of the other relevant circumstances bearing on a likelihood

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<sup>4</sup> During prosecution, the Examining Attorney inquired whether the term NORDIC had ever been used as a varietal or cultivar name or in connection with a plant patent, utility patent, or certificate for plant-variety protection. Applicant responded in the negative, to the best of its knowledge. April 27, 2015 Office Action and October 26, 2015 Response.

of confusion determination. *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985); *du Pont*, 177 USPQ at 567. Thus, in order to properly weigh its importance in the context of a full *du Pont* analysis, we will first address the other relevant factors. *Bay State Brewing Co.*, 117 USPQ2d at 1959.

### **A. The Marks**

We commence with the first *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.<sup>5</sup> See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

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<sup>5</sup> Applicant in its main brief states that “[a]s an initial matter, Applicant admits that its Mark does appear similar to the [cited] mark,” focusing primarily on the consent agreement and other *du Pont* factors. Brief, p. 6; 4 TTABVUE 7. Because however Applicant takes issue in its reply brief with some of the arguments made by the Examining Attorney in her brief in connection with the first *du Pont* factor, we do not construe Applicant’s statement as a concession.

Applicant argues that its stylized mark looks different and engenders a different meaning and commercial impression because the letter “eth” and the accent mark above the letter “i” will not be viewed as anything more than fanciful designs. Applicant also contends that the marks will be pronounced differently - that while the U.S. English letter “d” is “a voiced alveolar stop, made by holding the tongue on the alveolar ridge of the mouth tightly enough to block the passage of air temporarily,” the foreign letter “eth” “represents a dental fricative sound, made by expelling air while the tip of the tongue touches the teeth.” Reply, p. 2 n.1; 7 TTABVue 3. In Applicant’s view, these differences suffice to distinguish the marks.

We disagree. Each mark consists of a single word comprised of six letters and two syllables, commencing with the letter string “Nor-” from the U.S. English Latin alphabet and ending with the letter “c.” While the d-stroke Latin small letter “d” in Applicant’s mark is somewhat different in appearance, it resembles the Latin small letter “d” as written and spoken in U.S. English. For this reason, it too is likely to be pronounced as the hard letter sound “dee.” See *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1987) (“[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion.”). See also *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that ‘there is no correct pronunciation of a trademark’ and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar). The letter “i” in both marks could be pronounced as the long vowel sound “ee” or short vowel “ih.” The circumflex accent mark above the letter “i” in Applicant’s mark is unlikely to

affect these possible pronunciations, given the absence of accent marks in the U.S. English language. The application is devoid of any translation statement; nonetheless, even if the public were to perceive Applicant's mark as a foreign word, we can assume that consumers would ascribe the English meaning of the mark as "Nordic."<sup>6</sup> Thus the appearance, likely pronunciation and connotation of both marks are very similar.

In addition, the cited mark is registered in standard characters,<sup>7</sup> meaning that it may be displayed in any lettering style, size or color including those identical to the one depicted in Applicant's mark. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012) (the rights reside in the wording or other literal element and not in any particular display or rendition); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce."); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) ("rights associated with a word mark in standard

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<sup>6</sup> Applicant correctly notes that during prosecution the original description of the mark referred to Icelandic letters but that this reference was subsequently removed. Applicant also criticizes the Examining Attorney for now arguing in her appeal brief that Applicant's mark consists of the word "Nordic" spelled in Icelandic letters. We need not engage in a debate as to whether Applicant's mark consists of Icelandic letters in order to reach the determination that the marks are similar in sound, meaning, appearance and commercial impression.

