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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sun-Land Garden Products, Inc.

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Serial No. 75/714,956

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Mark E. Myers of Grunsky, Ebey, Farrar & Howell for Sun-Land Garden Products, Inc.

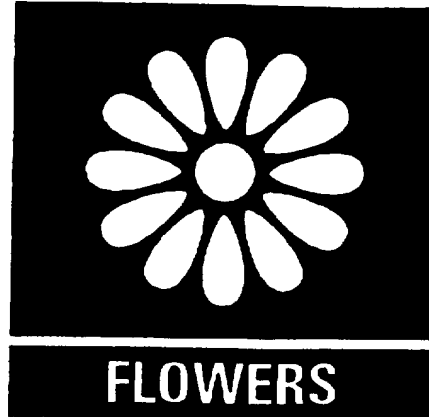
Bridgett G. Smith, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

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Before Simms, Hohein and Rogers, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Sun-Land Garden Products, Inc. ("applicant"), a California corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below:



for garden mulch.<sup>1</sup> Applicant and the Examining Attorney have submitted briefs but applicant did not file a request for an oral hearing.

The Examining Attorney has refused registration under Sections 1, 2 and 45 of the Act, 15 U.S.C. §§1051, 1052, and 1127, on the basis that applicant's asserted mark does not function as a mark to identify and distinguish applicant's goods. Essentially, the Examining Attorney argues that the proposed mark, as used on the specimen of record, is informational in nature and not used as a trademark to indicate source. The specimen of record--a large photocopy

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<sup>1</sup>Application Serial No. 75/714,956, filed May 21, 1999, on the basis of an allegation of applicant's bona fide intention to use the mark in commerce. Applicant submitted a disclaimer of the word "FLOWERS." After a notice of allowance was issued by this Office, applicant filed a statement of use on September 25, 2000, asserting first use since November 1, 1999, and first use in commerce since August 5, 2000. While the original application sought registration of the mark both for garden mulch (in Class 31) and for potting soil and soil conditioners for agricultural and domestic use (in Class 1), the statement of use was accompanied by only one fee and covers only garden mulch.

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of a 40-pound bag of planting mix--shows the asserted mark near the left side of the bag along with six other similarly styled designs such as the ones shown below as well as the word LAWNS beneath a stylized design of grass growing above the soil, the word VEGETABLES below a slightly stylized design of some vegetables, etc.<sup>2</sup>



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<sup>2</sup> We note that while the identification of goods currently lists "garden mulch," the specimen submitted with the statement of use shows the generic name of the product to be "Humus Rich Planting Mix."



The Examining Attorney argues that similar wording and similar designs are commonly used by others on packaging of similar products to convey similar information. The Examining Attorney contends that applicant's asserted mark merely provides information to the consumers concerning the use of applicant's products. In support of her refusal, the Examining Attorney has submitted photocopies from various Web sites of pictures of flowers on packaging, and

argues that the public is conditioned to look at these and similar designs and wording of others as informational matter indicating the function or use of the products rather than as trademarks. Applicant's asserted mark merely indicates a type of mulch suitable for flowers and does not designate source, according to the Examining Attorney.<sup>3</sup>

The Examining Attorney has also made reference to material which applicant has submitted explaining its Easy-Icon System. See below:



<sup>3</sup> In her brief, the Examining Attorney also discusses the functionality doctrine, which prohibits registration of functional product features. Applicant has also argued that registration is not barred by this doctrine. However, this discussion is misplaced as there is no refusal under Section 2(e)(5) of the Act ("...comprises any matter that, as a whole, is functional"). The refusal is that the asserted mark does not function as a trademark.

Applicant, on the other hand, while admitting that the asserted mark provides information to assist the public in determining the use of the product or as an aid in determining the type of mulch suitable for the cultivation of flowers (Brief, 2, 3, 4, 5 and 7, Response, filed June 4, 2002, 2-3, and Response, filed July 17, 2001, 2),<sup>4</sup> contends that "the mark is part of a system used by Applicant to not only aid the consumer in selecting a proper product, but more importantly, to have the consumer recognize such icons in the system as Applicant's, thereby identifying their goods and distinguishing them from their competitors and indicating the source of the goods." Applicant's Brief, 1-2, and Response, filed June 4, 2002, 3. In other words, while the asserted mark will admittedly assist the consumer in selecting the right product because the "design [identifies] the use of the product" (Brief, 2), applicant argues that consumers associate this design, as well as the entire icon system, with the source or origin of the product.

