IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Application No.: Filed: Mark: Glow Event Design, LLC.) 88125289) September 20, 2018) GLOW) USPTO Law Office 121 Attorney: Justine N. Burke

RESPONSE

Dear Mr. Burke:

On behalf of our Client, Glow Event Design, LLC ("Applicant"), we are in receipt of your Office Action dated January 3, 2019, in which the pending application No. 88125289 ("Application") has been refused because of possible likelihood of confusion with the registered marks No. 3848090 and 3847771 in class 41 (Registrant").¹ Applicant hereby respectfully requests reconsideration of the application identified above for the reasons stated below.

Likelihood of Confusion

The registration of the Application has been refused by Examining Attorney contending that the proposed mark, "GLOW", poses a possible likelihood of confusion with the registered marks Nos. 3848090 and 3847771 pursuant to 15 U.S.C §1052(d) using the factors set forth in *In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).* Examining Attorney has specifically refused the Application referencing similarity of the marks and the relatedness of the compared services as the most relevant factors pursuant to *In re i.am.symbolic, Ilc, 866 F.3d at 1322, 123 USPQd at 1747 (Fed. Cir. 2002).* We respectfully disagree with Examining Attorney's analysis and contend that the Applicant's mark is not confusingly similar as there is no likelihood that potential consumers will be confused or mistaken to the source of services as they are distinctively unrelated and therefore the pending Application should be entitled to registration on the Principal Register based on the following facts:

A) Comparison of the Marks

As confirmed by Examining Attorney, a determination of a likelihood of confusion under section 2(a) is made on a case-by-case basis using the applicable *du Pont* factors. In his analysis for determining a likelihood of confusion, the Examining Attorney further confirms that marks are compared in their entireties for similarities in appearance, sound, connotation and commercial impression. Based on the following facts of each parties use of its respected mark in relation to each of their distinctive services, Applicant's mark is distinguishable from Registrant's mark and therefore no likelihood of confusion:

i) Applicant's Mark as Compared to Mark in US Registration No. 348090 "GLOW"

¹ Both registrations 3848090 and 3847771 are owned by the same registrant Panorama Productions, LTD. in which first registration is for the word mark "Glow" in class 41 and second registration for design mark that includes the words "Glow Washington DC" in class 41. For purpose of this response and our analysis of the mark GLOW as used in commerce by the owner of both these registrations, we will refer to the owner as "Registrant".

While Applicant does not dispute that its mark is identical in appearance, sound and meaning to Registrant's mark "Glow", the Applicant asserts that the use of the mark in its totality is significantly different and creats a completely distinctive and substantially distinguishable overall commercial impression when considered in connection with each of the parties' respective services.

As stated in Examining Attorney's analysis, conflicting marks are to be compared by taking them as a whole rather than breaking them up into multiple parts for comparison. In evaluating a likelihood of confusion for conflicting marks, one must look at the impression of the consumer relating to the product and whether or not they will be confused in the marketplace. *See* TMEP §1207.01(b). The commercial impression of the marks must be distinguishable, which consumers perceive when taking the mark as its entirety. See *Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A 1972)* (found that the commercial impression created by the mark as a whole differed from the impression when dissected). For your reference, attached are a copy of each of the parties various online marketing and promotions attached herein as **Exhibit A** and incorporated by reference.

The attachment includes a side by side comparison of each Parties About Us webpage, their respective Facebook pages and online searches for their respective business on Facebook, Google and LinkedIn. As evidenced by the actual use of the parties' marks in commerce, looking at the Registrant's as a whole composite mark establishes the distinguishable nature of the mark in comparison to Applicant's mark as applied to the services and the overall impression made on the consumers. In fact, Registrant's entire online marketing and promotions continuously uses the qualifier "Club" in combination with "Glow" to target its specific consumers for its night club services in Washington DC while Applicant uses the description "event" to quality its services as an event coordinator/planner. The parties actual use in commerce distinguishes the nature of their respective marks as applied to each of their distinctive services creating a substantially independent and separate overall commercial impression when considered in connection with each of the parties' respective services and targeted consumers. As a result of the distinguishable difference in their use each respective mark is not confusingly similar for the consumers.

In addition to above, it is worth noting that the Parties have co-existed in the marketplace using each of their respective marks in commerce concurrently for the last decade without any evidence of actual consumer confusion. A lack of evidence of actual confusion when parties have coexisted for extended period of time suggests that consumers are unlikely to be confused and this should weigh in favor of a finding of no likelihood of confusion. *See Citigroup Inc. v. Capital city Bank Group Inc.*, 94 USPQ2d 1645, 2010 WL 595586, at *17 (TTAB 2010), aff'd, 637 F.3d 1344 (Fed. Cir. 2011).

ii) Applicant's Mark as Compared to Mark in US Registration no. 3847771 "Glow Washington DC" and Design

While Applicant does not dispute that its mark "GLOW" is included within literal element of the Registrant's Design Mark, Applicant respectfully disagrees that it merely deleted the other wording element of "Washington DC" to create its own mark. Applicant asserts that the use of the mark in its totality is significantly different from Registrant's design mark and creates a completely distinctive and substantially distinguishable overall commercial impression when each mark is considered in its totality and in connection with each of the parties' respective services.

