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

Proceeding	85768392
Applicant	Garden Innovations, LLC
Applied for Mark	ROLL OUT GARDEN
Correspondence Address	TIMOTHY C. MATSON LOMMEN ABDO, PA 920 2nd Avenue South, Suite 1000 MINNEAPOLIS, MN 55402 UNITED STATES trademark@lommen.com
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Filer's Name	Timothy C. Matson
Filer's e-mail	trademark@lommen.com
Signature	/s/ Timothy C. Matson
Date	01/15/2015

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

In the matter of the Ex Parte Appeal of
Trademark Application Serial No. 85/768,392

Applicant:	Garden Innovations, LLC
Serial No.:	85/768,392
Filing Date:	October 31, 2012
Mark:	ROLL OUT GARDEN

APPLICANT'S *EX PARTE* APPELLATE BRIEF

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DESCRIPTION OF THE RECORD

Registration Serial No. 2986612

1. T.S.D.R. File, Registration No. 2986612.

Application Serial No. 85/768,392

2. Application, Drawing and Specimen filed on October 31, 2012.
3. Office Action Letter dated March 4, 2013 (with Attachments 1-25).
4. Office Action Letter dated April 16, 2013.
5. Response to Office Action Letters dated October 26, 2013 (with Exhibit A, Mounce Declaration and Exhibits 1-8).
6. Office Action Letter dated November 2, 2013 (with Attachments 1-13).
7. Response to Office Action Letter dated May 14, 2014 (with Exhibit A and Exhibits 1-8).
8. Office Action Letter dated June 2, 2014.

STATEMENT OF ISSUES

1. Did the Examining Attorney make a strong showing by clear and convincing evidence that the mark **ROLL OUT GARDEN** is generic for applicant's goods?

Applicant's Assertion: No. The evidence offered by the Examining Attorney was wholly inadequate to sustain the PTO's heavy burden of showing genericness by clear and convincing evidence.

2. Assuming the Examining Attorney failed to sustain the difficult burden of showing genericness, did Applicant demonstrate that the mark **ROLL OUT GARDEN** has acquired distinctiveness under Section 2(f) of the Trademark Act?

Applicant's Assertion: Yes. Applicant established the mark **ROLL OUT GARDEN** has acquired distinctiveness by substantially exclusive and continuous use since 2004 and significant actual evidence of acquired distinctiveness.

BACKGROUND

On April 19, 2004, Applicant applied to register **ROLL OUT GARDEN** in Class 31 for “[m]ats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover” under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). (See TSDR File, U.S. Reg. No. 2986612, Application.) Applicant first used **ROLL OUT GARDEN** in commerce on March 23, 2004. (Id.)

On November 15, 2004, the Examining Attorney refused registration on the basis that the mark was merely descriptive of the goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). (Id., November 15, 2004 Office Action.) The Examining Attorney also objected to Applicant’s description of goods and recommended the description be amended to “[m]ulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover.” T.M.E.P. § 1402.01. (Id.)

On May 2, 2005, Applicant responded with arguments and evidence that the mark **ROLL OUT GARDEN** was not merely descriptive and accepted the Office’s identification of goods. (See TSDR File, U.S. Reg. No. 2986612, May 2, 2005 Response to Office Action.) In the alternative, Applicant requested that in the event the mere descriptiveness objection was made final, the mark be transferred to the Supplemental Register. (Id.) On August 16, 2005, the U.S. Patent & Trademark Office (“**PTO**”) issued a Certificate of Registration for the mark **ROLL OUT GARDEN** on the Supplemental Register. (U.S. Reg. No. 2986612)

On September 28, 2012, Applicant unintentionally allowed the 2005 registration of **ROLL OUT GARDEN** to cancel because Applicant had moved offices from Murrayville, Georgia to Cleveland, Georgia and did not timely respond to a notice of the filing requirement. (See TSDR File, U.S. Reg. No. 2986612.) Thus, although Applicant engaged in continuous use of **ROLL OUT GARDEN** since at least as early as March 24, 2004 to the present, Applicant's inadvertent failure to file a Section 8 Declaration of Continuous Use between the fifth and sixth years following registration of **ROLL OUT GARDEN** caused the U.S. Registration No. 2986612 to lapse in 2012. (Id.)