The specimen provided was a depiction of a bag of mulch upon which the mark and design were printed. The Applicant's customers use the mark to identify the type of mulch contained in the Applicant's bagged products. The

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<sup>4</sup> Applicant states, Response, filed July 17, 2001, 1, that it sells different varieties of potting soils and mulches "depending on the type of plants that can be grown with such soils or mulches."

mark FLOWERS and design identifies the product contained in the bag, mulch that can be used successfully in the cultivation of flowers.

Response, filed July 17, 2001, 2.

While applicant in its Brief, 7, contends that consumers have come to recognize its icon system as identifying the source of its goods, applicant has not specifically asserted a claim of acquired distinctiveness under Section 2(f) of the Act. See also Response, filed June 4, 2002, 3. Applicant has not referred to any length or period of usage of its asserted mark, or any exposure of its mark to the relevant public by way of sales or advertising, but has pointed only to the registration of some of these design elements as support for this statement. See also applicant's Brief, 3 ("[T]he consumer, through use of these marks over time, has come or will come to recognize this style of mark, and this FLOWERS mark and Design in particular, as being that of Applicant.") The Examining Attorney also notes in her brief that applicant has not made any claim under Section 2(f) of the Act, and that any claim of acquired distinctiveness attempted to be asserted by applicant in its brief is untimely. We agree, and shall treat this case solely on the basis of the

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refusal that the asserted mark fails to function as a mark, without any claim of acquired distinctiveness.

We start with the proposition that not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so. That is to say, not all words, designs, symbols or slogans used in the sale or advertising of goods function as a mark to identify and distinguish source. As the predecessor court of the U.S. Court of Appeals for the Federal Circuit observed in *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960):

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable merely because they do not happen to be descriptive of the goods or services with which they are associated.

A term may not function as a trademark unless it is used in a manner which clearly projects a single source of the goods. One may only determine whether the subject matter for which registration is sought is used as a trademark by reviewing such evidence as the specimens of use and any promotional material that may be of record in



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the application. *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992).

Sections 1, 2 and 45 of the Trademark Act clearly provide the statutory basis for refusal to register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods. See TMEP §1202.

Upon careful consideration of this record and the arguments of the attorneys, we conclude that applicant's asserted mark is not likely to be perceived as a mark for its mulch because it is used merely as informational matter advising purchasers of an intended use of the product--that the product is particularly suited for the cultivation of flowers. Moreover, it is placed with other similarly styled designs also indicating other intended uses of the product. This fact makes it all the more likely that the FLOWERS and daisy-like emblem here sought to be registered is and will be perceived as merely informational in nature--a quick and easy reference guide indicating an intended use of the product--and not as a trademark indicating origin of the product with applicant. Further, the promotional matter made of record by applicant (reproduced above) showing applicant's icons, one of which is the design here sought to be registered, indicates that

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applicant promotes these designs as "show[ing] you where to use the product and what to grow in it. Quick. Easy. And at a glance."

Accordingly, and in the absence of persuasive evidence that this asserted mark has become distinctive of applicant's garden mulch, we agree with the Examining Attorney that the asserted mark is unregistrable. See, for example, *In re Schwauss*, 217 USPQ 361 (TTAB 1983) (FRAGILE used on labels and bumper stickers does not function as a mark).

We also observe that applicant uses a "TM" notation with its asserted mark (as well as other designs). However, the presence of the letters "TM" cannot transform an otherwise unregistrable designation into a mark. *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); and *In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981). Finally, the fact that applicant may have succeeded in registering some of these designs (perhaps on different records) is not determinative of the question of registrability here. The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985), and even if some prior registrations had some characteristics similar to

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applicant's existing design, the allowance by this Office of such prior registrations does not bind the Board. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). As that Court stated:

Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board.

Decision: The refusal to register is affirmed.