

PTO Form 1930 (Rev 9/2007)

OMB No. 0661-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77541687
LAW OFFICE ASSIGNED	LAW OFFICE 105
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>REMARKS</u></p> <p>In the Office Action issued June 9, 2009, the Examining Attorney maintained the refusal to register the mark LIVING EARTH (“Applicant’s Mark”) on the basis of a perceived likelihood of confusion with Registration No. 3,289,351 for LIVING SOIL (the “Cited Mark,” and collectively with Applicant’s Mark, the “Marks”) for the services identified in International Class 001. The Examining Attorney also maintained the requirement that Applicant disclaim “EARTH” in Applicant’s Mark in connection with the Class 001 goods. For the reasons given below, Applicant respectfully disagrees with the Examining Attorney’s position and requests reconsideration of both the refusal to register and the disclaimer requirement and seeks approval of Applicant’s Application for publication</p>	
<p><u>DISCUSSION</u></p> <p>I. <u>THE CITED MARK PEACEFULLY COEXISTS WITH A NUMBER OF SIMILAR MARKS</u></p> <p>As discussed in Applicant’s first Response to Office Action dated May 15, 2009, the Cited Mark peacefully coexists with a number of marks containing identical or similar elements for soil amendments, potting soil, fertilizers and related goods, and the Cited Mark is therefore entitled to only</p>	

a narrow scope of protection. Applicant notes in particular the marks set forth below:

Mark	Application/ Registration No.	Goods/Services	Owner
LIVE EARTH	3,638,713	Soil amendments and fertilizers (CI 01)	Live Earth Products, Inc.
LIVING MULCH (Disclaims "MULCH")	3,456,111	Growing media and potting soil for plants, namely, earthworm castings compost and compost (IC 01)	EarthSweet, Inc.
DR. SUBLER'S LIVING SOIL (Disclaims "LIVING SOIL")	2,912,899	Natural, organic and synthetic soil additives; plant food supplements; soil amendments; soil conditioners; and fertilizers, all for domestic and commercial plant care, gardening, landscaping, horticultural and agricultural use (IC 01)	Pacific Garden Company
LIV-E-ARTH	2,189,793	Soil amendments and fertilizers for agricultural and horticultural use (CI 01) Mineral supplements (CI 05)	Live Earth Products, Inc.

Applicant respectfully submits that the Examining Attorney neglected to give sufficient consideration and weight to this evidence of coexistence. Widespread third-party use of similar terms for similar goods or services militates against a finding of confusing similarity. *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986); *see also Loctite Corp. v. Tubbs Cordage Co.*, 175 U.S.P.Q. 663, 665-66 (T.T.A.B. 1972) (fifteen similar third-party registrations, some for hardware items, is evidence that can help narrow the scope of protection afforded a mark for specialty household and industrial goods). The fact that the Cited Mark is able to peacefully coexist with such highly similar marks for nearly identical goods strongly indicates that consumers are able to distinguish among such marks without assuming a connection between their owners. Moreover, Applicant respectfully asserts that certain of the above-listed marks, namely LIVING MULCH and DR. SUBLER'S LIVING SOIL are closer in terms of sight, sound and meaning to the Cited Mark than Applicant's Mark. If the Cited Mark can coexist with these and the other above-listed marks, the Cited Mark should also be able to coexist with Applicant's Mark without giving rise to a likelihood of consumer confusion.

II. THE MARKS GIVE RISE TO SIGNIFICANTLY DIFFERENT COMMERCIAL IMPRESSIONS

In the Office Action, the Examining Attorney states that the Marks "create the same overall impression." Applicant respectfully disagrees and directs the Examining Attorney's attention to the evidence set forth on this point at length in Applicant's first Response to Office Action. Specifically, in addition to differing both aurally and visually, the Marks differ significantly in view of the wide range of different meanings that are conveyed by the element "EARTH" in Applicant's Mark and the comparatively narrower range of meanings conveyed by "SOIL" in the Cited Mark. As discussed further herein, the primary significance of "EARTH" as the proper name of the planet we inhabit results in a commercial impression of Applicant's Mark that is vastly different from that of the Cited Mark. While the broad semantic range of "EARTH" in conjunction with "LIVING" in Applicant's Mark suggests to consumers a vibrant, fertile planet and that Applicant's goods are beneficial to the health of our planet, the Cited Mark at most leads consumers to think only of the goods offered under the mark, namely, dirt.

