

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Laser Products Industries  
MARK: LIGHTWAVE  
SERIAL NO.: 88/132745  
FILING DATE: September 26, 2018  
EXAMINING ATTORNEY: Robert Clark  
LAW OFFICE: 101

Commissioner for Trademarks  
P.O. Box 1451  
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**RESPONSE TO MAY 17, 2019 OFFICE ACTION**

On May 17, 2019, the Examining Attorney issued a Final Office Action in connection with Laser Products Industries' ("Applicant") application to register the mark "LIGHTWAVE" (the "Mark") for International Class 9 goods, "digital and visual scanners used for hard surfaces such as granite, marble, quartz and stone surfaces." The Examining Attorney refused registration of the Mark on the basis that the Mark is merely descriptive. In response, Applicant respectfully submits that the Mark is entitled to proceed to publication because the Mark is distinctive.

**I. THE MARK IS DISTINCTIVE**

As described more fully below, the Examining Attorney's refusal to register Applicant's Mark on the grounds that it allegedly describes Applicant's goods is respectfully traversed. A term is merely descriptive if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services, whereas "[s]uggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature

of those goods or services.” TMEP § 1209.01(a); *see In re MBNA Bank, N.A.*, 340 F.3d 1328 (Fed. Cir. 2003); *see also Stix Products, Inc. v. United Merchants & Mfr., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); Thomas McCarthy, *McCarthy's on Trademarks and Unfair Competition* § 11:19 at 11-26.

Applicant’s Mark is suggestive because (a) it does not merely describe the goods offered in connection with the Mark, (b) doubts regarding the registrability of a mark must be resolved in the applicant’s favor, (c) the broad nature of the Mark precludes any descriptiveness finding, (d) it requires imagination by the consumer to ascertain the product offered under the Mark, (e) and the Mark creates a unique commercial impression.

**A. The Mark does not Merely Describe Applicant’s Measurement Goods.**

Applicant’s Mark is not descriptive of the applied-for visual and digital scanner goods because there is no generally recognized definition of LIGHTWAVE in relation to digital and visual scanners. The Examining Attorney relies on the definition of “Lightwave” as “of or designating ... equipment ... using fiber optics” from collinsdictionary.com to support their contention of descriptiveness. However, the definition provided does not include any reference to measurements, scanning, or how the Applicant’s product will function, so the Examining Attorney’s inclusion of scanner products into their collective meaning contradicts the assertion that the definition of “Lightwave” accurately describes the Applicant’s goods. In fact, the inclusion of the definition supports a finding that the Mark is suggestive rather than descriptive, as more fully discussed in the section below, because the Examining Attorney took an imaginative leap in expanding the definition of “Lightwave.” Since the definition cited by the Examining Attorney has no reference to optical scanner or products that do not use lasers, the description of the product under the Mark makes no mention of fiber optics, and since the same light merely exists in the

natural world absent the presence of Applicant's product, this Mark should be more aptly considered arbitrary or fanciful because it has no relation to the goods under it.

The Examining Attorney has only made bald assertions as to the characteristics and features of the Applicants products, which Applicant refutes. The Examining Attorney claims the scanner will use lasers, emit light waves, facilitate the movement of light from the scan, and use fiber optics. Nothing in the description of goods under the Mark states that it will use lasers, emit light waves, facilitate the movement of light or use fiber optics. The Examining Attorney has made exceptional assumptions referencing other goods from the Applicant not covered by this Mark, a dictionary definition that does not cover scanners, a single Wikipedia page, and a description of scanning services from an entirely different company to construct a product design having characteristics of which the Mark would be descriptive. The Examining Attorney has submitted no probative evidence that the scanner under this Mark will use lasers, emit light or use fiber-optics. All conclusions are based on erroneous assumptions on how the good under the Mark will function, rather than the description of goods present in the Application.

Applicant's research finds that "Lightwave" is not recognized in most standard dictionaries. Even so, Applicant addresses the Examining Attorney's assertions under their definition and respectfully refutes their arguments. Simply put, the definition provided for by the Examining Attorney is evidence that the Mark is suggestive, rather than descriptive.

