

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

APPLICANT:	<b>Luxottica Retail North America, Inc.</b>
SERIAL NO.:	86/285996
MARK:	<b>CLEARFOCUS</b>
OFFICE ACTION MAILING DATE:	9/8/2014
EXAMINING ATTORNEY:	Q Queen Law Office 111

**RESPONSE**

**I. Introduction**

In the September 8, 2014 Office Action, the Examining Attorney initially refused registration, alleging that Applicant's mark, CLEARFOCUS, is merely descriptive of Applicant's *eyeglass lenses* in Class 009. Applicant respectfully disagrees with the Examining Attorney's allegations of descriptiveness for at least the following reasons. First, Applicant's mark easily passes the *No Nonsense* test for determining whether a mark is descriptive or suggestive. Second, the Examining Attorney has violated the "anti-dissection" rule in finding Applicant's mark is "merely descriptive." Third, the Examining Attorney has not produced sufficient evidence to establish that Applicant's CLEARFOCUS mark is "merely descriptive." Fourth, refusal to register Applicant's CLEARFOCUS mark would be inconsistent with prior actions taken by the United States Patent and Trademark Office in finding similar marks registrable. Fifth, any doubt as to descriptiveness must be resolved in favor of Applicant, and as is well demonstrated by Applicant's arguments set out more fully below, there is much more than mere "doubt" as to the alleged descriptiveness of Applicant's CLEARFOCUS trademark.

**II. Applicant's CLEARFOCUS Mark is Suggestive and is Not Directly Descriptive of Applicant's Eyeglass Lenses.**

A mark is merely descriptive if it immediately conveys qualities or characteristics of the goods. *In re Gyulay*, 820 F.2d 1216, 1217, 3 U.S.P.Q. 1009 (Fed. Cir. 1987). However, if a mark requires some imagination, thought, or perception to arrive at the qualities or

characteristics of the goods, then the mark is suggestive. *Id.*; *see also In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 U.S.P.Q. 2d 1217, 1219 (Fed. Cir. 2012). To assist in resolving the distinction between a suggestive and descriptive mark, the Trademark Trial and Appeal Board adopted a three-part test for determining the difference in *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 U.S.P.Q. 502 (T.T.A.B. 1985). The test examines: (1) the degree of imagination required, (2) the competitor's use, and (3) the competitor's need. *Id.* Under the *No Nonsense* test, Applicant's CLEARFOCUS mark is clearly suggestive, and not "merely descriptive."

First, under the *No Nonsense* test, the degree of imagination required to call to mind "eyeglass lenses" when consumers encounter Applicant's CLEARFOCUS mark is quite high. A suggestive mark only indirectly conveys information about the ingredients, qualities, characteristics, intended purpose, function, or use of the goods and services. *Astra Pharmaceutical Products, Inc. v. Pharmatron, S.A.*, 145 U.S.P.Q. 461 (C.C.P.A. 1965). Essentially, a suggestive mark requires the consumer to exercise some degree of imagination to draw a conclusion about the nature of the goods or services. *Equine Technologies, Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 36 U.S.P.Q. 2d 1659 (1st Cir. 1995) (holding that imagination is required to connect the term EQUINE TECHNOLOGIES to hoof care products); *see also Philip Morris, Inc. v. R.J. Reynolds Tobacco Co.*, 207 U.S.P.Q. 451 (T.T.A.B. 1980) (holding SOFT SMOKE suggests some characteristic of the applicant's smoking tobacco, a suggestion that may not be clear or immediately perceptible or even be the same for each user of Applicant's tobacco); *Playtex Products, Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 73 U.S.P.Q. 2d 1127 (2d Cir. 2004) (holding term WET ONES is too generalized to directly

describe disposable wipes because the mark could “plausibly describe a wide variety of products”).

In the present application, Applicant’s CLEARFOCUS trademark functions quite similarly to the aforementioned EQUINE TECHNOLOGIES, SOFT SMOKE, and WET ONES marks inasmuch as “CLEARFOCUS” does not merely describe or identify Applicant’s eyeglass lenses. It is worth noting here that the Examining Attorney has produced no evidence of any dictionary definition defining the actual term, CLEARFOCUS. Without more information, relevant consumers would not know immediately the nature of the goods offered under Applicant’s mark. CLEARFOCUS could mean and/or apply to any number of things and does not immediately call to mind Applicant’s eyeglass lenses since the information given by the mark itself is indirect, vague, and could “plausibly describe a wide variety of products.” *Playtex Products, Inc.*, 390 F.3d at 164.

