

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77920002
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 107
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>This is in response to the Office Action dated May 5, 2011, in which the USPTO made final the refusal to register Applicant's PLANET GREEN &amp; Design mark ("Applicant's Mark") based on an alleged likelihood of confusion with U.S. Registration No. 3,458,605 for the mark "PlanIt Greener" (the "Cited Mark"), under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). Applicant respectfully submits the following response and requests that the Examining Attorney remove the 2(d) refusal and approve Applicant's Mark for publication. Applicant is filing a Notice of Appeal concurrently with this response.</p> <p><b>I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARK</b></p> <p>As set forth below, there is no likelihood of confusion between Applicant's Mark and the Cited Mark, based on the dissimilarity of the marks and their respective trade channels.</p> <p><b>A. The Cited Mark is "PlanIt Greener," Not "PLANIT GREENER" nor "PLANET GREENER"</b></p> <p>As an initial matter, we note that the Examining Attorney has compared Applicant's Mark to the mark "PLANIT GREENER (in Standard Characters)." However, the Registration Certificate for the Cited Mark shows that the mark is not "PLANIT GREENER," but rather "PlanIt Greener." See Exhibit A. As discussed more fully below, this distinction makes a drastic impact on the appearance, connotation, and commercial impression of the Cited Mark. Applicant respectfully requests that when evaluating this Response and the likelihood of confusion, the Examining Attorney consider the Cited</p>	

Mark as registered, including its distinctive formatting.

**B. The Marks Must be Compared in Their Entireties; They Cannot be Dissected**

It is well established that when determining likelihood of confusion, trademarks must be analyzed in their entireties and should not be split up into their component parts. *Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 167 U.S.P.Q. (BNA) 529, 530 (C.C.P.A. 1970); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F. 3d 1399, 181 USPQ 272 (C.C.P.A 1974). As the Federal Circuit has explained, “likelihood of confusion cannot be predicated on dissection of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

Applicant respectfully submits that the Examining Attorney has impermissibly dissected the marks to reach his conclusion that the marks are likely to be confused. However, when Applicant’s Mark and the Cited Mark are compared in their entireties, there is no question that the marks are distinct, and that no likelihood of confusion exists. Applicant’s Mark consists of an outer square, containing an inner circle, which contains the word “planet” on top of the word “green,” with the word “green” displayed in a slightly larger font. Overall, these separate elements combine into a single, unitary mark that is entirely distinct from the Cited Mark. Visually, the design elements will immediately distinguish Applicant’s Mark from the Cited Mark, which is merely a word mark. Additionally, given the distinctive formatting of the Cited Mark, consumers will interpret the mark as three separate words, “plan,” “it” and “greener,” displayed horizontally, none of which appear in Applicant’s Mark. As such, when the marks are viewed in their entireties, there is no likelihood of confusion between the marks.

Furthermore, after dissecting Applicant’s Mark into word and design components, the Examining Attorney put greater emphasis on the word portion of Applicant’s Mark, downplaying the distinctive design elements. The Examining Attorney argues that the “word portion of a mark is normally accorded greater weight in determining likelihood of confusion than the design portion.” However, the Federal Circuit has warned that “[t]here is no general rule as to whether letters or designs will dominate in composite marks.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Instead, evaluations of composite marks must be done on a case-by-case basis. As such, it was improper for the Examining Attorney to dissect Applicant’s Mark into separate word and design elements and to afford greater weight to the word portion of Applicant’s

Mark, particularly given the graphic nature of the design elements in Applicant's Mark, which includes contrasting shapes, among other features. When compared in their entirety, it is clear the marks are not confusingly similar.

**C. Even if the Marks Are Dissected Into Their Component Parts, the Marks Are Dissimilar**

Even assuming, in arguendo, that the Examining Attorney was correct to dissect the marks when conducting his likelihood of confusion analysis, Applicant respectfully submits that the component parts of the marks are not similar in visual appearance, connotation, or commercial impression.

The Examining Attorney argues that both marks contain a variant of the wording "planet." While it is true that Applicant's Mark incorporates the word "planet," the Cited Mark does not. Instead, the Cited Mark contains the term "PlanIt," which is a combination of two separate words, "plan" and "it." The distinctive formatting of the Cited Mark, which uses a capital letter to signify the start of each word, ensures that consumers will read the mark as "Plan It" rather than "planet." Thus, the two marks do not incorporate the common word "planet."

**D. The Marks Have Different Commercial Impressions**

The Cited Mark also creates a completely different commercial impression than Applicant's Mark. The phrase "plan it," implies an action or instruction, similar to "see it," "do it," "read it," and the like. As such, the mark will be interpreted as a slogan telling people what to do. Furthermore, planning or making something "greener" implies that you will improve on what already exists, similar to making something "cleaner," "smarter," "faster," or "stronger." By contrast, there is no such instruction in Applicant's Mark, and there is no indication that one will make something better than what already exists. Instead, Applicant's Mark simply describes an existing object, the planet, and does not suggest or command that people should make it better than it already is. The marks therefore create wholly different commercial impressions.