Accordingly, for the reasons set forth above and in its first Response to Office Action, Applicant respectfully reiterates its position that the Cited Mark should not serve as an obstacle to registration of Applicant's Mark.

III. DISCLAIMER

In the Office Action, the Examining Attorney dismissed the evidence submitted by Applicant in its first Response to Office Action demonstrating that the term "EARTH" is used to convey a wide range of meanings and reiterated her position that although "EARTH" and "SOIL" differ visually, both are generic and "convey the same overall meaning for 'dirt.'" Applicant respectfully disagrees with this position. Rather, as noted above, Applicant submits that the term "EARTH" differs significantly from the term "SOIL" in that it simultaneously conveys multiple meanings, whereas "SOIL" at most conveys two meanings, namely, "dirt" and "to make dirty." Moreover, Applicant asserts that in common usage, the most prominent of the various meanings of the term "EARTH" is the proper name of the planet we inhabit. This is especially true today, as the current focus on protecting and improving the environment that is the core of the green movement keeps the concept of our planet in the forefront of consumers' minds. A well-respected legal treatise notes that "[t]he standard most often applied to

determine whether a term is generic is not whether it has *some* significance to the public as the name of an article, but whether that is its *principal* significance." That is, the majority usage of a term is controlling. J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:6 (4th ed., 2007); see *Ty Inc. v. Softbelly's, Inc.*, 353 F.3d 528, 69 U.S.P.Q.2d 1213 (7th Cir. 2003) (The "primary significance" of the term is the legal test of genericness.) Thus, Applicant submits that because the principal significance of the term "EARTH" is the proper name for our planet, the term is not generic for the goods covered in Class 001 of the Application, but is rather suggestive.

In support of this position, Applicant notes that it would be a considerable stretch of current American English usage to suggest that a consumer interested in purchasing supplies for gardening, landscaping, planting or related uses would inquire at a store for "earth." Rather, and much more naturally, the consumer would likely inquire about and purchase "soil," "dirt," "mulch," "peat moss," etc. If a consumer were to inquire about "earth," at best the question would likely identify that consumer as a non-native speaker of English; at worst, the salesperson would fail to understand the question, or would be forced to re-phrase it to say, "Oh, you mean, you're looking for soil?" Moreover, the English language is replete with phrases and sayings incorporating the term "EARTH" that support Applicant's position that the most prominent meaning of "EARTH" is the name of our planet. These include, but are not limited to, "Mother Earth," "Earth Day," "down to Earth," "peace on Earth," "what on Earth?" and "salt of the Earth." None of these phrases or sayings makes any sense if one reads the meaning "dirt" into them. Rather, they all turn on the common understanding that "EARTH" refers most prominently and most significantly to the planet. Further, if "SOIL" and "EARTH" were essentially interchangeable, as the Examining Attorney suggests, then one would expect there to be parallel formatives of these terms. Applicant notes, however, that although a child can get its clothes "soiled" by playing in the dirt, it is ungrammatical and nonsensical to say that the child's clothes got "earthed." For the reasons set forth above, Applicant respectfully asserts that the relevant purchasing public does not primarily understand "EARTH" to mean "soil" or "dirt," and therefore, the element "EARTH" in Applicant's Mark is not generic vis-à-vis the covered Class 001 goods. However, if the Examining Attorney is not persuaded, Applicant also submits that the disclaimer requirement for "EARTH" is unwarranted because the combination of "LIVING" and "EARTH" in Applicant's Mark gives rise to

an incongruity, and the Mark is therefore unitary and no disclaimer is necessary. See T.M.E.P. §1213.05(d) ("If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.). If the Examining Attorney maintains that "EARTH" in Applicant's Mark conveys only "dirt" or "soil," then it is incongruous for "dirt" or "soil" to be "living." Dirt and soil may be the media in which living plants and animals grow and thrive, but dirt and soil themselves are made up of inert elements and minerals and cannot be said to be "living." The combination of "LIVING" and "EARTH" in Applicant's Mark is therefore incongruous, Applicant's Mark is unitary, and no disclaimer of the "EARTH" element should be required. This incongruity giving rise to a mark in which no disclaimer is required is evidenced by two existing registrations on the Principal Register previously discussed by Applicant in its first Response to Office Action, as set forth below:

Mark	Goods/ Services	App/Reg. No.	Owner
LIVE EARTH	Soil amendments and fertilizers (CI 01)	3,638,713	Live Earth Products, Inc.
LIV-E-ARTH	Soil amendments and fertilizers for agricultural and horticultural use (CI 01) Mineral supplements (CI 05)	2,189,793	Live Earth Products, Inc.

