

Mailed:
September 12, 2012

**This Opinion is NOT a
Precedent of the TTAB**

United States Patent and Trademark Office
Trademark Trial and Appeal Board

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In re UFP Technologies, Inc.
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Serial No. 85178012
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Melanie T. Frazier of Howard & Howard Attorneys PLLC for UFP Technologies, Inc.

Andrea Koyner Nadelman, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

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Before Bucher, Mermelstein and Lykos, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

UFP Technologies, Inc. seeks registration on the Principal Register of the mark **MF PLANTABLE PACKAGING** for goods identified in the application, as amended, as follows:

paper and cardboard packaging materials infused with seeds, namely, folding cartons, envelopes, die cut components in the nature of packaging materials in the nature of paper and cardboard containers and paper and cardboard cup sleeves; clamshells infused with seeds in the nature of cardboard clamshell packaging; bookmarks made of paper infused with seeds; business cards infused with seeds; paper hang tags infused with seeds; cup inserts of decorative paper

infused with seeds to be used as decoration in the wall of a tumbler, in International Class 16.¹

The Trademark Examining Attorney refused registration on the ground that the two-word term, “Plantable Packaging,” comprises an unregistrable component of an otherwise registrable mark under Section 6(a) of the Trademark Act of 1946 (as amended), 15 U.S.C. § 1056(a). The Trademark Examining Attorney takes the position that inasmuch as this expression is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), this mark should not be registered for the identified goods herein absent a disclaimer of the wording “Plantable Packaging” apart from the mark as shown.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. We affirm the refusal to register.

A mark is merely descriptive if it immediately conveys “knowledge of a quality, feature, function, or characteristics of the goods or services.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A “mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service”); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). To

¹ Application Serial No. 85178012 was filed on November 16, 2010, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce. Applicant has volunteered to disclaim the word “Packaging” alone.

be “merely descriptive,” a term need only describe a single significant quality or property of the goods or services. *Gyulay*, 3 USPQ2d at 1009 (Fed. Cir. 1987). Mere descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Applicant argues that the term “Plantable Packaging,” creates an inherent incongruity, and at worst for applicant, is a suggestive term inasmuch as it only vaguely suggests a characteristic of applicant's goods, and that it still requires imagination, thought, or perception to reach a conclusion as to what can be done with the goods once they have served their useful purpose. Applicant argues that it should not be required to disclaim this term because generally packaging is not used to grow vegetation.

By contrast, citing to dictionary entries and to a variety of third-party websites, the Trademark Examining Attorney contends that these entries all “demonstrate that the term ‘Plantable’ is used frequently to describe goods that have a second life as a plant product after serving an initial purpose as, for example, a party invitation, a personal journal, or product packaging,” that the combined wording “plantable packaging” is not incongruous, but rather that prospective consumers of applicant’s products will immediately perceive the wording “Plantable Packaging” as describing a feature of these goods.

We begin by looking at the dictionary definitions of the term “plantable,” attached to the Trademark Examining Attorney’s Denial of applicant’s Request for Reconsideration, October 24, 2011:

plant: *transitive verb*
1 a: to put or set in the ground for growth ...
3 a: to place in or on the ground 2

plant:
12. to put or set in the ground for growth, as seeds, young trees, etc.³

plant: ...
— **plant·able:** *adjective* 4

plant
RELATED FORMS
— **plantable:** *adjective* 5

plantable, a.
Capable of being planted; fit to be planted. 6

The Trademark Examining Attorney notes that directly beneath the Dictionary.com entry for “plantable” were two paid advertisements for seed-infused paper items similar to those of applicant:

[Green Wedding Invitations](#)
100% recycled, Exclusive Designs, Free Shipping, Show now!
www.foreverfiances.com

Plantable Paper
100% recycled handmade paper. Postcards, bookmarks, invitations
www.porridgepapers.com

² <http://www.merriam-webster.com/dictionary/plant>, Merriam-Webster, 2011.

³ <http://dictionary.reference.com/browse/plantable?s=t>, Dictionary.com, 2011.

⁴ <http://www.merriam-webster.com/dictionary/plantable>, Merriam-Webster, 2011.

⁵ <http://dictionary.reference.com/browse/plantable?s=t>, Dictionary.com, 2011.

