

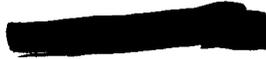
Atty Docket No.: 7130-126

Reference No.: 10303992
Applicant: Wella Aktiengesellschaft

Serial No.: 76/506,584
Mark: COLOR COMPLETE

Filing Date: April 16, 2003

Documents Filed:
APPEAL BRIEF



03-29-2005

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #66

The U.S. Patent and Trademark stamp affixed to this postcard hereby acknowledges receipt of the enclosed documents

Via: Express Mail Mailing Label No **EV613594074US**
Sender's Initials: MJC:MY:jb
Date: March 29 2005



[Home](#)

Track & Confirm

Current Status

You entered EV61 3594 074U S

Your item was delivered at 10:47 am on March 31, 2005 in ALEXANDRIA, VA 22314 to TRADEMARK 1451. The item was signed for by D BARFIELD.

[Shipment Details >](#)

Track & Confirm

Enter label number

[Go >](#)

[Track & Confirm FAQs](#) [Go >](#)

Notification Options

[▶ Track & Confirm by email](#) [What is this?](#) [Go >](#)

[▶ Request Proof of Delivery](#) [What is this?](#) [Go >](#)



POSTAL INSPECTORS
Preserving the Trust

[site map](#) [contact us](#) [government services](#)
Copyright © 1999-2002 USPS. All Rights Reserved. [Terms of Use](#) [Privacy Policy](#)



TRADEMARK

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

Applicant: Wella Aktiengesellschaft

Examiner: Amos T. Matthews

Serial No.: 76/ 506,584

Law Office: 108

Filed: April 16, 2003

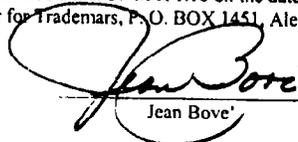
For: COLOR COMPLETE

APPLICANT'S APPEAL BRIEF

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below in an envelope addressed to: Commissioner for Trademarks, P. O. BOX 1451, Alexandria, VA. 22313.

Date: March 29, 2005


Jean Bove

To Docketing 4/1/05

INDEX OF CITED CASES

In re Abcor Development Corp., 588 F. 2d 811, 200 U.S.P.Q. 215 (C.C.P.A. 1978)..... 8

In re Aid Laboratories, Incorporated, 221 U.S.P.Q. 1215 (T.T.A.B. 1983)..... 6

In re Bel Paese Sales Co., 1 U.S.P.Q. 2d 1233 (T.T.A.B. 1986)..... 12

In re C.J. Webb, Inc., 182 U.S.P.Q. 63 (T.T.A.B. 1974)..... 5

In re Colonial Stores Incorporated, 55 C.C.P.A. 1049, 394 F. 2d 549, 157 U.S.P.Q. 382
(C.C.P.A. 1968)..... 11

In re Conductive Systems, Inc., 220 U.S.P.Q. 84 (T.T.A.B. 1983)..... 12

In re Delaware Punch Company, 186 U.S.P.Q. 63 (T.T.A.B. 1975)..... 11

The Fleetwood Company v. The Mitchum Company, 323 F. 2d 1015, 51 C.C.P.A. 831,
139 U.S.P.Q. 281 (C.C.P.A. 1963)..... 5

In re Frank J. Curran Co., 189 U.S.P.Q. 560 (T.T.A.B. 1975)..... 6

In re Pennwalt Corp., 173 U.S.P.Q. 317 (T.T.A.B. 1972)..... 12

In re Shutts, 217 U.S.P.Q. 363 (T.T.A.B. 1983)..... 9

In re Tennis in the Round Inc., 199 U.S.P.Q. 496 (T.T.A.B. 1978)..... 8

In re The Realistic Company, 440 F. 2d 1393, 58 C.C.P.A. 1204, 169 U.S.P.Q. 610
(C.C.P.A. 1971)..... 5

