

EXAMITE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of:	§	
OCUSOFT, INC.	§	Trademark Law Office No.: 108
Serial No.: 76/378707	§	
Filed: March 6, 2002	§	Examining Attorney:
Mark: NIGHT & DAY	§	Julia Hardy Cofield
International Class Nos.: 005	§	Attorney Docket No.: OCUS015

REQUEST FOR RECONSIDERATION

BOX RESPONSES NO FEE
 Commissioner
 for Trademarks
 2900 Crystal Drive
 Arlington, Virginia 22202-3514

CERTIFICATE OF MAILING			
37 C.F.R. § 1.10			
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee mailing label number <u>EL 98731 91603</u> addressed to:			
Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514.			
By:	<u>Cassie Hanson</u>	Date:	<u>11/7/03</u>
	Cassie Hanson		

Dear Sir:

Ocusoft, Inc., Applicant for the above-referenced application, responds to the Final Office Action mailed on May 8, 2003 by filing an appeal with the Trademark Trial and Appeal Board and requesting reconsideration by the examiner.

MARK IS SUGGESTIVE

The Examiner has issued a final rejection for the mark NIGHT AND DAY as descriptive. According to the Examiner NIGHT & DAY is "clearly descriptive" because "neither thought nor imagination is required to determine the meaning of the

terminology NIGHT & DAY.” The Applicant respectfully disagrees with the Examiner’s conclusion. As the Examiner states in her office action, a term is suggestive if “imagination, thought or perception is required to determine the nature of the goods/services from the term.”

Applicant believes that if a consumer were faced with the words NIGHT & DAY on a bottle, the consumer would not immediately think of lubricant gel that won’t blur vision. NIGHT & DAY does not in any clear or precise way merely describe ophthalmic lubricants. *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 U.S.P.Q. 832 (T.T.A.B. 1977). Conversely, marks such as LUBRICANT GEL and EYE LUBE would be descriptive of the goods. A consumer who read these would understand the nature of product almost immediately. Under the Examiner’s logic NIGHT & DAY would be descriptive of nearly anything. For example, the use of NIGHT & DAY with a car would be descriptive because the car had headlights and was “intended for night or day use.”

The history of U.S. Trademark Office decisions supports the Applicant’s position on this matter. Trademark registrations, attached herein, exist for NIGHT & DAY for decaffeinated coffee (Reg. # 2164131), DAY ‘N NIGHT for deodorant (Reg. #1500933) and NIGHT & DAY for bedding (Reg #1438098). Each of these products can be used day and night; yet the marks are not considered descriptive of the products by the U.S. Trademark Office.

Each of the above listed registered marks is suggestive of the intended use of the goods. For example, NIGHT & DAY for decaffeinated coffee is suggestive that this coffee can be consumed at night without keeping the consumer awake. This use

of the mark is in no way less suggestive than the using the mark for ophthalmic solutions. The consumer must exercise imagination to understand the suggestion from NIGHT AND DAY that this coffee won't keep you awake, just as the consumer must to understand that the Applicant's lubricant gel won't blur your vision during the day. The 9th Circuit clearly agrees in quoting, with approval, this sentence from McCarthy on Trademarks: "If the mental leap between the word and the product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness." *Self Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 35 U.S.P.Q. 2d 1342 (9 Cir. 1995). The mental leap between the words "NIGHT AND DAY" and a lubricant gel for the eyes is not instantaneous.

SUMMARY

NIGHT & DAY is clearly suggestive of ophthalmic lubrications, drops, and gels because the mental leap between the words and the goods is not instantaneous. The mark's suggestiveness is in accordance with prior U.S. Trademark Office decisions for NIGHT & DAY trademark registrations. Upon reading NIGHT & DAY, consumers must use considerable thought and imagination to conclude that the goods are ophthalmic lubricants that won't blur vision. The Applicant appeals the final office action and respectfully requests that the Examiner reconsider her decision and allow registration of the mark.

Respectfully submitted,



Jo Katherine D'Ambrosio
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Facsimile (713) 975-0995

Date: 11/7/03

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-11-07 12:21:43 ET

Serial Number: 75322285

Registration Number: 2164131

Mark (words only): NIGHT & DAY

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2003-09-17

Filing Date: 1997-07-10

Transformed into a National Application: No

Registration Date: 1998-06-09

Law Office Assigned: LAW OFFICE 101

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-09-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. KRAFT FOODS SCHWEIZ HOLDINGS AG

Address:

**KRAFT FOODS SCHWEIZ HOLDINGS AG
BELLERIVESTRASSE 203
CH-8008 ZURICH,
Switzerland**

Legal Entity Type: Corporation

State or Country of Incorporation: Switzerland

GOODS AND/OR SERVICES

decaffeinated coffee

International Class: 030

First Use Date: 1988-05-10

First Use in Commerce Date: 1988-05-10

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-09-17 - Section 8 (6-year) accepted & Section 15 acknowledged

