

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

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lancôme Parfums et Beaute & Cie

Serial Nos. 78560833 and 78621768

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Janofsky & Walker LLP for Lancôme Parfums et Beaute & Cie.

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Before Quinn, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lancôme Parfums et Beaute & Cie seeks registration on
the Principal Register of the mark **RESURFACE C-DERMABRASION**
for goods identified in the applications as follows:

"cosmetics, namely, creams, gels, milks,
lotions and powders for the body" in
International Class 3;¹ and
"cosmetics, namely, creams, gels, milks,
lotions and powders for the face, the body and
the hands" in International Class 3.²

¹ Application Serial No. 78560833 was filed on February 4, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Application Serial No. 78621768 was filed on May 3, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

These cases are now before the Board on appeal from the final refusals of the Trademark Examining Attorney to register this designation based upon applicant's failure to comply with the requirements of the Trademark Examining Attorney for disclaimers of the term "Resurface" apart from the mark as shown pursuant to Section 6 of the Act, 15 U.S.C. § 1056, on the ground that it is merely descriptive as applied to applicant's goods under Section 2(e)(1) of the Act. 15 U.S.C. § 1052(e).

The marks, the legal issues, the procedural histories, the overall records and the appeal briefs are nearly identical in these two appeals. Accordingly, these cases are considered together and determined in a single opinion. We affirm both refusals to register.

Is term merely descriptive?

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 "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) [ASPIRINA is merely descriptive of analgesic product]. See also *In re Gyulay*, 820 F.2d 1216,

3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980) [QUIK-PRINT is merely descriptive of "same day" services of printing, photocopying, collating, binding, cutting, drilling, folding, padding, stapling, and perforating]. To be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009. Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. 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 Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"; "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"].

The proper test in determining whether a term is merely descriptive is to consider the applied-for 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]. Hence, the ultimate question before us is whether the term **RESURFACE** 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. "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)

In re Gyulay, 3 USPQ2d at 1009]; *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].

In arguing for registrability, applicant contends that the "Resurface" portion of this mark is not merely descriptive inasmuch as the Trademark Office has already determined that the term "Re-surface" is not merely descriptive of applicant's goods; that the term "Resurface" does not immediately or directly describe applicant's goods; that the term "Resurface" is not merely descriptive because it connotes different things to different people while creating one or more of several different commercial impressions; that the authorities cited by the Trademark

Examining Attorney do not support a disclaimer requirement; and that the Trademark Examining Attorney has failed to accord substantial weight to the legal effect of applicant's incontestable registration for **RE-SURFACE**.

On the contrary, the Examining Attorney argues that the term "resurface" describes the purpose of the creams, gels, milks, lotions and powders; that various website entries demonstrate that the term "resurface" is being used in a merely descriptive manner by cosmetic companies to describe skin care products and techniques that change the surface of the body part to which they are applied and/or the effect that the cosmetic products will have on the skin.

The Record

We first turn to take a closer look at the evidentiary record. Applicant itself appears to use the word "Resurface" in a merely descriptive manner:

RESURFACE PEEL
Resurfacing and Soothing System
8% Glycolic Acid & 5% Physio-Peel
Enhancer™
Experience Resurface Peel, a safe and
effective at-home peel with 8% Glycolic
Acid & 5% Physio-Peel Enhancer™.

The Trademark Examining Attorney also placed into the record a variety of third-party uses of the terms "resurface" and "resurfacing" in the context of skin care treatments and

creams. These are drawn from websites directed to providing medical information and to marketing cosmetic products:

Dermabrasion

Dermabrasion removes the top layers of skin to **resurface** the texture of your skin. A rapidly rotating instrument is used to "sand" the outer layers...³

Dermabrasion and Microdermabrasion

Everyone would like the fresh-faced look of youthful glowing skin, and one of the many dermatological techniques used to **resurface** and revitalize the skin is dermabrasion. By scuffing or abrading the skin with tiny particles, the old layer of skin is removed to reveal new skin underneath. Less harsh than chemical peels and laser skin treatment, microdermabrasion is used to reduce wrinkles, lines, blemishes, uneven skin tone, and to improve acne, facial scars and to remove pre-cancerous growths. Dermabrasion is favored over chemical peels in the treatment of acne.

Microdermabrasion is a lighter form of dermabrasion known as the "lunchtime facial," and removes only the topmost layer of skin to reveal fresh skin underneath. While microdermabrasion may not produce the dramatic results of laser resurfacing, there is no recovery time after the microdermabrasion procedure. There may be redness after the treatment; however, most patients are able to return to work immediately. Before you come to a decision about skin **resurfacing**, think carefully about your options and discuss your questions during a consultation with a qualified professional.

