

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Stuart C. Segall)
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International Class:	41)
)
Serial No.:	77/790467)
)
Mark:	HYPER-REALISTIC)
)
Attorney Docket:	11407.5)

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RESPONSE TO OFFICE ACTION

In response to the Office Action dated November 4, 2009, Applicant Stuart C. Segall (“Applicant”) responds as follows and requests allowance of the application for registration.

1) Amendment to Description of Goods – Examiner’s Suggestions Have Been Adopted

The examining attorney has found the current description of services indefinite as to the phrase “preparation of” and must be amended to further clarify that the preparation is provided for others as a service and not merely incidental and/or ancillary to other services that Applicant provides.

The current description is as follows:

“Training services in the field of urban warfare; providing urban-simulated facilities for educational training, namely military training; preparation of operational specific urban combat training scenarios; and preparation of special effects including weapons effects, namely rocket-propelled grenades, mines, improvised explosive devices, lighting, smoke, noise, explosions, and combat wounds, for use in military training.”

The examiner suggests the following amended description (insertions underlined):

“Training services in the field of urban warfare; providing urban-simulated facilities for educational training, namely military training; preparation for others of operational specific urban combat training scenarios provided in connection with urban warfare training services; and preparation for others of special effects including weapons effects, namely rocket-propelled grenades, mines, improvised explosive devices, lighting, smoke, noise, explosions, and combat wounds, for use in military training.”

Applicant adopts this suggested amendment without prejudice with one additional amendment, as shown below:

“training services in the field of urban warfare; providing urban-simulated facilities for educational training, namely military training; preparation for others of operational specific urban combat training scenarios provided in connection with urban warfare training services; and preparation for others of special effects including weapons special effects, namely rocket-propelled grenades, mines, improvised explosive devices, lighting, smoke, noise, explosions, and combat wounds, for use in military training.”

Accordingly, Applicant respectfully submits that the objection to the description of services as being indefinite has been adequately addressed and the description is sufficiently definite.

2) Refusal to Register / Rejection under 2(e)(1) - Applicant's Mark is at most Suggestive but not Merely Descriptive.

The examining attorney has also refused registration on the grounds that the proposed mark merely describes the specified services. Applicant respectfully traverses the refusal as follows:

Applicant respectfully responds that HYPER-REALISTIC (the “Mark”) is instead as most suggestive of Applicant’s services. Since doubts on the issues of descriptiveness are to be resolved in favor of the applicant, *In Re Bed-Check Corporation*, 226 U.S.P.Q. 946, 948 (T.T.A.B. 1985), Applicant requests that the refusal be reconsidered and withdrawn based on the following arguments.

The refusal is based on these points. First, it is stated that the Mark merely describes as a whole a feature and/or characteristic of the claimed services, namely that they provide a heightened or “hyper” realistic” [sic] training and/or training environments. Second, Applicant’s specimen of record is cited as referring to these features of its services. Third, dictionary definitions of the terms “hyper” and “realistic” are attached to the office action. The office action states that the use of the prefix “hyper” with the term “realistic” provides an overall meaning of the proposed mark that merely describes these features and/or characteristics of Applicant’s training services.

What should be considered is whether, in the context of the services at issue, the overall impression of the entire Mark HYPER-REALISTIC is suggestive, even though isolated parts may be considered descriptive when viewed separately. See *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1020); *California Cooler, Inc. v. Loretto Winery, Ltd.*, 227 U.S.P.Q. 808, 810 (9th Cir. 1985).

HYPER-REALISTIC taken as a whole, evokes a different impression than the term HYPER and the word REALISTIC. HYPER-REALISTIC is not a regular word or phrase. Rather, it is irregular term created by hybridizing HYPER and REALISTIC. HYPER-REALISTIC is a combination of an arbitrary word or prefix (HYPER) and an adjective (REALISTIC), with no verb or term of action, and no particularized meaning as a whole. It is not a well defined word or term by dictionary standards, thus it has no settled descriptive meaning. It could suggest numerous things, such things as relating to fantasy, magic, psychology, psychiatry, art, logic, biology, mathematics or law and dozens of related services.

In *West & Company v. Arica Institute, Inc.*, 557 F.2d 338, 342, 195 U.S.P.Q. 446, 470 (wd Cir. 1977), the Court found that the mark PSYCHOCALISTHENICS was not descriptive because it “suggests a number of things but ... does not describe any one thing in particular. It could indicate a system of purely mental exercises..., a system of physical exercises ... which are designed to create specific, mental, emotional and physical results, or even a traditional exercise program merely designed to improve mental fitness and alertness.” Like PSYCHOCALISTHENICS, HYPER-REALISTIC taken as a whole suggests a number of things but does not describe any one thing in particular. It could suggest special training services or environments, but it could suggest many other types of services, but not merely describe any of them.

