

**THIS ORDER IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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January 17, 2023

Opposition No. **91273482**

Anastasia Beverly Hills, LLC

v.

*Rubi Arreola*¹

Yong Oh (Richard) Kim, Interlocutory Attorney:

On June 15, 2022, Applicant, with Opposer's consent, moved to amend the filing basis of involved Application Serial No. 90227452² from Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and to amend her mark from DEFINED BROW STUDIO in standard

¹ Applicant's change of correspondence address (10 TTABVUE) has been noted and entered into the proceeding file.

² For the mark DEFINED BROW STUDIO in standard characters for "Beauty treatment services especially for eyebrows; Cosmetic and body procedures, namely, fibroblasting, micropigmentation, cavitation, and microblading; Cosmetic eyebrow care services in the nature of waxing, brow tint, henna, and ombré; Cosmetic skin care services, namely, waxing, facials, brow shaping, brow tints, brow lifts, and brow laminations; Cosmetic tattooing services; Eyelash services, namely, lash extensions, lash lifts, and lash perms; Face and body waxing services; Microblading being eyebrow tattooing services; Salon services, namely, brow and eyelash tinting, body waxing, facial waxing, makeup services, and makeup application services; Tattooing services; Tattooing and permanent makeup services" in International Class 44. The application was filed on September 30, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and approved for publication under Section 2(f), 15 U.S.C. § 1052(f), with a disclaimer of BROW STUDIO.

characters to DEFINED BROW in standard characters.³ By its order of August 8, 2022, the Board denied the proposed amendment to the filing basis and further denied the amendment to the mark as a material alteration.⁴

On September 2, 2022, Applicant, with Opposer's consent, renewed her request to amend the filing basis of the subject application and to amend her mark.⁵ Applicant has also requested that the recitation of services also be amended.

Amendment to Filing Basis

Applicant has renewed its request to amend the basis of her application from Section 1(a) to Section 1(b) of the Trademark Act. In support thereof, Applicant has provided a verified statement that "Applicant has a bona fide intention to use the mark in commerce on or in connection with the services of the subject application and that she has a bona fide intention to use the mark in commerce on or in connection with the services as of the application filing date."⁶ Applicant's verification is defective to the extent it fails to confirm a continuing valid basis since it only attests to Applicant's present bona fide intention and fails to attest that Applicant *had* a bona fide intention to use the mark in commerce as of the application filing date. *See* Trademark Rule 2.34(a)(2), 37 C.F.R. § 2.34(a)(2).

It is further noted that the application was approved for publication under Section 2(f) of the Trademark Act which is limited to "a mark used by the

³ 8 TTABVUE.

⁴ 9 TTABVUE.

⁵ 11 TTABVUE.

⁶ *Id.* at 14.

applicant.” Thus, by definition, prior use is required. Since Applicant, in connection with her proposed amendment to her mark, is seeking to substitute her claim of use with a claim of a bona fide intention to use in contravention of her claim of acquired distinctiveness, Applicant’s proposed amendment to the filing basis from Section 1(a) to Section 1(b) is unavailable.

Accordingly, the amendment to the filing basis is **DENIED**.

Amendments to Mark and Recitation of Services

Applicant has renewed her request to amend the mark involved herein from DEFINED BROW STUDIO to DEFINED BROW. To support this amendment to the mark, Applicant has offered the following amendment to the recitation of services in International Class 44 (additions bolded).

From: Beauty treatment services especially for eyebrows; Cosmetic and body procedures, namely, fibroblasting, micropigmentation, cavitation, and microblading; Cosmetic eyebrow care services in the nature of waxing, brow tint, henna, and ombré; Cosmetic skin care services, namely, waxing, facials, brow shaping, brow tints, brow lifts, and brow laminations; Cosmetic tattooing services; Eyelash services, namely, lash extensions, lash lifts, and lash perms; Face and body waxing services; Microblading being eyebrow tattooing services; Salon services, namely, brow and eyelash tinting, body waxing, facial waxing, makeup services, and makeup application services; Tattooing services; Tattooing and permanent makeup services; in International Class 44.

