

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: February 19, 2013

Mailed: July 23, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Glen Raven, Inc.*

*v.*

*Amerinova Properties, LLC*

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Opposition No. 91192496  
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Christopher Kelly and Jennifer L. Elgin of Wiley Rein LLP for Glen Raven, Inc.  
Jennifer L. Whitelaw of Whitelaw Legal Group for Amerinova Properties, LLC.

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Before Cataldo, Taylor and Wolfson, Administrative Trademark Judges.  
Opinion by Wolfson, Administrative Trademark Judge:

Amerinova Properties, LLC (“applicant”) has filed an application to register the mark SUN BRELLA’S for “living plants” in International Class 31.<sup>1</sup> Glen Raven, Inc. (“opposer”) opposed the registration of applicant’s mark, alleging that applicant’s mark so resembles opposer’s assertedly famous mark SUNBRELLA for

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<sup>1</sup> Application Serial No. 77703289, filed March 31, 2009, pursuant to Section 1(a) of the Trademark Act, alleging that applicant first used the mark, and first used the mark in commerce, on March 28, 2009.

“fabrics sold in the piece for use in a diverse array of applications,”<sup>2</sup> as to cause a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution of the mark’s distinctiveness under Section 43(c), 15 U.S.C. § 1126(c). Opposer claims prior use and ownership of registrations for the marks SUNBRELLA,<sup>3</sup> SUNBRELLAS,<sup>4</sup> and SUNBRELLA “PLUS”<sup>5</sup> (each mark in standard character format), and for the two design marks depicted below.<sup>6</sup>



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In its amended answer,<sup>9</sup> applicant denied the salient allegations to the claims under Sections 2(d) and 43(c) and asserted several affirmative defenses. As none of

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<sup>2</sup> Notice of opposition paragraph 1.

<sup>3</sup> Reg. No. 0709110 for “fabrics for awnings, furniture, handbags, and sportswear”; registered December 27, 1960; renewed.

<sup>4</sup> Reg. No. 2028355 for “sunscreen lotions for the skin”; registered January 7, 1997; renewed.

<sup>5</sup> Reg. No. 2966133 for “fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor and outdoor furniture and beach umbrellas”; registered July 12, 2005; Section 8/15 combined declaration accepted and acknowledged.

<sup>6</sup> Opposer also claimed ownership of Reg. Nos. 3118723 and 2451005. These registrations were cancelled for failure to file acceptable declarations under Section 8.

<sup>7</sup> Reg. No. 3652524 for “fabrics sold in the piece for use in producing awnings, sun and windscreens, tents, canopies, boat covers and tops, indoor and outdoor furniture, beach umbrellas, area rugs, draperies, sheers, window treatments”; registered July 7, 2009.

<sup>8</sup> Reg. No. 2761048 for “fabrics sold in the piece, for use in the manufacture of awnings, canopies, boat covers and tops, indoor and outdoor furniture, bags and umbrellas”; registered September 9, 2003; Section 8/15 combined declaration accepted and acknowledged.

the affirmative defenses have been pursued at trial, they are considered as withdrawn. *See Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187 (TTAB 2012) (affirmative defenses not pursued at trial deemed waived).

#### Evidentiary Issues

Opposer has objected to the introduction of exhibits attached to applicant's notices of reliance 1, 2, 3 and 6. Opposer further moves to strike the first paragraph of the section entitled "The Facts" in applicant's trial brief. Applicant objects to the introduction of exhibits 36-39 attached to the trial deposition of opposer's Vice-President of Marketing.

#### ***Opposer's Objections***

The exhibits attached to applicant's first, third, and sixth notice of reliance are web pages. To be admissible by notice of reliance, copies of pages from websites must bear the date they were accessed, and the web address (URL) at which they were located. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). In this case, the pages that make up the exhibit to applicant's first notice of reliance do not bear dates or web addresses. The exhibits to applicant's third and sixth notices of reliance are identified by their URL location, but not by a date.<sup>10</sup> Accordingly, opposer's objection to the introduction of these web pages is sustained.

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<sup>9</sup> Applicant amended its initial answer as a matter of course within 21 days after service. Fed. R. Civ. Pro. 15(a).

<sup>10</sup> The reference to "2008-2009 Catalog" on the web page attached to applicant's first notice of reliance is insufficient to show when the page was accessed.

Opposer's objection to the introduction of the exhibits attached to applicant's second notice of reliance is overruled. These exhibits consist of printouts of third-party registrations from the Trademark Applications and Registrations Retrieval (TARR) database of the USPTO and, as such, are official records that are self-authenticating. Trademark Rule 2.122(e); *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1217 (TTAB 2011). Accordingly, we have considered them.

