

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	*	
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Plant Development Services, Inc.	*	Shaunia P. Carlyle, Esq.
	*	Examining Attorney
U.S. Application Serial No.: 88163672	*	Law Office 110
	*	
Mark: AUTUMN SUNSET	*	

RESPONSE TO OFFICE ACTION:
SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

Applicant Plant Development Services, Inc. (“Applicant”) has applied to register the mark AUTUMN SUNSET on the Principal Register (the “Mark”). In its initial Trademark Application, Applicant identified the goods to be associated with the Mark as “Live plants” under International Class 031. In this Response To Office Action, Applicant has amended the description of the goods, narrowing the variety of live plants to be associated with the Mark to “Live plants, namely, azaleas.”

In the Office Action, the Examining Attorney refused registration of Applicant’s Mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the mark in U.S. Registration No. 2060990 for AUTUMN SUNSET in connection with “live flowering rose plants” in International Class 031.

A refusal under Section 2(d) is generally predicated upon the determination that an applicant’s mark so resembles a registered mark as to be likely to cause confusion. Trademark Manual of Examining Procedure (“TMEP”) § 1207.01. The question is not whether people will confuse the marks, but whether the marks will confuse consumers into mistakenly believing that the goods originate from the same source. *Paula Payne Prods. Co. v. Johnson’s Publ’g Co.*, 473 F.2d 901, 902, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973); TMEP § 1207.01. In the seminal case

addressing a Section 2(d) likelihood of confusion analysis, *In re E. I. du Pont de Nemours & Co.*, the court established a number of factors to be considered in a likelihood of confusion determination. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973); TMEP § 1207.01. Of those factors, a key factor is the similarities or differences in the respective goods described in the application and the registration. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976); *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282 (T.T.A.B. 2009); TMEP § 1207.01. Applicant respectfully submits that because of the dissimilarity between Applicant's goods, being "live plants, namely, azaleas," and the prior registrant's goods, being "live flowering rose plants," together with the high degree of sophistication and care typically exercised by consumers who purchase those plants, it is unlikely that consumers would mistakenly believe that the respective goods originate from the same source.

As amended by this Response To Office Action, Applicant has limited the use of its Mark to a specific variety of live plants, being azaleas. The prior registrant's mark is likewise limited to an entirely different variety of live plants, being roses. Although both Applicant's azaleas and the prior registrant's roses are live plants, this shared feature is their only similarity. The two plants are markedly distinct in type, appearance, and landscaping purpose and use.

Courts have held that "even when two products or services fall within the same general field, it does not mean they are sufficiently similar to create a likelihood of confusion." *Harlem Wizards Entertainment Basketball, Inc.*, 952 F. Supp. at 1095 (finding that HARLEM WIZARDS' "show basketball" and WASHINGTON WIZARDS' "competitive basketball" were "markedly distinct" and that any similarity between the two basketball teams was superficial). Meaningful differences between the goods tends to negate consumer confusion, "even when the products are superficially within the same category." *Id.*; see also *Sunenblick v. Harrell*, 895 F. Supp. 616, 629

(S.D.N.Y. 1995), *aff'd* 101 F.3d 684 (2d Cir. 1996) (Table), *cert. denied*, 519 U.S. 964, 117 S. Ct. 386 (1996) (finding no confusion between jazz records and hip-hop records sold under the identical mark UPTOWN RECORDS even though the recordings were both musical products, because they were marketed to different consumers and sold in separate sections of record stores); *Swanson v. Georgetown Collection, Inc.*, No. 94-CV-1283, 1995 WL 72717, *12 (N.D.N.Y. Feb. 14, 1995) (holding that confusion was unlikely between the mark FARAWAY FRIENDS for porcelain dolls and FAR AWAY FRIENDS for cloth dolls); *and see General Mills Inc.*, 824 F. 2d at 627, 3 U.S.P.Q.2d at 1445 (no likelihood of confusion between APPLE RAISIN CRISP and OATMEAL RAISIN CRISP even though both marks identify ready-to-eat breakfast cereals that directly compete); TMEP §1207.01(a)(iv) ([T]here can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto.”).

Applicant’s Mark, AUTUMN SUNSET, has been used in commerce since at least as early as July, 2004, as a mark for a particular azalea cultivar (Exhibit 1) that is part of Applicant’s collection of azalea cultivars known and branded as Encore® azaleas. Encore® azaleas are so named because unlike traditional azaleas which bloom only once per year in the spring, Encore® azaleas have been cultivated to bloom in the spring, summer, and fall. (Exhibit 2). The Encore® collection of re-blooming azaleas currently contains thirty-one varieties of re-blooming azaleas. (Exhibit 3; see also <https://www.encoreazalea.com/the-collection>).

