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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85768392

MARK: ROLL OUT GARDEN



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Garden Innovations, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

31486

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the examining attorney's final refusal to register the mark ROLL OUT GARDEN for "mulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover." Registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and Section 23(c) of the Trademark Act, 15 U.S.C. §1091(c) on the ground that the mark sought to be registered is generic for the identified goods. In the alternative, registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that the mark sought to be registered is descriptive of the identified goods and on the ground that the evidence submitted by applicant is insufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

STATEMENT OF THE FACTS

Applicant filed an application on October 31, 2012 seeking registration of the mark ROLL OUT GARDEN for "mulch and sees[sic] for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover."

In an Office action dated March 4, 2013, registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that the mark sought to be registered is descriptive of the identified goods. Applicant was also required to provide documentation and information related to the goods and wording in the mark and clarify the identification of goods.

On April 16, 2013, a supplemental Office action was issued, wherein the previously raised Section 2(e)(1) refusal and requirements to provide documentation and information and clarify the identification of goods were continued and maintained, and setting forth an additional requirement to provide information regarding use of the wording in the mark as a varietal or cultivar name.

On October 16, 2013, applicant submitted a response to the Office action contesting the descriptive refusal and, in the alternative claiming that its mark had acquired distinctiveness in accordance with Section 2(f) of the Trademark Act and amending the application to the Supplemental Register.¹ Applicant also responded to the requirements to provide documentation and information related to the goods and wording in the mark, clarify the identification of goods, and provide information regarding use of the wording in the mark as a varietal or cultivar name.

On November 2, 2013, a supplemental Office action was issued to address the new issues raised in applicant's October 16, 2013 response as a result of applicant's alternative arguments related to its claim of acquired distinctiveness and amendment to the Supplemental Register. In this Office action, registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and Section 23(c) of the Trademark Act 15 U.S.C. §1091(c) on the ground that the mark sought to be registered is generic for the identified goods and therefore, is ineligible for registration on the Principal Register under Section 2(f) or the Supplemental Register. In the alternative, registration was refused on the ground that the evidence submitted by applicant is insufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

On May 2, 2014 applicant submitted a response to the Office action contesting the generic refusal and descriptive refusal and, in the alternative claiming that its mark had acquired distinctiveness in accordance with Section 2(f) of the Trademark Act and amending the application to the Supplemental Register.²

¹ Although applicant actually amended the application to seek registration on the Principal Register under a Section 2(f) claim in its response, the amendment to seek registration under a Section 2(f) claim and amendment to seek registration on the Supplemental Register were treated as being alternative arguments as applicant also contested the descriptive refusal.

² Although applicant actually amended the application to seek registration on the Supplemental Register in its response, the amendment to seek registration under a Section 2(f) claim and amendment to seek registration on

On June 2, 2014, the refusal to register the mark pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and Section 23(c) of the Trademark Act, 15 U.S.C. §1091(c) on the ground that the mark sought to be registered is generic for the identified goods was made final. In the alternative, the refusals to register the mark pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that the mark sought to be registered is descriptive of the identified goods and on the ground that the evidence submitted by applicant is insufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f) were made final. Applicant was additionally advised that if the mark was found to be eligible for registration on the Principal Register under a Section 2(f) claim or the Supplemental Register that the wording “garden” must be disclaimed because it is generic for the identified goods.

On November 24, 2014, applicant filed a Notice of Appeal.

On January 15, 2015, applicant filed its appeal brief, which was forwarded to the examining attorney on February 5, 2015, for statement.

ISSUES ON APPEAL

1. Whether the mark ROLL OUT GARDEN is generic when used in connection with “mulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover” under Section 23(c) of the Trademark Act, 15 U.S.C. §1091(c);
2. If the mark is not found generic, whether the mark ROLL OUT GARDEN is merely descriptive when used in connection with “mulch and seeds for agricultural purposes, namely, mats

the Supplemental Register were treated as being alternative arguments as applicant also contested the generic and descriptive refusals.

composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover” under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); and

3. If the mark is not deemed generic but is deemed merely descriptive, whether applicant’s evidence is sufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

ARGUMENT

THE MARK ROLL OUT GARDEN IDENTIFIES THE GENUS OF GOODS IN THE APPLICATION AND WILL BE UNDERSTOOD AS SUCH BY THE RELEVANT PURCHASERS SUCH THAT THE MARK IS GENERIC WITHIN THE MEANING OF SECTION 23(c) OF THE TRADEMARK ACT

A generic term is a common name that the relevant public uses or understands primarily as referring to the category or genus of the goods in question. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); see TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of goods and cannot be registered as trademarks or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c). Registering generic terms “would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods?

In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods is often defined by an applicant's identification of goods. See *In re Country Music Ass'n*, 100 USPQ2d 1824, 1827-28 (TTAB 2011) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In this case, the identification, and thus the genus, is "mulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover."

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods. *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1952 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In this case, the relevant public comprises ordinary consumers who purchase applicant's goods, because there are no restrictions or limitations to the channels of trade or classes of consumers. Therefore, the relevant public consists of ordinary consumers of garden products.

Regarding, the public perception of the mark, the evidence used to determine how relevant consumers understand the meaning of ROLL OUT GARDEN when used in connection with "mulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover," consists of dictionary definitions, applicant's own use of ROLL OUT GARDEN on the goods, and third-party use of the wording ROLL OUT GARDEN.

