

TAB

BOX RESPONSES - NO FEE
Trademark Law Office: 105
Serial No.: 76/076117
Mark: VITAL COPPER

TRADEMARK TRIAL AND
APPEAL BOARD

02 NOV 13 AM 9:49

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: ProCyte Corporation Attorney Docket No. PRCO223444
Serial No.: 76/076117 Trademark Attorney: Barney Charlon
Filed: June 23, 2000 Law Office: 105
Mark: VITAL COPPER International Class: 5

REQUEST TO SUSPEND THE APPEAL AND REMAND THE FILE
TO THE TRADEMARK EXAMINER

Seattle, Washington 98101

October 29, 2002



TO THE COMMISSIONER FOR TRADEMARKS:

11-04-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #61

BACKGROUND

On November 9, 2001, the Trademark Examiner issued a final rejection of the above-identified trademark application based on a determination that the mark VITAL COPPER is merely descriptive under Section 2(e)(1). A copy of the final Office Action without the exhibits is attached to this Request as Exhibit A.

On May 8, 2002, Appellant filed its Amendment to Allege Use, a copy of which is attached as Exhibit B. On May 9, 2002, Appellant filed a Request to Amend the Application to the Supplemental Register and a Request for Reconsideration asking the Trademark Examiner to consider Appellant's Request to Amend the mark to the Supplemental Register, a copy of which is attached as Exhibit C. Attached to the Amendment and Request for Reconsideration was a copy of Appellant's Amendment to Allege Use. Also on May 9, 2002, Appellant filed a Notice of Appeal to the Trademark Trial and Appeal Board in order to preserve its appeal rights. A copy of the Notice of Appeal is attached as Exhibit D.

On June 3, 2002, the Trademark Trial and Appeal Board suspended the appeal and remanded the file to the Trademark Examining Attorney for examination of the Amendment to Allege Use. A

1
2 copy of the Notice of Suspension is attached as Exhibit E. On July 10, 2002, the Trademark Trial and
3 Appeal Board once again remanded the file to the Trademark Examiner for consideration of the
4 Amendment to Allege Use since the file had been returned to the Trademark Trial and Appeal Board
5 without any action being taken by the Trademark Examiner. A copy of the subsequent remand notice is
6 attached as Exhibit F. On August 8, 2002, the Trademark Examiner accepted Appellant's Amendment
7 to Allege Use. A copy of the Trademark Examiner's acceptance is attached as Exhibit G. On
8 August 30, 2002, the Trademark Trial and Appeal Board notified Appellant that the appeal was
9 resumed. A copy of the resumption of appeal notice is attached as Exhibit H.

10 REQUEST TO SUSPEND AND REMAND

11 Appellant respectfully requests that the appeal that was resumed on August 30, 2002 be
12 suspended and that the file be remanded to the Trademark Examiner to consider Appellant's Request to
13 Amend the above-identified trademark application to the Supplemental Register. As shown in Exhibit
14 C, this Request to Amend was originally filed on May 9, 2002 but never considered by the Trademark
15 Examiner.

16 If the application is amended to the Supplemental Register, the need for the appeal will be moot.
17 Therefore, Appellant once again requests that the appeal be suspended pending the Trademark
18 Examiner's review of Appellant's previously filed Request to Amend the application to the
19 Supplemental Register.

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CLOSING

Should there be any questions regarding the foregoing, please contact the undersigned attorney directly.

Respectfully submitted,

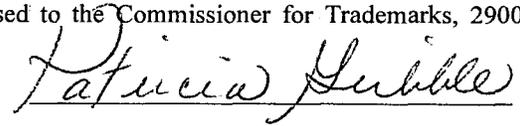
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Faye L. Tomlinson
Direct Dial No. 206.695.1717

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

Date: October 29, 2002



FLT:pag

EX A
TO/BEL

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

SERIAL NO. 76/076117 ProCyte Corporation	APPLICANT 	PAPER RECEIVED DOCKETING CAM NOV 16 2001 CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small>
MARK VITAL COPPER		REF. NO. PRC0223444
ADDRESS DENNIS K. SHELTON CHRISTENSEN O'CONNOR JOHNSON & KINDNESS 1420 FIFTH AVENUE, SUITE 2800 SEATTLE, WA 98101		
ACTION NO. 02	MAILING DATE 11/09/01	
FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: 1. Filing Date, serial number, mark and applicant's name. 2. Filing date of this Office action. 3. Examining Attorney's name and Office number. 4. Telephone number and ZIP code.