In fact, consumers must engage in a multi-step reasoning process to determine what attributes may be identified by the mark, and the term “CLEARFOCUS” may mean different things to many different people. For example, the term “CLEARFOCUS” likely conjures up various images in the consumer’s mind, ranging from goods as diverse as cameras or other lens equipment, computer software, dietary supplements or drinks for concentration, self-help services, windows and window goods, imaging services, and others. The term certainly does not immediately identify or describe Applicant’s goods or a feature thereof. Rather, the term is suggestive in that it connotes that Applicant’s eyeglass lenses are pure, transparent or simply free from cloudiness that allows users to easily see or focus on things in their environment. Thus, the term as applied to Applicant’s goods is most certainly suggestive, as one must exercise some kind of imagination, thought and/or perception to understand the relationship of Applicant’s

mark to the actual goods offered by Applicant. Therefore, the first prong of the *No Nonsense* test indicates the mark is not descriptive.

Second, regarding competitor's use of the term, it is quite significant that the Examining Attorney has not produced any evidence of any others in the field of eyeglass lenses products using "CLEARFOCUS" to describe their products. If the unitary term "CLEARFOCUS" was in fact "merely descriptive" of eyeglass lenses goods then there would be evidence of third parties using the term in a descriptive manner to describe their own products. In actuality, there are no other competitors of Applicant that use the term "CLEARFOCUS" to describe any of their products. This is because "CLEARFOCUS" is not defined in any dictionary since the term itself is the fanciful combination of two terms. *See Multiple Dictionary Search Results attached as Exhibit A.*

Third, competitors have no need to use the term "CLEARFOCUS" to describe their own eyeglass lenses, nor would competitors be "unduly deprived" if they cannot use Applicant's CLEARFOCUS mark in their advertising. Registration of Applicant's CLEARFOCUS mark, as a coined term, would not deprive competitors from using either individual word "clear" or "focus" to describe their products. Competitors in the business of manufacturing eyeglass lenses have numerous ways to express themselves effectively to prove the "virtues of their products" without infringing on Applicant's CLEARFOCUS trademark. *See No Nonsense Fashions, Inc.,* 226 U.S.P.Q. at 503-504. The fact that the Examining Attorney did not identify or cite to any competitors using "CLEARFOCUS" to describe their products clearly demonstrates that competitors have no "competitive need" to use the term.

As demonstrated by the foregoing arguments, the three-part *No Nonsense* test is clearly met. The lack of any consistency or clarity regarding the actual meaning of the mark

CLEARFOCUS, as well as nonuse by competitors to describe the same products demonstrates the suggestiveness of Applicant's CLEARFOCUS mark for eyeglass lenses.

**III. The Examining Attorney has Improperly Dissected Applicant's Mark to Find the Mark Descriptive.**

Under the anti-dissection rule, the idea that a mark should not be dissected into its individual components to find a mark descriptive is well established. As the Supreme Court has stated, the "commercial impression of a trademark is derived from it as a whole" and as such, a mark should be "considered in its entirety" without the elements separated and considered in detail. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414 (1920); *see also In re Colonial Stores, Inc.*, 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968) (holding unitary term SUGAR & SPICE held suggestive of bakery products though individual terms descriptive of baking ingredients); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (holding unitary term SNO-RAKE suggestive of a snow removal hand tool); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557, 559 (T.T.A.B. 1975), *aff'd* 189 U.S.P.Q. 348 (C.C.P.A. 1976) (holding the mark BIASTEEL to be unitary and thereby suggestive despite the descriptiveness of both BIAS and STEEL in relation to steel tires).

In the present Office Action, the Examining Attorney did not reference Applicant's entire CLEARFOCUS trademark as a unitary whole. Instead, the Examining Attorney only focused on defining the individual words "clear" and "focus" by themselves. The Examining Attorney, based on the definitions of these individual words, improperly determined that Applicant's CLEARFOCUS mark was descriptive without analyzing the overall context of Applicant's full, coined, CLEARFOCUS mark. Applicant's entire CLEARFOCUS mark is, (at the very least) a suggestive mark that gives consumers the impression that Applicant's eyeglass lenses are pure, clean and transparent, such that users can easily see out of them. The proper analysis should

center on the commercial impression of Applicant's CLEARFOCUS mark as a whole and not on its individual terms parsed out. Applicant deliberately uses the combination of the terms "clear" and "focus" to suggestively convey a particular meaning. Like the SUGAR & SPICE and BIASTEEL marks referenced above, Applicant's commercial impression is derived from analyzing CLEARFOCUS in its entirety, and the impression is lost when the individual elements are considered without fully analyzing them in the context of the mark as a whole.