The word “roll” means “to move forward along a surface by revolving on an axis or by repeatedly turning over.”³ The word “out” means “to be disclosed or revealed; come out.”⁴ The word “garden” refers to “a plot of land used for the cultivation of flowers, vegetables, herbs, or fruit.”⁵ Thus, the wording ROLL OUT GARDEN, when used in connection with applicant’s pre-seeded rolls that grow a garden, will be understood as referring to a roll that one moves forward or repeatedly turns over in order to create a plot of land use for the cultivation of flowers, vegetables, herbs, or fruit.

Applicant’s specimen shows the mark ROLL OUT GARDEN appearing on product packaging, with the following additional notations and depictions: (1) Roll Out Garden Just Roll Out and Water!; (2) the depiction of a green cylindrical roll being unrolled below the wording “roll” and above the wording “Roll out garden over the raked area;” (3) “Fully soak mat thoroughly after rolling out on soil;” (4) the depiction of flowers along with the wording “Beautiful Blooms Like These Can Be Yours,” and (5) Enjoy your Roll Out Flowers garden. Thus, the purchasing consumer will understand the wording ROLL OUT GARDEN as identifying a type of goods, namely, a pre-seeded roll that grows a garden (in this case, a flower garden) after it is rolled out and watered.

For a mark that is a generic phrase, the evidence of record must show that the composite mark, as a whole, is used generically and thus would be perceived by the relevant purchasing public as a generic phrase when used in connection with the relevant goods. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345-46, 57 USPQ2d 1807, 1810-11 (Fed. Cir. 2001) (quoting *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1348-49, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760 (TTAB 2013); TMEP §1209.01(c)(i).

³ *See, Office action dated March 4, 2013 at pgs. 2-5*

⁴ *See, Office action dated March 4, 2013 at pgs. 6-9*

⁵ *See, Office action dated March 4, 2013 at pgs. 10-12*

In the present case, the following evidence establishes that the applied-for mark ROLL OUT GARDEN is generic as used in connection with a pre-seeded roll that grows a garden as it shows use of the composite mark, as a whole, generically:

- Living Green website providing an article about how a roll-out vegetable garden makes gardening easy wherein the author notes that he can't help notice how much the "**roll-out garden**" mats look like yoga mats and advising that whether you decide to jump on board with the "**roll-out garden**" or create your own from scratch, be sure to know how to deal with slugs and other pests in all-natural ways⁶
- World's Worst Gardener website providing information about the writer's experience trying the "**roll out garden**" you can get at Home Depot⁷
- Things Are Good website providing information about a neat "**roll-out garden**" designed by Chris Chapman⁸
- Walmart website showing what appears to be another product from applicant's "roll out" line of goods, which is identified as being a "**roll-out garden**" that produces thousands of flowers with vivid colors and fragrances to enjoy⁹
- Yahoo website showing a question posted by a user asking if the 'roll n grow' "**roll out garden**" works¹⁰

In conclusion, the evidence demonstrates that consumers perceive the wording ROLL OUT GARDEN as the common commercial or generic name for mats that are rolled out to grow a garden.

For the foregoing reasons, ROLL OUT GARDEN is generic for the identified goods and accordingly the generic refusal should be affirmed.

⁶ See, Office action dated March 4, 2013 at pgs. 13-16

⁷ See, Office action dated March 4, 2013 at pg. 24

⁸ See, Office action dated November 2, 2013 at pgs. 2-5

⁹ See, Office action dated November 2, 2013 at pgs. 6-12

¹⁰ See, Office action dated November 2, 2013 at pgs. 13-14

APPLICANT'S ARGUMENTS AGAINST THE GENERIC REFUSAL

Applicant contests the generic refusal based upon two arguments. First, applicant argues that the examining attorney failed to analyze the commercial impression of the mark as a whole. Applicant makes this argument on the basis that the examining attorney included definitions of the individual words that comprise the mark. In the present case, the dictionary evidence provided is only one part of the evidence and overall analysis provided to support the generic refusal. In addition to dictionary definitions, the examining attorney has provided evidence of the exact wording in the mark, ROLL OUT GARDEN, used as a generic phrase to identify pre-seeded rolls that grow a garden.

In furtherance of the argument that the dictionary definitions of the individual words that comprise the mark do not support the generic refusal, applicant indicates that the definitions included as evidence, specifically with respect to the wording "roll out" are problematic because this wording has other meanings when used in different contexts.

Here, as noted by applicant however, the analysis does not take place in a vacuum and the determination as to whether the applied-for mark is generic for the identified goods cannot be made in the abstract.

In this case, applicant has provided definitions of the wording "roll out" which completely disregard the nature of the goods. Applicant has provided definitions that relate to aeronautics, sports, business, games, and drag racing while the goods at issue are garden products. Therefore, applicant's evidence does not establish that ROLL OUT GARDEN is not generic of the identified goods, nor does it shed any light on the consumer perception of the mark. Instead, applicant's alternate definitions establish only that in connection with other goods or services the wording "roll out" may be perceived by consumers

differently when applied in the fields of aeronautics, sports, business, games, and drag racing, as opposed to garden products.

