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SEPT. 28, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Corning Inc.**

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Serial No. 75/160,655

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**Paul R. A. Burke** for Corning Inc.

Jill C. Alt, Trademark Examining Attorney, Law Office 114,  
(Mary Frances Bruce, Managing Attorney).

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Before **Cissel**, Hohein and Wendel, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 4, 1996, applicant applied to register  
the mark "GLARECUTTER" on the Principal Register for  
"ophthalmic lenses," in Class 9. The basis for the  
application was applicant's assertion that it possessed a  
bona fide intention to use the mark in interstate commerce.

The Examining Attorney refused registration under  
Section 2(e)(1) of the Trademark Act on the ground that the  
mark sought to be registered is merely descriptive of the

goods identified in the application. She took the position that "GLARECUTTER" immediately describes a feature of ophthalmic lenses, i.e., that they cut glare. As support for the refusal to register, she made of record excerpts from Webster's Ninth New Collegiate Dictionary, wherein the word "glare" is defined as "a harsh uncomfortably bright light... especially painfully bright sunlight"; and the word "cut" is defined as "to reduce in amount."

Also included with the Office Action in which the refusal to register was made were copies from the records of the Patent and Trademark Office of several third-party registrations. In one, the mark "GLARE FREE" is shown to be registered on the Supplemental Register for ophthalmic lenses and lens kits.<sup>1</sup> The second registration is for the mark "GLARELESS" for coated ophthalmic lenses,<sup>2</sup> and is also on the Supplemental Register. The third registration made of record by the Examining Attorney shows that the mark "GLARE FREE 2000" is registered for ophthalmic lenses and lens kits.<sup>3</sup> That registration is on the Principal Register, but the descriptive term "GLARE FREE" is disclaimed apart from the mark as shown.

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<sup>1</sup> Reg. No. 1,903,896.

<sup>2</sup> Reg. No. 1,714,758.

<sup>3</sup> Reg. No. 1,916,009.

Applicant's response to the refusal was to argue that the term sought to be registered is not merely descriptive, but rather is only suggestive, in that when a potential purchaser considers the term in its entirety, "an element of doubt arises as to what the particular goods might be." (p. 2 of the response). Applicant also listed six third-party registrations of marks for various glass and optical products wherein the term "GLARE" was a component. In addition, applicant submitted a copy of a dictionary listing for the word "cutter." Among the definitions were both "an instrument... that cuts"; and "a ship's boat for carrying stores or passengers." Applicant argued that "its mark is capable of a double meaning and does not convey an immediate notion as to any particular characteristic, quality or ingredient of the applicant's product," because "'cutter' also alludes to a boat and is suggestive of people who wear ophthalmic lenses while boating." (p. 3).

The Examining Attorney was not persuaded, and in the second Office Action she made the refusal to register final. Submitted with the final refusal was a copy of an article from "Primary Care Optometry News" which discusses the "glare-reducing" filter technology in applicant's "glare-control products." The article discusses applicant's lenses, which are designed and prescribed to

help people with "sensitivity to bright sunlight and glare outdoors."

Applicant timely filed a Notice of Appeal and a request for reconsideration, attached to which was a copy of an information packet applicant distributes to the eye-care professionals who sell applicant's products to consumers. Also included were copies of the printed advertisements for applicant's "GLARECONTROL" line of lenses. Additionally, applicant submitted a copy of a technical definition of the word "glare" which shows that there are several different phenomena referred to as "glare." Applicant postulated that "GLARECUTTER does evoke a unique commercial impression, namely of some instrument or machine cutting through the glare," yet applicant nonetheless maintained that the term is not merely descriptive, but rather only suggestive of applicant's lenses.

Not surprisingly, the Examining Attorney was not convinced by this argument. With her response to the request for reconsideration, she submitted copies of a number of excerpts from articles retrieved from the Nexis® database of publications. One article uses the term "glare-cutters" in reference to polarized glasses. Another uses "glare cutters" in connection with computer monitor

shields. Other excerpts use various wording such as "cut the glare," "cuts the glare" and "cutting the glare" in reference to lenses, glass, and even a window treatments which reduce the effects of bright light.

Action on the appeal was resumed. Applicant and the Examining Attorney both filed briefs, but applicant did not request an oral hearing. Accordingly, we have resolved this appeal based on the written record and arguments.

The test for determining whether a trademark is merely descriptive of the goods or services with which it is used or with which it is intended to be used is well settled. A mark need not name the goods or services in order to be considered merely descriptive of them. Rather, a mark is merely descriptive if, as used in connection with the goods or services, it immediately describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Ethan Foods, Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re American Screen Process Equipment Co.*, 175 USPQ 561 (TTAB 1972). Further, the question of whether a mark is merely descriptive must be determined not in the abstract,

that is, not by asking whether one can guess from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or in connection with the services, it immediately conveys information about their nature. In re Abcor Development Corp., supra. We must determine the question of registrability based on the identification of goods or recitation of services as set forth in the application for registration, subject only to such limitations as to scope, channels of trade, etc. as are specified therein, or which are normal for goods of the same nature. In re Allen Electric and Equipment Co., 458 F.2d 1404, 173 USPQ 689 (CCPA 1972); In re Vehicle Information Network, Inc., 32 USPQ2d 1542 (TTAB 1994); and In re Cryomedical Services Inc., 32 USPQ2d 1377 (TTAB 1994).

