

Oral Hearing held:
November 16, 2004

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

*Decision mailed:
February 4, 2005*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

TruServ Corp.

v.

Advanced Impact Marketing Service, LLC

Opposition No. 91124078 to application Serial No. 75886506
filed on January 5, 2000

Christopher J. Schulte and Kristine M. Boylan of Meagher & Geer,
P.L.L.P. for TruServ Corp.

Ernest D. Buff of Ernest D. Buff & Associates, L.L.C. for
Advanced Impact Marketing Service, LLC.

Before Hohein, Walters and Holtzman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Advanced Impact Marketing Service, LLC has filed an
application to register the mark "GREEN THUMB CLUB" for services
identified as: "providing on-line chat rooms for transmission of
messages among computer users concerning gardening" in
International Class 38 and "gardening club; providing gardening
information via an on-line electronic communications network" in
International Class 42.¹

¹ Ser. No. 75886506, filed on January 5, 2000, which is based on an
allegation of a bona fide intention to use the mark in commerce. The
word "CLUB" is disclaimed.

TruServ Corp. has opposed registration on the grounds that it "is and has been in the business of offering numerous gardening goods under the mark GREEN THUMB [since] as early as 1949"; that the mark "is used on over 100 gardening goods such as hoses, pruning saws, pruning shears, tank sprayers, sprinklers, ant traps, hedge shears, hand trowels, hand cultivators, broadcast spreaders, insecticide and hose parts"; that, in particular, opposer is the owner of "five registrations on the Principal Register for the mark GREEN THUMB" for, *inter alia*:

(i) "hand operated tools, namely, cultivators, vegetation cutters, tool handles, manure and fertilizer drags, stone drags, lawn and turf edgers, forks, hoes, rakes, lawn brooms and combs, hooks, pokers, shovels, spades, seedling setters, scoops, scrapers, blade-type sidewalk cleaners, sod lifters, trowels, weeders, grass whips, and grass hooks" in International Class 8;²

(ii) "liquid wax-like preparation for application to plant foliage as resistant to the effect of dust condensation thereon and contributive to improving general foliage color and appearance and ... soil testing reagents to determine soil acidity and presence of nitrogen, phosphorus, and potash elements in soil samples" in International Class 6;³

(iii) "trellises for supporting plants and vines; [and] kits for growing plants, consisting of pots, seeds, fertilizer,

² Reg. No. 581,301, issued on October 20, 1953, which sets forth a date of first use anywhere and in commerce of April 29, 1949; third renewal.

³ Reg. No. 590,405, issued on June 1, 1954, which sets forth a date of first use anywhere and in commerce of August 12, 1952; expired after second renewal.

potting soil, [and] instruction book" in International Class 20;⁴

(iv) "lawn sprinklers" in International Class 6;⁵ and

(v) "nursery products--namely, all types of shrubs, trees, plants, blooming plants and berry plants, and products of the nursery--namely, cut flowers, seeds and bulbs; charcoal; cork; mosses for decorative effects, for plant packaging and preserving, for mixing with soils, and for soil dressings; [and] soil and mixtures of soils for general and special plant propagating and growing" in International Class 31;⁶

that such mark "has long been used in connection with the goods on which it appears, has long been the subject of substantial advertising and promotion, has been used and advertised throughout the United States, is widely recognized by consumers,

⁴ Reg. No. 608,452, issued on July 5, 1955, which sets forth a date of first use anywhere and in commerce of October 24, 1951; second renewal.

⁵ Reg. No. 792,083, issued on July 6, 1965, which is actually for the mark "GREEN THUMB" and design, as reproduced below,



and sets forth a date of first use anywhere and in commerce of September 28, 1964; first renewal.

⁶ Reg. No. 587,562, issued on March 30, 1954, which sets forth a date of first use anywhere and in commerce of May 3, 1943; expired after second renewal. Although, instead of such registration, opposer actually pleaded ownership of "federal trademark registration 1457989 which was granted on September 22, 1987 for metal hose couplings, hose washers, metal cap nuts, metal quick-connectors, two-way y-connectors, goose neck swivel connectors, metal hose nipples; grass seed; garden hose; hose nozzles and garden sprinklers; hand-powered compressed air sprayers, grass shears, pruning shears, hedge shears, tree pruners and saws," no proof of its ownership thereof was offered at trial. In view thereof, and inasmuch as proof of opposer's ownership of Reg. No. 587,562 was made of record at trial, the pleadings are hereby deemed to be amended to conform to such evidence. Fed. R. Civ. P. 15(b).

is in substantially exclusive use, and is federally registered so as to make the mark distinctive and famous"; that because applicant's "mark GREEN THUMB CLUB is confusingly similar to Opposer's mark GREEN THUMB, ... its ... use by Applicant in connection with its services is likely to cause confusion, deception and mistake"; and that applicant's use of its mark "will dilute the distinctiveness of Opposer's mark."

