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Paper No. 20  
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re DTC Eye Surgery Center, Inc.

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Serial No. 75/065,953

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Timothy J. Martin, Esq. for applicant.

Geoffrey D. Aurini, Trademark Examining Attorney, Law Office  
104 (Sidney Moskowitz, Managing Attorney).

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Before Seeherman, Quinn and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

DTC Eye Surgery Center, Inc. has filed a trademark  
application to register the mark shown below for "medical  
services in the nature of corrective surgery for eyes."<sup>1</sup>

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<sup>1</sup> Serial No. 75/065,953, in International Class 42, filed March 1, 1996,  
based on use of the mark in commerce, alleging first use and use in  
commerce as of September 1, 1995 and November 15, 1995, respectively.

The Trademark Examining Attorney has issued a final requirement for a disclaimer of LASER INSTITUTE OF THE ROCKIES, under Section 6 of the Trademark Act, 15 U.S.C. 1056, on the ground that this phrase is merely descriptive in connection with applicant's services.

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

The Examining Attorney contends that "Laser Institute" is merely descriptive, if not generic, in connection with applicant's services. He contends, further, that "Rockies" is primarily geographically descriptive in connection with applicant's services because "Rockies" is synonymous with "Rocky Mountains," which is a particular geographic area; that applicant is located, and its services are rendered, in the Rocky Mountain region, which is the geographic area in close proximity to the Rocky Mountains; and that a services/place association is presumed. In support of his position, the Examining Attorney submitted dictionary definitions of "Rockies," "laser" and "institute"; excerpts of articles from the LEXIS/NEXIS database; and copies of third-party registrations.

Applicant contends that the Examining Attorney's evidence is inapposite; and argues that, in view of the several connotations of "institute," the term "Laser Institute" is not merely descriptive. Applicant argues, further, that "of the Rockies" is not primarily geographically descriptive "when viewed in the context of Applicant's services"; that the Rocky Mountain region covers too broad an area to describe a particular geographic place and that, even if it is a particular geographic place, there is no services/place association herein; that "Rockies" has "widely used" meanings other than that of the Rocky Mountains; and that the phrase in its entirety, LASER INSTITUTE OF THE ROCKIES, is neither merely descriptive nor primarily geographically descriptive. In support of its position, applicant submitted dictionary definitions of "laser" and "institute."<sup>2</sup>

We consider, first, whether the phrase "Laser Institute" is merely descriptive in connection with applicant's identified services.

The test for determining whether a mark, or a portion thereof, is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature

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<sup>2</sup> Applicant submitted additional evidence with its brief; however, the record must be complete prior to appeal in an *ex parte* case. See Trademark Rule 2.142(d). This evidence is untimely and not subject to judicial notice. Thus, it has not been considered.

of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a term merely descriptive, that it describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The record includes a definition of "institute" as, *inter alia*, "an association of persons or organizations that collectively constitute a technical or professional authority in a field of work or study"<sup>3</sup>; and of "laser" as "any of several devices that convert incidental electromagnetic radiation of mixed frequencies to one or more discrete frequencies of highly amplified and coherent visible radiation[,] [a]lso called 'optical maser.'"<sup>4</sup> The

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<sup>3</sup> *Webster's Third New International Dictionary*, unabridged.

<sup>4</sup> *The American Heritage Dictionary of the English Language*.

Examining Attorney has submitted 13 third-party registrations for marks including the term "institute" with a disclaimer of that term. Nine of these registrations are for medical services analogous to applicant's services. Four additional third-party registrations include the phrase "Laser Institute," with a disclaimer of that phrase. Three of these registrations are for medical services analogous to applicant's services. Several excerpts from articles in the LEXIS/NEXIS database are of record and include three excerpts referring to three different "Laser Institute(s)" offering laser eye surgery.

Based on the evidence of record it is clear that, when applied to applicant's services, the term LASER INSTITUTE immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely that applicant is an organization that offers corrective eye surgery using lasers. 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 services to readily perceive the merely descriptive significance of the term LASER INSTITUTE as it pertains to the identified services.

We are not persuaded otherwise by applicant's arguments to the contrary. There is no question that applicant

utilizes lasers in connection with its services. In fact, applicant's Web page states that it was the first to offer LASIK in the Rocky Mountain region and that it continues to limit its practice to "corrective laser surgery." Further, not only does the definition of "institute" encompass applicant's specialized services, but the evidence indicates that the term "institute" has been used in connection with other medical practices. The fact that "institute" may have multiple definitions is not relevant as we must consider the term in connection with the services rendered and, thus, the meaning of the term is clear. We conclude that the phrase "Laser Institute" is, at least, merely descriptive and disclaimer thereof is appropriate.

We consider, next, the Examining Attorney's contention that the "of the Rockies" portion of applicant's mark is primarily geographically descriptive.

In order for a mark, or a portion thereof, to be considered primarily geographically descriptive under Section 2(e)(2), it is necessary to show that (i) the mark or relevant portion is the name of a place known generally to the public, and that (ii) the public would make a goods/place association, that is, believe that the goods or services for which the mark or relevant portion is sought to be registered originate in that place. See, e.g., *University Book Store v. University of Wisconsin Board of*

Serial No. 75/065,953

*Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's goods or services come from the geographical place named in the mark. *See, e.g., In re California Pizza Kitchen, Inc., supra*; and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982).

