

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
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General Contact Number: 571-272-8500

rdg/jk

Mailed: December 19, 2014

Opposition No. 91216907

Benefit Cosmetics LLC

v.

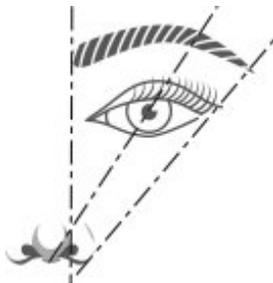
Anastasia Beverly Hills, Inc.

**Before Quinn, Cataldo and Masiello.  
Administrative Trademark Judges.**

By the Board:

### **Background**

Anastasia Beverly Hills, Inc. (“Applicant”) filed two applications to register the following mark



for “stencils for use in applying makeup and shaping the eyebrow” in International Class 16,<sup>1</sup> and for “tweezers” in International Class 8.<sup>2</sup>

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<sup>1</sup> Application Serial No. 86150767, filed December 23, 2013, based on an allegation of use of the mark in commerce pursuant to Trademark Act § 1(a), and alleging a date of first use anywhere and date of first use in commerce of April 1, 2010.

Both applications include the following description of the mark:

The mark consists of a portion of a face showing only the tip of the nose, both nostrils, an eye with eyelashes and an eyebrow with a dotted line running vertically from the tip of the eyebrow through the right nostril, a second dotted line running slightly to the right of the arch of the eyebrow to just beneath the tip of the nose, and a third dotted line running from beneath the right nostril to the end of the eyebrow.

Benefits Cosmetics LLC. (“Opposer”) filed a notice of opposition on the grounds that, in each case, the mark

- 1) is merely descriptive pursuant to Trademark Act § 2(e)(1);
- 2) comprises matter that, as a whole, is functional pursuant to Trademark Act § 2(e)(5); and
- 3) is merely informational in nature, fails to uniquely identify Applicant’s goods, and thus fails to function as a trademark pursuant to Trademark Act §§ 1, 2, and 45.

In its answer, Applicant has denied the salient allegations in the notice of opposition. Applicant moved for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c). The motion is fully briefed.

For purposes of this order, we presume the parties’ familiarity with the pleadings and the record.

### **Legal Standard**

A motion for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c) is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board may take judicial notice. For

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<sup>2</sup> Application Serial No. 86150772, filed December 23, 2013, based on an allegation of use of the mark in commerce pursuant to Trademark Act § 1(a), and alleging a date of first use anywhere and date of first use in commerce of May 25, 2010.

purposes of the motion, all well-pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law. *See, e.g., Baroid Drilling Fluids, Inc. v. Sun Drilling Products*, 24 USPQ2d 1049 (TTAB 1992). A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment. *Id.* *See also* TBMP § 504.02 (2014).

### **Analysis**

The record consists of the pleadings.<sup>3</sup> In its answer, Applicant admitted, *inter alia*, the following allegation:

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<sup>3</sup> For purposes of determining the merits of Applicant's motion, the Board gives no probative weight to the exhibits that Opposer submitted with its notice of opposition and its brief. *See Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009). The Board considers the exhibits not as evidence, but rather only as illustrations of what Opposer alleges.

For guidance, at trial, with the exception of a registration made of record in a manner set forth in Trademark Rule 2.122(d)(1), an exhibit to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless

23. Upon information and belief, Applicant's Proposed Mark is intended to be a visual depiction of a brow-mapping technique that Applicant refers to as the "Golden Ratio."

A. Functionality

Opposer's factual allegations in support of the claim that the mark is functional are as follows:

25. Applicant's Proposed Mark is functional in that it reflects a particular utilitarian brow-mapping technique or method.

26. Opposer and others in the beauty and cosmetics industry would suffer a significant non-reputation-related disadvantage if Applicant were granted a monopoly over use of Applicant's Proposed Mark.

27. Therefore, Applicant's Proposed Mark is functional under Section 2(e)(5) of the Lanham Act, U.S.C. § 1052(e)(5), and cannot be registered as a mark.

28. Because Applicant's Proposed Mark has a utilitarian and functional purpose, it cannot be appropriated exclusively by Applicant and cannot serve as a trademark of Applicant. Registration of such a utilitarian and functional design is inconsistent with the rights of Opposer and other third parties to make functional use of the same or similar designs.

Applicant contends that its mark is "a two-dimensional logo," that the functionality doctrine applies to trade dress, and that "(A)s a matter of law, logos are not trade dress." (Motion, p. 3). Applicant cites, *inter alia*, *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1793

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identified and introduced in evidence during the assigned period for the taking of testimony. See Trademark Rule 2.122(c); TBMP § 317 (2014).

