

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Fallien Cosmeceuticals, Ltd.
SERIAL NO.: 76/718,528
TRADEMARK: SKIN FIRM TECHNOLOGY
FILING DATE: October 5, 2015
CLASS: 3
To: Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
Attn: William D. Jackson, Esquire
Trademark Examining Attorney
Law Office 117

RESPONSE TO OFFICE ACTION DATED JANUARY 7, 2016

In an Office Action dated January 7, 2016, the Examining Attorney preliminarily refused to register Applicant's mark because he believes it merely describes Applicant's goods. Applicant respectfully submits the following response and amendment in support of registration.

I. DISCLAIMER OF "SKIN"

Applicant respectfully requests that the Examining Attorney amend the application to include the following disclaimer:

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

II. SKIN FIRM TECHNOLOGY IS NOT MERELY DESCRIPTIVE

The Examining Attorney has preliminarily refused to register Applicant's SKIN FIRM TECHNOLOGY mark, because he believes it to be merely descriptive of Applicant's goods, i.e. sun screen and skin creams.

Based on the following analysis and Applicant's disclaimer of the "SKIN" portion of its mark, Applicant respectfully requests the Examining Attorney withdraw his refusal and pass Applicant's mark on to publication.

A. Standard for Descriptiveness

Addressing the subject of descriptive wording in the case In re Gyulay, the Court of Appeals for the Federal Circuit recognized the language of the Trademark Trial and Appeal Board establishing that descriptiveness refusals are proper only when "the mark merely describes a significant characteristic of the goods." 820 F.2d 1216, 1217, 3 U.S.P.Q.2d 1009, 1009 (Fed. Cir. 1987). The key word in this language is the word *significant*. Indeed, the relevant characteristic in the determination of descriptiveness must be *significant*. It cannot logically be a minor, miniscule, or deeply shrouded characteristic. This is a fundamental point not to be overlooked.

The Federal Circuit continues as follows: 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.' Id. (quoting In re Qwik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. 505 , 507 (C.C.P.A. 1980)) (emphasis added; omission in original). "The categories are in actuality 'central tones in a spectrum . . . and are frequently difficult to apply.'" Id. (quoting Soweco, Inc. v. Shell Oil, Co., 617 F.2d 1178, 1183, 207 U.S.P.Q. 278, 282 (5th Cir. 1980) (omission in original)).

It is clear, therefore, that a mark or portion thereof, must *immediately* convey knowledge of a *significant* characteristic to support a descriptiveness refusal. The commercial impression cannot be a time-consuming, tenuous, or pensive connection - it must be immediate. Where a mark or a portion thereof, neither immediately conveys knowledge about a characteristic of the identified goods and/or services, nor is that characteristic significant from the relevant consumer's point of view, the wording fails to satisfy the legal standard for descriptiveness and accordingly must be held registrable.

In contrast to descriptive marks, a mark or portion thereof, is suggestive if it requires a consumer to employ at least some degree of thought, imagination, and perception to determine the nature of the goods or services offered in

connection with such wording. See In re Gyulay, 820 F.2d at 1216, 3 U.S.P.Q.2d at 1009. In other words, if "imagination, thought or perception is required to reach a conclusion on the nature of the goods," then it is a suggestive mark entitled to protection. Id. (internal quotation marks omitted); see also Gen. Mills Inc. v. Kellogg Co., 824 F.2d 622, 3 U.S.P.Q.2d 1442 (8th Cir. 1987).

Furthermore, "a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable." T.M.E.P. § 1209.01(a) (Apr. 2014); see, e.g., HQ Network Sys. v. Exec. Headquarters, 755 F. Supp. 1110, 18 U.S.P.Q.2d 1897, 1907 (D. Mass. 1991) ("'HEADQUARTERS COMPANIES' is on the cusp between being descriptive and being suggestive. It is, if you will, a suggestive mark with descriptive elements."). Understanding that a suggestive mark may, too, carry a certain meaning or significance is crucial to the case at hand.

Emanating from the aforementioned wealth of case law, it is clear that the standard for descriptiveness requires a basis of significance and immediacy. Descriptiveness, moreover, is a hurdle that can be eliminated through the creation of a new and suggestive whole. While not without its ambiguity, the descriptiveness standard must be properly applied with all due deference to Applicant.