In his analysis, the Examining Attorney has made the argument that essentially the dominant feature of Registrant's design mark is its literal word "Glow" as the other portion of the literal element

"Washington DC" is merely descriptive therefore less significant. In addition, he has argued that in evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make greater impression upon purchasers, be remembered by them and be used by them to refer to or request services and therefore granting the design element a lesser value as a whole.

While Applicant does not dispute that the word portion of a composite mark is normally accorded greater weight, based on Registrant's actual use of its mark in commerce, Applicant respectfully disagrees that the word "Glow" alone is the dominate portion of the literal element of Registrant's design mark. The dominant part of the mark is the part that makes the overall impression on the consumer, making it the part that consumers remember the most.² While marks may share identical features, they must be viewed in their totality and the intended overall impression by the logo and context in which they are presented to the consumers. See *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing and Pub. Co. v. Meredith Corp., 991 F.2d 1072, 1078* (2nd Cir. 1993) (finding that due to the overall impression by the logos and context in which they are found and considered, PARENT'S DIGEST and PARENTS were not sufficiently similar to prevent their use).

Registrant's services are specific to hosting night club and dance events at its own venue and other similar events in Washington DC. In all its marketing and promotion, it specifically references its services being in Washington DC.³ In fact, any online search of "Glow" alone does not find Registrant's night club unless the search also includes the wording "*DC*", "*Washington DC*" or "*Club*".⁴ Based on the actual use in commerce, if one was to analyze the literal element of Registrant's design mark for purpose of a dominant part, Applicant contends that the entire wording "Glow Washington DC" is the dominant word. The impression on the consumer is given by the entire mark rather than one part of it; thus, the whole mark is the dominant portion. *See Smith v. Tobacco By-Products and Chemical Corp., 243 F.2d 188, 189 (C.C.P.A. 1957)* (Both "GREEN LEAF" and "BLACK LEAF" were the dominant portions rather than the term "leaf" standing alone).

Additionally, conflicting marks are to be compared by taking them as a whole rather than breaking them up into multiple parts for comparison.⁵ In evaluating conflicting marks the courts look at the impression of the consumer relating to the product and whether or not they will be confused in the marketplace.⁶ Courts have held that sharing a common word alone is not sufficient evidence of likelihood of confusion and the marks have to be looked at in their entirety and the meaning they convey to the consumers.⁷ In *Colgate-Palmolive*, the conflicting marks were PEAK for dentifrice and PEAK PERIOD for personal deodorant. The court found no likelihood of confusion because the word "peak" alone conveyed a different meaning than the term "peak period."⁸ They found that the definition of "peak" denoted the top of a hill or mountain while "peak period" indicated a well-known phrase that conveyed the meaning of reaching the high point of something.⁹ The court held that these two meanings substantially differ, demonstrating the importance of looking at the mark in its entirety when making the ultimate decision about the likelihood of confusion.¹⁰

² 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, 4th ed. §23:44 (2014)

³ A copy of Registrant's "About Us" website page and Facebook page are attached herein as <u>Exhibit B</u> and incorporated by reference.

⁴ A copy of online search results for the words "*Glow*", "*Glow DC*" "*Club Glow*" and "*Club Glow Washington DC*" are attached herein as **Exhibit C** and incorporated by reference.

⁵ 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, 4th ed. §23:41 (2014)

⁶ TMEP §1207.01(b).

⁷ Colgate-Palmolive Co. v. Carter-Wallace, Inc. 432 F.2d 1400 (C.C.P.A. 1970),

⁸ Id.

⁹ See Id. at 1401

¹⁰ See id. at 1402

In addition, as referenced in section (i) above, the parties actual use in commerce distinguishes the nature of their respective marks as applied to each of their distinctive services creating a substantially independent and separate overall commercial impression when considered in connection with each of the parties' respective services and targeted consumers. As a result of the distinguishable difference in their use each respective mark is not identical nor it is confusingly similar for the consumers.

Also as mentioned, the Parties have co-existed in the marketplace using each of their respective marks in commerce concurrently for the last decade without any evidence of actual consumer confusion. Nor has the Applicant's mark ever appeared to prospective customers as a shorten form of Registrant's marks as demonstrated by the exhibits of actual use in commerce attached herein. A lack of evidence of actual confusion when parties have coexisted for extended period of time suggests that consumers are unlikely to be confused and this should weigh in favor of a finding of no likelihood of confusion.

Based on the above facts and specific to each party's use of its respected mark in relation to their distinctive services, Applicant's mark is distinguishable from Registrant's mark and therefore no likelihood of confusion.

