

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
POST REGISTRATION DIVISION

Registrant: Orange Brand Services, Ltd.
Mark: ORANGE & Design
Registration No.: 4,208,122
Registration Date: September 18, 2012

REQUEST TO CORRECT ERROR IN REGISTRATION

I. **INTRODUCTION**

Registrant Orange Brand Services Ltd. (“OBSL”) hereby requests, pursuant to 15 USC § 1057(g), 37 C.F.R. 2.174 and TMEP 1609.10, that the United States Patent and Trademark Office (“USPTO”) correct an error in United States Trademark Registration No. 4,208,122 for the mark ORANGE and Design (“ORANGE Device Registration”), and issue a corrected Certificate of Registration, to indicate that the color “orange” is claimed as part of the mark. As will be shown, Registrant complied with the then applicable rules to make a color claim for the relevant application and the USPTO erroneously issued the ORANGE Device Registration without any color claim. Registrant further submits that since the failure to include the color claim was due to an error made by the USPTO, and not Registrant, that Registrant should not be required to pay any fee as a result of this request. *See* 37 C.F.R. 2.174, TMEP 1609.10(a).

Because the error is not believed to be material, Registrant submits that no re-publication is required in accordance with TMEP 1609.10(a).

II. **STATEMENT OF FACTS**

The facts are as follows:

- Registrant filed the application that resulted in the ORANGE Device

Registration with the USPTO on October 6, 2000.

- The application was assigned Serial No. 76-142,527. The drawing submitted with the application was lined for the color orange. A copy of the relevant portion of the Orange Device Application with the drawing is attached as Exhibit 1.

- On March 30, 2001, the USPTO issued an Office Action raising several issues including a question regarding whether the drawing is lined for color. In particular, the Office Action stated:

“The drawing appears to be lined for color. The applicant must include a statement that the mark is lined for the color orange. 37 C.F.R. Sections 2.37 and 2.52(a); TMEP Section 807.06(a).”

A copy of the relevant portion of the March 30, 2001 Office Action is attached as Exhibit 2.

- In response to the March 30, 2001 Office Action, as timely filed by Registrant on October 1, 2001, Registrant submitted the following color claim:

Lining Statement

Please enter the following in the application:

--The mark is lined for the color orange--

A copy of the relevant portion of the October 1, 2001 response is attached as Exhibit 3.

- In an Office Action issued on December 12, 2001, the USPTO acknowledged the color claim:

“The applicant’s color lining statement is acceptable and has been made of record.”

A copy of the relevant portion of the December 12, 2001 Office Action is attached as Exhibit 4.

As a result of factors wholly unrelated to the color claim, including an extended opposition proceeding, the ORANGE Device Registration did not issue until September 18, 2012. At the time of the issuance of the registration there was no reference to any color claim in the Certificate of Registration.

However, although not expressly acknowledged, the drawing of the mark, as shown in the Certificate of Registration, appears to be lined for the color orange. See below.

United States of America
United States Patent and Trademark Office



Reg. No. 4,208,122 ORANGE BRAND SERVICES, LTD. (UNITED KINGDOM COMPANY)
Registered Sep. 18, 2012 ST. JAMES PARK, GREAT PARK ROAD
ALMONDSHURY PARK, BRADLEY STROKE
BRISTOL, UNITED KINGDOM
Int. Cls.: 12, 35 and 36

III. ARGUMENT

A. Registrant Submitted and the USPTO Acknowledged Registrant's Color Claim Prior to Registration

Registrant respectfully submits that the USPTO made an inadvertent error in issuing the ORANGE Device Registration without an appropriate color claim.

In order to support this argument, it is helpful to review the rules regarding color claims at the time the application was filed, as these rules are different than the current rules.

As noted, the ORANGE Device Application was filed on October 6, 2000. This was a transition period when the USPTO was phasing out the use of lining drawings for color and implementing the use of color drawings. However, the use of lining to designate color was still permitted until November 2, 2003. As stated in TMEP Section 808.01(b):

Previous Practice. Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the USPTO's color lining system. The color lining system required applicants to line their drawings using certain patterns designated for certain colors, and to provide a color lining statement describing where the colors appeared. The color lining system was deleted from the rule effective October 30, 1999; however, during a transitional period between October 30, 1999 and November 2, 2003, the USPTO continued to accept drawings that showed color by using this lining system....