Procedure

The dermabrasion and microdermabrasion procedures can both be conducted in an outpatient facility like a doctor's or dermatologist's office. Both procedures usually take from 15 minutes to one hour depending on the extent of the procedure and area to be covered. The doctor will progress by covering your hair and eyes and numbing the skin with spray or injected anesthetic. You may receive an oral sedative for more in-depth treatments. For dermabrasion, the deeper abrasive treatment, a doctor will use a hand held rough wire brush or a sanding wheel containing diamond particles to scrape away the affected portion of the skin surface. The effects of dermabrasion are more dramatic than those of microdermabrasion because the hand held tool does touch the skin. The microdermabrasion procedure is milder and less invasive than total dermabrasion because the skin is essentially sprayed away using micro particles. Your doctor will use a hand held device to spray tiny aluminum oxide crystals against your skin as debris is suctioned away. The results are subtler and recovery time is greatly reduced.

....⁴

SHORT-PULSED CARBON DIOXIDE LASER RESURFACING OR THE WRINKLE LASER

³ <http://www.mayoclinic.org/plasticsurgery-sct/dermabrasion.html>

⁴ <http://www.cosmeticsurgeryinsider.net/>

Introduction:

The lay press and popular news has been devoting an inordinate amount of attention to a new medical device which reportedly is the latest surgical "fountain of youth." The rapidly-pulsed carbon dioxide lasers, of which there are a number of competing brands, work by burning or vaporizing the skin very quickly minimizing damage to skin or tissue that is not specifically being targeted. These devices, particularly in combination with computerized pattern generators, allow very precise delivery of the laser light in geometric patterns and are being used in the place of older methods to rejuvenate or **resurface** the skin, such as dermabrasion or chemical peels. They do offer distinct advantages and, as we are finding out, some distinct disadvantages over the old methods.

The use of such lasers to **resurface** the skin was originally conceived of and implemented by a dermatologist who had used older generation carbon dioxide lasers for various cosmetic and noncosmetic procedures. At the annual meeting of the American Society for Dermatologic Surgery (ASDS) held in May 1996 numerous papers were presented concerning the various uses for this truly remarkable device as well as its potential misuses.⁵

Don't be skinned alive - choose professional skin treatments

If you're thinking about cosmetic or dermatological procedures, be careful. What you see isn't always what you get. A number of people have harmed, disfigured or scarred from what should have been relatively risk-free dermatological work.

...

A guide to skin treatments

Although treatment for skin cancer remains the most requested procedure, the following treatments are also among the most popular:

- **Dermabrasion:** This involves the use of an abrasive instrument to mechanically "sand" or **resurface** the skin, achieving a rejuvenated, more youthful appearance. It is often used to treat substantial scarring, sun damage and pigmentation problems. ..⁶

Laser Skin Resurfacing

Skin **resurfacing** can produce some of the most wonderful changes for skin problems including wrinkles, scars, pigment irregularities, sun damage and poor complexion. Unfortunately, there is a lot of confusion among patients as to what type of **resurfacing** procedure is necessary to accomplish the desired improvement. There are a lot new procedures being advertised and many are promising the world with no downtime. In some situations, these claims are valid, in others they are not. When it comes to wrinkles, scars, and advanced sun damage, only true **resurfacing** procedures will accomplish the goals of most people.

To simplify matters, skin **resurfacing** is best categorized by depth of resurfacing: ultra-superficial, superficial, medium, and deep. There are three basic means to **resurface** skin: laser, dermabrasion, and peel with each capable of **resurfacing** at any depth. The degree of improvement is directly related to the depth of **resurfacing**, as is the time of recovery.⁷

⁵ <http://www.medquestltd.com/articles/article28.html>

⁶ <http://www.health24.com/antiageing/Quinmax/3685-3690.asp>

⁷ http://www.dr-apo.com/laser_skin.php



Skin resurfacing

Skin resurfacing employs a variety of techniques to change the surface texture and appearance of the skin. Common skin **resurfacing** techniques include chemical peels, dermabrasion, and laser resurfacing.

Skin **resurfacing** procedures may be performed for cosmetic reasons, such as diminishing the appearance of wrinkles around the mouth or eyes. They may also be used as a medical treatment, such as removing large numbers of certain precancerous lesions called actinic keratoses. Physicians sometimes combine techniques, using dermabrasion or laser **resurfacing** on some areas of the face, while performing a chemical peel on other areas.

Laser **resurfacing** is the most recently developed technique for skin **resurfacing**. Specially designed, pulsed CO2 lasers can vaporize skin layer-by-layer, causing minimal damage to other skin tissue. Special scanning devices move the laser light across the skin in predetermined patterns, ensuring proper exposure. Wrinkling around the eyes, mouth, and cheeks are the primary uses for laser **resurfacing**. Smile lines or those associated with other facial muscles tend to reappear after laser **resurfacing**. Laser **resurfacing** appears to achieve its best results as a spot treatment; patients expecting complete elimination of their wrinkles will not be satisfied.

