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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Murad, Inc.

Serial No. 77556539

Michael A. Painter of Isaacman, Kaufman & Painter, P.C. for
Murad, Inc.

Rebecca L. Gilbert, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Bergsman, Wellington and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Murad, Inc. has appealed from the final refusal of the
trademark examining attorney to register PERFECTING SERUM
in standard character format for "skin moisturizer."

Applicant disclaimed the exclusive right to use the word
"serum" and claimed ownership of Registration No. 2148418
on the Supplemental Register for the mark PERFECTING SERUM
for "skin moisturizers." There are two issues before us in
this appeal: whether applicant's mark is merely

descriptive of the identified goods (refusal based on Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1)); and, if so, whether applicant's mark has acquired distinctiveness.

Preliminary Issues

A. Whether applicant's brief exceeds the page limits?

Trademark Rule 2.142(b)(2) provides that applicant's brief "shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary." The brief "must be printed in at least 11-point type and double-spaced." Trademark Rule 2.126(a)(1) made applicable by Trademark Rule 2.142(b)(2).

Applicant's brief was thirty pages of which twenty-five pages were argument. The examining attorney objected to the length of applicant's brief. Applicant acknowledged that its brief exceeded the permissible length, but argued that would have been permissible if applicant had printed it in 11-point type. However, applicant did not file its brief in 11-point type, nor did it file a late brief in 11-point type and request that the Board consider the late-

filed brief. Accordingly, applicant's main brief has not been considered.¹

B. Whether applicant may argue that its mark is not merely descriptive?

This application has a tortured prosecution that must be reviewed to determine whether applicant may argue that its mark is not merely descriptive.

Date	Action
August 27, 2008	Applicant filed its application for registration on the Principal Register.
September 8, 2008	Applicant filed a preliminary amendment claiming that its mark had acquired distinctiveness by virtue of applicant's substantially exclusive and continuous use for more than five years. Applicant did not expressly assert that it was claiming acquired distinctiveness in the alternative.
December 3, 2008	In an examiner's amendment, applicant disclaimed the exclusive right to use the word "serum."
January 13, 2009	The application was published for opposition.
March 9, 2009	Jurisdiction was restored to the examining attorney pursuant to a letter of protest.

¹ We have, however, considered applicant's responses to Office actions and its reply brief. *In re Thomas*, 79 USPQ2d 1021, 1023 n.5 (TTAB 2006).

Date	Action
March 9, 2009	Examining Attorney issued an Office action refusing registration on the grounds that the mark is merely descriptive and that the declaration that the mark has acquired distinctiveness is insufficient.
June 17, 2009	Applicant filed a response to the Office action arguing that the mark is suggestive, not descriptive, and presenting evidence that the mark has acquired distinctiveness. Applicant did not expressly state that it was arguing that its mark had acquired distinctiveness in the alternative.
July 6, 2009	Examining Attorney issued a final refusal on the grounds that the mark is merely descriptive and that the evidence that that the mark has acquired distinctiveness is insufficient. The examining attorney did not point out that applicant had not expressly stated that it was arguing, in the alternative, that its mark had acquired distinctiveness and, therefore, had waived the right to argue that its mark was not merely descriptive.
August 17, 2009	Applicant filed a request for reconsideration based only on the ground that its mark had acquired distinctiveness.
August 18, 2009	Examining Attorney denied the request for reconsideration.
October 5, 2009	Applicant filed its appeal brief, which has been given no consideration.

Date	Action
October 21, 2009	Examining Attorney filed her opposition brief. In addition to arguing the merits of the refusals, the examining attorney asserted that applicant waived its right to argue that the mark is not merely descriptive.
November 12, 2009	Applicant filed its Reply Brief, arguing that the examining attorney's actions of continually arguing that the mark was merely descriptive "refute the contention that the Applicant did not preserve its rights to contest the Examiner's findings."

Although applicant did not expressly state that it was claiming, in the alternative, that its mark had acquired distinctiveness, nevertheless, we find that applicant may argue that its mark is not merely descriptive. After applicant responded to the March 9, 2009 Office Action arguing that its mark was not merely descriptive, the examining attorney addressed applicant's argument on its merits and did not object or otherwise advise applicant that it had not expressly claimed, in the alternative, that it was seeking registration under the provisions of Section 2(f). In fact, the first time the examining attorney advised applicant that it had waived its right to argue that its mark was not merely descriptive was in her responsive brief on appeal. If the applicant makes an improper argument, the examining attorney should object to

the argument in the next Office action, or the Board may consider that objection waived. *Cf. In re 1st USA Realty Professionals*, 84 USPQ2d 1581, 1583 (TTAB 2007) (Board considered applicant's own registration, provided for the first time on appeal, because it had been referred to during prosecution and the examining attorney addressed the issue without objection; Board also allowed evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake); *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action).

