

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARK: GLOSSING SYRUP
SERIAL. NO.: 78/220,322
APPLICANT: Beauty Holding Company, Inc.
FILING DATE: February 28, 2003
INTERNATIONAL CLASS: 3
TO: Commissioner for Trademarks
ATTN: Jamie T. Griffin
Examining Attorney
Law Office 103



10-27-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

**REQUEST FOR RECONSIDERATION AND RESPONSE TO OFFICE ACTION
DATED APRIL 6, 2004**

This is in response to the office action dated April 6, 2004, wherein the Trademark Attorney made final the refusal of registration on the grounds that the mark is merely descriptive. Applicant respectfully requests that the Trademark Attorney withdraw the finality of the refusal to register and pass the mark to publication.

Applicant submits that the mark GLOSSING SYRUP as applied to applicant's goods is at most suggestive, not merely descriptive, of applicant's goods. As previously argued in applicant's response to office action number 1, one may be

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informed by suggestion as well as by description. Thus, the fact that persons encountering applicant's mark would recognize a suggestion that applicant's goods would imbue a user's hair with a silky texture, does not render applicant's mark descriptive. Similarly, the fact consumers may understand, when encountering the mark GLOSSING SYRUP, that applicant's goods can be used to enhance hair shine, does not mean that applicant's mark is merely descriptive.

Moreover, even if the elements of applicant's mark were each found to be individually descriptive of applicant's goods, it is well settled that the combination of words in a mark, each of which are descriptive, may result in a mark which is not descriptive. *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.* 186 U.S.P.Q. 557 (C.C.P.A. 1975); *In re Colonial Stores, Inc.* 157 U.S.P.Q. 348 (C.C.P.A. 1968). See also: *Audio Fidelity, Inc. v. London Records, Inc.*, 141 U.S.P.Q. 792 (C.C.P.A. 1964) (AUDIO FIDELITY suggestive of phonograph records); *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 U.S.P.Q. 502, 507-8 (T.T.A.B. 1985) (SHEER ELEGANCE held not merely descriptive of panty hose); *In re Distribution Codes, Inc.*, 199 U.S.P.Q. 598 (TTAB 1978) (CODE & SYMBOL suggestive of journal regarding product identification which discusses use of codes and symbols); *In re Colgate-Palmolive Co.*, 149 U.S.P.Q. 793 (T.T.A.B. 1966) (HANDI WIPES held not merely descriptive for dusting cloths). It is also well settled that a mark should be viewed in its entirety. See *In re Hutchinson Technology, Inc.*, 7 U.S.P.Q. 2d 1490 (Fed. Cir. 1988).

Applicant's mark, when viewed in its entirety, does not immediately describe the character of applicant's goods. The mark consists of an unusual combination of the term GLOSSING that suggests light and airy with the term SYRUP that suggests

thickness and stickiness. The chosen combination of terms present in the mark requires consumers to exercise some degree of imagination to recognize suggestions about applicant's goods. Combinations of merely descriptive components have been found registrable if the juxtaposition of the words has an unusual or incongruous meaning as applied to the goods. See, e.g., *In re TBG Inc.*, 229 U.S.P.Q. 759,760 (T.T.A.B. 1986) (SHOWROOM ONLINE not merely descriptive of computerized interior furnishings product information service).

In support of his decision to make final the refusal of registration, the Trademark Attorney relied upon excerpts of three published articles. Applicant respectfully submits that each of these articles is inapposite to the issue of whether the term syrup is descriptive of applicant's goods. Each excerpt appears to relate to unusual or unique instances, i.e., a photograph of rock star Bono with KARO syrup in his hair (clearly not the intended purpose of KARO syrup); an excerpt from a grotesque piece of fiction describing the aftermath of an act of murder (it appears that the "syrup" in the hair of the murderer is splatter from the murder victim), and a reference to an undetermined element of maple syrup in a hair care product.

Finally, even if the applicant's mark GLOSSING SYRUP were descriptive, applicant submits that the acquisition of secondary meaning entitles applicant's mark to registration.

For the foregoing reasons, applicant respectfully submits that its mark

GLOSSING SYRUP is suggestive, not merely descriptive, and therefore entitled to registration.

Respectfully submitted,

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Date: 10/6/04

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