These marks for identical or nearly identical goods were registered on the Principal Register without disclaimer of the element "EARTH." Applicant's Mark is at least as incongruous and unitary as LIVE EARTH and LIVE-E-ARTH and should also be allowed to register on the Principal Register without disclaimer of "EARTH."

Additionally, Applicant points to the nearly thirty marks published or granted registration on the Principal Register without disclaimer of "EARTH" or analogous elements that were cited in support of its position in the first Response to Office Action. These applications and registrations demonstrate that the term "EARTH" has been found in many instances by the U.S. Patent and Trademark Office to be at least suggestive in connection with identical, similar or related goods and services. Accordingly, Applicant reiterates its position that the subject Application should be accorded consistent treatment and registered on the Principal Register without disclaimer of "EARTH."

For the reasons set forth above and in Applicant's first Response to Office Action, Applicant therefore respectfully requests that the refusal to register and disclaimer requirement be withdrawn and Applicant's Application be approved for publication.

CONDITIONAL NOTICE OF APPEAL

Because the subject application has been finally refused by the Examining Attorney, Applicant has also timely filed a Conditional Notice of Appeal.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the Application is in condition for publication and requests action consistent therewith. No filing fees are believed due with this correspondence. In the event additional fees are required in connection with this application, please charge all necessary fees to Deposit Account No. 50-1212, Reference 10808522 /LETC:002/MSM. The Examining Attorney is requested to contact the undersigned by telephone at (512) 536-3194 if a telephone conference might be of assistance.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Karla S. Lambert/
SIGNATORY'S NAME	Karla S. Lambert
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	12/09/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Wed Dec 09 15:02:19 EST 2009
TEAS STAMP	USPTO/RFR-97.77.193.174-2 0091209150219644057-77541 687-4604d25b49d1239886b34

785ee65713cca-N/A-N/A-200 91209144610961334
--

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action**To the Commissioner for Trademarks:**

Application serial no. 77541687 has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REMARKS

In the Office Action issued June 9, 2009, the Examining Attorney maintained the refusal to register the mark LIVING EARTH ("Applicant's Mark") on the basis of a perceived likelihood of confusion with Registration No. 3,289,351 for LIVING SOIL (the "Cited Mark," and collectively with Applicant's Mark, the "Marks") for the services identified in International Class 001. The Examining Attorney also maintained the requirement that Applicant disclaim "EARTH" in Applicant's Mark in connection with the Class 001 goods. For the reasons given below, Applicant respectfully disagrees with the Examining Attorney's position and requests reconsideration of both the refusal to register and the disclaimer requirement and seeks approval of Applicant's Application for publication

DISCUSSION**I. THE CITED MARK PEACEFULLY COEXISTS WITH A NUMBER OF SIMILAR MARKS**

As discussed in Applicant's first Response to Office Action dated May 15, 2009, the Cited Mark peacefully coexists with a number of marks containing identical or similar elements for soil amendments, potting soil, fertilizers and related goods, and the Cited Mark is therefore entitled to only a narrow scope

of protection. Applicant notes in particular the marks set forth below:

Mark	Application/ Registration No.	Goods/Services	Owner
LIVE EARTH	3,638,713	Soil amendments and fertilizers (CI 01)	Live Earth Products, Inc.
LIVING MULCH (Disclaims "MULCH")	3,456,111	Growing media and potting soil for plants, namely, earthworm castings compost and compost (IC 01)	EarthSweet, Inc.
DR. SUBLER'S LIVING SOIL (Disclaims "LIVING SOIL")	2,912,899	Natural, organic and synthetic soil additives; plant food supplements; soil amendments; soil conditioners; and fertilizers, all for domestic and commercial plant care, gardening, landscaping, horticultural and agricultural use (IC 01)	Pacific Garden Company
LIV-E-ARTH	2,189,793	Soil amendments and fertilizers for agricultural and horticultural use (CI 01) Mineral supplements (CI 05)	Live Earth Products, Inc.

