

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 17, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Solid Waste Management Coordinating Board
v.
Greener Pastures Development Corporation

Opposition No. 91174062
to application Serial No. 78758826
filed on November 21, 2005

Garrett M. Weber of Lindquist & Vennum, PLLP for Solid Waste Management Coordinating Board.

Jeffrey D. Shewchuk for Greener Pastures Development Corporation.

Before Seeherman, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Greener Pastures Development Corporation, seeks registration of the mark THE GREEN GUARDIAN (in standard character form) for services ultimately identified in the application as "lawn and landscape maintenance services including weed management, fertilizing, seeding, aeration, fungus and lawn and garden pest control services, and mold and salt damage repair; lawn and landscape

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information services, namely, providing, online, telephonically or in-person, advice and consultation on proper weed management procedures, proper fertilizing procedures, proper seeding procedures, proper aeration procedures, proper fungus and pest control procedures, proper mold and salt damage repair procedures, proper mowing procedures, proper watering procedures, and proper lawn and garden waste disposal procedures" in International Class 44.¹

Opposer, Solid Waste Management Coordinating Board, opposed registration of applicant's mark on the grounds that, as applied to applicant's services, the mark so resembles opposer's previously used mark GREEN GUARDIAN for its services "for helping citizens understand the urgent need to make environmentally-responsible purchasing and disposal decisions in their daily lives and for promoting public awareness regarding the importance of managing waste and recycling" as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d). In addition, opposer alleges fraud based on the allegations that applicant was not using the mark THE GREEN GUARDIAN in connection with the information services

¹ Serial No. 78758826, filed November 21, 2005. The application is based on an allegation of first use and use in commerce in 2000 under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

relating to "proper lawn and garden waste disposal procedures" at the time it filed its use-based application.²

Applicant filed an answer by which it admitted the allegations that opposer "openly advertised and promoted using the mark GREEN GUARDIAN prior to applicant's filing date" and that "the services identified in [applicant's] application are substantially related to environmental information and education services including information services relating to proper lawn and garden waste disposal procedures."

Applicant otherwise denied the salient allegations of the notice of opposition, including the allegations "concerning the continuous nature of [opposer's] use, concerning any usage by [opposer] of the mark GREEN GUARDIAN as a trademark, concerning any usage by opposer of the term GREEN GUARDIAN as a tradename, and concerning what services are or have been provided by opposer under the GREEN GUARDIAN mark."

The evidence of record consists of the pleadings herein; the file of the opposed application; the testimony

² Opposer also pleaded fraud based on the allegations that applicant "had detailed knowledge of [opposer's] use and rights in the substantially identical mark GREEN GUARDIAN for confusingly similar services prior to [applicant's] November 21, 2005 filing of the declaration" in its application attesting that "no other person, firm, corporation, or association has the right to use the mark in commerce..." However, opposer did not address these allegations in its brief and we consider the fraud claim based on these allegations to be waived.

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depositions (with exhibits) taken by opposer of Victoria A. Reinhardt, a Commissioner on the Ramsey County Board and member of opposer, taken on September 5, 2007, and Linda Gondringer, senior associate at Richardson, Richter & Associates, a consulting firm, taken on September 13, 2007; the testimony depositions (with exhibits) taken by applicant of Mark R. Miles, applicant's owner, James A. Vandergriend, applicant's independent CPA, and Paul Overson, an employee of Independent Delivery Service which prints and delivers advertising flyers for applicant. In addition, opposer submitted a notice of reliance upon applicant's responses to opposer's first set of interrogatories and requests for admission, and the discovery deposition of applicant's owner Mr. Mark R. Miles.

THE PARTIES

Opposer is "a joint powers board made up of six counties in the Minneapolis-St. Paul, Minnesota metropolitan area." Br. p. 2; Gondringer Test. p. 7. Opposer and its members provide information to the public on recycling and waste disposal.