-*As TMEP 807.07(g) explains, prior to November 2, 2003, the USPTO did not accept color drawings and an applicant who wanted to show color in a mark was required to either

- 1) submit a black-and-white drawing, with a statement describing the color(s) or
- 2) alternatively, the applicant could use a color lining system that previously appeared in 37 C.F.R. §2.52 but was deleted from the rule effective October 30, 1999.

The ORANGE Device Application was lined for the color orange as permitted by the then current rules.

In addition, as also required, Registrant clearly stated that the lining was intended to designate the color orange in its October 1, 2001 Office Action Response. That color claim was acknowledged by the USPTO in the December 12, 2001 Office Action.

Accordingly, Registrant was in full compliance with the then existing rules regarding the submission of a color claim and clearly made a color claim pursuant to those rules.

Further, it was the practice of the USPTO at that time to presume that color was claimed as a feature the mark. As TMEP 807.07(g) states “in applications filed prior to November 2, 2003, *it was presumed that color was claimed as a feature of the mark*, unless the applicant specifically stated that no claim was made to color, or that color was not claimed as a feature of the mark.”

In short, the issuance of the ORANGE Device Registration without an appropriate color claim was a result of a clear mistake made by the USPTO to recognize the color claim previously made by Registrant in accordance with the then existing rules and to apply its own rules at the time regarding the presumption that color is claimed as a mark.

B. The Amendment Sought Is Not Material

Trademark Rule 2.72 (37 C.F.R. §2.72) prohibits any amendment of the mark in an application under §1 or §44 of the Trademark Act that “materially” alters the mark on the drawing filed with the original application.

The test for determining whether an amendment is a material alteration looks to whether the modified mark contains what is the essence of the original mark and whether the new form creates the impression of being essentially the same mark. As a general rule, the addition of any element that would require a further search will constitute a material alteration. *See* TMEP 807.14, 1609.02(a). Here, it is respectfully submitted no additional search would have been required.

It is submitted that the proposed amendment should not otherwise be deemed to be material under applicable USPTO Rules.

In general, the addition, deletion, or amendment of color features in a design mark does not result in a material alteration of the mark. If a proposed amendment to a color feature of a mark does not change the commercial impression of the mark, the amendment is unlikely to have an adverse impact on public notice. In such cases, the mark need not be republished, and the proposed amendment would not be deemed a material alteration TMEP 807.14(e).

By analogy, it is recognized that where, an amendment is made from a black-and-white special form drawing to one claiming a color(s) as a feature of the mark, the amendment generally does not constitute a material alteration. If a mark is initially depicted in a black-and-white special form drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, without limitation and not just the color for which the amendment is sought. Thus, the amendment of what the USPTO apparently treated as a black-and-white drawing to one claiming a particular color as a feature of the mark is, therefore, a restriction or limitation of the applicant's or registrant's rights. TMEP 807.14(e)(i). As a result the amendment should not be deemed to material and no re-publication should be required.

IV. CONCLUSION

Accordingly, Registrant respectfully request that the USPTO issue a corrected registration for the ORANGE Device Registration with an appropriate claim to the color orange pursuant to section 7(g) of United States Trademark Act (15 USC 1057(g)).


Because the error was the inadvertent fault of the USPTO, it is respectfully submitted that this amendment should be made without charge. 37 C.F.R. 2.174, TMEP 1609.10(a).

Respectfully submitted,

CROWELL & MORING, LLP

Dated: New York, New York
April 17, 2014

By:



Dickerson M. Downing
Honor Costello

590 Madison Avenue
New York, NY 10022
(212) 895-4212

Attorneys for Applicant
Orange Brand Services, Ltd.

