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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gardenlife, Inc.

Serial No. 74/366,357

Timothy D. Pecsénye and Cynthia Greer of Blank, Rome, Comisky & McCauley for Gardenlife, Inc.

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(Thomas Lamone, Managing Attorney).

Before Simms, Cissel and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Gardenlife, Inc. has filed an application to register the mark "GARDENLIFE" for "living plants and trees, flower and vegetable seeds for agricultural and horticultural purposes sold exclusively through applicant's own proprietary mail order business" in International Class 31 and "retail and wholesale distributorship [services] featuring gardening supplies, plants[,] trees and seeds; and mail order catalog services

featuring gardening supplies[,] plants, trees and seeds" in International Class 42.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods and services, so resembles the following marks, which are registered for the indicated goods, as to be likely to cause confusion, mistake or deception:

(1)(a) the mark "GARDENLIFE" and design, as reproduced below,



which is registered for "plastic hose fittings and connectors" in International Class 17 and "water sprinklers and sprayers for lawn and garden use; [and] cleaning brushes" in International Class 21;² and

(b) the mark "GARDENLIFE," which is owned by the same registrant as the above mark and is registered for "water sprinkling units for use in gardening, floriculture and horticulture, namely, static, rotating, swinging and pulse sprinklers; spinning

¹ Ser. No. 74/366,357, filed on March 9, 1993, which for both classes alleges dates of first use of May 1, 1984.

² Reg. No. 1,315,752, issued on January 22, 1985, which for both classes sets forth a date of first use anywhere of 1969 and a date of first use in commerce of August 1974; combined affidavit §§8 and 15.

sprinklers; spraying sprinklers; and lances for sprinkling pipes" in International Class 11 and "nonmetallic reel for flexible hoses, connectors and fittings of plastic material for flexible hoses" in International Class 20;³ and

(2) the mark "GARDENLIFE," as depicted in the stylized format shown below,

GARDENLIFE

which is owned by a different registrant and is registered for "fertilizers" in International Class 1.⁴

Registration has also been finally refused on the ground that the catalogs submitted as specimens, while acceptable to demonstrate service mark use, "are unacceptable as evidence of actual trademark use." In particular, the Examining Attorney insists that such specimens do not constitute displays associated with the goods⁵ as required by Sections 1(a)(1)(C) and 45 of the Trademark Act, 15 U.S.C. §§1051 (a)(1)(C) and 1127, and Trademark Rule 2.56.

³ Reg. No. 1,415,720, issued on November 4, 1986, which for both classes set forth a date of first use anywhere of 1978 and a date of first use in commerce of 1981; combined affidavit §§8 and 15.

⁴ Reg. No. 1,544,077, issued on June 20, 1989, which set forth dates of first use of December 31, 1987; combined affidavit §§8 and 15.

⁵ While, in the application as originally filed, applicant alleged in the affixation clause that "[t]he mark is applied directly on the goods ... and in other ways customary in the trade," applicant has elected not to submit verified substitute specimens evidencing use of its mark labels, tags or packaging for its goods as suggested by the Examining Attorney.

Applicant has appealed. Briefs have been filed, and an oral hearing was held before the Board. We affirm the refusals to register.

Turning first to the refusal under Section 2(d), applicant contends that "[t]he mere fact that [the respective goods at issue] ... can be used in a garden does not, alone, establish the necessary nexus between the goods" for purposes of a finding that such goods are so closely related that the sale thereof under the same or similar marks would be likely to cause confusion as to source or sponsorship. Applicant further insists that, as set forth in its application, its goods and services are marketed exclusively through its own proprietary mail-order catalog distribution system and that the channels of trade for the respective goods are therefore different. Applicant also maintains that its customers are sophisticated, commercial purchasers who would exercise a great deal of care in the selection of goods which they order. Consequently, because its goods and services assertedly are "distinctly different" from the goods offered by the cited registrants, applicant argues that "[i]f the registrations cited by the Examiner are able to coexist, ... [then] Applicant's Application should also be entitled to registration."