Upon discovery of the inadvertent error, Applicant filed a new application to register **ROLL OUT GARDEN** on October 31, 2012. The Examining Attorney initially refused registration on the Principal Register on the basis that the mark was merely descriptive of the goods. (See March 4, 2013 Office Action.) In support of the objection, the Examining Attorney cited a few dictionary definitions and a couple of web screenshots that have no relevance to Applicant's use of the words "Roll Out Garden." The Examining Attorney also issued a generic advisory at that time and requested supplemental information and documentation regarding the mark. (Id.) Applicant responded to the March 4, 2013 Office Action by, among other things, arguing that the mark is not merely descriptive and providing significant evidence strongly supporting Applicant's substantially exclusive and continuous use of the mark since 2004. (See October 16, 2013 Response to Office Action.)

On November 2, 2013, the Examining Attorney added a refusal to register **ROLL OUT GARDEN** on the Supplemental Register on the basis that the mark is generic for Applicant's goods. (See Office Action dated November 2, 2013.) The Examining Attorney provided no evidence or explanation to support the position that the mark **ROLL OUT GARDEN**,

previously registered on the Supplemental Register in 2005, had become generic in 2014. Moreover, the Examining Attorney only added a few nominal pieces of wholly inadequate or irrelevant evidence beyond that cited in its Office Action dated March 4, 2013. (Id.) Included in the examples was a Walmart advertisement showing acquired distinctiveness of Applicant's mark **ROLL OUT GARDEN** for the goods. (Id.)

On June 2, 2014, Applicant responded by arguing that under the correct standard for genericness, the mark **ROLL OUT GARDEN** is not generic. Applicant also provided supplemental evidence strongly supporting Applicant's substantially exclusive and continuous use of the mark since 2004. (See June 2, 2014 Response to Office Action.) Despite Applicant's evidence and arguments, the Examining Attorney maintained as final its refusal to register **ROLL OUT GARDEN** on either the Principal or Supplemental Registers. (See Office Action dated June 2, 2014). Therefore, Applicant filed this Appeal.

ARGUMENT

I. THE EXAMINING ATTORNEY DID NOT SUSTAIN THE DIFFICULT BURDEN OF SHOWING THAT THE MARK ROLL OUT GARDEN IS GENERIC BY CLEAR AND CONVINCING EVIDENCE.

The Examining Attorney made two critical errors in finding that Applicant's mark **ROLL OUT GARDEN** is generic. First, the Examining Attorney failed to properly analyze the commercial impression of the words "Roll Out Garden" as a whole, instead misconstruing the sum of its parts. Second, the Examining Attorney failed to properly state or undertake the difficult burden of proving genericness by a showing of clear and convincing evidence, instead offering wholly inadequate evidence that has very little impact on or relevance to the genericness inquiry at issue.

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. See Section 14(3) of the Act. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); In re Am. Fertility Soc'y, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). The Examining Attorney bears the burden of making a “strong” showing, with “clear evidence,” that the applicant’s proposed mark is generic. In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also In re K-T Zoe Furniture, Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). “[D]oubt on the issue of genericness is resolved in favor of the applicant.” In re DNI Holdings, Ltd., 77 USPQ2d 1435, 1437 (TTAB 2005).

There is a two-part test used to determine whether a designation is generic: (1) what is the genus of goods or services at issue? and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. Id.

The relevant public for a genericness determination refers to the purchasing or consuming public for the identified goods and/or services. Sheetz of Del., Inc. v. Doctor's Assocs. Inc., ___ USPQ2d ___, Opp'n No. 91192657 (TTAB Sept. 5, 2013) (citing Magic Wand Inc. v. RDB Inc., 940 F.2d at 641, 19 USPQ2d at 1553). It is not necessary to show that the relevant public *uses* the term to refer to the genus. The correct inquiry is whether the relevant public understands the term to be generic. In re 1800Mattress.com IP LLC, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

The Examining Attorney failed at every step of the analysis. The finding that **ROLL OUT GARDEN** is generic cannot stand. The Board should strike the Examining Attorney's objection to registration of the Mark on the Supplemental Register.