⁶ <http://www.freedictionary.org/>, also *WEBSTER'S REVISED UNABRIDGED DICTIONARY* (1913).

The Trademark Examining Attorney also included a number of websites showing third-party businesses offering goods in plantable packaging in an effort to be environmentally friendly:

Plantable Packaging Creates Spruce Trees and Wildflowers

by MARK NAGURSKI
in ENVIRONMENT & SUSTAINABILITY

Welcome to **IDDICTIVE** - your daily fix of great business ideas. If you don't want to miss a thing make sure to grab updates by [RSS feed](#) or [email](#). It's free and you can cancel them at any time.



Funky **Plantable Packaging**

[Green business trends](#) are hotter than ever as smart businesses add environmentally friendly twists to just about everything they can – making ‘green living’ simpler for everyone.

Even better are the companies who are putting the environment at the heart of their **business models** – and making a profit in the process. Two quick spots include **plantable packaging** and plantable stationery – both making our use of paper less landfill and more hope filled (sorry).

In keeping with its brand identity, organic cosmetics company [Pangea Organics](#) uses molded fibre packaging that is not only biodegradable but also plantable. The packaging comes embedded with ‘edible sweet basil or flowering amaranth seeds’ and this Christmas they went all out with Spruce tree seeds.

On a similar note, [Botanical Paperworks](#) sell a range of biodegradable stationery, cards and calendars – this time embedded with wildflower seeds. When you’re done with them; simply plant, add water and watch your waste grow!

Two simple ways to make traditionally wasteful industries greener and create a devoted following in the process. How could you do the same? What other 'waste' products could be put to better use?

Site: [Botanical Paperworks](#)

Site: [Pangea Organics](#)

7

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Plantable Packaging

Posted by julz on be green, change the world

I was reading a magazine called [Natural Health](#) and came across a really cool concept that I hope companies and consumers will take seriously - [plantable packaging](#). [Plantable packaging](#) is made of 100 percent recycled post-consumer fiberboard, which begins to decompose within a few days of being placed in wet dirt. Plantable packages are embedded with seeds such as sweet basil, amaranth, and wildflowers that sprout after just a few weeks. According to the article, we could save 90 million trees a year in the United States if just 10 percent of American companies switched to post-consumer fiberboard not to mention the transformation of landfills that could occur. Check out [Pangea Organics](#) and [Cargo Cosmetics](#) for companies that support this concept. ⁸

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Green Ore Naturals - content area



Sow Tomorrow. [Plantable Packaging](#)

Planting a Bright Green Future with Sow Tomorrow.

[Sow Tomorrow](#) This luxury range of organic soap and skincare aims to offer great products that encourages mindful use of packaging, utilising green and organic manufacturing principles. The inner wrapper of the soap is designed to be planted after use by following the planting instructions on the outer sleeve. A percentage of profits goes to the following charities, The World Land Trust, Tusk, Send a Cow, Acorn & Bath Cats & Dogs Home.

[Plantable Packaging](#) We are now manufacturing our own hand made recycled palntable packaging!

After some research into various types of recycled card and paper, Suzanna fell over recycled, handmade seed paper that may grow when planted. The paper had a lovely rich texture and had just the right feel to complement the hand cut bars of soap Sue and her husband, a qualified pharmacist, had been working on. The Sow Tomorrow range of soaps and skincare was inspired by the discovery of the paper with a view to encouraging thoughtful use of waste products.