Antiviral medications should be started several days before the procedure. Laser **resurfacing** is performed under local anesthesia. An oral sedative may also be taken. The patient's eyes must be shielded, and the area surrounding the face should be shielded with wet drapes⁸

drknighton.com

Providing services for a happier, healthier you!

**DIAMOND
DERMABRASION**

The gentle way to a younger complexion

Why choose Medical Diamond Dermabrasion™ (Turbo) over conventional microdermabrasion?

Medical Diamond Dermabrasion (Turbo) has the ability in one treatment to correct and improve the skin to a level that it would take four conventional microdermabrasion treatments. Simply put, why pay more money when in reality you get less. The Medical Diamond Dermabrasion (Turbo) has the ability to **resurface** many skin conditions ...

WHAT we're accomplishing with microdermabrasion is not only removing some of the damaged skin but stimulating new cell growth as well.

Research has shown that repetitive, superficial abrasions can create significant new cell growth. Microdermabrasion [allows] patients to gradually **resurface** their skin without the downtime and risk of more aggressive procedures.

Mark Rubin, MD ⁹

⁸ <http://skin-care.health-cares.net/skin-resurfacing.php>

Dermabrasion Information and Background Background Information

Dermabrasion, Dermasanding or Dermaplaning is a surgical procedure that has been performed since the late 1950's. It is another example of a treatment, which aims to "**resurface**" the skin. It is similar in its aim to lasers or chemical peels, but uses a machine to remove the outer layer of the skin or epidermis and then the top third part of the dermis of the skin.

In recent years, the use of this particular form of skin treatment has declined as chemical peels and lasers have become more popular. A milder form of dermabrasion, known as **microdermabrasion**, has become very popular recently.....¹⁰

Exuviance Skin Healthy Home Resurfacing Peel System

Description Exuviance Skin Healthy Home **Resurfacing** Peel System - Easy to use 4 step (cleanse, peel, neutralize, moisturize) home regimen system that will improve the appearance of dull, lifeless, sun-damaged skin. This system brings back your skin's healthy appearance **by exfoliating** (or **resurfacing**) the dead, dull surface layers of the skin and stimulating the process of cell renewal to bring new, fresh skin cells to the surface. Simply **resurface** your skin with the peel once or twice a week and follow-up daily with the skincare regimen for optimal "skin healthy" benefits. Ideal for face, chest and back of hands where exposure to the environment usually shows the signs of aging...¹¹

Organic Skin Resurfacing Cream

Skin **resurfacing!** Organic **resurfacing skin cream**, a natural alternative to laser resurfacing skin. A unique blend of ancient Indian skin resurfacing, organic medicinal herbs and organic herb and fruit acids. **Resurface** your skin as an anti-aging skin care treatment ...¹²

Las Colinas Vitamin C Infusion Cream 10% Anti Aging Skin Care

Las Colinas Vitamin C Infusion™ 10% contains 10% bio-available L-Ascorbic Acid suspended in a co-polymer matrix. This vitamin C infusion formula is a super intensive treatment for your deeper lines and wrinkles that do not respond to other anti-aging products on the market. This crème is concentrated and it does not require refrigeration and will not discolor. A wonderful and powerful antioxidant. L-Ascorbic Acid is efficiently delivered to your problem areas. This is what your skin needs to fight and also helps reverse the damaging and aging effects of free radicals that you get from sun exposure, environmental toxins, stress and other daily activities. It is oil free. Vitamin C Infusion™ helps to tremendously improve dermal re-collagenation and to **resurface** skin with accelerated cellular turnover...¹³

⁹ www.drknighton.com/diamond_questions.htm

¹⁰ [http://www.consultingroom.com/Treatment%5FFAQs/Display.asp?Treatment Fags ID=33&Treatment Name=Dermabrasion](http://www.consultingroom.com/Treatment%5FFAQs/Display.asp?Treatment%20Faq%20ID=33&Treatment%20Name=Dermabrasion)

¹¹ <http://www.skinelite.com/exuv-037.html>

¹² <http://www.products skincare.com/>

¹³ <http://www.stuff4beauty.com/catalog.php?category=Las%20Colinas%20Vitamin%20C%20Infusion%20Cream%20%20Anti%20Aging%20Skin%20Care>

La Prairie Night Care - Cellular -

Microdermabrasion Cream (Intensive Resurfacing Treatment Face & Body) 125ml/4.2oz¹⁴

Youthful Essence Resurfacing Tool and Sponge Kit by Susan Lucci¹⁵



Rapid Resurface

Rapid Resurface Micro-dermabrasion at its best? Featuring a totally aluminum-free formula, gently, yet effectively, polish skin to perfection in minutes...¹⁶



