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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OMS Investments, Inc.

Serial No. 75/660,252

Melville Owen and Koorosh Afshari of Owen Wickersham &
Erickson, P.C. for OMS Investments, Inc.

Marlene Bell, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Hanak, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

OMS Investments, Inc. seeks registration of the term
WINTERIZER on the Principal Register as used in connection
with "lawn fertilizer for agricultural and domestic use;
combination of lawn fertilizer and herbicide for
agricultural and domestic use," in International Class 1.¹
As filed, the initial application papers claimed that this

¹ Application Serial No. 75/660,252 was filed on March 15,
1999, based upon an amended claim of use in commerce since at
least as early as October 1985 (see amended declaration of
February 7, 2000, based upon amended identification of goods).

term had acquired distinctiveness as a source indicator consistent with Section 2(f) of the Lanham Act.

This case is now before the Board on appeal from the final refusal to register based upon the ground that applicant's showing of acquired distinctiveness is insufficient to overcome the highly descriptive nature of the mark. Applicant and the Trademark Examining Attorney have briefed the issues, but applicant did not request an oral hearing.

This decision involves weighing the degree of descriptiveness of the term WINTERIZER against the volume of evidence applicant has proffered to show acquitted distinctiveness. While both sides of the balance have been argued vigorously by applicant and by the Trademark Examining Attorney, in a close decision, we reverse the Trademark Examining Attorney's refusal to register.

By applying with an initial claim of acquired distinctiveness, applicant has conceded that the term "Winterizer" is merely descriptive of (although not generic for) its goods. Such a claim is tantamount to an admission that the term "Winterizer" is not inherently distinctive and therefore is unregistrable on the Principal Register, in light of the prohibition in Section 2(e)(1) against merely descriptive marks, absent a showing of acquired distinctiveness pursuant to Section 2(f). See Yamaha

International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["[w]here, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact"]; and TMEP §1212.02(b).

As our principal reviewing court has noted with respect to the possible registrability of descriptive terms which may nevertheless acquire distinctiveness, "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has obtained secondary meaning." Yamaha International Corp. v. Hoshino Gakki Co. Ltd., *supra* at 6 USPQ2d 1008. See In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990) at n. 4. It is settled, moreover, that the applicant has the burden of proof with respect to establishing a *prima facie* case that a merely descriptive term has acquired distinctiveness. For instance, as stated in Yamaha, "the ultimate burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on ... [the] applicant." Id.

We turn first to a consideration of exactly where on the continuum of distinctiveness the applied-for mark falls. The word "winterize" is a common English language word. It is a verb meaning "to prepare for winter."² As seen in the

² **Winterize** [transitive verb]: to make ready for winter or winter use... Webster's Third New International Dictionary of the English Language Unabridged (1993).

second of these dictionary entries, the word "winterizer" is itself listed as a dictionary word without a definitional entry. Logically, it appears to be a noun meaning 'a thing that prepares something else for winter.' The recurrent theme in applicant's submissions, as well as in more than a hundred LEXIS/NEXIS hits submitted by the Trademark Examining Attorney, is that applicant's product is a fertilizer high in potassium that is recommended for use on lawns in late-fall as it is designed to help the turf develop a stronger root system during the cold of the winter months.

As presented on the computer-generated pages of NEXIS, many of the newspaper stories appear to use the term "winterizer" in a highly descriptive, if not generic manner. However, at the time of briefing, the Trademark Examining Attorney did not take the position that this term is generic for applicant's goods (and she is certainly not required to do so in order to prevail herein). Nonetheless, we begin our discussion by clarifying that the Trademark Examining Attorney appears to have conceded the capability of this term to function as a source indicator.

Winterize (verb): to prepare (an automobile, house, etc.) for cold weather... **winterizer** (noun), The Random House Dictionary of the English Language, Second Ed. Unabridged.

On the other hand, applicant continues to argue that there is no clear evidence that the term "Winterizer" is even "highly descriptive." However, there are more than one hundred LEXIS/NEXIS stories - many of them local newspaper articles distributed in cities and towns across the United States - demonstrating what appears to be non-trademark usages of this term for fall-time fertilizers designed for one's turf.

Writers often use the word in quotation marks (e.g., "winterizer" fertilizer, "winterizer-style" fertilizer or "winterizer-type" fertilizer). Some of the articles referred specifically to "Winterizer" as Scott's branded product. Conversely, few of the hits contained similar references to other branded lawn care products. In any case, based upon a thorough review of this record, it is not clear whether, and if so, how many, of applicant's competitors may be using this term in a highly descriptive or generic manner on their own goods.³

When considering carefully the substantial amount of LEXIS/NEXIS evidence on which the Trademark Examining Attorney relied, we do not agree with applicant's position

³ On this point, we would urge the Trademark Examining Attorney in a similar case to supplement the NEXIS evidence with Internet search results that might show more clearly the extent of third-party usage of this term in a descriptive manner within product names for their own competing lawn care products.

that these NEXIS articles "apparently authored by lawn-and-garden type reporters" do not reflect the knowledge of the average American consumer. While it is understandable that the average cosmetics customers may not know of "Vittel" - a place name for a small French town rarely mentioned in the American press,⁴ the frequent use of a highly-descriptive (and arguably generic), English-language word in these many newspaper articles reinforces the shared understanding of dozens of newspaper writers and the many consumers who read these articles that the term conveys information about a characteristic or function of the identified lawn care products.