Opposer's objection to the recitation of facts upon which applicant relies in its trial brief centers on applicant's inclusion of statements taken from the discovery deposition of Birdie Lenard, applicant's administrator to the executive director, specifically at pgs. 36, 37, 44, 76 and 81-85. Opposer contends that the Board may not admit such statements into evidence except to the extent they serve to rebut or clarify other statements from portions of Ms. Lenard's deposition that have been previously adduced by opposer. Opposer contends that in this case, applicant is impermissibly attempting to use the statements to affirmatively prove facts about its own product and not merely to make not misleading those portions of Ms. Lenard's deposition that were introduced by opposer. In addition, opposer contends that the statements do not support the facts as asserted. *Reply Brief*, p. 3.

Trademark Rule 2.120(j)(4) provides that a party may submit any portions of a deposition "which should in fairness be considered so as to make not misleading what was offered" by the adverse party. Here, opposer offered Ms. Lenard's deposition for several purposes, such as for showing the alleged fame of opposer's

mark, the similarities of trade channels and classes of purchasers, applicant's manner of use of its mark, and applicant's alleged lack of familiarity with its retail sales locations. Pages 36 and 37 of the deposition do not address these issues but rather are directed to the witness's understanding of the allegations contained in the notice of opposition, and page 44 addresses the witness' awareness of opposer's mark. The statements contained on these pages do not serve to make any portion of the deposition as submitted by opposer not misleading and accordingly, they have not factored into our decision herein. Pages 76 and 81-85 are directed, in part, to identifying applicant's contact with sales representatives of Euro American Propagators, its largest client, and with green goods buyers (responsible for purchasing plants at retail nurseries) in order to describe applicant's channels of trade. The information contained in these latter pages is directed to the same topics as were presented by opposer's submitted portions of the deposition. These latter pages have been considered with respect to the issues of relevant trade channels and classes of purchasers (although not for the purpose of showing, as applicant's witness asserts, that there have not been any instances of actual confusion). Further, we agree with opposer that the facts as stated in applicant's brief are not necessarily supported by the statements in the deposition. Accordingly, we have disregarded the first paragraph of applicant's brief entitled "The Facts."

***Applicant's Objections***

Applicant objects to that portion of the testimony deposition of opposer's Vice President of Marketing, Harold (Hal) Hunnicutt, III, addressing market research studies conducted at opposer's behest in 1988 and 1989 (exhibits 36 and 37), a 1997

survey developed in part by Mr. Hunnicutt to test brand awareness among the boating market (exhibit 38), and an awareness study conducted in 2005 for opposer by an unrelated third-party research firm (exhibit 39). Applicant objects to the admissibility of the studies and related testimony. Opposer seeks to make the reports of record to show brand awareness of its SUNBRELLA mark.<sup>11</sup> Applicant argues that the evidence constitutes inadmissible hearsay; is improperly being offered as expert testimony; is too old to be of value; and has not been authenticated.

We believe that applicant's objections go to the weight of this evidence and not to its admissibility. The studies appear to have been designed and conducted according to accepted principles for determining accurate results, and are relevant to the issue of the relative market strength of opposer's mark. Accordingly, the evidence is admitted for what it shows on its face. The studies and the related testimony, however, have limited probative value. They were directed to a sample that does not include buyers of live plants, and with the exception of the 2005 study, were also not directed to buyers of outdoor items such as patio furniture, umbrellas, or outdoor cushions, but rather to buyers of opposer's fabric. Further, although introduced by Mr. Hunnicutt's testimony, Mr. Hunnicutt did not conduct, design or direct the studies, with the possible exception of the study directed to the boating market, and does not appear to have any first-hand knowledge thereof. Thus, we have considered the evidence as showing that at the time conducted, for the

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<sup>11</sup> It is noted that the studies have been designated as confidential and were filed under seal.

representative sample that was included in the study, and limited to the market at issue therein, a certain segment interviewed recognized SUNBRELLA as a brand for opposer's fabric. We have not, however, considered any of Mr. Hunnicutt's opinions regarding the results of the studies. Mr. Hunnicutt testified as a fact, not an expert witness.

#### The Record

Pursuant to Trademark Rule 2.122(b), the record includes applicant's application file and the pleadings. In addition, opposer's testimony and evidence consists of: the testimony deposition of Harold (Hal) Hunnicutt, III, opposer's Vice President of Marketing; and notices of reliance covering print-outs from the TARR database showing status and title of opposer's pleaded registrations; publically available news articles; copies of official documents regarding legal proceedings brought by opposer against alleged third-party infringers of its SUNBRELLA mark; excerpts from applicant's responses to opposer's first set of interrogatories Nos. 1, 11 and 14; portions of Ms. Lenard's discovery deposition; copies of pages from opposer's website; copies of third-party registrations purporting to show that a single entity has registered a mark covering goods of both parties; and copies of magazine articles directed to landscape architects containing opposer's advertising.