Azaleas are woody flowering shrubs. (Exhibit 4). Applicant’s azaleas are of the evergreen variety, meaning that they retain their foliage year-round, and are characterized by bright green leaves with a multi-season flower display. (Exhibit 5). Azaleas require minimal maintenance to stay healthy and produce attractive flowers and foliage year after year. (Exhibit 6). Because of

these qualities, consumers specifically seek out evergreen azaleas such as Applicant's re-blooming azaleas for use as permanent evergreen foundation plantings in the landscape. (See Exhibit 6).

Roses, by contrast, are not easy-care evergreen foundation shrubs, but are ornamental flowering perennials that can be upright, climbing, or trailing in growth habit, with stems that are often armed with sharp thorns. Not a plant for every gardener, roses are sought after, cultivated, and bred primarily by enthusiasts for their beautiful, unique, and fragrant flowers. (Exhibit 7). Devotees throughout the world have formed and join local, regional, national, and international clubs, organizations, and societies for the appreciation and cultivation of roses, and to support and promote rose horticulture, education and research. (See, e.g., <https://www.rose.org/>; www.worldrose.org; <http://www.rosemagazine.com/pages/rosesocieties.asp>; <https://www.planetnatural.com/rose-gardening-guru/societies-organizations/>; http://www.manhattanrosesociety.org/related_websites/rose_societies_and_clubs.html; <https://www.orangecountyrosesociety.org/>; <https://centralfloridarosesociety.org/>; <http://www.rosepetals.org/home.html>). But as the song goes, every rose has its thorn.¹ Roses can be difficult to grow and demand a fair amount of maintenance and care to thrive. (Exhibit 8). They require a lot of sun, well-drained soil amended with compost, adequate water, regular fertilizing, regular pruning, mulching, and insect and disease control. (See Exhibit 8). Roses, being perennials, go dormant in winter and must be properly prepared and protected during the winter in order to grow back the following spring. (Exhibit 9). Because they are challenging to grow, and perform well only under a special combination of sun, soil, water, fertilizer, pruning, insect and disease prevention, and winterizing, consumers do not purchase and plant roses for permanent evergreen foundation shrubbery. Instead, roses are typically grown and cultivated by enthusiasts

¹ "Every Rose Has Its Thorn" by Poison.

who admire their beauty and have the know-how, time, patience, and skill needed for their successful performance in the garden.

While nurseries and retail garden centers may carry permanent shrubs such as azaleas as well as specialty plants such as roses, they are generally stocked in different sections of the nursery or store because they serve different purposes in the landscape - azaleas are typically stocked together with other evergreen foundation plants while specialty plants like roses are stocked in a different area. Each plant type attracts a different kind of consumer who is seeking to buy for a different landscape purpose.

Consumers of both azaleas and roses tend to be knowledgeable and sophisticated and unlikely to confuse the source of an azalea with the source of a rose. Azaleas, like other landscape foundation plants, are often purchased and planted in quantities and, depending on the number purchased, can be costly. For example, the retail price for Applicant's azaleas ranges from \$19.98 per plant for a 1-gallon plant to \$39.98 per plant for a 3-gallon plant. (See Exhibit 10). Given the significant cost and the planning, time, and labor required to complete a landscape project with foundation plants like azaleas, consumers do not typically buy azaleas on impulse, but select and purchase the plants following significant research and consideration. Similarly, roses are purchased by avid gardeners who have researched the types of roses they desire to grow, the necessary growing conditions and the maintenance and care requirements, and who are willing to commit the time, labor, and attention necessary for the roses' success in the garden.

Circumstances indicating consumer sophistication and care in purchasing tend to minimize likelihood of confusion. TMEP § 1207.01(d)(vii); *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion

merely because of the similarity between the marks NARCO and NARKOMED); *see also In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers). Applicant submits that consumers encountering Applicant's Mark and the prior registrant's mark are sophisticated consumers capable of readily distinguishing an azalea from a rose and easily differentiating the marks used to identify the source of each of these goods. Given the considerable differences between roses and azaleas and the degree of investigation, knowledge, and sophistication exercised by consumers in purchasing these plants, buyers are not likely to mistakenly believe that Applicant's azaleas and the prior registrant's roses originate from the same source.

For all of the reasons set forth hereinabove, Applicant submits that the dissimilarities between the respective goods are sufficient to preclude likelihood of confusion or mistake under Section 2(d). Applicant respectfully requests that the examining attorney approve Applicant's Mark for publication.