**E. The Marks Will Be Used in Different Trade Channels**

As raised in prior responses, the marks will be used in distinct trade channels, further decreasing the likelihood of confusion. The Cited Mark is used in connection with exhibitions in the field of ecology and environmental studies, as shown in the specimen accompanying the April 1, 2008 Statement of Use for the Cited Mark. Consumers must physically travel to such exhibitions, which are located around the country. By contrast, Applicant has used its PLANET GREEN word mark, and will

use its PLANET GREEN & Design mark, in connection with its own subscription television network and online store. Consumers access the PLANET GREEN goods and services from the convenience of their home, by turning on the television or logging onto the Internet, rather than traveling to a third-party location. Furthermore, because Applicant's Mark will be displayed via a subscription cable/satellite service that is only available upon payment from the consumer, consumers are more likely to know the source of the content and to be able to distinguish the goods and services provided in connection the PLANET GREEN network from third-party goods and services.

Thus, consumers are not likely to encounter the marks in similar trade channels, or to believe they come from a common source. In fact, we note that Applicant's PLANET GREEN word mark and the Cited Mark have co-existed without confusion in their respective trade channels since Applicant began using its PLANET GREEN word mark in 2008 in connection with its popular television network. This further shows that confusion between Applicant's Mark and the Cited Mark is not likely.

## II. CONCLUSION

For the reasons set forth above and in prior responses, Applicant respectfully requests that the USPTO remove finality and approve Applicant's Mark for publication. In the event that the Examining Attorney does not grant this request, a Notice of Appeal to the Trademark Trial and Appeal Board is being filed simultaneously herewith to preserve Applicant's rights. A copy of said Notice of Appeal is attached hereto for the Examining Attorney's ready reference.

### EVIDENCE SECTION

#### EVIDENCE FILE NAME(S)

<b>ORIGINAL PDF FILE</b>	<a href="#">evi_20447535-113340707_.EXHIBIT_Apdf.pdf</a>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\779\200\77920002\xml11\RFR0002.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_20447535-113340707_.Notice_of_Appealt.pdf</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\779\200\77920002\xml11\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\779\200\77920002\xml11\RFR0004.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Exhibit A is the registration certificate for the PlanIt Greener mark. The second attachment is the Notice of Appeal to the Trademark Trial and Appeal Board

	regarding Applicant's Mark.
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Amy E. Salomon/
<b>SIGNATORY'S NAME</b>	Amy E Salomon
<b>SIGNATORY'S POSITION</b>	Attorney of record, Arent Fox LLP (DC bar member)
<b>DATE SIGNED</b>	11/04/2011
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Nov 04 11:53:52 EDT 2011
<b>TEAS STAMP</b>	USPTO/RFR-204.4.75.35-201 11104115352062461-7792000 2-480521faed607d8d7fba8c9 099cb63686b-N/A-N/A-20111 104113340707480

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

Application serial no. **77920002** has been amended as follows:

**ARGUMENT(S)**

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

This is in response to the Office Action dated May 5, 2011, in which the USPTO made final the refusal to register Applicant's PLANET GREEN & Design mark ("Applicant's Mark") based on an alleged likelihood of confusion with U.S. Registration No. 3,458,605 for the mark "PlanIt Greener" (the "Cited Mark"), under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). Applicant respectfully submits the following response and requests that the Examining Attorney remove the 2(d) refusal and approve

Applicant's Mark for publication. Applicant is filing a Notice of Appeal concurrently with this response.

**I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARK**

As set forth below, there is no likelihood of confusion between Applicant's Mark and the Cited Mark, based on the dissimilarity of the marks and their respective trade channels.

**A. The Cited Mark is "PlanIt Greener," Not "PLANIT GREENER" nor "PLANET GREENER"**

As an initial matter, we note that the Examining Attorney has compared Applicant's Mark to the mark "PLANIT GREENER (in Standard Characters)." However, the Registration Certificate for the Cited Mark shows that the mark is not "PLANIT GREENER," but rather "PlanIt Greener." See Exhibit A. As discussed more fully below, this distinction makes a drastic impact on the appearance, connotation, and commercial impression of the Cited Mark. Applicant respectfully requests that when evaluating this Response and the likelihood of confusion, the Examining Attorney consider the Cited Mark as registered, including its distinctive formatting.