EXHIBIT 1

EXHIBIT 1

TRADEMARK/SERVICE MARK
4061-4026

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK EXAMINING OPERATION

Mark : ORANGE and Design
Classes : 12 and 36
Applicant : Orange Personal Communications Services Limited, a
company organized under the laws of England and
Wales
Business
Address : St. James Court, Great Park Road
Almondsbury Park, Bradley Stoke
Bristol, United Kingdom

Commissioner for Trademarks
BOX NEW APP/FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

SIR:

Applicant requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 as amended for the following goods and services:

Class 12: Air balloons; airships; automobiles; cycles; boats; cars; coaches; land vehicles; air vehicles; water vehicles; parts, fittings and accessories for all the aforesaid goods.

Class 36: Insurance and financing of telecommunications apparatus, systems and installations; provision of credit card facilities and services; provision of electronic funds transfer services and on-line transaction facilities; computerized financial services; provision of

TRADEMARK/SERVICE MARK
4061-4026

on-line valuation services; real estate affairs and real estate property management and information and advice relating to the aforesaid; provision of financial information; stock exchange quotations; stocks and shares information services; stocks and bonds brokerage; fund raising activities; charitable collections, organizing collections and organizing fund raising activities; financial sponsorship; discount services; information and advisory services relating to insurance, financial affairs, monetary affairs, home and Internet banking, stocks and share information, stocks and bonds brokerage, provided on-line from a computer database or the Internet.

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods and services. (15 U.S.C. §1051(b), as amended).

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods and, with regard to the goods, bases this application on both a claim of priority based upon a foreign application in accordance with 15 U.S.C. §1126(d), as amended, namely, Community Trademark Application No. 1619386 filed April 19, 2000, and on a bona fide intent to use the mark in commerce on said goods, in accordance with 15 U.S.C. §1051(b).

A certified copy of the Community Trademark registration will be submitted as soon as it issues.

Applicant has a bona fide intention to use the mark in commerce in connection with the above identified services and, with regard to the services, upon its foreign registration, namely U.K. Reg. No. 2030260B, dated August 12, 1995, in accordance with section 15 U.S.C. 1126(e), as amended. Applicant bases this application on a

bona fide intention to use the mark in commerce in connection with said services, in accordance with 15 U.S.C. §1051(b) and upon its foreign registration, in accordance with 15 U.S.C. §1126(e), as amended.

A certified copy of the U.K. registration will be submitted shortly.

POWER OF ATTORNEY

Applicant hereby appoints: John A. Diaz; John C. Vassil; Alfred P. Ewert; David H. Pfeffer; Harry C. Marcus; Robert E. Paulson; Stephen R. Smith; Kurt E. Richter; J. Robert Dailey; Eugene Moroz; John F. Sweeney; Arnold I. Rady; Christopher A. Hughes; William S. Feiler; Janet Dore; Joseph A. Calvaruso; James W. Gould; Richard C. Komson; Israel Blum; Christopher K. Hu; Bartholomew Verdirame; Dickerson M. Downing; Maria C.H. Lin; Joseph A. DeGirolamo, Michael P. Dougherty, Seth J. Atlas, Andrew M. Riddles, Bruce D. DeRenzi, Michael M. Murray, Mark J. Abate, John T. Gallagher, Steven F. Meyer, Kenneth H. Sonnenfeld, Harold Haidt, David H.T. Kane; Siegrun D. Kane; Tony V. Pezzano, Walter G. Hanchuk; Andrea L. Wayda; and each of them as its attorneys to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration. Please address all correspondence to:

Dickerson M. Downing, Esq.
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154

TRADEMARK/SERVICE MARK
4061-4026

I hereby authorize the U.S. attorneys and/or agents named hereinabove to accept and follow instructions from R.G.C. Jenkins & Co., as to any action to be taken in the U.S. Patent and Trademark Office regarding this application without direct communication between the U.S. attorneys and/or agents and me. In the event of a change in the person(s) from whom instructions may be taken, I will so notify the U.S. attorneys and/or agents named hereinabove.

DESIGNATION OF DOMESTIC REPRESENTATIVE

MORGAN & FINNEGAN, L.L.P., whose address is 345 Park Avenue, New York, New York 10154, is hereby designated applicant's representative upon whom notice or process in proceedings affecting the mark or the registration may be served.