B) Comparison of Services

With respect to comparison of the services provided by Applicant and Registrant, clearly each of their services fall under the primary class 41 for entertainment services. However, not only there is no relation to the actual services being offered, but there is also a clear and significant difference between the party's respective services¹¹. While Registrant offers night club services at its venue in Washington DC, Applicant is an event planner/coordinator for private and corporate clients with no overlap between their services. In fact, by the definition of each of their respective services, they provide a very distinguishable service to their targeted consumers that have very different need in the market. While Registrant's consumers would be seeking the Registrant's night club services for an evening or a specific music event at their venue in Washington DC for a per person ticket purchased online or at Registrant's venue, Applicant's clients are individuals or corporations who seek Applicant's expertise to assist them with coordination and planning of a one of a kind large scale future event such as a wedding or a conference that will require retaining of Applicant's services in advance. For your reference, attached are a copy of Wikipedia and Dictionary definitions of each of the parties' specific services attached herein as **Exhibit D** and incorporated by reference.

As a result of the specific type of services offered by each party, the channel of trade and classes of customers are substantially different with no possibility of an overlap resulting in no likelihood of confusion between the marks. The main consideration in evaluating a possible likelihood of confusion is whether or not the marks are so similar as to confuse the source or sponsorship of the goods.¹² When considering whether there would be confusion among customers, the court "stands in the shoes" of the ordinary purchaser of the goods while giving the attention that the particular purchasers would give in the particular circumstances. See Id. Looking at the conditions of the purchase and consumers, the likelihood of confusion is decreased. *See Luigino's, Inc. v. Stouffer Corp., 170 F.3d 827, 831 (8th Cir. 1999).*

In the case of *Luigino's, Inc. v. Stouffer Corp.,* the conflicting marks were LEAN CUISINE and LEAN 'N TASTY, both for dietary foods. The court found that both marks had identical meanings but the

¹¹ Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369-71, 101 USPC2d 1713, 1722-23 (Fed. Cir. 2012) ¹² TMEP § 1207.01

overall impression created by the marks was not confusingly similar.¹³ The court held that the targeted consumers of both products were a special class that would tend to examine the front of the product and determine the brand and kind of entrée and decide based on this small investigation of the products.¹⁴ They found that this deterred the likelihood of confusion among the mark owner's consumers.

Similar to *Luigino's Inc.*, in this particular case the consumers will take the time to differentiate the marks and find the company that is desired. If one visits the website for the Registrant's mark, one would see that the website goes by the name of "Club Glow" offering event tickets for its featured artist at its venue in Washington DC. In fact, there is no mistaking from the Registrant's website that it is a night club in Washington DC featuring various musicians on specific dates in which one can buy a ticket for online. On the other hand, the typical consumers purchasing Applicant's services will have a budget for a private or corporate event in which based on that they will negotiate a contract with Applicant for coordinating and planning a customize theme event for a specific date in the future. The same as for the Registrant, there is no mistaking from Applicant's website that it provides private or corporate event planning and there is no option to purchase any services other than contacting Applicant for a consultation. Compare *Luigino's, Inc.* 170 F.3d at 831 (found that consumers shopping for dietary foods will take extra care in their purchases lessening the likelihood of confusion between LEAN CUISINE and LEAN 'N TASTY). Combining the sophistication of the consumers and the clear and significant difference between the party's respective services eliminates any likelihood of confusion with the Registered marks.

While Applicant's relevant services do include arranging, organizing and planning events for its client's special events, it does not host or conduct the event or provide any night club entertainment services as it does not have a venue. In fact, Applicant respectfully disputes the conclusion made by Examining Attorney that its professional event planning and coordination services are of a type that are commonly provided by a single source under the same mark. Specifically, all the attached evidence in support of this conclusion, including TAO Las Vegas, Rosebar, Temple and The Gryphon are all night club service providers with specific venue similar to Registrant's services and none provide the event planning and coordination services. While they do offer their venue for private and corporate events, none provide customize event planning and organization services for clients. Notwithstanding, Applicant understands that its wording for identification of its services under class 41, specifically "*entertainment services, namely conducting parties*" it too broad and it will gladly amend its application to narrow the wording to ensure limiting its identification of services accordingly.

In view of the foregoing and in consideration that the Parties have co-existed in the marketplace using each of their respective marks in relation to their unrelated services in commerce concurrently for the last decade without any evidence of actual consumer confusion, Applicant respectfully requests the Examining Attorney to withdraw his objections based § 2(d) of the Trademark Act and forward the application for publication in the Official Gazette. Favorable action is therefore requested. Thank you in advance for your consideration.

¹³ Id. at 830

¹⁴ Id. at 831.

