

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85840400
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
Request for reconsideration in RESPONSE TO 2nd OFFICE ACTION	
<p>The Applicant is responding to the Office Action dated December 15, 2013, and files concurrently herewith a Notice of Appeal.</p>	
<u>Section 2(e)(1) Refusal – Deceptively Descriptive</u>	
<p>Applicant seeks registration of the mark CHALKBOARD PAPER in connection with the following goods in International Class 016:</p>	
<p style="padding-left: 40px;">Plastic drawing surfaces incorporating thermochromic pigments that change colors in response to fluctuation in temperature of the writing instrument.</p>	
<p>The Examiner rejects the mark CHALKBOARD PAPER for being “deceptively misdescriptive.” Nonetheless, we believe that the mark is registerable and so we traverse this rejection for the reasons explained below.</p>	
<p>Although the examiner cites to <i>In re White Jasmine LLC</i>, 106 USPQ2d 1385, 1394 (TTAB 2013) for a two part test, the Court of Appeals for the Federal Circuit has established a three-part test for determining whether a mark is deceptive pursuant to section 2(a):</p>	
<p>(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?</p>	
<p>(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?</p>	
<p>(3) If so, is the misdescription likely to affect the decision to purchase?</p>	
<p><i>In re Budge Mfg. Co., Inc.</i>, 857 F.2d 773, 775, 8 U.S.P.Q.2D (BNA) 1259, 1269 (Fed. Cir. 1988, <i>accord Hoover Co. v. Royal Appliance Mfg. Co.</i>, 238 F.3d 1357, 1361 (Fed. Cir. 2001).</p>	
<p>CHALKBOARD PAPER is not deceptively misdescriptive no matter which test is applied.</p>	

The mark CHALKBOARD PAPER cannot be deceptively misdescriptive because it primarily suggests a characteristic of the goods. These goods are in the nature of plastic drawing surfaces incorporating thermochromic pigments that change colors in response to fluctuation in temperature of the writing instrument. Because the color of thermochromic pigment is reversible as a function of temperature, the writings or drawings on these goods may be erased by the application of hot or cold temperatures. In one example of this, a clear sheet of plastic may be made to turn blue by placing the sheet in a freezer. Touching the sheet with a finger or a warm writing instrument causes the blue to turn clear again locally around the area of contact, and so a clear pattern may be drawn on the blue background. In another example, this same pattern may be erased by placing the sheet in a warm environment that causes the sheet to turn entirely clear. A blue pattern may then be written on the clear background using an ice cube or a cool writing instrument. This same blue pattern may be partially erased by use of a warm writing instrument.

The transient or erasable nature of these designs suggests the character, quality, function, and use of the goods. This is in the nature of a chalkboard from which indicia is easily erased so that the surface is reusable again and again. This makes the mark suggestive, not merely descriptive where a " ['suggestive'] mark refers to some characteristic of the goods, but requires a leap of the imagination to get from the mark to the product." *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 654 F.3d 1179, 1188 (11th Cir. Fla. 2011) (citing *Welding Servs., Inc.*, 509 F.3d at 1357 -58). This is presently the case where a leap of imagination is required to understand the transient nature of indicia that may be written on the goods.

Granted, CHALKBOARD PAPER is not a chalkboard and is not made of paper. However, it is well known also that chalkboards are not made of paper and paper lacks the nature of a chalkboard. This logical incongruity does not suggest to the ordinary consumer that the goods are made of chalkboard and paper, rather, the primary emphasis is upon the character, quality, function, and use of the goods. It is also the case that, upon viewing the goods, no reasonable consumer would be persuaded that they are made of chalkboard and/or paper. The goods are clearly made of plastic. Thus, even if the examiner remains persuaded that CHALKBOARD PAPER misdescribes the composition of the goods (point (1) of the *Budge* test), it is not further the case that this would trick consumers into believing that the misdescription actually describes the goods (Point 2) where the appearance is clearly that of plastic composition. It also is not further the case that any misdescription would affect the consumer decision to purchase where the goods are clearly not in the nature of a chalkboard or paper.

The Undersigned respectfully solicits withdrawal of the rejection to reasons explained above.

Applicant's CHALKBOARD PAPER mark is distinctive and suggestive and therefore should be entitled to register on the Principal Register.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_742032101-112843113_543254_Request_for_Reconsideration_13June2014.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\858\404\85840400\xml7\RFR0002.JPG

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	\\TICRS\EXPORT16\IMAGEOUT16\858\404\85840400\xml7\RFR0004.JPG
DESCRIPTION OF EVIDENCE FILE	Request for Reconsideration in PDF format is attached for the convenience of the examiner only, all argument is provided within the form.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Dan Clevealnd Jr./
SIGNATORY'S NAME	Dan Cleveland, Jr.
SIGNATORY'S POSITION	Attorney of Record, Colorado Bar Member
SIGNATORY'S PHONE NUMBER	720 931 3012
DATE SIGNED	06/13/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jun 13 12:20:53 EDT 2014
TEAS STAMP	USPTO/RFR-74.203.210.1-20 140613122053737300-858404 00-5001912f88480921e7c759 4cd6a1061da3d32f5c865b451 945acd62e1511f1ef0-N/A-N/ A-20140613112843113493

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85840400** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Request for reconsideration in RESPONSE TO 2nd OFFICE ACTION

The Applicant is responding to the Office Action dated December 15, 2013, and files concurrently herewith a Notice of Appeal.

