

**THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE T.T.A.B.**

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Butler

Mail date: May 20, 2004

Opposition No. 91153755

Walters Gardens, Inc.

v.

Pride of Place Plants, Inc.

Before Quinn, Hohein and Bucher, Administrative Trademark Judges.

By the Board:

Applicant is seeking to register the mark PIILU for "live plants."¹ As grounds for the opposition, opposer alleges that applicant's mark is the cultivar name and, thus, the generic name for a *Clematis* plant.² Applicant, in its answer, denies the salient allegations of the notice of opposition.³

¹ Application Serial No. 76201447, filed on January 29, 2001, claiming a *bona fide* intention to use the mark in commerce. Applicant includes a statement that PIILU translates into English as "little duckling."

² Although opposer articulates language which appears to invoke Section 2(d) of the Trademark Act, likelihood of confusion with a previously used or previously used and registered mark, opposer does not plead a mark, and further combines such language with allegations that applicant's mark is a cultivar name for live *Clematis* plants. See paragraph no. 5 of the notice of opposition. Such allegations appear to be amplifications of opposer's claim that applicant's mark is generic. Thus, the only pleaded claim, and the claim before us, is that applicant's mark, as a cultivar name, is the generic name for the goods.

³ Opposer's consented motion, filed September 28, 2003, to extend discovery and trial dates is granted.

This case now comes up on opposer's fully-briefed motion, filed November 21, 2003, for summary judgment in its favor on the ground that applicant's mark is the cultivar name of a *Clematis* plant and, thus, the generic name of the goods.⁴ In addition, applicant has filed objections to most of the evidence submitted by opposer, which we address first.

Applicant's objections to evidence

Applicant's objection to opposer's Exhibit Nos. 1 and 2 (photocopies of books) as unauthenticated is overruled. Applicant's objection to Exhibit No. 2 as not being introduced by way of a witness testifying to the truth, identification, or authenticity of such exhibit is overruled. Trademark Rule 2.122(e) allows the introduction of printed publications, including books. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. See TBMP Section 528.05(e) (2nd ed. Rev. 1 March 2004). Both submissions contain appropriate information for self-authentication, including: title, editor or compiler, organization for whom materials were compiled, publisher, city of publishing, and copyright date. Cf. Wright & Gold, 31 Federal Practice and Procedure: Evidence § 7140 (2000),

⁴ To the extent that opposer argues (at p. 12 of its brief) that applicant's mark is deceptive or deceptively misdescriptive, said issues have not been pleaded and are not before us. See Fed. R. Civ. P. 56(a); and TBMP Section 528.07(a) (2nd ed. Rev. 1 March 2004).

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discussing Fed. R. Evi. 902(6), ("The rule extends to both domestic and foreign publications.") We note that Exhibit No. 1 is published in the United Kingdom and is in English.

Applicant's objections to opposer's Exhibit No. 1 that it allegedly evidences foreign use by applicant and that it may contain references in a language other than English are overruled.⁵ To the extent applicant is objecting to Latin references to the genus and species of plants, and foreign terms used as the cultivar names of plants, applicant objection is without merit. Such references go to the practice in the field of naming plants and may be highly relevant to public perception in the United States of the term applicant seeks to register, and of the ultimate issue before us: whether the PIILU is the generic name of a *Clematis* plant.

Applicant's objection to opposer's Exhibit Nos. 3, 6, 7, 8 and 9 (Internet printouts) as unauthenticated, and thus as hearsay, is overruled. Opposer has now submitted a declaration in support of said exhibits. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). Cf. *Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382 (TTAB 2000) ("... this defect is curable..."). Applicant's objections to Exhibit Nos. 6-10 and 13 as allegedly evidencing foreign use by applicant and because they may contain references in a language other than English are

⁵ The Board notes in passing the some of applicant's exhibits also are in foreign languages, at least in part.

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overruled. For the most part, the references are also in English. In addition, as stated previously, Latin terms for genus and species, and foreign terms used as cultivar names, may be relevant to this proceeding.

Applicant's objection to opposer's Exhibit Nos. 4, 10, 11, 12, 13, 14 and 17 (responses to discovery requests, including produced documents) as unauthenticated is overruled. Trademark Rule 2.127(e)(2) permits the filing of responses to discovery requests, including produced documents, for purposes of summary judgment. See also TBMP Section 528.05(c) (2nd ed. Rev. 1 March 2004). Applicant's objections to Exhibit No. 13 as irrelevant because it allegedly evidences foreign use by applicant and because it may contain references in a language other than English are overruled for reasons stated previously. Applicant's objection to opposer's Exhibit No. 16 (copy of a periodical article) as unauthenticated is overruled. Trademark Rule 2.122(e) allows the introduction of printed publications, including excerpts from periodicals. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. See TBMP Section 528.05(e) (2nd ed. Rev. 1 March 2004). The submission contains appropriate information for self-authentication: name of periodical, date of publication, page numbers, title to article, and author of article. Cf. Wright & Gold, *supra*, discussing Fed. R. Evi. 902(6), ("... no extrinsic evidence is required to

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authenticate printed materials purporting to be newspapers or periodicals.”)

