

ESTTA Tracking number: **ESTTA665748**

Filing date: **04/09/2015**

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, tm@lommen.com
Submission	Reply Brief
Attachments	ROLL OUT GARDEN - Reply Brief.pdf(57623 bytes)
Filer's Name	Timothy C. Matson
Filer's e-mail	trademark@lommen.com
Signature	/s/ Timothy C. Matson
Date	04/09/2015

**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* REPLY BRIEF

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF CONTENTS.....	1
TABLE OF AUTHORITIES.....	2
ARGUMENT.....	3
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	3
A. The Examining Attorney Failed to Analyze the Commercial Impression of the Mark ROLL OUT GARDEN as a whole.....	3
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.....	5
II. THE MARK ROLL OUT GARDEN HAS ACQUIRED DISTINCTIVENESS BASED ON SUBSTANTIALLY EXCLUSIVE AND CONTINUOUS USE SINCE 2004 AND SIGNIFICANT EVIDENCE OF ACQUIRED DISTINCTIVENESS.....	6
CONCLUSION.....	7

TABLE OF AUTHORITIES

<i>Cases</i>	<u>Page(s)</u>
<u>In re Am. Fertility Soc'y</u> , 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).....	4
<u>American Scientific Channel, Inc. v. American Hospital Supply Corp.</u> , 690F.2d 791, 216 USPQ2d 1080 (9 th Cir. 1982).....	7
<u>Committee for Idaho’s High Desert v. Yost</u> , 92 F.3d 814, 39 USPQ2d 1705 (9 th Cir. 1996).....	6
<u>In re Dial-A-Mattress Operating Corp.</u> , 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001).....	4
<u>In re DNI Holdings, Ltd.</u> , 77 USPQ2d 1435 (TTAB 2005).....	5
<u>In re Gould Paper Corp.</u> , 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).....	4
<u>In re Jonathan Drew</u> , Serial No. 78/979,742 (T.T.A.B. Dec. 11, 2009).....	5
<u>In re K-T Zoe Furniture, Inc.</u> , 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994).....	5
<u>In re Merrill Lynch, Pierce, Fenner & Smith Inc.</u> , 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).....	5
<u>Reader’s Digest Ass’n v. Conservative Digest</u> , 821 F.2d 800, 3 USPQ2d 1276 (D.C. Cir 1987).....	7
<u>Yahama International Corp. v, Hoshino Gakki Co.</u> , 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).....	7
 <i>Other Authorities</i>	
2 J. Thomas McCarthy, <u>McCarthy on Trademarks and Unfair Competition</u> , <i>Secondary Meaning</i> §§ 15:48, 15:49 (2002).....	6, 7

ARGUMENT

Applicant submits that the lion's share of the arguments and evidence cited in the Examining Attorney's Appeal Brief filed March 20, 2015 are restatements of the wholly inadequate arguments and evidence submitted by the Examining Attorney in the Office Action Letters dated March 4, 2013, April 16, 2013, November 2, 2013 and June 2, 2014. Because Applicant's *Ex Parte* Appellate Brief filed January 15, 2015 satisfactorily addresses most of these points, Applicant will not repeat all of its arguments here. However, a few of the most glaring deficiencies in the Examining Attorney's appellate brief will be highlighted in this reply.

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.

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

The Examining Attorney admittedly failed to recognize the composite nature of Applicant's mark. Instead, the Examining Attorney selectively tracked one definition of each word in the composite mark independently, and then criticized Applicant's multiple definitions of the wording 'roll out' as "completely [disregarding] the nature of the goods." (*Id.* (See Ex. Brief at 4, 6.)

Of course, the Examiner's statement that the term 'roll out' disregards the nature of the goods actually underscores Applicant's point here: the term "roll out" has nothing to do with the planting of a garden using mats composed of various materials. That is the very essence of the suggestive nature and creativity of this mark. Perhaps this explains why the Examining Attorney failed to cite a single contrary definition of the term "roll out" in support of the refusal below. Whatever the reason, the Examining Attorney's construction of **ROLL OUT GARDEN** ignores

the directives of the Federal Circuit Court of Appeals regarding terms made up of compound words.¹

The Examining Attorney also failed to distinguish the numerous other trademark registrations or approvals for publication on the Principal Register of marks employing the words **ROLL OUT**. According to the Examining Attorney, the prior uses of the term “roll out” in these marks do not describe the goods being sold under such marks. Applicant agrees. However, the fact that these **ROLL OUT** marks are for different goods does not change the fact that the term “roll out” also has nothing to do with the planting of a garden using mats composed of various materials.²