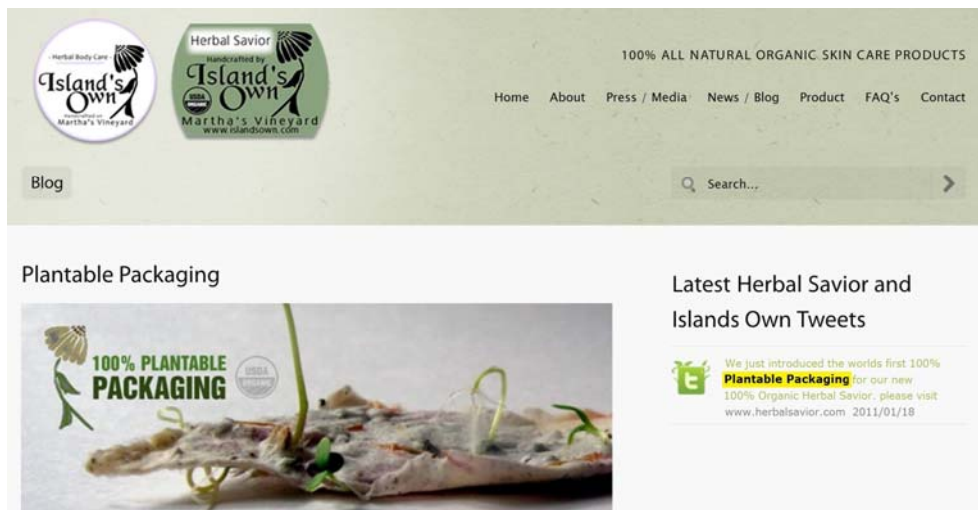
⁷ <http://www.iddictive.com/2009/01/08/plantable-packaging-creates-spruce-trees-and-wildflowers/>

⁸ <http://juliaparra.blogspot.com/2007/06/plantable-packaging.html>,
<http://www.naturalhealthmag.com/>



9

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10

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plantable packaging July 4th, 2008

we are really excited to be working with [ecosource home & garden](#) on their [packaging](#). we designed candle sleeves, labels for their bulb kits and disks for the herb kits. all of the paper was [handmade by us](#) with wildflower seeds and the herb kits have organic herb seeds embedded in the paper.

⁹ http://www.greenorenaturals.com/showtopic.php?org_id=875&kb_header_id=34101

¹⁰ <http://herbalsavior.com/uncategorized/plantable-packaging/>



11

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CREATE MEANING

FEBRUAR 6, 2011

Plantable packaging stops pollution.

By Bjoern von Buchholtz in Allgemein, Design, Innovation

The designer Ben Huttly sets a new mark on developing innovation in communication.

He invented a packaging/hangtag that is 100% biodegradable as well. The paper is 100% recyclable natural cotton and the type is printed and cutted [sic] by laser. Not surprising so far.

But the best:

It is made from the seeds of the food to which they're attached. So he bridged the subjects: gardening and environmental issues.

Small ideas can help solving big problems. Well done Mr. Huttly.

¹¹ <http://www.porridgepapers.com/plantable-packaging/>



12

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¹² <http://createmeaning.com/2011/02/plantable-packaging-stops-pollution/>

News & Features

Tree Life Box Creates New Trees from Packaging Waste

An innovative new packaging, Life Box, includes seedlings, so you can plant trees when you dispose of the box.
By **Kathryn Hawkins**. Posted on July 05 2010



You probably already recycle all of your cardboard and paper boxes. But now, thanks to mycologist Paul Stamets, your packaging waste may have a far greener future.

Stamets has invented the simple, yet revolutionary Tree Life Box: a recycled paper fiber box that's lined with seed mix. Once opening the package, simply tear up the box, plant it in a patch of soil, and water it regularly. Before long, new trees will begin to grow.

If you keep track of carbon credits, the Tree Life Box could be a bonanza for you: Stamets estimates that one out of every hundred tree seedlings will survive for 30 years. A 30-year-old tree can provide one ton of carbon.

The creators soon hope to develop additional Life Boxes to help create vibrant greenery. Some of their future boxes may be filled with flower or grass seeds, and the boxes can be customized to fit any form, from DVD mailers to pizza boxes.

Although shipping giants like UPS haven't changed over to Tree Life Boxes just yet, the company's already got one influential early adopter: Al Gore is shipping his newest book, *Our Choice*, in the **plantable packaging**, and other green gurus are sure to follow.

Want to learn more about the new packaging? Check out the [Life Box website](#).

Filed under: Business, Green,

13

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Pangea Organics: This Face Mask Grows Basil



We love any beauty product that does double duty, so we were immediately sucked in when we heard [Pangea Organics](#) offered a face mask that would not only spruce up our skin, but also arrives in **plantable packaging** that grows into Genovese Sweet Basil.

Made with natural ingredients such as Japanese matcha tea, acai and goji berry that promise to revitalize with antioxidants while polishing the skin, the Facial Mask comes wrapped in rugged paper packaging that you soak, then plant in soil. The seeds inside the packing should turn into sauce-worthy basil within just a few weeks.