Opposer's standing is not at issue in Applicant's motion. However, for completeness, we note that the notice of opposition sufficiently sets forth allegations which, if proven, would establish Opposer's standing. See Board's Order, September 3, 2014.

(TTAB 2006). It further argues that it is not seeking to register a product feature, that its registration would not affect others' manufacturing of tweezers or stencils, and that allegations related to the use of diagrams to perform services are not material to whether the mark is functional for the goods. (Motion, p. 7-8).

Opposer asserts in response that "(T)here is nothing in the record to indicate that Applicant's Proposed Mark is not trade dress" and that "even if Applicant were later able to prove that Applicant's Proposed Mark is not trade dress, that would be entirely immaterial ... [M]arks that are not trade dress can be functional." (Opposer's Brief, p. 6).

On this record, accepting all of Opposer's well-pleaded factual allegations to be true, and drawing all inferences therefrom in a light most favorable to Opposer, we find that genuine disputes exist that preclude us from finding that Applicant is entitled to judgment as a matter of law. At a minimum, there is a genuine dispute regarding whether Applicant's mark is one which can be subject to a claim that it is, as a whole, functional. Even though Applicant's mark is an image rather than a product configuration, we have pointedly recognized that "(T)he fact that a drawing of a mark is in two dimensions will not preclude the mark from being refused as functional." *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d at 1792. We do not foreclose the possibility that § 2(e)(5) is broad enough to allow a two-dimensional image to be found to be functional.

On the record before us there is a genuine dispute with respect to whether the image shown in the mark may be essential to the use or purpose of “tweezers” and “stencils for use in applying makeup and shaping the eyebrow,” or may affect the cost or quality of these goods. *See TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1003 (2001); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1783 (TTAB 2012). To a notable extent, the genuine dispute emanates from the fact that we accept as true Opposer’s allegation that the mark “reflects a particular utilitarian brow-mapping *technique or method*” (Notice of Opp., para. 25; emphasis added), which could have some applicability to the use of Applicant’s goods.

For completeness, the Board notes that both parties have made arguments regarding the factors set forth in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982) (“*Morton-Norwich* factors”). Indeed, the Board applies all of these factors, giving each its appropriate weight, to determine whether a mark is functional. However, the alleged facts, as deemed admitted for purposes of this motion, are insufficient to dispose of all genuine disputes of material fact when subjected to a *Morton-Norwich* analysis.

In view of the foregoing, applicant’s motion for judgment on the pleadings with regard to the ground of functionality is **denied**.

Given the conclusory nature of Opposer's allegations, Opposer should consider amending its pleading so as to allege with more specificity the basis for its functionality claim; that is, Opposer should set forth the features of Applicant's mark that it alleges are essential to the use or purpose of, or affect the cost or quality of Applicant's identified goods.<sup>4</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 58 USPQ2d at 1006; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Labs., Inc., v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982).

### B. Descriptiveness

Opposer's factual allegations in support of the claim that the mark is merely descriptive are as follows:

13. Applicant's Proposed Mark is a version of a classic diagram that has been widely used in the cosmetics industry as a pedagogical tool for mapping and shaping eyebrows since long before Applicant's claimed date of first use. A representative sample of similar diagrams that, upon information and belief, were used on third-party websites prior to Applicant's earliest claimed first use date of April 1, 2010 are attached as Exhibit B.

14. Brow-mapping diagrams of the same type as Applicant's Proposed Mark also have been used in cosmetology schools and in training guides for estheticians. A representative excerpt from a cosmetology text is attached as Exhibit C. Such brow mapping diagrams are didactic devices that show estheticians how to shape eyebrows.

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<sup>4</sup> In Board proceedings, Fed. R. Civ. P. 11 (applicable by operation of Trademark Rule 2.116(a)), and U.S. Patent and Trademark Office Rule 11.18, require that all pleadings and filings be made in good faith and have, or likely will have, evidentiary support. Specifically, all grounds for relief and allegations in support thereof must have a basis in law or fact, and must not be filed for any improper purpose.

29. Alternatively, Applicant's Proposed Mark is merely a descriptive diagram that describes Applicant's method for mapping eyebrows. The diagram that composes Applicant's Proposed Mark is merely informational in nature, does not uniquely identify Applicant's goods or services, and is incapable of serving any source-identifying function. Further, Applicant's Proposed Mark has not acquired distinctiveness.

A mark is merely descriptive if it describes a feature, ingredient, characteristic, purpose, function, intended audience, or use of Applicant's goods. *See, e.g., DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920).