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

¹ See In re Gould Paper Corp., 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111–12 (Fed. Cir. 1987) (when term consists of compound words, examining attorney may establish term is generic only by producing evidence that each constituent word is generic and separate words retain their generic significance when joined to form the compound word that has “a meaning identical to the meaning common usage would ascribe to those words as a compound.”); In re Dial-A-Mattress Operating Corp., 240 F.3d at 1810 (Fed. Cir. 2001) (where mark is a phrase, examining attorney cannot cite definitions and generic uses of individual components but must provide evidence of meaning of the composite mark as a whole); In re Am. Fertility Soc’y, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999).

² The fact that only three marks cited are currently registered does not change the fact that all marks cited were approved for publication on the Principal Register. All examples necessarily required a determination by the Examining Attorney in those cases that the marks were not merely descriptive.

Examining Attorney's objection on the basis of genericness.

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.

Remarkably absent from the Examining Attorney's brief is any recognition of the PTO's difficult burden of proving genericness by clear and convincing evidence.³ Moreover, the evidence offered by the Examining Attorney was wholly inadequate to show genericness under the correct standard. For example, the Examining Attorney cited an anonymous 2010 blog about a UK product designer, two products sold under entirely different trademarks and which do not use the words "Roll Out Garden" in the manner Applicant uses, and a Yahoo blog entry commenting about a "roll out garden" product that conceivably could be Applicant's product. (See Ex. Brief at 5-9.)⁴ With respect to the Walmart advertisement, the Examining Attorney does not deny the reference is for Applicant's product. However, the Examining Attorney incorrectly stated that this reference does not contain any mention of Garden Innovations, LLC. (See Ex. Brief at 7.) To the contrary, "Garden Innovations" is referenced on the packaging of the product and on the web site promotion by Walmart. (See Office Action Letter dated November 2, 2014, Attachments 5, 11.)

³ See 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.")

⁴ The evidence offered by the Examining Attorney in this case pales in comparison to the evidence submitted in In re Jonathan Drew, Serial No. 78/979,742 (T.T.A.B. Dec. 11, 2009) (attached to Examiner's Brief). In Jonathan Drew, the Examining Attorney cited over 30 examples of use of **INFUSED CIGARS** including major newspapers such as *The Pensacola Journal*, *Charleston Gazette* and *Chicago Tribune*. There were no such references in this case.

Based on the foregoing, the Examining Attorney failed to properly undertake or satisfy the difficult burden of establishing genericness by clear and convincing evidence. The Board should strike the Examining Attorney's genericness objection and approve the mark for registration on the Principal 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 failed to apply the proper standards of proof of secondary meaning. Where the Applicant has engaged in exclusive use for many years, actual evidence of acquired distinctiveness is most often proven by circumstantial evidence as to the amount and nature of advertising for the mark, the length of time the mark has been in use, and the amount of goods sold under the mark.⁵ Here, Applicant submitted significant evidence of acquired distinctiveness, and the Examining Attorney gave improper weight to this evidence. (See Mounce 10/16/13 Declaration, Exhibits 1-8)

Moreover, the Examining Attorney submitted no evidence to suggest that Applicant's use has been non-exclusive. The Examining Attorney merely cited to an anonymous 2010 blog about a UK product designer, two products sold under entirely different trademarks and which do not use the words "Roll Out Garden" in the manner Applicant uses, and Yahoo blog entries commenting about a "roll out garden" product that conceivably could be Applicant's product. (See Ex. Brief at 5-9.) None of these references were to a competitor using **ROLL OUT GARDEN** in packaging or promotional materials for its product.

⁵ See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, *Secondary Meaning* § 15:48 at 15-74 to 15-74 (2002); Committee for Idaho's High Desert v. Yost, 92 F.3d 814, 39 USPQ2d 1705 (9th Cir. 1996).

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.⁶ 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."⁷

CONCLUSION

Based on arguments submitted above and in Applicant's main brief filed January 15, 2015, the Board should strike the Examining Attorney's mere descriptiveness objection and approve the Mark for registration on the Principal register.

Dated: April 8, 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

⁶ See 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."); 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).

⁷ Reader's Digest Ass'n v. Conservative Digest, 821 F.2d 800, 3 USPQ2d 1276 (D.C. Cir 1987).