In pursuit of the correct definition, Applicant acquired a copy of Webster's New World College Dictionary Fifth Edition to see the definitions. "Lightwave" was present in the form presented by the Examiner. *See Exhibit A.* However, it makes no mention of types of products or methods of usage that suggests the relevant consumer would see LIGHWAVE and understand that it is a handheld scanner for hard construction materials, which does not use lasers. In further

review, the definition of “Fiber-optics” provides no reference to visual or digital scanning. Webster’s New World College Dictionary defines “Fiber-optics” as “the branch of optics dealing with the transmission of light and images, as around bends and curves, through transparent optical fibers ... the technology using this fiber as for the transmission of data at high speeds and in large amounts ... such fibers bound together and used to send data, images, etc.” *See Exhibit B*. Since the description of the goods under the Mark makes no mention of using fiber optics or emitting light, the Examining Attorney had to make a serious jump to conclude that that Applicant’s product will (1) emit light waves, (2) use fiber optics, and (3) the assumed usage of fiber optics is indicative “that applicant’s scanners emit light waves ... the mark is merely descriptive of a feature of the goods because it indicates the movement of light from the scan.” OA at 3. Because (1) the description of the goods does not indicate it uses fiber optics, (2) the description of the goods does not indicate it will emit or use light or lasers, (3) not all scanners use light, (4) the Hein Online scanning services reference has no connection to the Applicant, and (5) the Examining Attorney’s Wikipedia citation to Fiber Optics Sensors does not refer to any product close to that of the Applicant, the Examining Attorney has provided nothing more than speculation that LIGHTWAVE is descriptive of a feature or characteristic of the goods under the Mark.

“Lightwave” is neither present in the newest standard versions of Merriam-Webster’s Dictionaries, nor in the Cambridge nor Oxford Dictionaries. *See Exhibit C*. These are considered the most comprehensive dictionaries in both standard and American English. The Encyclopedia Britannica states the Oxford English Dictionary remains the “supreme completed achievement in all lexicography.” *See Exhibit D*. Other comprehensive dictionaries, like American Heritage (credited with having the most entries), Dictionary.com (credited with compiling the most digital entries), Chamber’s Crossword Dictionary, and Harper Collins, the basis for the Collin’s search

conducted by the Examining Attorney were searched. None have “Lightwave.” See **Exhibit E**. All other reputable internet definition sites, which claimed “Lightwave” was a word, had the same final dictionary source as the Examining Attorney’s—simply reducing “Lightwave” to a product using fiber-optics. Nothing more. Fiber-optics are then defined as fibers and cables that transmit light. See **Exhibit B**. To make a jump that a digital and visual scanner for construction materials must use fiber optics that require light, meaning that the Mark is descriptive, necessarily requires dissecting the dictionary definition, imposing a method of function not present in the Application, and making assumptions about goods under the Mark. In all, the conclusion is an incorrect, extreme stretch that should not be sustained, which rather indicates that the Mark suggests what the goods under it could be.

Accordingly, the Examining Attorney’s conclusion that the LIGHTWAVE definition and the product asserted under the Mark fits that definition is respectfully traversed. “Lightwave” is not a recognized, independent, word in the English language for anything but vague products using fiber optics. The description of goods in the Application does not state that it will use fiber optics and Applicant confirms in this Response that the scanner will not use lasers. The entire refusal rests on the incorrect assumption of how the product under the Mark will work. The Examining Attorney’s dissections and assumptions using the dictionary definition is highly probative of the Mark’s distinctive posture—because the Examining Attorney had to make several imaginary leaps to come remotely close to what they believed were characteristics of the goods under the Mark. *In re Martin Container, Inc.*, 2002 TTAB LEXIS 360 (T.T.A.B. 2002) (placing burden on Examining Attorney “to put in evidence demonstrating generic use of the term, preferably in addition to dictionary evidence of genericness”).