The determination of whether a mark is merely descriptive is made in relation to the identified goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1757; *In re Chamber of Commerce of the U.S.A.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). The question is not whether someone presented with only the mark could guess what the goods are, but rather whether someone who knows what the goods are will immediately understand the mark as directly conveying information about them. *See Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (TTAB 2010).

Applicant argues that its mark is neither an illustration of tweezers or eyebrow and makeup stencils, nor an important feature or characteristic of tweezers or eyebrow and makeup stencils. (Motion, p. 9).

Opposer argues that the mark “describes the function, use, *and* purpose of the goods” (Opposer’s Brief, p. 6, emphasis in original), and that the mark “clearly describes the use and function of the goods set forth in Applicant’s Applications: namely, the mapping and shaping of eyebrows with stencils and tweezers.” (Opposer’s Brief, p. 20).

Given the conclusory nature of the allegations, and the fact that Opposer’s allegation is that the mark “describes Applicant’s *method* for mapping eyebrows” (Not. of Opp., para. 29, emphasis added), Opposer does not allege precisely how the mark merely describes a characteristic, intended use, function, or purpose for “tweezers” and “stencils for use in applying makeup and shaping the eyebrow.” However, we find that Opposer’s pleading raises, at a minimum, the genuine issue of whether the mark is an illustration of the function of Applicant’s goods within the meaning of § 2(e)(1).

In view of these findings, Applicant’s motion for judgment on the pleadings with regard to the ground of descriptiveness is **denied**.

### C. Failure to Function as a Trademark

Opposer’s factual allegations in support of the claim that the mark fails to function as a trademark are as follows:

29. ...The diagram that composes Applicant’s Proposed Mark is merely informational in nature, does not uniquely identify Applicant’s goods or services, and is incapable of serving any source-identifying function. Further, Applicant’s Proposed Mark has not acquired distinctiveness.

Applicant argues that, as a matter of law, this claim is inapplicable inasmuch as its mark is neither a slogan nor a term, and does not contain or provide any information about tweezers or eyebrow and makeup stencils. (Motion, p. 10).<sup>5</sup>

Opposer argues that a mark need not be a slogan or term to be deemed informational, and that the law relating to an alleged mark's failure to function is applicable to pictures and illustrations, citing *In re Int'l Spike, Inc.*, 196 USPQ 447, 448-449 (TTAB 1977). It further argues that marks of all types that merely convey instructions or information regarding a product's use are not source-indicating and do not function as trademarks, citing *In re H. Goodman & Sons, Inc.*, 135 USPQ 407, 408 (TTAB 1962).

For purposes of determining the motion for judgment on the pleadings, we look at how the applied-for mark is used on the specimen of record to determine if the mark functions as a trademark to indicate the source of Applicant's goods and to identify and distinguish them from others. Trademark Act §§ 1, 2, and 45. The specimen of use that Applicant submitted with its applications is of record by operation of Trademark Rule 2.122(b)(1).

Although the placement of the mark on the packaging, namely, the box containing Applicant's goods, as shown in the specimen of use, is consistent with a conventional use of a trademark, Opposer has alleged that the "mark diagram that composes" the mark is merely informational and is "incapable" (Not. of Opp., para. 29) of functioning as a mark. This suggests that there is something

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<sup>5</sup> We do not take as established Applicant's assertion that as a matter of law, a claim that a mark is "merely informational" is completely inapplicable to this mark.

inherent in the mark that deprives it of having a source-indicating function, regardless of how it is used.

On this record, there is a genuine dispute regarding whether the public perceives the features of the mark as a source indicator to identify and distinguish applicant's "tweezers" and "stencils for use in applying makeup and shaping the eyebrow" from the goods of others, or as merely informational matter regarding the goods.

In view of the foregoing, Applicant's motion for judgment on the pleadings regarding the failure to function claim is **denied**.

**Schedule**

Proceedings are resumed. The parties are allowed until thirty days from the mailing date of this order in which to serve responses to any outstanding discovery. Discovery, disclosure, and trial dates are reset as follows:

Expert Disclosures Due	<b>5/20/2015</b>
Discovery Closes	<b>6/19/2015</b>
Plaintiff's Pretrial Disclosures due	<b>8/3/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>9/17/2015</b>
Defendant's Pretrial Disclosures due	<b>10/2/2015</b>
Defendant's 30-day Trial Period Ends	<b>11/16/2015</b>
Plaintiff's Rebuttal Disclosures due	<b>12/1/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/31/2015</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).  
An oral hearing will be set only upon request filed as provided by Trademark  
Rule 2.129.