

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Lumenis Ltd.

Serial No: 90172556

Filed: September 10,2020

MARK: HiMS

Trademark Examining Attorney: Betty Chang
Law Office 115

To the Commissioner for Trademarks
United States Patent and Trademark Office

APPLICANT'S RESPONSE TO OFFICE ACTION

This is the response of Applicant, Lumemis Ltd, by Counsel, to the United States Patent and Trademark Office Action (Issue Date: December 15, 2020) from Trademark Examining Attorney, Betty Chang, which response is being made on or before June 15, 2021, for which no extension fees are due.

I. Office Search

Applicant has noted that a search of the USPTO database of registered and pending marks has revealed no conflicting marks that would bar registration under Trademark Act Section 2(d). *15 U.S.C. §1052(d); TMEP §704.02.*

II. Section 2 (e) (1)– Mark is Merely Descriptive

A. Reasons for Refusal to Register

1. Applicant is desirous of registering the mark HiMS, for the identified goods and services:

IC 010: Electromagnetic stimulation (EMS) medical and aesthetic skin treatment devices, for performing non-invasive skin and body treatment procedures;

IC 044: Medical and aesthetic treatments of the face, skin and other body portions, namely, electromagnetic stimulation (EMS) skin tightening and skin rejuvenation services.

2. The Trademark Examining Attorney has refused registration of the mark, HiMS, under the Trademark Act, *Section 2(e)(1), 15 U. S. C. Section 1052(e)(1) TMEP §§1209.01(b), 1209.03 et seq.* on the grounds that Applicant's mark is merely descriptive.

3. The Trademark Examining Attorney submits that a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services.
4. Accordingly, the Trademark Examining Attorney contends that Applicant's applied for mark is descriptive because it merely describes a use and feature of Applicant's goods and services.
5. The Trademark Examining Attorney contends based on evidence from the NIH National Library of Medicine that the acronym "HiMS" comprising the mark stands for "high intensity magnetic stimulation". Further evidence brought by the Trademark Examining Attorney shows that high intensity electromagnetic stimulation is used in aesthetic body treatments. Relative to the identified goods and services, in the Trademark Examining Attorney view, "HiMS" means devices and services for delivering high intensity magnetic stimulation. Therefore, the mark merely describes a use of the goods and a feature of the services.
6. Accordingly, it is the Trademark Examining Attorney's position, that since the applied –for mark is merely descriptive of the goods and services provided by Applicant, and, furthermore in her view appears to be generic in connection with the identified goods and services and thus cannot acquire distinctiveness, the applied for mark is incapable of registration.

B. Statement of the Law

1. For the following reasons, Applicant respectfully disagrees with the finding and requests that the Trademark Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark.
2. It is well settled law that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e) (1) of the Trademarks Act, only if it *immediately* describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services *See In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215,217-218 (CCPA 1978). Such information must describe the goods or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981).
3. It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought, the context in which it is being used on or in connection with those goods and/or services, and the possible significance that the term would have to the average purchaser of the goods and /or services because of the manner of its use.
4. Accordingly, the basic test for determining whether a mark is merely descriptive is whether the involved term *immediately* conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. *See In Bright Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

5. On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ496, 497 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363,364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165,166 (TTAB 1980).
6. Thus, a mark may transcend descriptiveness if it "requires imagination, thought, and perception to arrive at the qualities or characteristics" of the goods or services. *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). The placement of a mark on the fanciful-suggestive-descriptive-generic continuum is a factual determination. *Id.*, 57 USPQ2d at 1565.
7. Finally, in determining whether a mark is descriptive, one must consider the mark in its entirety. Common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark. See *Concurrent Technologies Inc v Concurrent Technologies Corp.*, 12 USPQ 2d 1054, 1057 (TTAB 1989).

C. Applicant's Arguments in Support of Registration

Regarding the Trademark Examining Attorney's refusal under *Section 2(e)(1)*, 15 U. S. C. *Section 1052(e)(1)* TMEP §§1209.01(b),1209.03 et seq. referred to in IIA above, Applicant makes the following submissions for the Trademark Examining Attorney's further consideration:

1. Applicant seeks to register the mark HiMS for "Electromagnetic stimulation (EMS) medical and aesthetic skin treatment devices, for performing non-invasive skin and body treatment procedures" in Class 10 and "Medical and aesthetic treatments of the face, skin and other body portions, namely, electromagnetic stimulation (EMS) skin tightening and skin rejuvenation services" in Class 44. Applicant's goods are devices and services for delivering high intensity magnetic stimulation. The Trademark Examining Attorney has refused registration on the basis that "HiMS" comprising the mark stands for "high intensity magnetic stimulation".
2. Applicant respectfully disagrees. Applicant's mark is not merely descriptive of its goods and services because the mark has an ambiguous and nebulous meaning that requires consumers to use thought and perception to understand the mark's relationship to the goods, and because the mark relies on an acronym which has no meaning in common parlance, but rather is one that when applied to the goods or services at issue, requires imagination, thought or perception as to the nature of the goods or services offered by Applicant to connect or associate it with the applied for mark. Furthermore, Applicant's mark is a single, coined term, rather than a phrase made up of two potentially descriptive terms. Applicant's mark therefore has a suggestive connotation and is not merely descriptive. Accordingly, the mark should be allowed to proceed to publication.