Applicant asserts that, while the standard as a suggestive mark is met, the Mark should aptly be considered fanciful or arbitrary, because it only exists in this context to function as a trademark and LIGHTWAVE, as presented, has no independent meaning to be found in traditional discourse or any credible resource on the English language which comports with the good under the Mark. *See, e.g., Hokto Kinoko Co. v. Concord Farms, Inc.*, 738 F.3d 1085, 1096 (9th Cir. 2013) (“Fanciful’ marks ... are words or phrases invented solely to function as trademarks.”); *Water Pik, Inc. v. Med-Systems, Inc.*, 726 F.3d 1136, 1152 (10th Cir. 2013) (“the mark is a novel word or design that has been coined for the sole purpose of serving as a trademark”); *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt.*, 618 F.3d 1025, 1033 (9th Cir. 2010) (“made-up words with no discernable meaning”); *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1197 (9th Cir. 2009) (“[Some] marks are ... plainly distinctive, as for example in fanciful marks where the letters do not form a word in the dictionary and there is no apparent logical connection to the goods, such as Exxon gas or Xerox copiers.”); *George & Co., LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 394 (4th Cir. 2009) (“made-up words created for the sole purpose of serving as a trademark”); *Tumblebus, Inc. v. Cranmer*, 399 F.3d 754, 761 n.7 (6th Cir. 2005) (A fanciful mark “is a combination of letters or symbols signifying nothing other than the product or service to which the mark has been assigned.”); *Lane Capital Mgmt, Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 344 (2d Cir. 1999) (“A fanciful mark is not a real word at all, but is invented for its use as a mark.”). Since the product does not produce light, there is no logical connection between the made-up name, the Mark, and the good at issue, the Mark should be considered at the very least suggestive.

A combination of two previously known words does not preclude a finding of distinctiveness. *Comerica Inc. v. Fifth Third Bankcorp*, 282 F. Supp. 2d 557, 568 (E.D. Mich. 2003) (describing a combination of two pre-existing words as “fanciful” and finding that

FLEXLINE could be categorized as fanciful or suggestive for home equity credit lines); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 (2003) (“The rule that arbitrary, coined or fanciful marks or names should be given a much broader degree of protection than symbols, words or phrases in common use would appear to be entirely sound.”).

Even if the Examining Attorney does not accept this assertion, since the Mark does not directly describe the goods under it, it inherently contains a suggestive element. Where a suggestive element is present although some part could through some interpretation may be considered descriptive, the entire mark cannot be deemed descriptive. *Macia v. Microsoft Corp.*, 327 F. Supp. 2d 278, 283–85 (D. Vt. 2003) (“A mark with suggestive as well as descriptive qualities may not be deemed merely descriptive.”). The combination of two descriptive terms can—and does in this case—become suggestive. And it is entirely inappropriate to use an attenuated definition and goods not covered by the Mark to create a Frankenstein-esq definition purporting to show descriptiveness. It is even more inappropriate to use a website with incorrect information to purport to show a definition indicating descriptiveness. The Examining Attorney’s assertion of descriptiveness based upon the erroneous dictionary definition is thus respectively traversed.

The Examining Attorney relies on two websites purporting to show that the Applicant’s scanner uses light to support its contention of descriptiveness. With all due respect, the evidence shown is both neither from the Applicant nor does it contain an accurate depiction of how Applicant’s scanner works. First, the Examining Attorney, in contradiction to general TMEP requirements, provides a Wikipedia page to illustrate what fiber-optic sensors are. The TMEP, § 710.01(b) states that “[g]iven its inherent limitations [from crowd sourced editing], any information obtained from Wikipedia® should be treated as having limited probative value. If the

examining attorney relies upon Wikipedia® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions.” This is a Final Office Action. No additional sources are used to support the Wikipedia evidence; thus, its value is limited. The reliance without further evidence is exceptionally concerning, given that it does not refer to visual or digital scanning or scanners, so its relation to the goods as described in the Application is attenuated at best, but more likely theoretical.

The second piece of evidence in support of the Examining Attorneys contention of descriptiveness, presented in conjunction with the Wikipedia page definition of fiber-optic sensors, is from Hein Online, showing their scanning capabilities and method of operation. Hein Online is not the Applicant. Hein Online does not use Applicant’s products. Hein Online is in an entirely different field than Applicant. Hein Online is dedicated to the preservation, production and display of academic and government documents. Applicant is dedicated to scanning, laser and digital software technology for the construction industry. Further, the scanners cited in the Hein Online documentation do not operate in any manner like those of the Applicant. Those in the cited Hein Online documentation can only operate with use of light. Nothing in the description of the product under the Mark states that Applicant’s product directly uses or emits light. Digital means that it relates to information technology. Visual means that it relates to seeing or sight. Scanner means that it is a device for sensing and recording data. Nothing requires that it uses light or that all scanners operate the same. Thus, the use of the Hein Online evidence is at the very least irrelevant and at most, an example the examining Attorney’s improper extrapolation and creating of a description of goods under the Mark that is not present.



