

U.S. TRADEMARK APPLICATION SERIAL NO. 88/191,713
MARK: LIGHT UP LAND
RESPONSE TO OFFICE ACTION DATED FEBRUARY 22, 2019

SIR:

This is in response to an Office Action from the United States Patent and Trademark Office dated February 22, 2019. In the Office Action with regard to the above-referenced trademark application (“Application”), the following issues were raised:

1. Disclaimer Requirement
2. Classification & Identification of Services

Response

1. Disclaimer Requirement

The Examiner asserted that Applicant “must provide a disclaimer of the phrase ‘LIGHT UP’ because it is not inherently distinctive, as the term, ‘LIGHT UP’ is at best, merely descriptive. To support this assertion, the Examiner cites to “attached Internet dictionary evidence show[ing] that the term LIGHT UP refers to “to become lit.” Further, the Examiner asserted that “the attached evidence from the commercial marketplace shows that the phrase, LIGHT UP, in relation to toys and novelty toys is highly descriptive. Thus, when considered in relation to applicant’s identification of services, the mark merely describes a feature, characteristic, purpose, or function of Applicant’s services, namely, applicant distributes toys and novelty light up items.”

Applicant respectfully disagrees with the Examiner’s position and asserts that the “LIGHT UP” portion of the mark is perhaps suggestive of its services, but still functions as a trademark for the specific services asserted. In determining whether a mark is “merely descriptive”, the first step is to review the specific goods or services with which the mark is utilized. A specific mark may, in fact, be merely descriptive when used with one type of goods or services but still function as a trademark for different goods or services. It is important to view “the **context** in which a term appears, and the **audience** to which it is directed, e.g., the word, “fish”, was said to be generic as it describes aquatic life, yet, ‘fish’ as used in a ‘fish market’ turns ‘fish’ into a descriptive term if it describes a type of market”¹ Another example includes the word, Safari. When applied to “ice chests, axes, tents and smoking tobacco, [the word, safari,] does not describe such items,” and is

¹ *Union Nat. Bank, Laredo v. Union Bank, Austin*, 909 F.2d 839, 845 (5th Cir. 1990).

thus not generic whereas when used with “an expedition into the African wilderness”, it is undisputedly “a clear example of the use of ‘Safari’ as a generic term.”²

The particular services in question are “wholesale distributorship featuring light up toys and novelty light up goods to owners of amusement parks, theme parks, resorts and attractions” in class 035 and “retail store services featuring novelty light up toys and novelty light up and bubble goods” in class 041.

With regard to the class 035 services, Applicant is a wholesale distributor who is in the business of inventing, producing and distributing novelty items in bulk to owners of amusement parks and theme parks etc. The products that Applicant sells may or may not, in fact, light up. It is not a requirement that the goods that they sell “illuminate” or “light up” products.

In addition, the mark Applicant is applying for is the combination of the phrase, LIGHT UP, with the word, LAND. Accordingly, when customers view the context in which the mark appears, it is not just the phrase, “LIGHT UP”, but the entire phrase, “LIGHT UP LAND”. The addition of the word, LAND, invokes an impression of a place.

Further, for both the class 035 and 041 services, the phrase, LIGHT UP, has numerous meanings and can be used in many contexts such as to “suddenly become or cause to be animated with liveliness or joy.” Therefore, the phrase, LIGHT UP, can invoke numerous different impressions in one’s mind that are not specific to a product that illuminates. The phrase, “LIGHT UP” does not itself “conjure up the image of” a product that illuminates. This phrase “could plausibly describe a wide variety” of products and services and is therefore at worst, suggestive.³

In addition, Applicant respectfully asserts that Examiner’s attached evidence from the Internet regarding the “commercial marketplace” for the class 035 services is irrelevant to Applicant, as Applicant is not 1) selling goods online and 2) not selling goods to average consumers online. As demonstrated by Applicant’s listing of services, Applicant is a wholesale

² *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 12,14 (2d Cir.1976).

