TRADEMARK
03031-T0007B WWW/LCM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Verilux, Inc.
Trademark:	OPTIX
Serial No.:	88/236,648
Filing Date:	December 20, 2018
Trademark Attorney:	John Dwyer, Law Office 116

Commissioner for Trademarks
Post Office Box 1451
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

I. INTRODUCTION.

In the Office Action dated January 24, 2019 (the "Office Action"), the applied-for mark was refused registration based on:

- Objection to the identification and classification of goods;
- Prior Pending Application;
- Refusal under Section 2(e) – Merely Descriptive;

Applicant respectfully disagrees with the refusals, and based upon Applicant's response and amendments herein, Applicant requests that the Examining Attorney withdraw the refusal to register and approve this applied-for mark for publication.

II. IDENTIFICATION AND CLASSIFICATION OF GOODS.

Applicant hereby amends the goods descriptions for International Class 11 as follows:
International Class 011: Electronic lighting fixtures with glare control and **anti-glare devises, namely, filters for use with lighting apparatus** all for home and office use.

III. PRIOR PENDING APPLICATION.

The Office Action asserts that, because the filing date of the application, Serial No. 87234373 for GROW OPTIX precedes Applicant's filing date, Applicant's application to register its mark may be refused because of a likelihood of confusion between the two marks. While Applicant hereby disagrees that the prior-filed application may cause a likelihood of confusion with Applicant's applied-for mark, Applicant hereby further reserves its rights to fully argue against a Section 2(d) refusal should the prior-filed application mature to registration.

IV. REFUSAL UNDER SECTION 2(E) – MERELY DESCRIPTIVE.

The examining attorney has refused registration of Applicant's Mark under Section 2(e)(1) of the Trademark Act, on the grounds that it merely describes the identified goods. 15 USC. § 1052(e). Applicant disagrees with the refusal, and argues that the mark OPTIX is at least suggestive of Applicant's goods, if not arbitrary in relation to the goods.

A mark is descriptive only if it immediately describes the ingredients, qualities, or characteristics of the goods or it conveys information regarding a significant function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 200 USPQ 215, 217 (CCPA 1978); *See also In re MBNA America Bank N.A.*, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumer immediately associates it with a quality or characteristic of the product or services"). Since the impression on the ultimate consumer determines descriptiveness, the mark must be considered in relation to the identified goods and services – not in the abstract. *Abcor* at 218.

Suggestive marks, are registrable on the Principal Register without proof of secondary meaning. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). A designation does not have to be devoid of all meaning in relation to the goods or services to be registrable. The OPTIX term does not describe Applicant's goods as the phonetic equivalent term, "optics" has a variety of meanings including, "the public's opinion and understanding of a situation after seeing it as the media shows it, and the possible political effects of this," and "the study of light and of instruments using light." (*See* https://dictionary.cambridge.org/us/dictionary/english/optics.) In order to make the connection between the mark OPTIX and lighting fixtures with glare control and anti-glare devises, some further intellectual or imaginative step is required.

The term OPTIX is at least suggestive of Applicant's goods and can be associated with many different goods and services that are not even remotely related to Applicant. When viewed

by a consumer, some imaginative step will need to be taken to connect OPTIX to Applicant's goods. For example, the term OPTIX is associated with many different goods including televisions, eyeglass stores, car engines, acrylic sheets, management solutions, and financial institutions. In addition, a Google search of the term OPTIX yields numerous results, all for various uses of the term OPTIX. (*See* Exhibit A.) None of these results relate to Applicant's goods. Therefore, in light of the arguments and evidence presented, Applicant's Mark is at least suggestive of its goods because there is "something more," an imaginative step, needed to form a connection in the consumer's mind.

A. Alternative Argument in Favor of Acquired Distinctiveness - Statutory Presumption Through Five Years of Use

In the alternative to Applicant's arguments in support of Applicant's Mark being at least suggestive, Applicant argues OPTIX has acquired distinctiveness. If the Trademark Office does not consider a mark inherently distinctive, it may be registered on the Principal Register upon proof of acquired distinctiveness, or "secondary meaning," that is, proof that it has become distinctive as applied to the applicant's goods or services in commerce. If the applicant establishes that the matter in question has acquired distinctiveness as a mark in relation to the named goods, then the mark is registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Applicant submits it provides sufficient evidence of record to support its claim of acquired distinctiveness, as discussed in detail below.

