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Paper No. 12
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LAS Laser Analytical Systems GmbH

Serial No. 75/773,323

Bruce S. Londa of Norris McLaughlin & Marcus P.A. for LAS Laser Analytical Systems GmbH.

Aretha C. Masterson, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Wendel, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

LAS Laser Analytical Systems GmbH, a German corporation, seeks registration of the term DELTACONCEPT as applied to:

"lasers, namely, solid state lasers, diode lasers, gas lasers, dye lasers, and parts therefor; amplifiers, namely, laser amplifiers and parts therefor; lidars, namely, differential absorption lidars, and parts therefor; meters, namely, Fourier transform spectrometers, light energy meters and wavelength meters and parts therefor; spectroscopic instruments and parts therefor; laser based systems comprised of laser for chemical application; laser based systems comprised of lasers for industrial machining applications; laser based systems comprised of lasers for scientific applications; laser based systems comprised of lasers for environmental applications;

laser based systems comprised of lasers for analytic systems and parts therefor; optical sensors for use in gas and particle analysis and environmental monitoring and parts therefor," all in International Class 9.¹

Registration has been finally refused pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that the applied-for term does not function as a trademark as evidenced by the specimens of record.

The appeal has been fully briefed, but applicant did not request an oral hearing.

We affirm the refusal of registration.

The specimens accompanying the application papers as originally submitted by applicant consist of photocopies of relevant pages of a user's manual for a WAVETRAIN external cavity frequency doubler for continuous-wave, single frequency lasers. This tabletop-sized device (pictured on the front cover of the user's manual) is said to represent an advancement in deep UV technology used in scientific/ research and industrial applications. We have reproduced

¹ Application Serial No. 75/773,323 was filed on August 11, 1999, based upon applicant's allegations of use in commerce between Germany and the United States of America at least as early as April 1998.

the relevant sections of the user's manual (from pages 11 and 12 of that manual):

The DeltaConcept

The patented DELTACONCEPT design used in the WAVETRAIN surpasses the classical double-Z resonator in many aspects. As shown in Figure 2 below, only two mirrors M1 and M2 are used for this resonator:

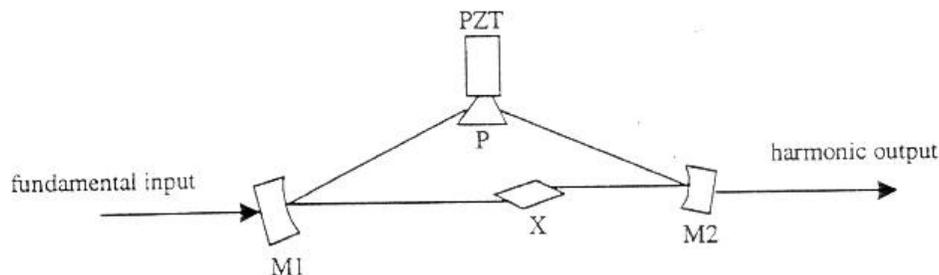


Figure 2: Deltaconcept resonator

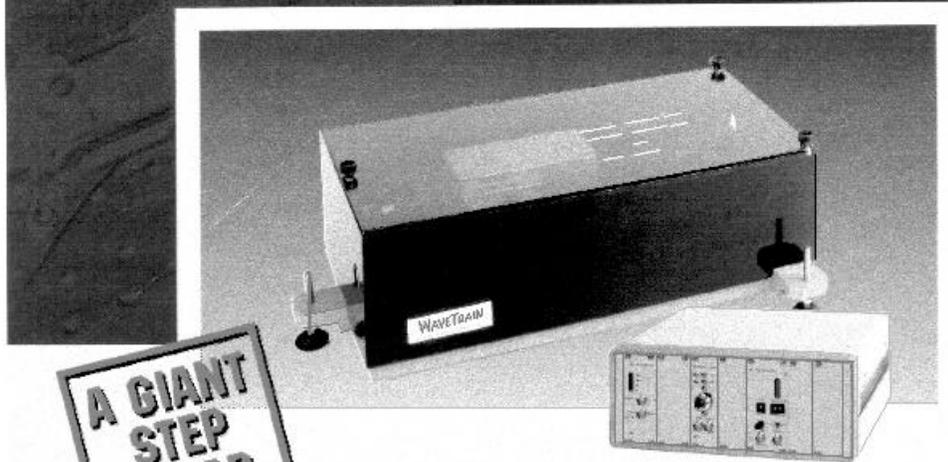
... Moreover, the DELTACONCEPT design reduces the dimensions of the resonator resulting in a considerable increase in the spectral width of the resonator modes. ...

In the DELTACONCEPT design optics exchange needed for large wavelength changes is confined to mirrors M1, M2 and the crystal X making an exchange more easily. ...

The Trademark Examining Attorney originally assigned to this application refused the specimens as unacceptable, explaining that these specimens do not show usage of the term DELTACONCEPT as a trademark for the identified goods. Applicant then responded by submitting a substitute specimen reproduced below - a one page, multi-colored sheet of paper having text and images, and variously described by applicant as a "brochure" or "point of sale display":

WAVETRAINTM

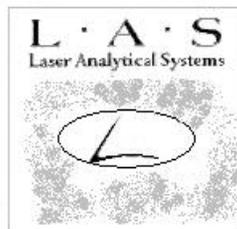
CW Frequency Doubler



**A GIANT
STEP
AHEAD**

for single frequency lasers

- Unmatched conversion efficiencies •
- Patented *DeltaConcept*[®] cavity technology •
- Excellent output power and beam pointing stability •
- Sealed and robust oscillator block design •
- Ultrafast piezo control •
- Active auto-stabilization (Rekick Feature) •



***DeltaConcept*[®] technology**

However, the newly assigned Trademark Examining Attorney took the position that neither the original specimens nor this substitute specimen demonstrated use of the term DELTACONCEPT as a trademark for the enumerated goods. With the second Office action, she made final her refusal to register based upon applicant's failure to comply with the Office's requirement for acceptable specimens of use.

