

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86393410
LAW OFFICE ASSIGNED	LAW OFFICE 124
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/86393410/large
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	The color(s) green, red, yellow, blue, pink, purple, and white is/are claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of seven layers of color applied to candles in the following order from top to bottom: green, red, yellow, blue, pink, purple and white. The dotted line outlines the shape of the goods to indicate placement of the mark, and the configuration of the candle is not part of the mark.
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7420424194-20181212112930567511_393410_Indio_7_Layer_Candle_Final_OA_Req_for_Reconsideration.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0004.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0005.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0006.JPG
ORIGINAL PDF FILE	evi_7420424194-20181212112930567511_EXHIBIT_A.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT17\IMAGEOUT17\863\934\86393410\xml17\RFR0007.JPG
DESCRIPTION OF EVIDENCE FILE	the actual argument text and TESS records
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use the individual colors blue, green, pink, red, yellow, white, and purple or seven layers apart from the mark as shown.
COLOR(S) CLAIMED	The color(s) green, red, yellow, blue, pink, purple and white in that specific order only is/are claimed as a feature of the

(If applicable)	mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of seven layers of color in a specific order applied to candles in the following order from top to bottom: green, red, yellow, blue, pink, purple and white. The dotted line outlines the shape of the goods to indicate placement of the mark, and the configuration of the candle is not part of the mark.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/annakrobinson/
SIGNATORY'S NAME	Anna K. Robinson
SIGNATORY'S POSITION	Attorney of record, Michigan bar member
SIGNATORY'S PHONE NUMBER	2483584400
DATE SIGNED	12/12/2018
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Dec 12 11:41:05 EST 2018
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XXX-2 0181212114105894082-86393 410-61073af62b628d7eb2d96 ec01388ea9379e0dabe8263f7 caf346b6d7fa3082-N/A-N/A- 20181212112930567511

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 09/20/2020)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86393410** (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/86393410/large>) has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of the actual argument text and TESS records has been attached.

Original PDF file:

[evi_7420424194-20181212112930567511_393410_Indio_7_Layer_Candle_Final_OA_Req_for_Reconsideration.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

Original PDF file:

[evi_7420424194-20181212112930567511 . EXHIBIT A.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use the individual colors blue, green, pink, red, yellow, white, and purple or seven layers apart from the mark as shown.

Color Claim

The color(s) green, red, yellow, blue, pink, purple and white in that specific order only is/are claimed as a feature of the mark.

Description of mark

The mark consists of seven layers of color in a specific order applied to candles in the following order from top to bottom: green, red, yellow, blue, pink, purple and white. The dotted line outlines the shape of the goods to indicate placement of the mark, and the configuration of the candle is not part of the mark.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /annakrobinson/ Date: 12/12/2018

Signatory's Name: Anna K. Robinson

Signatory's Position: Attorney of record, Michigan bar member

Signatory's Phone Number: 2483584400

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 86393410

Internet Transmission Date: Wed Dec 12 11:41:05 EST 2018

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XXX-2018121211410589

4082-86393410-61073af62b628d7eb2d96ec013

88ea9379e0dabe8263f7caf346b6d7fa3082-N/A

-N/A-20181212112930567511

Response to Office Action

This document is filed in response to the Examiner's Final Office Action mailed July 12, 2018. Applicant believes it fully satisfies all outstanding requirements and resolves all outstanding refusals.

A. Disclaimer of Individual Colors

The Examiner refused registration of the Applicant's mark, asserting that the individual colors are functional due to the religious significance of each color. The Examiner also deemed the candle's seven layers functional, citing utilitarian advantages and religious significance. While the Applicant respectfully disagrees, to move the trademark application forward, the Applicant hereby disclaims the individual colors and the fact that the candle has seven layers from the trademark. The Applicant has entered the following disclaimer statement:

- No claim is made to the exclusive right to use the individual colors blue, green, pink, red, yellow, white, and purple or seven layers apart from the mark as shown

Thus, in this application, the Applicant seeks protection only on the specific *order* of the colors: green, red, yellow, blue, pink, purple and white, from top to bottom.