Applicant references nine third-party applications or registrations in arguing that the mark is suggestive and not generic. Out of the nine referenced applications and registrations, only three are active registrations. Further, the issue here is not whether “roll out” is generic in connection with the goods and services set forth in the third-party applications or registrations. The determination of whether the mark ROLL OUT GARDEN is generic for the identified goods must be made in connection with the identified goods. Here, eight of the nine references show the wording “roll out” used in connection with goods and services that are completely unrelated to applicant’s goods, such as electric cable and wiring, business and financial services, toys, roofing underlayment, hand tools, home delivery of movies and games, and massage services. Applicant cites to only one cancelled registration that relates to garden products, namely, Registration No. 2030291 for plant growth regulator for agricultural use. Although applicant’s goods and plant growth regulators are both garden products, plant growth regulators are liquid and thus the meaning of “roll out” would be perceived entirely differently by a consumer in connection with liquid goods than in connection with a pre-seeded roll that grows a garden. Therefore, the evidence of the third-party applications and registrations offered to support the conclusion that the wording “roll out” is not generic in connection with goods and services which are entirely different from applicant’s goods is irrelevant.

Applicant also argues that the mark is not generic when considered as a whole because consumers will not be able to reach a conclusion as to the nature of the goods in connection with which it is used. This argument is completely belied by the evidence which shows that the mark is used by others to identify a type of goods, namely, a pre-seeded roll that grows a garden and which supports that when viewed in connection with the goods, consumers will indeed be able to reach a conclusion as to the

nature of the goods because ROLL OUT GARDEN is the common commercial or generic name for a pre-seeded roll that grows a garden.

The second argument advanced by applicant against the generic refusal is that the evidence is inadequate because there is no indication one way or another as to whether or not the references to ROLL OUT GARDEN set forth above refer to applicant's product and also that there is no evidence in the record to show that the composite "roll out garden" was ever used on or in connection with a product in the manner applicant's uses the mark. The evidence shows generic use of the wording ROLL OUT GARDEN because it shows the wording used to identify a type of product, and does not show the wording used to refer to applicant, nor any other entity as the source of goods. This can also be gleaned from the context of the evidence showing generic use of the wording ROLL OUT GARDEN. For example, the reference to the "roll out garden" on the Yahoo website identifies the source of the product as being "roll n grow" which directly contradicts any assertion that this reference points to applicant's goods. Further, the reference to the "roll out garden" on the Things Are Good website indicates that the goods are designed by Chris Chapman, which again directly contradicts any assertion that this reference points to applicant's goods. Notably, none of the references contain any mention of applicant's company Garden Innovations, which also supports that the references do not point to applicant's goods. Moreover, even if the goods referred to in the evidence are applicant's, as it appears to be the case on the Walmart website, the use of the wording ROLL OUT GARDEN demonstrates that consumers perceive this wording to identify a type of good, and not the source of the goods.

Applicant also argues that blog entries do not show that the relevant consumers view applicant's mark as primarily a designation to refer to the genus of applicant's goods. To the contrary, examples of terms being used in consumer blogs, discussion groups and forums provide direct evidence of consumers' familiarity with the term and their understanding of the term's significance. *See In re*

Jonathan Drew, Inc. dba Drew Estate, Ser. No. 78979742 2009 TTAB LEXIS 707 (Dec. 31, 2009) (INFUSED CIGARS held to be generic for use in connection with “cigars.”)¹¹

For the reasons set forth above, applicant’s arguments against the generic refusal are unpersuasive.

IN THE ALTERNATIVE, THE MARK ROLL OUT GARDEN DESCRIBES A FEATURE AND THE TYPE OF THE GOODS AND WILL BE UNDERSTOOD AS SUCH BY THE RELEVANT PURCHASER SUCH THAT THE MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT

In the alternative, if the mark is ultimately determined not to be generic for the identified goods, the mark is descriptive of the identified goods.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Further, determining the descriptiveness of a mark is done in relation to an applicant’s goods, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b).

¹¹ The examining attorney has attached a courtesy copy of the decision. To independently view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the opposition number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

As discussed above, applicant seeks registration of the mark ROLL OUT GARDEN for use in connection with “mulch and seeds for agricultural purposes, namely, mats composed of wood fiber mulch containing seeds for flowers, grass, herbs, vegetables and ground cover.”

The word “roll” means “to move forward along a surface by revolving on an axis or by repeatedly turning over.”¹² The word “out” means “to be disclosed or revealed; come out.”¹³ The word “garden” refers to “a plot of land used for the cultivation of flowers, vegetables, herbs, or fruit.”¹⁴ Thus, the wording ROLL OUT GARDEN, immediately conveys that the goods are in the nature of a garden which features the ability to be moved forward along a surface by revolving on an axis (i.e. rolled out).

In addition to the dictionary definitions of the individual terms which demonstrate that the wording ROLL OUT GARDEN, when used in connection with applicant’s mats, will be understood as describing a feature and the type of applicant’s goods, applicant’s very own specimen supports that the wording “roll out” will be understood as describing a salient feature of the goods and that the wording “garden” identifies the type of goods.