In each use-based application, the Trademark Examining Attorney must determine (based upon the specimens of record) whether the claimed designation is eligible for registration as a trademark. Specifically, when applicant claims that the mark on the drawing page of the application is being used as a trademark, the Trademark Examining Attorney must find that the matter designated is indeed functioning as a source indicator for the goods offered. When making this finding in the instant case, the Trademark Examining Attorney correctly referred to the specimens of use to discover how the applicant actually uses the aforesaid designation. See In re Bose Corp., 546 F.2d 893, 192 USPQ 213 (CCPA 1976); In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); In re Scientific Methods, Inc., 201 USPQ 917 (1979). The Trademark Examining Attorney is correct in contending that there needs to be a logical association

between the alleged mark and the product - an association that causes consumers to recognize the term as a source indicator for the claimed goods.

The user's manual and the advertising flyer both reveal most prominently a trademark for these goods, namely WAVETRAIN. It is true that goods may bear multiple trademarks. However, whenever the term DELTACONCEPT appears in the original specimens or on the substitute specimen, it is used in the context of "DELTACONCEPT design," "patented *DeltaConcept*® cavity technology," "*DeltaConcept*® technology," etc.²

Notwithstanding the fact that the term "DeltaConcept" is always accompanied by words such as "design," "patented," "technology," "method," "cavity technology," etc., applicant argues that purchasers would immediately notice the prominent use of DELTACONCEPT as a source indicator for its laser based systems such as the WAVETRAIN instrument.

² Attaching a trademark symbol[®] to the term as applicant has done twice on the advertising flyer [*DeltaConcept*®] is not, in and of itself, sufficient to transform this term into a trademark for the identified goods based upon otherwise unacceptable usage on the specimens. Further, something as subtle as repeating the ad color from the top of the flyer to the carrier device around the appearance of the words "*DeltaConcept*® technology" will not succeed in making this matter into a product mark. See *In re Manco Inc.*, *supra*, and cases cited therein.

We find that the current case is not unlike an earlier case decided by this Board more than thirty years ago. See In re Big Stone Canning Co., 169 USPQ 815 (TTAB 1971) [FLASH COOK merely indicates a process of cooking rather than identifying applicant's canned vegetables, which are identified by another mark on the label]:

As the mark is used on the containers for the goods it is apparent that it refers to a particular process rather than serv[ing] to identify the goods. ... And, while applicant contends that "FLASH COOK" suggests "better color and flavor," it is our opinion that said term indicates the process of cooking rather than other factors. The term "flash," as an adjective, describes a food-processing method and indicates an extremely brief exposure to some very intense altering agent (as heat or cold). See: Webster's Third International Dictionary, 1965. Examples thereof are flash drying of milk, flash freezing of food. The term "FLASH COOK" would readily connote the process of cooking and when the term "process" is used in conjunction therewith, no other connotation would be ascribed thereto, particularly since the trademark "BUTTER KERNEL" is being used to identify source.

In order to be registrable as a trademark, the mark must be used to identify goods and distinguish such goods from those manufactured or sold by others. See: Ex parte Phillips Petroleum Company, 100 USPQ 25 (Comr., 1953). Nothing in this record shows any such use of the mark sought to be registered ...

Big Stone Canning, 169 USPQ at 816.

Similarly, based upon the entire record in this case, we have no doubt but that applicant's DELTACONCEPT may well be at the heart of applicant's advancements in laser technology. Yet we have not found a single instance in the

specimens where the designation DELTACONCEPT is used as a source indicator for the WAVETRAN instrument itself.

The manufacturer who merely uses a term in some context in relatively close proximity to an identified product does not necessarily transform the adopted term into a trademark for that product. While applicant clearly intends DELTACONCEPT to function as a mark for its laser based systems, it is true that:

"... not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so and not everything that is recognized or associated with a party is necessarily a registrable trademark."

See In re Port-A-Hut, Inc., 183 USPQ 680, 682 (TTAB 1974).

For example, the label chosen for an inventor's methodology will not always make the transformation into a source identifier for the claimed product - even if a critical component of the goods depends upon the invention. This may remain true, even after such time as the proprietary technology is universally identified in some way with that very inventor/assignee.

Based upon the specimens of record in this case, we cannot conclude that the term DELTACONCEPT functions as a trademark for the goods identified herein. Rather, we find that applicant uses the term DELTACONCEPT as the

designation for an invention incorporated into its laser-based systems, and particularly as seen in connection with the WAVETRAN laser frequency doubler. Unfortunately for applicant, given the context in which it is used on the specimens of record, the term DELTACONCEPT does not function as a trademark to indicate the origin of applicant's identified goods.

Decision: The refusal of registration is affirmed.³

³ Applicant and the Trademark Examining Attorney continue to disagree over whether the sheet submitted as a substitute specimen actually qualifies as a "point of sale display." See page 4, *supra*. We find nothing in the record actually showing this 8½" x 11" paper being used in that manner (e.g., a photograph of a commercial booth or trade show display portraying this paper next to the equipment). However, in light of our disposition of this case, we do not need to decide this related but collateral issue.