Applicant, in its answer, has denied the salient allegations of the opposition.⁷

The record consists of the pleadings; the file of the opposed application; and, as opposer's case-in-chief, the stipulated testimony, with exhibits, of its associate general counsel, Susan M. Radde, taken on the closing date (October 14, 2002) of its initial testimony period. No evidence, however, was introduced by applicant in its behalf at trial and opposer, in view thereof, submitted no evidence in rebuttal. Briefs have been filed⁸ and an oral hearing, attended by counsel for each of the parties, was held.

⁷ While applicant has also pleaded, as a putative affirmative defense, that "Opposer's mark is descriptive and therefore entitled to a very narrow scope of protection," such defense constitutes a collateral attack on the validity of opposer's pleaded registrations. As such, it is a compulsory counterclaim and will not be heard unless a counterclaim or separate petition has been filed which seeks the cancellation of such registrations on the ground of descriptiveness. See Trademark Rules 2.106(b)(2)(i) and (ii). In view thereof, and since applicant has neither filed a counterclaim nor a separate petition to cancel opposer's pleaded registrations, no further consideration will be given to applicant's putative affirmative defense of descriptiveness. See TBMP §313.01 (2d ed. rev. 2004) ["The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration"].

⁸ Applicant's agreed motion for an extension of time to file a brief is granted. In view thereof, both its initial and revised briefs are

Turning first to the ground of priority of use and likelihood of confusion, priority of use is not in issue in this proceeding with respect to opposer's "GREEN THUMB" marks for the goods which have been specifically set forth above and which are the subjects of its *three* subsisting pleaded registrations since the evidence of record establishes that those registrations (namely, Reg. Nos. 581,301; 608,452; and 792,083)⁹ are currently in full force and effect and are owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ

timely filed, with the latter differing from the former in that certain of the confidential documents attached thereto were submitted under seal. It is noted, however, that in each of its briefs, applicant asserts in its description of the record that, in addition to the "Declaration of Susan M. Raddle [sic] dated October 14, 2002 attaching 21 exhibits," the "evidence of record consists of" applicant's "Response to Opposer's First Set of Interrogatories dated April 23, 2002" and eight confidential documents allegedly received from opposer in response to applicant's request for production of documents. Opposer, in its reply brief, has objected to consideration of the additional evidence and, contemporaneously therewith, has filed a motion to strike such evidence, contending that it is "not properly of record in this matter" because applicant "failed to file any evidence during the trial phase of this opposition. Although applicant, in a timely response, argues that "[t]he documents that are the subject of Opposer's MOTION TO STRIKE should be considered by the Board because these documents are admissions against interest and because they contradict statements made in Opposer's Brief," opposer is correct that the additional evidence should not be considered as part of the record herein because it was not properly introduced by applicant during its testimony period. Accordingly, the additional evidence is hereby stricken and will not be given any further consideration. See TBMP §539 (2d ed. rev. 2004), which provides in pertinent part that: "Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party." Moreover, because, in view thereof, each of applicant's initial and revised briefs contains numerous factual allegations which have no evidentiary support in the record for this proceeding, such allegations have been given no consideration. See TBMP §801.01 (2d ed. rev. 2004), which states in relevant part that "the facts and arguments presented in the brief must be based on the evidence offered at trial"; and TBMP §704.06(b) (2d ed. rev. 2004), which sets forth in pertinent part that: "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial."

⁹ See footnotes 2, 4 and 5, respectively.

108, 110 (CCPA 1974). In addition, the record establishes that by October 20, 1983, opposer completed the acquisition by assignment from Millburn Peat Company, Inc. of all right, title and interest to the mark "GREEN THUMB" for fertilizer for lawn or garden soil nutrient use. Opposer thus has priority of use with respect thereto inasmuch as the earliest date upon which applicant can rely in this proceeding, since applicant did not take any testimony or otherwise present any evidence in its behalf, is the January 5, 2000 filing date of its involved application for its "GREEN THUMB CLUB" mark. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); Zirco Corp. v. American Tel. & Tel. Co., 21 USPQ2d 1542, 1544 (TTAB 1991); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). The focus of our determination therefore is on the issue of whether applicant's "GREEN THUMB CLUB" mark, when used in connection with the services recited in its applications, so resembles opposer's "GREEN THUMB" marks for the goods set forth above in its pleaded and subsisting registrations as to be likely to cause confusion, mistake or deception as to source or sponsorship.