Applicant’s specimen shows the mark ROLL OUT GARDEN appearing on product packaging, with the following additional notations and depictions: (1) Roll Out Gard Just Roll Out and Water!; (2) the depiction of a green cylindrical roll being unrolled above below the wording “roll” and above the wording “Roll out garden over the raked area;” (3) “Fully soak mat thoroughly after rolling out on soil;” (4) the depiction of flowers along with the wording “Beautiful Blooms Like These Can Be Yours,” and (5) Enjoy your Roll Out Flowers garden. Thus, the purchasing consumer will understand the wording “roll

¹² See, *Office action dated March 4, 2013 at pgs. 2-5*

¹³ See, *Office action dated March 4, 2013 at pgs. 6-9*

¹⁴ See, *Office action dated March 4, 2013 at pgs. 10-12*

out” as describing a salient feature of the goods, namely, that the goods feature the ability to be rolled out to grow a garden as opposed to growing a garden in a more traditional way, such as by sprinkling seeds to grow a garden. Moreover, applicant’s own specimen uses the wording “garden” to denote the type of the goods and thus applicant’s own specimen supports that the wording “garden” identifies the type of goods.

The following evidence shows descriptive third-party use of the wording “roll out” and generic use of the wording “garden,” separately:

- Living Green website providing an article about how a “**roll-out**” vegetable “**garden**” makes gardening easy and indicating that all one has to do is “**roll it out,**” add soil and water to start a “**garden**”¹⁵
- Home Depot website showing the sale of a garden roll and providing in the product description that the garden roll make it easy to grow your own flower garden – “**Roll out**” the mat to get your annual, organic flower ‘**garden**’ started right away¹⁶
- Amazon website showing the sale of a pre-seeded sunflower garden roll out mat, which lets you “**roll out**” flower “**gardens**” with no digging, furrowing or planting by hand¹⁷

In addition to the evidence which shows descriptive third-party use of the wording “roll out” and generic use of the wording “garden,” separately, the record contains the following evidence showing third-party use of the composite phrase ROLL OUT GARDEN wherein the wording “roll out” describes a salient feature of the goods and the wording “garden” identifies the type of goods:

- Living Green website providing an article about how a roll-out vegetable garden makes gardening easy wherein the author notes that he can’t help notice how much the “**roll-out garden**” mats look like yoga mats and advising that whether you decide to jump on board with the “**roll-out garden**” or create your own from scratch, be sure to know how to deal with slugs and other pests in all-natural ways¹⁸

¹⁵ See, Office action dated March 4, 2013 at pgs. 13-16

¹⁶ See, Office action dated March 4, 2013 at pgs. 17-20

¹⁷ See, Office action dated March 4, 2013 at pgs. 21-23

¹⁸ See, Office action dated March 4, 2013 at pgs. 13-16

- World's Worst Gardener website providing information about the writer's experience trying the "**roll out garden**" you can get at Home Depot¹⁹
- Things Are Good website providing information about a neat "**roll-out garden**" designed by Chris Chapman²⁰
- Walmart website showing what appears to be another product from applicant's "roll out" line of goods, which is identified as being a "**roll-out garden**" that produces thousands of flowers with vivid colors and fragrances to enjoy²¹
- Yahoo website showing a question posted by a user asking if the 'roll n grow' "**roll out garden**" works²²

In conclusion, the evidence demonstrates that when purchasers encounter the mark ROLL OUT GARDEN on applicant's goods, they will immediately understand the mark as a combination of a term describing a salient feature of applicant's goods, namely, that the goods feature the ability to be rolled out for use, and a term identifying the class of applicant's goods, namely, gardens.

For the foregoing reasons, in the event that the mark ROLL OUT GARDEN is ultimately determined not to be generic for the identified goods, the mark is descriptive of the identified goods and accordingly the descriptive refusal should be affirmed.

APPLICANT'S ARGUMENTS AGAINST THE DESCRIPTIVE REFUSAL

Applicant contests the descriptive refusal based upon the same argument used to contest the generic refusal, specifically, that the examining attorney failed to analyze the commercial impression of

¹⁹ See, Office action dated March 4, 2013 at pg. 24

²⁰ See, Office action dated November 2, 2013 at pgs. 2-5

²¹ See, Office action dated November 2, 2013 at pgs. 6-12

²² See, Office action dated November 2, 2013 at pgs. 13-14

the mark as a whole. As detailed above in the generic refusal, the use of individual dictionary definitions does not warrant a conclusion that the commercial impression of the mark as a whole has been disregarded. Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

In this case, both the individual components and the composite result are descriptive of applicant’s goods, as demonstrated by not only the individual definitions of the terms but also by the evidence consisting of screenshots of third-party websites, which collectively demonstrate that the wording “roll out” describes a salient feature of the goods and the word “garden” identifies the type of goods, and further that the mark is used descriptively, as a composite phrase, in connection with the identified goods.

Further, despite the other meanings of the wording “roll out” provided by applicant, the determination of whether a mark is merely descriptive is made in relation to an applicant’s goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102

USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

In any event, the general definition of the wording “roll out” provided by applicant, namely, to “flatten or spread with a roller” and to “straighten by unrolling” actually supports that this wording describes a salient feature of the goods because as demonstrated by applicant’s specimen and sample advertisements, the product does feature the ability to be flattened or spread with a roller and to be straightened by unrolling.

Applicant references the same third-party applications or registrations outlined above in the generic refusal in arguing that the mark is suggestive and not descriptive. As noted previously, the fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d

1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); see *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Therefore, applicant's evidence of third-party registrations for different goods and services is not persuasive where here, the evidence illustrates that the wording ROLL OUT GARDEN immediately conveys salient information about the goods.

