

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/322290

MARK:

77322290

CORRESPONDENT ADDRESS:

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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Agrium Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

7002/TM

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

The assigned examining attorney has reviewed the referenced application and determined the following.

Refusal Under Sections 1, 2 and 45 of the Trademark Act

Registration is refused because the proposed color mark, consisting of color applied to the identified goods, is merely an ornamental or decorative feature of such goods and thus would not be perceived as a trademark. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127; *See Qualitex Co. v. Jacobson Products Co.*, 115 S.Ct. 1300, 34 USPQ2d 1161 (1995); *In re Owens-Illinois Fiberglass Corporation*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re Deere & Co.*, 7 USPQ2d 1401 (TTAB 1988); TMEP §1202.05.

The applicant's proposed mark consists of the color green as applied to the fertilizers. The applicant's proposed mark is merely an ornamental or decorative feature of such goods and will not be perceived as a trademark.

If the proposed mark identifies a color that is deemed functional for the identified goods, then it is not registrable on the Principal Register under §2(f), or the Supplemental Register. TMEP §1202.05(b).

A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995) (color black functional for outboard motors because it provides competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *In re Ferris Corporation*, 59 USPQ2d 1587 (TTAB 2000) (color pink used on surgical wound dressings is functional because the actual color of the goods closely resembles Caucasian human skin); *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (colors yellow and orange held to be functional for public telephones and telephone booths, since they are more visible under all lighting conditions in the event of an emergency); *In re Howard S. Leight & Associates Inc.*, 39 USPQ2d 1058 (TTAB 1996) (color coral held to be functional for earplugs, because it is more visible during safety checks).

A color may also be considered functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process.

Requirement for Additional Information

Applicant must provide the following information and documentation to permit proper examination of the proposed color mark, 37 C.F.R. §2.61(b):

- an explanation as to whether the identified color green serves any purpose as used on the goods;
- an explanation as to whether the identified color green is a natural by-product of the manufacturing process for the goods;
- any available advertising, promotional or explanatory literature concerning the goods, particularly any material that relates specifically to the proposed mark;
- an explanation as to the use of color in applicant's industry;
- a statement clarifying any other use of color by applicant;
- an explanation as to whether competitors produce the goods in the identified color(s) and in colors other than the identified color(s); and
- color photographs and color advertisements showing competitive goods.

Applicant may also submit any other evidence relevant to the issues in this case.

This information is necessary to evaluate accurately and fully the registrability of the applicant's proposed designation. 37 C.F.R. Section 2.61(b); TMEP § 814. If the applicant does not provide the information required herein, registration may be refused. The Trademark Rules of Practice have the effect of law and failure to comply with a request for information is grounds for refusal of registration. *In re DTI Partnership, L.L.P.*, 67 USPQ2d 1699 (TTAB 2003). See also *In re Page*, 51, USPQ2d 1660, 1665 (TTAB 1999); *In re Babies Beat, Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (TTAB 1978); *In re Air Products and Chemicals, Inc.*, 192 USPQ2d 84, 85-86 (TTAB 1976); and *In re Morrison Industries, Inc.*, 178 USPQ 432, 433-34 (TTAB 1973).

Section 2(f) Claim

The applicant's present claim of acquired distinctiveness is insufficient to overcome the refusal. The applicant has the burden of establishing the distinctiveness of the mark. See TMEP §§1202.04(d), 1202.04(e) and 1212 *et seq.* This has not been done in the present case.

In *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300, 34 USPQ2d 1161, 1162-3 (1995), the Supreme Court explained that marks consisting of a single color applied to the goods were unlike inherently distinctive words and designs which are immediately recognizable to consumers as marks, but that such color marks could attain "secondary meaning." The Court of Appeals for the Federal Circuit has noted that "by their very nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character." *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985). The Court reviewed the evidentiary submission of the applicant in *Owens-Corning*, which included advertising materials that emphasized the "pink" mark; radio and television commercials which highlighted the "pink" aspect of applicant's fiberglass and a consumer survey which showed consumer recognition as to the source of pink insulation to be 50%. The Court also noted that the applicant was the only manufacturer of this type of insulation that colored its insulation. Therefore, there was no "competitive need" for this color.

In cases involving color, it is crucial to prove distinctiveness to promote the color as a trademark. The fact that the colored goods appear in an advertisement or that the product is successful is not persuasive evidence that color is recognized as a mark. The Trademark Trial and Appeal Board has found that color marks, when properly promoted, can function as source indicators. The Board has held that the colors applied to livestock waterers function as a mark based on the following:

[T]he use thereof in its brochures and literature in the manner of a trademark, the reference in the advertisement material to the distinctive red and yellow paint job on its waterers and the acknowledgment by users of poultry and animal waterers that when they see a waterer with the colors red and yellow, they know it's a product originating with applicant...

In re Richie Mfg. Co., 170 USPQ 291, 292 (TTAB 1971).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following issue.

Description of Mark

Applicant must provide a concise description clearly indicating the location of the color in the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The following is suggested:

The mark consists of the color green used on the granules of fertilizers. The dotted lines around the granules of fertilizers are intended to show placement of the green color and are not claimed are part of the mark.

No Conflicting Marks

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Alice Benmaman/
Trademark Attorney
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RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.