2003-07-29 - Section 8 (6-year) and Section 15 Filed

2003-07-29 - TEAS Section 8 & 15 Received

1998-06-09 - Registered - Principal Register

1998-03-17 - Published for opposition

1998-02-13 - Notice of publication

1998-01-02 - Approved for Pub - Principal Register (Initial exam)

1997-12-31 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

BARTON M. ZEDD
KRAFT FOODS HOLDINGS, INC.
THREE LAKES DR
NORTHFIELD IL 60093

Domestic Representative

BARTON M. ZEDD

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-11-07 12:22:25 ET

Serial Number: 73650160

Registration Number: 1500933

Mark (words only): DAY 'N NIGHT

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1994-02-09

Filing Date: 1987-03-19

Transformed into a National Application: No

Registration Date: 1988-08-23

Law Office Assigned: TMEO Law Office # 7

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1994-05-26

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. KMART PROPERTIES, INC.

Address:

KMART PROPERTIES, INC.
3250 WEST BIG BEAVER ROAD SUITE 226
TROY, MI 48084
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Michigan

GOODS AND/OR SERVICES

PERSONAL ANTIPERSPIRANT AND DEODORANT SOLD EXCLUSIVELY THROUGH K MART CORPORATION RETAIL STORES

International Class: 003

First Use Date: 1985-06-30

First Use in Commerce Date: 1985-06-30

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1994-02-09 - Section 8 (6-year) accepted & Section 15 acknowledged

1993-09-27 - Section 8 (6-year) and Section 15 Filed

1988-08-23 - Registered - Principal Register

1988-06-16 - Opposition terminated for Proceeding

1988-05-24 - Opposition dismissed for Proceeding

1987-10-26 - Opposition instituted for Proceeding

1987-07-28 - Published for opposition

1987-07-02 - Notice of publication

1987-06-28 - Notice of publication

1987-06-26 - Notice of publication

1987-06-12 - Approved for Pub - Principal Register (Initial exam)

CONTACT INFORMATION

Correspondent (Owner)

M. BLAIR T. GERDES (Attorney of record)

M. BLAIR T. GERDES
KMART PROPERTIES, INC.

SUITE 226

3250 WEST BIG BEAVER ROAD

TROY, MI 48084-2902

United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-11-07 12:22:52 ET

Serial Number: 73556065

Registration Number: 1438098

Mark

**&Night
&Day**

(words only): NIGHT & DAY

Standard Character claim: No

Current Status: A Section 8 affidavit has been accepted.

Date of Status: 1993-07-30

Filing Date: 1985-08-27

Transformed into a National Application: No

Registration Date: 1987-04-28

Law Office Assigned: TMEO Law Office # 7

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-11-13

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. NORDISK TEKSTIL-VAEVERI OG TRYKKERI A/S

Address:
NORDISK TEKSTIL-VAEVERI OG TRYKKERI A/S
RUGAARDSVEJ 103-115
ODENSE C,
Denmark

Legal Entity Type: Corporation
State or Country of Incorporation: Denmark

GOODS AND/OR SERVICES

COMFORTER COVERS, PILLOW CASES, SHEETS
International Class: 024
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 44(e)

ADDITIONAL INFORMATION

Foreign Registration Number: 565/1978
Foreign Registration Date: 1978-02-10
Country: Denmark
Foreign Expiration Date: 1988-02-10

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1993-07-30 - Section 8 (6-year) accepted
1993-07-30 - Post Registration action correction
1993-04-22 - Section 8 (6-year) filed
1987-04-28 - Registered - Principal Register
1986-09-09 - Published for opposition
1986-08-10 - Notice of publication
1986-07-02 - Approved for Pub - Principal Register (Initial exam)
1986-05-19 - Communication received from applicant
1985-12-10 - Non-final action mailed
1985-10-24 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

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www.patents-trademark.com

November 7, 2003

BOX RESPONSE- NO FEE
Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

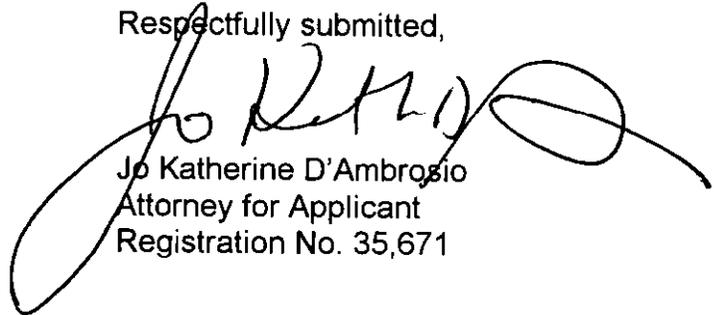
RE: Application of Ocusoft, Inc., Serial No. 76/378707, for the mark NIGHT & DAY
class 005

Dear Sir:

Enclosed for filing in connection with the captioned application is/are the
following:

1. Request for Reconsideration of the Final Office Action dated May 8, 2003.
2. Return Receipt Postcard

Respectfully submitted,



Jo Katherine D'Ambrosio
Attorney for Applicant
Registration No. 35,671



11-10-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #72