UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/506584

APPLICANT: WELLA AKTIENGESELLSCHAFT

CORRESPONDENT ADDRESS:
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[redacted]

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: 1/28/05

MARK: COLOR COMPLETE

CORRESPONDENT'S REFERENCE/DOCKET NO: LA-7130-126

CORRESPONDENT EMAIL ADDRESS:

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 e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 76/506584

The Trademark Trial and Appeal Board has remanded this application to the examining attorney to consider applicant's remarks filed November 23, 2004. The final refusal to register dated August 24, 2004 is suspended in order to consider applicant's remarks.

It is Applicant's position that its mark is not descriptive because it does not immediately describe the goods. Applicant's argues that when "applied to shampoos, conditioners and other hair care products, the [proposed mark] can be understood as referring to a person's hair, not the goods, conveying the idea that the hair needs nothing more." A mark is merely descriptive under Trademark Act Section 2 (e)(1), 15 U.S.C. § 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. See: *In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Bed & Breakfast Registry,* 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986). The goods in this application are " hair care preparations, namely, shampoos and hair conditioners, hair colors and dyes, color removal and lightening preparations and hair bleaches; hair styling and finishing products, namely, hair sprays, spray gels, mousses, creams, lotions, pomades and waxes; and hair and scalp treatments, namely, restructurizers and scalp conditioners" in International Class 3.

It is not necessary that the proposed mark describe all of the purposes, functions, characteristics or feature of the goods to be merely descriptive. For the purpose of Section 2(e)(1) analysis, it is sufficient that the mark describes only one attribute of the goods to be found merely descriptive. When

COLOR COMPLETE is used in connection with applicant's goods, it tells consumers that applicant's hair care items will entirely impart a hue to one's hair.

Applicant asserts that the mark is not descriptive, but has meaning unrelated to the goods. The fact that a mark may have meanings other than the one involved in a particular application is not controlling, because descriptiveness must be determined in relation to the goods for which registration is sought. See: *In re Bright-Crest, Ltd.,* 204 USPQ 591, 593 (TTAB 1979). Moreover, the descriptiveness of a mark may be determined by virtue of the inherent meaning of the terms in ordinary language. See: *In re Cenus Communications Co.*, 23 USPQ2d 1717 (TTAB 1992). Here, the meaning of the mark as a composite designation immediately and unambiguously conveys the fact that the when used the goods will impart total color to a person hair.

Applicant also argues that the mark is not descriptive because it suggests a possible or desired result of using the goods. However, marks have been held merely descriptive if it describes a function of the goods or services. For instance, in *Educational Development Corporation v. The Economy Company,* 195 USPQ 482 (Court of Appeals, 10th Cir.), the Court held Continuous Progress merely descriptive when used in connection with educational materials. The Court said at page 485:

> By adopting CONTINUOUS PROGRESS as its mark, EDC directly conveyed to educators the most important characteristic of its product. The fact that the mark by itself does not indicate the format, laboratory nature, or other features of the product is irrelevant. A mark to be merely descriptive need not directly convey all of a product's characteristics use or function but need only imparts directly a crucial, important aspect of the product. The mark in question is a term which, to those in the educational field, indicates the use and function of the product. Accordingly, it is merely descriptive.

Also, in the case of *In re Allen Hollander Co., Inc.,* 170 USPQ 422 (TTAB 1971) the Trademark Trial and Appeal Board held EASY –PEEL merely descriptive when applied to labels and tags, including labels and tag bearing adhesive because it describes a desired characteristic of the goods. In do so, the Board stated at page 422:

> Considering applicant's contentions, it is not necessary that the mark tell what the goods are since a mark is merely descriptive if it immediately describes a desirable characteristic of the goods and this consideration must be viewed in relationship to the goods on which applicant uses it mark. See: In re Anchor Hocking Glass Corporation, supra; and In re Guido, 153 USPQ 689 (TT&A Bd., 1967), and cases cited therein. When we view applicant's mark in this light, it immediately relates to purchasers that applicant's labels are easy to peel either off the backing therefore or off the object to which they have been applied, or both. In this regard, it is common practice for persons to substitute a hyphen for the word "to" in describing the desired characteristics of their products.

The proposed mark when used in connection with applicant's goods describes a desired feature or characteristic of the goods and as such is merely descriptive under Trademark Act Section 2(e)(1). See: *In re G.E. Smith, Inc.*, 138 USPQ 518 (TTAB 1963).

The refusal to register under Trademark Act Section 2(e)(1) because the proposed mark is merely descriptive of the identified goods is again made FINAL.

This application will be returned to the Trademark Trial and Appeal Board so the appeal can be resumed.

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

(1) $325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or

(2) $375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be $325 per class, and if such payments are made with a paper response, the fee will be $375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at http://www.uspto.gov/teas/index.html.

/Amos T. Matthews/
Examining Attorney
Law Office 108
(571) 272-9346

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) **CANNOT** currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Baez, Vionette

From: Matthews, Amos
Sent: Monday, January 31, 2005 9:17 AM
To: Baez, Vionette
Subject: 76/506584

Hi Vionette,

I have maintained the final refusal in serial number 76/506584.

Amos T. Matthews
Trademark Examining Attorney
U.S Patent and Trademark Office
Law Office 108
(571)272-9346