<sup>7</sup> Under Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a), the requirements for a standard character mark are as follows: (1) the application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color; (2) the mark does not include a design element; (3) all letters and words in the mark are depicted in Latin characters; (4) all numerals in the mark are depicted in Roman or Arabic numerals; and (5) the mark includes only common punctuation or diacritical marks.

character (or typed) form reside in the wording and not in any particular display of the word.”). While this does not afford Registrant the right to use the same diacritical markings as in Applicant’s mark, this does not preclude a finding that the marks, when considered in their entireties, are similar for likelihood of confusion purposes. The USPTO does not treat diacritical markings as requiring a special form drawing.<sup>8</sup> Consistent with this practice, the “d” presented in Applicant’s mark is designated as the “dstrok-latin small letter d with stroke” on the USPTO standard character list (entry No. 273). Likewise, the circumflex accent mark above the letter “i” is also included as a stand-alone standard character (entry No. 94). This constitutes further evidence that consumers are unlikely to treat these markings as “fanciful designs” such that they would detract from the marks’ inherent similarities. That being said, even if they were perceived by the purchasing public as such, the literal elements of the respective marks are highly similar in appearance, sound, connotation and commercial impression.

Thus, when considered as a whole, both Applicant’s and Registrant’s marks are similar in appearance, sound, connotation and commercial impression. The first *du Pont* factor therefore weighs in favor of finding a likelihood of confusion.

## **B. The Goods and Trade Channels**

Next we discuss the second and third *du Pont* factors – a comparison of the goods

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<sup>8</sup> As explained in Section 807.03(b) of the Trademark Manual of Examining Procedure (“TMEP”), the USPTO has created a standard character set that lists letters, numerals, punctuation marks, and diacritical marks that may be used in a standard character drawing. The set is available on the USPTO website at the following hyperlink: <http://www.uspto.gov/teas/standardCharacterSet.html>.

and established, likely-to-continue channels of trade, bearing in mind that Applicant's and Registrant's respective goods must be compared as they are identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The term “[n]atural plants” in Applicant's identification of goods is sufficiently broad to encompass Registrant's more narrowly identified plant “holly cultivars.” As such, Applicant's goods are in part legally identical with regard to the cited registration.<sup>9</sup> *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant's broadly worded identification of ‘furniture’ necessarily encompasses Registrant's narrowly identified ‘residential and commercial furniture.’”). Because the goods are legally identical in part and unrestricted as to trade channels, we must also presume that Applicant's and Registrant's identical products travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *See In re Vittera Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of

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<sup>9</sup> Applicant in its appeal brief offers to exclude “holly cultivars” from the identification of goods in its application. Brief, pp. 7 and 17; 4 TTABVUE 8 and 18. We construe Applicant's offer as a motion to amend its identification of goods. At the appeal stage, such a motion can only be considered by way of a separate request for remand with a demonstration of good cause. *See* TBMP § 1205 (“Amendment of Application During Appeal”) and § 1209.04 (“Remand – Upon Request By Applicant”). Insofar as Applicant has failed to file such a motion, we cannot consider Applicant's motion to amend the identification of goods. That being said, even if we were to grant Applicant's request sua sponte and remand the application back to the Examining Attorney for consideration, such an amendment would not alter our determination because by their very nature, the remaining goods are highly related.



consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). Even without invoking these legal presumptions, from the identifications themselves, we can conclude that the remaining goods identified in Applicant's application "[h]orticultural and forestry products, namely, live shrubs, flowering plants in the nature of perennials, and groundcover plants" and "flowers" are highly related to Registrant's "live plants, namely holly cultivars."

Accordingly, the second and third *du Pont* factors also both weigh in favor of finding a likelihood of confusion.

### **C. Lack of Actual Confusion and Concurrent Use**

Applicant points to contemporaneous use in international commerce of its mark for a number of years with Registrant's mark and the absence of evidence of actual confusion. Applicant asserts this argument even though its applied-for mark has yet to be used in the United States. Applicant also relies on the co-existence of the cited mark and its previously registered mark NORDIC CARPET for the identical goods (Registration No. 2967443) as further evidence that consumers are unlikely to confuse the marks as to source.

Applicant's argument that the lack of actual confusion mitigates the likelihood of confusion is misplaced, given that Applicant's mark has yet to be used in U.S.

interstate commerce. Further, any suggestion that confusion is unlikely between the marks based on the coexistence of Applicant's previously used and registered mark NORDIC CARPET and the cited registration is unpersuasive, given the obvious distinctions in the marks. The seventh and eighth *du Pont* factors are therefore neutral.