Applicant's continues its criticism of the LEXIS/NEXIS evidence, charging that "many of the articles cited by the Examining Attorney expressly refer to WINTERIZER as a brand and thus a source indicator." Applicant then points out a number of examples:

- Good fall weather in North America helped spur sales in nearly all categories, especially late fall lawn fertilizer products like Scotts Winterizer™. *Financial Times Information*, January 14, 2002.
- October-November: Winterizer - Fall Lawn Fertilizer. *The Chicago Sun-Times*, April 8, 2001.
- Scotts 17.05-pound bag of Winterizer with weed control. *Daily Press*, October 6, 1999.

⁴ Accord In re Societe Generale des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Accordingly, applicant takes the position that the Trademark Examining Attorney's "'evidence' that Appellant's mark is 'highly descriptive', is at best, inconclusive and contradictory and far from clear proof that the mark WINTERIZER has not established a *prima facie* case of acquired distinctiveness." (Applicant's reply brief, p. 5). Applicant herein cites to the court's determination of In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) for the proposition that wholesale reliance on NEXIS entries is improper given the contradictory nature of the articles retrieved by NEXIS and relied upon by the examining attorney in that case (the "mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence" that the mark was highly descriptive/generic).

In fairness to the position taken by the Trademark Examining Attorney herein, it should be made clear that the *majority* of the NEXIS uses in the record do not contain recognizable references to applicant or applicant's products. The term "winterizer" (lower case, and as a noun) is repeatedly used to describe a particular type of lawn care fertilizer applied in the fall. In fact, one could actually conclude from a review of all the NEXIS hits that the term is used throughout the lawn care industry to

describe goods such as applicant offers. Hence, given what the totality of the evidence in the record demonstrates, we find that applicant's applied-for term is at the very least, highly descriptive.

As a result of this finding, the sole remaining issue in this appeal is whether the highly-descriptive term WINTERIZER has acquired sufficient distinctiveness to be registered under the provisions of Section 2(f) of the Lanham Act.

Applicant has supplied an extensive array of evidence of acquired distinctiveness demonstrating:

- More than \$137 million worth of WINTERIZER brand products sold since 1997.
- Applicant's sales of WINTERIZER brand products have increased by 1700% over the past sixteen years.
- By 1997/1998, the WINTERIZER brand fertilizer products had captured more than 60% of the entire U.S. fall/winter fertilizer market making it the most popular brand of fall/winter fertilizer in the United States.
- During the five-year period of 1997-2002, applicant expended more than \$12 million on advertising and promoting the WINTERIZER brand in various media, including regularly advertising the brand on such high profile TV/cable programs as:

1. *Good Morning America*
2. *Law and Order*
3. *World News With Peter Jennings*
4. *NBC's Nightly News*
5. *Today Show*
6. *Spin City*
7. *48 Hours*
8. *Nash Bridges*
9. *20/20*
10. *NFL Football*

11. *Dateline*
12. *The Cosby Show*
13. *Diagnosis Murder*
14. *Major League Baseball Playoffs*
15. *College Football*
16. *PGA Weekday Afternoon*
17. *JAG*
18. *ESPN Sports Center*
19. *Breeder's Cup*
20. *ESPN Major League Soccer Pennant Race*

- Applicant's print and television promotions specifically promote the WINTERIZER mark as one of applicant's source indicators by linking the mark to applicant through visual placement and textual description.
- The WINTERIZER advertising program has made fundamental changes in consumer behavior, causing a large segment of consumers to fertilize their lawns during fall.
- Applicant's *Lawn Care* magazine, reaching more than 7 million consumers annually, has continuously and prominently featured/promoted the WINTERIZER mark.
- Applicant's web site, which has continuously and prominently featured and promoted the WINTERIZER mark received more than 15 million hits in 1999 alone.
- Applicant's advertising efforts, including those associated with the WINTERIZER brand fertilizer, which is one of the applicant's core products, were recently projected to create 2.5 billion consumer impressions annually.
- Extensive use of various brochures and point of purchase signage, clearly indicating applicant as the source of WINTERIZER brand fertilizer.
- Extensive promotion of the WINTERIZER mark in applicant's catalogs with descriptive text and images stresses that WINTERIZER brand fertilizer is exclusive to applicant.