DECLARATION

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true; that the applicant has a bona fide intention to use the mark shown

TRADEMARK/SERVICE MARK
4061-4026

in the accompanying drawing in commerce on or in connection with the specified goods or services; that the applicant believes it is entitled to use the mark; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

ORANGE PERSONAL COMMUNICATIONS
SERVICES LIMITED

Dated: 6 October 2000

By: Hazel Buckley
Name: HAZEL BUCKLEY
Title: TRADE MARK ATTORNEY
R.G.C JENKINS & Co.
26 CAXTON STREET
LONDON U.K.

Representative for the Applicant.



10-06-2000

TRADEMARK/SERVICE MARK
4061-4026

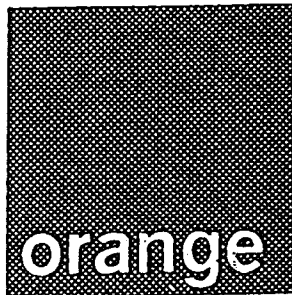
APPLICANT: Orange Personal Communications Services Limited

ADDRESS: St. James Court, Great Park Road
Almondsbury Park, Bradley Stoke
Bristol, United Kingdom

BASES FOR FILING: Priority claimed based on CTM Appln. No. 1619386 dated April 19, 2000 (§1126(d)) (goods) and on U.K. Reg. No. 2030260B dated August 12, 1995 §1126(e)) (services) and on a bona fide intent to use the mark in commerce (1051(b))

GOODS: Class 12: Air balloons; airships; automobiles; cycles; boats; cars; coaches; land vehicles; air vehicles; water vehicles; parts, fittings and accessories for all the aforesaid goods.

SERVICES: Class 36: Insurance and financing of telecommunications apparatus, systems and installations; provision of credit card facilities and services; provision of electronic funds transfer ...



574769_1

TRADEMARK



76142527

EXHIBIT 2

EXHIBIT 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 76/142527		APPLICANT Orange Personal Communications Services ETC		PAPER NO.	
MARK ORANGE AND DESIGN		ACTION NO. 01		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov	
ADDRESS DICKERSON M. DOWNING MORGAN & FINNEGAN L L P 345 PARK AVE NEW YORK NY 10154-0004		MAILING DATE 03/30/01		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. & TM OFFICE		REF. NO. 4061-4026	
Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.					

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/142527

The assigned examining attorney has reviewed the referenced application and determined the following.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

The drawing appears to be lined for color. The applicant must include a statement that the mark is lined for the color orange. 37 C.F.R. Sections 2.37 and 2.52(a); TMEP section 807.06(a).

The following requirement applies to the goods in International Class 12 only.

The applicant must insert a disclaimer of the descriptive term "Orange" in the application. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.09(a)(i). That term is descriptive because it could indicate the color of the applicant's goods.

A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use "Orange" apart from the mark as shown.

The applicant must rewrite the recitation of services in its entirety because of the nature and extent of the amendment. 37 C.F.R. Section 2.74(b).

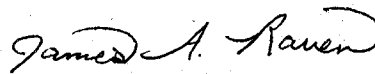
Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

The applicant has filed asserting a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), and claiming priority under Section 44(d), 15 U.S.C. Section 1126(d), based on a foreign application. Under these circumstances, the applicant may rely solely on its intent to use the mark in commerce as the basis for registration and not the expected foreign registration, and still claim the benefit of the priority filing date. If the applicant chooses to do so, this Office will approve the case for publication without waiting for the applicant to submit a certified copy of the foreign registration. Of course, the application must be in condition for publication in all other respects. Moreover, while the application may be approved for publication, the mark will not be registered until an acceptable allegation of use has been filed.

If the applicant wishes to proceed relying on the applicant's intent to use the mark in commerce as the sole basis for registration, with the claim of priority, the applicant should so advise the examining attorney. If the applicant does so, the applicant may not subsequently rely on the foreign registration. TMEP section 1006.01.