#### **D. Market Interface and Consent Agreement**

We now consider the tenth *du Pont* factor – the market interface between Applicant and Registrant which in this case involves an evaluation of their proposed consent agreement.<sup>10</sup> Factors to be considered in weighing a consent agreement include the following:

- (1) Whether the consent shows an agreement between both parties;
- (2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
- (3) Whether the parties agree to restrict their fields of use;
- (4) Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
- (5) Whether the marks have been used for a period of time without evidence of actual confusion.

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<sup>10</sup> The Examining Attorney rejected the initial “joint use agreement” submitted on October 26, 2015 as a “naked consent” insufficient to overcome a likelihood of confusion refusal because it neither (1) sets forth reasons why the parties believe there is no likelihood of confusion, nor (2) describes the arrangements undertaken by the parties to avoid confusing the public. See *In re Mastic*, 829 F.2d 1114, 4 USPQ2d 1292, 1295-96 (Fed. Cir. 1987); *In re Permagrain Prods., Inc.*, 223 USPQ 147, 149 (TTAB 1984). We agree with the Examining Attorney that this first consent agreement clearly constitutes a “naked consent” and is therefore insufficient to overcome a likelihood of confusion. Thus, we focus our discussion on the merits of the revised consent agreement submitted on June 13, 2016.

*See generally du Pont, supra; In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071(Fed. Cir. 1993); *In re Mastic, supra; cf. Bongrain Int’l (Am.) Corp. v. Delice de Fr., Inc.*, 811 F.2d 1479, 1 USPQ2d 1775(Fed. Cir. 1987). In the seminal case on consent agreements, the *du Pont* court also cautioned that while “a naked ‘consent’ may carry little weight,” “substantial” weight should be conferred to “more detailed agreements.” *du Pont*, 177 USPQ at 568.

It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in *causing* public confusion. The genius of the free competitive system is the paralleling of the interest of the entrepreneur and the consuming public so far as possible. Altruism aside, it is in his *pecuniary* interest, indeed a matter of economic survival, that the businessman obtain and retain customers, the very purpose and function of a trademark, and that he avoid and preclude confusion. Millions of advertising dollars are spent daily for that precise purpose. The history of trademark litigation and the substantial body of law to which it relates demonstrate the businessman’s alertness in seeking to enjoin confusion. In so doing he guards both his pocketbook and the public interest.

[E]xperienced businessmen fully and continuously alert to each other’s products, labels, trade channels and advertising . . . will be quick to act against confusion. . . . Dollars were at stake. Decisions of men who stand to lose if wrong are normally more reliable than those of examiners and judges.

*Id.* at 568-69. That being said, “there is no *per se* rule that a consent, whatever its terms, will always tip the balance to finding no likelihood of confusion, and it therefore follows that the content of each agreement must be examined. Few may be found lacking, but it is not a foregone conclusion that all will be determinative.” *Bay State Brewing Co.*, 117 USPQ2d at 1953. As explained by the Federal Circuit in *In re Mastic, supra*, the role of a consent agreement in the likelihood of confusion analysis is nuanced:

[T]he *DuPont* case does not make it a “given” that experienced businessmen, in all cases, make an agreement countenancing each other's concurrent use of the same or similar marks only in recognition of no likelihood of confusion of the public. One must look at all of the surrounding circumstances, as in *DuPont*, to determine if the consent reflects the reality of no likelihood of confusion in the marketplace, or if the parties struck a bargain that may be beneficial to their own interests, regardless of confusion of the public. For example, the parties may prefer the simplicity of a consent to the encumbrances of a valid trademark license. However, if the goods of the parties are likely to be attributed to the same source because of the use of the same or a similar mark, a license (not merely a consent) is necessary to cure the conflict. See 1 J. McCarthy, *Trademarks and Unfair Competition* § 18:25, at 866 (2d ed. 1984).

