

This Opinion Is Not a
Precedent of the TTAB

Mailed: May 22, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Jessica Cosmetics International, Inc.

v.

Zen Spa Enterprises, Inc.
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Cancellation No. 92060934

Jay H. Geller of Jay H. Geller, APC for Jessica Cosmetics International, Inc.

Diego Murgia-Díaz and Christian Trinidad-De Jesús of Pietrantoni Méndez & Álvarez LLC for Zen Spa Enterprises, Inc.

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Before Thurmon, Deputy Chief Administrative Trademark Judge, Heasley and Johnson, Administrative Trademark Judges.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

Zen Spa Enterprises, Inc. (“Respondent”) owns the registered mark shown below



(with “SPA” disclaimed) on the Principal Register for “Health spa services for health and wellness of the body and spirit offered at a health resort” in International Class 44.¹ Jessica Cosmetics International, Inc. (“Petitioner”) seeks cancellation, alleging that Respondent’s mark “is merely descriptive and/or generic for the subject services.”² Petitioner has not proven its claim, and therefore, we deny the Petition to Cancel.

I. Petitioner Fails to State a Claim

The sole factual question Petitioner asks the Board to answer is whether the term ZEN SPA is generic.³ We will not answer that question, because to do so would be to issue an advisory opinion. Petitioner seeks cancellation of the composite mark shown

¹ Registration Number 3602491 registered on the Principal Register on April 7, 2009 based on an application filed on May 19, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The Registration also identifies “Physical fitness instruction and consultation” services in International Class 41, but those services are not involved in this proceeding for the reasons set forth below. The word SPA is disclaimed.

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

² 1 TTABVUE 4.

³ 102 TTABVUE 6. The Petition alleged merely descriptiveness and/or genericness, but a mark that has been registered for more than five years, as in this case, cannot be challenged for mere descriptiveness, or on the basis that the mark lacks secondary meaning. *See Park ‘N Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 658, 83 L. Ed. 2d 582, 224 USPQ 327, 331-332 (1985); *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532 (Fed. Cir. 1999).

In its Reply Brief, Petitioner argues, “The Board should amend the registration to cover Puerto Rico only.” 104 TTABVUE 6-7. We cannot provide such relief because “geographic limitations will be considered and determined only in the context of a concurrent use proceeding.” *Snuffer & Watkins Mgmt. v. Snuffy’s Inc.*, 17 USPQ2d 1815, 1815 (TTAB 1990) (citing Trademark Rules 2.99(h) and 2.133(c)).

above, which includes design elements and the literal element ZEN SPA. Petitioner acknowledges this point:

In the Petition to Cancel Petitioner alleged that the mark ZEN SPA is generic and, therefore, incapable of functioning as a trademark and must be canceled. The registration contains a design element that is irrelevant for purposes of consideration whether the term “zen spa” is generic for the services ...⁴

Petitioner gets the cart before the horse. The essential question in this case is not whether the literal element ZEN SPA is generic, but whether the mark as a whole is distinctive. If the design elements create a separate, distinctive commercial impression, then the mark is distinctive regardless of what the literal element means. *Montecash LLC v. Anzar Enters.*, 95 USPQ2d 1060, 1062-63 (TTAB 2010); *cf In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1570 (Fed. Cir. 1988) (“In deciding whether the design background of a word mark may be separately registered, ‘the essential question is whether or not the background material is or is not inherently distinctive ...’”) (quoting *In re E. J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958)).

The design elements for Respondent’s mark are separable and distinctive, as we explain in more detail below, making the mark distinctive. That is the end of the story. A finding that the term ZEN SPA is generic for Respondent’s services would result in no relief, and for that reason, we will not opine on that issue. The only possible consequence of a finding that ZEN SPA is generic would be a disclaimer, but

⁴ Petitioner’s brief, 102 TTABVUE 6.

that relief was not sought by Petitioner⁵ and would not be available if it had been sought. *See Montecash*, 95 USPQ2d at 1065 (“by seeking entry of a disclaimer for a purportedly generic term that forms part of a mark that is not generic in its entirety, and that has resided on the Principal Register for more than five years, [petitioner] has failed to state a claim upon which the Board will grant relief.”); *see* 3 McCarthy on Trademarks and Unfair Competition § 20:44 (5th ed. March 2020 update) (in *Montecash* “[t]he Board held that a claim for restriction under Lanham Act § 18, 15 U.S.C.A § 1068 of a registration over five years old cannot ask for a disclaimer of an alleged generic part of a composite mark which is not generic in its entirety.”); *see generally* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 309.03(d) (2019).

A. The Design Elements Create a Separate, Distinctive Commercial Impression

Whether design elements of a composite mark create a separate, distinctive commercial impression “is necessarily a subjective matter which must be determined based on a viewer’s first impression.” *In re Sadoru Group*, 105 USPQ2d 1484, 1486 (TTAB 2012) (citations omitted). The Board in the *Sadoru Group* case found the mark shown below did not “create a separate and inherently distinctive commercial impression apart from the word itself.” *Sadoru Group*, 105 USPQ2d at 1490.

The image shows the word "SADORU" in a bold, black, stylized font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The 'S' is particularly large and prominent. The word is centered horizontally.

⁵ 1 TTABVUE 4-5 (no claim presented under Section 18 of the Trademark Act).

The Board noted that the letters were “not of uniform thickness,” and the tops of the letters “give the upper portion of the mark a slightly concave shape ...” *Sadoru Group*, 105 USPQ2d at 1489. These design elements were not enough to create a separate, distinctive impression on consumers, the Board found.

