

This Opinion is not a
Precedent of the TTAB

Mailed: September 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Christie Brinkley Skincare, LLC

v.

Alumier Europe Ltd.

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Opposition No. 91229847

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Christopher J. Day of Day Law Firm
for Christie Brinkley Skincare, LLC.

Faustino A. Lichauco of Occhiuti & Rohlicek LLP
for Alumier Europe Ltd.

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Before Adlin, Goodman and Coggins,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Alumier Europe Ltd. seeks a Principal Register registration for the proposed mark IR DEFENSE, in standard characters (IR disclaimed), for “beauty serums that provide protection against infrared radiation.”¹ In its notice of opposition, Opposer Christie Brinkley Skincare, LLC alleges prior use of, and ownership of pending applications to register, the marks IR DEFENSE, in standard

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¹ Application Serial No. 86660963, filed June 12, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

characters,² RECAPTURE DAY + IR DEFENSE, in standard characters (DAY and IR DEFENSE disclaimed),³ and RECAPTURE 360 + IR DEFENSE, in standard characters (IR DEFENSE disclaimed),⁴ all for “cosmetics that provide protection against infrared radiation; non-medicated skin care preparations that provide protection against infrared radiation.” Opposer specifically alleges that Office actions issued in each of its pleaded applications finding that Opposer’s pleaded marks could at least potentially cause confusion with the mark in Applicant’s involved application. As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s marks, and that Applicant’s mark is merely descriptive of Applicant’s goods. In its answer, Applicant admits that Opposer’s pleaded applications were suspended based on a potential likelihood of confusion with Applicant’s involved mark, but otherwise denies the salient allegations in the notice of opposition.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Applicant’s involved application. In addition, Opposer introduced:

² Application Serial No. 86726961, filed August 17, 2015 under Section 1(a) of the Act, and subsequently amended to Section 1(b), based on an alleged intent to use the mark in commerce (the “961 Application”).

³ Application Serial No. 86726965, filed August 17, 2015 under Section 1(a) of the Act, based on alleged first use dates of November 2014 (the “965 Application”).

⁴ Application Serial No. 86740503, filed August 28, 2015 under Section 1(a) of the Act, based on alleged first use dates of November 2014 (the “503 Application”).

Notice of Reliance (“Opp. NOR”) on its pleaded applications, dictionary definitions, a thesaurus entry and Internet printouts. 9 TTABVUE.⁵

Testimony Declaration of Andrew Surwilo, Opposer’s Managing Member, and the exhibits thereto. (“Surwilo Dec.”). 10 TTABVUE.

Applicant introduced:

A Notice of Reliance (“App. NOR”) on the file history for Opposer’s pleaded ’961 Application. 11 TTABVUE.

II. Standing

Opposer has established its use, and continued interest in using, the term IR DEFENSE for skincare products and cosmetics. 10 TTABVUE 4-5 (Surwilo Dec. ¶¶ 4-5). This establishes its standing to oppose registration of Applicant’s mark on the ground of descriptiveness. *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961) (standing established where an opposer “is one who has a sufficient interest in using the [allegedly] descriptive term in its business”); *see also Kellogg Co. v. Gen. Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (acknowledging that a commercial interest in an allegedly descriptive term is sufficient to establish standing). *Cf. Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) (“It is clear that use of a term in a descriptive sense is sufficient to impart standing to oppose federal registration of a descriptive ‘word, name, symbol, or device’ as a trademark.”).

⁵ Citations to the record reference TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

III. Evidence of Descriptiveness

Opposer relies on the following dictionary definitions of the proposed mark's constituent terms:

IR—"infrared"⁶

DEFENSE—"the act or action of defending;" "capability of resisting attack;" and "means or method of defending or protecting oneself, one's team, or another."⁷

9 TTABVUE 20-21, and on the following thesaurus entry:

PROTECTION—"means or method of defending"⁸

9 TTABVUE 19.

Opposer also relies on an article which indicates that infrared rays from sunlight can damage skin. Specifically, a blog posting on the "lovelyskin.com" website entitled "The Next Big Thing: Infrared Sunscreen," states that infrared or IR rays "generate free radicals that cause collagen breakdown and accelerate skin aging." *Id.* at 22. The article recommends "sunscreens that offer infrared protection," as they "are the best defense against sunburn, premature photoaging and skin cancer," and goes on to list two of "our favorite IR sunscreens." *Id.* One of the recommended products is "Obagi Medical Sun Shield" and the other is "SkinMedica Total Defense." *Id.*; *see also, id.* at 24-26 (printouts from "skinmedica.com" website showing Total Defense products being promoted for their ability to "protect" skin).

⁶ <http://unabridged.merriam-webster.com/collegiate/ir>.

⁷ <http://unabridged.merriam-webster.com/collegiate/defense>.

⁸ <http://unabridged.merriam-webster.com/thesaurus/protection>.

IV. Analysis

A mark is deemed merely descriptive, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the goods for which it is used. *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009)); and *In re Abcor Dev.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the proposed mark would have to the average purchaser of the goods because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

When two or more merely descriptive terms are combined, the determination of whether the composite proposed mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *See e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir.

2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech Inc.*, 64 USPQ 2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publ. Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry).

