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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re High Caliper Growing, Inc.

Serial No. 86589047

Zachary A.P. Oubre of McAfee & Taft for High Caliper Growing, Inc.

Lauren E. Burke, Trademark Examining Attorney, Law Office 106, Mary I. Sparrow, Managing Attorney.

Before Masiello, Lynch, and Coggins, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

High Caliper Growing, Inc. ("Applicant") filed an application to register POND POTS in standard characters on the Principal Register for "Fabric containers for growing plants," in International Class 22.[1]

The Trademark Examining Attorney originally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's

[1] Application Serial No. 86589047 was filed on April 8, 2015 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based on Applicant's asserted use of the mark in commerce, stating April 27, 1999 as the date of first use and first use in commerce. Applicant has disclaimed the exclusive right to use POTS apart from the mark as shown.

mark is merely descriptive of the identified goods. When Applicant requested, in the alternative, registration under Section 2(f), 15 U.S.C. § 1052(f), on the ground that the mark had acquired distinctiveness, the Examining Attorney refused registration on the additional ground that the proposed mark is generic and therefore incapable of distinguishing the identified goods, or, alternatively, that the mark is merely descriptive and that Applicant had failed to show acquired distinctiveness under Section 2(f). While continuing to pursue registration under Section 2(f), Applicant maintained, as an alternative position, that its mark was neither generic nor merely descriptive. When the Examining Attorney made both refusals final, Applicant filed a request for reconsideration, which the Examining Attorney denied. Applicant then appealed to this Board. The case is fully briefed.

1. Refusal on grounds of genericness.

We first address the Examining Attorney's refusal to register the proposed mark on the ground that it is generic for the identified goods. A designation is generic if it refers to the class or category of goods or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.,* 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.,* 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) ("*Marvin Ginn*")). The test for determining whether a proposed mark is generic is its primary significance to the relevant public. *In re American Fertility Soc'y,* 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.,* 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *Marvin Ginn, supra.* Making this determination "involves a two-step inquiry:

First, what is the genus of goods or services at issue? Second, is the term sought to be registered … understood by the relevant public primarily to refer to that genus of goods or services?" *Marvin Ginn*, 228 USPQ at 530. The Examining Attorney has the burden of establishing by clear evidence that a mark is generic. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc*., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re American Fertility Soc'y, supra*; *Magic Wand Inc., supra.*

(a) The genus of Applicant's goods.

Because the identification of goods or services in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, generally "a proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration." *Magic Wand*, 19 USPQ2d at 1552 (citing *Octocom Sys., Inc. v. Houston Computer Servs*., Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). In this case, the identification of goods is clear in meaning and is an appropriate expression of the genus of goods at issue.[2] Accordingly, we proceed to consider whether the term POND POTS is understood by the relevant public primarily to refer to fabric containers for growing plants.

[2] Applicant proposed that its identification of goods should be taken as the genus of goods at issue (Applicant's brief at 5, n.2, 4 TTABVUE 6) and the Examining Attorney has conceded this point (Examining Attorney's brief, 6 TTABVUE 6).

(b) Public understanding of POND POTS.

The relevant public consists of individuals and representatives of businesses having an interest in cultivating plants in containers. Applicant has made of record the following relevant dictionary definitions:

> **pond:** an area of water that is surrounded by land and that is smaller than a lake. …
>
> a body of water usually smaller than a lake <a fishing *pond*> -- sometimes used with *the* to refer informally or facetiously to the Atlantic Ocean.[3]
>
> **pot:** a usually rounded metal or earthen container used chiefly for domestic purposes (as in cooking or for holding liquids or growing plants); *also* : any of various technical or industrial vessels or enclosures resembling or likened to a household pot <the *pot* of a still>.[4]

The Examining Attorney argues that Applicant's goods are containers that may be used for growing aquatic plants in ponds. Applicant's specimen of use (a label attached to the goods) confirms this. The text of the label states, among other things: "Flexible Bottom Contours to Your Pond"; "Cleaner – Pond-Pots Hold in Aquatic Soil"; and "No Sharp Edges – Safer for Fish."[5] The Examining Attorney has also made of record five items from the internet in which the term "pond pots" is used to describe containers used for aquatic plants in ponds:

> If you have a small pond you may want to use pots to avoid having problems with plant roots. Fabric pond pots or mesh pots are best. Fabric pond pots allow air to pass

[3] Definition from <merriam-webster.com>, Applicant's response of May 6, 2016 at 11.

[4] Definition from <merriam-webster.com>, *id*. at 12.