Also, the office action concludes that the Mark “merely describes as a whole a feature and/or characteristic of the claimed services, namely that they provide a heightened or ‘hyper’ realistic’ [sic] training and/or training environments.” However, HYPER-REALISTIC, taken as a whole, is not merely descriptive of the claimed services, including specifically:

“training services in the field of urban warfare;”

“providing urban-simulated facilities for educational training, namely military training;”

“preparation for others of operational specific urban combat training scenarios provided in connection with urban warfare training services;” or

“preparation for others of special effects including weapons special effects, namely rocket-propelled grenades, mines, improvised explosive devices, lighting, smoke, noise, explosions, and combat wounds, for use in military training.”

Rather, the suggestive meanings of the Mark invoke exaggerated and intangible ideas. So, no actual service could literally be merely described as HYPER-REALISTIC, particularly training services or environments. At most, the Mark could only be suggestive of the services.

Further, the specimen of record is cited as referring to the features of its services. However, the specimen of record does not use HYPER-REALISTIC to describe the services. The Mark is used as a service mark in the specimen of record, e.g., HYPER-REALISTIC training. This is a proper use of trademark, e.g., mark followed by product or service, such as APPLE computer. The word REALISTIC is used in a few sentences in the specimen of record, but separate from the term HYPER in the specimen of record (e.g., “Special effects artists create realistic weapons effects and explosions...,” Special effects wound makeup artists create dozens of extremely realistic wounds and simulations...”). These uses of the word REALISTIC in the specimen of record are akin to using “calisthenics” by itself in marketing materials for PSYCHOCALISTHENICS in *West & Company*. PSYCHOCALISTHENICS and HYPER-REALISTIC are not established words, they suggest multiple meanings, and they are not merely descriptive.

Dictionary definitions of the terms “hyper” and “realistic” attached to the office action do not establish that HYPER-REALISTIC is a defined term or that the Mark as a whole is merely descriptive of the claimed services. Again, there is no well established

dictionary definition of HYPER-REALISTIC. The office action cites definitions of “hyper” and “realistic” separately. The cited dictionary definitions of the prefix HYPER confirm that the term has multiple definitions. None of the definitions merely describe or even refer to the claimed services. The services are not “over, above, beyond,” “excessive, excessively,” “existing in more than three dimensions,” or “linked or arranged nonsequentially.”¹ Moreover, the two dictionary definitions of the word REALISTIC cited in the office action², taken by themselves or in combination with the prefix HYPER, do not merely describe or even refer to the services no matter how combined (see the table below):

HYPER	REALISTIC	CLAIMED SERVICES
1. over, above, beyond	1. tending to or expressing an awareness of things as they really are	1. training services in the field of urban warfare
2. excessive, excessively	2. of or relating to the representation of objects, actions, or social conditions as they really are	2. providing urban-simulated facilities for educational training, namely military training
3. existing in more than three dimensions		3. preparation for others of operational specific urban combat training scenarios

¹ Additional meanings for “HYPER” include, *inter alia*, 1. when used adverbially and substantively as a prefix, “over, above, beyond” that which is joined to the term as the second adjective or substantive element – as in the case of *hypersensitive*, *hyperaccurate*, *hyperacidity*, and *hyperconformist*; 2. In mathematics, especially in adjectives applied to mathematical functions, related to or resembling those denoted by the simple adjectives, but involving some extension or complication, as in the case of *hyper-complex*, *hyper-elliptical*, and *hyper-geometrical*; 3. In chemistry, to denote the highest in a series of oxygen compounds, in the case of *hyperchloric*, *hyperoxide*; 4. and especially in computing, where the prefix *hyper-* connotes an association with electronic texts or media, and a structuring of texts or information in a highly interconnected, non-linear manner, as in the case of *hyperlink* and *hypertext*; or with the computer, computer-mediated or Internet-related social and cultural phenomena, as in the case of *hyper-world* or *hyperlearning*. See, Ex. A hereto (dictionary definitions from OED Second Ed. 1989).

² REALISTIC has additional meanings, including *inter alia* “characterized by faithfulness of representation,” “that which conceives or imagines (a thing) as real,” or “concerned with, and characterized by, having a practical view of life” it does not merely describe Applicant’s services. See, Ex. B hereto (dictionary definitions from OED Second Ed. 1989).

		provided in connection with urban warfare training services
4. linked or arranged nonsequentially		4. preparation for others of special effects including weapons special effects, namely rocket-propelled grenades, mines, improvised explosive devices, lighting, smoke, noise, explosions, and combat wounds, for use in military training

There is no combination of these various definitions that taken together as a whole (e.g., beyond or excessively real) merely describe Applicant’s claimed services (e.g., training services, providing urban-simulated facilities, preparation for others of training scenarios and special effects). Rather, the combinations only suggest the services. Since the office action does not cite a requisite threshold of evidence that the Mark is merely descriptive of the claimed services, Applicant submits that the initial burden to show descriptiveness has not been met. See *In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233, 1236 (T.T.A.B. 1986).

