

ESTTA Tracking number: **ESTTA463497**

Filing date: **03/23/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Sunray Printing Solutions, Inc.
Granted to Date of previous extension	03/24/2012
Address	25123 - 22nd Avenue South St. Cloud, MN 56301 UNITED STATES
Correspondence information	Terrance C. Newby, Jonathan D. Jay Attorney of Record Leffert Jay & Polglaze, P.A. 200 South Sixth Street Suite 3200 Minneapolis, MN 55402 UNITED STATES docketing@ljp-iplaw.com Phone:612-312-2200

**Applicant Information**

Application No	85173716	Publication date	01/24/2012
Opposition Filing Date	03/23/2012	Opposition Period Ends	03/24/2012
Applicant	CGH, Inc. 2400 Interlachen Road, Suite 415 Spring Park, MN 55384 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 2005/04/00 First Use In Commerce: 2005/04/00  
All goods and services in the class are opposed, namely: Promoting the goods and services of others by providing coupon mailers and coupon templates for making coupon mailers

**Grounds for Opposition**

The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	The mark is merely a background design that functions as part of a composite mark that incorporates additional designs or wording # it does not indicate the source of Applicant#s goods. Thus, the Alleged Mark does not function as a trademark. See 15 U.S.C. Â§Â§ 1051, 1052 and 1127; Trademark Manual of Examining Procedure (#TMEP#) Â§Â§ 1202.11.

Attachments	NoticeofOpposition.pdf ( 24 pages )(2604113 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Terrance C. Newby/
Name	Terrance C. Newby
Date	03/23/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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In the Matter of Trademark Application Serial No. 85173716  
For the Alleged Mark “Week 4 Week 3 Week 2 Week 1.”  
Published in the Official Gazette on January 24, 2012

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**SUNRAY PRINTING SOLUTIONS, INC.**

Opposer,

v.

**CGH, INC.,**

Applicant.

**NOTICE OF OPPOSITION**

Opposition No. \_\_\_\_\_

Trademark Application Serial No. 85173716

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Sunray Printing Solutions, Inc., a Minnesota Business Corporation located and doing business at 25123 – 22<sup>nd</sup> Avenue South, St. Cloud, MN 56301 (“Opposer”), believes that it will be damaged by registration of the alleged mark referenced above, and hereby opposes CGH, Inc.’s (“Applicant”) application on the following grounds:

**Standing**

1. Opposer Sunray Printing Solutions, Inc. produces numerous printed items for various retailers. One of Opposer’s products is a “magnet coupon mailer” designed to display grocery store coupons on refrigerators. One of Opposer’s magnet coupon mailer products displays grocery store coupons starting with Week 1 and ending with Week 4. (Exhibit A.) Opposer has produced magnet coupon mailers bearing the “Week 1, Week 2” descriptions since at least April, 2010. Opposer intends to produce additional magnet coupon mailers bearing these descriptive phrases in the future.

2. Applicant CGH, Inc. filed a trademark application on or about November 10, 2010 seeking to register a mark consisting of “an elongated vertical column of a coupon mailer divided into rectangles with the wording ‘WEEK 4’, ‘WEEK 3’, ‘WEEK 2’, and ‘WEEK 1’ in each rectangle designating the weeks in descending order from top to bottom.” (“The Alleged Mark,” Exhibit B.)

3. Applicant has accused the Opposer of infringing the Alleged Mark. On December 28, 2011, Applicant filed an Amended Complaint against Opposer in the United States District Court for the District of Minnesota, alleging that Opposer has infringed Applicant’s alleged trademarks and alleged trade dress in the “WEEK 4”, “WEEK 3”, “WEEK 2”, and “WEEK 1” Alleged Mark. Opposer has denied that it infringes the Alleged Mark.

4. Although Opposer and Applicant both sell coupon mailers, Opposer’s coupon mailers are different from Applicant’s Alleged Mark in several important respects. First, Opposer’s coupon mailers use a different font from the Alleged Mark submitted to the USPTO. (Compare Opposer’s product, Exhibit A, with the Alleged Mark, Exhibit B at 5.) Second, Opposer’s product includes additional, non-protectable information such as dates and product information not shown in the Alleged Mark. Applicant has no trademark claim to dates or product descriptions.

