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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Digital Lightwave, Inc.

Serial No. 75/217,097

Stefan V. Stein of Holland & Knight, LLP for Digital
Lightwave, Inc.

Patty Evanko, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Seeherman, Hohein and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On December 23, 1996 Digital Lightwave, Inc. filed the
above-identified application for the mark LIGHTWAVE
MANAGEMENT for goods which were subsequently identified as
"electronic testing equipment, namely, telecommunication
line integrity testing apparatus for assessing the
performance of telecommunications networks." The

application was based on an asserted bona fide intention to use the mark in commerce; subsequently applicant filed an amendment to allege use, asserting first use and first use in commerce as of November 1997. Applicant has disclaimed exclusive rights to use the word LIGHTWAVE.

When a final refusal of registration issued pursuant to Section 2(e)(1) on the ground that applicant's mark is merely descriptive of its goods, applicant filed the instant appeal.

Applicant and the Examining Attorney have filed briefs.¹ An oral hearing was not requested.

The Examining Attorney contends that LIGHTWAVE MANAGEMENT is merely descriptive of applicant's goods because it identifies their purpose or function. In support of this position, she has made of record the following definitions:

¹ After applicant filed its appeal brief it came to the attention of the Board that applicant had filed a request for reconsideration along with its notice of appeal. Although the original papers were never received by the Office, applicant submitted by facsimile transmission a copy of the request, bearing a certificate of mailing by Express Mail. Accordingly, the Board deemed the request to be timely, suspended proceedings on the appeal, and remanded the application to the Examining Attorney for consideration of the request for reconsideration. After the Examining Attorney ultimately maintained the refusal of registration and returned the file to the Board for resumption of proceedings in the appeal, the Board allowed applicant time to file a supplemental appeal brief if it desired. Applicant did not submit a supplemental brief, and therefore applicant's original brief and the Examining Attorney's brief are the only briefs in the file.

Lightwave: light in the infrared, visible and ultraviolet ranges, which falls between x-rays and microwaves.²

Lightwave system: A device that transmits light pulses over optical fibers at extremely high speeds.³

Management: The act, manner, or practice of managing: handling, supervision, or control⁴

Manage: 1. To direct or control the use of: handle: *manage a complex machine tool.*⁵

The Examining Attorney has also submitted excerpts of articles taken from the NEXIS database which refer to applicant and its products:

Digital Lightwave, Inc. (Nasdaq: DIGL), a leader in the lightwave management equipment market....
"PR Newswire," October 16, 1997

Digital Lightwave's ASA 312 Network Information Computer is a lightwave management product that has the ability to simultaneously process multiple protocols to verify and qualify the performance of telecommunications networks and embedded equipment.
"PR Newswire," July 17, 1997

Digital Lightwave develops, manufactures, and sells lightwave management products, including Network Information Computers that provide information concerning the performance of SONET, ATM and T-Carrier

² The Computer Desktop Encyclopedia.

³ Tech Encyclopedia.

⁴ The American Heritage Dictionary of the English Language, 3d ed. © 1992).

⁵ Id.

telecommunications networks and
transmission equipment and Remote
Access Agents....

"PR Newswire," May 29, 1997

Digital Lightwave specializes in
Lightwave management products for
monitoring SONET, ATM and T-Carrier....

"Network Briefing," May 15, 1997

Digital Lightwave Inc, Clearwater,
Florida builder of computer systems to
provide information on performance of
lightwave telecommunications networks
and transmission equipment....

"Computergram International," May 6,
1997

The company's lightwave management
products are used by telecommunications
service providers and network equipment
manufacturers to analyze the
performance of lightwave transmission
(fiber optic) networks and to more
effectively implement fiber optic
network expansion.

"PR Newswire," April 16, 1997

Digital Lightwave, Inc. (Nasdaq: DIGL),
an emerging leader in the lightwave
management equipment market....

"PR Newswire," August 6, 1997

Digital Lightwave develops,
manufactures, and sells lightwave
management products, including Network
Information Computers....

"PR Newswire," May 29, 1997

In addition, in response to a request for information
about its goods, applicant has provided excerpts from its
website (www.lightwave.com) which include the following

statements, under the heading "Lightwave Management™

Technology for OEM Subsystems:

Digital Lightwave develops and manufactures custom optical subsystems used to monitor, analyze and facilitate the management of fiber-optic-based networks. Based on the company's reusable core component technology developed for its leading high-speed optical diagnostic and analysis products, these subsystems offer customized solutions for specific customer requirements.

Working with its OEM customers, Digital Lightwave designs cost-effective ways of bringing additional intelligence to optical networks and embedded elements. By providing customized portable test instruments, network-integrated lightwave diagnostics and element-embedded performance monitoring....