If the applicant does not so indicate, this Office will presume that the applicant wishes to rely on the foreign registration as an additional basis for registration and will expect the applicant to submit the certification or certified copy of the foreign registration and, if appropriate, an English translation. It is customary for the translator to sign the translation.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



James A. Rauen
Examining Attorney
Law Office 103
(703) 308-9103 ext.157

EXHIBIT 3

EXHIBIT 3

103
2A

TRADEMARK/SERVICE MARK
4061-4026

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATIONS

Applicant : Orange Personal Communications Services Limited
Mark : **ORANGE and Design**
Serial No. : 76/142,527
Filing Date : October 6, 2000
Examining Attorney : James A. Rauen
Law Office 103
Office Action : March 30, 2001 (No. 1)



10-01-2001

U.S. Patent & TMO/TM Mail Fpct 01 491

BOX RESPONSES
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

S I R:

AMENDMENT AND RESPONSE

Applicant hereby responds to the above-referenced Office Action as follows:

Express Mail Label No.: EL912005804US

Date of Deposit : October 1, 2001

I hereby certify correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

LEESHON SATTERFIELD
(Typed or printed name of the person mailing paper(s))

Signature of the person mailing paper(s)

OL

AMENDMENTS

Lining Statement

Please enter the following in the application:

--The mark is lined for the color orange--

Description of Goods and Services

Please delete the current description of goods and services in its entirety and replace it with the following:

Class 12: Vehicular balloons; airships; automobiles; bicycles; tricycles; motorcycles; boats; cars; coaches, namely, horse drawn carriages; land vehicles, namely wagons, supermarket wagons, baby strollers, baby carriage, all-terrain vehicles, SUV's, buses, cable cars, go carts, motorized golf carts, locomotives, mopeds, motor homes, snow mobiles, trucks, trailers, vans; air vehicles, namely airplanes, gliders, helicopters, sailplanes, seaplanes; water vehicles, namely canoes, ferry boats, kayaks, row boats, steam boat, motor boats, sail boats, ships; parts, fittings and for all the aforesaid goods.

Class 36: Insurance, namely, insurance administration, insurance agencies, insurance brokerage, insurance claims processing, insurance consultation, insurance actuarial services, insurance subrogation and salvage and financing of telecommunications apparatus, systems and installations; credit card and transaction services; provision of electronic funds transfer services and on-line banking; computerized financial services, namely; provision of on-line valuation services in the field of real estate, personal property; real estate affairs and real estate property management and information rendered by telephone, internet, mail, in person and consultation rendered in conjunction therewith; financial information services, namely providing stock exchange quotations and stocks and shares information; stocks and bonds brokerage; charitable fund raising services, namely organizing charitable collections and fund raising activities; financial sponsorship in the areas of sports, cultural activities and the arts; incentive rewards redemption, namely, financial transactions in the form of redeeming points awarded through a customer loyalty program in return for gifts up to the value of those points; information and consulting services relating to insurance, financial affairs, monetary

affairs, home and Internet banking, stocks and share information, stocks and bonds brokerage, provided on-line from a computer database or the Internet.]

RESPONSE

Requirement of a Disclaimer of "ORANGE"

Although the word "orange" does have descriptive connotations under some circumstances and with respect to some products, it does not have descriptive connotations under all circumstances and with respect to all goods. In fact, as is recognized, with respect to well known trademarks such as SHELL, CAMEL and many others, a word which may be descriptive in one context can be totally arbitrary in another. This is just such an instance.

The products sold by Applicant under the ORANGE mark have nothing to do with the orange fruit and are not, for the most part, colored orange.¹

In short, the goods and services at issue include an extensive list of products pertaining to telecommunications and related areas and have no intrinsic expressed or implied association to the color or word orange.

Further, it should be noted that the Patent and Trademark Office did not require a disclaimer with respect to the following registrations or applications owned by the applicant for which Notices of Allowances have been issued:

¹ It is conceivable that some of the products sold by applicant will be manufactures in a spectrum of colors including orange and others. However, use of the mark ORANGE has no functional association with the color of these products nor was it adopted with that intent.

<u>MARK</u>	<u>REG. NO./ APP. NO.</u>	<u>REG. DATE/ FILING DATE</u>	<u>CLASSES</u>
ORANGE	920090	9/14/71	9, 36
ORANGE	74/525370	5/16/94	9, 38
ORANGE and Design	2396644	10/24/00	9, 38
THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE	75/447943	3/10/98	9, 16, 37, 38
ORANGE	2344619	4/25/00	9, 38

Accordingly, there should be no reason to require a disclaimer here and Applicant respectfully request that the Examining Attorney withdraw the requirement for a disclaimer of the word ORANGE.

