

In the Office Action, the Examining Attorney refused registration on the basis the GLASS ANALYTICS mark merely describes Applicant's software pursuant to Section 2(e)(1) of the Trademark Act. This refusal is respectfully traversed and reconsideration is requested in view of the following remarks.

A mark or term is merely descriptive if it imparts or conveys an immediate idea as to the ingredients, qualities or characteristics of the goods or services with which it is used. *In re Abcor Development Corp.*, 200 U.S.P.Q. 215 (CCPA 1978). Further, not only must a mark immediately impart information about the goods or services, but it must do so with a "degree of particularity." *In re Intelligent Medical Systems, Inc.*, 5 U.S.P.Q. 2d 1674 (TTAB 1987); *see also, Holiday Inns, Inc. v. Monolith Enterprises*, 212 U.S.P.Q. 949 (TTAB 1981). To be characterized as "descriptive," a mark must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of the relevant goods. If information about the goods or services 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. J. Thomas McCarthy, *McCarthy on Trademarks* (4th Ed. 2003), citing *Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55 (2nd Cir. 1961); *accord, Robert Bruce, Inc. v. Sears, Roebuck & Co.*, 174 U.S.P.Q. 94 (E.D. Pa. 1972). That is, the mark must literally, and with particularity, "describe" the goods or services. As noted in *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382 (CCPA 1968) and *In re Quik-Print Copy Shops, Inc.*, 205 U.S.P.Q. 505, n.7 (CCPA 1980), "**merely**" in "merely descriptive" means "**only**."

Unlike merely descriptive marks, suggestive marks do not directly describe the characteristics of the goods, but rather evoke them by requiring a consumer to use his imagination to draw conclusions about the nature and features of the goods and services. *In re Colonial Refining and Chem. Co.*, 196 U.S.P.Q. 46 (TTAB 1977); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 217 U.S.P.Q. 988 (5th Cir. 1983). Granted, "[t]here must be some description in almost any suggestion or the suggesting process will not take place." *Q-tips, Inc. v. Johnson & Johnson*, 98 U.S.P.Q. 86, 88 (3d Cir. 1953); *In re Reynolds Metals Co.*, 178 U.S.P.Q. 296, 297 (CCPA 1973) ("...one may be informed by suggestion as well as by

description.”). However, this fact alone does not preclude a finding that the mark itself is suggestive. *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382 (CCPA 1968).

In refusing registration, the Examining Attorney stated:

The *American Heritage Dictionary* defines "analytics" as "[t]he branch of logic dealing with analysis", and "analysis" as "[t]he separation of an intellectual or material whole into its constituent parts for individual study" (See attached dictionary evidence). Applicant identifies its goods and services as software for "designing, modeling and visualizing building glass products" and "evaluating the optical, thermal, aesthetic and other characteristics thereof". In this case, the wording "GLASS ANALYTICS" immediately conveys and merely describes a feature of Applicant's identified goods and/or services, namely, software for analysis of various characteristics of glass products for the purpose of designing glass products.

As the dictionary definition provided by the Examining Attorney shows, "ANALYTICS" can mean "the branch of logic dealing with analysis." However, "the branch of logic dealing with analysis" is exceedingly vague. "Analytics" is a branch of logic, and the fact that it is a branch of logic does not provide any direct information to consumers regarding the nature of Applicant's software. It does not identify or describe, with certainty, the functionality of Applicant's software. Moreover, even assuming consumers would understand "ANALYTICS" to mean performing the function of analysis of glass characteristics, this is only one aspect of Applicant's software. Applicant's software is for use in designing, modeling and visualizing building glass products. As such, the mark is suggestive, not descriptive.

The Board has consistently reversed the decisions of the examining attorneys who refuse registration under Section 2(e)(1) in the absence of actual evidence linking the recognized meaning of the mark sought to be registered to the goods or services of the Applicant. *See, e.g., In re Classic Beverage Inc.*, 6 U.S.P.Q.2d 1383 (TTAB 1988) (reversing examining attorney's refusal to register "CLASSIC COLA" where evidence failed to establish link between meaning of "classic" and applicant's goods, or to indicate any definite information about applicant's product); *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674 (TTAB 1987) (reversing examining attorney's refusal to register "INTELLIGENT MEDICAL SYSTEMS" where he failed to introduce evidence establishing that "intelligent" was descriptive or "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the

[relevant goods]”).

Applicant submits that the evidence does not support that the GLASS ANALYTICS mark is merely descriptive. In view of the foregoing, Applicant respectfully requests withdrawal of the refusal to register.