UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/442445

MARK: COLORFAST

77442445

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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: LTL Color Compounders, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
E-2712
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 correspondence filed in which applicant clarified its claim of acquired distinctiveness based on five years of use by indicating that it has nine years of use. Applicant's assertion of nine years of use remains insufficient to establish acquired distinctiveness. Therefore, the descriptiveness refusal is again continued and made FINAL. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a).

MARK IS MERELY DESCRIPTIVE – FINAL REFUSAL

In the Office action dated 2/18/09, the examining attorney made final the descriptiveness refusal pursuant to Section 2(e)(1) of the Trademark Act. Most of the text of the final refusal is again set forth below. The evidence attached to the final Office action dated 2/18/09 is incorporated herein, and is also referenced in the text below.

Registration is refused because the applied-for mark merely describes a characteristic or feature 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.*

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition);*In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In this case, applicant seeks to register the mark COLORFAST for "synthetic resins for use in color and additive compounding." As noted in the evidence submitted in the first Office action, "colorfast" identifies something that is non-fading. As the dictionary entries in the final Office action dated 2/18/09 also shows, "colorfast" is defined as "containing a dye that will not fade or wash out" and "having color that will not run or fade with washing or wear." As the Internet evidence attached in the final Office action dated 2/18/09 from websites such as Brookstone, MSN shopping and Dillen shows, fade-resistant resins are often called "colorfast." In addition, as the applicant indicates in its response to the first Office action, "some of the applicant's goods are formulated to resist fading."

In the final Office action dated 2/18/09 examining attorney also attached registrations for goods similar to the applicant's wherein "colorfast" is disclaimed. Third-party registrations featuring the same or similar goods as applicant's are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

Applicant indicates that the mark is not descriptive because it relates to the applicant's fast service. This argument is unpersuasive because, as noted above, descriptiveness is determined based on the goods, not in the abstract. In this case, "colorfast" identifies goods that are non-fading. As such, the mark has a recognizable descriptive meaning in relation to the goods.

For the foregoing reasons, the descriptiveness refusal pursuant to Section 2(e)(1) of the Trademark Act is continued and now made FINAL.

INSUFFICIENT CLAIM OF ACQUIRED DISTINCTIVENESS

In the previous Office action, the examining attorney indicated that applicant's claim of acquired distinctiveness based on five years' use is insufficient because of the highly descriptive nature of the applied-for mark. *In re Kalmbach Publ'g Co.,* 14 USPQ2d 1490 (TTAB 1989); §TMEP 1212.05(a). In its response, applicant indicated that it has nine years of substantially exclusive and continuous use. However, nine years of use is not sufficiently greater than five years of use. Moreover, given the highly descriptive nature of the mark, nine year of use remains insufficient to support a claim of acquired distinctiveness. Applicant's list featuring use of the wording COLORFAST is also insufficient to establish acquired distinctiveness given the highly descriptive nature of the mark and given that the term "colorfast" is used to identify a type of resin.

For the foregoing reasons, applicant's claim of acquired distinctiveness based on use remains insufficient.

AMENDMENT TO SUPPLEMENTAL REGISTER SUGGESTED

The applied-for mark has been refused registration on the Principal Register. As noted previously,

applicant may respond to the refusal by amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816.

RESPONDING TO A FINAL ACTION

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. 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.