

THIS OPINION
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OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

COHEN

Mailed: March 27, 2014

Opposition No. 91204124

Threshold Enterprises, Ltd.

v.

Robert Campbell

**Before Kuhlke, Wellington, and Gorowitz,
Administrative Trademark Judges.**

By the Board:

This case now comes up on applicant's motion for summary judgment seeking dismissal of the opposition based on the alleged dissimilarity of the parties' marks. The motion has been fully briefed.¹

Robert Campbell ("applicant") seeks to register the mark PLANT HERBAL TREASURES² in standard characters for

¹ Applicant's reply brief, filed February 21, 2014 is over-length at fifteen pages. As such, it exceeds the ten-page limit for reply briefs in support of motions and has therefore received no consideration. Trademark Rule 2.127(a); *see also Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB 2011).

² In its response to the motion for summary judgment, opposer argues that applicant previously used the mark, PLANETARY HERBAL TREASURES and because of "this history and [a]pplicant's gamesmanship" it filed the notice of opposition. Nonetheless, the mark sought to be registered by applicant is PLANT HERBAL TREASURES not PLANETARY HERBAL TREASURES.

"dietary herbal supplements, vitamins, and nutritional supplements" in International Class 5.³

Threshold Enterprises, Ltd. ("opposer") filed its notice of opposition to the registration of applicant's mark on the ground of priority and likelihood of confusion. In support of these grounds opposer has claimed ownership of the registrations PLANETARY in standard characters for "vitamins, dietary herbal supplements and nutritional supplements" in International Class 5⁴ and PLANETARY FORMULAS in standard characters for "dietary herbal supplements and nutritional supplements" in International Class 5.⁵

Applicant submitted his answer, generally denying the allegations of the notice of opposition and enumerating two affirmative defenses. However, for purposes of the motion for summary judgment, applicant "concede[s] to the relatedness of its products to [o]pposer's products, and that [o]pposer has priority in interstate commerce. Thus the sole ground for [the motion for summary judgment] is the significant dissimilarity of the marks themselves."

³ Application Serial No. 853961369 was filed August 12, 2011 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an assertion of a bona fide intent to use the mark in commerce, disclaiming PLANT and HERBAL apart from the mark as shown.

⁴ Registration No. 3370447 was issued January 15, 2008 claiming a date of first use anywhere and in commerce of January 1, 1984.

⁵ Registration No. 1900303 was issued June 20, 1995 claiming a date of first use anywhere and in commerce of January 1, 1984, disclaiming FORMULAS apart from the mark as shown.

As an initial matter, opposer argues in its response to the motion for summary judgment, that applicant's PLANT HERBAL TREASURES mark is similar to opposer's common law mark, PLANETARY HERBALS. However, opposer did not plead this mark in its notice of opposition, asserting it for the first time in its response to the motion for summary judgment. Further, opposer has not sought to amend its pleadings to include this mark. Accordingly, the Board has not considered opposer's arguments related to any PLANETARY HERBALS mark. See, e.g., *ChaCha Search Inc. v. Grape Technology Group, Inc.*, 105 USPQ2d 1298, 1301-02 (TTAB 2012); *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1296-97 (TTAB 2010); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007).

Thus, in comparing the parties' marks, the Board has considered whether applicant's mark, PLANT HERBAL TREASURES, in relation to the goods for which registration is sought, so resembles opposer's PLANETARY and PLANETARY FORMULAS marks for the same goods is likely to cause confusion, mistake or deception. Trademark Act Section 2(d); 15 U.S.C. § 1052(d).

Applicant argues, *inter alia*, as grounds for summary judgment, that the parties' marks, taken as a whole, "are

overwhelmingly different in appearance, sound, meaning or connotation, and commercial impression"; that the dictionary definitions of PLANETARY⁶ and PLANT⁷ indicate a difference in connotation and commercial impression;⁸ that the parties' goods are purchased by sophisticated consumers; that there is no evidence of actual confusion; that opposer's mark is weak because of numerous third-party registrations containing the consecutive letters PLAN; and that therefore, registration of applicant's mark will not likely lead to confusion and the opposition should be dismissed.

In support of his motion, applicant also includes a copy of a trademark search report and various TSDR printouts of some of the marks contained in that trademark search report.

Opposer argues, *inter alia*, that applicant's trademark search report is of little probative value in the absence of

⁶ E.g., "having to do with a planet or the planets."

⁷ E.g., "any of a kingdom of eukaryotes generally characterized by the ability to carry on photosynthesis in its cells ..." or "a young tree, shrub or herb, ready to put into other soil for growth to maturity."

