

10-06-04 /M



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

Atty. Ref.: 0820312.0277

In re Application of

AstraZeneca AB

Serial No.: 78/176,053

Filed: October 18, 2002

Mark: **PURPLEPILL.COM**
-----X

Law Office: 116

Exam. Atty: William Patrick Shanahan

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I hereby certify that this paper or fee is being deposited with the United Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

Signature *Julio Simmons*
JULIO SIMMONS

Printed Name
October 5, 2004

Date

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BOX RESPONSES
NO FEE

**RESPONSE TO "PRIORITY ACTION FINAL"
AND REQUEST FOR RECONSIDERATION**

SIR:

Responding to the "Priority Action Final" dated December 5, 2003, the Examining Attorney refused registration of the subject service mark on the Principal Register, on the ground that it is "merely descriptive" of applicant's services. The Examining Attorney also suggested that applicant submit a claim of acquired distinctiveness under Section 2(f) of the U.S. Trademark Act. Applicant now requests amendment of this application to claim acquired distinctiveness under Section 2(f), and submits the enclosed "Declaration of Distinctiveness"



from an officer of applicant's related U.S. company¹ that is primarily responsible for the marketing of applicant's "Purple Pill" medications in the U.S.A. and the promotion of said products, e.g., through the informational services offered via the "purplepill.com" web site.

The declarant alleges that the subject mark has become distinctive of the goods for which the mark is sought to be registered, by reason of (a) substantially exclusive and continuous use of said mark in commerce by the applicant for said goods for more than four and one-half (4.5) years preceding the date of execution of the declaration, (b) the applicant's registration on the Principal Register of "the color purple as applied to the goods or to containers therefor" as a trademark for pharmaceutical preparations and substances for the treatment of gastrointestinal diseases, (c) the applicant's extensive promotion of the color purple as a trademark for its aforementioned goods, which has resulted in trade and public recognition of said color as a trademark, and (d) the widespread public awareness of the domain name/service mark "purplepill.com" for applicant's information services relating to the aforementioned goods, which are known to the public as "The Purple Pill", and the association of said goods and their source of origin with the words "Purple Pill" and "purplepill.com".

Applicant had previously informed the Examining Attorney that its application to register the color purple *per se* was in the course of being published. Applicant can now claim ownership of Reg. No. 2,806,099, for "the color purple as applied to the goods or to containers therefor", as a trademark for pharmaceutical preparations and substances for the treatment of gastrointestinal diseases. (Please see Exhibit "A" annexed to the enclosed "Declaration of Distinctiveness".) Applicant's color trademark was registered on the basis of acquired distinctiveness and we now seek registration of the related word mark "purplepill.com" on the

¹ If so requested by the Examining Attorney, applicant (AstraZeneca AB) will be pleased to execute a Section 2(f) claim in its own name.

same basis. If applicant's purple-colored capsules have acquired distinctiveness in respect of applicant's gastrointestinal pharmaceutical preparations, then, *a fortiori*, the words "purplepill.com" must also have acquired distinctiveness in respect of the service of providing information about gastrointestinal diseases and medications.


The evidence set forth in the enclosed "Declaration of Distinctiveness" illustrates how applicant's "Purple Pill" medications became the largest selling pharmaceutical product in the U.S.A. at their sales peak, and how applicant engaged in an unprecedented level of advertising and promotion, including "look for" advertising to associate the color purple and the words "PURPLE PILL" with its goods. Applicant also made extensive use of the words "PURPLEPILL.COM" as a source-identifier. Applicant achieved a high level of media and public recognition of said colors and words, e.g., "Perhaps only Welch's, the Minnesota Vikings and Oprah Winfrey are as closely linked to the color purple as "Prilosec". (Please see Exhibit "G" annexed to the enclosed "Declaration of Distinctiveness".) Applicant's efforts to promote the arbitrary, non-functional color purple as a trademark, and its sales volume for its goods, far exceeded the efforts made to protect the well-known "pink" color trademark for fibrous glass residential insulation (see *In re Owens-Corning Fiberglass Corporation*, 227 USPQ 417 (Fed. Cir. 1985), or the showing made to achieve publication of the color purple for sandpaper by the 3M Company (see U.S. Appl. Ser. No. 75/488,524).

IN CONCLUSION, applicant requests reconsideration of the final refusal of registration and prays that the subject application be approved for publication in the *Official Gazette* since applicant has complied with all outstanding requirements and established a valid basis for registration.

Respectfully submitted,

AstraZeneca AB

Dated: October 5, 2004

By  _____

Keith E. Danish

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Attorneys for Applicant

Of Counsel: Mark I. Peroff, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Julie Simms
(Signature of person mailing paper or fee)

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Declaration of Distinctiveness

To the Commissioner of Patents and Trademarks:

The undersigned, Linda S. Palczuk, declares that:

1) I am Executive Director, Commercial Operations of AstraZeneca Pharmaceuticals LP, a U.S. affiliate of AstraZeneca AB, which is the applicant for registration of the above-identified service mark, and I am fully familiar with the use and promotion of the subject service mark and the use and promotion of the color purple as a trademark of AstraZeneca AB in the United States of America. My company and the applicant are both owned by AstraZeneca PLC, and my company is primarily responsible for marketing of "PRILOSEC"® and "NEXIUM"® gastrointestinal pharmaceutical preparations in the United States of America.

NY-323964

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