5. Opposer contends that the Alleged Mark is not a protectable mark under the trademark laws. However, if the Alleged Mark is registered, Opposer may have to take actions such as changing its advertising, altering its communications and marketing plans with customers, and creating new mailers. Opposer may also be damaged because it could potentially be found liable to Applicant for trademark infringement damages for using the descriptive phrase

“WEEK 4”, “WEEK 3”, “WEEK 2”, and “WEEK 1” in future magnet coupon mailers. Opposer would be damaged by incurring these costs.

6. The goods and/or services on which Opposer has used and intends to use the phrase “WEEK 4”, “WEEK 3”, “WEEK 2”, and “WEEK 1” (or similar phrases) appear to be the same types of goods and/or services on which Applicant has allegedly used the Alleged Mark, as set forth in Applicant’s description of goods and services and as evidenced by the specimens in Applicant’s application. (Exhibit B.)

7. Opposer has standing to challenge the Application because Opposer is engaged in the manufacture and/or sale of the same or related goods or services as Applicant, and because the Alleged Mark is merely descriptive:

A party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses. Thus, opposer as a competitor of applicant is a proper party to challenge applicant's right of registration.

*Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, at \*6-7 (TTAB 2007) (holding that Target had standing to oppose registration of the mark “Ultimate Polo” because Target had used the mark descriptively on its own goods).

#### **Grounds for Opposition**

**COUNT I: THE APPLICANT’S ALLEGED MARK DOES NOT FUNCTION AS A TRADEMARK, IN VIOLATION OF 15 U.S.C. §§ 1051, 1052 AND 1127, AND THEREFORE, APPLICANT IS NOT ENTITLED TO REGISTRATION.**

8. Applicant is not entitled to registration because the specimens submitted by Applicant demonstrate that Applicant has not used the Alleged Mark as a trademark in commerce. Rather, the phrase “WEEK 4”, “WEEK 3”, “WEEK 2”, “WEEK 1” is merely a background design that functions as part of a composite mark that incorporates additional designs or wording – it does not indicate the source of Applicant’s goods. Thus, the Alleged Mark does not function as a trademark. See 15 U.S.C. §§ 1051, 1052 and 1127; Trademark Manual of Examining Procedure (“TMEP”) §§ 1202.11. *See also In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1570, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988) (citations omitted), “[a] background design which is always used in connection with word marks must create a commercial impression on buyers separate and apart from the word marks for the design to be protectible as a separate mark.’ In deciding whether the design background of a word mark may be separately registered, the essential question is whether or not the background material is or is not inherently distinctive.... If the background portion is inherently distinctive, no proof of secondary meaning need be introduced; if not, such proof is essential.”

9. Neither can the Alleged Mark be used as a service mark. See TMEP § 1301.02(a) (to function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application). *See also In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of “winterizing” motor vehicles); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE so highly

descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services).

10. The USPTO previously refused registration of Applicant's Alleged Mark on the ground that "the applied-for mark . . . is merely a background design that functions as part of a composite mark that incorporates additional designs or wording; it does not function separately as a mark." (See Office Action dated February 28, 2011 in Trademark Application Serial No. 85173716 at page 2, attached hereto as Exhibit C.) The background design aspect of the Alleged Mark continues to preclude registration with respect to this Application.

**COUNT II: THE APPLICANT HAS NOT SHOWN THAT THE ALLEGED MARK HAS BECOME DISTINCTIVE OF THE APPLICANT'S GOODS IN COMMERCE, AS REQUIRED BY 15 U.S.C. § 1052(f), AND THEREFORE, APPLICANT IS NOT ENTITLED TO REGISTRATION.**

11. Opposer incorporates by reference the preceding paragraphs.

12. Applicant has not provided evidence sufficient to show that the Alleged Mark is registrable under 15 U.S.C. § 1052(f) on the basis that it has become distinctive of Applicant's goods in commerce, or acquired secondary meaning. The USPTO also refused Applicant's mark because it is descriptive – "the applied-for mark merely describes a feature of applicant's goods and/or services." (Exhibit C at 2.)

13. In response to the USPTO's refusal to register a merely descriptive mark, Applicant submitted an affidavit from Vickie Johnson, Applicant's Vice President of Sales and Marketing. Johnson asserts that the Alleged Mark "is distinctive of Applicant's services by reason of the evidence submitted herein, including the significant sales volume, advertising, and promotion of Applicant's mark." Johnson also asserts that "Applicant had gross revenues of over \$75 million dollars for its WEEK 4, WEEK 3, WEEK 2, WEEK 1 coupon mailer services." (Exhibit D at 1.)