Even in dissecting Applicant's mark, the Examining Attorney failed to note that both of the terms "clear" and "focus" have a myriad of definitions. Indeed, the information the Examining Attorney attached to the Office Action as evidence shows these numerous definitions. The Examining Attorney stated that the definition for "clear" is: "bright or not obscured or darkened." However, this reference is actually a combination of a number of different definitions for the term "clear" that appears on a page with over 50 definitions of the term (where it is defined as an adjective, an adverb, a noun, and a verb). Just a few of the other definitions listed include: serene, calm; without qualification or limitation; free of obstruction; completely or utterly, free from doubt or confusion, to make or become free from darkness, obscurity. Several of these definitions are also suggestive of the positive qualities of Applicant's eyeglass lens goods.

Similarly, the term "focus" has a number of definitions, not simply "the distance or clarity of an image rendered by an optical system" as asserted by the Examining Attorney. Focus can also mean a number of different things (as evidenced in the definitions provided by the Examining Attorney), including: a center of interest or activity; close or narrow attention; a point at which rays of light... converge or from which they appear to diverge; to concentrate attention or energy. There are over 20 definitions for the term "focus" and the word can also be

used as a noun, adjective, and verb. Again, many of these definitions for the term suggest positive qualities and characteristics of Applicant's eyeglass lens goods.

There is simply no evidence to support a finding that Applicant's CLEARFOCUS mark is descriptive of a function or purpose of Applicant's eyeglass goods because 1) CLEARFOCUS is not a defined term; and 2) there are such a huge number of varied definitions of the individual terms that it is unclear exactly what Applicant's goods are. Even if the terms "clear" and "focus" were found to be descriptive Applicant has created a combination of terms that identifies a "unitary mark" with a unique, incongruous, or otherwise non-descriptive meaning in relation to Applicant's eyeglass lenses. *See In re Colonial Stores, Inc.*, 394 F.2d at 552. This is certainly further evidence that Applicant's CLEARFOCUS mark is suggestive of the goods offered by Applicant, and is in no way directly descriptive thereof.

**IV. The Evidence Upon Which the Examining Attorney Relies Falls Far Short of That Required to Find the Mark Descriptive.**

The only evidence which the Examining Attorney provided to support the alleged descriptiveness of CLEARFOCUS consists of dictionary definitions of the individual terms "clear" and "focus." The Examining Attorney provided no other evidence to support the idea that the general consuming public would understand the term CLEARFOCUS to be merely descriptive of eyeglass lenses. In order for the evidence presented by the Examining Attorney to support a finding of descriptiveness, the evidence presented must show that the consumers of Applicant's goods would immediately recognize the term CLEARFOCUS as describing the actual goods themselves.

As discussed above, there are a number of dictionary definitions for both "clear" and "focus." Applicant's use of the terms "clear" and "focus" within its CLEARFOCUS mark is simply not directly descriptive of a function or purpose of Applicant's goods, but rather is

suggestive of pleasing qualities of Applicant’s goods. Simply, the definitions provided by the Examining Attorney do not establish that the consuming public would view “CLEARFOCUS” as descriptive of eyeglass lenses. Given the vast amount of data available on the internet, the fact that the Examining Attorney has only pointed to dictionary definitions of the individual terms “clear” and “focus” actually demonstrates that the consuming public, as a whole, very likely does not view Applicant’s CLEARFOCUS trademark as a descriptive identifier for Applicant’s goods. The Examining Attorney has not presented enough evidence to establish that Applicant’s CLEARFOCUS mark gives potential customers a “clear and unequivocal idea” of a quality, function or characteristic of Applicant’s goods. *See* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §11:71 (4th Ed. 2012). Overall, the foregoing evidence is simply insufficient to find that the general public, as a whole, would immediately believe that the trademark CLEARFOCUS is “merely descriptive” of Applicant’s eyeglass lenses.