In reaching this conclusion, the Board reviewed a number of prior decisions involving the same issue. We present some of the results of that review in the table below. *Sadoru Group*, 105 USPQ2d at 1486-88, 1489-90.

Separate, Distinctive Impression	No Separate, Distinctive Impression
	
	
	

⁶ This entry and the two below it were not involved in Board proceedings, but were registered on the Principal Register with the literal elements of each mark disclaimed, but without a showing of acquired distinctiveness. *Sadoru Group*, 105 USPQ2d at 1489-90. The Board placed less weight on these registrations than on marks considered by the Board or a court. We include them for sake of completeness.

	
	
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We find the design elements in the mark at issue here, and shown again below,



create a separate, distinctive commercial impression from the term ZEN SPA. There are at least three different design features in the mark. The most striking is the

⁷ *Sadoru Group*, 105 USPQ2d at 1487. In the LITE mark case, the Board found the design elements of the mark shown above “were not of such a nature that they would serve to distinguish applicant’s mark in its entirety.” The mark was registered upon a showing of acquired distinctiveness. See *In re Miller Brewing Co.*, 226 USPQ 666, 669 (TTAB 1985).

outlined image of a person seated in the lotus position.⁸ The words ZEN SPA are presented in a stylized font, and the word SPA appears within a solid, black bar. The word ZEN is larger than the word SPA, which might be perceived as a fourth design element. These elements, taken together, create a separate, distinctive commercial impression.

We need not determine whether the design elements of this mark are inherently distinctive or have acquired distinctiveness.⁹ The only possible basis for cancellation advanced by Petitioner is genericness. Because the design elements create a separate commercial impression, Petitioner must show that these elements are generic to prevail. Petitioner has presented no evidence or argument to support such a finding.

Petitioner's claim is similar to a claim we dismissed in the *Montecash* case, which involved the mark shown below.



The Board stated, “It is clear that respondent’s mark, composed of a design element combined with the term MONTEPIO, is not generic as a whole. Indeed, petitioner

⁸ The mark is described as “consist[ing] of Drawing of a human figure in a seated, lotus position, words ‘Zen Spa’ written below the sitting figure.” Registration No. 3602491.

⁹ Though such a finding is not necessary, for sake of completeness, we find the design elements of Respondent’s mark are inherently distinctive.

only asserts that a portion of the mark, MONTEPIO, is a generic term.” *Montecash LLC*, 95 USPQ2d at 1062-63. The same is true in the present case. The registered mark is not ZEN SPA. The mark consists of the design elements noted above **and** the literal element ZEN SPA. Petitioner here, just like the petitioner in the *Montecash* case, fails to state a claim.

The distinctiveness of the design elements of Respondent’s mark falls somewhere between the mark at issue in the *Montecash* case and the designs shown in the left column of the table above. Respondent’s mark includes a clearly separate element of the image of the person in the lotus position. The other design elements relate to the font, the sizing, and the background of the literal elements, and in that sense, are similar to the marks the Board reviewed in the *Sadoru Group* case (i.e., the marks in the left column of the table). With the separate image and the other text-related design elements, Respondent’s mark is distinctive regardless of what the words ZEN SPA mean.

B. The Distinctiveness of the Entire Mark Is Before Us

Petitioner also cites *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1640 (Fed. Cir. 2016), where the court stated, “The stylized nature of the mark cannot save it from ineligibility as generic.” The mark at issue in the *Cordua Restaurants* case is shown below.

Churrascos ¹⁰

The court affirmed a finding by the Board that the word CHURRASCOS was generic for the applicant's services.

Three important points must be noted about the *Cordua Restaurants* case. First, "Cordua did not argue before the Board and does not argue now that this stylization creates a separate impression" *Id.* at 1639-40. *Cordua Restaurants* was an ex parte appeal, there was no adversary. Petitioner raised the issue here, as illustrated by the following argument.

Adding stylization to descriptive or generic wording does not render the resulting mark registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself, or the applicant can otherwise show by evidence that the particular stylized display has acquired distinctiveness.¹¹

This is a cancellation proceeding and Respondent's mark is presumed valid. Petitioner bears the burden of proving the mark lacks distinctiveness, and therefore, it is Petitioner that must show the entire mark is generic.

Second, the Board addressed the issue in the *Cordua Restaurants* case even though the applicant did not. The Board found "the display of Applicant's mark, consisting primarily of stylized letters, does not make the applied-for matter

¹⁰ Application Serial No. 85214191.

¹¹ 102 TTABVue 8.

registrable, despite the genericness of the term CHURRASCOS, since it does not create a separate commercial impression over and above that made by the generic term.” *Cordua Rests.*, 110 USPQ2d 1227, 1232 (TTAB 2014) (citing *Sadoru Group*), *aff’d*, 118 USPQ2d 1632.

Third, the design elements in Respondent’s mark are more distinctive than the stylized lettering of the mark in the *Cordua Restaurants* case. The separate image of the person in a lotus position in Respondent’s mark distinguishes it from the CHURRASCOS mark and the other marks shown in the table above that include only stylized lettering.

Finally, we note that every case must stand on its own. As the court explained in the *Cordua Restaurants* case, “we must evaluate the evidence in the present record to determine whether there is sufficient evidence to establish that it is ineligible.” *Cordua Rests.*, 118 USPQ2d at 1635. We find, on the record before us, that Respondent’s mark is distinctive. Petitioner failed to prove its claim.

Decision: The Petition to Cancel is Denied.