It is entirely inappropriate to cite an unrelated product, in an unrelated industry, that functions in an unrelated manner, as conclusive evidence that Applicant's product must function in the same way and thus the Mark is descriptive, when the descriptive of the product does not indicate so. While Applicant understands that its company name might suggest that it only works in products and services using lasers, a simple search of its website shows that while they do some work in lasers, they also develop technology solutions and sell other goods. A contention of descriptiveness must come from the actual description of products or services presented in the application, rather than any extrinsic evidence of what it could be—and what the Examining Attorney's bald assertion of what it could be, through the dictionary definition, the Wikipedia page, and the Hein Online example, is an entirely incorrect depiction of the goods. The Examining Attorney's decision on descriptiveness is based only on erroneous extrinsic evidence. For the forgoing reasons, Applicant respectfully asserts the Examiners arguments and evidence that the Mark is descriptive are entirely traversed such that this Mark must be allowed to proceed to publication.

The *In re TBG* case is particularly instructive here. 229 U.S.P.Q. 759 (T.T.A.B. 1986). In that case, the Examining Attorney refused registration of that applicant's SHOWROOM ONLINE mark for the services "leasing computer databases and video disks in the field of interior furnishings and related products of others" on the grounds that the mark was merely descriptive. *Id.* The Examining Attorney applied a literal application of the definitions "showroom" and "online" and rationalized that the combination of the two terms "conveys an immediate idea of providing an interior furnishings showroom by means of a computer terminal." *Id.* at 760. However, the Trademark Trial and Appeal Board disagreed. The TTAB held that although the definitions were accurate, the literal application of the function or characteristic to the applicant's

leasing or services was not. *Id.* The TTAB concluded that the SHOWROOM ONLINE mark could be registered as it had “no direct significant” and “no obvious meaning” in relation to the applicant’s leasing or information service or public or financial services. *Id.*

Here, Applicant’s Mark does not in any way describe or indicate the hard construction material scanning device sold in connection with the Mark, nor does it immediately convey the nature or purpose of the product. Upon hearing or seeing LIGHTWAVE, consumers would not know that Applicant is providing a visual and optical scanning device. There are many possible goods that might be suggested by the Mark, but without further thought and perception of the specific goods, consumers will not know the purpose of the nature of those goods upon seeing Applicant’s Mark. The fact that a mark could reveal some information about the goods or services provided does not render it merely descriptive. Applicant’s Mark is not descriptive because it simply cannot identify to the consumer what goods or services are provided.

**B. Doubts Regarding the Registrability of the Mark Should be Resolved in the Applicant’s Favor**

As evidenced in the foregoing and below, the issue of whether the Mark is descriptive is uncertain. “When doubts exist as to whether a term is descriptive as to the goods or services for which registration is sought, *it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication* with the knowledge that a competitor of applicant can come forth and initiate an opposition proceeding in which a more complete record can be established.” *In re The Stroh Brewery*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) (emphasis added). Further, there is “a thin line between a suggestive and a merely descriptive designation and where reasonable [people] may differ, it is the Board’s practice to resolve the doubt *in the applicant’s favor* and publish the mark for opposition.” *In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981) (emphasis added).

Because reasonable persons might differ in their analysis of whether the Mark is descriptive, Applicant respectfully requests that the application for the Mark be allowed to proceed to publication.