TRADEMARK LAW OFFICE 105
 Serial Number: 76/076117
 Mark: VITAL COPPER

Please Place on Upper Right Corner
 **of Response to Office Action ONLY **

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.
For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

DOCKETED

RE: Serial Number: 76/076117

This letter responds to the applicant's communication filed on May 21, 2001.

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified goods.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL.

Merely Descriptive - Section 2(e)(1)

Registration of applicant's mark VITAL COPPER was refused on the ground that it is merely descriptive of applicant's "medicated skin care preparations, namely, moisturizers, creams, lotions, solutions, sprays, ointments and gels." In its response, applicant argues that the mark is only suggestive of the goods at issue and that the refusal to register should therefore be withdrawn.

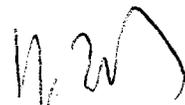
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In particular, applicant argues that the mark is not merely descriptive because it "does not immediately describe Applicant's goods." In addition, applicant asserts that none of the definitions of the word COPPER relied on by the examining attorney "include any reference to the fact that copper is an essential mineral for the human body" and "the variety of definitions for the term 'vital' indicates that the term 'vital' as used in the mark VITAL COPPER could suggest any number of things such as enhancing the appearance or health of something."

The examining attorney, however, must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). In addition, the examining attorney must consider descriptiveness in relation to the relevant goods or services. The fact that a term may have different meanings in another context is not controlling on the question of descriptiveness. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). In the present case, the term VITAL COPPER, when considered in connection with the goods at issue, would be perceived by consumers as nothing more than a description of medicated skin care products that contain the vital mineral copper. Indeed, applicant itself in its website, excerpts of which are enclosed, indicates that its product "Nourishes the skin with *vital copper*" and uses its "patented *copper* peptide technology, providing *vital copper* micronutrition to the skin." (Emphasis added.) See also the enclosed additional representative sample of printouts from the Internet discussing the vital role copper plays in bodily nutrition. Accordingly, as both the plain meaning of the term VITAL COPPER as well as the fact that applicant and other industry concerns use the term VITAL COPPER to describe a characteristic and feature of the goods at issue, applicant's mark must be deemed to be merely descriptive.

Based on the arguments and evidence set forth herein and in the previous Office action, the refusal to register is made FINAL.

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. Section 2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).



Barney Charlon
Examining Attorney
Law Office 105
703-305-9105 EXT 130

EX.B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ProCyte Corporation

Attorney Docket No. PROCO22344

Serial No.: 76/076,117

Trademark Attorney: Barney Charlton

Filed: June 23, 2000

Law Office: 105

Mark: VITAL COPPER

AMENDMENT TO ALLEGE USE UNDER 37 C.F.R. § 2.76.
WITH DECLARATION - ALL GOODS

TO THE COMMISSIONER FOR TRADEMARKS:

Applicant requests registration of the above-identified mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051, et seq., as amended). Applicant is using the mark in commerce on or in connection with all of the goods identified in the application and reproduced below:

medicated skin care preparations, namely moisturizers, creams, lotions, solutions, sprays, ointments and gels.

A facsimile showing the mark as used in commerce is submitted with this amendment.

Date of first use of the mark anywhere: at least as early as October 24, 2000.

Date of first use of the mark in commerce which the U.S. Congress may regulate: at least as early as December 18, 2000.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this application or any resulting registration, declares that she is properly authorized to execute this Amendment to Allege Use on behalf of the applicant; she believes the applicant to be the owner of the mark sought to be registered; the mark is now in use in

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commerce; and all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true.