As *DuPont* holds, a consent is simply evidence which enters into the likelihood of confusion determination and may or may not tip the scales in favor of registrability, depending upon the entirety of the evidence. 476 F.2d at 1362-63, 177 USPQ at 567-69; see 1 J. Gilson, *Trademark Protection and Practice* §3.04[3], at 3-64 (1987). If the evidence of record establishes facts supporting an applicant's argument that the two uses can exist without confusion of the public, even a “naked” consent to registration is significant additional evidence in support of the applicant's position. If, in addition, the consent is “clothed” with the parties’ agreement to undertake specific arrangements to avoid confusion of the public, as in *DuPont*, the parties’ assessment of no likelihood of confusion is entitled to greater weight, not because of the consent itself, but because such arrangements are additional factors which enter into the likelihood of confusion determination.

4 USPQ2d at 1294-95.

With this guidance in mind, we now turn to the relevant provisions of Applicant’s proposed consent agreement with Registrant:

LCN agrees to use the ‘935 mark only in connection with “live plants, namely, holly cultivars”; (¶ 1)

A-Plant agrees not to use the ‘833 mark in connection with “live plants, namely, holly cultivars”; (¶ 2)

The overall commercial impression of the ‘935 registration and the ‘833 application is very different. LCN’s customers have come to associate “Nordic” with a very specific type of plant, specifically Nordic Inkberry (botanical name: *Ilex glabra* ‘Chamzin’). A-Plant will be using the “Nordic” name with a very

different collection of plants, specifically a group of tough and hardy plants. LCN's Nordic Inkberry will not be included in A-Plants collection of plants sold under the Nordic name nor does Nordic Inkberry meet A-Plants standards as a tough and hardy plant; (¶ 3)

The additional distinctive design of "Nordic" in stylized characters in the '833 application further dispels any likelihood of confusion between the '833 application and the '935 registration. A-Plant agrees to only use the registration that extends from the '833 application with the distinctive, stylized characters; (¶ 4)

A-Plant, through its licensees, provides a great deal of education and training to customers who include landscape contractors, re-wholesalers and independent garden centers. A-Plant through its licensees, has a robust website, holds on-site training sessions, and participates in industry association seminars and training sessions. Thus, A-Plant, through its licensees, sells to sophisticated consumers who take care in their purchasing decisions and have ample opportunity to learn more about the product they are purchasing and its source of origin; (¶ 5)

LCN and A-Plant shall use their respective marks in a manner calculated to avoid consumer confusion and will cooperate in taking any and all reasonable actions to avoid consumer confusion. LCN and A-Plant mutually agree to notify the other upon learning of any actual instances of consumer confusion regarding their prospective products. LCN and A-Plant may then take steps, as necessary, to further distinguish their respective products and to help prevent future consumer confusion; (¶ 6) and

A-Plant also owns United States Trademark Registration Number 2,967,443 for "Nordic Carpet" for use in connection with "[l]iving shrub plants and live natural flowers" in International Class 031. A-Plant's '443 registration was cited against LCN's application for the '935 registration, and A-Plant and LCN entered into a joint use agreement to allow LCN to obtain the '935 registration; (preamble)

A-Plant and LCN respectively own "Nordic Carpet" ('443 registration) and "Nordic" ('935 registration), and the marks have coexisted peacefully for years without actual confusion. (¶ 7).

*See* June 13, 2016 Response; TSDR 4-5.