In re TMS Corporation of America, 200 U.S.P.Q. 57 (T.T.A.B. 1978)..... 12

In re Universal Water Systems, Inc., 209 U.S.P.Q. 165 (T.T.A.B. 1980)..... 6

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

Applicant: Wella Aktiengesellschaft) Examiner: Amos T. Matthews
Serial No.: 76/ 506,584) Law Office: 108
Filed: April 16, 2003)
For: COLOR COMPLETE)
Docket No.: 7130-126XX/10303992)
=====)

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

I. INTRODUCTION

Pursuant to a Notice of Appeal filed November 23, 2004, Applicant has appealed the Trademark Examining Attorney's refusal to register Applicant's mark COLOR COMPLETE for shampoos, conditioners, hair colors and dyes, hair bleaches, and various other hair care preparations. This Appeal Brief is timely filed pursuant to the February 1, 2005 Notice from the Trademark Trial and Appeal Board resuming the Appeal following remand to the Trademark Examining Attorney.

II. RELEVANT FACTS

Applicant is applying for registration of the mark COLOR COMPLETE for 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, gels, mousses, creams, lotions, pomades and waxes; and hair and scalp treatments, namely, restructurizers and scalp conditioners.

Registration has been finally refused under Section 2(e) of the Trademark Act on the basis that the words comprising the mark are merely descriptive when applied to the goods.

Applicant submits that its mark COLOR COMPLETE is not descriptive. At most, Applicant contends that its mark is suggestive of Applicant's goods. Further, Applicant contends that its mark does not immediately convey an idea about the goods. In addition, Applicant contends that its mark has more than one meaning in connection with the goods. All of this indicates that Applicant's mark COLOR COMPLETE is not descriptive under the Trademark Act.

III. APPLICANT'S ARGUMENT

A. Summary of Applicant's Argument

For three independent reasons, Applicant submits that the mark COLOR COMPLETE is not descriptive. First, at most, Applicant's mark merely suggests a desired result of using the goods. Second, unlike a descriptive term, Applicant's mark requires imagination and mental pause to convey any idea about the goods. Third, Applicant's mark has more than one meaning in relation to the goods, in contrast to a descriptive term. For at least these reasons, COLOR COMPLETE is not merely descriptive within the meaning of the Trademark Act. Accordingly, Applicant's mark is entitled to registration on the Principal Register.

**B. At Most, Applicant's Mark Suggests a Possible or Desired
Result of Using the Goods and Is Therefore Not Descriptive**

It is well established that a mark is not descriptive if it suggests a possible or desired result of using the goods. *The Fleetwood Company v. The Mitchum Company*, 323 F. 2d 1015, 51 C.C.P.A. 831, 139 U.S.P.Q. 281 (C.C.P.A. 1963). The case of *The Fleetwood Company* is illustrative. A party opposed registration of the mark FAYD for skin creams. The Trademark Trial and Appeal Board decided in favor of the opposer, finding that the term "FAYD" was the phonetic equivalent of the word "fade", and that "fade" was descriptive of the fading action of a bleaching skin cream. In overturning the Board, the Court found that "fade" did not describe the goods. Rather, "fade" suggested a desired result of using the skin cream. *Id.* at 1016. Thus, the mark was entitled to registration.

Similarly, in *In re The Realistic Company*, 440 F. 2d 1393, 58 C.C.P.A. 1204, 169 U.S.P.Q. 610 (C.C.P.A. 1971), the Court found that the mark CURV' for permanent wave curling solutions was entitled to registration. The Trademark Trial and Appeal Board had denied registration, finding that the mark merely described the goods' function of imparting curves to the hair. In reversing, the Court held that CURV' merely suggested a possible result of using permanent wave curling solutions. *Id.* at 1394.

The Trademark Trial and Appeal Board follows a similar rule. For example, in *In re C.J. Webb, Inc.*, 182 U.S.P.Q. 63 (T.T.A.B. 1974), the examiner denied registration of a mark after the applicant refused to disclaim the term BRAKLEEN. The goods were a cleaning and degreasing composition for automotive brake parts. The examiner contended that BRAKLEEN was the phonetic equivalent of "brake clean", and that "brake clean" described the purpose of the

goods or the result of their use – to clean brakes or to obtain clean brakes. In overturning the examiner, the Board decided that the term BRAKLEEN was a concise way of saying the phrase “this product will get your brake clean.” Because the mark was just the term BRAKLEEN and not the entire phrase, the mark only suggested a desired result of using the brake cleaner and was therefore not merely descriptive.