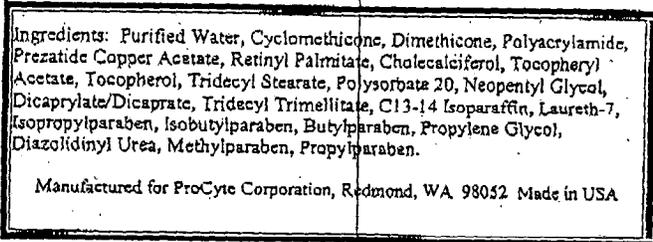
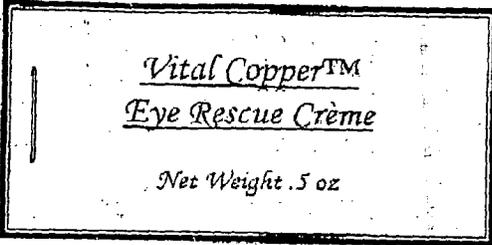
PROCYTE CORPORATION

Date: 5/8/02

(Signature) Robin Carmichael
Robin Carmichael
Title: Vice President of Marketing

1 Applicant: ProCyte Corporation
2 Application Serial No. 76/076,117
3 Filed: June 23, 2000
4 Mark: VITAL COPPER
5 Attorney Docket No. PRCO223444

6 Facsimile showing mark as currently used - submitted with Amendment to Allege Use:



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BOX RESPONSES - NO FEE
Trademark Law Office: 105
Serial No.: 76/076,117
Mark: VITAL COPPER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	ProCyte Corporation	Attorney Docket No. PRCO223444
Serial No.:	76/076,117	Trademark Attorney: Barney Charlton
Filed:	June 23, 2000	Law Office: 105
Mark:	VITAL COPPER	International Class: 5

AMENDMENT AND REQUEST FOR RECONSIDERATION

Seattle, Washington 98101
May 9, 2002

TO THE COMMISSIONER FOR TRADEMARKS:

AMENDMENT

On November 9, 2001, the Trademark Examiner issued a final Office Action in conjunction with prosecution of the above-identified trademark application. In the Office Action, the Trademark Examiner made final his refusal that the mark VITAL COPPER is merely descriptive as applied to the goods. Based on the Trademark Examiner's determination that the mark is descriptive, applicant respectfully requests that the original application be amended to seek registration on the Supplemental Register. Enclosed with this Amendment and Request for Reconsideration, please find a copy of applicant's Amendment to Allege Use filed May 8, 2002 evidencing that use of the mark has begun.

REQUEST FOR RECONSIDERATION

Based on the foregoing Amendment, applicant respectfully requests that the Trademark Examiner act on applicant's request to amend the application to seek registration on the Supplemental Register.

In order to preserve its rights on appeal, applicant has also filed a Notice of Appeal. A copy of the Notice of Appeal is attached. Applicant requests, however, that the appeal be suspended pending resolution of applicant's Request for Reconsideration.

Should there be any questions regarding applicant's proposed Amendment, the Trademark

1 Examiner or the Trademark Trial and Appeal Board is asked to contact the undersigned attorney
2 directly.

3
4 Respectfully submitted,

5 CHRISTENSEN O'CONNOR
6 JOHNSON KINDNESS^{PLLC}

7 *Faye L. Tomlinson*

8 Faye L. Tomlinson

9 Direct Dial No. 206.695.1717

10
11 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first
12 class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, 2900 Crystal Drive,
13 Arlington, VA 22202-3513, on the below date.

14 Date:

May 9, 2002

Patricia Dibble

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EX.D

BOX TTAB
FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Applicant: ProCyte Corporation

Attorney Docket No. PRCO223444

Serial No.: 76/076,117

Trademark Attorney: Barney Charlon

Filed: June 23, 2000

Law Office: 105

Mark: VITAL COPPER

NOTICE OF APPEAL TO THE
TRADEMARK TRIAL AND APPEAL BOARD

Seattle, Washington 98101

May 9, 2002

TO THE COMMISSIONER FOR TRADEMARKS:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner refusing registration. The required fee of \$100.00 (\$100.00 per class) is submitted herewith by our check No. 138457. Please charge any additional fees or credit any overpayment to Deposit Account No. 03-1740. A copy of this notice is enclosed.