In light of our rulings above on applicant's trial submissions, applicant's admissible evidence consists of portions of the discovery deposition of Ms. Lenard; TARR printouts of two registrations for the mark SUNDRELLA and SUNDRELLA CASUAL and design; and certain of opposer's responses to applicant's first and second set of interrogatories and requests for admission.

We now turn to a consideration of the issue of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

#### Standing and Priority

Standing is a threshold jurisdictional issue in every case, directed solely to determine the interest of the plaintiff. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). *See also, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982); and *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries*, 213 USPQ at 189.

Opposer's pleaded registrations for the mark SUNBRELLA, and the marks that include SUNBRELLA, show opposer as owner and that the registrations are subsisting. Accordingly, Section 2(d) priority is not at issue in this case as to the marks and goods covered by the respective registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

#### Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison*



*Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Because evidence has been made of record regarding the factors of fame, the channels of trade and the relevant classes of consumer, we have considered these additional factors in making our determination. To the extent that any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral. We first consider the strength of opposer's mark.

A. Strength of Opposer's Mark

"A strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("When an opposer's trademark is a strong, famous mark, it can never be 'of little consequence,' " quoting *Specialty Brands v. Coffee Bean Distribs.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984)). In considering the inherent strength of the mark under the factor of fame, we have considered the inherent strength of the mark based on the nature of the mark itself as well as its commercial strength. *See Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, *McCarthy on*

*Trademarks and Unfair Competition* § 11:83 (4th ed.) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

Opposer’s marks SUNBRELLA, SUNBRELLAS, and SUNBRELLA “PLUS” have been registered on the Principal Register as inherently distinctive marks without resort to Section 2(f) or subject to a disclaimer. The registrations, being over five years old, are incontestable and no longer subject to challenge under Trademark Act § 2(e). Trademark Act § 14(3), 15 U.S.C. § 1064(3). The marks are inherently strong. We have focused our analysis on opposer’s word marks, as they are the closest to applicant’s SUN BRELLA’S mark.

Opposer has also shown that its mark SUNBRELLA is commercially strong. It has been in continuous use for over 50 years on fabrics of many types, in particular, high-performance fabrics that are primarily used for making awnings, boat covers, and outdoor furniture cushions.<sup>12</sup> Sales, while confidential, have been shown to be substantial, doubling over the past decade and “driven by the growth of the outdoor room concept.”<sup>13</sup> Advertising expenditures, filed under confidential seal, have also been sizable.<sup>14</sup> The SUNBRELLA mark has been extensively promoted through print, internet, television and social media.<sup>15</sup> Opposer has a

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<sup>12</sup> Hunnicutt dep., pp. 21-22.

<sup>13</sup> Hunnicutt dep., p. 158.

<sup>14</sup> Hunnicutt dep., p. 133.

<sup>15</sup> Hunnicutt dep., pp. 130-132, see also pp. 77-82 (television), 118 (internet), 119 (Facebook, Twitter and YouTube); see generally exhibit 3 (advertising since the early 1960’s); exhibits 5, 13-14 (promotional videos); exhibits 6-12 (advertising furniture, umbrellas, rugs, and

significant investment in its website “sunbrella.com,” which has been in operation since 1998.<sup>16</sup> Opposer has also received considerable unsolicited media coverage.<sup>17</sup> Opposer received two advertising awards for SUNBRELLA ads, in 2008 and 2009,<sup>18</sup> and reaches out to gardeners and garden clubs to expose them to the concept of the “outdoor room,” discussed more fully below. Opposer engages in enforcement activity to protect its rights in the SUNBRELLA mark, including through opposition and cancellation proceedings filed with the Board.<sup>19</sup>

Overall, the record evidence supports a finding that opposer’s mark is commercially strong among opposer’s customers, i.e., wholesalers, landscape architects, fabric stores, and designers. Critically, however, the record provides no direct evidence as to the extent of the awareness of the SUNBRELLA mark by the ultimate consumers who purchase finished products made with SUNBRELLA brand fabrics. While this is not typically necessary, here such evidence would be especially probative, given that opposer does not sell directly to end users. As discussed more fully below, the consumers of the finished goods incorporating opposer’s fabric are the only class of customers that overlaps with applicant’s customers. While there is evidence in the record that the SUNBRELLA mark

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sheer fabric under the SUNBRELLA mark); and exhibits 27-29 (advertising in gardening magazines).

<sup>16</sup> Hunnicutt dep., p. 118 and 125.

<sup>17</sup> Hunnicutt dep., p. 166; exhibit 42; Second notice of reliance, exhibit B.

<sup>18</sup> Hunnicutt dep., pp. 134, 137; exhibits 34 and 35.

