

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
02 February 2006

Mailed:  
4 March 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Walters Gardens, Inc.  
v.  
Pride of Place Plants, Inc.

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Opposition No. 91153755  
to application Serial No. 76201447

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Barry C. Kane of Kane & Co., PLC for Walters Gardens, Inc.

Brian K. Brookey of Christie, Parker & Hale, LLP for Pride  
of Place Plants, Inc.

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Before Drost, Kuhlke, and Walsh, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 29, 2001, Pride of Place Plants, Inc.,  
(applicant) applied to register on the Principal Register  
the mark PIILU in typed or standard character form for "live  
plants" in Class 31. The application (Serial No. 76201447)  
is based on applicant's allegation of a bona fide intent to  
use the mark in commerce.

After the mark was published for opposition on June 18,  
2002, opposer, Walters Gardens, Inc., filed its opposition

to registration of applicant's mark on the ground (pp. 1-2. without paragraph numbers) that:

Long prior to any date of first use upon which Applicant can rely, others around the world, including those in the industry in the United States, have been using the term PIILU to refer to a specific cultivar of Clematis live plants.

Long prior to any date of first use upon which Applicant can rely, the term "PIILU" has been used generically to refer to a cultivar of Clematis marketed throughout this country by other nurseries...

Applicant's registration should be denied on grounds the term "PIILU" has become a generic term referencing a specific cultivar of Clematis live plant offered for sale in this country and the world long prior to Applicant's filing of the application, and the use of that term by the industry has not been abandoned.

Applicant denied the salient allegations of opposer's notice of opposition. An oral hearing was held on February 2, 2006. After the hearing, the case was suspended pending the appeal of the board's decision in *In re KRB Seed Co.*, 76 USPQ2d 1156 (TTAB 2005). When the Federal Circuit affirmed that decision in *In re Pennington Seeds Inc.*, 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006), proceedings were resumed.<sup>1</sup>

#### The Record

The record consists of the pleadings; the file of the involved application; the testimonial deposition of John Dale Walters, opposer's CEO, with exhibits; the testimonial

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<sup>1</sup> Opposer's motion for a directed verdict is denied. The board does not consider motions for directed verdicts. TBMP §§ 502.01 and 534.04 (2d ed. rev. 2004). We will proceed to final judgment.

deposition of Clarence Henry Falstad III, opposer's laboratory director, with exhibits; the testimonial deposition of Chad Michael Walters, opposer's inventory manager; the testimonial deposition of Maurice Horn, an owner of Joy Creek Nursery, with exhibits; the testimonial deposition of Christopher Michael Hansen, Director of Horticulture for Wayside Gardens Division of Geo. W. Park Seed Company, Inc., with exhibits; the testimony of Brewster Rogerson, a retired Kansas State University professor and collector of Clematis plants, with exhibit<sup>2</sup>; the testimonial deposition, with exhibits, of Rick Sorenson, applicant's president; and petitioner's notices of reliance on various publications.

Standing

As a potential competitor who would use the term PIILU generically, opposer has established its standing to oppose applicant's mark. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (One basis for standing includes "descriptive use of term in registered mark"); *Ferro Corporation v. SCM Corporation*, 219 USPQ 346, 352 (TTAB 1983) (Opposer "has a real interest sufficient to give it standing. The rationale is that a competitor should be free from harassment based on

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<sup>2</sup> Mr. Rogerson referred to people like himself (p. 17) as "essentially laymen with a lot of knowledge from practical affairs."

the presumed exclusive right which registration of a generic term would erroneously accord") (citation omitted).

Issue

Is the term PIILU a varietal or cultivar name for a specific plant in the genus Clematis and therefore a term that cannot function as a trademark for applicant's "living plants"?

Evidentiary Questions

Prior to proceeding to the merits of this case, we must address two evidentiary questions. First, applicant has objected to several depositions (Brief at 7-8) that opposer has introduced:

Much of that evidence is inadmissible. For instance, WGI [opposer] cites to the deposition transcripts of Brewster Rogerson, Maurice Horn and Christopher Hansen. WGI never conducted discovery depositions or written discovery for any of these individuals. WGI also failed to identify these individuals during the discovery period in response to PoPP's [applicant] discovery requests, which included PoPP's Interrogatory No. 3, requesting identification of "person(s) most knowledgeable about alleged third party use of the term PIILU for live plants," and Interrogatory No. 16, requesting identification of witnesses from whom WGI intended to present testimony.