The Examining Attorney, on the other hand, correctly points out that it is well settled that goods and/or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and/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 in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Moreover, as the Examining Attorney also observes, it is well established that the issue of likelihood of confusion must be determined in light of the goods and/or services set forth in the involved application and cited registrations and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods and/or services. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

In the present case, while applicant's goods and its catalog services are indeed limited to mail-order sales and distribution, none of the cited registrations contains any such restriction nor are applicant's distributorship services so limited. Thus, and since there is nothing in the record to suggest that registrants' goods are not suitable for sale through distributorship and mail-order channels of trade, they must be considered to be available through distributorships and by mail-

order catalogs, just like applicant's goods, and to be suitable for sale to the same classes of customers. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). No weight, therefore, may be given to applicant's contentions regarding differences in distribution channels and intended purchasers for the respective goods and services.

In addition, it is clear that the various water sprinklers and sprayers for lawn, garden, floricultural and horticultural use, lances for sprinkling pipes, and hose fittings, connectors and reels sold by one of the registrants and the fertilizers marketed by the other are all related "gardening supplies". Such products, like applicant's living plants and trees and its flower and vegetable seeds, would be sold through wholesale distributors and mail-order catalogs to commercial growers and garden-supply retailers and would also be offered by retail distributors to professional growers and those members of the public at large who are interested in gardening. Moreover, as the Examining Attorney notes in her brief, registrants' fertilizers, sprinklers, sprayers, lances for sprinkling pipes, and hose fittings, connectors and reels are complementary to applicant's living plants and trees and its flower and vegetable seeds since the respective goods are frequently used together for agricultural and horticultural purposes, such as operating commercial nurseries and planting gardens.⁶ The respective goods

⁶ To state the obvious, those with a need for applicant's goods would inevitably need one or more of registrants' goods since, as the Examining Attorney points out in her brief, both "[watering and]

in this case, as the Examining Attorney further points out, "are apt to be advertised and displayed in proximity to each other, whether in the aisles of a home and garden center, or on the pages of a printed sales catalog."⁷

In consequence of the above, we agree with the Examining Attorney that:

[A]n obvious connection clearly exists between the registrants' goods and the applicant's goods and services. Water sprinklers, water sprayers, [fittings, connectors and reels for] hoses, ... and fertilizers ... are often integrated and necessary parts of a place where living plants and trees, flower seeds and vegetable seeds are used, namely, in a garden. They are goods which are frequently sold in the same places, such as lawn and garden centers Moreover, the [respective] goods are often available through mail[-]order services, such as those which the applicant offers.

Thus, irrespective of the coexistence of the cited registrations, it is plain that applicant's goods and services are so closely related to each of the registrants' goods that contemporaneous use of the same or similar marks in connection therewith would be likely to cause confusion as to source or sponsorship, even among

fertilizing plants and seeds is often a necessary step in assuring their proper growth."

⁷ As the Examining Attorney additionally observes, that the "water sprinkling units" set forth in one of the cited registrations are specifically identified as being "for use in gardening, floriculture and horticulture" strongly suggests that "these various gardening supplies are marketed to the same class of individuals that are apt to already be or to make themselves familiar with the applicant's mail order services and gardening goods".

sophisticated purchasers such as commercial growers and nurserymen.

Turning, therefore, to the marks at issue, applicant argues that, in the case of the two cited registrations which are owned by the same registrant, the copies which it made of record of the specimens submitted in connection with the underlying applications therefor show that the registrant is actually using the mark "CLABER GARDENLIFE" (both with and without a design feature) and, thus, the literal portions of such marks and applicant's "GARDENLIFE" mark are not identical in appearance, sound or meaning. Section 2(d) of the Trademark Act, however, precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" The issue of likelihood of confusion accordingly must be decided on the basis of the mark sought to be registered and the mark shown in each cited registration. The fact that a registrant may use its registered mark with added matter, such as the house mark "CLABER," is thus irrelevant and immaterial. See, e.g., ITT Canteen Corp. v. Haven Homes Inc., 174 USPQ 539, 540 (TTAB 1972) and cases cited therein.⁸ As to the other cited registration, applicant has offered no argument with respect thereto and, therefore,