And while we love the **plantable packaging** trend and hope it continues to grow (check out our recent post on Mr. Larkin for another company embracing plantable fashion), we wouldn't waste our money if the mask itself didn't work.

Turns out, we think it's as sweet as the basil promised by the packaging. Free of scary parabens and frightening synthetics, this all-natural mask freshened up our skin without irritating it and left its surface smooth and glowing.

¹³ <http://gimundo.com/news/article/tree-life-box-creates-new-trees-from-packaging-waste/>

Other Pangea Organics products with **plantable packaging** include the Facial Cleanser and Facial Scrub. The company also recently launched two new products that we're dying to try: an Eye Cream and a Balancing Oil made with Himalayan geranium and pomegranate.

Find Pangea Organics locally at *Pure Beauty locations* or online at www.pangeaorganics.com. Through May 15, you can save 20 percent on your order via the web site by entering the promo code NatureMom at checkout.

By Lorraine Sanders on May 12, 2009 8:37 AM

14

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Citroheaven Organic Soap in **Plantable Packaging** - triple pack

From **Green One Limited**

15

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Design Killed The Cliché

Thursday, September 30, 2010

Plantable Packaging



This is an awesome concept! Eco-friendly packaging that contains seeds so you can plant it and grow herbs.

BambuEarth is a natural beauty company that sells handmade natural soaps and personal care products as well as natural laundry detergents and dryer sheet alternatives. They are producing products free of synthetic chemicals so they are better for the skin and reduce water pollution. They even mention that they work well with cloth diapers! The best part however is that their bars of

soap come packaged in seeded handmade paper that grows basil and all the tags are printed on recycled cereal boxes. I just love that idea of being able to plant your packaging and immediately put it to good use.

<http://bambuearth.com/>

Posted by Thomas Hemmingson at 7:00

16

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¹⁴ <http://www.7x7.com/fashion/pangea-organics-face-mask-grows-basil>

¹⁵ <http://www.ethicalsuperstore.com/marketplace/>

¹⁶ http://designkilledthecliche.blogspot.com/2010_09_01_archive.html

Clean Waste, Clean Water:
The blessings of waste management innovations

By Katie Clancy

Welcome to **imovewater.net**'s think tank, a hub where we can share ideas, dispel myths, advertize gatherings, and dialogue about a common passion: clean water.

Okay, let me get us started.

Our quest for clean water these days is a viscous paradox. The majority of us seek clean water in plastic, which, of course, pollutes clean water. Advertisers sell us "purity" at the same time as their products are contaminating the oceans, hurting wildlife, and filling landfills. Maybe it's our culture's addiction to convenience that is dragging us down. We are a world where single-use disposable packaging (plastic bottles, bags, and cups) is the number one consumer product in the world. Plastic bottle production in the US annually alone requires about 17.6 million barrels of oil, which really seems in vain when we realize that 86 percent of those plastic water bottles are not recycled. Every year, 100 billion plastic bags are used. In fact, if each person were required to carry the average amount of packing they consumed in one year, we would each be dragging 800 pound bags on our backs.

If we really want to stand witness to the purification of our waters on an ecological level, let's take a good look at our waste.

Luckily, new advancements aim to knock plastic out of the water—literally. Those innovations, which include **plantable packaging** by mushroom guru Paul Stamets, provide a solution to building new dreams using the ruins of old pleasures.



Stamets is known for his groundbreaking research in mycoremediation using mycelium (aka fungus) to respond to environmental crisis. Mycelium is a network of cells that acts as a filter, improving water quality and reducing erosion by trapping sediment, harmful bacteria, and nutrients that escape during runoff. Stamets has dedicated his life to using mushrooms to clean up polluted land and water environments that have suffered from over farming, toxic dumping, and heavy metal pollution. Known as the Earth's "great recyclers," mycelium has powerful enzymes that breakdown hydrocarbons and suck up heavy metals to repair a site and bring it back to life.