**B. The Marks Must be Compared in Their Entireties; They Cannot be Dissected**

It is well established that when determining likelihood of confusion, trademarks must be analyzed in their entireties and should not be split up into their component parts. *Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 167 U.S.P.Q. (BNA) 529, 530 (C.C.P.A. 1970); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F. 3d 1399, 181 USPQ 272 (C.C.P.A 1974). As the Federal Circuit has explained, "likelihood of confusion cannot be predicated on dissection of a mark." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

Applicant respectfully submits that the Examining Attorney has impermissibly dissected the marks to reach his conclusion that the marks are likely to be confused. However, when Applicant's Mark and the Cited Mark are compared in their entireties, there is no question that the marks are distinct, and that no likelihood of confusion exists. Applicant's Mark consists of an outer square, containing an inner circle, which contains the word "planet" on top of the word "green," with the word "green" displayed in a slightly larger font. Overall, these separate elements combine into a single, unitary mark that is entirely distinct from the Cited Mark. Visually, the design elements will immediately distinguish Applicant's Mark from the Cited Mark, which is merely a word mark. Additionally, given the distinctive formatting of the Cited Mark, consumers will interpret the mark as three separate words, "plan," "it" and "greener,"

displayed horizontally, none of which appear in Applicant's Mark. As such, when the marks are viewed in their entireties, there is no likelihood of confusion between the marks.

Furthermore, after dissecting Applicant's Mark into word and design components, the Examining Attorney put greater emphasis on the word portion of Applicant's Mark, downplaying the distinctive design elements. The Examining Attorney argues that the "word portion of a mark is normally accorded greater weight in determining likelihood of confusion than the design portion." However, the Federal Circuit has warned that "[t]here is no general rule as to whether letters or designs will dominate in composite marks." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Instead, evaluations of composite marks must be done on a case-by-case basis. As such, it was improper for the Examining Attorney to dissect Applicant's Mark into separate word and design elements and to afford greater weight to the word portion of Applicant's Mark, particularly given the graphic nature of the design elements in Applicant's Mark, which includes contrasting shapes, among other features. When compared in their entireties, it is clear the marks are not confusingly similar.

#### **C. Even if the Marks Are Dissected Into Their Component Parts, the Marks Are Dissimilar**

Even assuming, in arguendo, that the Examining Attorney was correct to dissect the marks when conducting his likelihood of confusion analysis, Applicant respectfully submits that the component parts of the marks are not similar in visual appearance, connotation, or commercial impression.

The Examining Attorney argues that both marks contain a variant of the wording "planet." While it is true that Applicant's Mark incorporates the word "planet," the Cited Mark does not. Instead, the Cited Mark contains the term "PlanIt," which is a combination of two separate words, "plan" and "it." The distinctive formatting of the Cited Mark, which uses a capital letter to signify the start of each word, ensures that consumers will read the mark as "Plan It" rather than "planet." Thus, the two marks do not incorporate the common word "planet."

#### **D. The Marks Have Different Commercial Impressions**

The Cited Mark also creates a completely different commercial impression than Applicant's Mark. The phrase "plan it," implies an action or instruction, similar to "see it," "do it," "read it," and the like. As such, the mark will be interpreted as a slogan telling people what to do. Furthermore, planning or making something "greener" implies that you will improve on what already exists, similar to making something "cleaner," "smarter," "faster," or "stronger." By contrast, there is no such

instruction in Applicant's Mark, and there is no indication that one will make something better than what already exists. Instead, Applicant's Mark simply describes an existing object, the planet, and does not suggest or command that people should make it better than it already is. The marks therefore create wholly different commercial impressions.

#### **E. The Marks Will Be Used in Different Trade Channels**

As raised in prior responses, the marks will be used in distinct trade channels, further decreasing the likelihood of confusion. The Cited Mark is used in connection with exhibitions in the field of ecology and environmental studies, as shown in the specimen accompanying the April 1, 2008 Statement of Use for the Cited Mark. Consumers must physically travel to such exhibitions, which are located around the country. By contrast, Applicant has used its PLANET GREEN word mark, and will use its PLANET GREEN & Design mark, in connection with its own subscription television network and online store. Consumers access the PLANET GREEN goods and services from the convenience of their home, by turning on the television or logging onto the Internet, rather than traveling to a third-party location. Furthermore, because Applicant's Mark will be displayed via a subscription cable/satellite service that is only available upon payment from the consumer, consumers are more likely to know the source of the content and to be able to distinguish the goods and services provided in connection the PLANET GREEN network from third-party goods and services.

Thus, consumers are not likely to encounter the marks in similar trade channels, or to believe they come from a common source. In fact, we note that Applicant's PLANET GREEN word mark and the Cited Mark have co-existed without confusion in their respective trade channels since Applicant began using its PLANET GREEN word mark in 2008 in connection with its popular television network. This further shows that confusion between Applicant's Mark and the Cited Mark is not likely.

