

The Examining Attorney now has refused registration of the mark on the basis that the amended drawing constitutes a material alteration of the mark as set forth in the original drawing. The Examining Attorney finds there has been such a material alteration, because the amended drawing “seeks to change a trademark featuring color into a trade dress for packaging.”

To the contrary, however, Applicant seeks – and from the filing of the present application, always has sought – to register the word VICTOR in red, on a yellow background. As the original Examining Attorney conceded, the specimens submitted in the application depict the mark in *precisely* this way: “as the word, VICTOR in red with an indefinite yellow background.” This is how the original drawing sought to depict the mark; i.e. the word VICTOR in red, on a yellow background.¹

An “applicant may register the color of the background material on which the words or design appear apart from the words or design.” *See* TMEP §1202.05(c). To depict such a color claim, however, a depiction of the object on which the color is used is needed, as the drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. *See* 37 C.F.R. §2.51. *See also* TMEP §1202.05(d)(i).

In most cases, the drawing will consist of a representation of the product or product package. . . . The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time *making it clear that* the shape of the product, or *the shape of the package, is not claimed as part of the mark.* 37 C.F.R. §2.52(b)(4); TMEP §807.08. In the *absence of a broken-line drawing*, the Office will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.

Id. (emphasis added).

Applicant’s amended drawing merely conformed the original drawing to proper Trademark Office practice for a mark seeking to register the color of the background on which the word portion of the mark appears. The amended drawing depicts the product package in **broken lines**. As TMEP §1202.05(d)(i) states, this makes it clear that the shape of the packages is *not* claimed as part of the mark. It is depicted in the drawing (in broken lines) merely to show how the color background appears on the goods – i.e. to show a representation of the mark as actually used on the goods. Only in the *absence* of broken lines is it appropriate to assume, as the Examining Attorney does here, that the mark is a composite consisting of the package, in a particular color. *Id.*

¹ The initial Examining Attorney incorrectly assumed that Applicant’s drawing was, and was intended to depict, the word VICTOR in red on a yellow *rectangle*. As pointed out in response to the initial Office Action, however, *Applicant* did not create or submit the rectangular shape. Rather, that background “shape” was created by, and the result of, the TEAS electronic system.

Therefore, it respectfully is submitted that the amended drawing is not a material alteration, but merely a clarification, of the mark as filed, and should be accepted. Further, as noted above, the specimen submitted conforms to the amended drawing, and it would appear that the Examining Attorney does not contend otherwise. Accordingly, and Applicant having complied with the color description of the mark as required by the Examining Attorney, it is further respectfully submitted that all outstanding requirements have been met.