B. Amended Description of the Mark

The Applicant also hereby amends the description of the mark to clarify that, in this application, the Applicant does not claim rights in the individual colors or the use of seven layers, but only the order of the colors. The description of the mark as amended is:

- "The color(s) green, red, yellow, blue, pink, purple and white **in that specific order only** is/are claimed as a feature of the mark. The mark consists of seven layers of color **in a specific order** applied to candles in the following order from top to bottom: green, red, yellow, blue, pink, purple and white. The dotted line outlines the shape of the goods to indicate placement of the mark, and the configuration of the candle is not part of the mark."

This further clarifies that, in this application, the Applicant seeks protection only on the specific order of the colors: green, red, yellow, blue, pink, purple and white, from top to bottom.

If the Examiner requires further amendments to clarify the scope of the Applicant's claim, and to the extent this raises a new issue, the Applicant requests the Examiner issue a new Nonfinal Office Action.

**C. Request to Withdrawal of Section 2(e)(5) Refusal –
The Mark as Amended is Not Functional and is Registrable**

The Examiner has refused registration of the applied-for mark on the grounds that it is functional. The Applicant now seeks protection only on the specific order of the colors in the candle; green, red, yellow, blue, pink, purple and white, from top to bottom. The Applicant disclaimed from the application the items that the Examiner deemed functional, namely, the individual colors and the fact that the candle has seven layers. Thus, the remaining matter in the trade dress mark, namely, the specific order of the colors, has trademark significance, is nonfunctional and registrable.

1. Examiner Did Not Establish a Prima Facie Case That the Order of the Colors is Functional

The Examiner must establish a prima facie case that the proposed trade dress mark sought to be registered is functional in order to make and maintain the §2(e)(5) functionality refusal. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012); *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 USPQ 625, 629 (Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). To do so, the Examiner must not only examine the application content, but also conduct independent research to obtain evidentiary support for the refusal. See TMEP §1202.02(a)(v).

In this case, the Examiner did not provide any evidence that the specific order of the colors the Applicant seeks to protect is functional. To the contrary, the Examiner stated in the Final Office Action that the order of the colors was “arbitrary.” Since there is no evidence to support that the order of the colors is functional, the Examiner did not establish a prima facie case that the proposed amended trade dress mark, covering only the order of the colors, is functional.

2. The Order of the Colors is a Significant Element For Which the Applicant Seeks Protection

In the Final Office Action, the Examiner acknowledged that the specific order of the colors is arbitrary and, thus, not functional. However, the Examiner stated that, “the overall design” is functional, and “[a]n applied-for mark possessed of significant functional features does not qualify for registration where insignificant elements of the design are non-functional.” The Examiner cites several cases to support these points:

- *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1024-27, 224 USPQ 625, 628-30 (Fed. Cir. 1985): This case involves the configuration of a vertical milling machine. In this case, the court’s conclusion on functionality is actually favorable to the present Applicant. The court held that “the overall configuration of the Bridgeport Series I machine is functional, and that the only portion of the Series I design that is nonfunctional **and capable of receiving trademark protection** is the curved design of the column and ram.” *Id.* at 1026. The court went further to emphasize, “[w]e need only hold that here, where most of the product’s overall design is functional, **the nonfunctional components alone, rather than the overall design, are capable of being considered a trademark.**” *Id.* at 1027. The court ultimately found that the nonfunctional parts had not acquired distinctiveness. That is not the case with the present application. The Applicant’s acquired distinctiveness arguments were accepted on September 8, 2016.

- *In re Vico Prods. Mfg. Co.*, 229 USPQ 364 (TTAB 1985): This TTAB decision involves the design of a whirlpool jet for a bathtub. In that case, the applicant sought to register as a trademark the *entire configuration* of its venturi body and not the arguably origin-indicating feature of the product. In the present case, the Applicant has disclaimed elements the Examiner deemed functional, and is only seeking to protect the specific nonfunctional color order.
- *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372 (Fed. Cir. 2012): This TTAB decision involves a cap for a medical collection tube. In this case, the applicant had several utility patents on the product and regularly touted the utilitarian aspects of the elements it was seeking to protect in the trade dress application. The Applicant in the present case has no utility patents, and the order of the colors has no utilitarian function.