### **C. The Broad Nature of the Mark Itself Precludes Any Descriptiveness Finding**

The Mark is extremely general. It could mean nearly anything. No consumer would be able to look at the Mark and know immediately the services provided under it. No consumer would know it relates to a handheld scanner. There are a multitude of possibilities that can exist under the Mark. For example:

- A lamp in the shape of the wave
- A device to show different waves of light
- A flashlight
- Paintings of simulated light waves
- A scanner that emits light
- Lightbulbs
- LEDs
- Any product that could have a light emitting component

There tens, if not hundreds, of potential goods and services that a consumer must sift through to come even remotely close to the goods at issue in this Application. At no point would a consumer look at the Mark and immediately think it applied to a handheld scanner that does not use lasers. It is too far removed from the Mark. The Mark, in its arbitrary state, vaguely suggests that it could relate to the waves light produces, but that, in no way, describes any element of the applied-for goods. To be descriptive, a mark must almost immediately convey to the consumer the exact goods and services under it. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63

(1995). Because it is nearly impossible for any consumer to immediately understand the goods in connection with the Mark, Applicant respectfully submits that this Mark is entitled to publication.

**D. The Mark's Meaning is not Immediately Apparent and Requires Imagination Rendering It Suggestive of the Applied-For Goods.**

Applicant's Mark is suggestive because (i) it does not immediately convey the nature of the goods offered, and (ii) conveying a feature or characteristic of a good is an insufficient basis to characterize the Mark as merely descriptive.

i. Applicant's Mark Requires Consumers to Make an Imaginative Leap.

Considering the foregoing, consumers will be required to make significant an imaginative leap to understand the connection between the Mark and the goods and services offered thereunder when confronting it. A trademark should only be deemed descriptive "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *In re Abacor Development Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978) (emphasis added). It must at once communicate to the public the nature of the goods or services with which the mark is used. "While a descriptive term directly and clearly conveys information about the ingredients, qualities, or characteristics of the product or service, the 'suggestive' term only indirectly hints at these things." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:67 (4th ed. 2006). "If information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a 'suggestive,' not descriptive, manner." *Id.* at 11:19.

"If a consumer must use imagination or any type of multistage reasoning to understand the mark's significance, then the mark does not describe the product's features, but suggests them." *Kendall-Jackson Winery v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n. 8 (9th Cir. 1998) (emphasis added); *see also In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978)

("[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive."). If a mental leap is required to determine the nature of the goods or services with a mark, that mark is suggestive rather than descriptive. *See, e.g., Treemo, Inc. v. Flipboard, Inc.*, No. c13-1218-JPD, 2014 WL 5306671, \*8 (W.D. Wash. October 15, 2014) ("The term "FLIP" in the FLIPBOARD mark describes the way that users can use their fingers to 'flip' through content in the application, but otherwise the mark does not literally describe the application . . . some imagination and 'a mental leap' is required to understand the mark's relationship to the product."). "If a consumer must use more than a small amount of imagination to make the association, the mark is suggestive and not descriptive." *Rodeo Collection, Ltd. V. W. Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987).

Applicant's Mark requires imagination to reach a conclusion about the services offered in connection with the Mark. One factor to determine if consumers must make this mental leap, is whether a consumer would conjure up a number of images in association with a mark. *See AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (reasoning that the "Slickcraft" mark is suggestive for boats because it could conjure a number of images). Similarly, here, consumers will have to make a cognitive leap to associate the LIGHTWAVE Mark with Applicant's handheld visual and digital scanner. As discussed above, Consumers will be required to sort through multiple potential meanings of "LIGHTWAVE" in order to draw a connection between that term and Applicant's services. Even to the extent that Applicant's product could involve light, it will not involve lasers, as the Examining Attorney seems to conclude. Further, the Examining Attorney's conclusion regarding the "descriptive" meaning of the Mark does not actually describe Applicant's product.

What the Court says in *In re Colonial Stores, Inc.*, is that even descriptive words can be combined to create a registrable mark if it functions as more than *a mere description* of the ingredients of the goods on which the mark is used. 394 F.2d 551 (emphasis added). And further, the Court found that the mark in dispute (SUGAR & SPICE for bakery products) was not merely descriptive and entitled to registration because the mark “clearly does not tell the potential purchaser *only* what the goods are, their function, their characteristics or their use, or, of prime concern here, their ingredients.” *Id.* (emphasis added). So, the correct standard, according to *In re Colonial Stores, Inc.*, is that the mark is entitled to registration if it does anything more than merely describing the goods or services connected with it even if they have descriptive tendencies. Likewise, even if a mark has descriptive qualities, so long as it has suggestive ones, it cannot be considered merely descriptive. *See, e.g. Macia*, 327 F. Supp. 2d at 283–85.