⁸ Applicant's contention, which it reiterates in its reply brief, that "registrant's actual use of the mark [as "CLABER GARDENLIFE"] as evidenced by [the copies] of the specimens of record be granted significant weight" is without merit. See, e.g., Sealy, Inc. v. Simmons Co., 265 F.2d 934,121 USPQ 456, 459 (CCPA 1959); Burton-Dixie Corp. v. Restonic Corp., 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); and Hat Corp. of America v. John B. Stetson Co., 223 USPQ 485, 106 USPQ 200, 203 (CCPA 1955).

apparently concedes that the stylized "GARDENLIFE" mark shown therein is essentially identical in all respects to its "GARDENLIFE" mark.⁹

We agree with the Examining Attorney that, when considered in their entirety, applicant's "GARDENLIFE" mark is virtually identical to both registrants' "GARDENLIFE" marks in sound, appearance, meaning and commercial impression. Its mark is also substantially similar visually, and is essentially the same phonetically, connotatively and in commercial image, to the "GARDENLIFE" and design mark owned by one of the registrants. This is due to the fact that, in the registered mark, the term "GARDENLIFE" is the dominant feature thereof since, where a composite mark consists of a literal term and a design element, it is the literal portion which would most likely to be impressed upon a customer's memory and would be used by prospective purchasers when ordering or asking for the goods. See, e.g., In re Appetito Provisions Co., Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). Such is especially the case where, as here, the design element in the registered mark is simply a geometric pattern or

⁹ It is pointed out that inasmuch as applicant seeks to register its mark in a typed format consisting of all capital letters, its rights therein encompass the term "GARDENLIFE" itself and are not limited to the depiction thereof in any special form. See Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Moreover, "[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word] could be depicted". *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). One such manner is that illustrated by the stylized "GARDENLIFE" mark cited herein. Applicant's mark must consequently be regarded as including the display thereof in the same stylized presentation.

carrier which serves merely to display the literal portion of the composite mark.

We conclude, in view thereof, that actual and potential purchasers, who are acquainted with the "GARDENLIFE" mark and/or "GARDENLIFE" and design mark owned by one of the registrants for water sprinklers and sprayers for lawn, garden, floricultural and horticultural use, lances for sprinkling pipes, and hose fittings, connectors and reels, or who are familiar with the "GARDENLIFE" mark owned by the other registrant for fertilizers, would be likely to believe, upon encountering applicant's "GAARDENLIFE" mark for the living plants and trees and flower and vegetable seeds for agricultural and horticultural purposes which it sells exclusively through its own proprietary mail order business, its retail and wholesale distributorship services featuring gardening supplies, plants, trees and seeds, and its mail-order catalog services featuring gardening supplies, plants, trees and seeds, that such closely related gardening supplies and associated services emanate from, or are otherwise sponsored by or affiliated with, the same source.

Turning next to the remaining ground for refusal,¹⁰ the specimens submitted by applicant for its goods consist of a

¹⁰ In this regard, Section 1 of the Trademark Act, 15 U.S.C. §1051, provides in pertinent part that, in the case of an application based upon use in commerce, the following requirement must be met (**emphasis added**):

- (a) The owner of a trademark **used in commerce** may apply to register his or her trademark under this Act on the principal register hereby established:

complete copy of its 1985-1986 mail-order "GUIDE FOR PROFESSIONAL GROWERS" catalog and photocopies of the front cover thereof. The mark "GARDENLIFE," as used on such catalog, appears as part of the logo reproduced below,

(1) By filing in the Patent and Trademark Office--

....

(C) such number of **specimens** or facsimiles **of the mark as used** as may be required by the Commissioner.

Section 45 of the Trademark Act, 15 U.S.C. §1127, in turn defines "use in commerce" in relevant part as follows (**emphasis added**):

For purposes of this Act, a mark shall be deemed to be in use in commerce--

(1) on goods when--

(A) it is placed in any manner on the goods or their containers or **the displays associated therewith** or on the tags or labels affixed thereto, **or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale**

In accordance therewith, Trademark Rule 2.56 provides in pertinent part that:

The specimens shall be duplicates of the labels, tags, or containers bearing the trademark, or the displays associated with the goods and bearing the trademark (or if the nature of the goods makes use of such specimens impracticable then on documents associated with the goods or their sale)



which is used on the front and back covers of the catalog, on a one-page listing therein as one of 20 "EXCLUSIVE BRANDS" offered by applicant, on a few scattered pages in association with other brands and on the front and back of accompanying order forms.