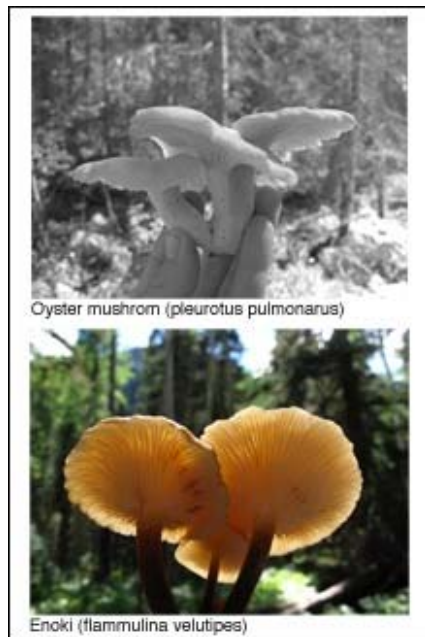
His devotion to fungi has led him to revolutionize the packaging industry with his new product, The Life Box. Forget recycling—with The Life Box, you can literally grow a forest from the box in which you ship everyday objects! It looks like ordinary cardboard, but each box has hundreds of tree seeds and thousands of mycorrhizal fungal spores infused into the corrugations of the cardboard. After delivery of goods, the Life Box can grow a tree nursery.

This beats plastic corn cups and regular recycling on every level. Even Coca Cola's new "Plant Bottle" that is made of 30% Brazilian sugarcane (www.greenerpackage.com) hasn't solved the way to move out of petroleum-based recycling.

Permaculture pioneer Penny Livingston, recently featured in Joao Amorim's film "2012: Time for Change" described our current corporate design as one that transforms a living system into a dead, [non-renewable] system. But as we become conscience to reduce what we consume, and we invest in new technologies like The Life Box that are igniting a 360 degree shift from this cycle.

The Life Box isn't directly connected to mushrooms, but taking another lesson from its creators, we can see that mycelium has huge potential for healing our relationship to waste.

Katie Holgate, a mushroom ecologist, is in the process of developing microfiltration systems that transform homogenized, polluted habitats into biodiverse systems using mycelium. In order to start that process, she must become very intimate with her garbage. She uses certain waste products such as compost, cardboard, old newspapers, spent coffee grounds, burlap bags to sprout the spores on, giving value to what is ordinarily thought as useless.



"Working with mushrooms has transformed my personal relationship to trash. Like many people, I used to be in denial about what I was consuming and where it went beyond a landfill. But Stamet's work with mushrooms really inspired my relationship to waste management. Instead of it being worthless, I have found the value in what we throw away. In that sense, trash is a precious resource," Holgate said. The benefits of using this mycelium in the environment, she adds, are imperative to strengthening the immunity of the ecosystem.

It might not be convenient, but let's honor waste streams as we do water: as a valuable resource rather than a property or consumable product.

Stay tuned for the next installment of imovewater.net's Ecology Blog!

In the meantime, learn more about The Life Box and Stamet's current research, at www.fungi.com.

Written by Katie Clancy

17

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¹⁷ <http://imovewater.net/page0/page11/page11.html>

EXCLUSIVE INTERVIEW WITH MATHEW GERSON, CO-FOUNDER OF SIR RICHARD'S NEW VEGAN CONDOMS

July 7th, 2010



You've stocked up on red hot green lingerie for sexy, romantic flings, and soon you'll be able to add a benevolent vegan condom to your do-gooding sex repertoire. Sir Richard's condoms truly double your pleasure, because for every condom you purchase, one is donated to a developing country to help prevent the spread of sexually transmitted diseases. According to Sir Richard's co-founder Mathew Gerson, only 10 percent of the global demand for free condoms is met annually.

I was so intrigued by the news swirling around this company's innovative condoms and mission to revolutionize the condom industry and truly "do unto others," that I contacted Mathew Gerson to get the lowdown on Sir Richard's myself. Below is our exclusive interview.

EcoSalon: Which developing countries will you be distributing condoms to, and why are these countries your top choices?

Mathew Gerson: We are currently in discussions with organizations in Haiti, Thailand and Uganda. Each of these countries has a significant gap in the number of condoms needed in relation to the number available. The organizations that we have chosen to work with are established organizations which have seen success as regards to their efforts in increasing the use and acceptance of condoms in their regions.

