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

Proceeding	79254013
Applicant	Shyne Lab AG
Applied for Mark	SHYNE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: US-portion of International Trademark Application for „SHYNE“

Applicant: Shyne Lab AG

Serial No.: 79/254,013

Int'l Reg. No.: 1454849

Filed: December 19, 2018

Examiner: Julie Vo

Law Office: 123

Mail Stop: TTAB
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S BRIEF OF APPEAL

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Introduction

The Examiner had finally refused registration of the present application for the mark "SHYNE" based on the ground that "the mark is merely descriptive" under Section 2(e)(1) of the Lanham Act. Applicant had previously traversed this determination and now asks the Board to determine that the refusal is not warranted in this case and should be withdrawn. Applicant's prior arguments and law submitted and of record are hereby incorporated by reference.

Applicant's Goods

Applicant's finally amended goods read as follows:

Class 003

Non-medicated toiletry preparations; non-medicated body cleaning and beauty care preparations; bath preparations, not for medical purposes; non-medicated skin, eye and nail care preparations; hair removal and shaving preparations, namely, hair removing cream, wax for removing body hair; non-medicated hair care preparations and treatments; cosmetics; make-up; perfumery; essential oils and aromatic extracts being aromatic oils; non-medicated soaps; air fragrancing preparations; sunscreen preparations for household use; hair lotions; hair dyes; hair spray; hair nourishers; adhesives for affixing false hair; false eyelashes; bleaching preparations and other substances for laundry use; cleaning preparations; dentifrices.

1. The Examiner Committed Error in Analyzing the Products in the Application

Attachments

Reviewing the Examiner's refusals in three Office Actions, the final Office Action having 12 attachments, it is surprising to find that the Examiner discusses applicant's goods as if these consist simply and only of *hair preparations*. This is not the case and is also not fair. The 12 attachments are related to *hair preparations* somewhere in commerce that advertise a number of products having nothing to do with applicant's products. The Examiner's focus on only *hair preparations* is too narrow and misleading.

2. The Examiner did not apply 'Descriptiveness' correctly to Applicant's Mark.

Determination of Descriptiveness

Descriptiveness cannot be determined in the abstract as the Examiner does here.

The Examiner sees the mark "SHYNE" as a misspelling of the term "shine". Everything that applicant has submitted as proof that "Shyne" is also a proper name, or that the applicant's commercial name is Shyne Lab AG was never given a line by the Examiner.

Moreover, the manner in which Examiner is trying to make the case relies exclusively on the statement that "shine" [as underlying SHYNE] is a characteristic of the product (see Office Action dated March 22, 2019). As stated in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 228 USPQ 528, 530 (Fed. Cir. 1986)*, quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, (citations omitted), "[t]he name of a thing is in fact the ultimate in descriptiveness."

This cannot be said to be the case here. Applicant's products themselves are not characterized by "shine". These products are just chemicals in a bottle, whether face cream, cosmetics or hair products or cleaners, and therefore "shine" is not a feature of the products themselves but rather a result (or not!) upon application of such products, i.e. in the case of certain hair products applied on hair in some procedure may enhance a characteristic of natural hair. Additionally, special cleaning preparations make your car shine as per attachment by the Examiner. However, cleaning preparations are also just sodium carbonate (as in a popular household cleaning product named "Ajax"). The term "shine" as presented by the Examiner as being a result of an application of the product therefore requires a two-step thought process of what "shine" refers to. Moreover, the mere fact that applicant's products are mostly non-hair products removes the mark even further from the descriptiveness analysis. Fact is, one cannot put all the goods in one category. Each product group has a different use pattern. Thus, while the Examiner focuses exclusively on hair care preparations, what about *hair removing cream, wax for removing body hair* to name as examples?