Applicant, in its initial brief, insists that, as so used on its catalog:

The trademark GARDENLIFE serves as a source identifier for both Applicant's mail order catalog services as well as the goods identified in the pages of the catalog. It is customary in the industry to display trademarks identifying goods on catalogs such as those submitted by Applicant. Applicant's goods are live plants and trees and seeds and it is impracticable to place its trademark on such goods. Consumers purchasing items from Applicant's catalog know that the goods identified within the pages come from Applicant so the mark GARDENLIFE acts as a source identifier for the goods. See TMEP § 905.04 and Lands' End, Inc. v. Harry F. Manbeck, Jr., 797 F. Supp. 511; 24 USPQ[2d] 1314 (TTAB 1992) (catalogs deemed acceptable as trademark specimens).

Although the Examining Attorney has not addressed applicant's assertion that it is impracticable to place its "GARDENLIFE" mark on its live plants and trees and on its seeds, TMEP §905.04, which is entitled "Material Appropriate as

Trademark Specimens," provides in relevant part that (**emphasis added**):

Reflecting the definition of "use in commerce" in §45 of the Trademark Act, 15 U.S.C. §1127, Trademark Rule 2.56 permits applicants to submit documents associated with the goods or their sale as specimens where the goods are such that placement of the mark on the goods, containers, tags, labels or displays associated with the goods is impracticable. **This provision is not intended as a general alternative to submitting labels, tags, containers or displays associated with the goods; it applies only to situations in which the nature of the goods makes use on such items impracticable.**

A mere assertion of impracticability may not suffice to establish that such use is impracticable; rather, the record must indicate that the goods are in fact of such a nature. The provision may apply, for example, in an application to register a mark for natural gas, grain that is sold in bulk, [or] chemicals that are transported only in tanker cars.

Nothing in the record indicates, however, that it is impracticable for applicant to use its "GARDENLIFE" mark on tags or labels for its living plants and trees or on packaging for its flower and vegetable seeds. In fact, through its catalog, applicant offers printed labels and tags for the plants and trees which it sells and it is common for packages of seeds, including those sold in the quantities marketed by applicant, to carry one or more brand names thereon. Thus, even though applicant may principally sell its goods to professional growers, it simply has not shown that the nature of its goods are such that it

impracticable to use the "GARDENLIFE" mark on labels, tags or packaging for its goods. Whether the specimens furnished by applicant are acceptable as evidence of technical trademark use depends, therefore, upon whether its catalog constitutes a display associated with its goods.

We concur with the Examining Attorney that applicant's reliance on *Lands' End Inc. v. Manbeck*, 24 USPQ2d 1314 (E.D. Va. 1992) is misplaced. In that case, Lands' End Inc. sought to register the mark "KETCH" for use in connection with purses and submitted portions of its mail-order catalog as specimens of use of the mark.¹¹ The court, in holding that such specimens, as displays associated with the goods, were acceptable to evidence trademark use of the mark "KETCH" for purses, reasoned that:

Lands' End's use of the term "KETCH"
with the picture of the purse and

¹¹ Specifically, as described by the court in its opinion:

The catalogue displays include a picture and a description of each item, and often a trademark is used on the catalogue display to identify the item. In this case, Lands' End is attempting to register the term "KETCH" as a trademark to be associated with a certain kind of purse. Lands' End has submitted a page of its catalogue showing the picture of a purse, a verbal description, and the term "KETCH" as they allege constitutes trademark usage. The alleged trademark "KETCH" appears prominently in large bold lettering on the display of purses in the Lands' End specimens in a manner which clearly associates the term with the purses.