As a pioneer in optical networking technologies, Digital Lightwave helps its customers maintain a competitive edge by providing engineering and manufacturing expertise in the development of innovative optical monitoring and diagnostic subsystems....

For example, Digital Lightwave has recently developed an integrated monitoring and analysis system....

Listed under "Core Technologies" are "Optical applications: Monitoring, diagnostics, real-time analysis."

Applicant has also stated, in response to specific questions raised by the Examining Attorney, that applicant's electronic testing apparatus uses lightwaves to

test the integrity of the telecommunication line and that its apparatus analyzes lightwaves.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of a significant ingredient, quality, or characteristic of the goods with which it is used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question is not decided in a vacuum, but in relation to the goods on which, or the services in connection with which, it is used. See *In re Abcor Development Corporation*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

There is no question that the term LIGHTWAVE describes a characteristic of applicant's testing apparatus. Applicant has acknowledged this descriptiveness by disclaiming this term in its request for reconsideration, and also, in its Supplemental Register registration for DIGITAL LIGHTWAVE for essentially the same goods (electrical testing equipment, namely, line integrity testing apparatus),⁶ applicant has disclaimed exclusive rights to LIGHTWAVE, an admission that the term is generic for the services.

⁶ Registration No. 2,226,814, issued February 23, 1999.

As for the combined term LIGHTWAVE MANAGEMENT, the evidence shows that this term is also descriptive of applicant's goods. As the Examining Attorney has pointed out, the NEXIS excerpts refer to applicant's goods as lightwave management products and lightwave management equipment. Applicant did not specifically discuss these articles in its appeal brief, but during the course of prosecution it characterized the references as misuses by the particular reporters. Although one such reference might be dismissed as a misuse, here we have evidence of multiple uses of "lightwave management" as a descriptive term for applicant's products. Further, applicant's own materials indicate the descriptive nature of the words. The purpose of applicant's goods is to do lightwave diagnostics and performance monitoring, and its systems are used "to monitor, analyze and facilitate the management of fiber-optic-based networks." To the relevant customers for such goods, LIGHTWAVE MANAGEMENT, as used on the goods, will immediately convey that one feature of the equipment is to monitor the lightwaves in the fiber-optic-based networks.

Applicant argues that LIGHTWAVE MANAGEMENT is an oxymoron because light cannot be controlled and commanded. However, lightwaves can be analyzed and monitored, and it

is the "supervision" meaning of "management" that would be understood by the relevant consumers. Applicant appears to take the position that the test of whether the term is merely descriptive is based on whether one can determine what the goods are based only on seeing the mark.

Applicant specifically argues that it would require "a great deal of imagination and luck" for a consumer to conclude what the products are from viewing the mark. However, applicant misstates the test for determining descriptiveness in arguing that imagination would be required to guess what applicant's goods are from the mark alone. As indicated above, the question of whether a term is merely descriptive is not decided in a vacuum. "Whether consumers could guess what the product is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant also points to the lack of any dictionary definition of the phrase "lightwave management." However, the Office is not required to submit evidence that the entire phrase LIGHTWAVE MANAGEMENT appears in a dictionary in order to establish that the mark is merely descriptive. Descriptive phrases are not necessarily found in dictionaries and, thus, even without such evidence the phrase as a whole may still be found to be merely

descriptive. See, for example, *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985) (VENTURE LENDING ASSOCIATES merely descriptive of investing services).

Applicant also argues that there is no evidence of competitors' use of the term. Although descriptive use by competitors may be evidence that a mark is merely descriptive, the absence of such evidence does not necessarily mean that the mark is not descriptive. The fact that an applicant is the first to use a term in connection with its goods does not justify registration if the term is merely descriptive of them. See *In re Ruffin Gaming LLC*, 66 USPQ2d 1924 (TTAB 2002); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Applicant has also made reference to a third-party registration for MANAGEMENT OF LIGHT, with the word LIGHT disclaimed, for "micro structured optical surfaces for use in the field of optics for forming lenses, prisms, beamsplitters, lenticulars, and reflectors."⁷ Because of

⁷ Registration No. 2,263,330. According to the request for reconsideration, a copy of which was submitted by facsimile transmission because the original never reached the Office (see footnote 1), applicant submitted the record "obtained from the USPTO web site" for this registration. Applicant did not submit a copy with the facsimile transmission, but we have obtained the information from the Office records, and have treated the registration as being of record.

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the differences in these goods and those in applicant's application, the fact that this mark was registered has no persuasive value in our determination of whether applicant's mark is merely descriptive.

Decision: The refusal of registration is affirmed.