<sup>19</sup> Hunnicutt dep., p. 171; Exhibit 44; Fourth notice of reliance, exhibits D1-D3. In this regard, the fact that there exist two registrations, owned by the same entity, for the marks SUNDRELLA and SUNDRELLA CASUAL, for outdoor furniture, is not dispositive. This number of similar, but not identical marks is too few to impact the overall strength of opposer’s mark.

appears on, at least, some hang tags for finished goods, there is no information as to the extent to which consumers of the finished goods have been exposed to such use of these hang tags, as part of the “outdoor room” or otherwise. The extent to which finished goods that incorporate opposer’s fabric have been advertised directly to the ultimate retail consumer is also unclear. Direct customer evidence is particularly probative in such circumstances; thus, in the absence of direct customer evidence, we are unable to ascertain the extent of consumer awareness of opposer’s SUNBRELLA mark to identify the source of opposer’s fabrics as used in connection with finished goods incorporating those fabrics. We also note the lack of information as to the percentage share of the market SUNBRELLA products command in the end-user category. Nonetheless, the record shows that the mark SUNBRELLA generally is strong among purchasers of outdoor furniture. We do not, however, find that the mark is well-known or famous among these purchasers.

Thus, while this *du Pont* factor favors opposer somewhat, it does not mandate that we accord opposer’s mark extreme deference in terms of the latitude of legal protection it receives. Because of the dominant role fame plays in the likelihood of confusion analysis when it exists, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

B. Comparison of the Marks

In comparing the marks, we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the

similarity or dissimilarity between them. *Palm Bay*, 73 USPQ2d at 1692. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *See Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

Opposer's mark SUNBRELLA for "fabrics for awnings, furniture, handbags, and sportswear" is closer in sight, sound, meaning and commercial impression to applicant's mark SUN BRELLA'S than are opposer's other word marks or its design marks and we limit our discussion to that mark. If we find that there is no likelihood of confusion with opposer's SUNBRELLA mark, there is no need for us to consider the likelihood of confusion with the other registered marks. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). We note that the identification of goods for all of opposer's marks, with the exception of

SUNBRELLAS for sunscreen lotions, include fabrics made for use in the manufacture of indoor and outdoor furniture.

Applicant's mark SUN BRELLA'S is virtually identical to opposer's mark SUNBRELLA. Both contain the suggestive letter string S-U-N-B-R-E-L-L-A. The space between the words SUN and BRELLA'S and the addition of the "apostrophe S" in applicant's mark do not change the appearance or pronunciation of applicant's mark enough that a prospective purchaser would be likely to distinguish it from opposer's mark. Both marks share the identical term "SUN" as the first word or component thereof; its significance is reinforced by its location. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). *See also, Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). The presence or absence of a space between the two words does not change the meaning or the commercial impression each mark as a whole conveys. *See, e.g., In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) ("Without the space, THEATL is equivalent in sound, meaning and impression to THE ATL and is equally descriptive of applicant's goods."); *Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"). Likewise, the presence of the apostrophe in the term BRELLA'S in applicant's mark merely creates a possessive form of the term BRELLA in opposer's

mark. Consumers will not take the time to analyze the slight differences in meaning created by the inclusion of the apostrophe and letter “s” in applicant’s mark. *See, e.g., Winn’s Stores, Incorporated v. Hi-Lo, Inc.*, 203 USPQ 140 (TTAB 1979) (“little if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark” WINN’S when compared to applicant’s mark WIN-WAY). Keeping in mind that the comparison of the marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, these slight differences are not likely to be noticed or remembered by consumers when encountering these marks under market conditions. Finally, the commercial impressions of the marks are similar. Each offers a play on the word “umbrella” by replacing the letters “um” with “sun.” This connotation is reinforced by the fact that opposer’s goods include umbrellas and awnings for use in the sun, whereas applicant’s goods include live plants “all of which were specifically bred to grow best in the sun.”<sup>20</sup>

The strong visual and aural resemblance between the marks, as well as the similar connotations and commercial impressions evoked by the marks outweigh any slight differences in impression created by the spacing and use of the possessive form in applicant’s mark. Accordingly, this *du Pont* factor favors opposer.

C. Comparison of the Goods; Trade Channels; Classes of Purchasers

Applicant’s application is for “live plants.” Opposer makes fabrics. Paragraph 2 of the notice of opposition alleges use of the SUNBRELLA mark since 1959 on “a line of performance fabrics for a variety of uses, including awnings,

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<sup>20</sup> Applicant’s response to opposer’s first set of interrogatories, No. 1.

indoor, outdoor and garden furniture, accessories such as draperies, pillows, rugs and throws, bedding products and varied marine uses, including sail covers, windshield coves and deck enclosures.” These goods are not competitive in nature, but it is not necessary that the goods be competitive in order to support a finding of likelihood of confusion, “it being sufficient that the goods or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.” *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990).