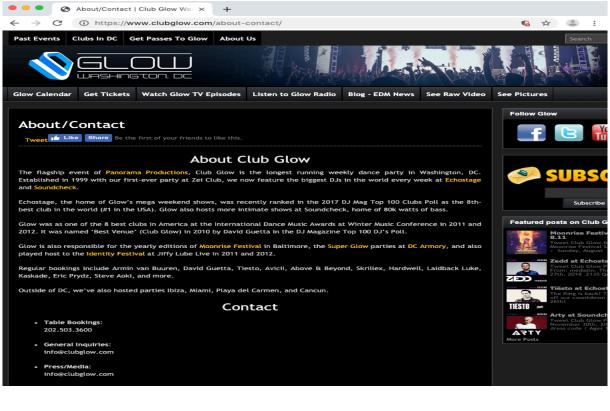
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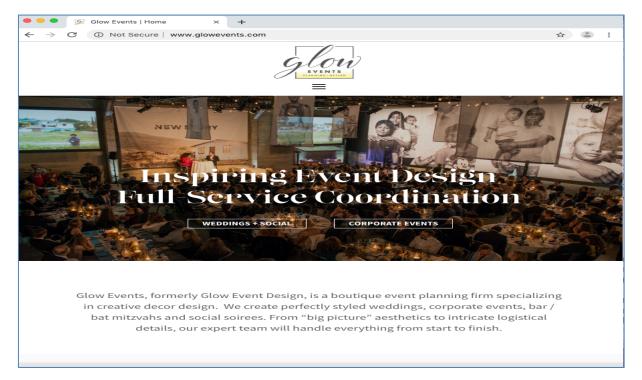
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Mahsa Hakimi, Attorney for Applicant

Address:	916 Kearny St., Suite 604
	San Francisco, CA 94591
Phone:	415-255-4503
Email:	mahsa@hakimilaw.com

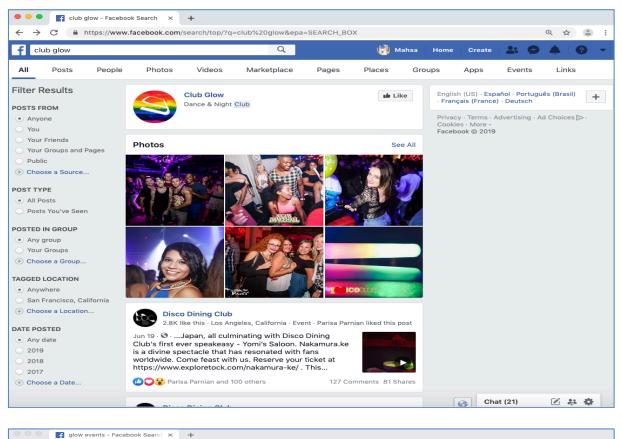
EXHIBIT A

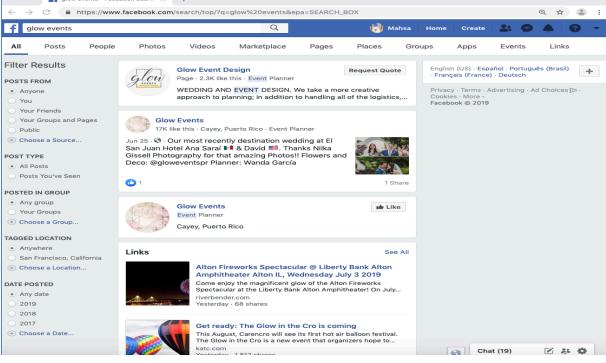




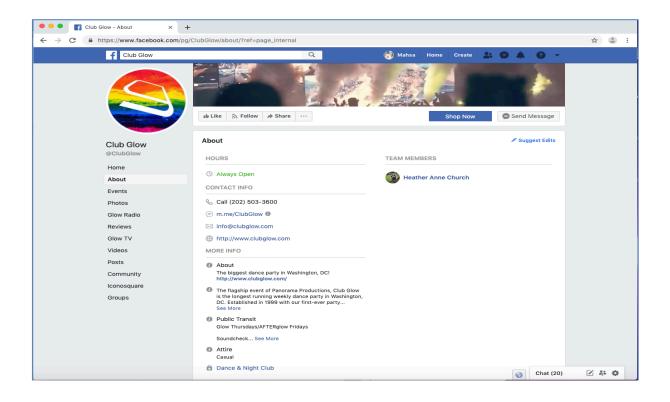
1. REGISTRANT & APPLICANT <u>ABOUT US PAGES</u> (as of 07/02/2019)

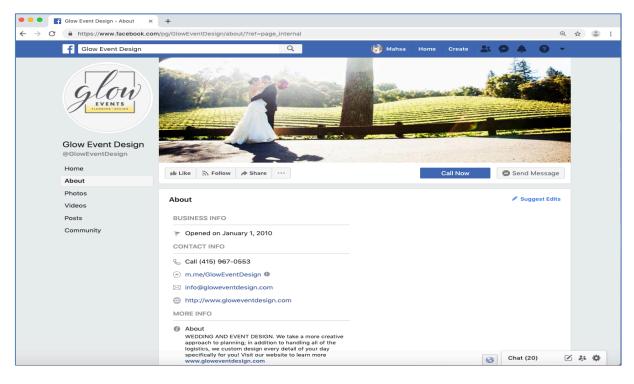
GLOW-Response to Office Action Serial No. 88125289