14. None of the advertising expenditures or evidence submitted proves that Applicant's sales or revenues caused consumers to associate the phrase "WEEK 4", "WEEK 3", "WEEK 2", "WEEK 1" with Applicant's goods or services. At best, Applicant's evidence shows only that Applicant expends significant funds on advertising, and Applicant's overall "gross revenues" reflect that spending. But even continuous use and significant sales and revenue are not enough to prove that a descriptive mark has attained distinctiveness, if the advertising does not use the mark to identify Applicant as the source of the goods or services. *See Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, at \*14-15 (TTAB 2007) (Applicant's extensive sales and advertising expenditures for 14 years were insufficient to prove that a descriptive mark had become distinctive: "In any event, the sales figures show only the popularity of applicant's product, not that the relevant customers of such products . . . have come to view the [proposed mark] as applicant's source-identifying mark.")

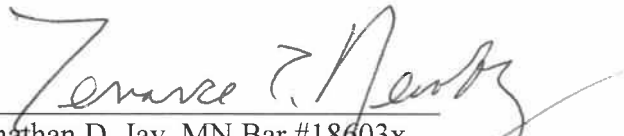
15. Similarly, Johnson's affidavit shows only that Applicant has achieved some success due to its advertising – there is no evidence that customers have come to view "WEEK 4", "WEEK 3", "WEEK 2", "WEEK 1" as applicant's source-identifying mark." Thus, Applicant's mark remains merely descriptive.

WHEREFORE, for the foregoing reasons, Sunray Printing Solutions, Inc., respectfully requests that the Trademark Trial and Appeal Board grant this Opposition, and refuse CGH, Inc.'s application for registration of the alleged mark "WEEK 4", "WEEK 3", "WEEK 2", "WEEK 1" in its entirety.



Respectfully submitted,

**LEFFERT JAY & POLGLAZE, P.A.**

By: 

Date: March 23, 2012

Jonathan D. Jay, MN Bar #18603x  
Terrance C. Newby, MN Bar # 0254587  
Daniel J. Polglaze, MN Bar # 0254654  
Leffert Jay & Polglaze, P.A.  
U.S. Bank Plaza, North Tower  
200 South 6th Street, Suite 3200  
Minneapolis, MN 55402  
Tel: 612-312-2200  
Fax: 612-312-2250

**ATTORNEYS FOR OPPOSER SUNRAY PRINTING, INC.**

# EXHIBIT A

4 Weeks of  
**Holiday Cheer!**  
**SUNMART**

10.5 oz. Chicken or Tomato  
**Our Family Soup**  
**FREE**  
 SUNMART  
 Coupon effective Sunday, January 3 - Saturday, January 9.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9716

**SUPER COUPONS**  
**WEEK 4**  
 January 3 thru January 9

Sweet Gold Pineapples  
**BUY ONE FREE GET ONE FREE**  
 SUNMART Limit 2 FREE  
 Coupon effective Sunday, January 3 - Saturday, January 9.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9718

10 Piece - Drumsticks Only  
**Deli Fresh Fried Chicken**  
**\$2.99**  
 Limit 10 Pieces  
 SUNMART  
 Coupon effective Sunday, January 3 - Saturday, January 9.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9717

3 lb. IQF Boneless  
**Our Family Chicken Breast**  
**\$3.00 OFF**  
 Limit 2  
 SUNMART  
 Coupon effective Sunday, January 3 - Saturday, January 9.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9719

2 Liter  
**Our Family Pop**  
**FREE**  
 SUNMART  
 Coupon effective Sunday, December 27 - Saturday, January 2.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9730

**SUPER COUPONS**  
**WEEK 3**  
 December 27 thru January 2

1 lb. Box  
**Zesta Saltines**  
**BUY ONE FREE GET ONE FREE**  
 SUNMART Limit 1 FREE  
 Coupon effective Sunday, December 27 - Saturday, January 2.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9732

Dozen  
**Bakery Fresh Chocolate Chips Cookies**  
**\$1.99**  
 SUNMART  
 Coupon effective Sunday, December 27 - Saturday, January 2.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9731

**SUPER COUPONS**  
**WEEK 2**  
 December 20 thru December 26

Bulk Wild King Crab Legs  
**\$6.99 LB**  
 SUNMART  
 Coupon effective Sunday, December 27 - Saturday, January 2.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9733

Dozen  
**Our Family Large Eggs**  
**FREE**  
 SUNMART  
 Coupon effective Sunday, December 20 - Saturday, December 26.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9734

**SUPER COUPONS**  
**WEEK 1**  
 December 13 thru December 19

Jumbo Roll Bounty Paper Towels  
**BUY ONE FREE GET ONE FREE**  
 SUNMART Limit 1 FREE  
 Coupon effective Sunday, December 20 - Saturday, December 26.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.




