

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/13/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lightwave Electronics Corporation

Serial No. 74/712,452

David H. Jaffer of Rosenblum, Parish & Isaacs for
applicant.

Martha Santomartino, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Lightwave Electronics Corporation has filed a
trademark application to register the mark LIGHTWAVE
ELECTRONICS for "lasers."¹ In response to an initial
refusal to register on the ground that the mark is merely
descriptive in connection with the identified goods,
applicant submitted a claim of acquired distinctiveness

¹ Serial No. 74/712,452, in International Class 9, filed August 8, 1995,
based on an allegation of first use and use in commerce as of March 16,
1987.

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under Section 2(f) of the Act. The application also includes a claim of ownership of Registration No. 1,593,629, on the Supplemental Register, for the identical mark and goods.²

The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of applicant's goods and that it has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f).

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

While applicant does not expressly concede that its mark is merely descriptive, by virtue of its ownership of a registration on the Supplemental Register for the identical mark and goods, applicant impliedly admits that the registered term was merely descriptive, at least at the time of registration. *In re Hunke & Jochheim*, 185 USPQ

² Registration No. 1,593,629 issued as a registration on the Supplemental Register on April 24, 1990. [Section 8 affidavit accepted April 4, 1996.]

188, 189 (TTAB 1975); and *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1137 (TTAB 1992).³

The Examining Attorney has submitted excerpts of articles from the LEXIS/NEXIS database regarding lasers, lightwaves, electronics and lightwave electronics.⁴ We also take judicial notice of the dictionary definitions of "lightwave" and "laser"⁵ submitted by the Examining Attorney with her brief.

We conclude, based on this evidence, that a "laser" generates a type of "lightwave"; and that "lightwave electronics" is used in various written materials available to the public to identify a field of electronics. Thus, we

³ However, registration on the Supplemental Register does not constitute an admission that the registered mark has not acquired distinctiveness. *Perma Ceram Enterprises, supra*. See also, *General Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984).

⁴ For example, "IEEE Journal of Lightwave Electronics" [quoted in *Microwave Journal*, August, 1996]; "A few years ago the group started stocking fiber-optic cable and lightwave electronics" [*Network World*, June 13, 1988]; regarding the acquisition of a transmission company, "[I]t intends, says Dey, to enhance the Stromberg capability through lightwave electronics" [*Telephone Engineer & Management*, April 15, 1987]; "[m]ore conventional semiconductor lasers, widely used in lightwave communications and compact disc players..." [*Optical Materials & Engineering News*, September 1, 1995]; "Lasers are used to generate lightwaves that carry high-speed data ... in fiber-based networks" [*Industry Week*, June 5, 1995]; "[t]he former is a high-precision laser system that floods the network with lightwaves, each at a precisely defined wavelength" [*Electronic Design*, October 145, 1994].

⁵ *Communications Standard Dictionary* (3rd ed.), 1996, defines "lightwave" as "an electromagnetic wave (a) that has a wavelength within or near the visible spectrum..." and "laser" as (syn.) "light amplification by stimulated emission of radiation." The dictionary includes a note with regard to lasers that the "release of radiated energy" is "highly controlled ... so as to generate an intense highly directional narrow beam of ... electromagnetic energy."

find that, when applied to applicant's goods, the term LIGHTWAVE ELECTRONICS immediately describes, without conjecture or speculation, that the science of "lasers" falls within the rubric of "lightwave electronics." Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term LIGHTWAVE ELECTRONICS as it pertains to lasers. See, *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); and *In re Recovery*, 196 USPQ 830 (TTAB 1977). Further, despite applicant's arguments to the contrary, the evidence supports the conclusion the LIGHTWAVE ELECTRONICS is highly descriptive in connection with lasers.

Thus, we turn to consider whether applicant has established, under Section 2(f), that LIGHTWAVE ELECTRONICS has acquired distinctiveness in connection with lasers.

Initially, applicant's claim of acquired distinctiveness relied solely upon a declaration by applicant's president attesting to applicant's "continuous

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and exclusive use in interstate commerce [of the mark in connection with the identified goods] for more than five consecutive years." Subsequently, applicant submitted annual figures for its advertising campaigns for its products, along with samples of its print advertisements, and annual figures for its product revenues. Applicant noted that it advertises its products in laser industry magazines such as *Laser Focus World*. Applicant submitted a 1996 article from *The Industrial Physicist*, entitled "the Diode-Pumped Laser Revolution," that refers to applicant as among the prominent manufacturers in this laser industry. Applicant also submitted four letters from commercial and university purchasers of applicant's products. Each letter includes, essentially, the following statement:

I identify the term LIGHTWAVE ELECTRONICS with the products of Lightwave Electronics Corporation. I perceive the term as a trademark which identifies Lightwave Electronics Corporation as a source of diode-pumped laser products.

We note that applicant submitted additional evidence with its reply brief. We have not considered this evidence, as it is untimely. The record in an application must be complete prior to appeal. See Trademark Rule 2.142(d).

The issue is whether the descriptive term LIGHTWAVE ELECTRONICS has acquired secondary meaning in connection

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with applicant's laser products, that is, whether applicant's use and promotion of the term over a period of time has been of such a nature and extent that the primary significance of the term in the minds of the relevant purchaser is no longer descriptive, but rather is an indication of the source of the goods of the applicant. *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). It is applicant's burden to establish acquired distinctiveness and we find that, on the record before us, applicant has not established that LIGHTWAVE ELECTRONICS has acquired distinctiveness in connection with the identified goods.

Merely using a term for a number of years does not necessarily lead to the conclusion that distinctiveness has been achieved. *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984). As our reviewing court noted in *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001 (Fed. Cir. 1988) "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." See also, *Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *Restatement (Third) of Unfair Competition* (1993), Section 13, comment

e.⁶ In this case we have a mark that is highly descriptive in connection with the identified goods. Thus, we conclude that more evidence than that which has been offered here is necessary to establish the acquired distinctiveness of this designation.

Clearly, applicant's products are not general consumer goods, but applicant has submitted no information regarding the nature of the channels of trade or purchasers of its products, the expense of its products, or the average number of products sold in a year, either by applicant or, generally, in this industry. Thus, it is impossible to determine whether applicant's apparently modest advertising expenditures translate into substantial exposure of applicant's products and trademark to relevant purchasers or whether the revenues disclosed represent substantial sales to a significant percentage of the relevant market. Similarly, a mention of applicant in a single publication and form letters from four of applicant's own customers do not appear significant in the absence of evidence regarding

⁶ "The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness."

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the relative circulation of the publication in the industry or indicating that any consumers, or these four consumers in particular, should be considered a determinative number given the channels of trade and class or nature of purchasers for applicant's products under the mark. The record contains no information linking applicant's evidence "with use in contexts which would condition customers to react to or recognize the designation ... as an indication of source..." *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443, 1450 (TTAB 1994).

Decision: The refusals under Sections 2(e)(1) and 2(f) of the Act are affirmed.

R. F. Cissel

E. J. Seeherman

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board