Applicant has used the OPTIX mark for well over the last five (5) consecutive years as a source designation for lighting filters and apparatuses. As such, OPTIX has acquired distinctiveness through its extensive use. "Substantially exclusive and continuous" use of a mark in commerce for more than five (5) years is prima facie evidence of distinctiveness. 15 U.S.C. § 1052(f); 37 C.F.R. § 2.41(b). Applicant began using the applied-for mark at least as early as 2004 in connection with its lighting fixtures. Since that time, Applicant's use of the mark in commerce has been substantially exclusive and continuous. (*See* Exhibit B, Declaration of Nicholas Harmon ¶ 9. (hereinafter "Harmon Dec.")) Therefore, Applicant is entitled to registration of the mark on the Principle Register. *See In re Whitetail Institute of North America, Inc.*, 2014 WL 1390517 (TTAB 2014) (holding that the mark WINTER GREENS was registrable on the Principal Register based on its seven (7) years of continuous and exclusive use).

B. Acquired Distinctiveness - Evidence of Extensive Use

Applicant further submits evidence regarding the extent and nature of its use of the mark in commerce. *See generally* Trademark Rule 2.41(a), 37 C.F.R. §2.41 (a). At this stage, "[A]pplicant need not conclusively establish distinctiveness, but need only to establish a prima facie case to warrant publication of a mark for opposition." *Yamaha Int'l Corp. v. Hoshino Gakki Co.,* 840 F. 2s 1572 (Fed. Cir. 1988) (*quoting In Re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. 916, 919 (TTAB 1983).

Applicant has created an exceptionally strong and well-known, if not famous brand whose technological advancements in the personal use lighting and light therapy industries are known worldwide. (*See generally* Harmon Dec.) Applicant is a highly regarded and trusted company specializing in its innovation, manufacture, and sale of lighting and light therapy products. Applicant has been manufacturing, promoting, advertising, offering for sale and selling products bearing the OPTIX mark since 2004. (*See* Harmon Dec. ¶ 6.) Applicant's OPTIX goods are anti-glare devices for use on various lighting apparatuses. (*See* Harmon Dec. ¶ 7.) The high quality of Verilux's goods for a consumer's health is a very important factor that makes its OPTIX goods so popular. (*See* Harmon Dec. ¶ 8.) Therefore, extensive evidence showing Applicant's Mark has acquired distinctiveness exists.

C. Sophistication of Consumers

Applicant's consumers are sophisticated and take care when purchasing applicant's goods. Purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). Applicant's consumers care about the lighting products they use and the impact those lights have on their overall health and well-being. These consumers use specific types of lighting apparatus to reduce glare and the effects of fluorescent lights. Therefore, these consumers exercise considerable care when purchasing these goods because they depend on high quality, reliable lights. Offering high quality goods in Applicant's industry is necessary as the importance of lighting is critical when it comes to a sophisticated consumer's health and well-being. Relevant consumers particularly choose Applicant's goods because they are the industries' benchmark of such goods and known for their quality and durability. (*See* Harmon Dec. ¶ 8.) Therefore, Applicant's consumers take great care in choosing brands for all of their personal and office lighting needs.

All of the information and evidence that Applicant has set forth in this Response shows that the Applicant's Mark has become distinctive and a source identifier of Applicant's goods.

Not only is Applicant's Mark at least suggestive, but more importantly, the fact that Applicant has used the mark so extensively and exclusively with its lighting fixtures for over 15 years means it has acquired secondary meaning. OPTIX is a well-known source identified for Applicant's lighting products and has acquired distinctiveness.

V. CONCLUSION.

In light of the arguments set forth herein, Applicant respectfully requests that the examining attorney publish the applied-for mark for opposition.

Respectfully submitted,

June 27, 2019

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