The record reveals among other things that opposer, which in the late 1970s or early 1980s was known as Cotter & Co., "is an international manufacturer and wholesale distributor for a cooperative of approximately 6,000 retail stores." (Radde dec.

at ¶3.) Opposer uses its "GREEN THUMB" marks "as a source identifier for gardening and lawn care products sold through its member True Value stores." (Id.) Opposer "sells its GREEN THUMB products in both the member stores as well as over the Internet," with the latter, depending on the season, "offer[ing] hundreds of GREEN THUMB products" through opposer's "primary Internet sales portal www.truevalue.com." (Id. at ¶8.) Opposer "also offers an 'Ask the Expert' service on the truevalue.com site which allows customers to ask gardening questions of a National Gardening Association representative." (Id. at ¶9.)

Opposer, as shown by certain of the exhibits it submitted, uses its "GREEN THUMB" mark on product labels and in product information, brochures and advertising. Its overall advertising expenditures, which in recent years have been over \$50 million annually, have included "television and radio advertisements which include GREEN THUMB products," with expenditures in 2002 of "approximately \$2,800,000.00 on television air time and \$758,000.00 on radio air time promoting products bearing the mark." (Id. at ¶13.) Opposer "also advertises its GREEN THUMB products through an internally-produced circular program" which includes the mailing of such circulars "to markets in which [retail] members request coverage." (Id. at ¶14.) The results of such advertising expenditures, according to Ms. Radde, have been "massive sales of products bearing the mark through ... over 6,000 member stores," with retail sales for the period between June 1999 and June 2002

of "20,013,920 units bearing the mark which [in turn] accounted for \$156,207,835.40 in total revenue." (Id. at ¶15.)

Neither applicant nor opposer, as previously noted, properly introduced any evidence into the record concerning applicant, its "GREEN THUMB CLUB" mark, or any of the services in connection with which applicant seeks registration of such mark. Our determination of the issue of likelihood of confusion, therefore, is based on an analysis of the limited facts properly offered into evidence by opposer and which are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the *du Pont* factors of the similarity or dissimilarity of the goods and services at issue and the similarity or dissimilarity of the respective marks.¹⁰

Turning first to consideration of the marks at issue, we find that when considered in their entirety, applicant's "GREEN THUMB CLUB" mark is substantially identical to opposer's "GREEN THUMB" marks in sound, appearance, connotation and commercial impression due to the shared presence of the term "GREEN THUMB." In particular, we concur with opposer that, as

¹⁰ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."

properly pointed out in its main brief, the dominant and distinguishing portion of applicant's "GREEN THUMB CLUB" mark consists of the term "GREEN THUMB," given the descriptiveness of the word "CLUB" (as evidenced by applicant's disclaimer thereof) in connection with applicant's gardening club services and its related services of providing on-line gardening information as well as chat rooms for transmission of messages concerning gardening. See, e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); and In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant maintains, however, that the respective marks are not confusingly similar. In essence, applicant argues that because "[t]he dictionary meaning for the term green thumb is an enhanced ability to grow plants," opposer's "GREEN THUMB" marks are not only highly suggestive of its lawn and gardening products, and thus are limited to a narrow scope of protection, but such marks, when used in connection with opposer's goods, "convey substantially dissimilar connotations" from applicant's "GREEN THUMB CLUB" mark, when such mark is used in connection with the services which it intends to render. While it is generally the case that, where the marks at issue are not identical, the fact that they are suggestive may lessen the likelihood of confusion, it is also the case that, where the respective marks are the same or, as in this proceeding, substantially identical, the suggestiveness of the marks has far less significance. See, e.g., Eastern Industries, Inc. v.

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Waterous Co., 289 F.2d 952, 129 USPQ 422, 424 (CCPA 1961). Here, the respective marks not only identically convey the suggestion that opposer's products and applicant's services offer customers thereof an enhanced ability to grow plants, but given that the marks overall are also, as noted above, substantially identical both visually and phonetically, their commercial impression is substantially the same. Thus, if used in connection with the same or related goods and services, confusion as to the source or sponsorship thereof would be likely to occur.