CONCLUSION

Applicant submits the application is now in condition for allowance and requests that it be placed in suspension pending the foreign registration.

Respectfully submitted,

Date: 10/1/01

By: Janet Dore
Janet Dore
Attorney for Applicant
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 415-8563

JD/REL

EXHIBIT 4

EXHIBIT 4

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 76/142527 Orange Personal Communications Services ETC		PAPER NO.	
APPLICANT 76/142527 Orange Personal Communications Services ETC		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov	
MARK ORANGE AND DESIGN		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
ADDRESS DICKERSON M. DOWNING MORGAN & FINNESAN L L P 345 PARK AVE NEW YORK NY 10154-0004		ACTION NO. 02	Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.
		MAILING DATE 12/12/01	
		REF. NO. 4061-4026	
FORM PTO-1525 (5-80)		U.S. DEPT. OF COMM. & TM OFFICE	

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/142527

- ~~This letter responds to the applicant's communication filed on October 1, 2001.~~
- ~~The applicant's color lining statement is acceptable and has been made of record.~~
- ~~The applicant's amended identification of goods and services has been made of record, and is acceptable with the following exceptions.~~

International Class 12

~~The wording "SUV's" in the identification of goods is unacceptable as indefinite. The applicant may amend this wording to "sport utility vehicles," if accurate. TMEP section 804.~~

International Class 36

The wording "real estate affairs" in the recitation of services is unacceptable as indefinite. The applicant must amend the recitation to specify the common commercial name of the services or to indicate their nature. TMEP section 1301.05.

The wording "incentive rewards redemption, namely, financial transactions in the form of redeeming points awarded through a customer loyalty program in return for gifts up to the value of those points" in the recitation of services is unacceptable as indefinite. The applicant may amend this wording to "incentive reward programs to promote the sale of products and services of others by redeeming points awarded through a customer loyalty program in return for gifts up to the value of those points," if accurate. TMEP section 1301.05. The applicant is advised that these services are properly classified in International Class 35.

The applicant is reminded that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any goods or services that are not within the scope of those in the present identification.

If the applicant wishes to add Class 35 to this application, as indicated above, the applicant must comply with each of the following.

- ①
- (1) The applicant must list the goods and services by international class with the classes listed in ascending numerical order. TMEP section 1113.01.
 - (2) The applicant must submit a filing fee for each international class of goods and services not covered by the fee already paid. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01. The fee for filing a trademark application is \$325 for each class.

Disclaimer Requirement

w/o

The requirement for a disclaimer of the word "Orange" is maintained. The examining attorney has considered the applicant's arguments carefully but found them unpersuasive.

The applicant, in its latest communication, concedes the descriptiveness of the term at issue when it states "it is conceivable that some of the phone products sold by applicant have been or will be manufactured in a spectrum of colors including orange." To sustain a Section 2(e)(1) disclaimer, no more than this is required. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

The applicant notes that five of its prior "Orange" marks were not held descriptive. However, prior registrations are not conclusive on the question of descriptiveness. The examining attorney must consider each case on its own merits. A mark which is merely descriptive is not registrable merely because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). The marks noted by the applicant were also for different goods than the instant application. In addition, one of those marks contains a statement in the identification of goods that the goods are not orange in color.


The Trademark Trial and Appeal Board has repeatedly held marks which indicate the color of the goods to be merely descriptive. See *Ferro Corp. v. SCM Corp.*, 219 USPQ 346 (TTAB 1983); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974).

IMPORTANT NOTES: The examining attorney is prepared to withdraw the disclaimer requirement if the applicant amends its identification of goods to indicate that the goods are not orange in color.

The applicant is reminded that this requirement applies only to the *goods* for which it seeks registration, and not the *services*. The applicant may word its disclaimer to reflect this.

The requirement for a copy of the applicant's foreign registration is continued.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



James A. Rauen
Trademark Examining Attorney
Law Office 103
(703) 308-9103 ext. 157