⁸ In support of this argument, applicant submitted various internet printouts, containing the date it was accessed and printed along with the URL, of dictionary definitions (for which the Board may take judicial notice) for PLANETARY and for PLANT. See TBMP § 704.08(b) and 704.12(a); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1075 n.17 (TTAB 2011).

evidence of actual use;⁹ that the parties' goods are relatively inexpensive and the purchasers are "less discerning"; that although opposer is "currently unaware of instances of actual confusion," "confusion could be discovered from third parties" during discovery; that the parties' marks sound alike in that they begin with PLAN followed by the "T" sound; that the parties' marks are similar in connotation and meaning because applicant's mark connotes "a living thing that grows in the ground" and opposer's mark connotes "of or belonging to the Earth" and consumers affiliate the "ground" with "Earth"; and that therefore, there is a genuine dispute of material fact relating to the issue of likelihood of confusion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed

⁹ As to strength of a mark, third party registrations have little to no probative value because they are not evidence of actual use. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973).

in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

"The purpose of summary judgment is judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result." *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1244 (TTAB 1989); see also *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). The determination of a likelihood of confusion does not necessarily require examination and findings as to each *du Pont* factor. See *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.* 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Each of the thirteen elements may from

case to case play a dominant role and in a particular case, a single *du Pont* fact may be dispositive. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (*citing du Pont*, 177 USPQ at 567). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

Inasmuch as applicant has, for purposes of its motion for summary judgment, conceded the similarity of the parties' goods,¹⁰ the key factor in this case is the degree of similarity between the marks PLANT HERBAL TREASURES and PLANETARY/PLANETARY FORMULAS. See, e.g., *id.*; *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 1558-1560 (Fed. Cir. 2001). While opposer argues that the parties' goods are casually purchased, opposer has not submitted evidence sufficient to find a genuine dispute. We therefore treat this factor as neutral.¹¹

¹⁰ Indeed, the Board notes the parties' goods are identical.

¹¹ The Board notes that it would come to the same conclusion on summary judgment even if it were established that the parties'

Turning to the marks in this case, the Board considered opposer's pleaded marks, PLANETARY and PLANETARY FORMULAS, and applicant's mark, PLANT HERBAL TREASURES. Considering the marks in their entireties, we are of the opinion that they differ so substantially in connotation and commercial impression that combined with the differences in appearance and sound there is no likelihood that their contemporaneous use by different parties will result in confusion.¹² We would be of this opinion even if opposer offered evidence at trial to establish that the parties' goods are purchased casually rather than with care; and that opposer's marks are strong as applied to its goods.¹³ Further, opposer's argument, that:

goods are relatively low cost and do not involve a high degree of purchasing care.

¹² The Board further notes that while it is often the first part of a mark which is most likely impressed upon the mind of a purchaser, see *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), descriptive or disclaimed matter, is typically less significant or less dominant when comparing marks. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re National Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985).

¹³ Opposer has also argued that the context of the parties' use of their respective marks on labeling and packaging would lead to a likelihood of confusion with consumers. However, this argument was raised in relation to opposer's unpleaded PLANETARY HERBALS mark and as such, has not been considered by the Board. Notwithstanding the foregoing, even if the Board were to consider this argument, as previously noted, it would not change the Board's decision.

1. in the context of supplements, the most likely definition for the ordinary consumer for PLANETARY is "of or belonging to the Earth";
2. applicant's use of PLANT conveys to the consumer "a living thing that grows in the ground"; and
3. consumers would "affiliate 'ground' with the ground on Earth"

and therefore, the parties' marks have similar connotations and commercial impressions is simply too attenuated and ultimately, not persuasive. Except for the dictionary definitions submitted by opposer, opposer submits no evidence in support of the enumerated conclusions. *Cf. In re Chopper Industries*, 222 USPQ 258, 260 (TTAB 1984) ("The appearance of the term in a dictionary or other reference is not conclusive on the issue of capability") (*citing In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981)).

In short, opposer, in responding to the motion for summary judgment has not set out evidence that it could produce at trial which could reasonably be expected to cause us to come to a different conclusion. The first *du Pont* factor outweighs all the others which might be pertinent to this case and therefore, are not addressed further by the Board. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 21 USPQ2d at 1145 ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive").

In view thereof, based on the record herein and the applicable law, applicant has established that there is no genuine dispute of material fact as to the absence of a likelihood of confusion between the parties' marks. Accordingly, applicant's motion for summary judgment is **granted** on likelihood of confusion and the opposition is dismissed.