Nonetheless, without discussing or refuting this collection of evidence, the Trademark Examining Attorney simply takes the position that she "is not persuaded that a *prima facie* case of acquired distinctiveness has been established because the proposed mark is highly descriptive,

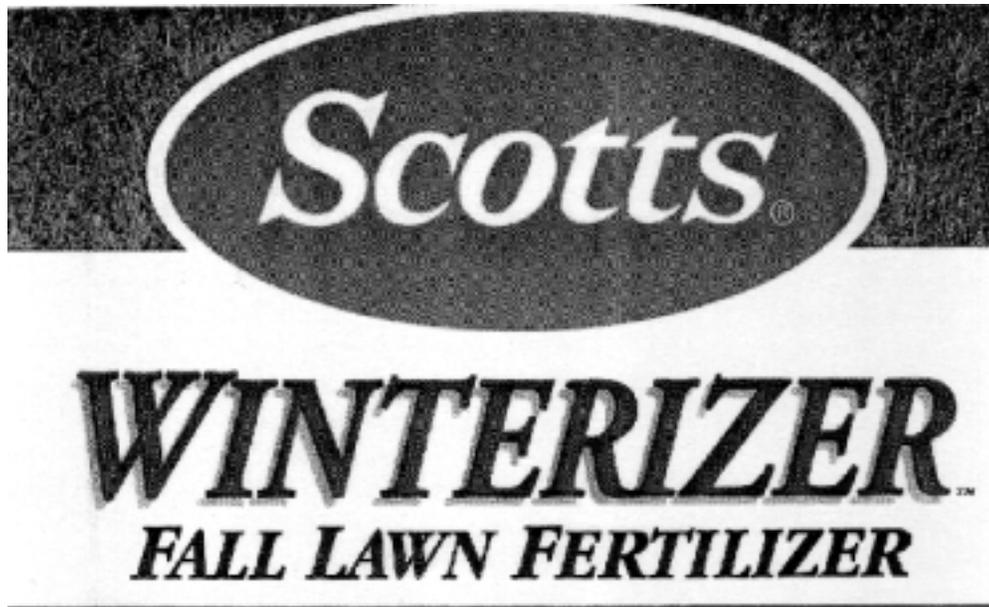
as evidenced by the numerous articles from the LEXIS/NEXIS Research Database, that refer to WINTERIZER as an actual type of fertilizer." (Trademark Examining Attorney's appeal brief, p. 7).

It is certainly true, for example, that we do not have benefit of a survey clarifying how the relevant public perceives this term when used on the identified goods. On the other hand, applicant is not required to conduct and submit a survey, and we must determine on the evidence of record whether applicant has met its burden of persuasion under Section 2(f) on the issue of acquired distinctiveness.

We turn then to a consideration of how applicant uses the "Winterizer" term on the specimens of record:



and



These cut-out portions of applicant's fourteen pound bags of fertilizer demonstrate use of applicant's house mark (Scotts®), in close proximity to the term applicant argues is its product mark (Winterizer™), shown in relatively large, red, bold and shadowed letters, followed in smaller letter by the category of the goods (Fall Lawn Fertilizer). Moreover, in all of applicant's promotional materials contained in this record, whether directed to stockholders, retailers or consumers, applicant has clearly demonstrated that its own manner of use is consistent with valid trademark usage.

The record shows that applicant has sold more than \$137 million worth of WINTERIZER brand product since 1997 alone. Furthermore, applicant has provided evidence of substantial advertising activity specifically directed to creating acquired distinctiveness for this term as used on fertilizer. In the past five-year period for which the

record contains data, applicant has spent more than \$12 million advertising its WINTERIZER brand. We find this volume of promotion and sales to be substantial.

Moreover, applicant has also provided some context by which we can evaluate its conclusion that such figures represent substantial sales. Specifically, applicant's WINTERIZER fertilizer has captured more than 60% market share during the time period for which sales figures were furnished. Hence, the volumes of WINTERIZER products sales demonstrated by applicant are not merely substantial in the abstract, but the record shows that applicant is the dominant player in this niche market - a specialized market it appears to have helped to create.

We find that this is a close case, inasmuch as the mark is highly descriptive and yet applicant has proffered a substantial showing of acquired distinctiveness that has not been refuted by the Trademark Examining Attorney. The record suggests that applicant may have created substantial demand for a new type of product, and has managed to control a substantial share of that newly-developed market. While acknowledging that many newspaper writers use this term to describe any fall fertilizer for lawns, we conclude that appellant has proven acquired distinctiveness by a preponderance of the evidence See Tone Brothers, Inc. v.

Sysco Corp., 31 USPQ2d 1321 (Fed. Cir. 1994) (the party attempting to establish legal protection for its mark has the burden of proving secondary meaning by a preponderance of the evidence).

Decision: The refusal to register under Section 2(f) of the Act is reversed.