

This Opinion is not a
Precedent of the TTAB

Mailed: May 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Garden Innovations, LLC

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Serial No. 85768392

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Timothy C. Matson of Lommen Abdo PA,
for Garden Innovations, LLC.

Jennifer D. Richardson, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

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Before Bucher, Kuhlke and Hightower,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Garden Innovations, LLC (hereinafter “Applicant”) seeks registration on the Principal Register of the mark **ROLL OUT GARDEN** (*in standard character format*) for “mulch and seeds for agricultural purposes, namely, mats composed of

wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover” in International Class 31.¹

Registration was originally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that **ROLL OUT GARDEN** is merely descriptive of Applicant’s named goods. In its response of October 16, 2013, Applicant traversed the descriptiveness refusal, while also arguing in the alternative that the term has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). In yet another alternative argument, Applicant suggested its willingness to amend to the Supplemental Register. On November 2, 2013, the Trademark Examining Attorney issued a new refusal on the basis that **ROLL OUT GARDEN** is generic and incapable of identifying Applicant’s services under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091. Applicant maintains its position that it may register **ROLL OUT GARDEN** on the Principal Register and has appealed the refusals based upon its alleged failure to acquire distinctiveness under Sections 2(f) of the Act and based upon genericness under Section 23(c) of the Act.

After the Trademark Examining Attorney made the refusals final, Applicant appealed to this Board.

¹ Application Serial No. 85768392 was filed on October 31, 2012, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as March 23, 2004.

I. Mere Descriptiveness

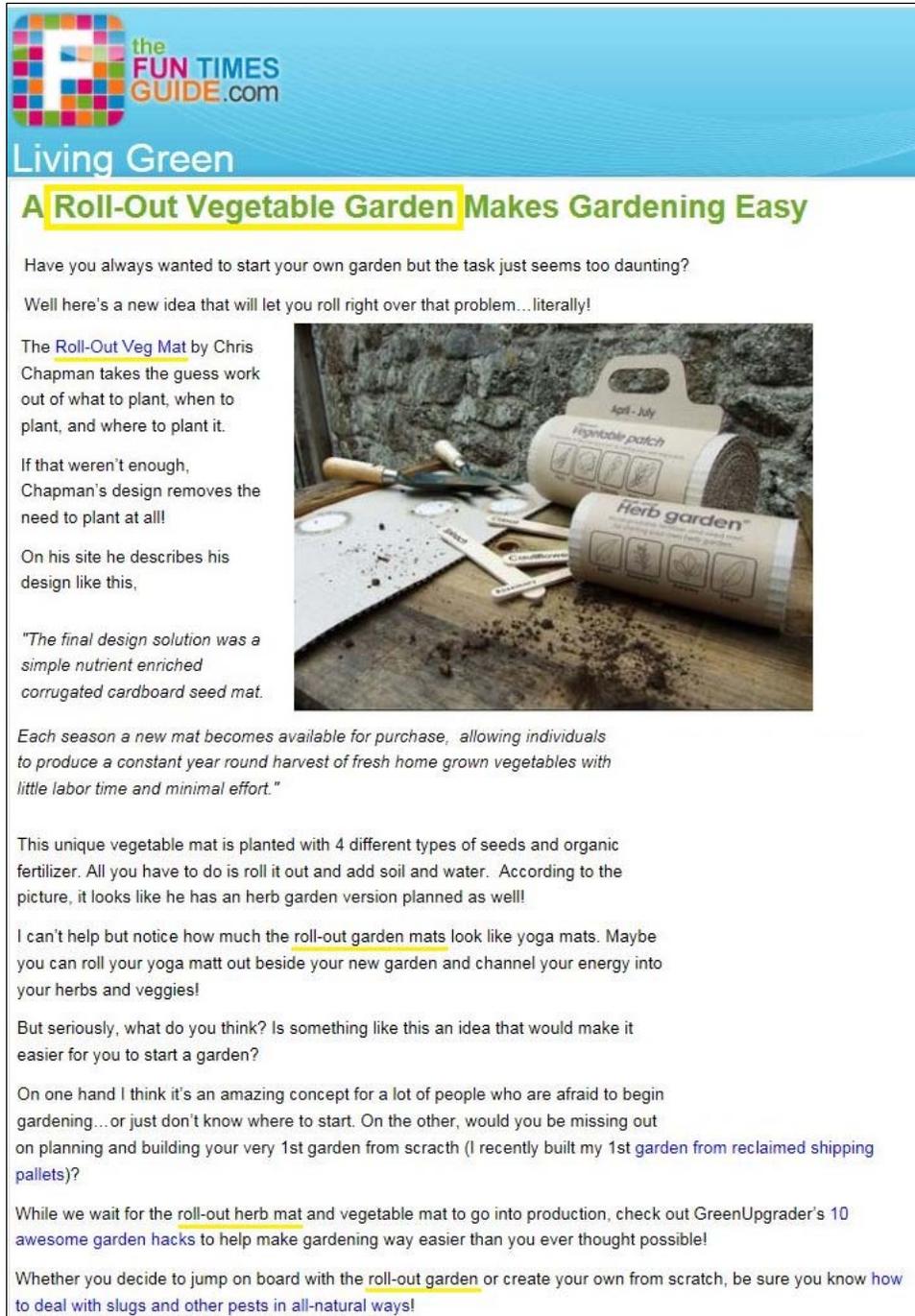
The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting, *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920) (“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.”)). The determination of whether a mark is merely descriptive must be made “in relation to the goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a non-descriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); and *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl & Larson LLP*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983).

