

**THIS DISPOSITION IS
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lancetti Cosmetics d/b/a Prestige Cosmetics

Serial No. 76438105

Myron Amer of Myron Amer, P.C. for Lancetti Cosmetics d/b/a
Prestige Cosmetics.

Midge F. Butler, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lancetti Cosmetics d/b/a Prestige Cosmetics seeks
registration on the Principal Register of the mark **LIP
CONCENTRATE** (*in standard character format*) for goods
identified in the application as "lip color, lip gloss, lip
pencils [and] lipliner pencils" in International Class 3.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this designation under Section 2(e)(1) of the

¹ Application Serial No. 76438105 was filed on August 5, 2002
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce.

Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "lip concentrate" immediately informs potential purchasers about the nature of applicant's goods.

Applicant and the Trademark Examining Attorney have each filed briefs on the issues involved in this appeal.

We affirm the refusal to register.

Preliminary matter

Applicant's entire "reply brief" consists of the following:

Applicant stands on its APPEAL BRIEF.

In addition, applicant files the within Amendment to allege use pursuant to 37 C.F.R. § 2.76, and requests that this application be amended to seek registration on the Supplemental Register.

Having taken the position that its mark is not merely descriptive, applicant is permitted to take the alternative position that the mark is, in any event, registrable on the Supplemental Register. TBMP § 1206.01 (2d ed. rev. 2004); and TMEP § 1212.02(c).

However, inasmuch as applicant is not backing off the arguments in its main brief on appeal, the position of its reply brief would appear to be little more than an alternative position (without being explicitly stated) at

final hearing in the event the Trademark Examining Attorney's refusal on the Principal Register is affirmed.

The record and the issues to be considered in an *ex parte* appeal must, at some point, be concluded. Fairness herein does not demand that we permit applicant to avoid an adverse determination on the only issue litigated, namely, mere descriptiveness, by countenancing an alternative amendment to the Supplemental Register filed with the reply brief.

Even at this late date, had applicant requested an unequivocal amendment to the Supplemental Register, we may well have chosen, as would be within our discretion, to remand for a consideration of this issue. This was not done.

Accordingly, given our § 2(e)(1) determination, *infra*, that is adverse to applicant, we will not consider applicant's alternative amendment to the Supplemental Register filed at such a late juncture of the appeal, and the proffered amendment to allege use is hereby moot. See TBMP § 1206.01 (2d ed. rev. 2004).

Refusal under Section 2(e)(1) of the Act

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1)

of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service."]. Hence, the ultimate question before us is whether the term **LIP CONCENTRATE** conveys information about a significant feature or characteristic of applicant's goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely

descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor*, supra at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB

1990) [NEW HOME BUYER'S GUIDE

merely descriptive of "real estate advertisement



services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to

consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Omaha

National Corp., 819 F.2d 1117,
2 USPQ2d 1859 (Fed. Cir. 1987)



[the term "first tier" describes a class of banks]; In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

The Trademark Examining Attorney herein argues that "the term CONCENTRATE, when used as a noun, is defined as 'a product that has been reduced in volume or bulk by the removal of liquid.'" She has placed into the record copies of web pages demonstrating that the term "lip concentrate"

is commonly used in the cosmetic industry to describe a product used on the lips that has been reduced in volume or bulk by the removal of liquid.

While applicant concedes that lip color and lip gloss have a fluid content and, thus, might technically be subject to a reduction in volume by the removal of liquid, applicant contends that while "the words 'lip concentrate' appears [sic] in trade literature," they are not used "in reference to either 'lip color' *per se* or to 'lip gloss' *per se*."

We turn then to look at the evidence the Trademark Examining Attorney has placed into the record.

Yves Saint Laurent Parfums Eye & Lip Concentrate²

Youthful Lip Concentrate

A powerful concentrate to compliment Youthful Lip Cream, abundant in smoothing and rejuvenating Retinol, this serum glides over the lip area rendering it smoother and plumper.