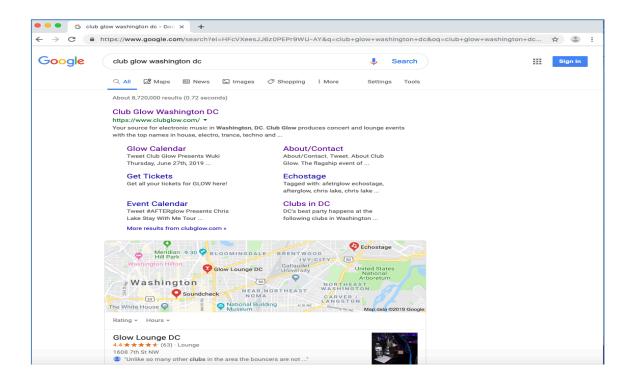
2. REGISTRANT & APPLICANT <u>FACEBOOK SEARCH PAGES</u> (as of 07/02/2019)

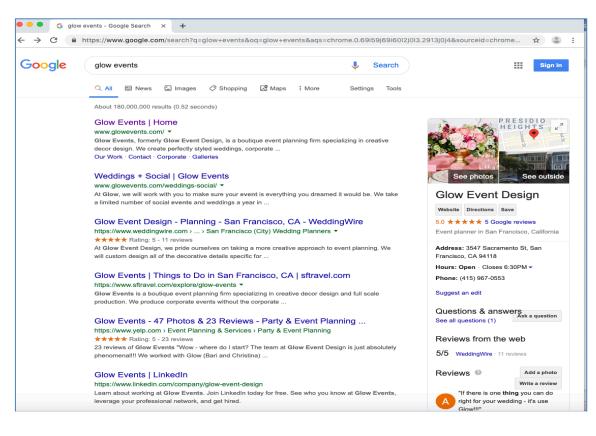




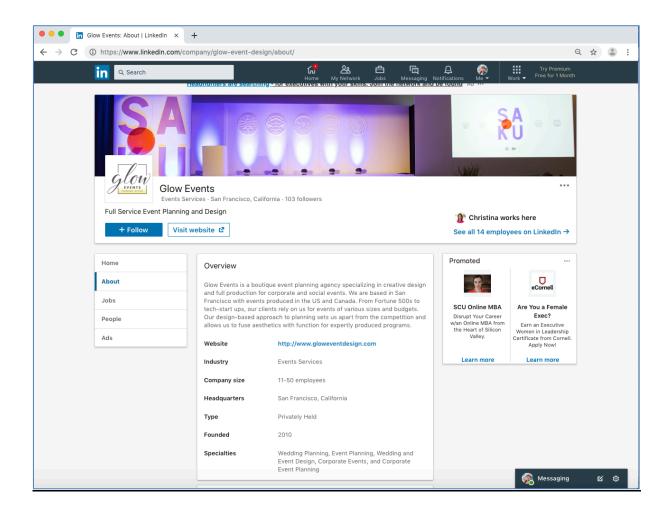
3. REGISTRANT & APPLICANT FACE BOOK PAGES

(as of 07/02/2019)





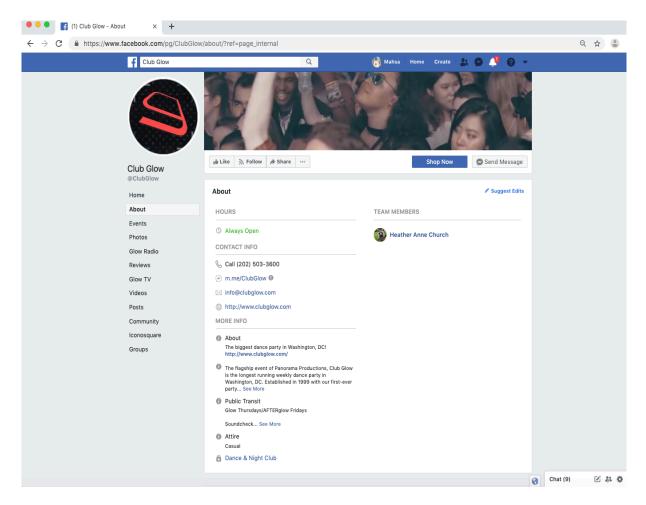
4. REGISTRANT & APPLICANT GOOGLE SEARCH (as of 07/02/2019)



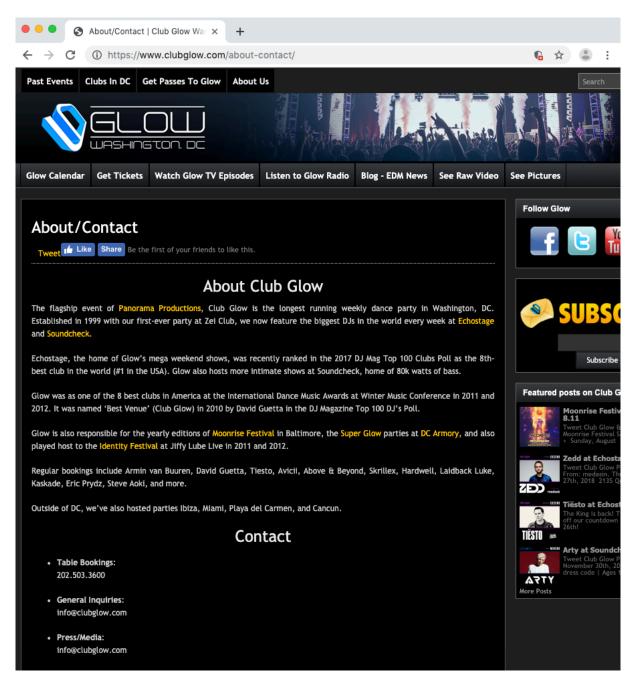
5. APPLICANT LINKEDIN PAGE

(as of 07/02/2019)