EcoSalon: What are Sir Richard's condoms made out of? Are they Fair Trade latex, casein-free and made in Malaysia?

Mathew Gerson: They are manufactured in Malaysia by one of the finest condom manufacturers in the world. To date we have not been able to source a supplier of Fair Trade latex, but we are in discussion with both TransFair USA as well as U.K. based Fair Deal Trading in the hopes that they might be able to provide for our future production runs. Sir Richard's condoms are casein-free and vegan-friendly. We hope to have third party vegan certification in time for our next run of product.

EcoSalon: Is the packaging design (colorful plaid print) meant to appeal to gays and women – and why?

Mathew Gerson: If you go to the condom aisle in any major supermarket you will see that the condoms that are currently marketed in the U.S. are overwhelmingly designed for a younger male user. We felt that the messaging and design tended to be clinical, industrial and pretty sophomoric.

There is a lack of any uplifting sense of design or subtlety in the entire conversation brands are having with their customers. We wanted the experience of the Sir Richard's brand to be one that is positive, both by design as well as the way in which we communicated our message and mission. Women currently purchase around 38 percent of condoms in the U.S., so we felt it was about time that their aesthetic sensibilities were finally honored.

EcoSalon: Will the Sir Richard's condom box be able to be planted to sprout wildflowers, and will the wrappers be recyclable? Are the condoms themselves biodegradable?

Mathew Gerson: The condom is an Over The Counter (OTC) Medical Device and is heavily regulated by the FDA. That said, we don't have a tremendous amount of creative freedom with regard to many aspects of packaging and production. We are looking into the possibility of utilizing "plantable packaging" as the company grows up. Currently our boxes are 100 percent recyclable and/or compostable paper board. The wrappers are made out of Mylar, as regulated by the FDA, which unfortunately cannot yet be recycled. One of the most environmentally responsible things you can do with your condom is to never flush them down the toilet in order to ensure the proper conditions for them to break down. Latex is 100 percent biodegradable.

EcoSalon: What is the launch date when Sir Richard's condoms will become available in the states, and where will they be sold?

Mathew Gerson: The condoms will be available in October of this year, both online via our website www.SirRichards.com as well as in select stores and boutiques. ¹⁸

We agree with the Trademark Examining Attorney that these pages demonstrate that "the term 'plantable' is used frequently to describe goods that have a second life as a plant product after serving an initial purpose as, for example, a party invitation, a personal journal, or product packaging."

¹⁸ <http://sirrichards.com/blog/press/interview-with-mathew-gerson-co-founder-on-ecosalon/>

Nonetheless, applicant argues as follows:

[M]any objects are not thought to be plantable, *e.g.*, automobiles, furniture, jewelry and packaging. Packaging is a container which is used by consumers to hold another item. Packaging is not meant to be planted into the ground. People do not buy packaging to plant it. The use of the term PLANTABLE with PACKAGING together creates an incongruity.

While packaging has not historically been thought of as “plantable,” it is clear from this record that is no longer the case. Applicant may be right that there are no indications of “plantable automobiles,” for example, and when a consumers is wanting to plant greenery, the first impulse is probably to seek out seeds or seedlings, not product packaging. However, based upon the entirety of this record, we find no incongruity in the combination of the two words “plantable packaging.” Third-party vendors have also been using the term “plantable packaging,” to describe biodegradable packaging infused with seeds. The term “plantable packaging” is actually a more concise formulation for such a material, but is certainly no less descriptive. The fact that some of the web pages may explain to the reader how items of biodegradable packaging infused with seeds actually work is consistent with the relative newness of this technology. Under the test we apply to make a determination under Section 2(e)(1), we find that this term immediately conveys knowledge of a significant feature of the involved goods.

Decision: The refusal to register absent a disclaimer of the words “Plantable Packaging,” is hereby affirmed. However, this decision will be set aside if,

within thirty (30) days of the mailing date of this decision, applicant submits to the Board a proper disclaimer of the words “Plantable Packaging.” *See* Trademark Rule 2.142(g), 37 U.S.C. § 2.142(g); and TBMP § 1218 (3d ed. rev. 2012). A proper disclaimer should read as follows: “No claim is made to the exclusive right to use the words ‘Plantable Packaging’ apart from the mark as shown.”