Instead, WGI waited until its testimony period to identify these three witnesses for the first time, by serving supplemental interrogatory responses on August 3, 2004, identifying all three individuals in response to PoPP's Interrogatories Nos. 3 and 16.

Based on the limited information of record in this case, we cannot hold that that applicant has demonstrated

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that opposer improperly withheld the identification of these three witnesses in response to its discovery request.

Furthermore, "a party in a Board proceeding generally has no obligation to identify all of its trial evidence prior to trial." *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).<sup>3</sup> See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) ("It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial") and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) ("If registrant wished to depose during discovery a witness having knowledge of petitioner's sales and advertising... a request for the person or persons most knowledgeable on that subject would have been a proper inquiry and would have elicited the information it was seeking. Inasmuch as petitioner had no duty to provide the names of its witnesses, registrant cannot complain that the negative answer was not later amended"). Applicant's citation to *Thibeault v. Square D Co.*, 960 F.2d 239 (1<sup>st</sup> Cir. 1992), a case dealing with expert witnesses, is not on point.

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<sup>3</sup> This opposition and the cited cases preceded the USPTO's new rules involving mandatory disclosure of witnesses and other information. See, e.g., 37 CFR § 2.121 (November 1, 2007).

We add that much of the witnesses' testimony cannot in any way be considered to relate to "third party use" of the term. To the extent that these depositions are directed to the parties' use or to use in reference works, applicant's interrogatory was not relevant. Therefore, we will consider the Rogerson, Horn, and Hansen depositions.

We also note that applicant attached several entries from online Estonian-English dictionaries to its brief. We will not consider this evidence because evidence submitted for the first time with an appeal brief is untimely and we do not take judicial notice of online dictionaries when it is not clear if these dictionaries are the online equivalents of a printed work. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). Furthermore, as we will discuss subsequently, it is too late for applicant to raise an issue concerning the correct translation of its mark.

#### Background

On January 21, 2001, applicant applied to register the mark PIILU in typed or standard character form for "live plants" in Class 31. The application is based on applicant's allegation of its intention to use the mark in commerce.

In his first Office action, the examining attorney required that: "applicant must indicate whether PIILU has

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any significance in the relevant trade, any geographical significance or any meaning in a foreign language."

In its response, applicant submitted that: "the term 'PIILU' is an Estonian word meaning 'little duckling.'"

On June 18, 2002, applicant's mark was published for opposition and opposer timely filed an opposition to the registration of applicant's mark.

We take judicial notice of the following definitions from *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

*Clematis* - any of numerous plants or woody vines of the genus *Clematis*, including many species cultivated for their showy, variously colored flowers.

Genus - *Biol.* the usual major subdivision of a family or subfamily in the classification of organisms, usually consisting of more than one species.

Species - *Biol.* The major subdivision of a genus or subgenus, regarded as the basic category of biological classification, composed of related individuals that resemble one another, are able to breed among themselves, but are unable to breed with members of another species.

Cultivar - a variety of plant that originated and persisted under cultivation.

Varietal - of, pertaining to, designating, or characteristic of a variety.

Variety - a category within a species, based on some hereditary differences.

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The TMEP 1202.12 (5<sup>th</sup> ed. rev. September 2007) provides the following guidance on the examination of varietal and cultivar names:

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public. These names can consist of a numeric or alphanumeric code or can be a "fancy" (arbitrary) name. The terms "varietal" and "cultivar" may have slight semantic differences but pose indistinguishable issues and are treated identically for trademark purposes.

Subspecies are types of a particular species of plant or seed that are members of a particular genus. For example, all maple trees are in the genus *Acer*. The sugar maple species is known as *Acer saccharum*, while the red maple species is called *Acer rubrum*. In turn, these species have been subdivided into various cultivated varieties that are developed commercially and given varietal or cultivar names that are known to the public.