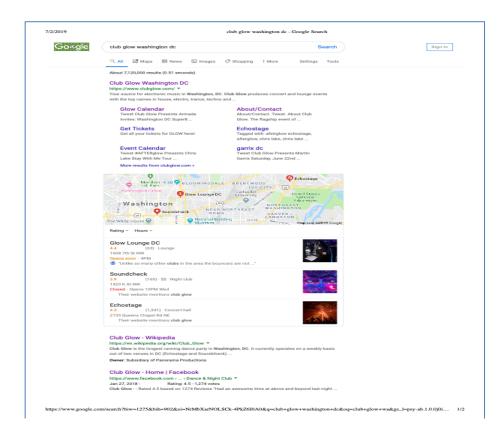
EXHIBIT B

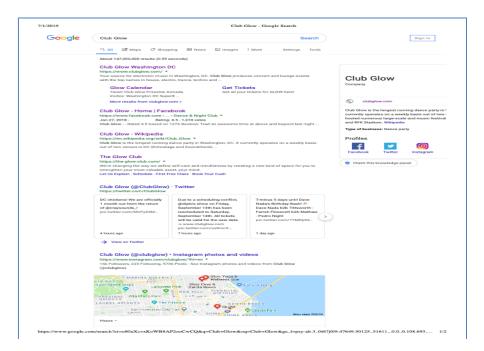


1. REGISTRANT <u>FACEBOOK PAGE</u> (as of 07/02/2019)



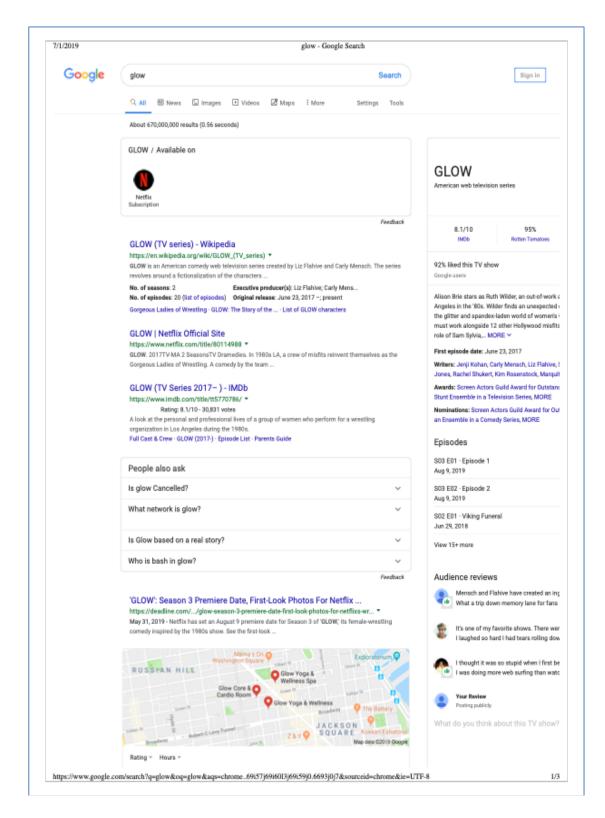
 REGISTRANT WEBSITE - <u>ABOUT US PAGE</u> (as of 07/02/2019)