Similarly, in *In re Frank J. Curran Co.*, 189 U.S.P.Q. 560 (T.T.A.B. 1975), the examiner denied registration of the mark CLOTHES FRESH for a clothes and shoe spray deodorant. The examiner contended that the mark described the purpose and function of the goods – to freshen clothes. The Board decided that the mark merely suggested a possible and desirable end result of using the spray deodorant. *Id.* at 560. Accordingly, the mark was not merely descriptive. Also, in *In re Aid Laboratories, Incorporated*, 221 U.S.P.Q. 1215 (T.T.A.B. 1983), the Board found that the mark PEST PRUF for animal shampoo with insecticide and deodorizing properties was entitled to registration. Although the examiner contended that the mark was descriptive of a characteristic or intended use of the goods, the Board decided that the mark merely suggested a possible end result of using the goods. *Id.* at 1216. Thus, the mark was not descriptive. Further, in *In re Universal Water Systems, Inc.*, 209 U.S.P.Q. 165 (T.T.A.B. 1980), the Board held that the mark PURITY for water filtering units and water cartridges was entitled to registration. The Board disagreed with the examiner's position that the mark merely described a feature, use, function or characteristic of the goods. Rather, the mark suggested a desired result of using the goods and was therefore not merely descriptive. *Id.* at 166.

In the present case, the Examining Attorney contends that Applicant's mark COLOR COMPLETE is descriptive of Applicant's goods. The Examining Attorney contends that Applicant's mark tells consumers that Applicant's goods “totally imparts a hue to one's hair”

(Office Action dated September 24, 2003 at page 2, lines 15 -16), "will completely impart the natural color" to hair (Office Action dated June 3, 2004 at page 2, lines 28-29), "will entirely produce vibrant color to the hair" (Office Action dated August 25, 2004 at page 2, line 20), or "will impart total color to a person['s] hair" (Office Action dated January 31, 2005 at page 2, line 13). Even assuming for the purposes of argument that Applicant's mark can be understood in any of these ways, Applicant's mark is not descriptive. As in the cases cited above, the goal of imparting total color or hue to the hair is simply a possible or desired result of using Applicant's hair care preparations, not a description of any characteristic of the goods. How well a user's hair is treated depends on many variables outside of Applicant's control, such as whether a user follows a product's directions and how much of the hair a user wishes to treat. Thus, the goal of imparting total color to the hair is just one of various outcomes. By suggesting a possible result of using the goods, Applicant's mark is not descriptive.

Moreover, even assuming that COLOR COMPLETE can be understood as telling consumers that Applicant's goods will impart total color, Applicant's mark only hints at this possible or desired result of using the goods. As with the mark BRAKLEEN in *In re C.J. Webb, Inc.*, the wording in Applicant's mark does not directly indicate that Applicant's goods will impart total color to the hair. Rather, Applicant's mark consists of only two words, "color" and "complete", that together must convey this idea. Because COLOR COMPLETE does not explicitly tell consumers that the goods will impart total color to the hair, Applicant's mark merely suggests or hints at such a result. Accordingly, at most, Applicant's mark is suggestive, not descriptive.

Furthermore, Applicant's mark COLOR COMPLETE is unusual in that the typical order of words in the term "complete color" is reversed. As such, Applicant's mark refers even less

explicitly to the desired result of imparting total color to the hair. The unusual word order adds to the suggestiveness of Applicant's mark.

In sum, Applicant's mark is not descriptive. Even assuming that the mark tells consumers that Applicant's goods will impart total color to the hair, Applicant's mark at most only suggests a possible or desired result of using Applicant's hair care products. Because the mark is not descriptive, Applicant's mark is entitled to registration on the Principal Register.