Discussion

The issue in this case concerns whether the name PIILU is the varietal or cultivar name of applicant's living plants. While applicant has filed its application under the intent-to-use provision of the Trademark Act, applicant does in fact use the term on a specific type of plant.

Q. Do you use the term Piilu on other cultivars of Clematis?

A. No.

Q. If you do not use with other cultivars of Clematis, how many cultivars of Clematis is the name Piilu associated with?

A. One.

Sorenson dep. at 135-36.

The specific plant discussed in this case is a Clematis plant that originated with the Kivistik family in Estonia. Sorenson dep. at 2. Applicant began "selling and distributing" that plant in "the early spring of either 1999 or 2000." Sorenson dep. at 2-3.

The dispute in this case concerns whether PIILU is a trademark for plants or the name of a cultivar. Case law has long held that varietal or cultivar names are not registrable because they are the generic name of the plants. *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315, 316 (D.C. Cir. 1942) ("The Patent Office and the District Court might properly conclude that the words 'Texas Centennial,' though originally arbitrary, have come to describe to the public a rose of a particular sort, not a rose from a particular nursery"), *cert. denied*, 318 U.S. 782 (1943); *In re Delta and Pine Land Co.*, 26 USPQ2d 1157, 1158 (TTAB 1993) (DELTAPINE "is the prominent part of various varietal names for plants or seeds, some of which are sold under the asserted mark"); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 1036 (TTAB 1979) (The "term 'COMMANDER YORK' as shown on the specimens and in applicant's catalogue is being used as the common descriptive name for a particular variety of applicant's apple trees"); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231, 232 (TTAB 1963) (CHIEF BEMIDJI held to be a varietal name of strawberry plants). In *In re*

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*Cohn Bodger & Sons Co.*, 122 USPQ 345, 346 (TTAB 1959), the board held:

The catalog shows clearly that "BODGER" is the trademark, and "BLUE LUSTRE" is the varietal name designating a hybrid petunia of a specific variety and color rather than a brand-name identifying seeds sold only by applicant and distinguishing them from seeds sold by others. The varietal name is available to all who grow the variety and sell the seeds therefrom to describe the particular hybrid petunia. The term "BLUE LUSTRE" is not a trademark.

However, if the term is used as a designation of source and there is a different varietal designation, the term may be registrable. *In re Cole Nursery Co., Inc.*, 178 USPQ 424, 424-25 (TTAB 1973) ("A page from applicant's Spring 1972 Trade List shows that 'TALLHEDGE' is used as an identification of source and, 'Rhamnus frangula 'Columnaris'' as a varietal designation") and *In re Stark Bro's Nurseries & Orchards Co.*, 132 USPQ 652, 653 (TTAB 1962):

[T]he varietal names for the apple, pear and strawberry trees and plants on or in connection with which applicant uses the designation "STARKRIMSON" are "Bisbee Apple", "Kalle Pear", and "Christ Strawberry", respectively; and in addition to these varietal names, applicant, in its catalogues, always uses the term "STARKRIMSON" to identify these particular products. It is, moreover, incongruous, to say the least, to suppose that a single designation, such as "STARKRIMSON", would or could be used and be considered in the trade or by the purchasing public as a varietal name for three distinctively different types of plants and/or trees.

The Federal Circuit has recently explained in the *Pennington Seed* case, 80 USPQ2d at 1761 and 1763, that:

We agree with the Director that the Board correctly decided that the varietal name "Rebel" is generic and hence is not entitled to trademark registration. Instructive to our holding is the decision in Dixie Rose. Although that decision of the District of Columbia Circuit is not binding on our court, we find its reasoning persuasive.

In addition, section 1202.12 of the TMEP provides that "varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public." While the TMEP is not established law, but only provides instructions to examiners, it does represent the PTO's established policy on varietal names that is entitled to our respect. We see no reason to differ with it.

The Federal Circuit also explained that an entity that is the source of a varietal that wishes to use a particular term as a trademark for its specific varietal is not prohibited from doing so, however, it must be clear that there is a generic name for the varietal. 80 USPQ2d at 1762.

