

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Levlad, Inc. : BEFORE THE
Trademark: ORGANIC SPA COLLECTION : TRADEMARK TRIAL
Serial No: 76-185349 : AND
Attorney: Robert Berliner : APPEAL BOARD
Address: Fulbright & Jaworski LLP : ON APPEAL
Los Angeles, California

SPA

EXAMINING ATTORNEY'S APPEAL BRIEF

SEP 8 2003

Statement of the Case

On December 23, 2000, applicant, Levlad, Inc., filed to register the trademark, ORGANIC SPA COLLECTION, for:

Hair shampoo, hair conditioners, hair rinses, suntan lotion; after-bath splash-on; face wash; facial masks; hand and body lotion; moisturizing lotion; skin cream; toothpaste; personal deodorants; non-medicated scalp treatment cream; non-medicated ointment for the treatment of burns, rashes, and minor skin disorders in International class 3; and

Medicated preparations for scalp care and the treatment of dandruff, dandruff shampoo; medicated ointment for the treatment of burns, rashes, and minor skin disorders in International class 5.

On June 28, 2001, registration was refused on the Principal Register under Section 2 (e) (1) of the Trademark Act, as amended, because the proposed mark merely described characteristics or qualities of the identified goods. On December 12, 2001, applicant argued against the statutory refusal but the trademark examining attorney was not persuaded. On March 6, 2002, the statutory refusal under Section 2 (e) (1) was made

final. On September 3, 2002, applicant filed a response to the final refusal with a disclaimer of the term, ORGANIC, apart from the mark as shown. On September 6, 2002, applicant filed a notice of appeal to the Trademark Trial and Appeal Board. On October 31, 2002, the Trademark Trial and Appeal Board suspended the appeal in order to remand the case to the trademark examining attorney for consideration of the disclaimer. On November 5, 2002, the trademark examining attorney, in viewing the response of applicant as a request for reconsideration after final refusal, denied the request and maintained the statutory refusal under Section 2 (e) (1). The appeal was resumed and applicant filed its Brief on Appeal on July 14, 2003. This statement is a response to that appeal.

Issue

Whether the trademark, ORGANIC SPA COLLECTION, for cosmetics and medicated preparations is merely descriptive of characteristics and qualities of the goods within the prohibition of Section 2 (e) (1) of the Trademark Act?

Argument

Section 2 (e) (1) of the Trademark Act prohibits registration of merely descriptive trademarks as applied to the identified goods in the application for registration. TMEP

section 1209 *et seq.* In the first office action of June 28, 2001, the trademark examining attorney provided evidence of the merely descriptive nature of the mark by introducing dictionary definitions of the individual terms, “organic,” “spa,” and “collection.” The relevant definitions are “organic” means “derived from living organisms, organic matter,” “spa” means “a health resort,” and “collection” means “a group of objects.” ORGANIC SPA COLLECTION is, therefore, defined as “a group of objects containing matter from living organisms as used in a health spa.” When applied to the identified goods of the application, cosmetics and medicated preparations, the characteristics and the qualities of the cosmetics and medicated preparations are merely described by the mark in that they are comprised of organic matter from living organisms as used in a spa and they are objects grouped together as cosmetics and medicated preparations. Other meanings in a different context, unrelated to the goods, are not controlling on the descriptiveness of the mark. See: *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Also in the first office action, the trademark examining attorney included Nexis-Lexis evidence that shows “Organic Spa Products” used with cosmetics to indicate “only plant derived oils” are used. The Nexis-Lexis evidence shows “natural, organic spa and skincare products” are available over the internet from Hawaii. Elizabeth Arden’s skin lotion is referred to as part of the Spa Collection in the Nexis database materials. The department store, Tiffany’s, features a new “spa collection” for shampoos – the same goods as this applicant. Princess Cruise Lines now offers for sale a “Grand Spa Collection” which includes shampoo, conditioner, bath and shower gels, moisturizer, body silk, bath and body oils, and soaps for landlocked customers. Cosmetic

manufacturers, like State of Mind, offer a myriad of shampoos, conditioners, exfoliators, tub teas, and body muds, under a "spa collection." Even the exclusive Madison Square Club gym in New York has launched a line of natural bath and body products called the "Madison Square Spa Collection." All this evidence was offered to applicant in support of the Section 2 (e) (1) refusal to register in the first office action.

In the March 6, 2002, final refusal to register, the trademark examining attorney bolstered his statutory refusal under Section 2 (e) (1) with Nexis-Lexis evidence that "organic" is used widely by cosmetic manufacturers, including Mary Kay Cosmetics, to merely describe the healthiness of its lotions and shampoos. The registrations from the cosmetic class, attached to the final refusal, bolster the merely descriptive and disclaimable nature of "collection," apart from the mark as shown. And "spa collection" is spreading rapidly in use to mean a certain *quality* of cosmetics and medicated preparations, as shown by the evidence of record. After the final refusal, applicant offered to disclaim the wording, ORGANIC, and it was accepted because it is arguably generic for the identified goods of applicant, based upon the evidence of record. Nothing new was argued by applicant in the request for reconsideration. The entire mark remains merely descriptive and unregistrable under Section 2 (e) (1) upon the Principal Register.