To determine whether the goods are related for likelihood of confusion purposes, we have looked to the nature and purpose of the goods, including whether they are complementary or used in conjunction with each other; whether the marketing methods, channels of trade and classes of purchasers are the same; and whether other companies offer both types of goods under the same mark. The record evidence overwhelmingly suggests that in all but a very limited arena, the marketing channels and classes of consumers are so disparate that these marks will not be encountered by the same persons under similar buying conditions. Even in this limited arena, i.e., the “outdoor room” market, confusion is not likely.

Opposer is strictly a textile manufacturer. It produces many different types of fabrics, such as fabrics for use in constructing ladies’ hosiery and for use in active



outerwear, flags, and backpacks,<sup>21</sup> but opposer only supplies the fabric and does not manufacture any of the finished products. Starting in 1959, opposer began using its mark SUNBRELLA for outdoor awning fabrics.<sup>22</sup> As Mr. Hunnicutt explained, “Sunbrella is an ingredient brand, and by that, I mean, it’s a – it’s a well-known brand of a component of a finished product, and it’s kind of like the Intel inside of the furniture world.”<sup>23</sup> Opposer expanded its outdoor uses of SUNBRELLA fabric to include boat canvas tops and sailboat sail protection fabrics, convertible car tops, drapery fabrics, outdoor rugs, decorative blankets or throws, and “in the outdoor furniture market for a fabric for cushions and sling chairs and umbrellas.”<sup>24</sup> It is this latter use with which we are particularly concerned.<sup>25</sup> We have carefully considered the evidence that opposer has presented with respect to the outdoor furniture market.

Opposer argues that there has been an evolution in the way outdoor furniture is marketed as a result of the growth of the “outdoor room.” Today, opposer argues, live plants and furniture are sold together as part of the outdoor room. In his deposition, Mr. Hunnicutt discusses the emerging market for “outdoor rooms,” a

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<sup>21</sup> See, e.g., opposer’s corporate brochure, Ex. 2 to Hunnicutt deposition.

<sup>22</sup> Hunnicutt dep., p. 21.

<sup>23</sup> Hunnicutt dep., p. 104.

<sup>24</sup> Hunnicutt dep., pp. 21-22.

<sup>25</sup> The use of the SUNBRELLA mark in the automotive and boating industry markets is irrelevant, because there is no record evidence to show that there is any market overlap, relatedness of the goods, or similarity in the trade channels or classes of consumers among the automotive or marine markets and applicant’s market for live plants. To the extent that opposer’s evidence of use pertains to these markets, while we have not disregarded it, it simply does not bear on the likelihood of confusion issue.

concept he describes as a “romancing of what we call the outdoor living room.”<sup>26</sup> He explains that the “growth trend has been fueled in part by the development of nicer, from an aesthetic standpoint and a comfort standpoint, furniture that can go outdoors to a level where today both the furniture and the fabrics are durable enough for outdoors but also look nice enough to belong inside the home.”<sup>27</sup> When asked to name the various components that make up an outdoor room, Mr. Hunnicutt answered that “it starts with the notion that you take an outdoor concrete patio or wooden deck and you add to it elements that make a nice living environment; comfortable and attractive furniture. Some form of shade, ... landscaping and hedges and trees and plants ... lighting and accessories and water features such as fountains and fire features such as fire pits or outdoor chimneys and grills ... you end up with an environment that’s far beyond just a chair and a Weber grill.”<sup>28</sup>

In this vein, opposer argues that SUNBRELLA brand fabric is an integral part of the outdoor room concept due to its high-performance, weather-resistant feature. It is in the “outdoor room” environment that opposer claims its customers could encounter those plants sold by applicant under the mark SUN BRELLA’S, causing confusion of source or sponsorship. Whereas in the past, live plants and outdoor furniture would not travel through the same trade channels to be

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<sup>26</sup> Hunnicutt dep., p. 29.

<sup>27</sup> Id. Thus, we have considered the record evidence pertaining to the indoor use of SUNBRELLA brand fabrics on indoor furniture, and in connection with rugs, decorative blankets and throws, to the extent these items are shown to be components of the outdoor room.

<sup>28</sup> Hunnicutt dep., p. 30.

purchased by the same classes of consumers, today, opposer argues, the popularity of the outdoor room has led to changes in the way the components that make up the outdoor room are marketed, such that at the retail level, the various components are displayed and sold together in a complementary fashion. Mr. Hunnicutt states:

We've begun to see that a lot of retailers – for a lot of retailers of products that contain Sunbrella, particularly outdoor furniture, have been integrated as a product offering to the consumer as an element of the outdoor room. And by that, I mean all the different components of the outdoor room including the furniture and including the live plants and – have been positioned next to each other, so they are complementary and they are offering and they all revolve around that concept of the outdoor room.<sup>29</sup>

These retailers include large retail chain stores as well as smaller garden centers that have expanded their offerings to include live plants and furniture.