Applicant’s objection to opposer’s Exhibit No. 5 (affidavit of Clarence H. Falstad, III) is overruled. Affidavits may be submitted on summary judgment even though they may be self-serving in nature and there is no opportunity for cross examination. See TBMP Section 528.05(b) (2nd ed. Rev. 1 March 2004).

Applicant’s objection to opposer’s Exhibit No. 15 as unauthenticated is sustained. The exhibit is composed of an apparent letter from applicant to opposer, dated 1998, and an accompanying press release. While such information may be introduced by way of affidavit or declaration or as discovery responses, the exhibit in question does not appear to be part of any discovery response. Although an affidavit was submitted in support of the exhibit, it does not establish the affiant’s personal knowledge of the documents and his competency to testify to the matters therein. Instead, the affiant, who identifies himself as opposer’s laboratory director, states only that he is familiar with the submissions by way of written and verbal correspondence with another of opposer’s employees and by way of examination of the documents at issue. However, this does not establish affiant’s. Why, for example, the affidavit of the addressee, an apparent employee of opposer, was not submitted is

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not explained.⁶ See TBMP Sections 528.05(a)-(c) (2nd ed. rev'd March 2004).

Applicant's objection to opposer's Exhibit No. 18 as unauthenticated is moot. The exhibit appears to be a TESS printout from the Office database of the status of applicant's subject application Serial No. 76201447. At this time, such printouts may only be introduced on summary judgment by way of affidavit or declaration or by way of a discovery deposition. See *Id.* at subsections (a), (b), (c), and (e). Nonetheless, the application file is of record for all purposes, including summary judgment, in this opposition. See Trademark Rule 2.122(b); and TBMP Section 528.05(a) (2nd ed. Rev. 1 March 2004). Thus, the TESS printout is simply redundant information.

Applicant did not object to opposer's Exhibit No. 19, a copy of the notice of opposition, which is, of course, of record.

Applicant's objection to the cover pages of opposer's Exhibit Nos. 6-9 as out-of-court statements by an unidentified declarant offered for the truth thereof is overruled. The cover page to each exhibit is no more than an index identifying the submissions made with the exhibit.

⁶ At trial, the business records of a party are to be introduced by way of a testimonial deposition as exhibits thereto. See TBMP Sections 702 and 703 (2nd ed. Rev. 1 March 2004). The Board notes that consideration of Exhibit 15 would not have changed our decision on summary judgment.

Opposer's motion for summary judgment

As general background in the plant naming field, opposer argues that plants are scientifically named according to the International Code of Botanical Nomenclature by providing a Latin genus and species name; that cultivars, or cultivated varieties, are plants that originated and persist due to human manipulation; that the International Code of Nomenclature for Cultivated Plants (hereinafter ICNCP), established in 1953, provides a framework for identifying, naming, registering and using cultivar names; that the ICNCP recognizes the difference between scientific names, which must be available in all countries for use by any person, and trademarks, which are not universally available for any person to use; that a cultivar status of a term is identified by placing the term between single quotation or downward vertical marks following the Latin genus name; that the Royal Horticultural Society (hereinafter RHS) is the international cultivar registration authority for *Clematis* names; and that the RHS registered the term PIILU as a cultivar for *Clematis* in the year 2000.

With respect to this particular case, opposer argues that Uno and Aili Kivistik, of Estonia, first developed the plant *Clematis* 'PIILU' in 1984, which they flowered in 1987 and named in 1988.⁷ According to opposer, PIILU was registered by Aili Kivistik with the Estonian Plant Production Inspectorate Variety

⁷ Opposer notes that Uno Kivistik died in 1998.

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Control Department, which is the identified registering party of PIILU with the RHS; and The International Clematis Register and Checklist for 2002, published by RHS, acknowledges the Kivistik family and identifies the first published reference to *Clematis* 'Piilu' in a 1992 catalogue.