Thus, the only way the Mark could be descriptive is if it has a generally accepted meaning that would apply to a handheld scanner for construction materials and resonates as such with consumers on their first impression. Applicant's Mark requires additional information to deduce the purpose and nature of Applicant's goods, contrary to the Examining Attorney's assertion that LIGHTWAVE on first impression refers to a handheld scanning device. Therefore, the Mark does not convey, immediately or otherwise, the specific nature of Applicant's goods.

ii. Applicant's Mark does not convey a feature of the applied-for goods.

In *In re Majestic Distilling Co., Inc.*, 164 U.S.P.Q. 386 (C.C.P.A. 1970), the Court held that CHARRED KEG was not merely descriptive of whiskey, even though the mark arguably conveyed information about a feature of the whiskey, *i.e.*, that it was aged in charred containers. Similarly, as mentioned above, in *In re Colonial Stores, Inc.*, 394 F.2d 549, the Court held that SUGAR & SPICE was not merely descriptive of bakery goods and services, even though the mark

arguably conveyed information about ingredients in the baked goods, *i.e.*, that they contain sugar and spices. In *Application of Sunbeam Corp.*, 370 F.2d 358 (C.C.P.A. 1967), the Court held that SPRAY MIST was not merely descriptive of electric irons, even though the mark arguably conveyed information about a feature of the irons, *i.e.*, that they spray mist.

Even if the Mark arguably conveys some information about a generalized feature of those goods, it is not merely descriptive of the applied-for goods because the commercial impression is suggestive of many possible goods and services. Here, LIGHTWAVE is suggestive of many possible goods and services and therefore is not merely descriptive. As such, the Mark is suggestive of Applicant's goods because there is no direct correlation between the goods and consumers are required to make a mental leap to ascertain the connection between the Mark and the goods.

**E. Applicant's Mark Creates a Unique Commercial Impression.**

Marks must be examined in appearance, sound, connotation, and commercial impression in their entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology, Inc.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). "It is the overall impression of the mark, not an individual feature, that counts." *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991). It does not follow that because terms may be individually descriptive that the combination of such terms results in a merely descriptive phrase. Reviewing an analogous refusal on the basis of descriptiveness, the U.S. Court of Customs and Patent Appeals stated:

Nor do we view the slogan WE SMILE MORE as descriptive of hotel, restaurant or convention services. That the individual words are common and ordinary is undeniable. That each is descriptive of something is clear. But marks must be considered in their entirety.

*In re Marriott Corp.*, 517 F.2d 1364, 1368 (C.C.P.A. 1975); *see also, In re Automatic Radio Mfg. Co., Inc.*, 404 F.2d 1391 (C.C.P.A. 1969) ("We quite agree that 'automatic volume control' is

wholly descriptive of that feature of a radio receiver, but that does not make AUTOMATIC merely descriptive of the radio receiver. Nor does it make ‘AUTOMATIC RADIO’ the name of the receiver.”).

Applicant submits that the Mark does not have an accepted meaning to consumers and its use is not common or widespread within the measurement industry. To Applicant’s knowledge, no other entity is using the same or similar term in its industry. *See, e.g., In re TBG Inc.*, 229 U.S.P.Q. 759 (T.T.A.B. 1986) (Board reversed the Examining Attorney’s conclusion that a mark was merely descriptive, and asserted that its conclusion was “corroborated by the fact that not a single third party use of the combination [of the mark] has been identified by the Office.”)

The Examining Attorney’s refusal fails to analyze the Mark in its entirety and improperly assumes that because the component terms can be individually defined, the Mark is therefore descriptive.



## II. CONCLUSION

Applicant submits that the Mark is unlikely to cause confusion with the Cited Mark, the Mark is suggestive, and that Applicant has successfully traversed the Examining Attorney's arguments. Therefore, Applicant respectfully requests that its application be submitted for publication.

Dated: November 15, 2019

Respectfully Submitted,

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