B. "SKIN FIRM TECHNOLOGY" is a Registrable Unitary Mark.

1. A Descriptiveness Refusal is Improper for a Unitary Phrase.

At its core, and as explained below, Applicant's mark SKIN FIRM TECHNOLOGY is a unitary phrase for which a descriptiveness refusal is inappropriate. Describing marks that constitute registrable unitary phrases - and with particular relevance to unitary marks such as Applicant's SKIN FIRM TECHNOLOGY - the T.M.E.P. provides that a phrase is deemed unitary when it "derives its meaning when viewed as a whole, with the combination of the components having a distinct commercial impression that is independent of the constituent elements." Id. § 1213.05(b) (Jan. 2015) (citing Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1561, 21 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991)).

2. "SKIN FIRM TECHNOLOGY" is Unitary.

Applicant respectfully submits that, under the appropriate standard as set forth above, Applicant's mark SKIN FIRM TECHNOLOGY is a unitary and registrable unique source identifier of Applicant's goods. Applicant's mark combines three words that *suggest* the sophistication of its creams and preparations that are cutting-edge or technologically advanced, and uses them to

identify its goods. Consumers will appreciate that these terms are used suggestively.

Applicant's unique mark SKIN FIRM TECHNOLOGY creates an inherently distinctive commercial impression that surpasses the respective meanings of the mark's individual components. The inextricable combination of the terms "SKIN", "FIRM", and "TECHNOLOGY" for Applicant's goods converts the individual components of Applicant's mark into an inseparable and entirely integrated, unitary, and suggestive whole that serves only as a unique source identifier for Applicant. The trademark significance of SKIN FIRM TECHNOLOGY is thus derived from the overall suggestive commercial impression engendered by Applicant's mark as a whole. Indeed, in the subject case, the whole is undoubtedly greater than the sum of its parts. Accordingly, because SKIN FIRM TECHNOLOGY is a distinguishing, suggestive, and unitary phrase, Applicant's mark is unquestionably registrable on the Principal Register. Applicant therefore respectfully requests that the subject mark be approved for publication.

**3. "SKIN FIRM TECHNOLOGY" is Suggestive, Not Merely
Descriptive.**

Even if Applicant's mark were not unitary, contrary to the Examining Attorney's position, Applicant's mark is not merely descriptive of the applied-for goods as it by no means

immediately describes or conveys knowledge of a significant characteristic of Applicant's sun screens and creams to relevant consumers.

Initially, it bears emphasizing that the evidence provided by the Examining Attorney does not establish that Applicant's mark "immediately describes sun screen and skin cream that employs scientific knowledge to make skin physically solid or resilient." While the Examining Attorney has provided dictionary definitions of the words "skin", "firm", and "technology", under scrutiny it becomes clear that those definitions do not demonstrate that Applicant's mark immediately describes the intended purpose or audience of Applicant's goods. In fact, the Examining Attorney has not provided any evidence, other than dictionary definitions, that demonstrates the descriptiveness of Applicant's mark or that consumers would immediately identify Applicant's mark as merely a descriptor of Applicant's goods.

Absent prior exposure to "SKIN FIRM TECHNOLOGY" in connection with sun screen and skin creams, it is impossible for consumers *immediately* to recognize the Applicant's mark as a descriptor of such goods as the phrase is not capable of *immediately* conveying knowledge about the goods in connection with which such an ambiguous and versatile phrase is used. While consumers of Applicant's goods may have a general understanding of the words "SKIN", "FIRM", and "TECHNOLOGY" in different

contexts and ultimately perceive a suggestive association between the innovative nature of Applicant's goods, the novel use of those terms in as the identifier for Applicant's creams requires consumers first to engage in at least a minimal amount of thought and reasoning to develop an understanding of the meaning of mark in connection with Applicant's goods. In other words, SKIN FIRM TECHNOLOGY is *suggestive* of a feature or characteristic of Applicant's goods, but it by no means *immediately* conveys knowledge about Applicant's them; rather, any link between SKIN FIRM TECHNOLOGY and Applicant's goods necessitates more than a minimal degree of imagination, thought, or perception before achieving the requisite "mental leap." This is the hallmark of suggestive marks.

Furthermore, the existence of marks on the Principal Register that include "FIRM" and "TECHNOLOGY" for nearly identical goods (including "skin-care preparations") without disclaimers of those terms demonstrates the Trademark Office's practice of not finding "FIRM" and "TECHNOLOGY" merely descriptive for Applicant's goods. Applicant respectfully submits that in light of the registrations listed below, Applicant's mark SKIN FIRM TECHNOLOGY is not merely descriptive as a whole, and its use of "FIRM" and "TECHNOLOGY" cannot be deemed descriptive separately.

