

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

In re Application of Mascotte Holdings, Inc.

Mark: SURROUND VISION  
Serial No. 86/029,226

Caryn Glasser  
Examining Attorney  
Law Office 108

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OFFICE ACTION RESPONSE**

In response to the office action issued on June 25, 2015 (the “Office Action”), Mascotte Holdings, Inc. (“Applicant”) respectfully requests reconsideration of Serial No. 86/029,226 (the “Application”) for the mark SURROUND VISION (the “Mark”) in view of the following remarks hereby submitted (the “Response”).

**REMARKS**

Pursuant to the initial office action issued on March 25, 2014, the Examining Attorney initially refused registration of the Mark based on a finding of descriptiveness under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1). Applicant filed a response arguing that the Mark is not descriptive, but the Examining Attorney maintained and continued the descriptiveness refusal in a subsequent office action issued on October 14, 2014. While Applicant does not believe that the Mark is descriptive, Applicant amended the Application to the Supplemental Register in order to expedite registration.

Pursuant to the Office Action, the Examining Attorney has now found the Mark to be “generic of a feature of the services and thus incapable of distinguishing [A]pplicant’s services.”

As more fully discussed below, Applicant respectfully submits that the Mark is not generic of its services within the meaning of Trademark Act §23(c), 15 U.S.C. §1091(c), that the Mark is entitled to registration on the Supplemental Register at a minimum, and therefore, requests that the Examining Attorney withdraw her objection to registration.

It is well settled that generic terms are words that the relevant purchasing public understands primarily as the common name or class for the applicable goods or services. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); In re Am. Fertility Soc'y, 188 F.3d 1341, 1346, 51 U.S.P.Q.2d 1832, 1836 (Fed. Cir. 1999).

More specifically, a two-part test is employed to assess whether a designation is generic: (1) what is the genus of goods or services at issue; and (2) whether the relevant public would understand the designation primarily to refer to that genus of goods or services. H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986).

The Examining Attorney has the burden of proving that a term or a group of terms are generic by clear evidence. In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers, and other publications. See In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 U.S.P.Q. 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix, where the examining attorney cited cookbooks and food-related news articles); In re Analog Devices Inc., 6 U.S.P.Q.2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 U.S.P.Q.2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities, where the examining attorney cited dictionaries and Nexis® articles).

In this case, Applicant's Mark is SURROUND VISION and its services are "cinema theater facilities; cinema theaters; providing facilities for movies; movie theaters; movie showing; arranging, conducting and organizing exhibition of movies and shows for entertainment purposes". SURROUND VISION is not the general or common commercial name for the services being offered by Applicant. Rather, the generic name for the services would be, for example, "movie theaters," which is not the mark or a component of the mark at issue in this case. Under the circumstances, Applicant's Mark as a whole cannot be deemed generic of the services it provides under the proposed Mark.

With respect to the evidence submitted by the Examiner, none of these references define or otherwise establish that SURROUND VISION is the generic name or otherwise the common commercial name for movie theaters. Specifically, the websites provided by the Examining Attorney in the Office Action merely note three uses of the phrase in connection with video technology -- by the MIT Media Lab, Fraunhofer Institute and BBC research division. Three uses hardly qualifies by any standard as sufficient evidence to demonstrate that SURROUND VISION is generic of the services at issue. Additionally, for each use noted in the Examiner's evidence, the phrase "Surround Vision" is capitalized. Were the term truly generic, it would show up throughout the Examiner's evidence in all lowercase letters. Accordingly, the Examiner's purported evidence falls short of proving that Applicant's Mark is generic or that the public would understand the Mark as a whole to have generic significance. See In Dial-A-Mattress, 240 F.3d 1341, 57 U.S.P.Q.2d 1807, 1810 (Fed. Cir. 2001) (finding that 1-888-M-A-T-R-E-S-S was not generic as applied to "telephone shop-at-home retail services in the field of mattresses," because there was no evidence of record that the public understood the term to refer

to shop-at-home telephone mattress retailers). For these reasons, Applicant respectfully submits that registration on the Supplemental Register is appropriate.

**CONCLUSION**

In view of submission of the aforesaid Response responsive to the issues raised in the Office Action, Applicant believes that all issues have been addressed. Applicant respectfully requests that the refusal be withdrawn and hereby asks that the present Application be approved for registration on the Supplemental Register.

Dated: December 15, 2015

Respectfully submitted,

PRYOR CASHMAN LLP

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