Moreover, a mark is considered suggestive if it “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” See *Stix Products, Inc. v. United Merchants & Mfs, Inc.*, 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968). The connection between the mark and the Applicant’s services must be instantaneous for the mark to be considered merely descriptive. See *Investacorp, Inc. v. Arabian Investment Banking Corp.*, 19 U.S.P.Q.2d 1056 (11th Cir. 1991).

HYPER-REALISTIC is suggestive because it does not immediately bring to mind any specific type of service, expression, awareness, representation or object, but rather a broad range of service, expressions, awareness, representations or objects that might take place or exist. See *In re Hutchinson Technology, Inc.*, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988) (TECHNOLOGY was not merely descriptive when used as part of a composite mark for computer components). In *Hutchinson*, the court felt that “technology” was a very broad general term that included many categories of goods and was too vague to convey an immediate idea of the nature of any particular goods. See *Id.* at 1493.

Likewise, REALISTIC is too general a term to be considered merely descriptive. The generality of REALISTIC contributes to the overall suggestiveness of the Mark.

Similarly, as noted above, the term HYPER has variable meanings, such as “over, above, beyond,” “excessive, excessively,” “existing in more than three dimensions,” or “linked or arranged nonsequentially.” All of those meanings are arbitrary to the claimed services, and the multiple meanings confirm that HYPER is a broad term with many applications and does not more than potentially suggest the services. See *In re Hutchinson, supra*.

Perhaps most importantly, the Mark HYPER-REALISTIC, taken as a whole, is not a well defined term, and it could be given multiple meanings. Therefore, it does not and cannot in any literal sense merely describe Applicant’s services. Also, as shown in the table above, any combination of the meanings of HYPER and REALISTIC suggests something that is, by example, beyond REALISTIC, excessively REALISTIC, REALISTIC in more than three dimensions or arranged nonsequentially REALISTIC. None of these meanings merely describe the claimed services.

HYPER-REALISTIC is an imaginary term. It pertains to imaginary subject matter. Nothing is HYPER-REALISTIC. REALISTIC connotes realism, faithful representation, or a sensible or practical idea of what can be achieved or expected. At most, HYPER-REALISTIC suggests something beyond realism in the abstract. It does not merely describe Applicant’s services, which are not real or reality but simulations of multiple representational circumstances in a training and educational capacity. At most, the Mark suggests such a high degree of fidelity in the replication of battlefield conditions in a training environment that participants so willingly suspend disbelief that they become totally immersed and eventually stress inoculated. However, this impression of HYPER-REALISTIC requires imagination, thought and perception to reach a conclusion as to the nature of these services.

HYPER together with the word REALISTIC is incongruous and would require a reasoning process to determine the services provided by the mark. Consumers would not immediately associate HYPER characteristics (whether they think of that term as applying to *hyperactivity* or *hypersensitivity* or *hypertext transfer protocol (http://)*) with representational or simulation services. Moreover, HYPER-REALISTIC is only

suggestive of something beyond real and realistic, and therefore would require a mature reasoning process to determine the services provided by the mark. It would not merely describe the services. Consumers would not immediately associate HYPER or HYPER-REALISTIC characteristics with realistic representation or realism, much less services in Applicant's field.

Applicant's situation is similar to that in *Airco, Inc. v. Air Products and Chemicals, Inc.*, 196 U.S.P.Q. 832 (T.T.A.B. 1977). In *Airco*, the mark "AIR-CARE" was challenged as being merely descriptive of the Applicant's program for maintaining hospital and medical anesthesia and inhalation therapy equipment and hospital piping systems. The Board explained that AIR-CARE was not merely descriptive by stating, "[t]he literal meaning of the mark, namely, 'care of the air' may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of Applicant's services, but it does not, in any clear or precise way, server merely to describe Applicant's preventative maintenances services...." *Id.* at 835.

As in *Airco*, HYPER-REALISTIC requires the consumer to think carefully to derive meanings, such as "beyond realistic" or "hyper expression of things as they really are," and those meanings are imaginative and require mature thought in that they suggest concepts and exaggerated ideas and things that do not exist. See also, *In re Tennis In the Round, Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978 (TENNIS IN THE ROUND for a round tennis stadium was suggestive even though its name gave some clue as to function); *In re TBG, Inc.*, 229 U.S.P.Q. 759, 760 (T.T.A.B. 1986 (SHOWROOM ONLINE was suggestive, not descriptive, of the applicant's services of leasing databases and video disks related to viewing interior furnishings.)).