PLU 9736

20 lb. Bag  
**Red Potatoes**  
**\$1.99**  
 Limit 1  
 SUNMART  
 Coupon effective Sunday, December 20 - Saturday, December 26.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9735

16 oz.  
**Our Family Smokehouse Cocktail Smokies**  
**2\$4**  
 Limit 2  
 SUNMART  
 Coupon effective Sunday, December 20 - Saturday, December 26.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9767

15 oz. Can Pears, Peaches or Fruit Cocktail  
**Our Family Canned Fruit**  
**FREE**  
 SUNMART  
 Coupon effective Sunday, December 13 - Saturday, December 19.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9768


**SUPER COUPONS**  
**WEEK 4**  
 January 3 thru January 9

12-inch Tombstone Pizza  
**BUY ONE FREE GET ONE FREE**  
 SUNMART Limit 1 FREE  
 Coupon effective Sunday, December 13 - Saturday, December 19.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9700

8 oz.  
**Our Family Sour Cream**  
**69¢**  
 Limit 1  
 SUNMART  
 Coupon effective Sunday, December 13 - Saturday, December 19.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 9769

12 oz. Butterfly Lime or Sweet Chili  
**Aquastar Shrimp**  
**2\$10**  
 Limit 2  
 SUNMART  
 Coupon effective Sunday, December 13 - Saturday, December 19.  
 Must have coupon. Limit one item per coupon, limit one coupon per family.



PLU 908E

# EXHIBIT B

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-12-22 12:20:30 ET**

**Serial Number:** 85173716 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:**(NOT AVAILABLE)

**Mark**



**(words only):** WEEK 4 WEEK 3 WEEK 2 WEEK 1

**Standard Character claim:** No

**Current Status:** Review prior to publication completed.

**Date of Status:** 2011-12-16

**Filing Date:** 2010-11-10

**The Information will be/was published in the Official Gazette on** 2012-01-24

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 102

**Attorney Assigned:**  
HERRERA-MARCUS ROSELLE MORALDE

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2011-12-16

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

1. CGH, Inc.

**DBA/AKA/TA/Formerly:** DBA Refrigerator Media Advertising

**Address:**

CGH, Inc.  
2400 Interlachen Road, Suite 415  
Spring Park, MN 55384  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Minnesota

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**GOODS AND/OR SERVICES**

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**International Class:** 035

**Class Status:** Active

Promoting the goods and services of others by providing coupon mailers and coupon templates for making coupon mailers

**Basis:** 1(a)

**First Use Date:** 2005-04-00

**First Use in Commerce Date:** 2005-04-00

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**ADDITIONAL INFORMATION**

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**Color(s) Claimed:** Color is not claimed as a feature of the mark.

**Disclaimer:** "WEEK 1", "WEEK 2", "WEEK 3", "WEEK 4"

**Description of Mark:** The mark consists of an elongated vertical column of a coupon mailer divided into rectangles with the wording "WEEK 4", "WEEK 3", "WEEK 2", and "WEEK 1" in each rectangle designating the weeks in descending order from top to bottom. The matter shown in broken lines is not part of the mark and serves only to show one position or placement of the mark.

**Section 2(f)**

**Design Search Code(s):**

20.03.24 - Bumper stickers; Calendars; Checks, bank; Coupons; Currency; Manuscript paper and sheet music; Menus; Money, paper; Music, sheet; Sheet music; Stickers, bumper; Tickets, paper; Trading cards

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-12-16 - Law Office Publication Review Completed

2011-12-12 - Assigned To LIE

2011-11-19 - Approved for Pub - Principal Register (Initial exam)

2011-11-14 - Examiner's Amendment Entered

2011-11-14 - Notification Of Examiners Amendment E-Mailed

2011-11-14 - EXAMINERS AMENDMENT E-MAILED

2011-11-14 - Examiners Amendment -Written

2011-11-14 - Previous Allowance Count Withdrawn

2011-11-09 - Approved for Pub - Principal Register (Initial exam)