Applicant respectfully submits that the Examining Attorney neglected to give sufficient consideration and weight to this evidence of coexistence. Widespread third-party use of similar terms for similar goods or services militates against a finding of confusing similarity. *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986); *see also Loctite Corp. v. Tubbs Cordage Co.*, 175 U.S.P.Q. 663, 665-66 (T.T.A.B. 1972) (fifteen similar third-party registrations, some for hardware items, is evidence that can help narrow the scope of protection afforded a mark for specialty household and industrial goods). The fact that the Cited Mark is able to peacefully coexist with such highly similar marks for nearly identical goods strongly indicates that consumers are able to distinguish among such marks without assuming a connection between their owners. Moreover, Applicant respectfully asserts that certain of the above-listed marks, namely LIVING MULCH and DR. SUBLER'S LIVING SOIL are closer in terms of sight, sound and meaning to the Cited Mark than Applicant's Mark. If the Cited Mark can coexist with these and the other above-listed marks, the Cited Mark should also be able to coexist with Applicant's Mark without giving rise to a likelihood of consumer confusion.

II. THE MARKS GIVE RISE TO SIGNIFICANTLY DIFFERENT COMMERCIAL IMPRESSIONS

In the Office Action, the Examining Attorney states that the Marks “create the same overall impression.” Applicant respectfully disagrees and directs the Examining Attorney’s attention to the evidence set forth on this point at length in Applicant’s first Response to Office Action. Specifically, in addition to differing both aurally and visually, the Marks differ significantly in view of the wide range of different meanings that are conveyed by the element “EARTH” in Applicant’s Mark and the comparatively narrower range of meanings conveyed by “SOIL” in the Cited Mark. As discussed further herein, the primary significance of “EARTH” as the proper name of the planet we inhabit results in a commercial impression of Applicant’s Mark that is vastly different from that of the Cited Mark. While the broad semantic range of “EARTH” in conjunction with “LIVING” in Applicant’s Mark suggests to consumers a vibrant, fertile planet and that Applicant’s goods are beneficial to the health of our planet, the Cited Mark at most leads consumers to think only of the goods offered under the mark, namely, dirt.

Accordingly, for the reasons set forth above and in its first Response to Office Action, Applicant respectfully reiterates its position that the Cited Mark should not serve as an obstacle to registration of Applicant’s Mark.

III. DISCLAIMER

In the Office Action, the Examining Attorney dismissed the evidence submitted by Applicant in its first Response to Office Action demonstrating that the term “EARTH” is used to convey a wide range of meanings and reiterated her position that although “EARTH” and “SOIL” differ visually, both are generic and “convey the same overall meaning for ‘dirt.’” Applicant respectfully disagrees with this position. Rather, as noted above, Applicant submits that the term “EARTH” differs significantly from the term “SOIL” in that it simultaneously conveys multiple meanings, whereas “SOIL” at most conveys two meanings, namely, “dirt” and “to make dirty.” Moreover, Applicant asserts that in common usage, the most prominent of the various meanings of the term “EARTH” is the proper name of the planet we inhabit. This is especially true today, as the current focus on protecting and improving the environment that is the core of the green movement keeps the concept of our planet in the forefront of consumers’ minds. A well-respected legal treatise notes that “[t]he standard most often applied to determine whether a term is generic is not whether it has *some* significance to the public as the name of an article, but

whether that is its *principal* significance.” That is, the majority usage of a term is controlling. J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:6 (4th ed., 2007); see *Ty Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 69 U.S.P.Q.2d 1213 (7th Cir. 2003)(The “primary significance” of the term is the legal test of genericness.) Thus, Applicant submits that because the principal significance of the term “EARTH” is the proper name for our planet, the term is not generic for the goods covered in Class 001 of the Application, but is rather suggestive.