We find that the consent agreement has multiple failings. At the outset, we note that the restriction that Applicant will not use its mark on "holly cultivars" is not

reflected in the application, and that even if it were, it would not overcome the highly related nature of the remaining goods in Applicant's application. Further, the assessment that "[t]he overall commercial impression" of the marks "is very different" because Registrant's customers have come to associate the mark NORDIC with a specific type of holly plant, namely the "Nordic Inkberry (botanical name: *Ilex glabra* 'Chamzin')" whereas Applicant will be using its mark in connection with "tough and hardy plants," is not reflective of the realities of the marketplace. In the industry, the term "hardy" is typically used to convey information about a feature or characteristic of live plants, such as identifying climate zones or describing plants that are adaptable, easy to grow and require minimal effort.<sup>11</sup> The record shows that it is not uncommon for nurseries to market "holly cultivars" as "hardy" plants. See for example excerpt from [www.thetreecenter.com](http://www.thetreecenter.com) ("Holly trees are often disease and pest resistant, and these hardy trees require minimal effort.") submitted with July 10, 2016 Office Action; TSDR 43. Consumers searching for "hardy" plants are therefore likely to encounter both Applicant's and Registrant's goods.

In addition, there is not, as in the consent agreement under consideration in *du Pont*, any indication that the parties' goods are restricted to different markets, trade channels and consumers;<sup>12</sup> rather, the agreement makes clear that Applicant's and

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<sup>11</sup> We take judicial notice of "hardy" from the Merriam-Webster Dictionary ([www.merriam-webster.com](http://www.merriam-webster.com)). "Hardy" within this context is defined as "capable of withstanding adverse conditions ... hardy plants."

<sup>12</sup> In *du Pont*, the parties agreed to sell their products in mutually exclusive markets -- "the general purpose cleaning market" versus "the automobile market." *du Pont*, 177 USPQ at 569.

Registrant's respective products will be sold in the same market and trade channels and to the same consumers "who include landscape contractors, re-wholesalers and independent garden centers." Consent Agreement ¶ 5. While Applicant states that it "provides a great deal of education and training" to these "sophisticated consumers who take care in their purchasing decisions and have ample opportunity to learn more about the product they are purchasing and its source of origin," (*id.*), there is nothing in the agreement regarding other purchasers, who we must assume would include the ordinary consumer, such as the novice gardener. Indeed, it seems plausible that the ultimate consumer of both Applicant's and Registrant's goods in many instances will be the ordinary consumer who will only exercise ordinary care. No provisions have been made to diminish the likelihood of confusion for these consumers.

Likewise, Applicant's promise "to only use the registration that extends from the '833 application with the distinctive, stylized characters" (¶ 4) does nothing to distinguish the marks as they may appear to prospective consumers.<sup>13</sup> The agreement lacks a corresponding provision restricting Registrant's depiction of its mark, which is highly similar to Applicant's applied-for mark. Because Registrant's mark is registered in standard characters, it is entitled to use the mark in the same or similar style, lettering, alphabet, color or font as Applicant. And while the previous consent agreement for Applicant's registered mark NORDIC CARPET was found sufficient,

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<sup>13</sup> Indeed, because Applicant has applied to register a stylized mark it in fact is already restricted to this particular font and stylization as depicted on the drawing page.

the obvious differences with that mark no doubt played a critical role in that determination.

Equally problematic, while the agreement provides for mutual notification in the event of consumer confusion, it is devoid of any specific measures Applicant and Registrant agree to undertake to *prevent* consumer confusion such as promises to use distinctly different packaging, labeling, or signs, etc., in association with their marks. Mere promises to “use their respective marks in a manner calculated to avoid consumer confusion” and to “cooperate in taking any and all reasonable actions to avoid consumer confusion” (§ 6) are too vague, especially given the similarity in the marks and identical and highly related nature of the goods.

As noted earlier, Applicant’s application is based on an international registration, and according to the record, Applicant has yet to use its mark in U.S. interstate commerce. As such, the agreement lacks the type of provision typically found in consent agreements to the effect that “each party had done business for many years under their present names, that each had been aware of the other’s use of its name as at present, and neither knew of any instances of customers’ confusion, mistake, or deception” in U.S. interstate commerce. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1306 (Fed. Cir. 1988). Under the guidance set forth in *Mastic*, any consent, whether “naked” or “clothed,” is evidence that must be considered in the likelihood of confusion analysis, and if the evidence of record establishes facts supporting an applicant’s argument that the two uses can exist without confusion of the public, even a “naked” consent is



significant additional evidence in support of the applicant's position. 4 USPQ2d at 1294-95. Such is not the case here, where Applicant has not used its applied-for mark in the United States.

