

**To:** Six Continents Hotels, Inc. ([trademark@cll.com](mailto:trademark@cll.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77713527 - 25837-221 DK  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 77/713527

**MARK:**

**\*77713527\***

**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

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**APPLICANT:** Six Continents Hotels, Inc.

**CORRESPONDENT'S**

**REFERENCE/DOCKET NO:**

25837-221 DK

**CORRESPONDENT E-MAIL ADDRESS:**

trademark@cll.com

## OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 5/6/2009

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, 2.65(a); TMEP §§711, 718.03.

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

### **NONDISTINCTIVENESS TRADE DRESS REFUSAL**

Registration is refused because the applied-for mark consists of a nondistinctive three-dimensional configuration, also known as “trade dress,” that would not be perceived as a service mark but only as decoration or ornamentation. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; *see Two Pesos, Inc. v. Taco Cabana*, 505 U.S. 763, 23 USPQ2d 1081 (1992); *In re File*, 48 USPQ2d 1363 (TTAB 1998); *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996); TMEP §1202.02(b)(ii).

Trade dress used in connection with services generally refers to the visual appearance or image of the place in which a service is provided, such as a store or restaurant interior decor or external facade. *See, e.g., Fuddrucker's, Inc. v. Doc's B.R. Others Inc.*, 826 F.2d 837, 841, 4 USPQ2d 1026, 1029 (9th Cir. 1987) (“a restaurant’s decor . . . may acquire the source-distinguishing aspects of protectable trade dress”).

In this case, the applied-for mark is not inherently distinctive because it is customary in the hotel industry to have lighting features near its entrances for illumination and security purposes. Here, the color green is merely used as lighting features for those purposes. Consumers would not believe such green lighting as designating a source, but rather one of ornamental illumination. The trademark examining attorney refers to the excerpted materials from the Google.com search engine in which hotel and entrances appeared in reference to lighting in 3 stories. See attachments.

In response to this refusal, applicant may submit evidence that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f) by submitting examples of advertising and promotional materials that specifically promote the applied-for mark as a service mark in the United States, 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 matter as a mark for the services. *See* 37 C.F.R. §2.41(a), TMEP §§1212.06 *et seq.* The evidence must relate to the promotion and recognition of the specific configuration embodied in the applied-for mark and not to the services in general. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211, 54 USPQ2d 1065, 1068 (2000).

In determining whether the applied-for mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant’s efforts in the United States to associate the mark with the source of the services, such as in unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *Id.*; 37 C.F.R. §2.41; *see* TMEP §§1212 *et seq.*

In establishing acquired distinctiveness, applicant may not rely on use other than use in commerce that

may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746 (TTAB 1999); TMEP §§1010, 1212.08.

As an alternative to submitting evidence of acquired distinctiveness, applicant may amend the application to the Supplemental Register. Trademark Act Section 23, 15 U.S.C. §1091; *see* 37 C.F.R. §§2.47, 2.75(a); TMEP §§816, 1202.02(b)(ii).

## **COLOR DESCRIPTION OF THE MARK**

The applicant must submit an amended description of the mark giving a concise location of the color mark. 37 C.F.R. § 2.52(b)(1); TMEP § 807.07(a).

The applicant must also include a written description of the mark indicating that the matter shown by the dotted lines is not a part of the mark and that it serves only to show the position of the mark. 37 C.F.R. § 2.52(b)(4); TMEP § 807.08.

Applicant must submit the following:

The mark consists of green lighting formed by four light fixtures placed in a symmetrical fashion near the entryway of the building. One set of two blue lights are evenly placed on columns to the right and left of the entry way and direct the green lighting downward thereby casting a green shadow down the length of the column; while the other set of two green lights are evenly placed on the building wall above the entry way and direct the green lighting upwards, casting a green shadow up the length of the wall and roof overhang. The matter shown by the dotted lines is not a part of the mark and serves only to show the position of the mark

Generic color names must be used to describe the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(i)-(a)(ii).

/william T. Verhosek/  
USPTO  
LO 114  
571-272-9464

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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# THE Colonnade HOTEL

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Welcome to The Colonnade Boston Hotel, a truly exceptional choice among [Back Bay Hotels](#). Nestled in the heart of the fashionable Back Bay neighborhood, in the shadow of the Prudential Center, we offer a sleek, ultra modern destination for savvy vacationers and business travelers. Enjoy short, pleasant strolls to Fenway Park, the Hynes Convention Center, and Copley Square Mall. To access the city beyond, the Prudential Center T Stop is just outside our front door. And for easy arrivals and departures, Boston Logan International Airport may be reached in under 15 minutes. From the Old North Church and the Freedom Trail to Newbury Street boutiques and the



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**Phone: 617-424-7000 Toll Free: 1-800-962-3030**

- Located in the heart of downtown Boston's fashionable Back Bay / Copley Square neighborhood
- Across the street from the Hynes Convention Center, the Prudential Center, the Prudential Center T stop, and one block from Copley Square shopping mall
- Steps away from over 650 national and international brand stores including Ralph Lauren, Saks Fifth Avenue, Zegna, and Neiman Marcus to name a few
- Two blocks from the newest and largest Apple store on Boylston.
- Walking distance to Fenway Park, Newbury Street boutiques, the Boston Symphony, and the Museum of Fine Arts
- Less than 15 minutes from Boston Logan International Airport
- Within 10 minutes away from all Amtrak locations including Back Bay, North and South Stations.