A key question in determining whether products would be considered complementary is whether they would be purchased and used together, inasmuch as complementary goods are typically used, served, or consumed together and found when encountering one good while purchasing the other. *In re Sela Products, LLC*, Serial No. 77629624, \_\_\_ USPQ2d \_\_\_ (TTAB March 26, 2013) (purchasers likely to encounter both surge protectors, and wall mounts and brackets, during course of purchasing a television, audio or home theater system); *American Drill Bushing Co. v. Rockwell Manufacturing Co.*, 52 C.C.P.A. 1173, 342 F.2d 1019, 1022 (1965) (drill bits and drill brushings are complementary products). That two goods are used together, however, does not, in itself, justify a finding of relatedness. *Shen*

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<sup>29</sup> Hunnicutt dep., p. 67.

*Manufacturing Co., Inc. v. The Ritz Hotel Limited*, 393 F.3d 1238, 73 USPQ2d 1350, 1355-1356 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Packard Press, Inc. v. Hewlett-Packard, Co.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000) (fact that computer hardware and software products are used during the rendering of data processing services does not make the goods and services related). The test is not that goods and services must be related if used together, but whether their use is complementary. There is nothing in the evidence to suggest that live plants and fabrics, including those that are used in the manufacture of outdoor furniture and umbrellas, are complementary in nature and thus related. On this record, we conclude that the goods are not complementary even though they may be components of an “outdoor room.”

Nonetheless, “goods that are neither used together nor related to one another in kind may still be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Shen*, 73 USPQ2d at 1356, *citing Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (comparing FRITO-LAY for snack foods to FIDO LAY for dog treats). The consuming public must understand the products to have originated from the same source. Opposer argues that the public has become accustomed to consider the goods to be related because they are sold together by the same retail establishment and used in conjunction as part of the outdoor room, and because they are advertised together.

As to advertising, opposer points to its own, and to third-party, advertising as evidence that the goods are related. Internet, catalog and advertising information that show third parties offer for sale the same types of goods or render the same services that are identified in the application and cited registrations may suggest a likelihood of confusion. Opposer's website includes postings apparently designed to teach users to be aware of color used in the outdoor room, and to consider the green of plants as one color to mix with the colors of chairs, sofas, pillows and cushions.<sup>30</sup> Promotional videos featuring a television design celebrity, Joe Ruggiero, are used to promote SUNBRELLA brand fabric, "to give people ideas about how to use the fabric in their outdoor room and how to design outdoor living spaces."<sup>31</sup> These videos, which appeared on opposer's website and are "provided on disk to customers for use in their showrooms,"<sup>32</sup> include "How to Design an Outdoor Room,"<sup>33</sup> a segment wherein Mr. Ruggiero explains how to set up an outdoor room by using one principle of design known as "containment": defining a space outdoors to resemble a room with floors, walls, and a ceiling. He explains the integration of plants with furniture by showing how "hedging creates a sidewall," or "gives the illusion of a wall," which may also be defined by the "architectural use of plants."<sup>34</sup> Opposer seeks to show by this evidence that prospective consumers look for the design relationship between plants and furniture, and will consider these elements when

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<sup>30</sup> For example, at [www.sunbrella.com/blog/index.php/fabrics/inspiring-hues/](http://www.sunbrella.com/blog/index.php/fabrics/inspiring-hues/), the article advises readers to "add a splash of pink" color from upholstery to mix with the dominant greens from plants, grass and flowers. Opposer's eighth notice of reliance.

<sup>31</sup> Hunnicutt dep., p. 73.

<sup>32</sup> Id.

<sup>33</sup> Hunnicutt dep., p. 70; exhibit 13.

<sup>34</sup> Id.

making purchasing decisions. We find this evidence unpersuasive. It does not show that prospective consumers have become conditioned to view the goods as related. Importantly, there is no information in the record as to the extent of exposure consumers may have had to opposer's advertising. Moreover, the designer advice given has not been shown to impact the purchasing decision. It also does not link opposer as a source of origin or sponsorship of live plants.

Third-party media attention to the outdoor room concept also does little to suggest that a manufacturer of fabrics for outdoor furniture cushions and umbrellas such as opposer, or even a manufacturer of outdoor furniture cushions, would be a source for live plants. For example, an article from StarTribune.com dated March 17, 2010 entitled *Restoration Hardware launched its first garden furniture collection* notes that "the home store has launched its first collection for the garden, with 13 groupings of furniture as well as items ranging from fountains, lanterns and textiles to fire pits, lighting, tools, planters, plants and architectural elements." This simply lists a large number of unrelated items that make up the outdoor room. In the article, *Liven Up Outdoor rooms with Plants, Furniture*, Tulsa World, May 21, 2010, the president of Amini's Galleries recommends that readers choose high-end furniture for their outdoor rooms, using fabric such as "the new generation Sunbrella fabric," and that they "decorate with the season's brightest and best plants."<sup>35</sup> Again, the mere fact that a typical outdoor room includes plants and landscaping as well as outdoor, casual furniture, and that these items may be sold together, does not compel the conclusion that consumers would be confused as to the

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<sup>35</sup> Opposer's second notice of reliance.

source or origin or sponsorship of widely disparate goods simply because they are offered for sale together as components of the outdoor room.