We do not of course hold that an applicant is precluded from acquiring trademark protection for a particular variety of grass seed. If an applicant wishes to establish trademark protection for its variety of grass seed, it can do so by associating a particular brand name with its grass seed. However, having designated the term "Rebel" as the varietal name for grass seed and having failed to associate any additional word with the Rebel grass seed that would indicate the seed's source, Applicant here is prohibited from acquiring trademark protection for the generic and only name of that variety of grass seed. This situation may be contrasted with pharmaceutical products where a generic name is designated for a new pharmaceutical product and its manufacturer associates it with a brand name. For example, ibuprofen is the generic term designated for a particular nonsteroidal anti-inflammatory drug and ADVIL is a brand name indicating a source of the drug.

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Trademark protection does not inure to the generic name there and it does not do so here.

We now look at the evidence in this case to see whether applicant's term PIILU is also the name of the goods. We start by noting that applicant's witness asserts that "[w]e always intended to use it as a trademark" and the witness answered in the affirmative when asked if applicant had actually used the term as a trademark. Sorenson dep. at 3. Applicant has introduced several examples in which its literature shows use of the term PIILU with a TM. See Sorenson Exhibits 1 ("Available for spring delivery 1999 ... Clematis 'Pillu'™ from Holland 1½ year old #1"); 3 (CLEMATIS 'Piilu'™ ); and 4, 6 and 7 (Clematis "Piilu"™). Applicant's witness testified that Clematis is the genus and "Kivso" is "the cultivar name." Sorenson dep. at 21 and 22. Applicant also maintains that "Little Duckling" is the cultivar name. Sorenson dep. at 47. Applicant's witness indicated that it was using several names for the specific Clematis plant.

Q. ... This letter marked as Exhibit 18 as of September 17<sup>th</sup>, 1998 indicates that you were at least using Clematis Piilu as of that date. Correct?

A. Um-hum.

Q. And I believe we have testimony from you that now says that you're using the cultivar name as Little Duckling for that Clematis. Is that correct?

A. That is correct.

Q. Did Little Duckling come after or before the use of the term Kivso?

A. After.

Sorenson dep. at 93. See also *Id.* at 96 ("so at least as of September of 1998 you had the term Piilu in single quotes without any reference to any kind of trademark status? A. Yes, that's correct"). However, applicant now intends "to object to growers using the term Clematis Kivso to refer to the particular cultivar." Sorenson dep. at 157. It does not intend to object to "growers using the term Clematis Little Duckling in selling this particular plant." Sorenson dep. at 157-58.

Cultivar names are "included in single quotation marks" in applicant's practice. Hansen dep. at 18 (Using single quotes "denotes a cultivar. Q. And is that industry standard? A. Yes"); Sorenson dep. at 47-48.<sup>4</sup>

The plants associated with the term PIILU originated in Estonia.

Q. Would you agree that the term Piilu is not associated with a Clematis of black flowers?

A. I'll agree to that.

Q. But it's generally the flowers are in the red to purplish range, and if I can refer to a previous exhibit, one of your marketing materials, it refers to a specific plant that originated in Estonia. Is that correct?

A. Yes.

Sorenson dep. at 29.

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<sup>4</sup> Despite being in the nursery business since 1970, the witness did not know why the term Piilu was in single quotes in applicant's literature. Sorenson dep. at 39.

Applicant's witness was also asked:

Q. Okay. Does the term Piilu, is that an English word?

A. No.

Q. What language is it?

A. Estonian.

Q. And what is the translation of the term Piilu from Estonian to English?

A. Little Duckling.

Sorenson dep. at 48. See also Response to Office Action dated October 11, 2001 ("In the Office Action the Trademark Examining Attorney has inquired as to the general significance of the term 'PIILU.' In response, Applicant submits that the term 'PIILU' is an Estonian word meaning 'little duckling'"). While Mr. Sorenson does not speak Estonian, he testified that his understanding of the translation is based on "basically it was a question that I asked the Kivistik family and they answered." Sorenson dep. at 160.