## **II. CONCLUSION**

For the reasons set forth above and in prior responses, Applicant respectfully requests that the USPTO remove finality and approve Applicant's Mark for publication. In the event that the Examining Attorney does not grant this request, a Notice of Appeal to the Trademark Trial and Appeal Board is being filed simultaneously herewith to preserve Applicant's rights. A copy of said Notice of Appeal is attached hereto for the Examining Attorney's ready reference.



## **EVIDENCE**

Evidence in the nature of Exhibit A is the registration certificate for the PlanIt Greener mark. The second attachment is the Notice of Appeal to the Trademark Trial and Appeal Board regarding Applicant's Mark. has been attached.

### **Original PDF file:**

[evi\\_20447535-113340707\\_.EXHIBIT\\_Apdf.pdf](#)

**Converted PDF file(s)** (1 page)

[Evidence-1](#)

### **Original PDF file:**

[evi\\_20447535-113340707\\_.Notice\\_of\\_Appealt.pdf](#)

**Converted PDF file(s)** (2 pages)

[Evidence-1](#)

[Evidence-2](#)

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Amy E. Salomon/ Date: 11/04/2011

Signatory's Name: Amy E Salomon

Signatory's Position: Attorney of record, Arent Fox LLP (DC bar member)

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: 77920002

Internet Transmission Date: Fri Nov 04 11:53:52 EDT 2011

TEAS Stamp: USPTO/RFR-204.4.75.35-201111041153520624

61-77920002-480521faed607d8d7fba8c9099cb

63686b-N/A-N/A-20111104113340707480

**EXHIBIT A**

**Int. Cl.: 41**

**Prior U.S. Cls.: 100, 101, and 107**

**Reg. No. 3,458,605**

**United States Patent and Trademark Office** Registered July 1, 2008

---

**SERVICE MARK  
PRINCIPAL REGISTER**

# **PlanIt Greener**

15 MINUTES, INC. (PENNSYLVANIA CORPORATION)  
1982 BUTLER PIKE  
CONSHOHOCKEN, PA 19428

WEBCASTS IN THE FIELD OF ECOLOGY AND ENVIRONMENTAL STUDIES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FOR: EDUCATION SERVICES, NAMELY, CONDUCTING EXHIBITIONS AND DISPLAYS AND INTERACTIVE EXHIBITS IN THE FIELD OF ECOLOGY AND ENVIRONMENTAL STUDIES, PRODUCTION OF TELEVISION PROGRAMS AND

FIRST USE 3-0-2007; IN COMMERCE 3-0-2007.

SN 76-673,727, FILED 3-7-2007.

ANNE MADDEN, EXAMINING ATTORNEY



United States Patent and Trademark Office

Home | Site Index | Search | Guides | Contacts | eBusiness | eBiz alerts | News | Help



**Electronic System for Trademark Trials and Appeals**

**Receipt**

Your submission has been received by the USPTO.  
The content of your submission is listed below.  
You may print a copy of this receipt for your records.

ESTTA Tracking number: **ESTTA439413**

Filing date: **11/04/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<b>Application Serial No.</b>	77920002
<b>Applicant</b>	Discovery Communications, LLC

**Notice of Appeal**

Notice is hereby given that Discovery Communications, LLC appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 77920002.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following classes of goods/services:

- Class 009.  
All goods and services in the class are appealed, namely: Pre-recorded video disks, audio-visual recordings, videotapes, compact disks, DVDs and CD-ROMs in the field of general human interest
- Class 038.  
All goods and services in the class are appealed, namely: Communications services, namely, transmitting streamed sound and audio-visual recordings via the Internet, cable networks, wireless networks, satellite, or interactive multimedia networks; audio and video broadcasting services over the Internet; transmission of information in the audio-visual field; television broadcasting services; cable television broadcasting; satellite television broadcasting; mobile media services in the nature of electronic transmission of entertainment media content; podcasting services; webcasting services; video-on-demand transmission services; providing on-line chat rooms and electronic bulletin boards for transmission of messages in the field of general interest
- Class 041.  
All goods and services in the class are appealed, namely: Entertainment services, namely, multimedia programs in the field of general interest, distributed via various platforms

across multiple forms of transmission media; providing entertainment information regarding ongoing television programs via a global computer network; production of television programs; production of multimedia programs

Respectfully submitted,

/Amy E. Salomon/

11/04/2011

**AMY E SALOMON**

**ARENT FOX LLP**

**1050 CONNECTICUT AVE NW**

**WASHINGTON, DC 20036-5303**

**UNITED STATES**

**tmdocket@arentfox.com, makings.linda@arentfox.com, salomon.amy@arentfox.com,  
lupo.anthony@arentfox.com, jones.margaret@arentfox.com**

**202.857.6000**

**[Return to ESTTA home page](#) [Start another ESTTA filing](#)**

**[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)**