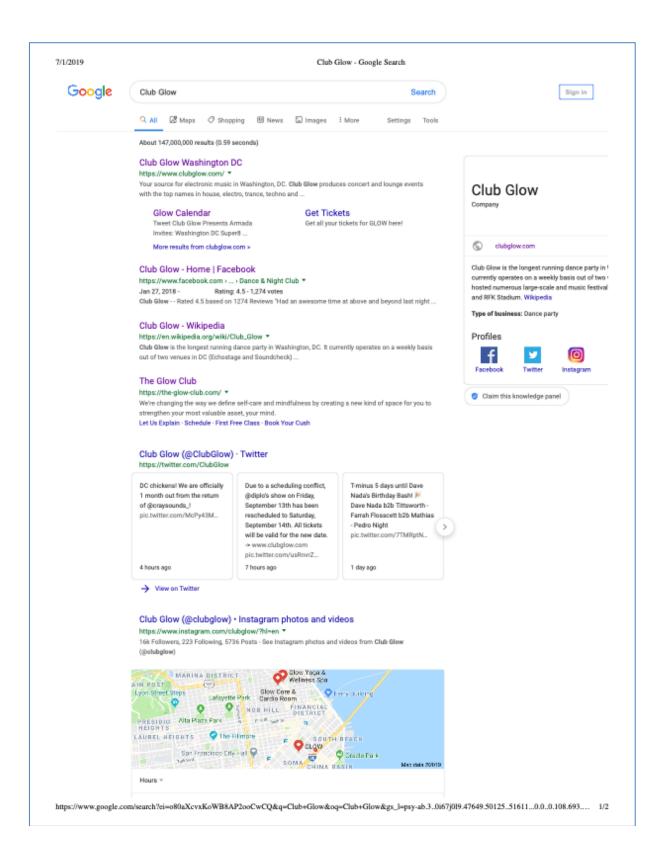


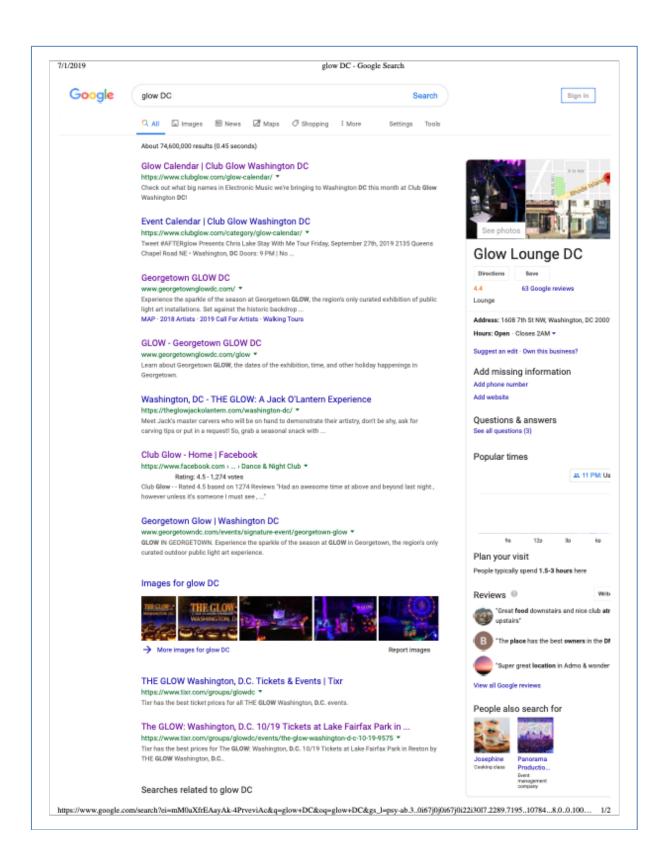


3. REGISTRANT GOOGLE SEARCH (as of 07/02/2019)

EXHIBIT C







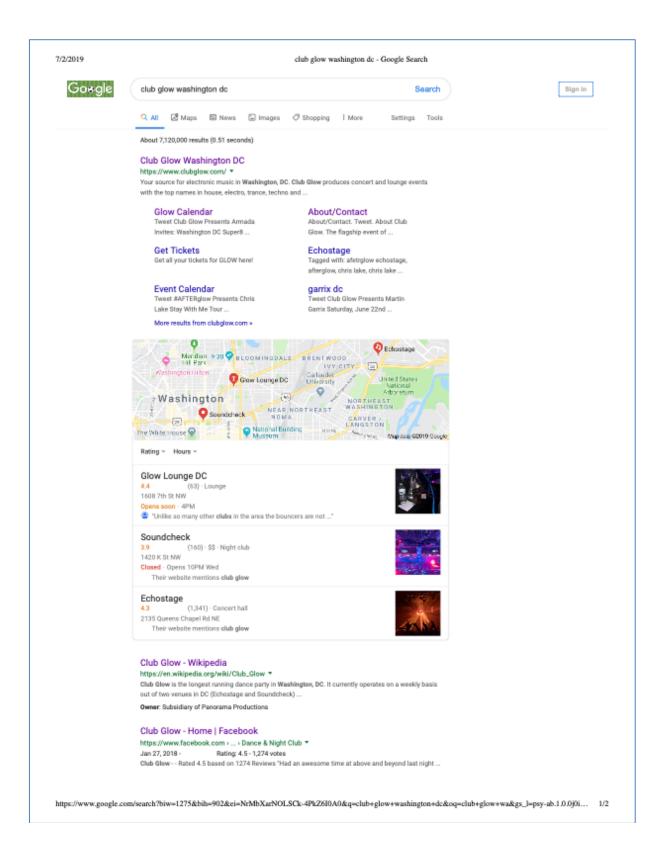


EXHIBIT D

Dictionary & Wikipedia Definitions

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Nightclub - Wikipedia

6/27/2019

Nightclub

WIKIPEDIA

A **nightclub**, **music club** or **club**, is an entertainment <u>venue</u> and <u>bar</u> that usually operates late into the night. A nightclub is generally distinguished from regular bars, <u>pubs</u> or <u>taverns</u> by the inclusion of a stage for live music, one or more <u>dance floor</u> areas and a <u>DJ</u> booth, where a DJ plays recorded music. The upmarket nature of nightclubs can be seen in the inclusion of VIP areas in some nightclubs, for celebrities and their guests. Nightclubs are much more likely than pubs or sports bars to use <u>bouncers</u> to screen prospective clubgoers for entry. Some nightclub bouncers do not admit people with informal clothing or gang apparel as part of a <u>dress code</u>. The busiest nights for a nightclub are Friday and Saturday night. Most clubs or club nights cater to certain <u>music</u> genres, such as <u>house music</u> or <u>hip hop</u>. Many clubs have recurring club nights on different days of the week. Most club nights focus on a particular genre or sound for branding effects.^[1]