A. The Examining Attorney Failed to Analyze the Commercial Impression of the mark ROLL OUT GARDEN as a whole.

The Federal Circuit has repeatedly emphasized the importance of analyzing the commercial impression of a proposed mark as a whole when determining whether a mark is descriptive or generic. See Dial-A-Mattress, 240 F.3d at 1345-56.; In re Am. Fertility Soc'y, 188 F.3d 1341, 1348 (Fed. Cir. 1999) (reversing the Board's finding of genericness when the Examining Attorney failed to produce evidence that a phrase as a whole was considered generic, even though there was evidence that individual components were generic). Thus, it is improper to dissect a mark and separately analyze the individual words that it may incorporate. In re Hutchinson Technology, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).

When a term consists of a compound word or a telescoped word, the examining attorney may establish that the term is generic only by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form the compound or telescoped word that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." In re Gould Paper Corp., 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987).

However, the Court of Appeals for the Federal Circuit has expressly limited the holding in Gould to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." In re Dial-A-Mattress Operating Corp., 240 F.3d at 1810 (Fed. Cir. 2001) (citing In re Am. Fertility Soc'y, 188 F.3d

1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). Where the mark is a phrase, the examining attorney cannot simply cite definitions and generic uses of the individual components of the mark, but must provide evidence of the meaning of the composite mark as a whole. Id.

In Am. Fertility Soc'y, for example, the court held that evidence that the components “Society” and “Reproductive Medicine” were generic was not enough to establish that the composite phrase **SOCIETY FOR REPRODUCTIVE MEDICINE** was generic for association services in the field of reproductive medicine. 51 USPQ2d at 1836–37. In Dial-A-Mattress, the court held that an alphanumeric telephone number “bears closer conceptual resemblance to a phrase than a compound word.” 57 USPQ2d at 1811. The court found that 1-888-M-A-T-R-E-S-S was not generic as applied to “telephone shop-at-home retail services in the field of mattresses,” because there was no evidence of record that the public understood the term to refer to shop-at-home telephone mattress retailers. Therefore, to establish that a mnemonic telephone number is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance. Id.

Here, the Examining Attorney ignored the composite nature of the mark, instead selectively tracking one definition of each word independently and in a vacuum. (See Office Action dated March 4, 2013, Attachments 1-12.) However, the operative portion of the composite mark is “Roll Out.” As demonstrated in the prosecution of the Mark, these words in combination have multiple varying definitions, including the following examples:

Roll Out (Aeronautics): 1. The unveiling of a new aircraft or spacecraft. 2. The stage of an aircraft’s landing during which it travels along the runway while losing speed.¹

¹ See The American Heritage Dictionary of the English Language (© 2000 Houghton Mifflin Company) (updated 2009); Random House Kernerman Webster’s College Dictionary (©2010 K Dictionaries Ltd.); www.oxforddictionaries.com/definition/english/roll--out; www.google.com/#q=roll+out+definition (See 10/16/13 Response, Ex. A, pp. 1-4)

Roll Out (American Football): 1. A play in which a quarterback moves toward the sideline after receiving the snap with the intention of passing the ball. 2. A football maneuver in which the quarterback moves laterally with the ball.²

Roll Out (Business): 1. The inauguration or initial public exhibition of a new product, service or policy. 2. The introduction of a new product or service.³

Roll Out (Backgammon): 1. To analyze a position by playing it out over and over again. 2. To estimate the equity of a position by means of computer simulation. 3. A rollout consists of numerous trials, the results of which are averaged together. (See also **Truncated Rollout, Cubeless Rollout, Cubeful Rollout**)⁴

Roll Out (General): 1. Flatten or spread with a roller; “roll out the paper”. 2. Straighten by unrolling; “roll out the big map.”⁵

Rollout (Drag Racing): The distance the front tires have to travel before the starting light beam reconnects and starts the clock without tripping the red light.⁶

The foregoing examples demonstrate that the composite of “roll” and “out” is used in a variety of divergent ways.⁷ None of these definitions describe the planting of a garden using