Applicant's prior registration on the Supplemental Register does not prevent applicant from contending that its mark is inherently distinctive in this application. *In re Hester Industries, Inc.*, 230 USPQ 797, 798 (TTAB 1986) (while Supplemental Registration is an admission that applicant believed that its mark was merely descriptive when it filed the application or made the amendment to the Supplemental Register, it is not binding on the Board which

makes its own determination of whether the mark is merely descriptive).

Whether Applicant's Mark Is Merely Descriptive?

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings

in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will immediately understand the mark as directly conveying information about them (*i.e.*, whether someone familiar with applicant's skin moisturizer will understand PERFECTING SERUM to convey information about the goods). *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *see also In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

The examining attorney submitted the following evidence to prove that PERFECTING SERUM is merely descriptive when used in connection with skin moisturizer:

1. The definition of the word "Perfecting" meaning "to bring to perfection or completion."
2. The definition of the word "Serum" meaning
 1. the clear, pale-yellow liquid that separates from the clots in the coagulation of blood; blood serum.
 2. Immune serum.
 3. any watery animal fluid.
 4. the thin, clear part of the fluid of plants.
 5. milk whey.
3. Use of the term "perfecting serum" by third parties.

Applicant submitted the declaration of Michael Painter, applicant's counsel, with attached exhibits, attesting to applicant's enforcement of its trademark rights in the mark PERFECTING SERUM. With the exception of Lancôme and Guerlain, the third-party users identified by the examining attorney have stopped using the term "Perfecting Serum" or were, in fact, selling applicant's

product.² One third-party user, KaplanMD, Inc., settled an infringement action brought by applicant by agreeing to a license.

The examining attorney argued that the third-party use of "Perfecting Serum" by those that have discontinued such use is relevant because "consumers have been extensively exposed to these advertisements." (Brief, unnumbered page 5). Without any supporting evidence regarding the length of time the third-parties used the term "Perfecting Serum" or the number of hits their websites received, we do not draw any conclusions regarding the extent that consumers have viewed these websites.

Also, we are cognizant that the discontinuance of the use of the term "Perfecting Serum" by the third parties upon threat of legal action may show a desire to avoid litigation rather than recognition of trademark rights. On the other hand, through its policing activities, applicant has taken steps to ensure that third-party use has not caused the mark PERFECTING SERUM to lose whatever distinctiveness or exclusivity it has achieved. As a result of applicant's enforcement activities, at the time

² The examining attorney also identified Biotherm as a third-party user, but applicant explained that Lancôme and Biotherm are owned by L'Oreal USA, Inc.

we are deciding this case, there are only two other users of the term at issue, and applicant asserts that it is currently negotiating with Guerlain.

The examining attorney argued that PERFECTING SERUM is merely descriptive because "consumers would immediately understand that the moisturizing serums are used to perfect the skin, which is a function and purpose of the goods."³ Because applicant disclaimed the exclusive right to use the word "serum" pursuant to a requirement by the examining attorney, we consider the disclaimer to be a concession that the word "serum" is merely descriptive of skin moisturizer. However, with the exception of the two third-party users noted above, there is no evidence that the word "perfecting" is used by others in the industry, or that it is understood by consumers, to describe a quality, characteristic or function of skin moisturizer or any other cosmetic or personal care product. The term "Perfecting Serum" requires an effort of imagination on the part of the observer to resolve the incongruity between skin moisturizer and the term "Perfecting" and "Serum" (*i.e.*, a serum does not normally perfect something). Consequently, the mark PERFECTING SERUM does not with any degree of

³ Brief, unnumbered page 4.

particularity describe the function or purpose of applicant's skin moisturizer. When PERFECTING SERUM is used in connection with skin moisturizer, some level of thought is necessary to make the connection between the mark and quality, characteristic or function it is supposed to describe.

Our decision is based on the record created by the examining attorney and applicant. Because a review of the record has not resolved our doubts as to whether applicant's mark is merely descriptive, we resolve those doubts in applicant's favor, as we are required to do. *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"); *see also Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

In view of the foregoing, we find that applicant's mark PERFECTING SERUM when used in connection with skin moisturizer is suggestive, rather than merely descriptive.

Because we have found that applicant's mark is not merely descriptive, the issue as to whether the evidence is sufficient to show that it has acquired distinctiveness is moot.

Decision: The refusal to register is reversed.