A large number of articles have been introduced that have appeared in home and garden-related magazines, which describe how a designer has decorated his or her (or a client's) house, several rooms within the house, or the outdoor room with plants and furniture, as well as other features such as fountains, umbrellas, rugs, grills, and statuary. Photographs proliferate in these articles, showing off the creative design and display of furniture and other objects, including live plants, in the room. At the end of the article, an advertising information page appears. Its purpose is to provide the interested shopper with names, contact information, and pricing on the various items shown in the photographs or described in the article. These typically include pricing information for the furniture, lighting, water features, rugs, paintings, grills – but not the plants, even where they figure prominently in the photos.<sup>36</sup> Likewise, opposer has not provided any shots of any of the in-store outdoor rooms that it asserts are created by the “big box” retailers to advertise how to set up an outdoor room.<sup>37</sup>

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<sup>36</sup> For example, opposer's second notice of reliance includes an article from Better Homes & Gardens, dated December 1, 2008, entitled “Mediterranean Refinement.” It describes how designer Carolyn Isler and architect Larry Boerder designed an “old-world-style home” for Bettina and Greg England in Dallas, Texas. In 16 pages, full-page photographs and short captions describe the room arrangements and the appointments. At the end of the article is a listing of resources, identifying the furniture, appliances, lamps, flooring, cabinetry, etc. in the pictures together with the name of the provider. “Sunbrella” is listed under “cushion fabric.” None of the plants, large or small, outside or in planters, is identified in the resources listing.

<sup>37</sup> This is particularly surprising, given that Mr. Hunnicutt testified that he and his staff regularly visit these stores, as well as patio furniture retailers and garden centers to find out how applicant's product is being displayed. “We're visiting places like garden centers and paying attention to how the weather impacts their business and what kind of traffic

Under cover of its fifth notice of reliance, opposer has submitted copies of web pages from on-line garden centers that sell both plants and components of the outdoor room in a single website. Several similar website pages were also introduced during Ms. Lenard's discovery deposition.<sup>38</sup> In reviewing this evidence, we have observed that even though there may be a "home page" that includes links both to plants and furniture, the web pages that are devoted to plants are separately tagged and accessible through different links than are the web pages that advertise outdoor furniture.<sup>39</sup> In addition, most of the online garden centers identify the plants being advertised by their specific species name, but few websites indicate the brand name of the furniture item being sold, or which of the particular items displayed in the pictured grouping on the site are available for sale. Purchasers buying their products through the websites are likely to conclude, given the remoteness of the plants from the furniture, and the detail with which the plants are identified as contrasted with the general nature of the outdoor room merchandise, that the garden center providing the website focuses its sales on live plants and merely displays the products of various manufacturers of outdoor

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they're seeing, and how much people are coming into their store for outdoor room elements and how much of it is strictly accessories and how much of it is strictly plants and kind of how they're tying the whole story together..." Hunnicutt dep., p. 98.

<sup>38</sup> Specifically, exhibits 28, 36 and 57.

<sup>39</sup> An exception appears to be Exhibit 57, attached to Ms. Lenard's deposition, which shows a garden-center website advertising patio furniture, live plants, and landscaping services on the same web page. Even so, this level of attenuation between plants on the one hand and furniture on the other appears to be as extreme as that of the typical "big box" store departmentalization.



furniture and other components of the outdoor room on their sites.<sup>40</sup> Although Ms. Lenard agreed that at the garden centers she visits, furniture may also be sold,<sup>41</sup> she described the furniture she had seen as being made of metal, “or it’s distressed or rotting.”<sup>42</sup> Overall, the websites do not show that the purchasing public would perceive that the goods are related.

Opposer has also submitted copies of three live use-based, third-party registrations to show that plants and furniture are being offered for sale by a single entity.<sup>43</sup> Copies of third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). However, a mere three registrations are entirely insufficient from which such conclusion may be drawn. Moreover, two of the three registrations are owned by the same entity.<sup>44</sup> Accordingly, these third-party registrations have very little probative value.