For the reasons explained above, the *du Pont* factor regarding market interface does not weigh in favor of diminishing a likelihood of confusion; accordingly, we deem this factor neutral.

### **E. Balancing the du Pont Factors**

"[W]e unmistakably recognize the Federal Circuit's instruction that consent agreements are frequently entitled to great weight." *Bay State Brewing Co.*, 117 USPQ2d at 1967. In this case, however, Registrant's consent is outweighed by the other relevant *du Pont* factors: the similarity of the marks in sound, appearance, connotation and commercial impression; the fact that the goods are, in part, legally identical or closely related; and that the goods are marketed in the same trade channels to the same consumers. In other words, the shortcomings in the consent agreement are such that consumer confusion remains likely. Accordingly, we affirm the Examining Attorney's Section 2(d) refusal.

## **II. Geographically Descriptiveness Refusal and Stylization of the Mark**

As noted earlier, Applicant has offered to disclaim NORDIC apart from the mark as shown which the Examining Attorney, in turn, has accepted in her appeal brief.<sup>14</sup> Applicant's disclaimer amounts to a concession that the term "Nordic" is primarily

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<sup>14</sup> See discussion in footnote no. 2.

merely geographically descriptive of the identified goods, thereby mooting this ground for refusal.<sup>15</sup> An issue remains, however, as to whether the stylization of Applicant's mark renders it inherently distinctive and registrable on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

It is well settled that when words which are primarily merely geographically descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed under Section 6 of the Trademark Act, 15 U.S.C. § 1056(a). *See In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976). Thus, the proper inquiry is not a comparison of its applied-for mark with a standard character version. Rather, the proper inquiry here is whether the stylization of the lettering creates "a separate and inherently distinctive commercial impression apart from the word itself," such that the mark as

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<sup>15</sup> Even if this were not the case, we would affirm the Examining Attorney's Section 2(e)(2) refusal. The test for determining whether a term is primarily geographically descriptive is whether the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public; the public would make an association between the goods and the geographic place identified in the mark, that is, believe that the goods originate in the geographic place identified in the mark; and the source of the goods is the geographic region named in the mark. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015). When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote the goods/place association may ordinarily be presumed from the fact that the goods originate in or near the place named in the mark. *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007). The record shows that Applicant is located in Denmark, and that the adjective "Nordic" as applied to the involved goods is primarily merely geographically descriptive. See Wikipedia excerpt entitled "Nordic Countries" showing Denmark as a "Nordic" country attached to April 27, 2015 Office Action (TSDR 8-26) and excerpt from Applicant's website [www.nordicplants.dk](http://www.nordicplants.dk) stating that Applicant grows trees and shrubs which originate in Denmark and are suited for the Danish climate attached to the July 10, 2016 Office Action (TSDR 17-20).

a whole is not primarily merely geographically descriptive. *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012) (internal citations omitted).

In support of its position, Applicant relies upon *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986) in which the Board found that the mark displayed below



**CONSTRUCT-A-CLOSET**

was registrable on the Principal Register with a disclaimer of the words CONSTRUCT-A-CLOSET. As the Board reasoned, while the literal portion was merely descriptive of components used to construct personal storage systems, “the tube-like rendition of the letter ‘C’ in the words ‘construct’ and ‘closet’ make a striking commercial impression, separate and apart from the word portion of applicant’s mark.” *Id.* at 589-90. Applicant also relies on TMEP Section 1213.05(g)(i), which provides examples of marks with a distinctive design that replaces a letter or part of a letter, thereby making them registrable on the Principal Register with a disclaimer of the merely descriptive, generic, or primarily geographically descriptive wording. By way of illustration, some of these examples include:



**Outdoor  
TOWELS**

Principal Register – Disclaimer of “TOWELS”



