

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

In re: Application of:)	
RAB Lighting Inc.)	Trademark Law Office 101
)	
Serial No.: 88/299,522)	Examining Atty.: Andrew Rhim
)	
Trademark: T34 (standard characters))	

Response to Office Action

In response to the Office Action dated April 26, 2019 (the “Office Action”), please consider the following:

I. Initial Remarks

Registration of Applicant’s mark T34 for use with “Lighting fixtures; Electric lighting fixtures; LED (light emitting diode) lighting fixtures” in International Class 11 (the “Mark”) has been refused in the Office Action under § 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), based on the assertion that the Mark merely describes a feature or characteristic of Applicant’s goods. Specifically, the Examining Attorney believes that “T34” is a shape of lightbulb. However Applicant’s goods do not use lightbulbs and the evidence does not establish that “T34” is in fact a lightbulb shape. The former is made clear by Applicant’s response to the Office Action’s Requirement for Information as well as the amendment to Applicant’s goods. For at least the reasons presented herein, Applicant respectfully asserts that the refusal to register its Mark was in error and any concerns that the Examining Attorney may have had are now moot. Applicant respectfully requests that the refusal be withdrawn.

II. Amendment of Identification of Services

An applicant may amend an application to clarify or limit the identification of goods and services. 37 C.F.R. § 2.71(a). Accordingly, Applicant further clarifies and limits its identification of goods as follows (where the **underlined bold** text is being added and ~~stricken~~ text is being deleted):

Class 11: ~~Lighting fixtures; Electric lighting fixtures;~~ LED (light emitting diode) lighting fixtures, **namely, lighting fixtures with integrated LEDs**

As amended, Applicant's goods are now as follows:

Class 11: LED (light emitting diode) lighting fixtures, namely, lighting fixtures with integrated LEDs

III. Requirement for Information - Goods

The Office Action requires that Applicant "submit additional product information about applicant's goods because the nature of such goods is not clear from the present record."

(Internal citations omitted). In response, Applicant submits herewith a fact sheet, instruction manual and advertisement/promotional information with photographs from Applicant's website for the goods. See Exhibit A.

The Office Action states that "Applicant must also describe in detail the nature, purpose, and channels of trade of the goods." In response, Applicant states that the goods are lighting fixtures with integrated LEDs (light emitting diodes) that fit into modular recessed ceiling grids. The goods do not use light bulbs. The goods provide general purpose illumination and are sold throughout the United States where lighting fixtures are sold.

IV. Response

The Mark is not merely descriptive of Applicant's goods. A mark is merely descriptive if "it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007)). See also TMEP §1209.01(b). "The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract." TMEP §1209.01(b). The immediate idea must be conveyed with a "degree of particularity." *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 1978 WL 21540, at *2 (T.T.A.B. Aug. 15, 1978).

Additionally, within the context of the Lanham Act, the term "merely" is interpreted to mean "only." *Application of Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 n.7 (C.C.P.A. 1980) (citing *Application of Colonial Stores, Inc.*, 394 F.2d 549, 552 (C.C.P.A. 1968)). In other words, when considered in conjunction with the particular identified goods or services, a mark is merely descriptive if it does nothing but describe those goods or services. *Colonial Stores*, 394 F.2d at 552.

While Applicant's Mark is fanciful, it is helpful to remember that only a "thin line of demarcation" lies between a suggestive term and a merely descriptive designation. *In Re Broco*, 225 U.S.P.Q. 227, 1984 WL 63012, at *2 (T.T.A.B. Nov. 1, 1984). "The distinction is often made on an intuitive basis rather than as a result of a logical analysis susceptible of articulation," *Id.*, but it must be remembered that "unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts [about the 'merely

descriptive' character of the mark] are to be resolved in favor of applicants.” *In Re Conductive Sys., Inc.*, 220 U.S.P.Q. (BNA) ¶ 84 (T.T.A.B. Sept. 27, 1983).

Specifically, The Section 2(e)(1) refusal was based on the Office Action’s belief that “the term T34 refers to a type of light bulb shape in the field of lighting.” However, the Office Action acknowledges that “the nature of [Applicant’s] goods is not clear from the present record.” Applicant’s Response to the Office Action’s Requirement for Information, submitted herewith, makes clear the nature of Applicant’s goods. See Exhibit A. Applicant’s description of goods for which registration is sought has also been clarified. Such information and clarification confirms that the Mark does not merely describe a feature or characteristic of Applicant’s goods. Notably, Applicant’s goods do not use light bulbs.