The parties’ respective classes of customers do not otherwise overlap. In identifying applicant’s customers, Birdie Lenard, applicant’s administrator, identified applicant as an “intellectual property management company” that

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<sup>40</sup> Whether it is likely that, by continuing to click on the links to obtain information about the furniture, a user would come to learn the brand name of the merchandise, its price, dimensions, the material from which it is made, etc., is unknown on this record.

<sup>41</sup> Lenard discovery dep., p. 125.

<sup>42</sup> Lenard discovery dep., p. 125.

<sup>43</sup> Opposer submitted 3 live registrations, 2 dead registrations, and 7 applications. The two dead registrations were cancelled under Section 8 and are not evidence of use of the marks. The pending applications are evidence only of the fact that the applications were filed on a certain date; they also are not evidence of use of the marks. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007).

<sup>44</sup> Reg. No. 3150457 for the mark GARDENERS EDEN and Reg. No. 3243519 for the mark GARDENERS EDEN THE SPIRIT OF THE GARDEN IN ALL THINGS.

“doesn’t actually sell plants”<sup>45</sup> but maintains a licensing arrangement with Euro American Propagators,<sup>46</sup> who purchases unrooted cuttings from Vietnam and grows them for sale to garden centers, farms, and nurseries.<sup>47</sup> Opposer does not sell to nurseries, farms or garden centers. Opposer’s customers are companies that manufacture awnings, furniture (indoor and outdoor), cut yardage retailers such as Calico corners and JoAnn Fabrics, interior designers, and “decorative jobbers”<sup>48</sup> who put together collections of fabrics for use by their design customers.<sup>49</sup> Opposer’s customers also include landscape architects.<sup>50</sup> Opposer works with the American Society of Landscape Architects “to promote Sunbrella fabric for outdoor spaces.”<sup>51</sup> Opposer contends that these landscape architects (or designers) with whom it works are now offering outdoor room design and construction whereby they will purchase live plants and furniture for their clients as part of the overall exterior project.<sup>52</sup> Nothing in the record suggests that this class of professional consumer purchases applicant’s plants, or that, even if such customer did, he or she would be confused as

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<sup>45</sup> Lenard discovery dep., p. 25.

<sup>46</sup> Lenard discovery dep., p. 30.

<sup>47</sup> Lenard discovery dep., pp. 138 and 140; Exhibit 65 (list of customers who received SUN BRELLA’S brand plants).

<sup>48</sup> Hunnicutt dep., p. 32.

<sup>49</sup> Hunnicutt dep., p. 33. Opposer also sells its fabric to companies that manufacture or repair boats and convertible automobile tops. Opposer has relationships with big box stores such as Home Depot and Costco as well as larger retailers such as Restoration Hardware, Pottery Barn and Crate and Barrel. Opposer does not sell its fabric to these stores; opposer sells “to the companies that supply product to them.” Id.

<sup>50</sup> Hunnicutt dep., p. 34; opposer’s tenth notice of reliance, Ex. J.

<sup>51</sup> Hunnicutt dep., p. 85; opposer’s tenth notice of reliance (advertisements directed to landscape architects).

<sup>52</sup> Hunnicutt dep., p. 86. Q: And just to be clear, is it your understanding, based on your knowledge, that landscape architects also choose and purchase live plants for their clients?  
A: Yes.

to the source of origin of the goods. We see no likelihood of confusion among landscape designers.

Accordingly, these *du Pont* factors weigh against a finding of likelihood of confusion.

D. Balancing the factors.

Opposer's mark is well-known among purchasers of fabrics in the piece, and is known to purchasers of outdoor furniture, and applicant's SUN BRELLA'S mark is similar to opposer's SUNBRELLA mark. The goods, channels of trade, and classes of purchasers, however, are markedly different. The only overlap has been shown in regard to purchasers of outdoor furniture, who may encounter live plants as part of the sale of the "outdoor room" concept. The concurrent sale of furniture and live plants however, has not been shown to make them complementary products or sufficiently related such that relevant purchasers would be confused as to the source or sponsorship of the goods. Accordingly, we find that applicant's registration of the mark SUN BRELLA'S is not likely to cause confusion with opposer's SUNBRELLA marks.

Dilution

We now consider opposer's dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. The fame that must attach to a mark for it to be eligible under the dilution provisions of the Trademark Act is greater than that which qualifies a mark as famous for the *du Pont* analysis of likelihood of confusion. *Toro Co. v. ToroHead Inc.*, 61 USPQ 1164, 1170, (TTAB 2001), *citing I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225,

1239 (1<sup>st</sup> Cir. 1998) (“[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection.”). Since we have already found that, on this record, opposer’s SUNBRELLA marks do not have the *du Pont* analysis fame, then it would follow that they do not have the fame necessary for a dilution claim. Having found so, we need not reach the other factors in a dilution analysis.

***Decision:*** The opposition is dismissed under both Sections 2(d) and 43(c) of the Trademark Act.