Principal Register – Disclaimer of “KIDS”

In addition, Applicant points to the following registered mark in support of its position:<sup>16</sup>

**ALASKA**

Reg. Nos. 3375855 and 3460798 – Principal Register – Disclaimer of “ALASKA”

Unlike the examples above, there are no distinctive design elements adjacent to or superimposed upon the letters or for that matter replacing any of the letters in Applicant’s mark. As discussed inter alia, the dstroke-latin small letter “d” and the circumflex accent mark above the letter “i” are not fanciful designs. Nor are the letters in Applicant’s mark presented in a unique or unusual rendition as in *Clutter Control*

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<sup>16</sup> In its brief, Applicant also cited other registered marks that have been cancelled. That being said, consideration of these marks would not have changed the outcome of this case.

or arranged or highlighted in a manner that create a separate and inherently distinctive commercial impression. The ALASKA mark above is distinguishable because the bolding of the letters “ASK” within the word “ALASKA” renders the likely pronunciation and impression of the mark as the phrase “ASK ALASKA.”

A comparison to *Jackson Hole* is instructive. In that case, the applicant applied to register the mark shown at right on the Principal



Register, with a disclaimer of the geographic designation “Jackson Hole.” The examining attorney refused registration of the mark as primarily merely geographically descriptive. The Board reversed the refusal to register, agreeing with the applicant’s position that “its mark consists not only of the mere geographical designation but also of the letters ‘JH’ displayed in a distinctive and prominent fashion so as to create a commercial impression in and of themselves ...” *Jackson Hole*, 190 USPQ at 176. Applicant persuasively argued and convinced the Board

... that the letters “JH” are twice the size of the other letters; that unlike any of the other letters, they are partly joined together, creating the visual impression of a monogram; and that they are set down from the rest of the letters, which positioning has the effect of highlighting the “JH” couplet.

*Id.* The underlying logic of *Jackson Hole* is not present in the mark before us. The letters in Applicant’s mark are not arranged in a manner that creates a separate and inherently distinctive commercial impression similar to the “JH” monogram.

While acknowledging that inquiries of this type are subjective and fact specific, in this case, we think that the mark involved in the case of *In re Bonni Keller Collections, Ltd.*, 6 USPQ2d 1224 (TTAB 1987) presents a more apt analogy. In that case the

Board found that the presentation of the mark **La Lingerie** was “rather ordinary” and nondistinctive. *Id.* at 1227. As the Board reasoned,

Since we find that the subject matter presented for registration is composed of a generic notation and that the lettering style, while somewhat embellished, is relatively ordinary, we conclude that the impact of the stylization of lettering is lost in the significance the term sought to be registered has as a generic notation and that the refusal of registration is proper.

*Id.* In this case, the stylization of the letters in Applicant’s mark are presented in plain block style lettering. We similarly find this stylization “rather ordinary” and not in any manner projecting a different commercial impression apart from the wording.

In addition, we note the Board’s determinations involving the marks at right which were found to be insufficiently stylized and therefore not inherently distinctive.



Simply put, when we apply the precedent of this Board, we do not find that the level of stylization in Applicant’s mark creates a separate and inherently distinctive commercial impression apart from the wording itself.

The determination regarding whether stylization is sufficient to carry a mark is “in the eyes of the beholder,” *Jackson Hole*, 190 USPQ at 176, and “a necessarily subjective one.” *Bonni Keller*, 6 USPQ2d at 1227. Nonetheless, we find that the

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<sup>17</sup> See *In re Guilford Mills, Inc.*, 33 USPQ2d 1042 (TTAB 1994).

<sup>18</sup> See *In re Project Five, Inc.*, 209 USPQ 423 (TTAB 1980).

impression conveyed by Applicant's mark is not separate from the disclaimed wording in the mark. Accordingly, we find that the stylization element does not render Applicant's mark inherently distinctive as a whole, and therefore affirm the Examining Attorney's refusal to register on this ground.

*Decision:* The refusals to register are affirmed.