³ *Playtex Products v. Georgia-Pacific Corp.*, 390 F.3d 158 (2d Cir. 2004)

distributor to “**owners** of amusement parks, theme parks, resorts and attractions.” These owners are not average consumers that are buying generic toys off the Internet. Rather, these owners are skilled businesspeople who commission Applicant to invent and create products that are distributed exclusively to them. Accordingly, Applicant respectfully asserts that the “LIGHT UP” portion of the trademark, when considered with Applicant’s wholesale distributorship services for a niche class of customers is, at worst, suggestive and not merely descriptive.

Moreover, any doubt as to whether “LIGHT UP” is “merely descriptive” when applied to Applicant’s services, “should be resolved in favor of the applicant.” *In re Rank Organization, Ltd.*, 222 USPQ2d 324, 326 (TTAB 1984).

Further, regarding both the class 035 and 041 services associated with Applicant’s mark, there are numerous trademarks that have registered where the predominant aspect of the mark is the phrase, “LIGHT UP”, or a phonetic equivalent thereof, and the goods or services include “illumination” and wherein a disclaimer of the phrase, “LIGHT UP”, was not required. These registrations are as follows:

1. Registration No. 5,023,656

Mark: **LIGHT UP THE LOVE**

Class 9 Goods: mobile phone applications for displaying **LED lighting images** on a mobile phone

Registration Date: August 16, 2016

2. Registration No. 5,227,464

Mark: **LIGHTUP.COM**

Class 35 Services: On-line retail store services featuring **lights, light bulbs, light tubes, light panels, light fixtures, light fixture hardware, LED bulbs, LED tubes, LED panels, fixtures for LED lights, fixtures hardware for LED lights**

Registration Date: June 20, 2017

3. Registration No. 4,718,277

Mark: **LIGHT UP LINKS**

Class 28 Goods: ...construction toys incorporating silicone and **LED (light emitting diode) parts and components...** toy construction sets incorporating silicone and **LED (light emitting diode) parts and components...**construction toys comprised of interlocking silicone and **illuminated parts and components...**

Registration Date: February 9, 2015

4. Registration No. 4,169,480



Mark:

Class 035 Services: on-line wholesale store services featuring **light up toys**

Registration Date: July 3, 2015

5. Registration No. 4,188,383

Mark: **LIGHT UP YOUR IMAGINATION**

Class 9 Goods: ...**luminous** or mechanical traffic signals, **luminous** or mechanical traffic signaling pattern, **luminous** signs, rotating **lights** for traffic signaling, **blinkers** in the nature of traffic **lights...** **luminous** pointers... light-emitting **electronic indicator panels...** **light emitting diodes...**

Class 11 Goods: **luminous house numbers, lamps...** **lights** for ships, **lighting** apparatus and fixtures or ships, **headlights** for ships, **lighting apparatus...** **LED (light emitting diode) lighting fixtures...** **neon lamps, lanterns, miniature light bulbs, lighting devices...** **electric lamps, electric lighting fixtures...** **lanterns for lighting...** **electric lights** for Christmas trees...

Registration Date: August 14, 2012

6. Registration No. 2,370,910

Mark: **LIGHT UP YOUR LIFE, INC.**

Class 035 Services: retail store services featuring European style **lighting fixtures** and low voltage systems comprised of 12V or 24V transformers, **lighting fixtures** and cable and rail

Registration Date: July 25, 2000

7. Registration No. 1,383,513

Mark: **LITE-UP**

Class 28 Goods: toy **light sticks**

Registration Date: February 18, 1986

8. Registration No. 1,302,795

Mark: **LITE-UP**

Class 28 Goods: toy **light sticks**

Registration Date: October 30, 1984

It is clear that, based on the above-referenced evidence, there are a number of third parties whose registrations were allowed, which registrations are used in association with goods or services that include an “illumination” aspect and wherein a disclaimer of the phrase, “LIGHT UP”, was not required.