When this test is applied to the facts in the case at hand, we find that the mark applicant seeks to register is clearly merely descriptive of the goods set forth in the application. We agree with the Examining Attorney that the proposed mark conveys the fact that a characteristic of applicant's ophthalmic lenses is that they cut glare. The record in this application plainly shows that applicant's

lenses filter high-energy blue light, and that this type of light constitutes glare, which causes discomfort and vision problems for some people. As the Examining Attorney points out, glare occurs when more blue light is allowed to reach and interact with the eye, and glare cutting occurs when less blue light is allowed to reach and interact with the eye. Although applicant's products cut or reduce glare in a way that differs from the way that polarized lenses cut glare, the fact that applicant's technique for accomplishing this is different or more technologically advanced does not alter the fact that applicant's lenses cut glare.

Applicant makes several arguments on the issue of descriptiveness, but none is persuasive. To begin with, applicant argues that the Examining Attorney has not met her burden of proof. We disagree. As noted above, this record establishes that the term applicant seeks to register immediately and forthwith conveys significant information about the function of applicant's products.

Applicant next argues that the Examining Attorney improperly dissected the mark in order to get the descriptive meaning from it. To the contrary, the record establishes that the descriptive connotation of "GLARECUTTER" is immediately understood when the mark in

its entirety is considered. The plain meanings of each of the components of the mark result in the obvious meaning of the combination. Contrary to applicant's argument, the term sought to be registered possesses no double meaning or incongruity, and does not create any doubt as to its meaning in connection with applicant's goods. Again, the test is not whether potential purchasers can surmise the nature of applicant's goods from consideration of the mark alone, but rather whether the mark sought to be registered, when viewed in connection with the goods specified in the application, immediately and forthwith conveys information about a significant characteristic of those goods.

Applicant's suggestion that "cutter" alludes to a boat and that the mark therefore is suggestive of people who wear ophthalmic lenses while boating borders on the disingenuous. We agree with the Examining Attorney's contention that it is difficult to understand how applicant's mark could be considered incongruous. "GLARECUTTER" clearly conveys the fact that applicant's lenses cut glare. It is difficult to think of a way to make this statement with any more clarity or simplicity.

Applicant's argument that the term sought to be registered does not describe applicant's products because they do not "cut off" the blue spectrum of light at a

particular point or eliminate it altogether, but rather only filter it, is also not well taken. The record clearly establishes that applicant's lenses reduce the amount of blue light allowed through the lens, cutting glare by a certain amount in a lightened state, and by another amount in a darkened state. Reducing the transmission of blue light constitutes cutting the glare.

Applicant argues that the purchasers of its goods are professional vision practitioners who are technically sophisticated, and therefore would appreciate the incongruity of using the term "GLARECUTTER" in connection with lenses which have no specific cut off point for the filtering of blue light. It is well settled that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable with regard to trademarks, however. In re Decombe, 9 USPQ2d 1812 (TTAB 1988). Further, we agree with the Examining Attorney that it is more likely that even sophisticated eye-care professionals understand "GLARECUTTER," when the term is used in connection with ophthalmic lenses which are promoted in the advertising material of record as being for use by patients with "light sensitivity" and "glare problems," indicates that the lenses reduce glare in some way.

Ordinarily, the third-party registrations listed by applicant in its response to the refusal to register would not be considered because copies of the registrations were not properly made of record. In the case at hand, however, the Examining Attorney addressed applicant's arguments based on in the listed registrations, so we will consider them as if they had been properly made of record.

They do not, however, establish that the mark sought to be registered is suggestive, rather than merely descriptive. The Board is not bound by decisions of Examining Attorneys to pass particular marks to publication. Moreover, two of the registrations listed by applicant have been canceled, and there appear to be reasonable explanations for the others. For example, the registration for "GLARE-OUT"<sup>4</sup> lists the goods as chemical lens cleaning preparations, not the lenses themselves, and the mark "GLAREBAN"<sup>5</sup> would appear to be only suggestive in connection with non-reflecting glass.

In summary, the record in this application establishes that "GLARECUTTER" conveys the fact that applicant's ophthalmic lenses cut glare. This is a significant characteristic for such products. Notwithstanding

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<sup>4</sup> Reg. No. 1,479,672;

<sup>5</sup> Reg. No. 1,479,672;

**Ser No.** 75/160, 655

applicant's arguments to the contrary, the mark is therefore merely descriptive within the meaning of Section 2(e)(1) of the Act. Accordingly, the refusal to register is affirmed.

R. F. Cissel

G. D. Hohein

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

**Ser No.** 75/160, 655