Applicant's Mark Requires Consumers to Use Additional Thought and Perception to Perceive the Connection Between Applicant's Goods and the Mark

3. Where consumers must engage in a multi-stage reasoning process to comprehend a mark and its relationship to the goods, rather than face an instantaneous understanding from the mark of an attribute of the products, the mark is suggestive. *See TMEP 1209.01(a)* (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services.”).
4. Applicant’s HiMS mark does not *immediately* describe Applicant’s products and services with any “degree of particularity.” *Plus Products, 211 USPQ at 1204-1205*. Applicant’s mark does not follow any well-recognized etymological conventions, and is built from components with multiple meanings. This requires consumers to use additional thought, perception, or imagination to comprehend the mark’s relationship to Applicant’s goods, thus giving the mark a suggestive significance.
5. Moreover, HiMS is not a recognized term used by the public in a descriptive manner, and the Trademark Examining Attorney has submitted no evidence suggesting that it is. In fact, consumers are already conditioned to recognize the use of terms such as "e," "i," ".com," and ".net," very often combined with generic terms such as "travel," "business," etc. to convey the notion that a product or service is internet based or associated with some or other technological product or innovative device. While the use of the abbreviated term “app” rose to prominence because of use in connection with mobile phones, there are other well-known examples where the use of the letter “i” is used, as in “iphone”, “ipad”, “ipod” and “bitcoin”, “bitmap”, etc. In much the same way HiMS is used in abbreviated form in reference to high intensity electromagnetic stimulation as in the case in issue of the applied for mark.
6. With these different meanings and connotations, it is possible that consumers would see Applicant’s mark and immediately ask questions such as “What does HiMS stand for?”; “What sort of product or service is related or associated to the mark?”; “Does it involve technology?”; “What is high intensity magnetic stimulation?”, “What are its risks and benefits?”, “Who is the provider of the goods and services associated with the mark?”, etc. The multiple possible meanings of the term and the vagueness of the term’s relevance to the goods and services require consumers to use additional thought, imagination, or perception to ultimately associate Applicant’s applied –for mark with its products and services, and thus make an informed choice and determination about purchasing Applicant’s goods and services.
7. These multiple meanings, the common patterns and terms that Applicant’s mark plays on, and the conditioning consumers have to recognize other terms to describe goods and services in the modern technological world are indicative that consumers would not simply instinctively recognize the connection between Applicant’s mark and Applicant’s goods. Instead, they would have to engage in a multi-step reasoning process and use additional thought, perception, or imagination to reach a conclusion as to the nature of those goods. *See TMEP § 1209.01(a)*.
8. In the light of the foregoing, Applicant respectfully disagrees with the Trademark Examining Attorney that the applied for mark HiMS *immediately* informs prospective purchasers of the nature and characteristics of applicant’s goods and services and *immediately* conveys information about significant features of the mark without any multi-stage reasoning process.

Thus Applicant's mark is not merely descriptive and should be allowed to proceed to registration.

9. Because the applied for mark HiMS is suggestive, Applicant's mark is not merely descriptive. When doubts exist as to whether a term is descriptive as applied to the goods or services for which registration is sought, those doubts should be resolved in favor of the Applicant. *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994).
10. Accordingly, the mark should be allowed to proceed to publication.

Genericness of the Applied for Mark

11. Finally, the Trademark Examining Attorney states that in addition to being merely descriptive, the applied-for mark appears to be generic in connection with the identified goods and services. A generic mark, being the "ultimate in descriptiveness," in the Trademark Examining Attorney's view, cannot acquire "distinctiveness" and thus is not entitled to registration on either the Principal or Supplemental Register under any circumstances. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986)); see TMEP §§1209.01(c) et seq., 1209.02(a).
12. The Trademark Examining Attorney has failed to show any competent evidence to show how the relevant public understands the term "HiMS", and on which to base to make her refusal of registration on the grounds of genericness.
13. The law on this issue is crystal clear. When the U.S. Patent and Trademark Office (USPTO) refuses registration on the basis of genericness, it (the Trademark Examining Attorney) bears the burden of establishing that the mark is generic with clear evidence. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 157, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). No such evidence has been adduced by the Trademark Examining Attorney to this effect.
14. Accordingly, there is no basis in fact or in law for a refusal of registration of the applied for mark based on genericness.

III. Conclusion

1. By reason of the above, Applicant is of the opinion that the Trademark Examining Attorney's grounds for rejection of the mark on the basis that applicant's applied- for HiMS mark is merely descriptive of its services, as referred to in IIA1-6 above, are overcome.
2. Because Applicant's mark requires consumers to use additional thought, perception, and imagination to comprehend, its significance and the nature of the goods and services associated with the mark, and the lack of evidence showing the claimed genericness, the mere descriptiveness refusal should be withdrawn. Applicant's mark should proceed to registration.

3. Accordingly, the Trademark Examining Attorney is respectfully requested to resolve any doubt in this regard in Applicant's favor and to allow the mark for registration.

Respectfully submitted,

/Anthony Jason Mirabito/
Anthony Jason Mirabito, Esq
Attorney for Applicant
Dated: June 10, 2021
(Will be signed electronically)