Finally, applicant argues that the mark is not descriptive because consumers will not be able to reach a conclusion as to the nature of the goods in connection with which it is used. As noted above, this argument is completely belied by the way in which applicant advertises its own product wherein the "roll out" feature of the goods is highlighted by applicant in describing the ease of use of the product to grow a garden.

For the reasons set forth above, applicant's arguments against the descriptive refusal are unpersuasive.

APPLICANT'S EVIDENCE OF ACQUIRED DISTINCTIVENESS IS INSUFFICIENT TO ESTABLISH THAT THE MARK ROLL OUT GARDEN HAS ACQUIRED DISTINCTIVENESS WITHIN THE MEANING OF SECTION 2(f) OF THE TRADEMARK ACT AND THUS APPLICANT HAS NOT OVERCOME THE DESCRIPTIVE REFUSAL

In the alternative, if the mark is ultimately determined to be descriptive and not to be generic for the identified goods, the Section 2(f) evidence submitted by applicant is insufficient to show that the mark has acquired distinctiveness.

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Bd. of Trs. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970)); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); see TMEP §1212.05(a).

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods would be less likely to believe that it indicates source in any one party. See, e.g., *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013).

The burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); see *In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971).

Applicant has submitted the following evidence in support of its claim that the mark has acquired distinctiveness: (1) a statement describing applicant's length of substantially exclusive and continuous use since 2004; (2) information about applicant's sales of all "Roll Out" products; and (3) evidence of applicant's marketing efforts, namely, sample advertisements, photographs of product placements, and website screenshots.

Regarding applicant's statement describing its length of substantially exclusive and continuous use since 2004, applicant has failed to show that its use is substantially exclusive as demonstrated by the aforementioned evidence showing multiple uses by third-parties in a generic manner, which belies any assertion of exclusivity of use. Further, the fact that applicant has been using the mark for a long time is merely indicative of applicant's commercial success and not dispositive of whether the mark has acquired distinctiveness.

Regarding applicant's sales information, applicant has not provided evidence which specifically evidences the sales figures for the goods at issue. Instead, applicant has provided the sales figures for *all* of its "Roll Out" products thus rendering the sales information completely irrelevant as to the amount of sales of the relevant goods. In any event, to the extent that the sales figures are considered, such evidence is not dispositive of whether the proposed mark has acquired distinctiveness. Sales may demonstrate the commercial success of applicant's goods, but sales do not establish that the relevant consumers view the matter as a mark for such goods. See *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

Regarding the evidence of applicant's marketing efforts, namely, the sample advertisements, photographs of product placements, and website screenshots, this evidence is merely indicative of applicant's efforts to develop distinctiveness and is not evidence that the mark has acquired distinctiveness. See *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). Additionally, there is no evidence regarding how many consumers or potential consumers have encountered applicant's marketing, and thus this evidence does not shed any light on consumer perception of the mark.

Finally, the evidence summarized above, which demonstrates many different uses of the wording ROLL OUT GARDEN in connection with pre-seeded rolls that grow a garden supports that purchasers will

not understand the mark as pointing uniquely to applicant as the source of the goods because consumers perceive the mark as identifying a type of product, not as identifying the source of the goods.

In conclusion, applicant has failed to submit evidence which demonstrates that consumers perceive the mark as pointing uniquely to applicant as the source of the goods, and thus applicant has failed to submit sufficient evidence to establish that the mark has acquired distinctiveness.

For the foregoing reasons, if the mark is ultimately determined to be descriptive and not to be generic for the identified goods, applicant's Section 2(f) evidence is insufficient to show acquired distinctiveness and accordingly the refusal to register the mark on the ground that applicant's Section 2(f) evidence is insufficient to show acquired distinctiveness should be affirmed.

APPLICANT'S ARGUMENTS AGAINST THE SECTION 2(f) REFUSAL

Applicant argues that the examining attorney made two critical errors in finding that applicant's mark has not acquired distinctiveness. First, there was a failure to follow the proper standards of proof of secondary meaning and second, improper weight was given to the significant Section 2(f) evidence submitted by applicant.

In arguing that the mark has acquired distinctiveness, applicant indicates that it is undisputed that applicant has had substantially exclusive and continuous use of the mark since 2003. To the contrary, as noted above, the evidence demonstrates several third-party uses of the wording which evidence that applicant is not the exclusive user of the wording.

Applicant argues that it has provided significant probative evidence of sales and advertising expenditures. For the reasons noted above, applicant's sales do not establish anything other than applicant's commercial success in this case and additionally the sales information provided does not

even specifically relate to the identified goods. Further, applicant has not included any marketing expenditures, and instead has only provided examples of how it advertises its goods without any context provided as to the number of consumers or potential consumers which have been exposed to applicant's marketing efforts and thus this evidence does not reveal anything regarding consumer perception of the mark.

For the reasons set forth above, applicant's arguments that its claim of acquired distinctiveness is sufficiently supported are unpersuasive.

CONCLUSION

Based upon the foregoing, the examining attorney respectfully requests that the Board affirm the refusal to register the mark pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and Section 23(c) of the Trademark Act 15 U.S.C. §1091(c) on the ground that the mark sought to be registered is generic for the identified goods. In the alternative, the examining attorney respectfully requests that the Board affirm the refusals to register the mark pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that the mark sought to be registered is descriptive of the identified goods and on the ground that the evidence supported by applicant is insufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Respectfully submitted,

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THIS OPINION IS
NOT A PRECEDENT OF
THE TTAB

Mailed: December 31, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jonathan Drew, Inc. dba Drew Estate

Serial No. 78979742

John W. Goldschmidt, Jr. of Dilworth Paxson LLP for Jonathan Drew, Inc. dba Drew Estate.

