From: Charlon, Barney

Sent: 7/13/2014 3:21:49 PM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85840400 - CHALKBOARD PAPER - 543254 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 3

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Attachment Information:

Count: 7

Files: cp-1.jpg, cp-2.jpg, cp1-1.jpg, cp1-2.jpg, cp1-3.jpg, cp2-1.jpg, 85840400.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85840400

MARK: CHALKBOARD PAPER

CORRESPONDENT ADDRESS:

DAN CLEVELAND JR

LATHROP & GAGE LLP

950 SEVENTEENTH ST STE 2400

DENVER, CO 80202-2822

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

APPLICANT: Chromatic Technologies, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

543254

CORRESPONDENT E-MAIL ADDRESS:

ipdocketing@lathropgage.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/13/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated December 15, 2013, are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Specifically, in its request for reconsideration, applicant appears to have conflated the tests for deceptively misdescriptive marks under Section 2(e)(1) and deceptive marks under Section 2(a), only the latter of which requires that the misdescription at issue affect a consumer's decision to purchase the goods.

As indicated in the previous Office actions, the test for determining whether a mark is deceptively misdescriptive under Section 2(e)(1) has two parts: (1) whether the mark misdescribes the goods and/or services; and if so, (2) whether consumers are likely to believe the misrepresentation. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984)); TMEP §1209.04.

As also indicated in the previous Office actions, the term CHALKBOARD PAPER is recognized in the paper products industry as a type of substrate, including those made of paper or plastic, that can be written on with chalk or other writing implements in the manner of a chalkboard. See the representative sample of printouts enclosed herein and with the previous Office actions.

In the present case, applicant has identified its goods broadly as "Plastic drawing surfaces incorporating thermochromic pigments that change colors in response to fluctuation in temperature of the writing instrument" and "Thermochromic printing inks" therefor.

In so identifying its goods, then, consumers would be likely to believe, albeit mistakenly, that applicant's marks simply refers to a variation of traditional CHALKBOARD PAPER that can be used with

thermochromic pigments. This mistaken belief on the part of consumers, moreover, would be reinforced by the fact that applicant has not limited the field of use of its goods, which must be presumed to travel in all normal channels of trade, including those in which traditional CHALKBOARD PAPER are used. Accordingly, applicant's mark must be refused registration under Section 2(e)(1) on the ground that it deceptively misdescribes the goods at issue.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Barney L. Charlon/

Trademark Examining Attorney

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Chalkboards

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CHALKBOARD PAPER BLACK- 10 SHEETS

Price: $19.99

Product Code: CHALKBOARD-PAPER-BLK-10

+ Add to Cart

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[redacted]

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DESCRIPTION

It's Chalkboard Paper from Chalk Ink! These are flexible plastic sheets ideal for Chalk Ink Wet Wipe Markers. Just write on & wipe off. (Or, use Artista Pro for a quick & easy waterproof sign.) Cut them to whatever size you need... and use sign clips or holders to identify the product you're selling.
10 black sheets- 8.5" x 11".

Related Products...

CHALKBOARD PAPER RED- 10 SHEETS
Price: $19.99
Add

CHALKBOARD PAPER PANEL 22"X28"
Price: $14.99
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COUNTER TOP SIGN 17"X11"
Price: $99.99
Add

EASEL 64" TALL
Price: $17.99
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CHALKBOARD PAPER PANEL 15"X20"
Price: $9.99
Add

5 CHALK INK CHALKBOARD TAGS
Price: $5.99
Add

CHALKBOARD PAPER GREEN-50 SHEETS
Price: $71.99
Add

CHALK INK 10 REUSABLE WHITE CHALKBOARD TAGS
Price: $11.99
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Share your knowledge of this product with other customers... Be the first to write a review

Browse for more products in the same category as this item:

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Favorite Shop

430 items

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Like this item?
Add it to your favorites to revisit it later.

Chalkboard Paper Set - 5 Sheets of Chalk Paper in Black, Green, Red, Blue and Yellow

$12.50 USD

Ask a Question

Only 1 available

Overview

- Material: plastic
- Feedback: 1588 reviews
- Ships worldwide from United States

This shop accepts Etsy Gift Cards

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CHALKBOARD PAPER

Posted on June 2, 2014

School's out, but chalkboard art is definitely in! Chalkboard paper table covering sets the stage for a playful, casual summer dinner. Stocked in our shop in rolls of twenty-five feet, just roll it out, add chalk and watch the fun unfold! Couldn't be simpler!

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