Here, the record leaves no doubt that IR DEFENSE is merely descriptive of beauty serums that provide protection against infrared radiation. The dictionary definitions and third party editorial uses of “IR” and “defense” in connection with skincare products, as well as the thesaurus entry for “protection” make clear that the term IR DEFENSE merely describes the purpose of Applicant’s goods – to protect or “defend” skin from the dangers of infrared or “IR” radiation from sunrays. For example, the “lovelyskin.com” article states that “sunscreens that offer **infrared** protection are the best **defense** against sunburn, premature photoaging and skin cancer.” 9 TTABVUE 22 (emphasis added). Other products designed to protect skin from the sun’s infrared rays use terms with similar meanings to describe their competing products, such as

“sun shield” and “total defense.” *Id.* The article describes one product’s “high SPF and Active IR technology which defends your skin from heat-related free radical damage.”

*Id.*⁹

The descriptiveness of Applicant’s proposed mark is further revealed by Applicant’s identification of goods itself: “beauty serums that provide **protection against infrared radiation**” (emphasis added). *See generally, In re Taylor & Francis (Publishers) Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (PSYCHOLOGY PRESS & Design found merely descriptive of nonfiction books in the field of psychology, in part because the applicant’s “identification of goods expressly states that the series of non-fiction books upon which applicant uses its mark are ‘in the field of psychology.’ The word PSYCHOLOGY therefore is merely descriptive of the subject matter of applicant’s books, as identified in the application”). The thesaurus entry for “protection” indicates that the term is a synonym for a “means or method of defending.” 9 TTABVUE 19. Furthermore, Applicant’s voluntary

⁹ Applicant introduced the file history of Opposer’s pleaded ’961 Application via notice of reliance, which establishes that Opposer’s identical proposed mark IR DEFENSE was refused registration for being merely descriptive. 11 TTABVUE. While the evidence in support of that refusal is therefore of record, we may not rely on it for the truth of the matters asserted. *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1037 n.14 and 1040 (TTAB 2010). Furthermore, we must decide each case on its own merits. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). At the same time, however, the evidence from the ’961 Application’s file history was properly introduced via notice of reliance in this case, is consistent with *Safer*, and is substantively no different than if Applicant had introduced the same materials separately, apart from the entire file history. These materials further reveal the public’s exposure to use of the term “defense” by other third parties in association with cosmetics and skincare goods. For example, the “skinexpert.com” website describes how cosmetics provide “defense against sun-damaged skin.” 11 TTABVUE 32, the “amazon.com” excerpt shows an “eye defense cream,” *id.* at 33, and the “skinceuticals.com” excerpt describes a skin care preparation that provides UV ray “defense.” *Id.* at 34.

disclaimer of the term “IR” is effectively a concession that at least this term is merely descriptive. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff’d* 565 Fed. Appx. 900 (Fed. Cir. 2014); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse Inc.* 89 USPQ2d 1844, 1851 (TTAB 2008).

When the merely descriptive terms “IR” and “defense” are combined, “the mark as a whole, i.e., the combination of the individual parts,” does not convey “any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *In re Oppedahl & Larson*, 71 USPQ2d at 1372. To the contrary, from “the perspective of a prospective purchaser or user” of Applicant’s beauty serums, “because ... the combination of the terms does not result in a composite that alters the meaning of [any] of the elements,” the proposed mark is merely descriptive. *In re Petroglyph Games*, 91 USPQ2d at 1341. Applicant does not argue to the contrary.

Applicant nevertheless argues that the term IR DEFENSE is not merely descriptive based on **Opposer’s** arguments made during Opposer’s prosecution of its pleaded ’961 Application to register the same term. Specifically, Applicant relies on Opposer’s argument in an Office Action response that its identical proposed mark IR DEFENSE is not merely descriptive because **Opposer’s** cosmetics and skin care products (as opposed to Applicant’s involved beauty serums that protect against infrared radiation) “cannot immediately be identified simply by viewing the subject mark.” 11 TTABVUE 16-19 (Opposer’s June 12, 2017 Office Action response in its ’961 Application). That is not the correct test, however. Indeed, “[t]he question is not whether someone presented with only the mark could guess what the goods or

services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech*, 64 USPQ2d at 1316-17). Here, consumers who know that Applicant’s goods are “beauty serums that provide protection against infrared radiation” will immediately understand that the proposed mark directly describes their stated purpose: defending a user’s skin against IR radiation. Furthermore, Opposer’s argument during prosecution of its own application that the terms IR and DEFENSE have “many different meanings” is irrelevant and not well-taken, to the extent Applicant makes the same argument here. “It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.” *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *see also*, *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1034 (TTAB 2007); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Finally, even if the record in this case established that Opposer (or Applicant) was the first and only user of the term IR DEFENSE, which it does not, that would be irrelevant. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2018) (“The fact that Applicant may be the first or only user of a term does not render that term distinctive ...”); *In re Sun Microsystems, Inc.*, 59 USPQ2d at 1087. *Cf. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), 72 USPQ2d 1833, 1838 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”).

V. Conclusion

Applicant’s proposed mark IR DEFENSE merely and immediately describes the stated purpose of its goods, which is to protect or “defend” a user’s skin against infrared or “IR” radiation. The term should remain available for other skincare businesses to use to describe their competing products and services. *See In re Abcor Dev.*, 200 USPQ at 217 (“The major reasons for not protecting [merely descriptive] marks are ... to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”).

Decision: The opposition is sustained under Section 2(e)(1) of the Trademark Act.¹⁰

¹⁰ We need not reach Opposer’s likelihood of confusion claim. *Yazhong Investing Ltd. v. Multi-Media Tech Ventures, Ltd.*, 126 USPQ2d 1526, 1540 (TTAB 2018); *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).