As to the respective goods and services, opposer contends in its main brief that use by applicant of the mark "GREEN THUMB CLUB" in connection with applicant's services of variously providing on-line chat rooms for transmission of messages among computer users concerning gardening, a gardening club and gardening information via an on-line electronic communications network "will cause significant confusion as to affiliation and sponsorship" with opposer's use of its "GREEN THUMB" marks for its lawn and gardening products because:

Opposer's consumers, conditioned by millions of dollars of advertising to associate gardening goods ... with Opposer, may very well consider Applicant's web site offering [to be] connected to Opposer. Consumers know that they can obtain Opposer's GREEN THUMB products over the Internet and while doing so obtain gardening information. If such consumers find Applicant's web site through a web search engine, they will likely think that they have found a strategic partner of Opposer. This element therefore weighs in Opposer's favor.

Applicant, on the other hand, asserts that:

Opposer's "Ask the Expert" service is run by an independent association, The National

Gardening Association (NGA). The service is not even directly run by Opposer. A user can access the "Ask the Expert" service without ever seeing the GREEN THUMB trademark. The only way a user might come across the GREEN THUMB trademark is if the NGA expert promotes one of the GREEN THUMB gardening tools in an answer. A user coming across Applicant's GREEN THUMB CLUB web site would likely think that the site involves gardening but it is unlikely that the user would think that the site has anything to do with the [Opposer,] TruServ Corporation.

We agree with opposer, however, that its goods and applicant's services are so closely related as to be likely, when offered under the marks at issue, to cause confusion as to source or sponsorship thereof. The evidence reveals in particular that opposer, in its advertising and sale on the Internet of various seasonal lawn and gardening products marketed under its "GREEN THUMB" mark, also provides an avenue whereby actual and prospective customers can request gardening advice. While such advice has not been offered under opposer's "GREEN THUMB" marks, the evidence nevertheless is significant inasmuch as it shows that consumers interested in purchasing lawn and gardening products could reasonably expect to encounter, as an adjunct thereto, a web-based information service devoted to chatting about and providing gardening advice. Such discussions and advice, as applicant acknowledges, could plainly include the recommendation of a specific brand or brands of lawn and gardening products. Consequently, in the case of opposer's "GREEN THUMB" lawn and gardening products, consumers familiar or acquainted therewith could reasonably believe, upon encountering applicant's "GREEN THUMB CLUB" gardening club services and its

services of providing, under such mark, both on-line chat rooms for transmission of messages among computer users concerning gardening as well as gardening information by way of an on-line electronic communications network, that such closely related goods and services have a common origin or are sponsored by or affiliated with the same source.

Among other things, opposer also insists in its main brief that "fame has attached to Opposer's mark[s]," as evidenced by its most recent advertising and promotional expenditures and product sales, and that "[t]his element weighs in Opposer's favor." While we concur with applicant, however, that the evidence presented by opposer is insufficient to establish that "GREEN THUMB" is indeed a famous mark for opposer's lawn and gardening products,¹¹ it is nonetheless the case that opposer has shown that such mark has acquired a not insubstantial measure of consumer recognition or strength and that it therefore cannot be considered as "not distinctive," as urged by applicant. Instead, and since there is no evidence that any third party currently is using a mark which consists of or contains the term "GREEN THUMB" in connection with lawn and/or gardening products, opposer's evidence of consumer recognition of its "GREEN THUMB" mark bolsters our conclusion that contemporaneous use of the marks at

¹¹ We observe, for instance, that the specifics of opposer's sales figures and its advertising and promotional expenditures cover a period of less than four years and there is no evidence as to the size of the market for lawn and gardening products and opposer's share thereof. Moreover, many of the samples of advertising introduced by opposer appear to be directed to the trade, that is, its retail members, rather than to the ultimate consumers of its goods.

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issue in connection with the respective goods and services of the parties is likely to cause confusion.

In view of our holding that opposer is entitled to the relief it seeks on the ground of priority of use and likelihood of confusion, we need not reach the remaining ground of dilution. Cf. American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd in op. not for pub.*, American Mobilphone Inc. v. American Paging Inc., 17 USPQ2d 1726, 1727 (Fed. Cir. 1990).

Decision: The opposition is sustained on the ground of priority of use and likelihood of confusion.