**V. Refusal of Registration of Applicant’s Mark Would Be Inconsistent with Marks Found Registrable on the Principal Register.**

In support of Applicant’s position that its CLEARFOCUS mark is not descriptive, Applicant respectfully calls to the Examining Attorney’s attention the following illustrative list of other marks similar to Applicant’s that were found registrable on the Principal Register, all without disclaiming either “clear” or “focus” in Class 09 for similar goods. The following are just a few such registrations; there are numerous others. Regarding marks using the term “clear” the list includes:

<b>Registration Number</b>	<b>Mark</b>	<b>Goods</b>
3577287	AQUACLEAR	Contact lenses
3782849	CLEAR CASE	Optical goods, namely, reading glasses, magnifying glasses, optical frames, eyeglass cords
1783281	CLEAR IMAGE	Telescopic device for



		mounting in spectacle frames
4555091	CLEAR RIDE	Anti-fog films, lenses, inserts for use in eyewear and protective eye gear
3938097	CLEARCOLOR	Contact lenses
86/054099 (allowed)	CLEARDAY	Contact lenses; tinted soft, hard and disposable contact lenses
3511303	CLEARSHOT	Sunglasses and sport glasses
1956402	CLEARVIEW	Contact lenses
3718592	FINE&CLEAR	Contact lens solutions; disinfectants for contact lenses
4213102	SOCLEAR	Anti-reflective lenses; spectacle lenses

Copies of the TSDR printouts for the above-referenced marks are attached hereto as **Exhibit B**.

Similarly, regarding the term “FOCUS” the list includes the following:

<b>Registration Number</b>	<b>Mark</b>	<b>Goods</b>
1665417	FOCUS	Soft contact lenses
2325259	FOCUSERS and Design	Eyeglasses
4522844	FREEFOCUS	Optical products, namely, eyeglass lenses, contact lenses, eyeglass frames and sunglasses
4588562	INFOCUSHD	Eyeglass lenses
4547820	MYFOCUS	Reading eyeglasses
4246437	SUPERFOCUS	Eyewear cases; eyewear, namely, sunglasses, eyeglasses, and ophthalmic frames and cases therefore

Copies of the TSDR printouts for the above-referenced marks are attached hereto as **Exhibit C**.

Just as the foregoing applicants were entitled to registration of their respective suggestive marks, so too is Applicant entitled to registration of its CLEARFOCUS trademark. All of the above listed trademarks use “clear” or “focus” in connection with various types of ophthalmic goods, including but not limited to: eyeglass lenses, reading glasses, optical products and contact lenses. The fact that these marks, in particular marks such as CLEARVIEW and CLEARCOLOR for contact lenses and MY FOCUS for reading glasses were found registrable,

is further evidence that Applicant's likewise is suggestive and descriptive and therefor, is entitled to registration on the Principal Register. The fact that any of the above cited goods could be offered under the CLEARFOCUS mark is yet further evidence of the suggestiveness of Applicant's CLEARFOCUS mark.

Applicant's CLEARFOCUS trademark is in fact, certainly less descriptive than CLEAR IMAGE (for a telescopic device for mounting to eyeglass frames), CLEARCOLOR (for contact lenses), and SUPERFOCUS (for eyeglasses) marks, yet these and other similar marks were not refused registration on descriptiveness grounds and/or were not required to disclaim any elements of the marks. Applicant merely asks for the same treatment as those other Applicants, whereby the examining attorneys in those cases recognized the unitary and suggestive overall connotations of each of the applicant's marks discussed above.

**VI. Any Doubt as to Descriptiveness of Applicant's Mark Must Be Resolved in Favor of Applicant.**

The distinction between a descriptive mark and a suggestive mark is hardly clear and is only subjectively definable. According to the Trademark Trial and Appeal Board, any doubt about whether a mark or term is suggestive or descriptive should be resolved in favor of the Applicant. *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972); *see also In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981); *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84 (T.T.A.B. 1983). In the present case, CLEARFOCUS does not merely describe Applicant's eyeglass lenses, and at the very least, Applicant deserves the benefit of this presumption based on the arguments above and based on numerous other marks containing the terms "clear" and "focus" for similar goods which were not found to be "merely descriptive."

In this case, because "CLEARFOCUS" does not actually describe Applicant's products, because the Examining Attorney has not presented any evidence to establish the descriptiveness

of the terms, and in light of the evidence of several other registered marks on the Principal Register which include “CLEAR” or “FOCUS” in Class 09 without any disclaimer, there is much more than a mere “doubt” as to descriptiveness of Applicant’s CLEARFOCUS trademark.

## **VII. Conclusion**

In view of the arguments set forth above, Applicant respectfully submits that its CLEARFOCUS trademark is not “merely descriptive” of Applicant’s eyeglass lenses. Applicant respectfully submits that this Response fully addresses all issues raised in the September 8, 2014 Office Action issued on this mark, and respectfully requests that the Examining Attorney lift the initial refusal, and approve this application for publication.

7403235v2