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THIS DISPOSITION IS NOT
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THE TTAB

Paper No. 8
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lebanon Chemical Corporation

Serial No. 75/739,273

John V. Moriarty of Woodard, Emhardt, Naughton, Moriarty & McNett for Lebanon Chemical Corporation.

Jon Schiffrin, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Chapman, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Lebanon Chemical Corporation has filed an application to register the mark PLANTING for "mulch containing paper and fertilizer for lawn, garden and commercial use."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark, if used in connection with the goods identified in the application, would be merely descriptive thereof. The

¹ Serial No. 75/739,273, filed June 29, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the term PLANTING is merely descriptive of a use or purpose for applicant's mulch. He argues that mulch is used as a part of the planting process and has made of record several excerpted NEXIS articles as evidence of the correlation between planting and mulch, of which the following are representative:

Mulch your plantings. Mulch reduces weed competition and permits the easy removal of seeds and foreign grasses. It also reduces the amount of watering needed.

The Times-Picayune (February 3, 2000);

Mulch is an ideal conclusion to the planting process, Owings said. Pine straw is a good mulch.

Sunday Advocate (Baton Rouge, LA)(February 13, 2000);

350 yards of fresh topsoil and mulch were trucked in for planting "all the herbs and vegetables I could possibly grow in this climate," Kuleto says.

The San Francisco Examiner (March 5, 2000).

The Examining Attorney argues that applicant's mulch not only protects the plants, in the manner of an ordinary mulch,² but since applicant's mulch contains fertilizer, the

² The Examining Attorney has made of record the dictionary definition of a mulch as "a protective covering, usually of organic matter such as leaves, straw, or peat, placed around plants to prevent the evaporation of moisture, the freezing of roots, and the growth of weeds." *The American Heritage Dictionary of the English Language* (3d ed. 1992).

mulch would be used in the planting process to add this component.

Applicant takes the position that although mulch may be used in planting, it is only a supplemental item such as a garden hose or a wheelbarrow, rather than a necessary product in the planting process. Thus, applicant argues, the consuming public would not be likely to immediately associate mulch with the term PLANTING. Applicant contends that although its mulch may be used by consumers in the manner of conventional mulches, this is not the perceived use for its fertilizing mulch. The added benefit of its mulch is that it can be placed around struggling or unhealthy shrubbery and plants without the need for supplemental fertilizer.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used, or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being or will be used, and the significance the designation is

likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

We agree with the Examining Attorney that a mulch, by definition, is directly associated with the planting process. The NEXIS evidence introduced by the Examining Attorney fully substantiates this association. Mulch is not merely a supplemental item similar to a garden hose or wheelbarrow which may be used for various purposes, one of which is planting. As shown by the NEXIS articles and the dictionary definition, mulch is used to protect new plantings, as part of the planting process. Thus, whether we view the term PLANTING as a descriptor of the process during which the mulch is used or as a descriptor of the plants or plantings around which the mulch is placed, PLANTING is merely descriptive of the mulch with which applicant intends to use the term.

The question is not whether the consuming public would be likely to associate the term PLANTING with a mulch such as applicant's, but rather whether the public would be likely to grasp the informational nature of the term PLANTING when encountered in connection with the mulch. The term is not to be considered in a vacuum, but rather in relation to the particular goods with which the term is intended to be used. Applicant acknowledges that its mulch may be used in the manner of conventional mulches, which are used in the planting process or at the time of planting. While applicant's particular fertilizing mulch may provide the additional benefit of eliminating the separate need for fertilizer, we see no reason why this would detract from the descriptiveness of the term PLANTING. The mulch remains a mulch for use in the planting process and for the benefit of plantings and the descriptive significance of the term PLANTING, when used in connection therewith, would be readily understood by the purchasing public.

Accordingly, we find the term PLANTING, if used, as intended, in connection with applicant's mulch containing paper and fertilizer, would be merely descriptive thereof.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

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