Opposer argues that "both 'Little Duckling' and 'PIILU' are used interchangeably." Brief at 6. Applicant contends that "[t]here is no admissible evidence that PIILU is the Estonian name for a cultivar name." Brief at 11. Applicant goes on to argue that "there is no evidence by anyone with personal knowledge - much less a "preponderance" of evidence - as to the translation of PIILU into English, or of Little

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Duckling into Estonian." Brief at 12 (emphasis deleted). We have already pointed out that applicant has entered into the record a translation of the term PIILU as the Estonian word for "Little Duckling." Applicant's witness was asked "And what is the translation of the term Piilu from Estonian to English?" His response was simply "Little Duckling." Sorenson dep. at 48. The witness based his understanding "of the translation of Piilu into English" on "a question that I asked the Kivistik family and they answered." Sorenson dep. at 160. However, the witness, who does not speak Estonian, does not personally know what the term Piilu means in Estonian. Sorenson dep. at 160-161.

As indicated earlier, we have rejected applicant's attempt to create a new issue in its appeal brief regarding the translation of the term Piilu. The examining attorney allowed applicant's mark to be published on the basis of the translation applicant submitted and this opposition was conducted without this translation being seriously challenged. Therefore, it is too late in a brief after trial for applicant to raise an issue about the accuracy of a translation that it provided during the prosecution of the application, and we will assume that the term Piilu is translated as "Little Duckling."<sup>5</sup>

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<sup>5</sup> We also will not consider opposer's issue regarding the adequacy of the ex parte examination apart from our discussion of the genericness issue. Even if there were some deficiency, it

However, even if PIILU is the equivalent of the term "Little Duckling" and if, as applicant now argues, that Little Duckling, is the generic name of its specific Clematis, we must determine whether under the doctrine of foreign equivalents it is the generic name of the goods in this situation. The foreign translation of an English generic term can result in the mark being generic. *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 413 (CCPA 1961) ("In the instant case registration of the Hungarian name for noodles, 'haluska' or its phonetic equivalent in English, whether or not hyphenated, would be contrary to law for no one can be granted the exclusive use of the name of an article, either in our native tongue or its equivalent in any foreign language"). The Federal Circuit has held that: "Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). We have no hesitation in finding that Estonian is a modern language to which the doctrine of foreign

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"would be manifestly unfair to penalize defendant for noncompliance with a requirement that was never made by the Examining Attorney." *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003).

equivalents would apply. *See, e.g., Weiss Noodle Co.* (Hungarian); *In re Spirits International N.V.*, \_\_\_ USPQ2d \_\_\_ (TTAB February 11, 2008) (Serial No. 74382759) slip op. at 9 (“[B]ecause the mark is in Russian, a common, modern foreign language, we must consider that an appreciable segment of the buying public will speak or understand this language”).

However, the Federal Circuit did caution that the “doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the word into its English equivalent.” *Id.* (internal punctuation omitted). A complicating factor in this case is the fact that the name of a cultivar or varietal is not just an issue for the United States:

The United States is a party to the UPOV [the International Convention for the Protection of New Varieties of Plant]. Although Pennington argues that UPOV does not apply here because the use of the designation “Rebel” predated the United States’ adherence to UPOV, we find this argument unpersuasive. The PTO’s policy of refusing registration of varietal names dates back to the *Dixie Rose* case, well before the UPOV treaty. While the requirements of the UPOV do not control this case, they underlie and are consistent with the conclusion that a varietal name is generic and hence support the PTO’s refusal to register the term “Rebel” as a trademark.

*Pennington Seed*, 80 USPQ2d at 1763. *See also International Code of Nomenclature for Cultivated Plants* (1995) (Principle 6 - “Cultivar and cultivar-group epithets must be

universally available in all countries for use by any person to denote a particular cultivar or cultivar-group").

In this case, it is not clear whether purchasers will stop and translate the name of a cultivar into a foreign language or if the assigned name will simply be incorporated as the name of the cultivar in the foreign language. For example, it is not clear whether the English words "Delta," "Pine," "Commander" or "Chief" would be translated into their Spanish, French, Estonian, etc. equivalents or whether the names DELTAPINE, COMMANDER YORK, and CHIEF BEMIDJI will remain the same in those languages. The record does not permit us to conclude that prospective purchasers will stop and translate the term. Therefore, we decline to apply the doctrine of foreign equivalents in this case and find that, assuming "Little Duckling" is the name of the cultivar and the Estonian word PIILU translates into English as "Little Duckling," PIILU must be another generic name of the cultivar.