It is opposer's position that the plant industry is composed of four identifiable groups: organizations, businesses, hobbyists, and the media. Opposer contends that, because Internet offerings and catalogues are commonplace ways in which plants are marketed, purchasers in the United States often purchase plants from distant sellers, and have been exposed to use of the term PIILU used as a cultivar since as early as 1992, the first known published (foreign) reference and, as to references in the United States, at least since 1999. According to opposer, it has been offering the cultivar *Clematis* 'Piilu' since 2000. Opposer argues that applicant's own use of the term PIILU, like that of the Kivistik family, demonstrates that, until recently, they treated *Clematis* 'Piilu' as a cultivar name and not as a trademark. Opposer argues that, in response to its interrogatory request seeking from applicant information concerning "...the genus, species, subspecies, varietal, cultivar, common, and commercial names, if any, for the cultivar of *Clematis* sold and promoted in association with the PIILU mark," applicant stated it "...does not know the answer to this interrogatory request..." Subsequently, opposer argues,

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applicant, on September 19, 2003, submitted a notification of name change, apparently to opposer's attorney, which, opposer argues further, contradicts applicant's response to opposer's discovery request.

Opposer argues that, as the cultivar name for a *Clematis* plant, PIILU is the generic name for the plant and cannot be registered. Opposer's motion is accompanied by the following exhibits: International Code of Nomenclature for Cultivated Plants 1995; The International Clematis Register and Checklist 2002; printouts from applicant's website; various e-mail exchanges between the Kivistiks and applicant's president, Rick Sorenson; the affidavit of Clarence H. Falstad, III, laboratory director for opposer, describing, in part, his perception of and experience in the plant industry; website printouts from various *Clematis* organizations, both foreign and domestic, copies of web catalogues and Internet sites, both foreign and domestic, selling *Clematis* 'Piilu' without trademark designation; hobbyist websites including references to *Clematis* 'Piilu', such site appearing to be exclusively foreign; published articles from periodicals, accessed from websites, both foreign and domestic, referencing *Clematis* 'Piilu' from 2000-2003; Clematis Catalog 1999 from J. van Zoest, Holland; opposer's spring catalogs for the years 2000-2003 referencing *Clematis* 'Piilu'; copies of e-mail exchanges between applicant's president and third parties concerning awards won by the *Clematis* 'Piilu'; a copy of Aili

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Kivistik's 2003 authorization for Australian agent, identifying 'PIILU' as the variety and leaving blank "also known as," further specified as "breeder's code, trade name etc. for variety"; a copy of applicant's responses to opposer's second set of discovery requests; a copy of a signed 1998 letter and accompanying press release from Mr. Sorenson, applicant's president, to opposer;⁸ a copy of Mr. Sorenson's 1999 article in "American Nurseryman," Climbing the Walls, inconsistently referring to C. 'Piilu' and Piilu™; a copy of applicant's notification of change of name of cultivar; a TESS printout of the status and accompanying information of applicant's application; and a copy of the notice of opposition.

In response,⁹ applicant indicates that it is the exclusive U.S. distributor and the owner of the trademark rights for the *Clematis* plants originating with the Kivistik family of Estonia. Applicant argues that PIILU is a well established trademark, its first international use being since 1992, and its use in the United States being since 1998. Applicant accuses opposer of using applicant's mark as a generic term, and of submitting no evidence that applicant's "...well-known mark PIILU is ... generic." Applicant argues that it widely licenses its mark in the U.S.; and that its mark is not found as a cultivar name in any U.S. or

⁸ Inasmuch as applicant's objection to this submission as unauthenticated was sustained, the submission was not considered.

⁹ Applicant's objections to opposer's evidentiary submissions have already been ruled on.

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international database. Applicant argues that the RHS does not list applicant's mark as a cultivar in its database; that any alleged "registration" on an RHS checklist was done by a third party; that there is no requirement that applicant use a trademark notice every time it uses its mark; that use of its mark in single quotes does not result in "automatic genericide"; that opposer has not produced any surveys of consumer perception of the term PIILU; that the foreign uses establish the strength of applicant's mark; and that the foreign uses do not show that PIILU is a cultivar name in the United States.

Applicant's response is accompanied by the declaration of its attorney in support of twenty Internet printouts including: order forms from opposer's website wherein *Alcea r. 'Peaches 'n' Dreams'* is displayed inconsistently with *Alcea r. 'Peaches 'n' Dreams'*[™]; various catalogue or website sales offerings of applicant's *Clematis* plant showing uses of applicant's mark as Piilu, *Clematis 'Little Duckling' "Piilu"*[™](Patens), *Clematis Kivistik*, Piilu, The Kivistik Collection Piilu t.m.; printouts from the Estonian Plant Production Inspectorate; a printout from the RHS plant selector database which found zero entries for the term piilu; a TESS printout and accompanying article concerning a mark (ENDLESS SUMMER) for live ornamental plants; a printout from opposer's website; an excerpt from the International Clematis Register for the disclaimer that "[I]nformation given in the Register can only be as good as that supplied by the registrant";