Mark	Reg. No.	Class	Goods
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BE FIRM	3856163	3	Non-medicated skin care preparations, namely, facial serums and creams.
FIRM ESSSENTIALS	2744629	3	Skin care products, namely, facial masks, moisturizers and serums.
TECHNOLOGY ACCELERATED SKIN CARE	4550355	3	Non-medicated skin preparations, namely, creams, lotions, gels, toners, cleaners, and peels.
AGE-LESS TECHNOLOGY	3551850	3	Cosmetics and non-medicated skin care preparations, namely, skin treatments, creams, cleansers and moisturizers.

Registration certificates for the above-referenced marks are attached hereto as Exhibit A.

As the foregoing demonstrates, the mark fails to meet the threshold legal standard for mere descriptiveness, rendering the subject descriptiveness refusal untenable. Applicant's mark SKIN

FIRM TECHNOLOGY thus can only be understood as a suggestive, unitary, and unique source identifier for Applicant's goods and is therefore unequivocally registrable on the Principal Register, especially in light of Applicant's disclaimer of "SKIN". Accordingly, Applicant respectfully requests that its mark be approved for publication.

III. CONCLUSION

As all the concerns of the Examining Attorney have been addressed, Applicant respectfully requests that the Examining Attorney approve its mark for publication.

Respectfully submitted,

FALLIEN COSMECEUTICALS, LTD.

Dated: July 7, 2016

By: /s/ David M. Perry
David M. Perry
Thomas H. Kelly
Its Attorneys

BLANK ROME LLP
One Logan Square
Philadelphia, Pennsylvania 19103
(215) 569-5767

EXHIBIT A

United States of America

United States Patent and Trademark Office

BE FIRM

Reg. No. 3,856,163

Registered Oct. 5, 2010

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

ASTRAL HEALTH & BEAUTY, INC. (DELAWARE CORPORATION)
BUILDING 200, SUITE 200
3715 NORTHSIDE PARKWAY
ATLANTA, GA 30327

FOR: NON-MEDICATED SKIN CARE PREPARATIONS, NAMELY, FACIAL SERUMS AND CREAMS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 2-18-2010; IN COMMERCE 2-18-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-932,677, FILED 2-10-2010.

COLLEEN KEARNEY, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

United States Patent and Trademark Office

Reg. No. 2,744,629

Registered July 29, 2003

**TRADEMARK
PRINCIPAL REGISTER**

FIRM ESSENTIALS

ONE WORLD NETWORKS INTEGRATED TECHNOLOGIES, INC. (NEVADA CORPORATION)
12300 WILSHIRE BLVD. SUITE 200
LOS ANGELES, CA 90025

FIRST USE 9-26-2002; IN COMMERCE 9-26-2002.

SN 76-394,377, FILED 4-10-2002.

FOR: SKIN CARE PRODUCTS; NAMELY, FACIAL MASKS, MOISTURIZERS AND SERUMS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

DAVID C. REIHNER, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

Technology Accelerated Skin Care

Reg. No. 4,550,355

SUZUKI, DAVID S. (UNITED STATES INDIVIDUAL)
2244 1ST AVE S.

Registered June 17, 2014

SEATTLE, WA 98134

Int. Cl.: 3

FOR: NON-MEDICATED SKIN PREPARATIONS, NAMELY, CREAMS, LOTIONS, GELS, TONERS, CLEANERS, AND PEELS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

TRADEMARK

FIRST USE 1-1-2004; IN COMMERCE 1-1-2004.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SKIN CARE", APART FROM THE MARK AS SHOWN.

SER. NO. 85-933,159, FILED 5-15-2013.

ANGELA M. MICHELI, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

United States Patent and Trademark Office

Reg. No. 3,551,850

Registered Dec. 23, 2008

**TRADEMARK
PRINCIPAL REGISTER**

Age-Less Technology

FREEZE 24/7 INTERNATIONAL LLC (NEW
YORK LIMITED LIABILITY COMPANY)
185 MADISON AVE, 12TH FL
NEW YORK, NY 10016

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: COSMETICS AND NON-MEDICATED SKIN
CARE PREPARATIONS, NAMELY, SKIN TREAT-
MENTS, CREAMS, CLEANSERS AND MOISTURI-
ZERS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

SN 78-608,310, FILED 4-13-2005.

FIRST USE 3-1-2006; IN COMMERCE 3-1-2006.

SKYE YOUNG, EXAMINING ATTORNEY