Notwithstanding, even if the “LIGHT UP” portion of the mark is considered “merely descriptive”, this portion of the mark has certainly acquired secondary meaning as it relates to the “wholesale distributorship services”. It is well known that one way to show that a mark has acquired distinctiveness is through long-standing use of the mark with the services. Generally, the standard for “long-standing use” is at least five years of continuous use with the services. Although Applicant filed its application as intent-to-use, Applicant actually began using the “LIGHT UP” portion of the mark with its wholesale distributorship services at least as early as December 31, 2005. Applicant’s has not yet submitted a statement of use in order to obtain the most accurate date of first use to further bolster the argument that Applicant far exceeds the standard for “long-standing use.” Notwithstanding, Applicant has been using the mark, “LIGHT UP” with its wholesale distributorship services for at least eighteen years, which more than satisfies the standard for long-standing use.

In addition, Applicant's customers recognize Applicant as the "LIGHT UP" company as it relates to the specific services that Applicant provides.

To demonstrate that Applicant's mark, "LIGHT UP", has acquired distinctiveness specific to the niche group of customers that benefit from Applicant's services, Applicant is in negotiations with its customers to sign an affidavit (Exhibit A). This affidavit asserts 1) Among other activities, the Company is in the business of operating amusement parks, resorts and attractions; 2) The Company has done business with, and has been a customer of, Applicant's for numerous years; 3) During the years of doing business with Applicant, it has become known as, and referred to as, the "LIGHT UPTM" Company in the industry (the "Industry"); 4) The Industry referred to is the service of wholesale distributorship of toys to amusement parks, theme parks, resorts and attractions; 5) When the Company hears the phrase, "LIGHT UP", in association with companies in the Industry, the Company has an immediate impression of Lightuptoys.com LLC as the entity that is supplying those wholesale distributorship services; and 6) The Company associates the mark, "LIGHT UPTM" with Applicant and has an impression that it provides innovation, experience, customer service and consistent first-rate quality of these wholesale distributorship services. Accordingly, when Applicant's customers hear the phrase, "LIGHT UP", in association with the services long supplied by Applicant, the Company has an immediate favorable impression of Applicant's company, Lightuptoys.com LLC, as the entity that is supplying these wholesale distributorship services. Accordingly, Applicant's mark, "LIGHT UP" has undoubtedly acquired distinctiveness.

2. Classification & Identification of Services

Applicant respectfully requests amendment to the services, as suggested by the Examiner. With strike-through designating deletions and underlining designating deletions, the amended services are as follows:

Class 035: entertainment services, namely, ~~providing an entertainment experience~~ live visual and audio performances including in the nature of music shows, dancing shows, and bubble shows ~~bubbles~~; wholesale distributorship ~~selling~~ featuring light up toys and novelty light up ~~items~~ goods to owners of amusement parks, theme parks, resorts and attractions

Class 041: retail store services featuring novelty light up toys and novelty light up and bubble ~~goods~~ items

Conclusion

Applicant believes that it has responded to each ground for rejection of registration of the Application and requests that all grounds for rejection be withdrawn and that registration of the Application be approved. If there are any questions concerning this response, please contact Applicant's counsel

Respectfully submitted,
/Scott R. Cox/

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EXHIBIT A

AFFIDAVIT

Comes now, _____, on behalf of _____ (the "Company"), and upon oath or affirmation states as follows:

1. Among other activities, the Company is in the business of operating amusement parks, resorts and attractions.

2. The Company has done business with, and has been a customer of, Lightuptoys.com LLC for numerous years.

3. During the years of doing business with Lightuptoys.com LLC, it has become known as, and referred to as, the "LIGHT UP™" Company in the industry (the "Industry").

4. The Industry referred to is the service of wholesale distributorship of toys to amusement parks, theme parks, resorts and attractions.

5. When the Company hears the phrase, "LIGHT UP", in association with companies in the Industry, the Company has an immediate impression of Lightuptoys.com LLC as the entity that is supplying those wholesale distributorship services.

6. The Company associates the mark, "LIGHT UP™" with Lightuptoys.com LLC and has an impression that it provides innovation, experience, customer service and consistent first-rate quality of these wholesale distributorship services.

FURTHER AFFIANT SAYETH NAUGHT.