The Examining Attorney contends that the primary significance of the phrase "of the Rockies" in the mark is geographic because the primary significance of "the Rockies" is geographic; that, even though the Rockies encompass a large area, it is a specifically defined geographic area which is neither vague nor remote or obscure in the context of consumer awareness. The Examining Attorney submitted excerpts from *The American Heritage Dictionary of the English Language* (3<sup>rd</sup> ed. 1992) of the following entries:

**Rockies** - See Rocky Mountains.

**Rocky Mountains** also **Rockies** - A major mountain system of western North America extending more than 4,827 km (3,000 mi) from northwest Alaska to

the Mexican border. The system includes numerous ranges and forms the Continental Divide. Its highest elevation is Mount Elbert, 4,402.1 m (14,433 ft) in central Colorado. ...

We also take judicial notice of the definition of "Rocky Mountain states" in *The Random House Dictionary of the English Language* (2<sup>nd</sup> ed. 1987) as "those states in the region of the Rocky Mountains, including Colorado, Idaho, Montana, Nevada, Utah and Wyoming, and sometimes Arizona and New Mexico."

The Examining Attorney submitted excerpts from applicant's Web site, wherein applicant states "Laser Institute of the Rockies was the first location to perform LASIK in the Rocky Mountain Region, and we are the only location in Colorado that specializes and limits our practice to corrective laser surgery" and "[p]atients have been coming to Dr. Dishler for LASIK from the Rocky Mountain region for over four years."

The Examining Attorney also conducted a search of the NEXIS database for "Rockies" within two words of "Denver." He submitted excerpts from five of 498 stories. Of the five excerpts, the two most relevant excerpts are from the *Denver Rocky Mountain News*, and refer to two companies, the Community Health Plan of the Rockies and the Food Bank of the Rockies, both located in Denver, Colorado.<sup>5</sup>

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<sup>5</sup> The Examining Attorney submitted two third-party registrations owned by the First National Bank of the Rockies of Meeker, Colorado. Both



Considering the first part of the test, we find the evidence clearly establishes that "the Rockies" is the name of a place known generally to the public. Not only does it identify a specifically defined, albeit large, mountain range, but the region encompasses specified states, including applicant's state of Colorado. See *Burke-Parsons-Bowley Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 10 USPQ2d 1443, 1444 (6<sup>th</sup> Cir. 1989) ("Appalachian" in the mark APPALACHIAN LOG STRUCTURES found to define a specific large geographic region); and *In re Mid-West Abrasive Co.*, 146 F.2d 1011, 64 USPQ 400 (CCPA 1945) (based primarily on a dictionary definition, "Mid-West" found to refer to a specific geographic place). Further, the phrase "of the Rockies" retains the primarily geographic character of "the Rockies" because, in the context of the entire mark, it indicates the region within which the "Laser Institute" is located and the services are rendered.

Considering the second part of the test, as applicant states on its Web site, applicant is located, and its services are rendered, in Colorado in the "Rocky Mountain region." Thus, we presume a public association of the goods with the place from the fact that the applicant's services come from the geographical place named in the mark. Because

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registrations include the organization's name, but only one of the registrations includes a disclaimer of "the Rockies." While we do not have the records of those registrations before us, it would appear that

both parts of the enunciated test have been met, we find "of the Rockies" is primarily geographically descriptive.

As with the issue of mere descriptiveness, we are not persuaded otherwise by applicant's arguments to the contrary. The term "Rockies" in the name of the baseball team, the Colorado Rockies, retains its geographic significance even as it may suggest a double entendre. This reinforces, rather than detracts from, the conclusion that "the Rockies" has primarily a geographical significance. Applicant also contends that the mere fact that the Examining Attorney found a few stories using "Rockies" in conjunction with "Denver" does not mean that "of the Rockies" in applicant's mark is primarily geographically descriptive "in the context of applicant's services"; and that there is no association between applicant's services and the Rocky Mountain region because these types of services are performed throughout the United States and in other countries. However, we are not concerned that services similar to applicant's services may be rendered worldwide. What is relevant in this case is that applicant's services are located and rendered in the Rocky Mountain region.

For the foregoing reasons, we conclude that the entire phrase LASER INSTITUTE OF THE ROCKIES consists of

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these two registrations indicate inconsistency in USPTO practice. Thus,

Serial No. 75/065,953

unregistrable matter under Sections 2(e)(1) and 2(e)(2) of the Trademark Act, and the Examining Attorney correctly required a disclaimer thereof.

*Decision:* The requirement, under Section 6 of the Trademark Act, for a disclaimer of LASER INSTITUTE OF THE ROCKIES is affirmed.

In accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Examining Attorney to place in condition for publication for opposition if applicant, no more than thirty days from the mailing date of this decision, submits an appropriate disclaimer of LASER INSTITUTE OF THE ROCKIES.

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this evidence is not useful herein.