C. **Applicant's Mark Does Not Immediately Describe the Goods and Is Therefore Not Descriptive**

It is well settled that a mark is merely descriptive only if it immediately describes a feature or characteristic of the goods, and nothing more. *In re Abcor Development Corp.*, 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978). A mark that requires thought or imagination to convey an idea of the goods is therefore not descriptive. *Id.*

An instructive case is *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496 (T.T.A.B. 1978). The examiner refused registration of the mark TENNIS IN THE ROUND, for providing tennis facilities in the form of courts and tennis ball machines and offering tennis instruction, under Section 2(c) since the applicant's tennis facility included eleven tennis courts arranged in a circular configuration. The Board decided that the readily recognized meaning of the mark was "a tennis court in the middle of an auditorium with an audience seated on all sides of the court", by analogy to the well known phrase "theater in the round", whereas in reality, it was the applicant's eleven tennis courts that were arranged together in a circular shape. *Id.* at 498. Because imagination and mental pause were necessary for the mark to convey an idea of the

services, the mark did not immediately describe a feature of the services. *Id.* Therefore, the Board reversed the examiner.

Similarly, in *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983), the Board decided that the mark SNO-RAKE for a toothless snow removal tool was not descriptive since the literal meaning of the mark was a rake for snow, whereas the actual tool, in the absence of prongs or teeth, was not in fact a rake. *Id.* at 364. Because imagination and mental pause were necessary for the mark to convey an idea of the goods, the mark was not merely descriptive under Section 2(e). *Id.* at 365.

In the present case, Applicant's mark does not immediately convey a feature or characteristic of the goods. In particular, even when used as a mark on shampoos, conditioners and other hair care products, the term "color complete" can be understood as referring to a consumer's hair, conveying the idea that the hair needs nothing more. Because the term "color complete" refers to hair, a consumer seeing COLOR COMPLETE on hair care products would pause to consider whether the mark was a reference to hair or to the products. Thus, to convey any idea about the goods themselves, thought and imagination would be required to distinguish the goods from the consumer's hair. Accordingly, Applicant's mark COLOR COMPLETE is not descriptive.

The Examining Attorney points to an excerpt from Applicant's web site as evidence that Applicant's mark COLOR COMPLETE is descriptive. Office Action dated August 25, 2004 at page 2, lines 3 - 19.8 and Exhibits. However, the term "color complete" is not used in the excerpt to describe Applicant's hair care preparations. Rather, COLOR COMPLETE is used

only as a trademark. *Id.* at page 2, line 16. Thus, nothing in the excerpt supports a finding of descriptiveness.

Further, the excerpt discusses both hair care products and the results of using the products on the hair. As a consequence, any meaning ascribed to Applicant's mark COLOR COMPLETE would apply equally to hair as well as the goods. The excerpt actually supports Applicant's position that a person who sees COLOR COMPLETE on hair care products would require thought and imagination to determine whether the mark was a reference to hair or to the products. Thus, in contrast to the Office Action's assertion, Applicant's mark is not descriptive.

Moreover, Applicant's mark COLOR COMPLETE can be understood in at least two different ways in reference to hair. As shown in the definition of "complete" from the Merriam-Webster Online Dictionary (Response to Office Action dated November 23, 2004, Exhibit A), the word "complete" can mean "having all necessary parts" (Definition 1) or "fully carried out" (Definition 4). Accordingly, the term "color complete" can suggest that a consumer's hair has total color (has all necessary parts), or suggest that as far as color is concerned, a consumer's hair needs nothing more (fully carried out). Because Applicant's mark is ambiguous, a person seeing COLOR COMPLETE on Applicant's goods would pause to consider which suggestion was intended. This adds to the amount of thought and imagination necessary to understand Applicant's mark, further demonstrating its non-descriptive nature.

In sum, Applicant's mark COLOR COMPLETE does not immediately convey an idea of Applicant's goods. Further, nothing in the excerpt from Applicant's web site supports a finding of descriptiveness. For these reasons, Applicant's mark is not descriptive.

