

Applicant's Response to Office Action

The Office Action dated July 9, 2019 refuses registration of the present application asserting that the submitted specimen does not show the mark in the drawing in use in commerce.

Specifically, the Examiner objects to the specimen which shows an e-commerce website offering the claimed goods for sale in connection with the brand TRUST OPTICS, and asserts that this specimen image does not show the applied-for mark, TRUST, being used in commerce.

Applicant respectfully disagrees, and submits that inclusion of a generic or merely descriptive aspect such as OPTICAL in the specimen does not change the commercial impression of the mark, and thus the refusal is improper.

It is submitted that specimens showing use of the mark in conjunction or combined with other components is acceptable to establish use of the mark as long as the mark being applied-for is "separate and not connected" from other components such that the applied-for mark creates a separate commercial impression.

In fact, the TMEP at Section 807.12(d) explicitly states:

[A]n applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen, i.e., the element performs a trademark function in and of itself.

In this case, the specimen shows the applied-for mark, TRUST, used in combination with a purely generic or descriptive term, OPTICS, which is descriptive of the goods being claimed in the application ("eyeglasses"). As such, it is submitted that the present case does not even involve a "composite mark", as the second word shown in the specimen is generic or merely descriptive. However, even assuming that it could be argued that the addition of the word OPTICS results in a composite mark, the specimen should still be accepted based on the standards set forth in the TMEP section noted above.

Applicant's position is further supported by decisions of the Trademark Trial and Appeal Board. For example, *In re Royal Body Care Inc.*, 83 USPQ2d 1564, 1567 (TTAB, 2007), where applicant sought to register the mark NANOCEUTIAL when it was embedded in the phrase RBC'S NANOCEUTICAL, the Board found that "the terms RBC's and NANOCEUTICAL are separate, not connected. They do create separate impressions." The Board in *In re Royal Body Care* concluded that NANOCEUTIAL created a separate commercial impression warranting registration despite being shown in the specimen as being used in conjunction with other aspects.

Just as in *In re Royal Body Care*, the applied-for mark in this case creates a separate commercial impression apart from the generic term OPTICS such that registration based on the submitted specimen is proper.

Similarly, in *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989), where applicant sought to register the mark TINEL-LOCK but the specimen displayed the mark as “RO6AI TINEL-LOCK-RING”, the Board held that registration was proper and noted that the alphanumeric designation “RO6AI” was a model number and not essential to the commercial impression engendered by TINEL-LOCK, and further dismissed consideration of the word “RING” as being a generic term.

In part, the Board in *In re Raychem* stated: “Prospective purchasers of these highly technical goods would readily recognize both the part number and the name of the goods as such, and would therefore look only to the trademark “TINEL-LOCK” for source identification. The fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented by this case, create a unitary expression such that “TINEL-LOCK” has no significance by itself as a trademark.”

Just as in *In re Raychem*, the specimen in this case shows the applied-for mark combined with a generic or merely descriptive term, OPTICS. The connection with the word OPTICS is even less pronounced in this case as compared to *In re Raychem* as there are no hyphens between TRUST and OPTICS in the specimen, as was the case in the mark “RO6AI TINEL-LOCK-RING.” Based at least on the reasoning relied upon by the Board in that case, it is submitted that prospective purchasers would readily recognize that OPTICS is a merely generic or descriptive term for the “eyeglasses” goods and therefore only look to the trademark TRUST for source identification.

This is further emphasized by other holdings of the Board in which an applied-for mark was allowed to register based on a specimen image showing use of the applied-for mark in combination with other aspects. “The courts in a proper case may recognize the right to registration of one part of an owner’s mark consisting of two parts.” *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (SERVEL functions as a mark apart from the term INKLINGS). Cases have frequently held that an applicant’s use of its corporate name or house mark along with another trademark or trade name does not create a unitary mark. *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969) (“While the record does show that Textron’s principal or house mark ‘HOMELITE’ appears on its chain saws as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin”); *In re Emco, Inc.*, 158 USPQ 622, 623 (TTAB 1968) (“It is concluded that the law and the record support applicant’s position that ‘RESPONSER’ is registrable without addition of the surname ‘MEYER’”); and *In re Barry Wright Corp.*, 155 USPQ 671, 672 (TTAB 1967) (“[I]t is clear that the notation ‘8-48’

stands out as a distinguishable element separate and apart from the statement ‘ANOTHER 8-48 FROM MATHATRONICS’’’).

Based on at least all of the foregoing, it is respectfully submitted that the refusal of the specimen is improper as it shows use of the applied-for mark, TRUST, which creates a separate commercial impression apart from the generic term OPTICS shown in the specimen, such that reasonable consumers would clearly recognize that OPTICS merely describes Applicant’s goods and instead look only to the mark TRUST as the source identifying mark.

Notwithstanding all of the above, it is submitted that Applicant also uses the mark TRUST without the word OPTICS in some materials in connection with the claimed goods. Accordingly, in the interest of advancing prosecution of the present case, a substitute specimen is submitted herewith showing the applied-for mark being used in connection with the claimed goods, along with the required declaration regarding the substitute specimen.

All issues are believed to be addressed by this response, and registration of the present case is respectfully requested.