To: Beauty treatment services especially for eyebrows; Cosmetic and body procedures, namely, fibroblasting, micropigmentation, cavitation, and microblading; Cosmetic eyebrow care services in the nature of waxing, brow tint, henna, and ombré; Cosmetic skin care services, namely, waxing, facials, brow shaping, brow tints, brow lifts, and brow laminations; Cosmetic tattooing services; Eyelash services, namely, lash extensions, lash lifts, and lash perms; Face and body waxing services; Microblading

being eyebrow tattooing services; Salon services, namely, brow and eyelash tinting, body waxing, facial waxing, makeup services, and makeup application services; Tattooing services; Tattooing and permanent makeup services; **all of the foregoing offered in a beauty studio**; in International Class 44.

Although the proposed amendment to the recitation of services is limiting in nature as required by Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), the amendment does little to render acceptable Applicant's proposed amendment to the mark.

Under Trademark Rule 2.72, 37 C.F.R. § 2.72, a proposed amendment to the drawing of the mark cannot materially alter the mark. *See Paris Glove of Canada, Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1861 (TTAB 2007) ("Material alteration' is the standard for evaluating whether a change in the form of a registered mark is permissible."). An amendment to a mark constitutes a material alteration "if the old and new formats do not create the same general commercial impression." *Id.* This holds true whether the amendment seeks to add to or delete matter from a mark. *See In re CTB Inc.*, 52 USPQ2d 1471, 1476 (TTAB 1999) ("deletion of matter from a mark should be evaluated according to the same standard as a proposed addition to the mark"). Thus, "the touchstone for permissible amendments to the mark is that the mark retains the same overall commercial impression." *Id.* at 1473.

By proposing to amend the recitation of services to specify that the services are offered in a beauty studio, Applicant seeks to buttress her contention that STUDIO is nondistinctive matter such that its deletion does not constitute a material alteration of the mark as originally filed. In further support, Applicant has attached

third-party registrations for marks that include the term STUDIO in singular or plural form for Class 44 services in which the term has been disclaimed.

First, to the extent Applicant has provided third-party registrations to reinforce the nondistinctiveness of STUDIO relative to “beauty services in International Class 44,”⁷ they are of little probative value since the nondistinctiveness of the term STUDIO vis-à-vis Applicant’s services is not at issue. Rather, it is the overall commercial impressions of Applicant’s mark before and after the amendment that is salient to the material alteration inquiry.

Nevertheless, it is Applicant’s contention that STUDIO is merely “the generic or highly-descriptive *type* of physical location *where* the services are provided [which] does not affect a consumer’s recollection of *who* provides the services.”⁸ Although Applicant argues that “STUDIO is a separable element that is not connected in meaning to DEFINED or DEFINED BROW,”⁹ the claim is belied by Applicant’s prosecution of her own application wherein Applicant asserted a claim of acquired distinctiveness as to the entirety of the mark, thereby conceding the merely descriptive nature of the mark as a whole rather than a portion thereof, *see Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“in cases where registration was initially sought on the basis of distinctiveness, subsequent reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive”), and further

⁷ *Id.* at 6.

⁸ *Id.* at 8 (emphasis in original).

⁹ *Id.* at 6.

entered a disclaimer of BROW STUDIO, as opposed to just STUDIO¹⁰, underscoring the unitary nature of BROW STUDIO and undercutting Applicant's claim that STUDIO is a separable element. *See In re Med. Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (finding MEDICAL DISPOSABLES to be a unitary phrase that must be disclaimed as a whole); *In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm'r Pats. 1987) (finding that "[d]isclaimers of individual components of complete descriptive phrases are improper" and that "[u]nitary expressions should be disclaimed as a composite," request to enter separate disclaimers of GLASS and TECHNOLOGY, rather than a single disclaimer of GLASS TECHNOLOGY, denied).