The Examining Attorney asserts that the combined dictionary definitions for the individual words “Roll,” “Out” and “Garden,” when used in connection with Applicant’s pre-seeded rolls that grow flowers, grass, herbs, vegetables and ground cover, immediately conveys that the goods are in the nature of garden seed mats.

Applicant is certainly correct that it is improper for the Office to dissect a mark and separately analyze the individual components. In this context, Applicant points specifically to several significantly different definitions for the term “Roll Out” from the fields of aeronautics, sports, business, games, and drag racing.

products from other vendors that function much as Applicant describes its own goods. The Fun-Times-Guide.com site is one example:



the FUN TIMES GUIDE.com

Living Green

A Roll-Out Vegetable Garden Makes Gardening Easy

Have you always wanted to start your own garden but the task just seems too daunting?

Well here's a new idea that will let you roll right over that problem...literally!

The Roll-Out Veg Mat by Chris Chapman takes the guess work out of what to plant, when to plant, and where to plant it.

If that weren't enough, Chapman's design removes the need to plant at all!

On his site he describes his design like this,

"The final design solution was a simple nutrient enriched corrugated cardboard seed mat.



Each season a new mat becomes available for purchase, allowing individuals to produce a constant year round harvest of fresh home grown vegetables with little labor time and minimal effort."

This unique vegetable mat is planted with 4 different types of seeds and organic fertilizer. All you have to do is roll it out and add soil and water. According to the picture, it looks like he has an herb garden version planned as well!

I can't help but notice how much the roll-out garden mats look like yoga mats. Maybe you can roll your yoga mat out beside your new garden and channel your energy into your herbs and veggies!

But seriously, what do you think? Is something like this an idea that would make it easier for you to start a garden?

On one hand I think it's an amazing concept for a lot of people who are afraid to begin gardening...or just don't know where to start. On the other, would you be missing out on planning and building your very 1st garden from scratch (I recently built my 1st garden from reclaimed shipping pallets)?

While we wait for the roll-out herb mat and vegetable mat to go into production, check out GreenUpgrader's 10 awesome garden hacks to help make gardening way easier than you ever thought possible!

Whether you decide to jump on board with the roll-out garden or create your own from scratch, be sure you know how to deal with slugs and other pests in all-natural ways!

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² http://green.thefuntimesguide.com/2009/08/roll_out_gardening_mat.php

Nonetheless, Applicant argues that the proposed mark is not merely descriptive because this term requires a mental leap involving imagination, thought and perception on the part of prospective purchasers to reach a conclusion as to the features or characteristics of the involved goods.

We disagree with Applicant's arguments on this point. We find that the individual terms retain their ordinary descriptive meanings when combined in Applicant's designation, "Roll Out Garden." Taking the individual meanings of the words in Applicant's applied-for term, the composite term adopted by Applicant conveys information about the salient features and characteristics of Applicant's goods. We note that the above writer, for example, has combined these words in a similar manner. This seems to support the position of the Trademark Examining Attorney that when purchasers encounter the term "Roll Out Garden" used in connection with Applicant's goods, they will immediately understand this designation as describing a salient characteristic of Applicant's goods, namely, that the mats involved feature the ability to be rolled out for use. The reason that the inexperienced gardener – or one without much time – might purchase and use this product is the alleged ease with which it permits one to grow flowers, grass, herbs, vegetables and ground cover in a designated area by rolling out a mat.