Priscilla Milton, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Holtzman, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Jonathan Drew, Inc. dba Drew Estate (applicant) filed an application to register on the Principal Register the mark INFUSED CIGARS in standard character form for goods ultimately identified as "cigars" in Class 34.¹

¹ Serial No. 78979742 filed July 27, 2005 based on an allegation of a bona fide intent to use the mark in commerce. The application includes a claim of ownership of Registration No. 3080344 on the Principal Register for the mark INFUSION for "cigars." An amendment to allege use asserting a date of first use and first use in commerce of November 30, 2007 was filed on December 4, 2007 and accepted by the examining attorney.

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The trademark examining attorney refused registration on the ground that the mark is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act. When applicant, in response to the refusal, filed an alternative amendment to the Supplemental Register, the examining attorney refused registration under Section 23 of the Act on the ground that the mark is generic for the goods and incapable of distinguishing applicant's goods from those of others.

The refusals were ultimately made final, and applicant appealed. Both applicant and the examining attorney have filed briefs.

We turn first to the question of genericness. The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) 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 (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (quoting *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

The Office has the burden of proving the genericness of a term by "clear evidence" of the public's understanding thereof.

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In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

The genus or category of goods in this case is the wording used in the identification, "cigars." The relevant public for applicant's cigars includes cigar "aficionados" and enthusiasts as well as ordinary members of the general public.

We turn then to the meaning of INFUSED CIGARS to the relevant public. Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. See Reed Elsevier Properties Inc., supra at 1380. Third-party websites are competent sources to show what the relevant public would understand a term to mean. Id. at 1381.

The examining attorney has submitted dictionary definitions of the word "infused" including the following:

1. To put into or introduce as if by pouring:
infused new vigor into the movement
 2. To fill or cause to be filled with something:
infused them with a love of the land
 3. To flavor or scent (a liquid) by steeping ingredients in it: "*He would infuse . . . vegetable oil with the pungent taste of scallions*" (Nina Simonds).
The American Heritage® Dictionary of the English Language (Fourth Edition 2009).
3. *intransitive verb* steep something in liquid: to soak tea or herbs in liquid to extract the flavor or another property, or be soaked in this way.
Encarta World English Dictionary (2007).

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As suggested by one or more of the above definitions, the term "infused" as applied to cigars, refers to a cigars that are flavored, or have been treated or processed in some way to absorb a flavor. This meaning is consistent with the Lexis/Nexis and website evidence submitted by the examining attorney showing that cigars are "infused" with flavors considered complementary to the taste of the cigar, such as chocolate, vanilla, coffee, herbs and liqueurs. Some examples are as follows (emphasis added):

After choosing from hundreds of varieties, ranging from cigars **infused** with coffee and chocolate to traditional full-bodied cigars,...

The Arizona Republic (Phoenix) December 10, 2005

The store sells a variety of cigars, including liquor and fruit flavored ones. Prices range from \$1.69 cigars called Rolys to a \$30 cigar double **infused** with Louis XIII Cognac. "It tastes like the cognac when you smoke it," said Jim Gaynor, one of the store's owners...

The Miami Herald August 28, 2005

...can have two cigars that look the same but taste completely different. The consistency - how tightly they're wrapped. "A lot of these are **infused** with different herbs or liqueurs."

Charleston Gazette (West Virginia) October 24, 2006

Overstock.com
Your Online Outlet
NICA Vanilla Caramel and Cognac Mini Cigars Pack
Nica Dulce cigars are slightly **infused** with Vanilla Caramel...flavor from start to finish. ... If you enjoy flavored cigars, you will love this mini cigar.
Overstock.com

The evidence below shows that cigars that have been imbued with a flavor, whatever process is used, are typically referred

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to as "flavored" or "infused cigars." Indeed, applicant admits that its goods are "flavored cigars." Brief at 4. The examining attorney has introduced numerous articles from the Lexis/Nexis database and printouts from retail and other commercial websites demonstrating the well recognized meaning of "infused cigars." The following excerpts are representative of the many examples of record (emphasis added).

A new trend with up and coming cigar smokers are **flavor-infused cigars**. We're not talking swisher sweet here. There are a number of these premium flavored cigars including the Acid line by Drew Estates.
Pensacola News Journal (Florida) December 22, 2006

...can have two cigars that look the same but taste completely different. The consistency - how tightly they're wrapped. "A lot of these are infused with different herbs or liqueurs. This one is called Java. This one is vanilla-infused." Kahlua, the liqueur maker, has a whole line of **infused cigars**.
Charleston Gazette (West Virginia) October 24, 2006

The storefront space seats 60; this includes the back room, dubbed a cigar parlor, where cigar smoking is encouraged and premium cigars are offered for sale. Harloff, the cigar lover, is also experimenting with **liqueur-infused cigars**.
Chicago Tribune December 22, 1995

Kevin Godbee, editor & publisher of Cigar-Review.com says, "The article is primarily about Drew Estate and their unique line of **infused cigars**."
M2 Presswire December 23, 2005

ROCKY'S CIGARS ONLINE

Discount Cigars

The famous coffee flavor of original Kahlua liqueur has been captured in a new cigar developed exclusively by Drew Estate, famous for his flavored **infused cigars**.