Contents

History

Early history 1960s 1970s: Disco 1980s 1990s, 2000s, and 2010s

Entry criteria

- Cover charge Dress code Exclusive boutique clubs Guest list
- Economic effects Noise pollution
 - Substance abuse Solutions

Photography

Security Serious incidents See also References External links

History

https://en.wikipedia.org/wiki/Nightclub

Night club



Laser lights illuminate the dance floor at a trance music event in a nightclub (Sheffield, 2006)

General information

Genres included	Electronic dance music
Location	Worldwide
Types of street rave dance	Hakken · Para Para · Rebolation · Melbourne Shuffle
Related events	Music festival • metal festival • rock festival • electronic dance music festival • technoparades • acid house party • doof • trance festival • teknival • algorave • free festival • free party • circuit party • concert tour
Related topics	Rave · Smiley · Disc jockey · VJing · Light beam · Loudspeaker · Sound system · Club drugs · MDMA · 2C-B

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Wedding planner - Wikipedia

6/27/2019

WIKIPEDIA

Wedding planner

A **wedding planner** is a professional who assists with the design, planning and management of a client's <u>wedding</u>. Weddings are significant events in people's lives and as such, couples are often willing to spend considerable amount of money to ensure that their weddings are well-organized. Wedding planners are often used by couples who work long hours and have little spare time available for sourcing and managing wedding venues and wedding suppliers.



A planner at a Chilean wedding

event

Professional wedding planners are based worldwide but the industry is the largest in the USA, India, western Europe and China.^{[1][2]} Various wedding planning courses are available to those who wish to pursue the career.^[3] Planners generally charge either a percentage of the total wedding cost, or a flat fee.^{[4][5]}

Planners are also popular with couples planning a <u>destination wedding</u>, where the documentation and paperwork can be complicated. Any country where a wedding is held requires different procedures depending on the nationality of each the bride and the groom. For instance, US citizens marrying in Italy require a <u>Nulla Osta</u> (affidavit sworn in front of the US consulate in Italy), plus an *Atto Notorio* (sworn in front of the Italian consulate in the US or at a court in Italy), and legalization of the above. Some countries instead have agreements and the couple can get their <u>No Impediment</u> forms from their local registrar and have it translated by the consulate in the country of the wedding. A local wedding planner can take care of the different procedures.

Contents

Services In popular culture See also References

Services

The services of a wedding planner may include:

- Interview the couple and parents to identify their needs.
- Preparation of the budget
- Design and style of the event
- Scouting locations
- Photoshoots
- Planning a detailed checklist (about a year in advance for a few days after the wedding) [6]
- Preparation of the list of participants
- Identification of venues for events (hotels, party house, ceremony, church, temples etc.)

https://en.wikipedia.org/wiki/Wedding_planner

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Event management - Wikipedia

7/2/2019

WikipediA

Event management

Event management is the application of project management to the creation and development of large-scale events such as <u>festivals</u>, conferences, ceremonies, weddings, formal parties, concerts, or <u>conventions</u>. It involves studying the brand, identifying its <u>target audience</u>, devising the event concept, and coordinating the technical aspects before actually launching the event.^[1]

The events industry now includes events of all sizes from the <u>Olympics</u> down to business breakfast meetings. Many industries, <u>charitable organizations</u>, and interest groups hold events in order to market themselves, build business relationships, raise money, or celebrate achievement.

The process of planning and coordinating the event is usually referred to as **event planning** and which can include budgeting, scheduling, site selection, acquiring necessary <u>permits</u>, coordinating transportation and parking, arranging for speakers or entertainers, arranging decor, event security, <u>catering</u>, coordinating with third party vendors, and emergency plans. Each event is different in its nature so process of planning & execution of each event differs on basis of type of event.

The **event manager** is the person who plans and executes the event, taking responsibility for the creative, technical, and logistical elements. This includes overall event design, brand building, marketing and communication strategy, <u>audio-visual</u> production, script writing, logistics, budgeting, negotiation, and client service.

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Strategic marketing and communication

Event management might be a tool for <u>strategic marketing</u> and communication, used by companies of every size. Companies can benefit from promotional events as a way to communicate with current and potential customers. For instance, these advertising-focused events can occur as press conferences, promotional events, or product launches.

Event managers may also use traditional news media in order to target their audience, hoping to generate media coverage which will reach thousands or millions of people. They can also invite their audience to their events and reach them at the actual event.^[2]

Event venue

https://en.wikipedia.org/wiki/Event_management

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