² See The American Heritage Dictionary of the English Language (© 2000 Houghton Mifflin Company) (updated 2009); Random House Kernerman Webster’s College Dictionary (©2010 K Dictionaries Ltd.); www.sportingcharts.com/dictionary/nfl/roll-out.aspx (See 10/16/13 Response, Ex. A, pp. 2-3, 9)

³ See The American Heritage Dictionary of the English Language (© 2000 Houghton Mifflin Company) (updated 2009); Random House Kernerman Webster’s College Dictionary (©2010 K Dictionaries Ltd.); www.macmillandictionary.com/us/dictionary/american/roll-out_1 (See 10/16/13 Response, Ex. A, pp. 2-3, 5)

⁴ See “Backgammon Glossary” at Backgammon Galore web page (www.bkgm.com). (See 10/16/13 Response, Ex. A, p. 6).

⁵ See www.hyperdictionary.com/dictionary/roll+out (© 2000-2009 hyperdictionary.com). (See 10/16/13 Response, Ex. A, p. 10).

⁶ See www.truestreetcars.com/forums/drag-racing/1804-drag-racing-basics.html. (See 10/16/13 Response, Ex. A, p. 8)

mats composed of various materials. Indeed, that is the suggestive nature and creativity of this mark. As a result, the mark is suggestive, not merely descriptive, because it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods in connection with which it is used. West & Co. v. Africa Inst., Inc., 557 F.2d 338, 195 USPQ 466 (2d Cir. 1977) (descriptive mark must forthwith convey an immediate idea of the ingredients, qualities or characteristics of the goods or goods.)

Moreover, the fact that a number of owners of trademarks were able to secure trademark registrations or approvals for publication on the Principal Register of marks employing the words **ROLL OUT**, is dispositive of Applicant's suggestive use here. For example, the following are examples of **ROLL OUT** marks that have different commercial impressions in different categories, and have been registered or approved for publication:

- **ROLL OUT**, U.S. Reg. No. 2,030,291, for plant growth regulator for agricultural use. (Registered on Principal Register; cancelled for failure to Section 9 renewal after ten years of registration.)
- **ROLL OUT USA**, U.S. Reg. No. 2,242,453, for electric cable and wiring. (Registered on the Principal Register; cancelled for failure to file Section 8 declaration of continued use after six years of registration.)
- **VIRTUALROLLOUT**, U.S. Reg. No. 2,663,775, for various business, management and financial services. (Registered on Principal Register; cancelled for failure to file Section 8 declaration of continued use after six years of registration.)
- **ROLL-OUT**, U.S. Serial No. 76/457,363, for toy action figures, vehicles and robots. (Approved for publication and notice of allowance issued; abandoned for failure to file statement of use.)
- **ROLL OUT**, U.S. Reg. No. 2,522,610, for roofing underlayment. (Registered on Principal Register.)
- **ROLL OUT 2000**, U.S. Reg. No. 2,653,724, for hand tools for removing

⁷ Instead of considering the varied meanings of the words "Roll Out" as a whole, the Examining Attorney misconstrued the sum of its parts – the words "Roll" and "Out" – in isolation.

automobile windshields. (Registered on Principal Register.)

- **ROLL OUT**, U.S. Serial No. 77/507,005, for home delivery of movies and games. (Approved for publication and notice of allowance issued; abandoned for failure to file statement of use.)
- **ROLL OUT**, U.S. Reg. No. 2,830,040, for massage services. (Registered on Principal Register.)
- **ROLL ME OUT**, U.S. Serial. No. 85/338,006, for stuffed toys. (Approved for publication and notice of allowance issued; abandoned for failure to file statement of use.)