As to the three-word composite as a whole, we find it is not ambiguous or incongruous; nor does it present an incongruous meaning such that "the merely descriptive significance of the term [] is lost in the mark as a whole." *In re*

RiseSmart Inc., 104 USPQ2d 1931, 1934 (TTAB 2012) (quotation omitted). *Cf.*, *e.g.*, *In re Colonial Stores Inc.*, 157 USPQ at 385 (**SUGAR & SPICE** a double entendre for bakery products); *In re Nat'l Tea Co.*, 144 USPQ 286 (TTAB 1965) (**NO BONES ABOUT IT** a double entendre for fresh pre-cooked ham).

Relying upon the evidence of record reviewed above, we find that the term “Roll Out Garden” is inherently weak in this field, and that the term was, upon its adoption and first use, at best for Applicant, highly descriptive of the involved goods. The Trademark Examining Attorney has submitted ample evidence to establish that when prospective purchasers encounter the term **ROLL OUT GARDEN** used in connection with Applicant’s identified goods, they will immediately recognize this designation to be a combination of words conveying information about salient features of a pre-seeded mat that grows flowers, grass, herbs, vegetables and ground cover.

II. Acquired Distinctiveness

Having found this designation to be highly descriptive, we turn next to Applicant’s assertion of acquired distinctiveness. *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990). In this context, it is Applicant’s burden to prove acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1006; *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant ...”). Not surprisingly, “logically that standard

becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008.

A claim that applicant has been using the subject matter for a long period of substantially exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. See *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990).

Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. However, a successful advertising campaign is not in itself necessarily enough to prove acquired distinctiveness. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

It is the Trademark Examining Attorney's position that **ROLL OUT GARDEN** is highly descriptive and Applicant's evidence is not sufficient to establish acquired

distinctiveness. And as discussed above, we are persuaded by the evidence of record that this term is highly descriptive of Applicant's goods.

In this context, as proof of acquired distinctiveness, Applicant relies upon a statement describing Applicant's length of substantially exclusive and continuous use since 2003; information about Applicant's sales of a variety of "Roll Out" products; and evidence of Applicant's marketing efforts, namely, sample advertisements, photographs of product placements, and website screenshots.

The sales figures Applicant has provided pertain to all of its "Roll Out" products, not simply "Roll Out Garden." And to the extent that the sales figures are considered probative, robust sales may point to the overall commercial success of Applicant's goods, but alone do not establish that the relevant consumers view the matter as a mark for such goods. *See In re Boston Beer Co.*, 53 USPQ2d at 1058; *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

As to Applicant's marketing efforts (e.g., sample advertisements, photographs of product placements, and website screenshots), this evidence is merely indicative of Applicant's efforts to promote its product, not proof that the highly descriptive term has actually acquired distinctiveness. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). In fact, Applicant has provided no evidence regarding how many potential consumers have encountered Applicant's marketing, and thus this evidence does not shed any light on consumers' perceptions of the mark. Given the nature of the applied-for term, prospective consumers subjected to this marketing effort may well see these references

repeatedly but still perceive the term as nothing more than a three-word description of the product that Applicant is marketing.

Accordingly, we find that Applicant has failed to submit evidence that demonstrates that consumers perceive the applied-for term as pointing uniquely to Applicant as the source of the goods, and thus Applicant has failed to submit sufficient evidence to establish that the designation has acquired distinctiveness under Section 2(f) of the Act.

III. Refusal based on Genericness

We turn then to the Trademark Examining Attorney's refusal based upon alleged genericness. When a proposed term is refused registration as generic, the Trademark Examining Attorney has the burden of proving genericness by "clear evidence." *In re Hotels.com, LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009); *In re Merrill Lynch Pierce Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992).

Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Ginn*, 228 USPQ at 530.

Evidence of the public’s understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

“An inquiry into the public’s understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)).

We find that the genus of services at issue in this case is adequately defined by Applicant’s identification of goods, specifically, a pre-seeded mat that grows flowers, grass, herbs, vegetables and ground cover. Thus, the term **ROLL OUT GARDEN** is generic if the relevant public understands it to refer to such gardening mats. *See 1800Mattress.com*, 92 USPQ2d at 1684 (genus of services is “online retail store services in the field of mattresses, beds, and bedding ...

[a]ccordingly, the mark is generic if the relevant public understands **MATTRESS.COM** to refer to such online services.”)