2011-09-21 - Notification Of Non-Final Action E-Mailed

2011-09-21 - NON-FINAL ACTION E-MAILED

2011-09-21 - Non-Final Action Written

2011-08-30 - Teas/Email Correspondence Entered

2011-08-29 - Communication received from applicant

2011-08-29 - TEAS Response to Office Action Received

2011-02-28 - Notification Of Non-Final Action E-Mailed

2011-02-28 - Non-final action e-mailed

2011-02-28 - Non-Final Action Written

2011-02-19 - Assigned To Examiner

2010-11-17 - Notice Of Design Search Code And Pseudo Mark Mailed

2010-11-16 - New Application Office Supplied Data Entered In Tram

2010-11-13 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Michael D. Schumann

**Correspondent**

MICHAEL D. SCHUMANN

HAMRE, SCHUMANN, MUELLER & LARSON, P.C.

PO BOX 2902

MINNEAPOLIS, MN 55402-0902

Phone Number: 612.455.3800

Fax Number: 612.455.3801

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	WEEK 4	
	WEEK 3	
	WEEK 2	
	WEEK 1	

# EXHIBIT C

**To:** CGH, Inc. (mail@hsml.com)  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85173716 - WEEK 4 WEEK 3  
WEEK 2 WEEK 1 - 20119.24US02  
**Sent:** 2/28/2011 7:25:23 AM  
**Sent As:** ECOM102@USPTO.GOV  
**Attachments:** Attachment - 1  
Attachment - 2  
Attachment - 3  
Attachment - 4  
Attachment - 5  
Attachment - 6

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

**APPLICATION SERIAL NO.** 85173716

**MARK:** WEEK 4 WEEK 3 WEEK 2 WEEK 1

**\*85173716\***

**CORRESPONDENT ADDRESS:**  
MICHAEL D. SCHUMANN  
HAMRE, SCHUMANN, MUELLER &  
LARSON, P.C.  
PO BOX 2902  
MINNEAPOLIS, MN 55402-0902

**CLICK HERE TO RESPOND TO THIS LETTER:**  
<http://www.uspto.gov/teas/eTEASpageD.htm>

**APPLICANT:** CGH, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

20119.24US02

**CORRESPONDENT E-MAIL ADDRESS:**

mail@hsml.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:** 2/28/2011

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### **SEARCH OF OFFICE'S DATABASE OF MARKS**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

### **FAILURE TO FUNCTION AS A SERVICE MARK**

Registration is refused because the applied-for mark, as used on the specimen of record, is merely a background design that functions as part of a composite mark that incorporates additional designs or wording; it does not function separately as a mark. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; *see In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998); TMEP §§1202.11, 1301.02(a). Specifically, the applied-for mark does not function separately as a mark because consumers will not see the layout of coupons as a source identifier. The applicant's layout features the common design for a coupon mailers. Consumers will only see it as another coupon mailer and not associate it with any particular source.

A background design that is not sufficiently distinctive or unique so as to create a commercial impression separate and apart from the word and/or design mark in conjunction with which it is used can be registered on the Principal Register only upon a showing of acquired distinctiveness. *See, e.g., In re Nat'l Inst. for Auto. Serv. Excellence*, 218 USPQ 744, 745 (TTAB 1983).

Applicant may respond to this refusal by satisfying one of the following:

(1) Claiming **acquired distinctiveness** under Trademark Act Section 2(f) by submitting **evidence** that the applied-for mark has become distinctive of applicant's services in commerce. Trademark Act Section 2(f), 15 U.S.C. §1052(f). Evidence may consist of examples of advertising and promotional materials that specifically promote, as a service mark, the subject matter for which registration is sought; dollar figures for advertising devoted to such promotion; dealer and consumer statements of recognition of the applied-for mark as a service mark; and any other evidence that establishes recognition of the applied-for mark as a service mark for the services. *See* 37 C.F.R. §2.41(a); TMEP §§1202.03(d); 1212.06 *et seq.*; or

(2) Amending the application to seek registration on the **Supplemental Register**. Trademark Act Section 23, 15 U.S.C. §1091; *see* 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816.

Applicant should note the following additional ground for refusal.