Applicant provides "organic lawn care services, lawn consulting services, weed remediation, fertilizer products, organic protein extracts, insect repellants, geese repellants." Miles Test. p. 5. Applicant has operated

under the name Greener Pastures Development Corporation since approximately 1988-1989. Miles Test. p. 8.

STANDING

As discussed below, opposer has shown that it and its members use the mark GREEN GUARDIAN in connection with "helping citizens understand the urgent need to make environmentally-responsible purchasing and disposal decisions in their daily lives and for promoting public awareness regarding the importance of managing waste and recycling" services and has demonstrated a real interest in preventing registration of the proposed mark. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Thus, opposer has established its standing.

PRIORITY

Turning first to the issue of priority, because opposer has not pleaded any registrations, opposer must rely on its common law use to prove its priority. The evidence of record establishes opposer's first use of the mark GREEN GUARDIAN in connection with its public service of providing information on recycling and waste disposal by one of its members on December 17, 2002. See e.g., *Gondringer Test.* p. 11; *Reinhardt Test.* pp. 23-24. On this date, the mark was

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used in a display at the visitors center in the Hennepin County Environmental Services Building. Id. The display provided information on proper waste management.³ Id. Thereafter, the "Green Guardian campaign was officially or publicly launched to the media in June of 2003." Gondringer p. 10. The mark is used by opposer and its member counties and municipalities. In addition, one of its members, Dakota County, on behalf of opposer, obtained a Minnesota state trademark registration for GREENGUARDIAN.COM "KNOW WHAT TO THROW."⁴ Gondringer Test. p. 49. Opposer provides its services through a variety of media but the website is the "centerpiece of its campaign." Gondringer Test. p. 13. Opposer also disseminates information through brochures handed out at events, including the Living Green Expo. Id. p. 14.

Applicant asserts it first used the mark THE GREEN GUARDIAN in connection with its services in the year 2000 and continuously thereafter. Applicant provided, inter

³ Although applicant did not object to exhibit one, the photograph of the display, or Ms. Gondringer's testimony regarding this exhibit, applicant's counsel did cross examine the witness about this exhibit. Applicant objected for the first time in its brief to the presumed date appearing in the photo as inadmissible hearsay. Applicant's objection is untimely. However, we have considered applicant's arguments to the extent they challenge the probative value of the photograph. We find the combined testimony of the two witnesses sufficient to conclude that this display was used on that date. The extent of public exposure on that date is, however, not known.

⁴ Although filed "on behalf of" opposer the registration is in the name of Dakota County.

alia, the following testimony and documentary evidence in support of its assertion of prior use. Applicant submitted an advertising flyer dating from 2000 that includes the excerpt shown below.

Green Guardian — Lawn Service Options for 2000

GPD 00068

- ◆ Worry Free Program - 7 organic fertilizer and natural weed control treatments, lime, overseeding, core aeration & fungus control.
- ◆ Premium Program - 5 applications of organic fertilizer and natural weed controls, lime & core aeration.
- ◆ Tiger by the Tail Premium Program - 2 organic fertilizer/weed control applications, 2 organic natural weed controls, lime & core aeration.
- ◆ Tiger by the Tail Basic Program - 2 organic fertilizer/weed control applications, 2 organic weed controls.
- ◆ Standard Program - 5 organic fertilizer and natural weed control treatments.
- ◆ Basic Program - 4 organic fertilizer and natural weed control treatments.
- ◆ Budget Program - 3 organic fertilizer and natural weed control treatments.
- ◆ Custom Programs - If none of the above programs are exactly what you have in mind, let us customize a program just for your lawn or maybe just get started with one of our **SPRING SPECIALS**.

Call **651-646-2900** or **612-331-8600** TODAY so you can have **GREENER PASTURES**

Applicant testified as follows:

Q. ...Can you identify that document of record?

A. Yes. That's one of our Greener Pastures' spring flyers.

Q. How was that document used?

A. That we put out usually hundreds of thousands of them to a million each spring using different delivery services.

Q. Do you recall what delivery service you used for this particular flyer?

A. Many of them. IDS was one of them.

Q. IDS refers to who?

A. Independent Delivery Service. The other ones are companies that are no longer in business. I

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don't remember their names. But then we had others that were going through local newspapers, like a city newspaper. We've had them inserted into the paper.