D. Applicant's Mark Suggests Something Other than the Goods and Is

Therefore Not Descriptive

It is well settled that a mark having more than one meaning as applied to the goods is considered a "double entendre". TMEP 1213.05(c). A mark that is a double entendre is entitled to registration as long as one of its meanings is not merely descriptive of the goods. *Id.* The case of *In re Colonial Stores Incorporated*, 394 F. 2d 549, 55 C.C.P.A. 1049, 157 U.S.P.Q. 382 (C.C.P.A. 1968), is illustrative. Applicant applied for registration of the mark SUGAR & SPICE for bakery goods. The examiner's decision, upheld by the Board, was that the mark was descriptive of bakery goods containing sugar and spice. In overturning the Board's decision, the Court held that the mark was not merely descriptive under Section 2(e) because the mark also suggested something else, a well known nursery rhyme. *Id.* at 552.

Similarly, in *In re Delaware Punch Company*, 186 U.S.P.Q. 63 (T.T.A.B. 1975), the Board held that THE SOFT PUNCH for non-carbonated soft drinks was not merely descriptive of the applicant's non-alcoholic punch in part because the mark also suggested something else, that the drink has an impact like a soft punch or a pleasing hit. *Id.* at 63.

In the present case, even assuming for the purposes of argument that Applicant's mark refers to the goods, COLOR COMPLETE also has a second meaning in relation to hair care preparations. As pointed out above, when used as a mark on hair care products, COLOR COMPLETE can be understood as referring to a consumer's hair, suggesting the idea that the hair needs nothing more. Because COLOR COMPLETE suggests something other than the goods when used as a mark on hair care products, COLOR COMPLETE is a double entendre having at least one meaning that is not merely descriptive of the goods. Accordingly,

Applicant's mark COLOR COMPLETE is not merely descriptive within the meaning of Section 2(e).

Moreover, in accordance with the dictionary definitions of "complete", Applicant's mark conveys at least two suggestions in relation to hair- that the hair has total color, or that the hair needs nothing more. Thus, Applicant's mark can be understood in more than one way when used as a mark on hair care products.

Unlike a descriptive term, Applicant's mark COLOR COMPLETE suggests something other than the goods, and can be understood in more than one way. All of this indicates that Applicant's mark is not descriptive.

E. Doubts as to Descriptiveness Are Resolved in Favor of the Applicant

There is a very thin line of demarcation between a term that is merely descriptive and therefore unregistrable, and a term that is suggestive and thus entitled to registration. *In re TMS Corporation of America*, 200 U.S.P.Q. 57, 58 (T.T.A.B. 1978). Where there is doubt in the matter, the doubt should be resolved in favor of the applicant. *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972); *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983); *In re Bel Paese Sales Co.*, 1 U.S.P.Q. 2d 1233, 1236 (T.T.A.B. 1986). Therefore, to the extent that there are any doubts as to the merely descriptive nature of Applicant's mark COLOR COMPLETE, such doubts should be resolved in Applicant's favor.

IV. CONCLUSION

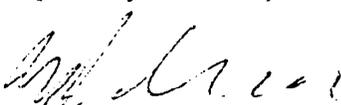
For at least three independent reasons, Applicant submits that its mark COLOR COMPLETE is not descriptive. First, at most, Applicant's mark is merely suggestive of a

possible or desired result of using Applicant's goods. Second, Applicant's mark does not immediately describe Applicant's hair care preparations. Instead, mental thought and imagination are required for the mark to convey any idea about the goods. Third, Applicant's mark is a double entendre having more than one meaning when applied to Applicant's hair care preparations. Each of these reasons is more than sufficient to demonstrate that Applicant's mark is not merely descriptive under the Trademark Act. Accordingly, Applicant's mark COLOR COMPLETE is entitled to registration on the Principal Register.

For the foregoing reasons, Applicant submits that its mark COLOR COMPLETE is entitled to registration on the Principal Register. Therefore, Applicant respectfully requests that the Board overturn the Trademark Examining Attorney's rejection.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

Respectfully submitted,



M. John Carson, Esq.
Attorney for Applicant

FULBRIGHT & JAWORSKI, L.L.P.
865 South Figueroa Street
29th Floor
Los Angeles, California 90017
Telephone: (213) 892-9200
Facsimile: (213) 680-4518