Indeed, many of the third-party registrations provided by Applicant, wherein the mark consists of STUDIO immediately preceded by a term that identifies the type of studio, appear to show that STUDIO is not a separable, stand-alone element, *see, e.g.*, Registration No. 5718386 (disclaimer of LASH STUDIO); Registration No. 6133655 (disclaimer of SKIN STUDIO); Registration No. 6089537 (disclaimer of BODY ROLL STUDIO); Registration No. 6123641 (disclaimer of SKIN STUDIO); Registration No. 6173354 (disclaimer of HAIR STUDIO), and that the perception of STUDIO as a "generic or highly-descriptive" term is often as part of a unitary phrase that particularly describes the studio rather than in connection with the broad definition of "an artist's workroom" as referenced by Applicant. *See, e.g.*,

¹⁰ Applicant's claim in her motion that she "accept[ed] a disclaimer of exclusive rights in STUDIO apart from the applied-for mark as a whole" (11 TTABVUE 6) is a misstatement of the prosecution history. No such disclaimer was offered by the Examining Attorney for Applicant to accept. The disclaimer offered by the Examining Attorney and accepted by Applicant was one for BROW STUDIO.

Registration No. 5718386 (disclaimer of LASH STUDIO on Supplemental Register);
Registration No. 6193440 (disclaimer of EYELASH STUDIO under Section 2(f));
Registration No. 6549481 (disclaimer of BODY STUDIO on Supplemental Register).

That STUDIO is not a stand-alone, separable element but rather is unitary with the term or terms that immediately precede it such that the phrase, as a whole, serves to describe the type or nature of the studio is further reinforced by Applicant's additional examples which undercut her claim that STUDIO is merely generic or highly descriptive matter that is separable from the subject mark and can be deleted without consequence to the commercial impression of the mark. For instance, Applicant's reference to *In re Averi Skye Enterprise, LLC*, Serial No. 87830306 (TTAB June 22, 2020) (nonprecedential) concerns a disclaimer of WAXING STUDIO rather than STUDIO alone or individual disclaimers of WAXING and STUDIO. As such, the decision supports a claim that BROW STUDIO is unitary rather than that STUDIO is a separable element. Furthermore, to the extent Applicant relies on how the term "studio" is used in the Trademark ID Manual to support her claim that the term is generic or highly descriptive, Applicant's example of "Tattoo studios" again demonstrates that STUDIO, as used in Applicant's mark, is not a separable term. Moreover, a further review of the Trademark ID Manual shows that there is no service designated simply as "studio" to identify Applicant's services or any other service, which cuts against Applicant's claim that the term is merely a generic or highly descriptive designation that is separable from the mark.

Finally, the Board notes that Opposer has asserted a claim of likelihood of confusion based on a pleaded registration for BROW STUDIO in typed form for “beauty salon services, namely hair removal, dressing and styling” in International Class 44, that the mark is registered on the Principal Register without a claim of acquired distinctiveness, that Opposer has disclaimed BROW but not STUDIO, and that by virtue of the amendment proposed herein, the parties believe that the commercial impression of Applicant’s mark is sufficiently changed so as to avoid a likelihood of confusion with Opposer’s mark.

In view of these considerations, the Board remains of the position that Applicant’s proposed amendment to delete STUDIO from her mark constitutes a material alteration. Applicant’s renewed motion to amend the application is therefore **DENIED**.

Dates are **RESET** as follows:¹¹

Expert Disclosures Due	1/24/2023
Discovery Closes	2/23/2023
Plaintiff's Pretrial Disclosures Due	4/9/2023
Plaintiff's 30-day Trial Period Ends	5/24/2023
Defendant's Pretrial Disclosures Due	6/8/2023
Defendant's 30-day Trial Period Ends	7/23/2023
Plaintiff's Rebuttal Disclosures Due	8/7/2023
Plaintiff's 15-day Rebuttal Period Ends	9/6/2023
Plaintiff's Opening Brief Due	11/5/2023
Defendant's Brief Due	12/5/2023
Plaintiff's Reply Brief Due	12/20/2023
Request for Oral Hearing (optional) Due	12/30/2023

¹¹ Opposer’s consented motion to suspend for settlement (filed September 13, 2022), which was presumably filed pending the Board’s disposition of the motion, is noted and granted. In view of the Board’s determination of the motion herein, proceedings are resumed.

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). **The briefs should cite to the TTABVUE record created during trial by docket entry and page number—e.g., 8 TTABVUE 3—to facilitate the Board’s review of the evidence at final hearing. See TBMP § 801.03.** Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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