Q. What year was this particular flyer used?

A. This was the year 2000.

Q. And what does it describe the Green Guardian mark as being associated with?

A. That was our first foray into trying to get people to understand what they had to do to avoid using chemicals. So we had set up a plan, a weed management plan that went through and detailed exactly what they had to do for their part, what we had to do for our part kind of on how we are going to work together to avoid using chemicals.

Q. How did the Green Guardian mark tie into that?

A. We called it the Green Guardian Protection Plan.

Miles Test. pp. 12-13

Applicant also submitted an invoice from 2001 that includes an entry for an "Organic Weed Control Plan" which is a service provided under THE GREEN GUARDIAN mark and an information sheet that includes the mark THE GREEN GUARDIAN.

The following testimony relates to these exhibits.

Q. Does this reflect the providing of goods or services under the Green Guardian mark?

A. Yes.

Q. Where does it do so?

A. Well, the organic weed control plan was what we implement and then attach to their first order of service for the season.

Q. What's the date on this invoice?

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A. The order date is October 23rd of 2000. It's one of our invoice numbers 133. It's just when we began to write this computer software.

Q. When were the services, to your knowledge, or goods provided?

A. On the schedule or ship date, that's when we anticipate delivering that service. So on the first one would have been on May 7 roughly in 2001....

Q. And how do you know that this included the Green Guardian Protection Plan?

A. Because we had two sheets that we would include with the program so that we would make sure that our customers weren't going to be becoming hostile towards us when they didn't get what they expected with Chemlawn.

Q. What was the content of those two sheets?

A. The general gist was here's what you have to do to take care of your lawn, here's what we do. Just an educational piece on kind of setting expectations to achieve desired results.

Q. I'm handing you what has been marked as Greener Pastures Development Corporation Exhibit Number 10. It was also produced at GPD 148. Can you identify that document for the record?

A. Yes. This is the Green Guardian Protection Plan also referenced under the organic weed control program.

Q. Is that the type of document that you were referring to earlier that made up some of these advertising expenses reflected in your corporate income tax returns and was provided with the invoice represented on Exhibit 9?

A. Yeah, this would be one of the things that we printed and distributed to our existing customers.

Miles Test. pp. 26-28.

Applicant also testified as to sales and advertising under THE GREEN GUARDIAN mark.

Q. To your knowledge, starting with the year 2000, approximately what portion of the sales dollars amounts would be involved with the Green Guardian trademark?

A. Under the lawn program, intro programs, product delivery, commercial services and commercial products. That would be 100 percent.

Q. So tell me what those dollar amounts are?

A. Well, for the lawn program in 2000, [redacted] The intro program, [redacted] Product delivery, [redacted] Commercial services, [redacted] And then commercial products is [redacted].⁵

Q. And for the that roughly [redacted] and change of sales how was the Green Guardian mark used?

A. That was used in the protection plan on trying to educate our clients that are buying the products on how they need to represent it to their customers so that they don't have angry or disappointed customers when things aren't going to work exactly as they were used to using chemicals.

Miles Test. pp.17-18.

In addition, applicant submitted a label for fertilizer used in 2002 that includes the following statement in the directions for use:

Before applying it is recommended that you measure an area of 100 meter square. Then apply 4 liters of water to this area to get a feel for the correct application rate. Please read the 'Green Guardian Protection Plan" at <http://www.greenerpast.com/lib/ggpp.doc> and follow the program steps to achieve a successful program.

⁵ These figures were filed under seal in conformance with the parties' protective order. Suffice it so say they are not insubstantial.

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Over the years applicant's use of THE GREEN GUARDIAN expanded to other media including its website in 2002. Miles Test. p. 52.

