

From: Mahmoudi, Mariam

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Subject: U.S. TRADEMARK APPLICATION NO. 77721817 - COORDINATES -  
26240.589 - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

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Files: New\_Products\_Brochure\_Jan2010\_Page\_16.jpg, 77721817.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77721817

MARK: COORDINATES



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Masonite International Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

26240.589

**CORRESPONDENT E-MAIL ADDRESS:**

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## REQUEST FOR RECONSIDERATION DENIED

**ISSUE/MAILING DATE: 10/1/2010**

Applicant is requesting reconsideration of a final refusal issued/mailed March 2, 2010.

After careful consideration of the law and facts of the case, the trademark examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. §2.64(b); TMEP §715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

### **2(e)(1) – MERELY DESCRIPTIVE REFUSAL**

Registration is refused because the applied-for mark merely describes a feature, characteristic and purpose and/or function of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 et seq.

Applicant argues that its advertising materials "do not establish actual use of the mark in connection with the Applicant's goods" and that because "applicant has filed an intent-to-use application," these "materials are not tied to the Applicant's intended use of the

mark.” This argument is unpersuasive. The “fact that applicant has filed an intent-to-use application does not limit the examining attorney’s evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession.” *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006); *See also In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005), involving an intent-to-use application where the Federal Circuit found a press release cited by the examining attorney relevant to show the public’s perception of the goods. TMEP §1209.02. Moreover, as was previously stated in the final Office action dated March 2, 2010, material obtained from applicant’s website is acceptable as competent evidence in examination and ex parte proceedings. *See In re N.V. Organon*, 79 USPQ2d 1639, 1642-43 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1302-03 (TTAB 2006); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1898 (TTAB 2001); TBMP §1208.03; TMEP §710.01(b).

Attached to this action, please find additional evidence from applicant’s website which further establishes the descriptive nature of the mark. Specifically, in reference to its MASONITE COORDINATES line of goods, applicant’s brochure states that “Now, more than ever, it’s easy to choose one design to enhance your home décor, inside and out, with our new coordinating collection of interior and exterior glass designs.” The public will immediately perceive that applicant’s doors and door products are coordinates, namely, a “set of articles...designed to match or complement one other, as in style or color.” Therefore, the trademark examining attorney must deny the request for reconsideration and adhere to the final action as written

/Mariam Aziz Mahmoudi/  
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**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.