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an excerpt of guidance notes for International Cultivar Registration Authorities; printouts showing the inconsistent uses of *Helleborus* Royal Heritage™ and *Helleborus* 'Royal Heritage', of *Weigela Florida* 'wine & roses' and Wine & Roses® *Weigela*, of *Penstemon* 'Red Rocks' and *Penstemon x mexicali* 'Red Rocks'™, of Ambridge Rose® Cv. Auswonder, Pat Austin™ Cv. Ausmum, Wenlock® Cv. Auswen and 'Ambridge Rose' (Auswonder), 'Wenlock' (Auswen) and a TARR printout for the registration of WENLOCK for live rose plants; various printouts showing terms used as trademarks and terms used as cultivars; printouts from various U.S. databases where plant names may be registered or listed; and search results from various databases. In addition, applicant's response is accompanied by a copy of a January 6, 2003 email from the Kivistik family to opposer expressing the Kivistik's position that Piilu has not become generic for their *Clematis* cultivar; that plants of the cultivar were given to members of The International Clematis Society during the 1998 visit, but no permission was given to members to propagate and sell in North America; that any sales by non-licensed growers are being done without permission; and that applicant may agree to sub-license opposer to grow the *Clematis* cultivars. The declaration of applicant's president also accompanies applicant's response, and is made in support of applicant's position as exclusive distributor in the United States of the Kivistik's plants; indicating further that applicant distributes plant licenses,

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including four in Canada, one in Australia, and eight in the United States; and that applicant began use in the United States of the mark in 1998, importing the first plants in the spring of 1999. A copy of the parties' executive protective agreement for the exchange of confidential information also accompanies applicant's response.

In reply, opposer maintains its position that 'Piilu' is a generic term as the term was set aside as the taxonomic name for a *Clematis* cultivar to give the worldwide community a uniform way to identify a specific plant. Opposer argues that applicant's "database arguments" are misleading as exemplified by applicant's position that the RHS "does not list PIILU anywhere in its plants keyword search database." Opposer contends that applicant misleadingly searched only RHS's "Plant Selector" database, which does not list the term "piilu," but RHS's "Plant Finder" database does yield a citation to *Clematis* 'Piilu' as a cultivar name. Opposer argues that applicant inflates opposer's foreign submissions by stating, "...from everywhere in the world except the United States," when opposer has submitted ample evidence of use of the term "piilu" in the United States. Opposer contends that its foreign sources help clarify how the term "piilu" is perceived in the United States, are relevant in light of the doctrine of foreign equivalents, and are relevant in view of the international effort in establishing taxonomic names, including cultivar names, for plants. Opposer also argues that applicant's

own inconsistent use of PIILU demonstrates that it is the cultivar name, and that applicant recently has made attempts to remove this generic term from the public domain and make the term its trademark.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. The movant is held to a stringent standard. See 10A Wright, Miller & Kane, Federal Practice and Procedure: Civil 3d § 2727 (1998). Summary judgment is not a substitute for the trial of disputed issues of fact. *Id.* at 2712. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Cultivar names, designations given to cultivated varieties or subspecies of plants or agricultural seeds, are the generic names of the plant or seed variety as known to the public. Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in

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this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult evidentiary area. See TMEP § 1202.12 (3rd ed. Rev. 2, June 24, 2002). Cf. *In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993), where registration of the word DELTAPINE, identifying the prominent portion of applicant's acknowledged varietal names which combined the term DELTAPINE with another term, was refused ("...this is an unusual case and ... little or no precedent exists...")

After careful consideration of the extensive record submitted by both parties, we find that genuine issues of material fact exist, at a minimum, with respect to the public perception in the United States of the term PIILU.

Accordingly, opposer's motion for summary judgment is denied. Moreover, given the nature of the intense factual considerations which are necessary to ascertain whether PIILU is a trademark or a cultivar name, we find the matter unsuitable for determination on summary judgment. Thus, this case is going to

trial (or settlement). No further summary judgment motions are to be filed.

Protective agreement noted

The stipulated protective agreement accompanying applicant's response to opposer's motion for summary judgment is noted. The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board) (2nd ed. Rev. 1, March 2004).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Proceedings resumed; dates reset

Proceedings are resumed. Discovery closed on November 6, 2003, in accordance with applicant's consented motion to extend dates, filed September 8, 2003. Trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	August 31, 2004

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30-day testimony period for party
in position of defendant to close: October 30, 2004

15-day rebuttal testimony period
to close: December 14, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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