Unlike the present case, each of the cited cases involves highly technical and utilitarian product designs. Every element, even those the applicants asserted as “nonfunctional,” served some function. In addition, these elements were minor in relation to the proposed marks as a whole; it is not surprising they would be considered “insignificant elements.” In the present case, the order of the colors in the applied-for design is a significant, and nonfunctional, element. It makes an immediate impression on the potential purchaser. The order of the colors is a highly significant element and is the very aspect of the trade dress mark that the Applicant seeks to protect.

The Applicant does not seek to prevent others from all use of these colors, but rather use of the colors in this specific order. “The functionality inquiry focuses on the utility of the feature or combination of features claimed as protectable trade dress.” *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1338, 213 USPQ 9, 13 (C.C.P.A. 1982). In the present application as amended, the only feature claimed as protectable trade dress is the specific order of the colors. The organization of the colors in the candle, green, red, yellow, blue, pink, purple, and white, from top to bottom, is an important source indicator for the Applicant. This feature is of central significance.

In addition, the trademark office has recognized that colors, in a specific order, are registrable. PLR IP Holdings (“PLR”), the owner of the POLAROID marks, secured two registrations for bands of colors in a specific order:

Reg. No. 4349054:



Reg. No. 4352706:



See Ex. A, Attached.

The Examiner allowed both of PLR's COLOR SPECTRUM marks to register based on acquired distinctiveness under §2(f) of the Trademark Act. In the present case, the Examiner accepted the Applicant's amendment to §2(f) on September 8, 2016, confirming that the Applicant submitted sufficient evidence to support a claim of acquired distinctiveness. Accordingly, just as PLR's COLOR SPECTRUM marks were registrable, protecting the order of the colors in the marks, the Applicant's mark, protecting the order of its colors, should be registrable on the Principal Register as well.

The Applicant also disagrees with the Examiner's statement that "the overall commercial impression of the seven-layer candles is the same, regardless of color order." The Applicant argues that the color order changes the commercial impression of the candles significantly.

Many hundreds of permutations of colors could be selected to create a unique visual impression. Indio's candle with its arbitrary arrangement of the seven layers, is a visual arrangement of green, red, yellow, blue, pink, purple, and white that has no functional or aesthetic purpose and creates a distinct, source identifying impression. Thus, the order of the colors is a highly significant, nonfunctional element.

3. Under the *Morton-Norwich* Factors, The Mark as Amended is Not Functional

The test to determine whether a mark is functional requires consideration of the following *Morton-Norwich* factors:

1. the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
2. advertising by the applicant that touts the utilitarian advantages of the design;
3. facts pertaining to the availability of alternative designs; and
4. facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982). The Applicant's mark, amended only to claim the order of the colors, green, red, yellow, blue, pink, purple, and white, is not functional.

First, there has never been a utility patent issued in connection with Applicant's design, let alone the order of the colors.

Regarding the second *Morton-Norwich* factor, the Examiner has not presented any evidence that advertising by Applicant touts the utilitarian features of the *order* of the colors. Thus, this factor weighs in favor of registration.

The third *Morton-Norwich* factor requires an assessment of the availability of alternative designs. The order of the colors in the mark provides no real utilitarian advantages to the user as compared to other color orders and is completely arbitrary. It is one of many equally feasible, efficient and competitive designs of color order.

Finally, the fourth *Morton-Norwich* factor requires consideration of the facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture. The cost to produce the colors in this order, green, red, yellow, blue, pink, purple and white, is no less than competitors' costs to produce the colors in a different order. Efficiencies did not impact the design. These facts demonstrate that the applied-for configuration of colors does not meaningfully affect the cost of the goods.

In sum, Applicant's trade dress mark, as amended to protect only the order of the colors, is not functional. There are many alternative ways the colors can be arranged, and there is no cost advantage to Applicant's specific color arrangement. Based on the totality of the factors, the applied-for product configuration can serve as a trademark and is thus registrable.

D. Conclusion

The Applicant submits that the mark is in a form suitable for registration on the Principal Register, without repeated publication. The statutory period for timely opposition has closed. Should the Examiner have further questions or require additional information, she is requested to contact the undersigned counsel.

EXHIBIT A