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Chen Yu Biolia Anti-Wrinkle Eye & Lip Zone – A special eye & lip concentrate ...⁴

Orlane-Paris, Line Reducing Lip Care (Energizing Concentrate)⁵

IHB Excellence #11 Lip and Eye Concentrate with Retinol⁶

Hydra Complete – Multi-Level & Concentrate for lip⁷

² <http://www.saksfifthavenue.com/main/> and <http://perfumebay.com/>

³ <http://www.pevoniacom.au/b-prod-lip.htm> and www.dayspaescape.com/

⁴ <http://www.cosmeticmall.com/>, <http://www.edirectory.co.uk/> <http://www.mr-shopping.net/shop/Cosmetics-Fragrance/Skincare/> and www.strawberrynet.com/

⁵ <http://www.tanaz.com/>

⁶ <http://www.excellenceskin.com/>

⁷ <http://www.dealdawg.com/>

Aveda Lip Color Concentrate⁸

Lisse Expert Eye & Lip Anti-Wrinkle Concentrate⁹

Watkins Marine Lip Concentrate: a source of Omega-3 fatty acids, which are necessary for the body's production of biochemical[s] which help to maintain the health of skin, hair and nails.¹⁰

As noted earlier, in analyzing mere descriptiveness, we must consider the mark as applied to the specific goods identified in the application. Based on this record, we are comfortable finding that each of the terms "lip" and "concentrate" is descriptive when applied to applicant's products such as lip color and lip gloss. Specifically, all of applicant's identified products are clearly applied to ones "lips." Applicant acknowledges that its lip color and lip gloss have a fluid content and thus, might technically be subject to a reduction in volume by the removal of liquid.

We also find that these individual words do not somehow lose this descriptiveness in the combination **LIP CONCENTRATE**. While a combination of words may be registrable if it creates a unitary mark with a unique, nondescriptive or incongruous meaning, in this case each

⁸ *Id.*; www.clothingcellar.com/

⁹ <http://www.mr-shopping.net/shop/Cosmetics-Fragrance/Skincare/>

¹⁰ <http://www.18hrwk.com/>

component of applicant's mark **LIP CONCENTRATE** retains its descriptive significance when used in the combination, and the combination as a whole is also merely descriptive of applicant's goods. When applied to lip color and lip gloss, there is nothing which would require the exercise of imagination, cogitation or mental processing or necessitate the gathering of further information in order for the merely descriptive significance of the term to be readily apparent to consumers of applicant's goods, namely that the product, in a concentrated form, is for use on the lips.

Accordingly, we find that the term **LIP CONCENTRATE**, when used in connection with lip color and lip gloss, would be merely descriptive of the nature of the goods, as contemplated under Section 2(e)(1) of the Act. The record also demonstrates, as contended by the Trademark Examining Attorney, that the term "lip concentrate" is used in the cosmetic industry to describe a variety of cosmetic and restorative products used on the lips that have been reduced in volume or bulk by the removal of liquid. These uses in the trade that the Trademark Examining Attorney found on the Internet buttress her claim - even if many of these products are in the nature of anti-wrinkle or anti-aging products to smooth the texture of the lips, rather than products

designed for appearance - to color ones lips or to make them shine.

Finally, even if applicant had been the first and/or only entity to use the term "Lip Concentrate" for such goods (which it is not), this fact would not be dispositive [*In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969); and *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998)] where, as here, the term unequivocally projects a merely descriptive connotation. See *In re Polo International Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999); and *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994).

In any case, the several uses in the record of "AVEDA Lip Color Concentrate" demonstrate that at least one of applicant's competitors was using a substantially similar term in a highly descriptive, if not generic manner, on lip color products prior to applicant's first claimed use during July 2006. Similarly, we find that yet other merchants and manufacturers in the cosmetic trade would certainly have a competitive need to use this term on such goods. See 2 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:18 (4th ed. 2001).

Decision: We find the well-crafted arguments of the Trademark Examining Attorney to be most convincing, and

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hence, her refusal to register this mark on the Principal Register based upon Section 2(e)(1) of the Lanham Act is hereby affirmed.