Finally, Applicant's mark **ROLL OUT GARDEN** compares favorably to other marks held not generic. In applying the two-part test under §1209.01(c)(i) of the Lanham Act to following cases, the marks sought to be registered were found not to be generic:

In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (STEELBUILDING.COM not generic for "computerized on line retail services in the field of pre-engineered metal buildings and roofing systems)

In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for "telephone shop-at-home retail services in the field of mattresses")

In re Am. Fertility Soc'y, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine)

In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (CASH MANAGEMENT ACCOUNT for "stock brokerage services, administration of money market fund services, and providing loans against securities services" held merely descriptive, rather than generic, and remanded to Board to consider sufficiency of §2(f) evidence)

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not generic for publications)

Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc., 107 USPQ2d 1750 (TTAB 2013) (ANNAPOLIS TOURS, with TOURS disclaimed, not generic for “conducting guided tours of historic districts and other areas of cities”)

Baroness Small Estates, Inc. v. Am. Wine Trade, Inc., 104 USPQ2d 1224, 1229 (TTAB 2012) (CMS not generic acronym for “wine” made from the grape varieties cabernet, merlot, and syrah; the Board noted that “the fact that a term is derived from individual generic words or even a listing of generic words does not necessarily make the derived term generic”)

In re Tennis Indus. Ass’n, 102 USPQ2d 1671 (TTAB 2012) (TENNIS INDUSTRY ASSOCIATION not generic for “association services, namely, promoting the interests of tennis facilities, tennis manufacturers, tennis retailers and tennis court contractors; providing market research services to track the economic vitality of the tennis industry”)

In re Country Music Ass’n, 100 USPQ2d 1824 (TTAB 2011) (COUNTRY MUSIC ASSOCIATION, with ASSOCIATION disclaimed, not generic for “association services, namely, promoting country music entertainers and the country music recording industry”)

In re Am. Online, Inc., 77 USPQ2d 1618 (TTAB 2006) (INSTANT MESSENGER not generic for telecommunications services and computer services related to providing real time text messages)

Zimmerman v. Nat’l Ass’n of Realtors, 70 USPQ2d 1425 (TTAB 2004) (collective service marks REALTOR and REALTORS not generic for real estate brokerage, management, appraisal, and planning services)

In re Federated Dept. Stores Inc., 3 USPQ2d 1541 (TTAB 1987) (THE CHILDREN’S OUTLET (“OUTLET” disclaimed), while merely descriptive of applicant’s “retail children’s clothing store services,” held capable of functioning as a mark)

Hunter Publ’g Co. v. Caulfield Publ’g Ltd., 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant’s evidence held sufficient to establish acquired distinctiveness pursuant to §2(f))

In re Failure Analysis Assocs., 1 USPQ2d 1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for “consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis” and “consulting engineering services in the metallurgical field,” found to be merely descriptive of applicant’s services rather than incapable of distinguishing them from those of others; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)).

By comparison, Applicant’s mark **ROLL OUT GARDEN** is certainly not generic or even merely descriptive because it tells the consumer very little about the ingredients and/or component parts of the product. The mark does not reference or identify “mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetable and ground cover.” In point of fact, no component part of the product appears in the composite mark. West & Co. v. Africa, supra (must convey immediate idea of the ingredients). Instead, the broad terms used (“roll,” “out” and “garden”) convey little about the ingredients, but rather require that mental leap or pause to determine what the goods are, their function, and their characteristics. In re Hutchinson Technology, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).

Despite the Federal Circuit’s clear directive that the Examining Attorney *must* consider the commercial impression of a proposed mark as a whole, the Examining Attorney failed to consider the composite mark **ROLL OUT GARDEN**, did not provide any analysis regarding how it reached its construction of the words in isolation, and never tied that construction to evidence of what the relevant public would understand those words to mean. As a result, the finding that **ROLL OUT GARDEN** is generic cannot stand. The Board should strike the Examining Attorney’s objection on the basis of genericness and approve the Mark for registration on the Supplemental Register.

B. The Evidence Offered by the Examining Attorney was Wholly Inadequate to Sustain the PTO’s Heavy Burden of Making a Strong Showing of Genericness by Clear and Convincing Evidence.

The Examining Attorney failed to properly undertake the difficult burden of proving genericness by clear and convincing evidence. Compare Office Action dated November 2, 2013; In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (Examining Attorney bears the burden of making a “strong” showing, with “clear evidence,” that the applicant’s proposed mark is generic.); In re K-T Zoe Furniture, Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). In re DNI Holdings, Ltd., 77 USPQ2d 1435, 1437 (TTAB 2005) (“[D]oubt on the issue of genericness is resolved in favor of the applicant.”) Moreover, the evidence offered by the Examining Attorney was wholly insufficient to support a finding of genericness under the 2-part analysis noted above. (Id.)