Epidermal Re-Texturizing Micro-Dermabrasion

The formula contains two highly effective skin-sloughing ingredients: a skin-polishing silica (micronized shells – referred to scientifically as “Diatomaceous Earth” and micro-dermabrasion crystals.”). The two particles compliment one another, enhancing their ability to thoroughly, yet safely eliminate the dead cells located in the epidermis – or upper layer of the skin. Our formula **resurfaces** these superficial layers of skin and further enhances cell renewal at the skin-surface level. The two particles compliment one another, enhancing their ability to thoroughly, but safely eliminate the dead cells located in the upper layer of the skin. Combined, they work to **resurface** these superficial layers of skin and further enhance cell renewal at the skin surface level.¹⁷

Crystal Peel, \$35.00

Crystal Peel is state of the art technology in skin care. It is the first and only Clinical Microdermabrasion Program designed for home use. Crystal Peel is an intensive process that can be an adjunct to the Microdermabrasion treatment in the skin care specialist's office, or simply by itself. Will gently and progressively **resurface** the skin to reduce fine lines, erase skin discoloration and freckles, and to refine enlarged pores. Excellent to use before applying anti-wrinkle products or Vitamin C for deeper penetration. The treatment also controls acne by gently removing the restrictive top layers of skin that traps dirt. Crystal Peel, by creating a controlled abrasion, stimulates the production of new collagen, which is key to maintaining skin's elasticity and tone.¹⁸

¹⁴ http://www.bizrate.com/skincareproducts/products_keyword--resurfacing.html

¹⁵ *Id.*

¹⁶ <http://www.leafandrusher.com/browseproducts/Rapid-Resurface.html>

¹⁷ <http://www.kiehls.com/us/en/face/epidermal-re-texturizing-micro-dermabrasion.htm>

¹⁸ <http://www.makemeheal.com/mmh/product/microdermabrasion/index.vm?procid=34>

In response to this Internet evidence, applicant argues that the term "Resurface" falls short of describing applicant's goods with the requisite degree of particularity. *In re TMS Corporation of the Americas*, 200 USPQ 57, 58 (TTAB 1978) [THE MONEY SERVICE not descriptive of "financial services"]. After reviewing this record thoroughly, we disagree.

Rather, consistent with the various dictionary definitions of "resurface" argued by applicant, it seems from the above uses on the Internet that this term is clearly used by the dermatology and cosmetology industries to describe the purpose of skin care treatments and cosmetic products, and that this is precisely the way in which the relevant public understands the term. The close linkage of the terms RESURFACE and DERMABRASION, in this composite mark as well as in the literature, only reinforces this strong connection.

Applicant is especially vehement in its reply brief that the Trademark Examining Attorney is collaterally estopped from attacking applicant's incontestable registration for the mark RE-SURFACE for "creams for the care and beauty of the face."¹⁹

¹⁹ Registration No. 2311855 issued on January 25, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

We agree with the premise of applicant's contention that if the involved RESURFACE portion of applicant's mark it seeks to register is identical to subject matter of applicant's incontestable registration, the word "Resurface" need not be disclaimed, provided the goods are identical. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.* 105 S.Ct. 658, 224 USPQ 327 (1985), and *In re The American Sail Training Association*, 230 USPQ 879 (TTAB 1986). On the other hand, each application for registration of a mark for certain goods must be separately evaluated and " ... [n]othing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration" *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985); *see also, In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) [applicant's incontestable registration of a service mark did not automatically entitle applicant to registration of that mark for broader financial services]; *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001); *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472-73 (TTAB 1994); and *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986). That is, the United States Patent and Trademark Office should not be barred from examining the registrability of a mark when an applicant

seeks to register it for additional goods or services, as it does here, even when the additional goods or services are closely related to those goods and/or services listed in a prior incontestable registration.

With respect to the goods, we note that the only overlap between the goods of the claimed registration and these applications involves *facial creams*. Otherwise, the identifications of goods in both of the involved applications are broader in formulations (viz., including "gels, milks, lotions and powders") and where they are applied (e.g., in the claimed registration for the "face" only, but the first application is to be used on the "body" generally while the second application enumerates skin-care products for the "face, the body and the hands"). Accordingly, the goods identified in the present applications involve additional and different goods.

Decision: These two refusals to register absent applicant's compliance with the Trademark Examining Attorney's requirement to disclaim the word "Resurface" (on the ground that this term is merely descriptive in connection with the identified goods) are hereby affirmed. Nonetheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside with respect to both applications and the

applications will be returned to the Trademark Examining Attorney to place in condition for publication for opposition, if applicant, no more than thirty days from the mailing date of this decision, submits an appropriately worded disclaimer for each application, namely:

No claim is made to the exclusive right to use the word "Resurface" apart from the mark as shown.

* * *