

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:

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's communication filed on July 16, 2008. The applicant (1) amended the description of the mark, (2) argued against the refusal to register the mark under Sections 1, 2 and 45 of the Trademark Act, and (3) claimed that the cited registrations are owned by applicant's related company. No. 1 is acceptable.

The Section 2(f) claim is denied.

The refusal to register the mark under Section 2(d) and Section 2(e)(5) is continued and made **FINAL**.

Refusal Under Section 2(e)(5)

The refusal under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5), is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

The applicant seeks to register the color green as applied on the granules of fertilizers.

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.

The applicant stated that (1) the color green does not serve any other purpose as used on the goods other than as a trademark, (2) the color green

is not the natural by-product of the manufacturing process, and (3) it uses the color green as a trademark to identify a source of origin of its goods.

In support of registration under Section 2(f), applicant submitted advertising materials for the color green on the fertilizer. However, applicant's claim of acquired distinctiveness remains 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).

In this case, the proposed mark consists of the color green as applied to the fertilizers. Potential purchasers do not initially view such use of color as a trademark for the goods but as ornamentation. The relevant purchasing public would not view the proposed mark as being a source indicator but merely as ornamentation for the goods.

Long use of the mark is one relevant consideration in determining whether a mark has acquired distinctiveness. See *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (§2(f) claim of acquired distinctiveness of SPRAYZON for "cleaning preparations and degreasers for industrial and institutional use" found persuasive where applicant had submitted declaration of its president supporting sales figures and attesting to over eighteen years of substantially exclusive and continuous use); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence submitted by applicant held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, continuous and substantially exclusive use for sixteen years, deemed "a substantial period but not necessarily conclusive or persuasive"). However, in this case the amount of time the proposed mark has been used is not overwhelming.

Large scale expenditures in promoting and advertising goods under a particular mark are significant to indicate the extent to which a mark has been used. However, the examining attorney must examine the advertising material to determine how the proposed mark is being used therein, the commercial impression created by such use, and what such use would mean to purchasers. *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over \$500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). See also *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant's highly descriptive trade name."); *Packaging Specialists, Inc.*, 221 USPQ at 919 (evidence held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, \$50,000 in advertising expenses over a multi-year period, the Board finding the sum "not impressive as adequate to achieve general consumer identification for an enterprise operating nationally in ... a large service industry"); *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant's statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark).

Affidavits or declarations asserting recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. However, the value of the affidavits or declarations depends on the statements made therein and the identity of the affiant or declarant. Furthermore, proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate a mark with the applicant. *In re Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) ("Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer for paints

perceives the words 'PAINT PRODUCTS CO.' in conjunction with paints and coatings.”). *See also In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (affidavit of applicant’s counsel expressing his belief that the mark has acquired secondary meaning accorded “no probative value whatsoever” because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not considered persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff’d*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (retailer’s statement that he has been in contact with many purchasers of loudspeaker systems of whom a substantial number would recognize depicted design as originating with applicant deemed competent evidence of secondary meaning); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 206 (TTAB 1977) (“[T]he fact that the affidavits may be similar in format and expression is of no particular significance ... since the affiants have sworn to the statements contained therein.”). In this case, the applicant has not submitted any affidavits or declarations asserting recognition of the mark as a source indicator.

Here, applicant just submitted samples of advertisement materials as evidence of acquired distinctiveness, however, such evidence is insufficient to overcome the refusal. None of the advertisement materials references the color green. Just showing the goods in color in advertisements is not enough to establish acquired distinctiveness. Therefore, the evidence currently of record is inadequate to establish acquired distinctiveness in this case.

### **Likelihood of Confusion**

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 2551388 and 2554423. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

The applicant applied to register the color green for fertilizers. The registered marks are the color green for granular chemical preparations for use in the manufacture of fertilizers; and for granular fertilizer ingredient of blended fertilizers for professional, commercial, and domestic use.

The applicant requested that the refusal under Section 2(d) be withdrawn since the cited registrations are owned by applicant’s related company. However, a legal relationship with the related company is insufficient to overcome the likelihood of confusion unless the parties constitute a single source.

Applicant indicates that it has a legal relationship with the registrant in the cited registrations. However, a legal relationship between the parties is insufficient to overcome a likelihood of confusion unless the parties constitute a “single source.” That is, the legal relationship between the parties must exhibit a “unity of control” over the nature and quality of the goods and/or services in connection with which the trademarks and/or service marks are used, and a “unity of control” over the use of the trademarks and/or service marks. *See In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987); *see also* TMEP §§1201.03, 1201.07.

Unity of control is presumed in instances where, absent contradictory evidence, one party owns all of another entity, or substantially all of another entity and asserts control over the activities of the other entity. Such ownership is established, for example, when one party owns all or substantially all of the stock of another or when one party is a wholly owned subsidiary of another. *See In re Wella A.G.*, 5 USPQ2d at 1361; TMEP §1201.07(b)-(b)(ii).

However, in most other situations, additional evidence is required to show unity of control. For example, if the parties are sister corporations or if the parties share certain stockholders, directors or officers in common, additional evidence must be provided to show how the parties constitute a single source. *See In re Pharmacia, Inc.*, 2 USPQ2d 1883, 1884 (TTAB 1987); TMEP §1201.07(b)(iii). Additional evidence is also required if the relationship between the parties is that of licensor and licensee. *See Pneutek, Inc. v. Scherr*, 211 USPQ 824, 832-33 (TTAB 1981); TMEP §1201.07(b)(iv).

Therefore, applicant must provide a verified statement explaining the nature of the legal relationship between the parties. If neither party owns all or substantially all of the other party, applicant must also provide a detailed written explanation and any documentary evidence showing the parties’ “unity of control” over the nature and quality of the goods and/or services in connection with which the trademarks and/or service marks are used, and the parties’ “unity of control” over the use of the trademarks and/or service marks. The explanation must be verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33. TMEP §1201.07(b)(ii)-(iii). However, if one party owns all of the other entity,

and there is no contradictory evidence of record, the written statement need not be verified. TMEP §1201.07(b)(i).

The applicant's mark and the registered marks are identical, namely, the color green as applied to the fertilizers. If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i). Here, applicant's mark and the registered marks are used in connection with fertilizers and fertilizers ingredients. Since applicant's and registrant's goods travel in the same trade channels, confusion as to origin of said goods is likely.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988). Accordingly, the refusal to register the mark under Section 2(d) is made **FINAL**.

#### **Options**

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For technical assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; 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.