

To: KONINKLIJKE PHILIPS ELECTRONICS N.V. (
Lillian.Drumheller@philips.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85730957 - 08341.0075
Sent: 5/22/2014 5:31:43 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

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

U.S. APPLICATION SERIAL NO. 85730957

MARK:

85730957

CORRESPONDENT ADDRESS:

MARK SOMMERS
FINNEGAN HENDERSON FARABOW GARRETT
& DUN
901 NEW YORK AVENUE NW
WASHINGTON, DC 20001

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: KONINKLIJKE PHILIPS
ELECTRONICS N.V.

CORRESPONDENT'S REFERENCE/DOCKET NO :

08341.0075

CORRESPONDENT E-MAIL ADDRESS:

Lillian.Drumheller@philips.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 5/22/2014

THIS IS A FINAL ACTION.

On October 17, 2013, the Office issued a final action refusing registration based on a failure to function. On April 3, 2013, the applicant responded with arguments against refusal and additional evidence.

Applicant arguments are unpersuasive and applicant's additional evidence is not persuasive; however, the evidence is significantly different from prior submitted evidence and must be addressed. Therefore, for the reasons set forth below, the refusal is now made FINAL under Trademark Act Sections 1, 2, 3 and 45 for failure to function as a service mark. *See* 15 U.S.C. §§1051-1053, 1127; 37 C.F.R. §2.64(a).

Sections 1, 2 & 45—Failure to Function Refusal

Registration is refused because the applied-for color mark, consisting of one color used on all of the surfaces of a product, is not inherently distinctive. Such marks are registrable only on the Supplemental Register or on the Principal Register with sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1120-21, 227 USPQ 417, 419 (Fed. Cir. 1985); *cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000).

As additional evidence, applicant submitted a survey. Survey evidence is relevant in establishing acquired distinctiveness and secondary meaning. *See Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 43, 59 USPQ2d 1720, 1730 (1st Cir. 2001). Applicant's survey, however, is of limited value because it presented applicant's mark to participants on its relatively unique pacifier design along with a relatively unique smiley face design. The probative value of a survey is significantly weakened, despite consumer recognition rates greater than 50%, if there are flaws in the way the survey is conducted. *See Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1569-71 (TTAB 2009).

Although the survey does include data about the subjective reasoning of the participants, specifically that many believed color was instrumental in recognizing the source of the pacifier, the design of the survey leaves no possibility of teasing out the actual reasons that survey participants recognized the source of the pacifier. The respondents are asked what caused them to recognize the source of the pacifiers after they have already established the association. When they respond that they recognize the color as a primary indicator of source, they could be succumbing to retroactive interference where the association they have made with the two other mark elements binds with the third.

A useful survey would have displayed a generic pacifier shape in teal green or a series of different pacifiers in teal green, including applicant's. If applicant's color has become associated as a source indicator apart from the other elements of its copending mark, then consumers would readily associate it with applicant. If applicant's goods are only recognizable in the gestalt of color-shape-smiley face, then, by definition, the applicant has not provided sufficient evidence to prove acquired distinctiveness as to *color*.

Therefore, registration is refused on the Principal Register because it fails to function as a trademark.

Proper Response to Subsequent Final

Applicant must respond to the refusal set forth above within six months of the date of issuance of this Office action. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a). A response to this Office action should be filed with the trademark examining attorney, and not with the Board. Applicant should not respond by filing another appeal. TMEP §715.04(b). The appeal will remain suspended while the application is on remand. TMEP §715.04. If applicant's response does not resolve all issues, the Board will be notified to resume the appeal. *Id.*

Contacting the Examining Attorney

If applicant has any questions concerning the above action, it is encouraged to contact the examining

attorney at the number listed below.

/DETJr/
David E. Tooley, Jr.
Trademark Examining Attorney
Law Office 112
571-272-8206
david.tooley@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

To: KONINKLIJKE PHILIPS ELECTRONICS N.V. (Lillian.Drumheller@philips.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85730957 - 08341.0075
Sent: 5/22/2014 5:31:44 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **5/22/2014** FOR U.S. APPLICATION SERIAL NO. 85730957

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **5/22/2014** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.