### **SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE**

Registration is refused because the applied-for mark merely describes a feature of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

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 the mark shows the layout of coupons. Customers will presume that the applicant’s services related to coupons. The applicant’s identification of services does in fact relate to coupons. Hence the applicant’s mark is descriptive of the applicant’s services.

Although applicant’s mark has been refused registration, applicant may respond to the refusals by submitting evidence and arguments in support of registration.

Applicant must respond to the requirements set forth below.

#### **DRAWING OF THE MARK AND SPECIMEN**

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen displays the mark as a three dimensional 3 page coupon book displayed at a 45 Degree angle with “Week 4 Week 3 Week 2 Week 1” and various other designs and wordings; and the drawing shows the mark as rectangular grid pattern with the wording “Week 4 Week 3 Week 2 Week 1.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). The mark on the drawing must be a substantially exact representation of the mark on the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a); *see* 37 C.F.R. §2.72(a)(1).

The drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* However, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the drawing. Specifically, the specimen appears as multiple pages and has a three dimensional appearance.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing use in commerce of the mark on the drawing. *See* TMEP §807.12(a); and

(2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** See 37 C.F.R. §§2.59(a), 2.193(e)(1); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. See TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. See TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. See TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. See 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); see 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

## **RESPONSE TO OFFICE ACTION**

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/teas/index.html>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at <http://www.uspto.gov/teas/eFilingTips.htm> and email technical questions to [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

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**TO RESPOND TO THIS LETTER:** Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**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 Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, 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/teas/eTEASpageE.htm>.

# EXHIBIT D



TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Refrigerator Media Advertising  
Serial No.: 85/173716 Attorney: Roselle M. Herrera  
Filing Date: November 10, 2010 Law Office: 102  
Mark: WEEK 4 WEEK 3 WEEK 2 WEEK 1 Docket: 20119.24US02

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DECLARATION OF VICKIE M. JOHNSON

I, Vickie M. Johnson, declare as follows:

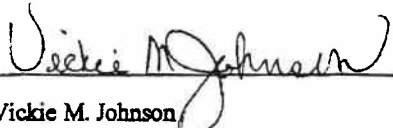
1. I am employed by CGH Inc., d/b/a Refrigerator Media Advertising in the capacity as Vice President of Sales and Marketing.
2. I have the knowledge and authority to make the following statements regarding Applicant's use of the service mark WEEK 4 WEEK 3 WEEK 2 WEEK 1.
3. The mark WEEK 4 WEEK 3 WEEK 2 WEEK 1 is distinctive of Applicant's services by reason of the evidence submitted herein, including the significant sales volume, advertising, and promotion of Applicant's mark. Through such expenditures, retailers and consumers have come to recognize Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 as a service mark identifying Applicant as the source of its services.
4. Applicant is a top direct-mail advertising company with over \$2 million in sales per year. In August, 2005, Applicant successfully introduced the WEEK 4 WEEK 3 WEEK 2 WEEK 1 mark for coupon mailer services. Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 mark has been in continuous and substantially exclusive use ever since.
5. In the past 6 years, Applicant had gross revenues of over \$75 million dollars for its WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer services. Applicant's consumer market consists of grocery and convenience store owners and managers. Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer is very well known and closely associated with Applicant.

Applicant's customers routinely look for the Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer when selecting advertising mailers of this type.

6. Applicant's unique display of WEEK 4 WEEK 3 WEEK 2 WEEK 1 appearing in the center spine of the coupon mailer distinguishes and draws attention to its service mark significance. Attached hereto as Exhibit A are examples of Applicant's mark appearing in its promotional materials including sell sheets, business cards, power point presentation and website.
7. In the last 6 years, Applicant has expended approximately \$120,000 in advertising and marketing its WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer services.
8. Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer service has received significant recognition in the grocery store industry. Applicant is known in the grocery store industry for its WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer services. Attached hereto as Exhibit B are two articles from *Supermarket News* discussing the success of Refrigerator Media Advertising's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer by grocery retailers.
9. Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer has received multiple statements of recognition from its customers. Exhibit C attached hereto contains testimonials from Applicant's customers.
10. Applicant's WEEK 4 WEEK 3 WEEK 2 WEEK 1 coupon mailer services have been used by over 500 different retailers in the U.S. in 27 states.
11. Applicant's mark is a distinctive mark and is recognized in the trade as a distinctive service mark of our company.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that all statements made herein of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: August 24, 2011

  
Vickie M. Johnson