The Examining Attorney based the genericness finding on seven web pages that have very little, if any, application or relevance to the genericness inquiry here. Four were cited in the initial Office Action Letter dated March 4, 2013, as follows:

1. FunTimesGuide.Com/Living Green: The first web page refers to an anonymous 2010 blog article written about a product designer from the United Kingdom named Chris Chapman who has apparently designed a “Roll-Out Veg Mat.” (See Office Action dated March 4, 2013, Attachments 12-16) The anonymous blog entry does not suggest, nor did the Examining Attorney cite, any evidence that a “Roll-Out Veg Mat” has ever been sold by Chris Chapman or anyone else in the United States.
2. Shade Loving Garden Mix: The second web page refers to a product available at the Home Depot called “Shade Loving Garden Mix.” (See Office Action dated March 4, 2013, Attachments 17-20) There is no evidence in the record that the composite “Roll Out Garden” was ever used on or in connection with this product in the manner Applicant uses **ROLL OUT GARDEN**.
3. Preseeded Garden Roll Out Mat: The third web page refers to a product available on Amazon.com called “Preseeded Sunflower Garden Roll Out Mat.” (Id., Attachments 20-22) There is no evidence that the composite

“Roll Out Garden” was ever used on or in connection with this product in the manner Applicant uses **ROLL OUT GARDEN**.

4. World’s Worst Gardener: The fourth web page refers to a one-time blog written by an anonymous person who discusses a “roll out garden” product you can get at Home Depot. (Id., Attachment 23) This one-time blog entry from an anonymous source has had no other activity since May 2012. Moreover, there is no evidence in the record to confirm or deny whether this individual was actually referring to Applicant’s product.

The Examining Attorney cited three additional web pages in the Office Action Letter dated November 2, 2013, as follows:

5. ThingsAreGood.Com: The fifth web page is a reference to what appears to be the same anonymous 2010 blog article noted above about a product designer from the United Kingdom named Chris Chapman who has apparently designed a “Roll-Out Veg Mat.” (Compare Office Action dated March 4, 2013, Attachments 12-16 to Office Action Letter dated November 2, 2013, Attachments 1-4.) The anonymous blog entry does not suggest, nor does the Examining Attorney cite, any evidence that a “Roll-Out Veg Mat” has ever been sold by Chris Chapman or anyone else in the United States.
6. Walmart Advertisement: The sixth web page is a Walmart page actually promoting and selling Applicant’s product under its **ROLL OUT** trademarks (as opposed to using the terms in a descriptive sense). (See Office Action Letter dated November 2, 2013, Attachments 5-11.) The page also includes multiple anonymous entries commenting on Applicant’s **ROLL OUT** products. (Id.)
7. Yahoo Blog Entries: The final web page is a Yahoo blog with questions about the “roll out garden” product. (Id., Attachment 12-13) As with the blog entries noted above, there is no evidence in the record to confirm or deny whether these consumers were referring to Applicant’s product, but given the Examining Attorney’s other evidence this seems likely.

In sum, the quantum of evidence provided by the Examining Attorney in support of the genericness objection amounts to: (a) an anonymous 2010 blog about a UK product designer; (b) two products sold under entirely different trademarks and which do not use the words “Roll Out Garden” in the manner Applicant uses; (c) a Walmart advertisement for Applicant’s product; and (d) Yahoo blog entries commenting about a “roll out garden” product that conceivably could be

Applicant's product. This evidence: (a) does not show that the relevant consumers view Applicant's designation **ROLL OUT GARDEN** to primarily refer to a genus of goods; and (b) is clearly inadequate to support a finding of genericness. In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re 1800Mattress.com IP LLC, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

Based on the foregoing, the Examining Attorney failed to properly undertake or satisfy the difficult burden of proving genericness by a showing of clear and convincing evidence. In the event the Board does not find acquired distinctiveness based on the arguments below, the Board should strike the Examining Attorney's objection on the basis of genericness and approve the Mark for registration on the Supplemental Register.