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rockyscigars.com

CIGARS INTERNATIONAL

Keith's PICK - Java by Drew Estate

See, Drew Estate is the king of **infused cigars**, known for ACID, Kahlua, Natural, etc. ... He wanted an unconventional, subtly flavored cigar unlike anything else on the market, and Drew Estate was the only maker that could pull that off.

cigarsinternational.com

Winecottageshop.com

Your Local Full Service Gourmet Wine Shop and More... Cigar Enthusiasts stop in and check out the humidor for your favorite Summertime smokes. We have an excellent selection for the ladies too. CAO makes great **infused cigars**, and cigarillos for every price and pleasure.

winecottageshop.com

Nicky Blaine's cocktail lounge

Nicky's Cigar Menu

[category] "**Flavor Infused Cigars**" [listing, for example] Bliss, Wild Cherry, Peach Passion, CAO Karma Sutra, Baileys Irish Cream, Gurkha cigar infused with Louis XIII Cognac, Makers Mark Bourbon Infused, Chocolate Infused Cigar, Vanilla Infused Cigar.

nickyblaines.com

Watch City Cigar

Silverados

Tins of 10 little **menthol infused cigars**

watchcitycigar.com

PRONTO shopping gone social

Category - Cigars

Kahlua Cigars Kahlua Corona Box of 24

Kahlua is one of the very few premium **infused cigars**.

pronto.com

CIGAR KING

FLAVORED AND **INFUSED CIGARS**: [listing, for example]

Acid; Ambrosia By Drew Estate; CAO Flavours; Gurkha Grand Reserve; Helix Remix Cafe Mocha; Rocky Patel Java; Lars Tatens Phat Cigars; Isla Del Sol; Makers Mark

cigarking.com

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Busy Bee Lifestyle
Fabulous and Unique Christmas Gifts for Men
Maker's Mark
This holiday season the company has expanded its line
to include a "Maker's Mark Gourmet Lover's Box"
containing...**bourbon infused cigars** in personalized
boxes.
busybeelifestyle.com

SEÑOR JUAN'S TABACALERO
The Friendliest Store On The New Jersey Shore!
HAND ROLLED INFUSED ROBUSTO TORPEDO Churchill
Cuban **Infused Cigars** By Chico
Senorjuancigars.com

QUALITY IMPORTERS TRADING COMPANY
Cigars
El Duque Cognac (**Cognac Infused Cigars**)
Torano - Reserva Decadencia (**Port Wine Infused Cigar**)
His Majesty Reserve (infused with a full bottle of
Premium Cognac)
Gurkha Grand Reserve (infused with Premium Cognac)
Qualityimporters.com

Cigar.com - Cigars
If you enjoy flavored and **infused cigars**, try the
[Dominican Sweets]... Other great flavors to try are
the [Acid by Drew Estate]...
cigar.com

The evidence above demonstrates exposure of the term
"infused cigars" to the relevant consumers and their
understanding of the term as a reference to a particular type of
cigar. However, the record also includes many examples of
generic use of "infused cigars" in consumer blogs, discussion
groups and forums, providing direct evidence of consumers'
familiarity with the term and their understanding of the term's

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significance. Some examples are set forth below (emphasis added).

LUXIST

Carlos Torano Introduces Port-Infused Cigars
Cigar maker Carlos Torano has announced a new product that may well be my dream cigar. The Carlos Torano Reserva Decadencia is a **port-infused cigar**. ... The unique flavor of the port inspired him to create...the company's top-rated cigar...with the gold-medal winning port wine. ...
luxist.com

today's Cigar
contamination?

[from BD] Pure bunk, The flavors don't marry in any way. ... But if you have flavored or **infused cigars** keep those separate.
cigarstoday.com

Club Stogie - Home of the Lowland Gorillas

Re: Maker's Mark cigars?

[by worr lord] Does anyone have experience with these?

[by RGD] Not with the Marker's Mark - but have had two Erin Go Bragh - which is along the same lines as they are **infused cigars**. ...

Clubstogie.com

THE CIGAR ADDICT

ACID DEF SEA

It was July of 2005 when my good friend Marlon introduced me to Acid's line of **infused cigars**. It was the Def Sea that became my staple, my everyday kind of smoke. ...
thecigaraddict.com

Cigar Trends Forum

Cigar Recommendations

[by khest] I have had the Latin Golds when living in SA. They offer **infused cigars** (flavour cigars) so if you like Swisher Sweets try their vanilla flavour.
cigartrends.com

CigarPass > The Good Life > Cigar Reviews

Maker's Mark 650

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[byBrickhouse] I don't smoke **infused cigars**, but this one has always had my interest...

cigarpass.com

TomsCigars.com

[Reviews]

Acid Remi Kuba Kuba

Although I don't regularly smoke flavored or **infused cigars** I thought it was time to try one of the most popular infused smokes.

tomscigars.com

STOGIE SR REVIEW

El Rey de los Habanos

[by RayD] I take the cello off of all of my cigars except for **infused cigars**. The **infused cigars** are kept in a separate humi, but I keep the cello on because I feel that they're more likely to pick up flavors than **non-infused cigars**.