[5] Application at 6.

through them, allowing the plants to grow in a natural and healthy way.[6]

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Water lilies are best planted in containers and then submersed into a pond. …

Container (wide rather than deep), use a no hole container or one of the fabric pond pots available for sale online or from specialist water garden stores.[7]

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Fabric pond pots – as opposed to the plastic pots that we, as water gardeners, commonly use, are an alternative to consider when potting up your favorite water lilies or dividing your aquatic plants. …The fabric pond pot can also be folded down to adjust height.[8]

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How to Plant a Water Lilly … Fill a fabric pond-pot halfway full of potting soil … You can purchase fabric pots and potting soil at your local garden specialty store. … Measure the fertilizer depending on the size of pond-pot you use. … Set the planted pond-pot on the floor of a shallow pond or lake that is no deeper than 8 inches.[9]

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Plants don't have to be planted directly in the soil of your pond, you can set them in mesh pots or fabric pond pots which will allow the air to pass through but will also

[6] "Adding Plants to Your Pond," at <marylandpet.com>, Office Action of November 6, 2015 at 4.

[7] "Planting Waterlilies," at <nurseriesonline.us>, *id*. at 5.

[8] "Fabric Pond Pots," at <tucsonwatergardeners.tripod.com>, Office Action of May 28, 2016 at 10.

[9] "How to Plant a Water Lilly," at <gardenguides.com>, *id*. at 11.

> prohibit the soil from getting into your pond and turning it muddy.[10]

Applicant argues that this evidence does not demonstrate that the relevant public would "generically refer to *all* fabric containers for growing plants as POND POTS."[11] This argument is unavailing, because "a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole." *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016), citing *In re Northland Aluminum Prods., Inc.* 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Applicant also points out that its goods are made of fabric, and that the dictionary definitions of "pond" and "pot" do not "make[ ] any reference to or indication of being associated with 'fabric' containers."[12] Although the dictionary indicates that a "pot" is "*usually* … [a] metal or earthenware container" (emphasis added), the record contains evidence, quoted above, that refers to planting pots that are made of plastic, mesh, or fabric. Accordingly, the fact that the one dictionary definition of record for the word "pot" does not indicate that a pot may be made of fabric cannot eliminate the possibility that customers may refer to a fabric container as a "pot." As for the relevance of the word "pond" to goods made of fabric, the evidence quoted above includes numerous references to "fabric pond pots."

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[10] "Plants that help keep the Fish Pond Healthy," at <petcaretips.net>, Office Action of September 15, 2016 at 5.

[11] Applicant's brief at 5, 4TTABVUE 6.

[12] *Id*. at 6, 4 TTABVUE 7.

Applicant also points out that some of the Examining Attorney's evidence includes references to Applicant's own goods. We do not consider Applicant's use of "Pond Pot" to name its goods as evidence of genericness.[13] We also have not considered the Examining Attorney's materials that appear to be of foreign origin.[14]

Finally, Applicant points out that the USPTO has issued registrations of the marks DIRT POT and HARVEST POT for fabric pots and the mark POND SKINS for pond liners.[15] These marks, which are facially different from POND POTS, have no relevance to the question of whether POND POTS is a generic term.

In light of the evidence of record, including evidence showing that members of the consuming public use the expression "pond pot" to describe fabric containers used for holding aquatic plants within ponds, we find that the Examining Attorney has clearly demonstrated that Applicant's proposed mark is a generic name for Applicant's goods; and that relevant customers would understand the term POND POTS primarily to refer to a category of fabric containers for growing plants. We therefore AFFIRM the refusal to register Applicant's proposed mark on the ground that it is generic.

2. Refusal on grounds of mere descriptiveness and lack of acquired distinctiveness.

We turn next to the Examining Attorney's refusal to register the mark on grounds that it is merely descriptive of the identified goods under Section 2(e)(1) and has not

[13] *See* Office Action of November 6, 2015 at 10; Office Action of May 28, 2016 at 5-9.

[14] Office Action of September 15, 2016 at 6-8.

[15] Response of November 1, 2016 at 7-11.

acquired distinctiveness under Section 2(f). During prosecution of the application, Applicant maintained that its mark was not merely descriptive of its goods.

A term is merely descriptive under Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods. *See In re Gyulay,* 3 USPQ2d at 1010.

Implicit in our holding that POND POTS is generic for Applicant's goods is a holding that the mark is at least merely descriptive of the goods under Section 2(e)(1). "The generic name of a thing is in fact the ultimate in descriptiveness." *Marvin Ginn, supra*, at 530. The dictionary evidence alone demonstrates that Applicant's mark immediately conveys the idea of a container for holding plants that may be used in connection with aquatic plants in a pond. The internet evidence demonstrates that such containers may be made of fabric.