The only remaining issue is whether PIILU is the name of a cultivar of Clematis. If it is, it is generic and it would not be registrable. *Pennington Seed*, 80 USPQ2d at 1762 ("'Rebel' is the name of a variety of grass seed and is its generic designation"). It has long been held that a product may have more than one generic name and that all these names are equally barred from registration. *Roselux*

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*Chemical Co., Inc. v. Parsons Ammonia Company, Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962); *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1538 (TTAB 2007) (It "is well settled that there can be more than one term to name a product"). Inasmuch as the *International Code of Nomenclature for Cultivated Plants* (Principle 11) "has no force beyond that deriving from free assent of those concerned with cultivated plants, there apparently is a real possibility that a cultivar may have more than a single name. We also note that applicant maintains that its specific Clematis cultivar is known as Little Duckling. Sorenson dep. at 47. Indeed, applicant maintains that the cultivar was also known as "Kivso." Sorenson dep. at 21 and 22.

However, we find that this particular cultivar or varietal of Clematis was originally known by the designation PIILU. Applicant acknowledges that it uses the term PIILU on one type of plant, not as a trademark for different living plants. Sorenson dep. at 135-36. See, e.g., *Stark Bro's Nurseries*, 132 USPQ at 653 ("It is, moreover, incongruous, to say the least, to suppose that a single designation, such as 'STARKRIMSON', would or could be used and be considered in the trade or by the purchasing public as a varietal name for three distinctively different types of plants and/or trees"). Applicant originally designated

the plant as Clematis 'Piilu.' *Id.* at 96 ("so at least as of September of 1998 you had the term Piilu in single quotes without any reference to any kind of trademark status? A. Yes, that's correct"). The name Piilu is used to designate a specific Clematis cultivar in the relevant trade literature.

'Piilu'

Early Large-flowered Group

'Hagley Hybrid' x 'Makhrovyi'

R: U. & A. Kivistik (1984), F: U. & A. Kivistik (1987), N: U. & A. Kivistik (1988), REG: EPPIVCD (2000)

Fls single and double, (4-) (6-12 cm across, solitary in lf-axils. Sepals of single fls 4-6, mauve-pink, bar broad, purple-red, surface textured and with irregular white markings, 2-5 cm ling, broadly elliptic, blunt but apiculate, overlapping, margin frilly. Filaments whitish, anthers yellow. Deciduous climber with stems 1-2 m. Lvs dark green, ternate or rarely pinnate. FL: May-June on previous year's growth (fls often double), Sept-Oct on current year's growth (fls single).

Published ref. Toovere 1992; *The Clematis* 1992; 59 (as 'Pülu')

(Misspelling: 'Pülu')

Victoria Matthews, *International Clematis Register &*

*Checklist* (2002), Royal Horticultural Society, 253-54.<sup>6</sup> We

add that some of the abbreviations in the entry are:

F - First flowered by

R - Raised by

N - Named by

Published ref. - the book, journal or catalogue where a cultivar name was first published

REG - Registered by

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<sup>6</sup> We note that in the book's acknowledgements (p. 11), the author thanks "Aili, Taavi and Aime Kivistik, Estonia."

Immediately following the entrees for 'Piilu' is a similar entry for 'Pille.'

'Pille'

Late Large-flowered Group

'Valge Daam' (s) x 'Niobe'

R: U. & A. Kivistik (1987), F: U. & A. Kivistik (1989), N: U. & A. Kivistik (1991), REG: EPPIVCD (2000)

Fls 14-18 cm across, solitary in lf-axils. Sepals 6, reddish-violet to mauve, 7-9 cm long, broadly elliptic, pointed, overlapping, margin wavy. Filaments whitish; anthers pale yellow. Deciduous climber with stems 1.5-2 m. FL: July-Sept on current year's growth.

Published ref. Türi AMS Clematis Cat. 1993; Kivistik, *Eesti elulõngad* 1998 (Misspelling: 'Pilii')

*Id.* at 254.

*An Illustrated Encyclopedia of Clematis*<sup>7</sup> contains the following entry:

Clematis Piilu

Origin: Raised by Uno Kivistik of Harjumaa, Estonia. The name means "little duckling."