Applicant also notes that other marks for services or goods using the terms "HYPER" and "REALISTIC" have been accepted on the Principal Register by the U.S. Patent and Trademark Office (E.g., HYPER REAL (Reg. # 2576173); HYPERREALITY (Reg. # 74350459); HYPERCOLOR (Reg. # 77038420); REALISTIC GOLF (Reg. # 2692237); AIREALISTIC (Reg. #76623778); and ULTRA-REALISTIC (Reg. #75629561)). Since these were admitted on the Principal register (for services such as model reproduction, aerial entertainment performances, clothing, and cosmetics), HYPER-REALISTIC should equally be allowed on the Principal Register for Applicant's services.

The Trademark Trial and Appeal Board states that although “there is often a thin line separately merely descriptive from suggestive terms... where there is doubt in the matter, the doubt should be resolved in applicant’s behalf and the mark should be published for opposition.” *In Re Bed-Check*, 226 U.S.P.Q. at 948 (holding SENSORMAT not merely descriptive of a pressure-sensitive pad placed under hospital patients for monitoring their movement in bed).

Based on the foregoing arguments, Applicant respectfully submits that the Mark is suggestive and not descriptive and requests the examining attorney to allow the mark to be published for opposition.

3) In the Alternative, Applicant’s Mark has Acquired Distinctiveness of Secondary Meaning and is Therefore Registerable Under Section 2(f).

Although Applicant submits that the Mark should be registerable as suggestive, in the event that the refusal to register on the grounds of descriptiveness is not withdrawn, Applicant respectfully requests that the refusal to register be reconsidered and withdrawn in view of acquired distinctiveness pursuant to section 2(f) of the Trademark Act.

Applicant submits that as a result of continuous use since at least 2002 and widespread marketing efforts and successes, Applicant’s Mark has come to be readily associated in the relevant industry and consumers therein with Applicant and its claimed services. Accordingly, HYPER-REALISTIC should proceed to registration on the Principal Register pursuant to Section 2(f), 15 U.S.C. 1052(f).

“An evidentiary showing of secondary meaning adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.” *In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q. 417, 422 (Fed. Cir. 1985). Under this standard, the following information is sufficient to show that Applicant’s use of the Mark has caused the purchasing public to identify the Mark with the Applicant.

Applicant refers to the specimen of record and supporting declaration showing extensive use of the Mark as discussed above. Applicant has made widespread use and promotion of the mark for the claimed services since at least 2002, including through the use of such marketing materials as reflected by the specimen of record. Applicant also refers to the supporting declaration (“Affidavit Under Section 2(f) of the Lanham Act”) submitted concurrently herewith.

As a result of its efforts, Applicant has a substantial and wide variety of clientele, including leaders in the military training market, private security companies and importantly the United States military itself. Applicant has provided its claimed services in connection with the mark since 2002 to hundreds individuals and groups throughout the United States. Applicant’s use of the mark, combined with marketing and promotion of the mark over seven plus years has caused consumers to recognize the mark and associate it with Applicant and its services.

A significant source of publicity for Applicant’s services offered under the Mark comes from Applicant’s company’s website at www.strategic-operations.com. The comprehensive website displays the Mark prominently and receives numerous hits. Attached as Exhibit C are excerpts from Applicant’s website showing use of the Mark, including marketing materials, articles, lists of clients and other materials. Applicant advertises its services in a wide variety of print and electronic media, as well as through trade shows and press releases and other media, advertising and promotional outlets. Applicant regularly participates in industry trade shows, which are attended by hundreds of industry professionals every year. Applicant’s presence at these trade shows has been prominent, and Applicant promotes its services under the Mark at these trade shows and conferences. Applicant has also received industry recognition for its services rendered under the Mark. Applicant has expended substantial resources in the successful promotion and sales of services under the Mark. As a result of its use, promotion and industry recognition of the Applicant and the Mark in association with Applicant and its services, Applicant respectfully submits that HYPER-REALISTIC has gained secondary meaning and distinctiveness in the marketplace. See, Exhibit C.

4) Conclusion.

For the reasons set forth above, Applicant respectfully submits that the application is in condition for allowance and a notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 619-688-1300 for any reason that would advance the instant application to issue.

Dated this 29th day of April 2010.

Respectfully submitted,

/s/

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Attachments:

Exhibit A - dictionary definitions from Oxford English Dictionary (OED) Second Ed. 1989

Exhibit B – “ “

Exhibit C – excerpts from www.strategic-operations.com

Affidavit Under Section 2(f) of the Lanham Act