II. THE MARK ROLL OUT GARDEN HAS ACQUIRED DISTINCTIVENESS BASED ON SUBSTANTIALLY EXCLUSIVE AND CONTINUOUS USE SINCE 2004 AND SIGNIFICANT EVIDENCE OF ACQUIRED DISTINCTIVENESS.

The Examining Attorney made two critical errors in finding that Applicant's mark **ROLL OUT GARDEN** has not acquired distinctiveness. First, the Examining Attorney failed to follow the proper standards of proof of secondary meaning. Second, the Examining Attorney gave improper weight to the significant Section 2(f) evidence submitted by Applicant.

Whether acquired distinctiveness has been established is a question of fact. See In re Loew's Theatres, Inc., 769 F.2d 764, 769-70, 226 USPQ 865, 869 (Fed. Cir. 1985). Three basic types of evidence may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (*see* 37 C.F.R. §2.41(b); TMEP §§1212.04–1212.04(e));
- (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before

the date when the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(b); TMEP §§1212.05–1212.05(d)); and

- (3) Actual evidence of acquired distinctiveness (*see* 37 C.F.R. §2.41(a); TMEP §§1212.06–1212.06(e)(iv)).

There is no requirement that all three types of evidence be submitted to support a claim of acquired distinctiveness. T.M.E.P. 1212. Moreover, direct evidence such as survey evidence is not a requirement for secondary meaning, which can be, and is most often is, proven by circumstantial evidence. Committee for Idaho’s High Desert v. Yost, 92 F.3d 814, 39 USPQ2d 1705 (9th Cir. 1996).

According to McCarthy, the easiest and least expensive manner to prove secondary meaning by circumstantial evidence is by showing: (a) the amount and nature of advertising for the mark; (b) the length of time the mark has been in use; and (c) the amount of goods sold under the mark. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Secondary Meaning § 15:48 at 15-74 to 15-74 (2002). Although such evidence is circumstantial as to the mental association of buyers, it is relevant evidence from which buyer associations may be inferred. Id., § 15:49 at 15-78 to 15-79 (“The size of a company and its sales figures are relevant evidence from which to infer the existence of secondary meaning”).

Here, it is undisputed that Applicant has had substantially exclusive and continuous use of the mark **ROLL OUT GARDEN** from March 2004 to the present (and had a prior registration of **ROLL OUT GARDEN** on the Supplemental Register from 2005 through 2012).⁸

⁸ The Examining Attorney cited Applicant’s cancelled registration of **ROLL OUT GARDEN**, U.S. Reg. No. 2,986,612, as evidence of mere descriptiveness vis-a-vis this application. Applicant disagrees. Applicant’s request to transfer to the Supplemental Register was made alternatively following argument in response to a mere descriptiveness refusal back in 2005. Thus, to the extent Applicant’s request constitutes an evidentiary admission of mere descriptiveness, which admission was made well before Applicant’s substantially exclusive and continuous use of the mark for more than 5 years.

(See Declaration of Jeff Mounce filed October 16, 2013) (Applicant use of mark on the goods has been substantially exclusive and continuous from March 2004 to the present). The Examining Attorney submitted no evidence to suggest that Applicant's use has been non-exclusive.

As to evidence of advertising and sales, Applicant also submitted significant evidence of acquired distinctiveness, as follows:

1. "Garden Innovations Company Overview," which provides a descriptive overview of the company including reference to over 30 major corporate direct customers and consumer direct marketing on The Home Shopping Network and QVC. (Mounce 10/16/13 Declaration, Exhibit 1)
2. "Garden Innovations 10-Year Sales Chart" reporting sales of products employing **ROLL OUT** marks since 2003. (Mounce 10/16/13 Declaration, Exhibit 2)
3. "Garden Innovations Customer Summary" reporting those customers who have purchased **ROLL OUT** products from Garden Innovations from 2003 through 2013, including, without limitation, major retailers ACE Hardware, Amazon, As Seen on TV.com, Big Lots, Do It Best Corp., Dollar General, Improvements, Kmart, Kmart.com, Menards, Inc., Miles Kimball Company, Mills Fleet Farm, Publishers Clearing House, QCI Direct, QVC, Inc., SuperValu, The Garden Mart, The Home Depot, , The Shopping Channel, Tractor Supply Co., The Home Shopping Network, Walgreen's, Walmart and Walmart.com. (Mounce 10/16/13 Declaration, Exhibit 3)
4. Sample Invoices of purchases of Garden Innovations' **ROLL OUT** products by Tractor Supply Co., Dollar General, ACE Hardware, Miles Kimball Company, Improvements LLC, QCI Direct and Publishers Clearing House. (Mounce 10/16/13 Declaration, Exhibit 4)
5. Sample advertisements for Garden Innovations' **ROLL OUT** products by The Shopping Channel, As Seen On TV and Big Lots. (Mounce 10/16/13 Declaration, Exhibit 5)
6. Photographs of product placements at trade shows and the like. (Mounce 10/16 13 Declaration, Exhibit 6)