In support of this position, Applicant notes that it would be a considerable stretch of current American English usage to suggest that a consumer interested in purchasing supplies for gardening, landscaping, planting or related uses would inquire at a store for “earth.” Rather, and much more naturally, the consumer would likely inquire about and purchase “soil,” “dirt,” “mulch,” “peat moss,” etc. If a consumer were to inquire about “earth,” at best the question would likely identify that consumer as a non-native speaker of English; at worst, the salesperson would fail to understand the question, or would be forced to re-phrase it to say, “ Oh, you mean, you’re looking for soil?” Moreover, the English language is replete with phrases and sayings incorporating the term “EARTH” that support Applicant’s position that the most prominent meaning of “EARTH” is the name of our planet. These include, but are not limited to, “Mother Earth,” “Earth Day,” “down to Earth,” “peace on Earth,” “what on Earth?” and “salt of the Earth.” None of these phrases or sayings makes any sense if one reads the meaning “dirt” into them. Rather, they all turn on the common understanding that “EARTH” refers most prominently and most significantly to the planet. Further, if “SOIL” and “EARTH” were essentially interchangeable, as the Examining Attorney suggests, then one would expect there to be parallel formatives of these terms. Applicant notes, however, that although a child can get its clothes “soiled” by playing in the dirt, it is ungrammatical and nonsensical to say that the child’s clothes got “earthed.”

For the reasons set forth above, Applicant respectfully asserts that the relevant purchasing public does not primarily understand “EARTH” to mean “soil” or “dirt,” and therefore, the element “EARTH” in Applicant’s Mark is not generic vis-à-vis the covered Class 001 goods. However, if the Examining Attorney is not persuaded, Applicant also submits that the disclaimer requirement for “EARTH” is unwarranted because the combination of “LIVING” and “EARTH” in Applicant’s Mark gives rise to an incongruity, and the Mark is therefore unitary and no disclaimer is necessary. See T.M.E.P. §1213.05(d)

(“If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.). If the Examining Attorney maintains that “EARTH” in Applicant’s Mark conveys only “dirt” or “soil,” then it is incongruous for “dirt” or “soil” to be “living.” Dirt and soil may be the media in which living plants and animals grow and thrive, but dirt and soil themselves are made up of inert elements and minerals and cannot be said to be “living.” The combination of “LIVING” and “EARTH” in Applicant’s Mark is therefore incongruous, Applicant’s Mark is unitary, and no disclaimer of the “EARTH” element should be required. This incongruity giving rise to a mark in which no disclaimer is required is evidenced by two existing registrations on the Principal Register previously discussed by Applicant in its first Response to Office Action, as set forth below:

Mark	Goods/ Services	App/Reg. No.	Owner
LIVE EARTH	Soil amendments and fertilizers (CI 01)	3,638,713	Live Earth Products, Inc.
LIV-E-ARTH	Soil amendments and fertilizers for agricultural and horticultural use (CI 01) Mineral supplements (CI 05)	2,189,793	Live Earth Products, Inc.

These marks for identical or nearly identical goods were registered on the Principal Register without disclaimer of the element “EARTH.” Applicant’s Mark is at least as incongruous and unitary as LIVE EARTH and LIV-E-ARTH and should also be allowed to register on the Principal Register without disclaimer of “EARTH.”

Additionally, Applicant points to the nearly thirty marks published or granted registration on the Principal Register without disclaimer of “EARTH” or analogous elements that were cited in support of its position in the first Response to Office Action. These applications and registrations demonstrate that the term “EARTH” has been found in many instances by the U.S. Patent and Trademark Office to be at least suggestive in connection with identical, similar or related goods and services. Accordingly, Applicant reiterates its position that the subject Application should be accorded consistent treatment and registered on the Principal Register without disclaimer of “EARTH.”

For the reasons set forth above and in Applicant’s first Response to Office Action, Applicant therefore respectfully requests that the refusal to register and disclaimer requirement be withdrawn and

Applicant's Application be approved for publication.

CONDITIONAL NOTICE OF APPEAL

Because the subject application has been finally refused by the Examining Attorney, Applicant has also timely filed a Conditional Notice of Appeal.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the Application is in condition for publication and requests action consistent therewith. No filing fees are believed due with this correspondence. In the event additional fees are required in connection with this application, please charge all necessary fees to Deposit Account No. 50-1212, Reference 10808522 /LETC:002/MSM. The Examining Attorney is requested to contact the undersigned by telephone at (512) 536-3194 if a telephone conference might be of assistance.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Karla S. Lambert/ **Date:** 12/09/2009

Signatory's Name: Karla S. Lambert

Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77541687

Internet Transmission Date: Wed Dec 09 15:02:19 EST 2009

TEAS Stamp: USPTO/RFR-97.77.193.174-2009120915021964

4057-77541687-4604d25b49d1239886b34785ee

65713cca-N/A-N/A-20091209144610961334