stogiereview.com

Olivia

Cigar club

There are even a lot of nice **infused cigars** these days that are mild and have a true infused taste instead of just the tip being sweet.

olivia.com

PUFF.com Forums

General Cigar Discussion

[by mtg972] Not really much into flavored/**infused cigars**, but I know Cl sells 2 brands made by La Aurora. Slainte is made with single malt scotch and Erin Go Bragh, Irish whiskey. ... And TNT sells bundles of La Divas (cognac) 25/\$40.

puff.com

Mayorga Coffee Infused - Club Stogie Cigar Discussion Forum

Has anyone tried these Mayorga Coffee Infused cigars? ...I've tried **infused cigars** before and really don't care for them ...

clubstogie.com

Jack Daniels Cigars - Cigar community and forum

As far as I know, you can get **liquor-infused cigars** from makers mark, gurkha and oliveros...

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cigarsmokers.com

It is clear from the Nexis articles and third-party commercial websites as well as consumer websites that "infused cigars" is a generic term, commonly used and understood to denote a type of cigar.

We find that the examining attorney has met her burden of establishing, prima facie, that the primary meaning of INFUSED CIGARS is generic for "cigars." Neither applicant's arguments nor its evidence rebuts this showing.

We do not question that applicant may be a "leading maker" or perhaps a "pioneer" of "infused cigars" or even that applicant coined the term. The problem is that none of these facts overcomes the generic meaning of "infused cigars" or makes this generic term registrable. See, e.g., *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1538 (TTAB 2007) ("Even if applicant was the first... user of a generic term or phrase...that does not entitle applicant to register such a term or phrase as a mark."). While sellers may recognize applicant as a well known maker or blender of cigars and that applicant is a significant source for "infused cigars," they nevertheless use the term "infused cigars" to refer to a type of cigar, rather than to brand of cigar. The record is clear that they do not recognize "infused cigars" to indicate the source of those cigars only in applicant.

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Applicant argues that many of the articles and/or websites are referring to applicant's products which as described by applicant include "Sauza Tequila Infused Cigar," "Acid's line of infused cigars" and "Kahlua infused cigars." Brief at 6. This argument is irrelevant because as explained above cigar retailers use the term "infused cigars" to refer to a type of cigar, rather than to brand of cigar. Moreover, the evidence shows that there are many other producers of "infused cigars" and that these producers similarly use "infused cigars" to denote a flavored cigar, for example, Maker's Mark Bourbon Infused Cigars, Black Star Farms Brandy Infused Cigars and Gurkha Royal Reserve Triple Cognac Infused Cigar. See, e.g., shopwiki.com; merchantcircle.com; thefind.com (excerpts not included). Also, the flavored cigars of other producers such as CAO, Chico, Helix and Cusano (Dominican Sweets) are advertised or promoted as "infused cigars." See, e.g., excerpts, supra, from winecottageshop.com; senorjuancigars.com; cigarking.com; cigar.com. Applicant's own evidence shows clear generic usage of "infused cigars" even when referring to applicant's brands of cigars, as in the following article which discusses applicant's "Kahlua" cigars.

BestCigarPrices.com
Kahlua Cigars
Kahlua was an ideal choice for General Cigars when they decided to introduce a new **infused cigar** line. When one thinks of infused cigars, the name that

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comes up is Drew Estate, and General went right to Jonathan Drew for their blend,. . . .for someone who wants to try something different, or someone who is a fan of **infused cigars**, Kahlua cigars are the perfect fit. . . .
Bestcigarprices.com

This is not a case of a "mixed" record as applicant contends. In this case, there is no evidence of use or recognition of "infused cigar" as a mark at least apart from applicant's composite marks such as Sauza Tequila Infused Cigars. Even in that case, "infused cigars" is used generically (*i.e.*, Sauza brand tequila infused cigars). Indeed, none of the evidence of record suggests in any way that the term "infused cigars" in itself acts as a source identifier indicating cigars originating solely from applicant.²

The term INFUSED CIGARS is incapable of distinguishing applicant's goods from the similar goods of others. Thus, the designation is not registrable on either the Principal Register or the Supplemental Register. Because applicant filed an "alternative amendment" to the Supplemental Register, we will now assume that INFUSED CIGARS is not generic and decide the question of whether the mark merely descriptive.

If INFUSED CIGARS is not generic, then the term is certainly descriptive of applicant's goods. The dictionary definitions,

² To the extent that applicant is making the argument, we point out that applicant's Registration No. 3080344 of a different mark for cigars has no bearing on the question of whether the mark in this case is registrable. See *In re Parkway Machine Corp.*, 52 USPQ2d 1628 (TTAB 1999).

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Nexis articles, website printouts and applicant's own evidence shows that the term is highly descriptive of a significant feature or characteristic of applicant's cigars. Indeed, while maintaining that its mark is not generic, applicant expressly states that the mark "may be at a minimum descriptive." Req. for Recon., March 30, 2009. There is no doubt that consumers would immediately, and without the exercise of any imagination, understand the descriptive meaning of INFUSED CIGARS in relation to cigars.

Decision: The refusal to register under Section 23 of the Trademark Act on the ground that the mark is generic for the goods is affirmed; and the refusal to register on the ground that the mark is merely descriptive of the goods under Section 2(e)(1) of the Act also is affirmed.