7. Garden Innovations' "2014 Program" identifying, among other things, a listing of major retailers that will sell Garden Innovations' **ROLL OUT** products. (Mounce 10/6/13 Declaration, Exhibit 7)
8. Pertinent screenshot of www.rolloutgrass.com, www.rolloutflowers.com and www.rolloutgarden.com (Mounce 10/13/16 Declaration, Exhibit 8)

Notwithstanding 10 years of substantially exclusive and continuous use and the foregoing significant evidence of substantial advertising and sales, the Examining Attorney myopically disregarded Applicant's Section 2(f) evidence out of hand, as follows:

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the Section 2(f) evidence is insufficient to show acquired distinctiveness because although applicant has provide evidence that demonstrates the commercial success of applicant's goods, the evidence does not demonstrate that relevant consumers view the matter as a mark for applicant's goods.

(See Office Action dated November 2, 2013.)

The Examining Attorney's analysis is clearly flawed. Applicant has demonstrated acquired distinctiveness by substantially exclusive and continuous use for over ten years, coupled with significant probative evidence of significant advertising expenditures and commercial success of Applicant's goods. While significant advertising expenditures and sales are not dispositive of secondary meaning, they are certainly probative. See also Yahama International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988) ("[P]roof based essentially on use in advertising and promotion in conjunction with other circumstantial factors has been deemed sufficient to establish secondary meaning.") Such circumstantial evidence can consist of the size of the seller, the number of actual sales made, large amounts spent in promotion and advertising, the scope of publicity given the mark, and any similar evidence showing wide exposure of the buyer class to the mark in question. 2 McCarthy on Trademarks and Unfair Competition, *Secondary Meaning* § 15:30 at 15-47 (citing American

Scientific Channel, Inc. v. American Hospital Supply Corp., 6909F.2d 791, 216 USPQ2d 1080 (9th Cir. 1982) (citing McCarty with approval). As the D.C. Circuit has noted, “to say that proof of extensive advertising and substantial sales may not be probative of secondary meaning is to defy both logic and common sense.” Reader’s Digest Ass’n v. Conservative Digest, 821 F.2d 800, 3 USPQ2d 1276 (D.C. Cir 1987). As a result, Applicant respectfully asserts that the mark **ROLL OUT GARDEN** has acquired distinctiveness and, therefore, is entitled to registration of the Principal Register.

CONCLUSION

Applicant asserts that the evidence offered by the Examining Attorney was wholly inadequate to sustain the PTO’s heavy burden of showing that the mark **ROLL OUT GARDEN** is generic by clear and convincing evidence. As a result, the Board should strike the Examining Attorney’s genericness objection and approve the Mark for registration on the Supplemental Register. Applicant also asserts that the mark **ROLL OUT GARDEN** has acquired distinctiveness by substantially exclusive and continuous use since 2004 and significant actual evidence of acquired distinctiveness. As a result, the Board should strike the Examining Attorney’s mere descriptiveness objection and approve the Mark for registration on the Principal register.

Dated: January 15, 2015

LOMMEN ABDO, P.A.

By /s/ Timothy C. Matson
Timothy C. Matson
1000 International Centre
920 Second Avenue South
Minneapolis, MN 55402
(612) 336-9331
Minnesota Atty. I.D. No. 225423
tim@lommen.com
trademark@lommen.com