Applicant also took the testimony of Paul Overson, a sales representative of Independent Delivery Service that delivered and printed applicant's advertising flyers, who testified as follows:

Q. What has Independent Delivery Service done for Greener Pastures Development Corporation?

A. Well primarily just delivering and printing flyers advertising flyers.

A. To your knowledge, have any of those flyers included the trademark GREEN GUARDIAN or The Green Guardian.

A. Yes.

Q. When, to your knowledge, did that begin, the delivery of flyers by Independent Delivery Service of flyers that contained the mark The Green Guardian?

A. I don't recall a specific date. I do recall the building that Mark was in Oakdale Minnesota and using the little logo on the flyers and me commenting to my operations guys that we put the name Greener Pastures on it because that's the corporate name that they were previously using. And I remember telling the guys, okay, this is a Green Guardian flyer but it's still Greener Pastures. I don't have a date again, but it was in the building in Oakdale, Minnesota.

Overson Test. p. 5.

Applicant was located in the Oakdale, Minnesota office from September 11, 2001 through fall 2004. Miles Test. pp. 11-12.

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With regard to the 2000 flyer, opposer asserts that "Applicant can provide no documentary evidence whatsoever that this flyer was ever actually distributed to anyone prior to Opposer's established date of first use in 2002," noting that "every single record relating to the use of this flyer in advertising or being delivered - which Miles claims to have maintained - were mysteriously stolen during a purported robbery while Applicant was being audited by the IRS." Rebuttal Br. pp. 4-5. See generally Miles Disc. Dep. Further, with regard to the "leave behind" flyer referencing THE GREEN GUARDIAN protection plan, opposer argues that "they are undated and therefore have no relevance to priority of use." Rebuttal Br. pp. 5-6. Opposer also argues that the documents do not "constitute evidence of protectable service mark use" in that the provision of "general information or instruction as to the purpose and uses of applicant's goods is merely incidental to the sale of goods and is not a separate informational service." Rebuttal Br. 6.

While there may not be additional documentary evidence to support the assertion of use of the flyer in 2000, the flyer itself bears the date of 2000, which is documentary evidence in itself. Moreover, the testimony of a witness, even without documentary evidence, can be sufficient to prove priority. See 3 J. Thomas McCarthy: McCarthy on

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Trademarks and Unfair Competition § 16.06(2) (4th ed. updated 2008). The testimony submitted by applicant makes clear that applicant used the mark THE GREEN GUARDIAN in connection with its lawn care services prior to opposer's claimed first use date of December 17, 2002. We find that Mr. Miles' testimony is not characterized by contradictions or inconsistencies. Further, although the testimony from Mr. Overson is somewhat general as to the timeframe in which Independent Delivery Service distributed applicant's flyers, it serves to bolster applicant's testimony and evidence that such flyers were printed and distributed. We also find that the flyer and leave behind documents evidence service mark use in that the mark is associated with the services.

Opposer also argues that applicant's actions "do not comport with its claim that it owns THE GREEN GUARDIAN or that it used it prior to [opposer's] undisputed use in 2002" in that after learning of opposer's use of the mark applicant's owner testified that he "was not concerned 'in the least' ... and requested permission from opposer to use the mark 'GREEN GUARDIAN' and logo and to 'connect up' with opposer to promote his environmentally-conscious lawn care company." Br. p. 6. In support of this contention, opposer points to the testimony of Mr. Miles and Ms. Gondringer, regarding the conversations they had after Mr. Miles had encountered opposer at a trade expo.

We first note that, reading the testimony, it is not clear whether or not Ms. Gondringer believed Mr. Miles was asking to use the words GREEN GUARDIAN or the Spartan design referred to as GREEN GUARDIAN; however, it is clear from Mr. Miles' testimony that he was asking to use only opposer's design of a Spartan and to somehow combine their efforts to further promote to the public environmentally-sound practices.⁶ Moreover, this is consistent with the rest of the evidence supporting Mr. Miles' assertion of trademark rights in the word mark THE GREEN GUARDIAN. Taken as a whole, we do not find in the testimony any implication that applicant did not believe it had trademark rights in THE GREEN GUARDIAN mark.