Turning to the second inquiry, Applicant asserts that the Trademark Examining Attorney failed properly to analyze the commercial impression of the phrase “Roll Out Garden” in its entirety. In short, Applicant argues that the Trademark Examining Attorney failed to prove genericness by clear and convincing evidence.

As noted above, we have found the term **ROLL OUT GARDEN** to be highly descriptive. As to genericness, however, the Trademark Examining Attorney’s evidence is relatively weak. For example, we note the advertisement posted by Amazon.com



Similarly, the record contained an online advertisement from The Home Depot. However, Applicant has provided evidence that Amazon.com and The Home Depot are both among its most dependable customers. Hence, we view the

³ <http://www.amazon.com/Preseeded-Sunflower-Garden-Roll-Out/dp/B007Q2ZOQU>

above Amazon.com site, which screen print has text and graphics clearly associated with Applicant, as an online, retail source for Applicant's affected garden mats.

Further, we note from the record an additional usage on the first posting of the "World's Worst Gardener" a reference to the "roll out garden you can get at Home Depot."⁴ While this single lower-case use of Applicant's adopted term is neither surprising nor particularly probative of genericness, we note that indeed the garden mat was purchased at The Home Depot, and hence may well have been a reference to Applicant's branded product as well. By contrast, in the commercial settings where merchants or manufacturers are paying for online advertisements, the record shows that "patches," "mats," "beds," or "rolls" are the commonly used terms of art for these gardening products. Conversely, the record does not reveal a single instance over the past dozen years where Applicant's competitors have used this term (i.e., since Applicant's adoption), suggesting to us that the evidence of record does not "demonstrate a competitive need for others to use" this term. *Hotels.com*, 91 USPQ2d at 1536.

The Federal Circuit addressed a similar case where there was a mixed record on the question of genericness. "The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term **CASH MANAGEMENT ACCOUNT** as a generic, common descriptive term for the brokerage services to which Merrill Lynch first

⁴ <http://worldsworstgardener.blogspot.com/>

applied the term.” *In re Merrill Lynch*, 4 USPQ2d at 1143; *see also In re Trek 2000 International Ltd.*, 97 USPQ2d 1106, 1113 (TTAB 2010) (the term **THUMBDRIVE** was found not to be generic).

Hence, in spite of the information immediately conveyed by the term “Roll Out Garden,” we find that there has not been a substantial showing in the case at bar that the relevant public understands the term “Roll Out Garden” to refer to gardening mats generally. Our substantial evidence review “requires an examination of the record as a whole, taking into account both the evidence that justifies and detracts” from our ultimate opinion. *Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006). As in *Merrill Lynch*, we find that the minimal evidence of generic use is offset by Applicant’s evidence that shows a significant amount of proper trademark use. Thus, we cannot conclude that “members of the relevant public primarily use or understand the term sought to be protected to refer to the genus” of the goods. As noted earlier, when a proposed mark is refused registration as generic, the U.S. Patent and Trademark Office bears the burden of proving genericness by “clear evidence.” Yet, the record in the case at bar, at a minimum, creates doubt about genericness, and so we are constrained to resolve doubt on the issue of genericness in favor of Applicant. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005) (**SPORTSBETTING.COM** is generic).

Accordingly, we agree with Applicant that the Trademark Examining Attorney has failed to prove genericness by “clear evidence.” Specifically, in

comparing the Office's showing above as to the seeming genericness of the individual words to the record evidence demonstrating the predominant use of the combined term, "Roll Out Garden," in connection with Applicant's goods, we cannot find substantial evidence supporting a determination of genericness. *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, ___ F.3d ___, ___ USPQ2d ___, No. 2014-1517, 2015 BL 150132 (Fed. Cir. May 15, 2015). Finally, we are cognizant of the fact that Applicant's previous registration of **ROLL OUT GARDEN**⁵ was only recently cancelled due to Applicant's inadvertent failure to file a Section 8 Declaration of Continuous Use between the fifth and sixth years following the date of issue.

Decision: The refusal to register **ROLL OUT GARDEN** on the Principal Register based upon mere descriptiveness and Applicant's insufficient showing of acquired distinctiveness is hereby affirmed. However, the refusal to register this term based upon a finding of genericness is reversed, and this mark will issue on the Supplemental Register in due course.

⁵ Registration No. 2986612 issued on the Supplemental Register on August 16, 2005; cancelled in 2012.