24 USPQ2d at 1315. In view thereof, the court stated that: "The question for determination here is whether Lands' End's use of the term 'KETCH' in the manner described above in its retail catalogue constitutes a use of 'displays associated' with the goods satisfying the use in commerce provision in 15 U.S.C. § 1127." Id.

corresponding description constitutes a display associated with the goods. The catalogue is by no means "mere advertising." A customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. A customer can easily associate the product with the word "KETCH" in the display. The mark and the accompanying description also distinguish the product from others. The point of sale nature of this display, when combined with the prominent display of the alleged mark with the product, leads this court to conclude that this [manner of use of the] mark constitutes a display associated with the goods.

24 USPQ2d at 1316. The *Lands' End* case, however, does not deal with the situation presented herein, namely, whether use of the service mark "GARDENLIFE" on a mail-order catalog constitutes trademark use thereof as a house mark for the plants, trees and seeds which applicant advertises and offers under a variety of its "exclusive" marks, including "GARDENLIFE".

As the Examining Attorney persuasively points out in her brief:¹²

[T]he Court in *Lands' End* did not rule that any and all catalogs or mail order catalogs constitute a "display associated with the goods." Rather, the case turned on the fact that the proposed trademark KETCH, and corresponding product description[,] were very closely, repeatedly, and unquestionably associated with the product to which the term KETCH specifically pertained, namely a purse.

To constitute "a display associated with the goods," the content of a catalog must

¹² TMPEP §905.06, the section of the Trademark Manual of Examining Procedure cited by the Examining Attorney in her brief, now appears, in light of the recent revision of the TMPEP, as Section 905.06(a), but the relevant substantive content thereof is unchanged.

include 1) a picture of the relevant goods,
2) the inclusion of the mark sufficiently

near the picture so as to associate the mark
with the goods, and 3) the inclusion of
enough information necessary to order the
goods. TMEP Section 905.06.

The catalog specimen contains over 124
pages. It is categorized into approximately
20 subdivisions or chapters. In fact,
a full reading of the [catalog] does not
leave the consumer with any impression that
GARDENLIFE either directly or indirectly
refers to any specific seeds, flowers, [or]
trees

In accepting the mail order catalog
specimen in *Lands' End*, the Court considered
a form of usage of the proposed trademark
that was completely different from the usage
which Gardenlife, Inc. makes of its mark.
There the consumer easily and accurately
associated the purse with the mark KETCH,
such that the consumer knew he or she was
looking at and purchasing a "Ketch" purse.

The applicant's specimens make no
reference to any "Gardenlife" seed,
"Gardenlife" tree, or "Gardenlife" [plant]
.... The mere coexistence in the same
catalog of a proposed trademark and pages of
[some of the] goods pictured for sale is
clearly insufficient, and does not meet ...
elements of the three-prong test identified
above. The specimens of record simply do not
demonstrate [trademark] use of GARDENLIFE in
connection with any of the identified goods.

In particular, we note that as displayed as part of a
logo on the front and back covers of the catalog and on the order
forms contained therein, the mark "GARDENLIFE" is plainly used in
a service mark manner in that it functions to identify and
distinguish the source of applicant's mail-order services.
While, by our count, such mark randomly appears, as part of the

same logo, on a dozen of the catalog pages which contain product descriptions, price information and in some instances pictures of applicant's plants, trees and seeds, in most cases the mark is featured in boxes of advertising text which refer either to other marks used by applicant for particular products, such as the brands "HOT TIP!," "HORSE RACING SERIES," "SUN & SHADE," "ROOTS" and "BIG FOOT," or to general categories of plants and services offered by applicant. In none of the instances is the proximity of usage such that customers for applicant's goods would clearly associate the mark "GARDENLIFE" with the goods pictured and/or described in the catalog. Instead, as used therein, buyers of applicant's products would plainly regard such mark as indicative solely of the mail-order source for the products and not as a trademark for the individual goods depicted and/or listed. The catalog specimens consequently fail to evidence trademark use in the same or an analogous manner to that held in *Lands' End* to constitute a display associated with the goods.

Decision: The refusals to register are affirmed.

R. L. Simms

R. F. Cissel

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board