Viewing the record as a whole, we find that applicant used the mark for its services prior to opposer's asserted December 17, 2002 date of first use, therefore, opposer has not established its priority with respect to its common law rights in the mark GREEN GUARDIAN.

In view thereof, we need not address the issue of likelihood of confusion.

FRAUD

Opposer claims applicant committed fraud inasmuch as applicant, in signing the use-based application, claimed use

⁶ The question of rights in a logo design is not in issue in this case.

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in connection with "proper lawn and garden waste disposal procedures" when it had not in fact made such use.

In order for opposer to prevail on a claim of fraud, opposer must prove that applicant knowingly made "false, material representations of fact in connection with" the application, filed November 21, 2005. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). See also *Mister Leonard Inc. v. Jacques Leonard Couture Inc.*, 23 USPQ2d 1064, 1065 (TTAB 1992); *Hachette Filipacchi Presse v. Elle Belle, LLC*, 85 USPQ2d 1090 (TTAB 2007) (statements regarding the use of the mark on goods and services are material to issuance and maintenance of a registration covering such goods and services). That is, to constitute fraud on the United States Patent and Trademark Office (USPTO), a statement must be (1) false, (2) made knowingly, and (3) a material representation. Moreover, the charge of fraud upon the USPTO must be established by clear and convincing evidence. See *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). See also *Smith International Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981) ("It thus appears that the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging

party"). Fraud will not lie if it is proven that the statement, though false, was made with a reasonable and honest belief that it was true. See Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon), 43 USPQ2d 1440, 1444 (TTAB 1997) (defendant "held, at the time she signed the application oath, an honest, good faith belief that her corporation ... as the senior user of the registered mark, was the owner of the mark"). "[P]roof of specific intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car Inc., 17 USPQ2d 1398, 1400 (S.D. Fla. 1990). See also Torres, supra, and Medinol Ltd. v. Neuro Vasx Inc., 67 USPQ2d 1205 (TTAB 2003).

In support of this claim opposer relies entirely on Mr. Miles' following testimony:

Q. How do you - what type of advice do you give to people on proper lawn and garden waste disposal procedures, if any?

A. I don't.

Q. You don't?

A. Are you talking as in composting or something of that nature?

Q. I'm asking what services you provided as of November 2005 about proper lawn and garden waste disposal procedures, if any?

A. I would say zero.

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However, Mr. Miles immediately clarifies this statement:

Q. How were those services provided, the lawn and landscape information services?

A. Well, that's provided in a number of ways, but commonly it's verbal and then, also, whatever documents we have we - if they request them then we'll mail them.

Q. How do you - what type of advice do you give to people on proper lawn and garden waste disposal procedures, if any?

A. I don't.

Q. You don't?

A. Are you talking as in composting or something of that nature?

Q. I'm asking what services you provided as of November 2005 about proper lawn and garden waste disposal procedures, if any?

A. I would say zero.

Q. Have you gotten any -

A. I may have one exception to that last one, though.

Q. What?

A. When we're talking about waste disposal of organic material, we don't like them hauling it away. We want them to mulch it into the grass. You know, don't collect your clippings, that's valuable organic matter and will help retain moisture and soften the soil for better root development and a healthier lawn.

Miles Disc. Dep. pp. 55-57.

We find this sufficient to support the identification "proper lawn and garden waste disposal services" which is part of a broad array of information and advice services

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regarding lawn care as identified in the application. The information regarding the retention and mulching of clippings falls within the parameter of information on "proper lawn and garden waste disposal procedures." Opposer argues further that this statement only goes to the present and cannot support use prior to the signing of the application. We do not find the statement to be limited to the present but rather encompasses applicant's services since it began offering lawn care services in 2000. In view thereof, we find applicant has not committed fraud.

Decision: The opposition is dismissed on all claims.