Section 2(e)(1) Refusal – Deceptively Descriptive

Applicant seeks registration of the mark CHALKBOARD PAPER in connection with the following goods in International Class 016:

Plastic drawing surfaces incorporating thermochromic pigments that change colors in response to fluctuation in temperature of the writing instrument.

The Examiner rejects the mark CHALKBOARD PAPER for being “deceptively misdescriptive.” Nonetheless, we believe that the mark is registerable and so we traverse this rejection for the reasons explained below.

Although the examiner cites to *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) for a two part test, the Court of Appeals for the Federal Circuit has established a three-part test for determining whether a mark is deceptive pursuant to section 2(a):

(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?

(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?

(3) If so, is the misdescription likely to affect the decision to purchase?

In re Budge Mfg. Co., Inc., 857 F.2d 773, 775, 8 U.S.P.Q.2D (BNA) 1259, 1269 (Fed. Cir. 1988, *accord Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1361 (Fed. Cir. 2001).

CHALKBOARD PAPER is not deceptively misdescriptive no matter which test is applied.

The mark CHALKBOARD PAPER cannot be deceptively misdescriptive because it primarily suggests a characteristic of the goods. These goods are in the nature of plastic drawing surfaces incorporating thermochromic pigments that change colors in response to fluctuation in temperature of the writing instrument. Because the color of thermochromic pigment is reversible as a function of temperature, the writings or drawings on these goods may be erased by the application of hot or cold temperatures. In one example of this, a clear sheet of plastic may be made to turn blue by placing the sheet in a freezer. Touching the sheet with a finger or a warm writing instrument causes the blue to turn clear again locally around the area of contact, and so a clear pattern may be drawn on the blue background. In another example, this same pattern may be erased by placing the sheet in a warm environment that causes the sheet to turn entirely clear. A blue pattern may then be written on the clear background using an ice cube or a cool writing instrument. This same blue pattern may be partially erased by use of a warm writing instrument.

The transient or erasable nature of these designs suggests the character, quality, function, and use of the goods. This is in the nature of a chalkboard from which indicia is easily erased so that the surface is reusable again and again. This makes the mark suggestive, not merely descriptive where a “suggestive” mark refers to some characteristic of the goods, but requires a leap of the imagination to get from the mark to the product.” *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 654 F.3d 1179, 1188 (11th Cir. Fla. 2011) (citing *Welding Servs., Inc.*, 509 F.3d at 1357 -58). This is presently the case where a leap of

imagination is required to understand the transient nature of indicia that may be written on the goods.

Granted, CHALKBOARD PAPER is not a chalkboard and is not made of paper. However, it is well known also that chalkboards are not made of paper and paper lacks the nature of a chalkboard. This logical incongruity does not suggest to the ordinary consumer that the goods are made of chalkboard and paper, rather, the primary emphasis is upon the character, quality, function, and use of the goods. It is also the case that, upon viewing the goods, no reasonable consumer would be persuaded that they are made of chalkboard and/or paper. The goods are clearly made of plastic. Thus, even if the examiner remains persuaded that CHALKBOARD PAPER misdescribes the composition of the goods (point (1) of the *Budge* test), it is not further the case that this would trick consumers into believing that the misdescription actually describes the goods (Point 2) where the appearance is clearly that of plastic composition. It also is not further the case that any misdescription would affect the consumer decision to purchase where the goods are clearly not in the nature of a chalkboard or paper.

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Applicant's CHALKBOARD PAPER mark is distinctive and suggestive and therefore should be entitled to register on the Principal Register.

EVIDENCE

Evidence in the nature of Request for Reconsideration in PDF format is attached for the convenience of the examiner only, all argument is provided within the form. has been attached.

Original PDF file:

[evi_742032101-112843113_543254_Request_for_Reconsideration_13June2014.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Dan Clevealnd Jr./ Date: 06/13/2014

Signatory's Name: Dan Cleveland, Jr.

Signatory's Position: Attorney of Record, Colorado Bar Member

Signatory's Phone Number: 720 931 3012

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85840400

Internet Transmission Date: Fri Jun 13 12:20:53 EDT 2014

TEAS Stamp: USPTO/RFR-74.203.210.1-20140613122053737

300-85840400-5001912f88480921e7c7594cd6a

1061da3d32f5c865b451945acd62e1511f1ef0-N

/A-N/A-20140613112843113493

Mark: CHALKBOARD PAPER (**word mark**)
Serial Number: 85840400
Attorney Reference Number: 543254

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:	CHALKBOARD PAPER)	
Filed:	November 21, 2013)	
Applicant:	Chromatic Technologies, Inc.)	Serial No.: 85/840,400
Examining Attorney:	Barney L. Charlon)	
	Law Office 104)	

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

RESPONSE TO 2ND OFFICE ACTION

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Mark: CHALKBOARD PAPER (**word mark**)
Serial Number: 85840400
Attorney Reference Number: 543254

(3) If so, is the misdescription likely to affect the decision to purchase?
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1269 (Fed. Cir. 1988, *accord Hoover Co. v. Royal Appliance Mfg. Co.*,
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that any misdescription would affect the consumer decision to purchase where the goods are clearly not in the nature of a chalkboard or paper.

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Respectfully submitted:

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Attorney for Applicant

June 13, 2014