Respectfully submitted,

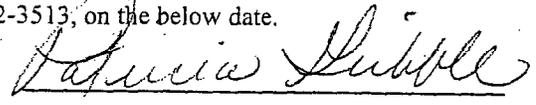
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Faye L. Tomlinson
Direct Dial No. 206.695.1717

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

Date: May 9, 2002



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To: BCL

EXE

PRCO-2-23444

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Johnson

RECEIVED DOCKETING
JUN 11 2002
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

Mailed: June 3, 2002
In re ProCyte Corporation
Serial No. 76076117
Filed: 06/23/2000

DENNIS K. SHELTON
CHRISTENSEN O'CONNOR JOHNSON & KINDNESS
1420 FIFTH AVENUE, SUITE 2300
SEATTLE, WA 98101

LaToya C. Johnson, Paralegal:

Applicant's notice of appeal and amendment to allege use (filed May 13, 2002, with certificates of mailing dated May 9, 2002 and May 8, 2002, respectively) are noted.

Accordingly, the appeal is instituted but action on it is suspended and the file is herewith remanded to the Trademark Examining Attorney for examination of the amendment to allege use. After the Examining Attorney's issuance of either an acceptance and/or ultimate denial¹ of

¹ In this connection, the amendment to allege use should be treated as a new issue, such that any refusal to allow registration cannot be made final until applicant has been given an opportunity to respond.

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Serial No. 76/0. ,117

the amendment, the file should be returned to the Board, the appeal will be resumed and the Board will take appropriate action.

A request for an oral hearing, if desired, is due not later than ten days after the due date for applicant's reply brief.

RECEIVED DOCKETING

SEH JUL 15 2002
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

BLS

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Johnson

PRCO-2-23444
Mailed: July 10, 2002

In re PROCYTE CORPORATION
Serial No. 76076117
Filed: 06/23/2000

DENNIS K. SHELTON
CHRISTENSEN O'CONNOR JOHNSON & KINDNESS
1420 FIFTH AVENUE, SUITE 2300
SEATTLE, WA 98101

LaToya C. Johnson, Paralegal:

In an order dated June 3, 2002, the Board indicated that the file of the above-identified application was being remanded to the Trademark Examining Attorney. The file, however, was sent back to the Board with no Office Action regarding the consideration of the amendment to allege use.

In view thereof, the file is herewith remanded to the Trademark Examining Attorney to issue a written Office Action regarding the amendment to allege use and then return the file to the Board for resumption of the appeal.

scl

EX 6

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/076117

APPLICANT: ProCyte Corporation

CORRESPONDENT ADDRESS:

DENNIS K. SHELTON
CHRISTENSEN O'CONNOR JOHNSON & KINDNESS
1420 FIFTH AVENUE, SUITE 2300
SEATTLE, WA 98101

MARK: VITAL COPPER

CORRESPONDENT'S REFERENCE/DOCKET NO: PRCO223444

CORRESPONDENT EMAIL ADDRESS:

N/A

RE: Serial Number 76/076117

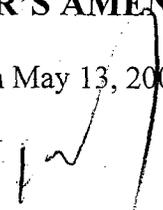
RECEIVED DOCKETING

AUG 13 2002

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

EXAMINER'S AMENDMENT

Applicant's amendment to allege use filed on May 13, 2002, is accepted.


Barney L. Charlon
Examining Attorney, Law Office 105
(703) 308-9105 x130, (703) 872-9825 fax
barney.charlon@uspto.gov(for informal responses)

AUG - 8 2002

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom105@uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and email address.

EX A

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Johnson

PRCO-2-23444

Mailed: August 30, 2002

RECEIVED DOCKETING



SEP 03 2002

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

In re PROCYTE CORPORATION

Serial No. 76076117

Filed: 06/23/2000

DENNIS K. SHELTON
CHRISTENSEN O'CONNOR JOHNSON & KINDNESS
1420 FIFTH AVENUE, SUITE 2300
SEATTLE, WA 98101

LaToya C. Johnson, Paralegal:

In view of the decision by the Trademark Examining Attorney on August 8, 2002, the appeal is resumed; and applicant is allowed until sixty days from the date hereof in which to file its brief herein. A request for an oral hearing, if desired, must be made not later than ten days after the due date for applicant's reply brief.