“If the examining attorney refuses registration [on descriptiveness grounds], he or she must support the refusal with appropriate evidence.” TMEP §1209.02. “Sources for considering the context in which the mark is or may be used include websites, publications, labels, packages, advertising material, and explanatory text on specimens for the goods and services.” TMEP §1209.01(b). Such items are provided in Exhibit A and make clear the Mark is not merely descriptive. The four references provided in the Office Action do not carry the burden of establishing that “T34” is descriptive of Applicant’s goods or is associated with the shape of a lightbulb shape.

The Office Action’s first reference shows Google search results for the query “‘t34’ and lighting.” This same search query now lists Applicant’s T34 lighting fixture as the top search result, despite the product only having been launched in September of 2019. See Exhibit B. This supports that the Mark is an identifier of source for Applicant and not a descriptive term.

The second reference, to the Gamut website, shows “T34” in the “Bulb Shape” field and depicts a “LED Bulb” with a screw base. However, this reference appears to have been removed. See Exhibit C, noting “Gamut is no longer accepting new orders.” Thus, it cannot speak to consumer’s impression of the Mark.

The third reference, to the Fytled website, contradicts the Gamut reference by showing a flood light without any light bulb. This is illustrated by the “Exploded Drawing” of the product, which is shown in this reference in the Office Action. However, this Fytlet reference is also not applicable to determining the impression of applicable U.S. consumers because the reference is to a company and website in China. See Exhibit D.

The fourth reference, to the 1000Bulbs website, purports to have a “T34” “Bulb Shape,” however, the depicted bulb shape is nothing like the bulb shape in the Gamut reference or the product depicted in the Fytled reference. Further, it is nothing like the alleged “T34 Bulb Shape” claimed to be depicted elsewhere on 1000Bulbs’ website. See Exhibit E.

In sum, the Gamut reference in the Office Action is no longer active. The Fytlet reference is in China and does not show or reference a light bulb shape. The 1000Bulbs reference is contradicted both by the Gamut and Fytlet references and even by other information on 1000Bulbs’ own website. Indeed, a chart from www.bulbs.com depicting bulb shapes does not reference “T34.” See Exhibit F. It can only be concluded that T34 does not refer to a specific type of light bulb shape in the field of lighting.

While evidence from the internet is generally permissible, it is worth remembering that the internet contains information that is not always accurate. Further, even if the references were valid, “[t]he internet (and websites such as Wikipedia) contains enormous amounts of information: some of it is generally known, and some of it is not.” *In re The Newbridge Cutlery*

Co., 776 F.3d 854, 863 (Fed. Cir. 2015). “Further, it is simply untenable that any information available on the internet should be considered known to the relevant public. The fact that potential purchasers have enormous amounts of information instantly available through the internet does not evidence the extent to which consumers of certain goods or services in the United States might use this information to discern the primary significance of any particular term.” *Id.*

For the sake of argument only, even if “T34” referred to a shape of lightbulb, the Mark would not describe a feature or characteristic of Applicant’s goods, as amended. The Office Action asserted that “the mark merely describes a feature or characteristic of the goods – namely, the goods utilize and/or are associated with a light bulb shape known as T34,” which was based on the originally specified goods: “Lighting fixtures; Electric lighting fixtures; LED (light emitting diode) lighting fixtures.” However, the description of goods has been clarified and amended by this Response to “LED (light emitting diode) lighting fixtures, namely, lighting fixtures with integrated LEDs.” As noted above, “[t]he determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract.” TMEP § 1209.01(b). The description of goods, as amended, makes clear that the source of light is integral to the fixture and is not from a lightbulb. “Sources for considering the context in which the mark is or may be used include websites, publications, labels, packages, advertising material, and explanatory text on specimens for the goods and services.” *Id.* Applicant’s actual goods on which the Mark is used do not feature sockets that accept screw-in lightbulbs. See Exhibit A, containing such items, and submitted in response to the Examining Attorney’s request for information regarding Applicant’s goods.

In sum, the Mark is a fanciful term that identifies the source of Applicant's goods. In the short time since Applicant's T34 lighting fixture was launched in September 2019 it has become the top Google search result for the search query "T34" for lighting. Applicant's goods, as shown by Applicant's response to the Office Action's Requirement for Information and Applicant's amendment to the specification of goods, confirm that the Mark is not used in connection with lightbulbs. Further, the Office Action's evidence fails to establish that the Mark is merely descriptive or that "T34" is a shape of lightbulb. For at least the above reasons, "T34" does not immediately convey a feature or characteristic of Applicant's goods but instead functions as a distinctive trademark for Applicant's goods. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal under Section 2(e)(1) and approve the Application for publication. The examining attorney is invited to contact Applicant's attorney if any issues remain that can be resolved by telephone or email.

Respectfully Submitted,

/Eric Lamb/

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