Parentage and year: C's Hagley Hybrid x. C. 'Makhrovyi' 1984

Applicant asserts that it obtained its rights "to propagate and sell a variety Clematis Piilu" from the Kivistik family." Sorenson dep. at 43.

Applicant has also used the term PIILU without any indication that it is a trademark. Indeed, in an invoice to opposer in South Carolina dated December 17, 1998, applicant

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<sup>7</sup> Authors Mary Toomey and Everett Leeds, published in association with the British Clematis Society by Timber Press, Portland, Oregon (2001). Mr. Sorenson testified (p. 161) that he contacted Mr. Leeds regarding Piilu and asked him to "get it right in the next rewrite." The witness received no promises from Mr. Leeds that the next edition would be changed. Sorenson dep. at 162.

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refers to two of its Clematis plants as "'My Angel' T.M." and "'Blue Light' T.M." but it also refers to the third as simply "Clematis 'Piilu.'" Hansen Ex. 7 and 8.

In an article written by applicant's president, Rick Sorenson, the plant is referred to as "A recent Estonian introduction is C. 'Piilu' (Pillu™ virgin's bower...), which was bred by plantsman Uno Kivitstik." Hansen Ex. 10. He also refers to plant without a TM symbol. *Id.* ("Clematis 'Piilu' features large, light purplish-pink flowers").

Opposer has used the term PIILU to identify a specific type of Clematis plant.

**Clematis Piilu**

For a truly distinctive look, Piilu offers large 4- to 4½-inch flowers, first in late spring to early summer on old wood, then again in late summer on young shoots..

Developed by Estonian hybridizer Uno Kivistik in 1984 as a cross between the classic C. Hagley Hybrid and C. Mahrouyi "Queen of climbers" is what one British Clematis expert calls them.

Hansen Ex. 18. See also Hansen Ex. 13, opposer's 2000 catalog ("'Piilu' - new! For a truly distinctive look, this award-winning new hybrid is unsurpassed").

Opposer has also submitted excerpts from several publications to show that the term PIILU is used to identify a cultivar or varietal name. See Hanson Ex. 5 (John Howell, *Choosing your Clematis* (© 2000), Under "Pink Clematis," "Group VII Late Large." The following entries appear

"'Hagley Hybrid,' 'Comtesse de Bouchard,' 'Piilu,' 'John Warren'").

Applicant itself entered into several licensing agreements with various growers such as Spring Valley Greenhouse Inc. that licensed a variety referred to as CLEMATIS 'Piilu'™. See Sorenson Ex. POP001-POP003. See also POP234. The license makes no reference to a cultivar or varietal 'Kivso' or "Little Duckling.'

We note that several of the articles involve foreign entities and publications. Nonetheless, we hold that these publications are relevant. Several cases have explained that foreign publications can be relevant in helping us understand how a term can be perceived in the United States. *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002):

[I]t is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely available to these same professionals and to the general public in the United States. Particularly in the case before us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin.

More recently, the Federal Circuit has explained that: "Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer

impression of a proposed mark." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007). Here, the record supports a conclusion that the field of plant breeding is an international industry where growers, breeders, and indeed many consumers would rely on publications and information from sources outside the United States. We note for example, that applicant's witness testified that he had a copy of the *International Clematis Register & Checklist* at his business and that he has used it as a reference. Sorenson dep. at 76. Therefore, we find these publications are relevant.

When we consider the record before us, it is clear that a cultivar or varietal of Clematis was introduced as Clematis 'Piilu.' While subsequently applicant attempted to change that varietal or cultivar name to 'Kivso' and later "Little Duckling," the relevant public would nonetheless recognize the name 'Piilu' as a varietal or cultivar name of this plant. Applicant's description of its own website seems to acknowledge its belated efforts to establish another cultivar name. Brief at 5 ("As of 2003, [its] web site contained an express reference to Kivso (later changed to Little Duckling) as a cultivar name and PIILU as a trademark"). Under our case law, PIILU is a generic name for these plants. As such, we agree that applicant is not entitled to registration on the Principal Register.

**Opposition No. 91153755**

Decision: The opposition is sustained and registration to applicant of its mark is refused.