To follow the above cited case law, marks found descriptive are for example, BED & BREAKFAST REGISTRY, held merely descriptive of lodging reservations services; or the mark MALE-P.A.P. TEST *In re MetPath Inc*., 223 USPQ 88 (TTAB 1984) held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer; Also, see *In re Bright-Crest, Ltd.,* 204 USPQ 591 (TTAB 1979) for the mark COASTER-CARDS and held merely descriptive

of a coaster suitable for direct mailing. These descriptive marks immediately convey something, i.e. the nature of the good itself.

In one of the seminal cases cited in *In re Chamber of Commerce case (see Office Action)* the court states: '*Descriptiveness must be evaluated in relation to the particular goods for which registration is sought, the context in which it is being used and the possible significance that the term would have for the average purchaser of the goods because of the manner of its use', see In re Abcor Dev. Corp.*, 588 F.2d 811, 813-14 (CCPA 1978). Applied to the instant case, this means that the goods except hair care preparations do not even fall under the Examiner's analysis, and while the Examiner takes the position that regardless of the other articles recited in the list of goods, any goods in the list will fall under the refusal. This is a flawed analysis and an untenable determination.

Accordingly, it is evident that the mark SHYNE does not fall into the category of describing the goods themselves.

3. *Applicant's Mark falls into the Category of Suggestive Marks*

Suggestive Marks

SHYNE falls clearly into the suggestive category. Most of applicant's goods have nothing to do with hair care whatsoever.

It is black letter law that marks follow a spectrum in which the marks range from arbitrary, coined, fanciful, suggestive to descriptive and finally to generic. While the strongest marks are those that are on one end of the spectrum and are

arbitrary, the category of marks deemed suggestive confer a suggestion of a characteristic that requires a certain thought process because, as here, the characteristic does not *per se* apply to the goods but requires an additional step in the thought process. Purchasers are not a monolithic bloc all thinking the same thing. Some may think of shoeshine when seeing or hearing the term shine, while others may think of other connotations.

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.

In *In re George Weston Ltd.,* 228 USPQ 57 (TTAB 1985) the mark SPEEDI BAKE for frozen dough was found to be a suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread. In another case the mark NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute *In re The Noble Co*., 225 USPQ 749 (TTAB 1985).

In *In re Pennwalt Corp., 173 USPQ 317* (TTAB 1972), the mark DRI-FOOT was held suggestive of anti-perspiring deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspiring and deodorant for the feet would be described.

Significantly, it is only *hair care preparations* listed above referring to hair products to which the Examiner directed the analysis and discussion in the three Office Actions. As concerns applicant's goods, the Examiner simply cites case law stating that any product in the recitation of goods could trigger a descriptiveness refusal citing *In re Chamber of Commerce of the United States of America* 102 USPQ2d 1217 (CAFC 2007). While in that case, all the services pertaining to the mark "National Chamber" related to those carried out by a chamber of commerce and thus were rightfully deemed descriptive, here in contrast, the goods have zero connotation to the Examiner's claim of an immediate characteristic of the goods. Therefore, the case must be deemed inapposite to the mark presently under consideration.

And furthermore, if the mental leap between the word and the product attribute is not almost instantaneous, it strongly indicates suggestiveness, not direct descriptiveness , see *Investa Corp Inc. v. Arabian Inv. Banking Corp*., 931 F2d. (11th Cir. 1991).

Conclusion

A realistic and unbiased look at the goods shows that: *hair care preparation, hair lotions; hair dyes; hair spray; hair nourishers* cannot be described by "shine" and it is entirely debatable whether these goods really actually do what the Examiner says they are doing, i. e. conferring "shine" to hair. For that reason and those set for the above, the mark SHYNE must be deemed a suggestive mark.

Since the remaining goods have no connection to the analysis the Examiner carried out, applicant submits that as to the goods not related to hair, "shine" cannot

apply because the mark is not even suggestive of the goods. For that reason, the Board should decide in favor of applicant and such action is respectfully solicited.

Shyne Lab AG

Dated: August 7, 2020

By: /Ursula B. Day/

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