Applicant argues that its fabric containers are "for growing all types of plants in any environment and [are] not limited to any particular application, whether a pond or otherwise. Thus, prospective purchasers would not have an *almost instantaneous* understanding of Applicant's Goods by and through Applicant's Mark."[16] However,

[16] Applicant's brief at 9, 4 TTABVUE 10 (emphasis in original).

as we have noted above, if a mark merely describes one significant attribute, function, or purpose of the goods, it may be considered merely descriptive, even though the goods may have a wider use or field of application. *In re Gyulay,* 3 USPQ2d at 1010. In the context of fabric containers for growing aquatic plants to be planted in ponds (Applicant's goods are clearly suitable for this purpose),[17] customers would immediately understand POND POTS as describing attributes of the goods. Applicant's contention that the Examining Attorney has "unilaterally change[d] the identification of Applicant's Goods to conclude that Applicant's Mark is merely descriptive"[18] is inapposite, because the Examining Attorney has merely pointed out the specific attributes of the goods that the mark describes.

Applicant contends that the mark does not immediately convey the information that the goods are made of fabric, causing a "mental pause" which renders the mark suggestive rather than merely descriptive. This argument is unavailing, because a mark need not immediately convey all information regarding the nature of the goods in order to be considered merely descriptive. *Id.*

Applicant argues, in the alternative, that its mark has acquired distinctiveness as Applicant's source indicator. "To establish secondary meaning, or acquired distinctiveness, an applicant must show that in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Coach Svcs., Inc. v. Triumph Learning LLC*, 668

[17] Indeed, as noted *supra*, Applicant's specimen of use states, among other things, that the goods have a "Flexible Bottom [which] Contours to Your Pond." Application at 6.

[18] Applicant's brief at 9, 4 TTABVUE 10.

F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012) (internal quotation marks omitted). We determine whether Applicant's asserted mark has acquired distinctiveness based on the entire record, keeping in mind that "[t]he applicant … bears the burden of proving acquired distinctiveness." *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (citation omitted). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and the nature of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (CCPA 1960). Typically, more evidence is required where a mark is such that purchasers seeing the matter in relation to the offered goods would be less likely to believe that it indicates source in any one party. *See In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 n.9 (Fed. Cir. 1990).

Applicant filed two declarations of its Chief Financial Officer, Phillip McNatt,[19] stating that Applicant has used its mark substantially exclusively and continuously since at least as early as April 27, 1999; that Applicant has sold more 100,000 units of marked goods since that date, grossing nearly $250,000; and that the goods are sold through 176 locations in 37 States. Mr. McNatt stated that Applicant has advertised through print and the media, and at trade shows, and that Applicant has attended more than 60 trade shows in the United States in the last 12 months, at which Applicant has distributed thousands of promotional sales sheets. Mr. McNatt

[19] Response of May 6, 2016 at 13-15; Response of August 18, 2016 at 17-21.

stated his belief that the mark has become distinctive of Applicant's goods, and that to his knowledge no others use the mark "in a source indicating manner." Applicant has made of record only a few pages of its promotional materials, including web pages, a sales sheet, and a cardboard display case.[20]

Applicant's mark is highly descriptive. It consists of two dictionary words that have clear meaning with respect to the goods. As the Examining Attorney has shown, third parties have spontaneously used the expression "pond pot" in order to describe products similar to Applicant's goods. Accordingly, we would require a strong evidentiary showing to persuade us that Applicant's mark has acquired distinctiveness.

Considering all of the evidence of record (including evidence not specifically addressed herein), we are not persuaded that Applicant's mark has acquired distinctiveness. Applicant's sales and revenues have been modest since Applicant's adoption of its mark. There is no evidence to indicate extensive promotional or advertising efforts. There is also no evidence to demonstrate that Applicant's efforts to promote its mark have succeeded in causing customers to associate the mark with Applicant's goods. To the contrary, the evidence shows that persons who have an interest in cultivating plants use the term "pond pot" to describe a *type* of container, rather than to identify Applicant's goods in particular. We find that Applicant has failed to demonstrate that its mark has become distinctive of its

[20] Response of August 18, 2016 at 19-21.

identified goods within the meaning of Section 2(f). Accordingly, we AFFIRM the Examining Attorney's refusal to register the mark under Section 2(e)(1).

Decision: The refusal to register Applicant's proposed mark on the ground that it is generic is AFFIRMED. The refusal to register the mark on the ground that it is merely descriptive under Section 2(e)(1) and has not acquired distinctiveness under Section 2(f) is AFFIRMED.