FEEDBACK

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#### PARKING & PUBLIC TRANSPORTATION

- If you are utilizing public transportation, the **Prudential** stop is directly outside our hotel.
- **On-Site Parking is available on an hourly or 24 hour basis.**
- Due to a limited number of spaces, parking within the hotel is available on a first-come/first-serve basis. If you are facing the front of the hotel, the garage entrance is on the left side of the hotel just past Brasserie Jo.

#### DIRECTIONS TO OUR BACK BAY BOSTON HOTEL

##### From The Airport:

Follow signs from the airport for Boston/Sumner Tunnel. At the end of the Sumner Tunnel, move into the left lane and merge onto I-93N. Follow I-93N to Exit 26 - Cambridge/Storrow Drive. Follow Storrow Drive to the Copley Square/Back Bay Exit (The 2nd left hand exit). At the traffic light, turn right onto Beacon Street. Follow Beacon Street 4 blocks and turn left onto Exeter Street. Follow Exeter Street until it ends and turn right onto Huntington Avenue. Follow Huntington Avenue through the 1st set of lights. Make a U-turn at the 2nd set of lights (The hotel will be on your left hand side at this set of lights). Once you make the U-turn, the hotel entrance will be immediately on your right hand side. The garage entrance is located just beyond Brasserie Jo.

##### From The West:

From New York and Connecticut (Route I-90E)

Follow the Massachusetts Turnpike/Route I-90E to Exit 22 - Copley Square/Prudential. Stay in the left lane and follow signs for "Prudential." This exit will place you directly onto Huntington Avenue. Proceed through the stop sign and merge into the far left lane. Make a U-turn at the 1st set of lights (The hotel will be on your left hand side at this set of lights). Once you

make the U-turn, the hotel entrance will be immediately on your right hand side. The garage entrance is located just beyond Brasserie Jo.

**From Worcester and Fitchburg (Route 2E):**

Follow Route 2E to Exit 52A - Route 95S/Route 128S. Follow Route 95S/Route 128S for 7 miles to Exit 25 - Massachusetts Turnpike/Route I-90E. Follow the same directions as above from Route I-90E.

**From The North: (Maine, New Hampshire, Vermont and the North Shore)**

Heading southbound on Route 95S, take Exit 37 - I-93S. Follow I-93S to Exit 26 - Storrow Drive. Stay in the left lane and follow signs for "Storrow Drive." Follow Storrow Drive to the Copley Square/Back Bay Exit (The 2nd left hand exit). At the traffic light, turn right onto Beacon Street. Follow Beacon Street 4 blocks and turn left onto Exeter Street. Follow Exeter Street until it ends and turn right onto Huntington Avenue. Follow Huntington Avenue through the 1st set of lights. Make a U-turn at the 2nd set of lights (The hotel will be on your left hand side at this set of lights). Once you make the U-turn, the hotel entrance will be immediately on your right hand side. The garage entrance is located just beyond Brasserie Jo.

**From The South: (Cape Cod and the South Shore)**

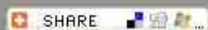
Heading northbound on Route I-93N, take Exit 18 - Massachusetts Avenue. Proceed through the 1st set of lights. At the 2nd set of lights, turn left over the highway and follow signs for Massachusetts Avenue. Turn right onto Massachusetts Avenue and continue through 8 sets of lights to Huntington Avenue. Turn right onto Huntington Avenue and continue through 2 sets of lights. The hotel will be immediately on your right hand side. The garage entrance is located just beyond Brasserie Jo.

\* The hotel has a self-parking garage with no valet. Parking is not included in the overnight rate.

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## Hotels and resorts

By Fred R. Lawson



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### 6.1 Entrance

#### 6.1.1 Signage

Signs and symbols are an important aspect of merchandising service to identify the **hotel**, provide information and direct visitors to the various facilities. At the same time, the graphic design must subtly suggest the status and character of the **hotel** in order to create and reinforce customer cognition, confidence and loyalty.

Signage and graphic design must be consistent throughout the **hotel** and coordinated with interior design.

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#### Restrictions

- Size, design and illumination of signs are usually subject to planning controls.
- Siting outside the curtilage may be prohibited.
- The highway authority may install standard roadside signs.
- Licensing registration and grading symbols need to be displayed at the entrance.

#### Identification

- Graphic symbols may be incorporated in the building facade.
- The **hotel** name and insignia are usually located at side of door or *porte-cochère* and at the road entrance.
- Corporate styling is also represented in canopies, flags, exterior furniture and uniforms.

#### Directions

- Clear directions to the guest entrance, disabled access, function areas, recreation club and service areas.

#### Illumination

External **lighting** improves visibility and merchandising, security and safety. Systems include:

- floodlighting and feature **lighting** of buildings and gardens
- colonnade **lighting** of access roads, paths, merchandising, security and safety. Systems include:
  - floodlighting and feature **lighting** of buildings and gardens
  - colonnade **lighting** of access roads, paths, merchandising, security and safety. Systems include:
    - floodlighting and feature **lighting** of buildings and gardens
    - colonnade **lighting** of access roads, paths, parking
    - direct or self-illumination of signs
    - soft **lighting** of **entrances**, windows, interiors.

#### 6.1.2 Landscaping

Landscaping softens the appearance of the building, provides screening and shelter for car parking and service areas, and an improved outlook for public areas and guestrooms. In larger sites the landscape plan encompasses recreational attractions (pools, tennis courts, golf courses, etc.) as well as lawns and terraces for extension of **hotel** functions.

Generally, the landscape design provides a balance of natural and planted areas with hard pavings and features (water fountains, pools, sculptures) to provide focuses of interest. Mature trees are usually retained in site development.

The external landscaping is often complemented by indoor planted arrangements bringing a refreshing garden ambience into the



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