It appears, as components of this proposed mark are used in actual commerce, ORGANIC SPA COLLECTION, has no separate, non-descriptive meaning. The fact that this applicant may be the first and only user of ORGANIC SPA COLLECTION, as a

designation, does not justify registration of the mark, if it is merely descriptive. See: *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

Applicant argues that the examining attorney is required to prove the entire mark is merely descriptive and that the elements of the mark, even if descriptive, cannot be held against applicant. This is not true. A combination of descriptive terms is only *not* merely descriptive if it results in a separable meaning from the descriptive meanings. Consumers know what "organic" means as applied to cosmetics or medicated preparations and consumers read about "spa collections" for cosmetics and medicated preparations. The sum of the whole combination is no less merely descriptive as the descriptive parts. Contrary to applicant's argument in its brief, the trademark examining attorney has definitely provided a prima facie showing of mere descriptiveness for the mark, running from the first office action in June of 2001 to the reconsideration of the final refusal to register in November of 2002. This prima facie case was un rebutted until applicant filed its brief before the Trademark Trial and Appeal Board. The brief is accompanied by two "exhibits" which should not be considered because the exhibits are untimely filed and new, not having been made of record before the appeal, for consideration by the examiner. Even if, arguendo, the exhibits are considered on appeal, they help the trademark examining attorney and not applicant. Exhibit A is a copy of the application as filed with filing receipt. Exhibit B consists of twenty-eight different marks from the office's TESS (Trademark Electronic Search System) database. The first fourteen documents in Exhibit B show the term, ORGANIC, disclaimed separately or as part of

other merely descriptive terms. The fifteenth document shows no disclaimer of ORGANIC but it shows the mark, ORGANIC AID, as a Section 2 (f) registration, dated April 10, 1979. So far, Exhibit B, in fifteen documents, has proved the term, ORGANIC, is not suggestive, as argued in applicant's brief, but merely descriptive, since at least as early as 1979. Documents 16 through 26, in Exhibit B, contain disclaimers of ORGANIC as merely descriptive. Document 27, the registration of PENN-ORGANIC in 1993, shows a hyphenated mark, not requiring a disclaimer. The last document, number 28 of Exhibit B, shows a disclaimer of ORGANIC in the mark, ORGANIC HEALTH, for cosmetic hair shampoos, toilet soap, skin creams, lotions, and oils in International class 3. Nothing in the untimely filed exhibit is helpful to applicant in overcoming the merely descriptive nature of "organic" in the mark, ORGANIC SPA COLLECTION. A mark is merely descriptive under Trademark Act Section 2 (e) (1) if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the *relevant* goods. See: *In re Gyulay*, 3 USPQ2d 1009 (Fed. Cir. 1987). On page 5 of applicant's Brief on Appeal, the Board will note that eleven trademarks are cited by applicant for the proposition that applicant's mark should be registered like these eleven. This argument must necessarily fail because none of the marks contain any of applicant's wording, "organic," "spa," or "collection," and none of the goods and services are *relevant, that is, comparable to cosmetics and medicated preparations*. Applicant continues to argue that the mark is suggestive and requires multiple steps of reasoning to arrive at a merely descriptive conclusion. This is not so. Simply stated, the refusal to register is valid because "organic" merely describes the wholesomeness of the ingredients of the cosmetics and medicated

preparations; and "spa collection" is used by multiple third parties, including applicant, to describe a quality level of the identified goods. Based upon a review of the Nexis-Lexis evidence of record in this application, the trademark examining attorney has reason to believe that multiple third parties are in need of the wording, "organic" and "spa collection," to describe their competing products. Applicant's mark is ORGANIC SPA COLLECTION for shampoo, conditioner, suntan lotion, body lotion, skin cream, toothpaste, deodorant, dandruff shampoo, and medicated ointment for the treatment of burns, rashes, and minor skin disorders. The terms, "organic" and "spa collection" are highly descriptive of a spa collection featuring organic goods, namely, shampoo, conditioner, suntan lotion, body lotion, skin cream, toothpaste, deodorant, dandruff shampoo, and medicated ointment for the treatment of burns, rashes, and minor skin disorders. In this case, there is no incongruity, no double meaning to the mark, and no imagination is needed to determine the exact qualities of the goods. The trademark examining attorney has considered the mark in relation to the identified goods, not in the abstract. Further, at each point in time when an office action was written, copious evidence from the Nexis-Lexis automated database was provided to bolster and support each refusal to register. The Trademark Trial and Appeal Board has held that materials obtained from computerized text searching are competent evidence to show the descriptive, and merely descriptive, use of the terms under the Trademark Act, Section 2 (e) (1). See: *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

CONCLUSION

The trademark examining attorney respectfully requests that the statutory refusal be affirmed.

Respectfully submitted,

A handwritten signature in cursive script that reads "Richard A. Straser". The signature is written in black ink and is positioned above the printed name of the examining attorney.

Richard A. Straser, Examining Attorney

Margaret Le, Managing Attorney