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Paper No. 15
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shiseido Company, Ltd.

Serial No. 75/980,951

Howard N. Aronson of Lackenbach Siegel for Shiseido Company, Ltd.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Cissel, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On January 6, 1999, Shiseido Company, Ltd. filed an application, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), to register the mark SUCCESSFUL AGING on the Principal Register for the following services, as amended:

“educational services, namely, seminars, practical training in the form of educational demonstrations, academies, colloquiums, symposiums, and conferences all in the field of health, beauty, personal care and nutrition; education in the field of health, beauty, personal care and nutrition rendered through correspondence

courses; organizing exhibitions in the field of health, beauty, personal care and nutrition; arranging and conducting athletic competitions; and teaching in the field of health, beauty, personal care and nutrition" in International Class 41; and

"beauty salons, hairdressing salons, providing fashion information, health care, physical therapy, cosmetics research and food nutrition consultations" in International Class 42.¹

The Examining Attorney refused registration on the ground that the term SUCCESSFUL AGING, when used in connection with the identified services, is merely descriptive of the services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Preliminarily, we will address evidentiary matters. First, the Examining Attorney requested in her brief that the Board take judicial notice of the dictionary definitions of "successful" and "aging" which she attached

¹ The original application also included various soaps, perfumes, cosmetics, and skin care and body care products in International Class 3. Upon applicant's request that the Class 3 goods be divided out, the Office created a divisional application. Applicant's Class 3 goods remain in the parent application Serial No. 75/616,106, which the Examining Attorney has approved for publication.

thereto. The request is granted. See TBMP §712.01, and the rules and cases cited therein.

Second, applicant attached to its brief photocopies of (i) dictionary definitions, and (ii) several third-party registrations, the latter of which were objected to by the Examining Attorney as untimely filed. The Board takes judicial notice of the dictionary definitions. However, the third-party registrations are untimely. See Trademark Rule 2.142(d) and TBMP §1207. Applicant's request for a suspension and remand for consideration of the third-party registrations was denied by the Board. Applicant's reply brief included a second request for a remand, which was also denied by the Board. For clarity of the record, the Board notes that we have not considered applicant's untimely submissions of third-party registrations.

The Examining Attorney contends that the term SUCCESSFUL AGING "is descriptive of ways to enhance longevity, well being and quality of life for the elderly through health, nutrition, keeping active and maintaining a positive outlook on life," and thus, applicant's mark is "descriptive of educational and health related counseling services in which the subject matter of the services pertains to 'successful aging.'" (Final Office action, p. 2.) Specifically, the Examining Attorney contends that the

term SUCCESSFUL AGING is merely descriptive of these services as it is the featured subject matter of the services, or it is a major purpose of the services, or it is the result intended to be attained through the services. (Brief, p. 4.)

Applicant contends that the term "SUCCESSFUL AGING" includes a multitude of facets and connotations, (e.g., longer life, happier life, healthy old age, simply reaching old age) with no specific one being predominant to the ordinary consumer; that the consumer must use a multi-stage reasoning process to conclude that applicant's services lead to "successful aging"; that the words are an incongruous coupling of a positive word with a negative word; that there is nothing about the mark taken as a whole which would enable potential purchasers to immediately understand the precise nature of applicant's services; and that the mark is at most, suggestive, not merely descriptive, of applicant's services.

It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." (Emphasis added). In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of

particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978). See also, In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991. As the Court stated in In re Abcor Development, supra: "Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.'" See also, In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

Viewing this record in its entirety, we find that the Examining Attorney has not established a prima facie showing that the mark SUCCESSFUL AGING is merely descriptive of applicant's various identified services, such as, educational services, conducting athletic competitions, beauty salon services, hairdressing salon

services, and food nutrition consultations. The excerpted stories retrieved from the Nexis database and submitted by the Examining Attorney² show the words have several different connotations, such as the following:

- (1) "Successful aging means being a futurist (taking a long-view) and being flexible," The Futurist, May 1, 1999;
- (2) "...She also admits she's quite happy. That's because she's learned the first rule of successful aging -- stay busy," Chicago Tribune, February 13, 2000; and
- (3) "...keeping socially active, not just active, is the key to successful aging, according to a finding released in a recent issue of The Journal of Applied Genealogy," The Fort Worth Star-Telegram, December 6, 1999.

Thus, in connection with applicant's services, the mark does not readily and immediately evoke an impression and an understanding of the specific nature of applicant's various

² Several of the approximately 25 excerpted stories were from wire services or foreign publications. Wire service articles are of limited probative value in assessing the reaction of the public to the term applicant seeks to register because evidence from a proprietary news service is not presumed to have circulated among the general public. With regard to foreign publications, they are of little probative value because it cannot be assumed that foreign uses had any material impact on the perceptions of the public in the United States. See *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992).

Finally, a few of the excerpted stories were of such limited scope that it is difficult to draw any conclusions therefrom.

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identified services. See *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987); *In re TMS Corporation of America*, 200 USPQ 57 (TTAB 1978); and *In re Silva Mind Control International, Inc.*, 173 USPQ 564 (TTAB 1972).

Moreover, the mark SUCCESSFUL AGING is somewhat incongruous with "aging" (i.e., the concept of growing older) having a slightly negative connotation, while "successful" has a clearly positive connotation. Applicant's mark is the juxtaposition of two common words, which is creative, and has not been shown to be merely descriptive. See *In re Shutts*, 217 USPQ 363 (TTAB 1983).

On this record, we conclude that the mark SUCCESSFUL AGING, when considered in connection with the services set forth in the application, requires a degree of perception and a multi-stage thought process to determine the nature of any particular characteristics or features of applicant's services.

Decision: The refusal to register under Section 2(e)(1) is reversed.