

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK EXAMINING DIVISION

APPLICANT : Coty Germany GmbH )  
)  
TRADEMARK : MOISTURE RENEW ) Tina Brown  
SHEER & SHINE )  
) Examining Attorney  
SERIAL NO. : 76/719,525 ) Law Office 118  
)  
FILED : October 20, 2015 )

**OFFICE ACTION RESPONSE**

Applicant has received and reviewed the Office Action dated July 25, 2016, regarding the above-referenced application and provides the following response.

**I. 2(F) CLAIM OF ACQUIRED DISTINCTIVENESS IN PART**

Applicant is the owner of U.S. Registration No. 4893207 for the mark MOISTURE RENEW for “cosmetics for the lips,” which was registered on January 26, 2016 with a 2(f) claim of acquired distinctiveness. Pursuant to T.M.E.P. § 1212.02(f)(i), Applicant therefore asserts a claim of acquired distinctiveness with regard to the MOISTURE RENEW portion of its mark based on its ownership of this prior registration, which is active on the Principal Register for goods that are sufficiently similar to the “cosmetics” identified in the Application.

**II. APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT’S GOODS**

Registration of Applicant’s mark has been initially refused under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), on the basis that Applicant’s mark MOISTURE RENEW SHEER & SHINE is allegedly merely descriptive of Applicant’s goods, namely “cosmetics.” As stated above, Applicant has entered a claim of acquired distinctiveness in part with regard to the MOISTURE RENEW portion of its mark. That amendment alone is sufficient to overcome the

2(e)(1) refusal since it renders the mark as a whole as distinctive. In any event, Applicant respectfully submits that the remaining portion of its mark, SHEER & SHINE, when considered in its entirety, is not descriptive, but is instead inherently distinctive. Based on the foregoing, Applicant requests withdrawal of the Section 2(e)(1) refusal.

**A. SHEER & SHINE Must be Considered In Its Entirety.**

The Examining Attorney contends that Applicant's mark is merely descriptive because "[l]ipsticks that are sheer and shine are commonly offered." However, the Supreme Court mandates that, "[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety . . . ." *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920). In this case, the holding of *In re Colonial Stores, Inc.* is instructive:

While it may be true that each of the individual words in the present applicant's mark are . . . independently unregistrable, . . . their unusual association or arrangement in the Applicant's mark results in a unique and catchy expression which does not, without some analysis and rearrangement of its components suggest the contents of applicant's goods.

394 F.2d 549 (C.C.P.A. 1968) (SUGAR & SPICE not merely descriptive of bakery products). Under this rule, the combination of allegedly descriptive elements can result in a mark that is non-descriptive and fully registrable as a whole. *See, e.g., In re Chesapeake Corp. of Va.*, 420 F.2d 754, 755-56 (C.C.P.A. 1970) (SUPERWATERFINISH papers not descriptive of paper); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557, 559 (T.T.A.B. 1975) (BIASTEEL not descriptive of automobile tires), *aff'd*, 189 F.2d 348 (C.C.P.A. 1976).

Because the Examining Attorney has not considered the overall meaning of SHEER & SHINE, but rather dissected the mark into "sheer" and "shine" the methodology underlying the refusal is impermissible. As discussed further below, SHEER & SHINE, when considered in its

entirety and in connection with the goods identified in the Application, is not merely descriptive, but is instead inherently distinctive.

**B. The Meaning of SHEER & SHINE, When Considered in Its Entirety, Is Not Descriptive.**

As the Examining Attorney is aware, “[a] mark is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” *Stix Prods. v. United Mfrs. Inc.*, 259 F. Supp. 479, 488 (S.D.N.Y. 1968) (holding CONTACT for self-adhesive decorative plastic suggestive instead of descriptive); *see also Estee Lauder, Inc. v. Gap, Inc.*, 42 U.S.P.Q.2d 1228, 1232 (2d Cir. 1997) (affirming finding that the term “100%” was suggestive, and not descriptive, of moisturizer because consumers would need additional information in order to perceive the nature of the goods sold by applicant); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product).

In this case, when it is properly considered as a unitary expression, SHEER & SHINE is distinct. Like the TINT TONE mark for hair coloring discussed in *In re John H. Breck, Inc.*, the mark SHEER & SHINE overlap in significance and their combination is somewhat incongruous or redundant when applied to cosmetics. 150 USPQ 397, 398 (TTAB 1966). The term “sheer,” as defined by the Meriam Webster definition cited by the Examining Attorney, means “very thin or transparent.” SHINE means “to give off light” or “to have a smooth surface that reflects light,” again according to the definition cited by the Examining Attorney. As a result, a “sheer” and “shine” have a somewhat incongruous or redundant meaning. Generally, something that is transparent does not reflect or give off light, because light passes through, rather than reflecting off, transparent objects. To the extent the light can be thought of as passing through a transparent

surface and reflecting off of the other side, the terms then have a meaning that is redundant with regard to the feature at issue. In *In re John H. Beck, Inc.* the Board held that this type of redundancy is a form of incongruity that indicates that a mark is suggestive. *Id.*

The Board's decision *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) is also instructive. In that case, the Board found inappropriate a requirement for a disclaimer of "LIGHT" apart from the mark "LIGHT 'N LIVELY" for reduced calorie mayonnaise stating that "the merely descriptive significance of the term "LIGHT" is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole." *Id.* Like LIGHT 'N LIVELY, the terms "sheer" and "shine" lose any descriptive significance with regard to cosmetics when combined into a unitary mark. The alliterative cadence of SHEER & SHINE contributes to its perception as a unitary mark, with a unique non-descriptive meaning.

As further support that consumers will view SHEER & SHINE as a mark rather than a descriptor, Applicant notes that the definitions provided by the Examining Attorney apply inconsistent parts of speech. "Sheer" is an adjective while "shine" is a verb. (Applicant draws the Examining Attorney's attention to its use of the verb "shine," not the adjective "shiny"). This incongruity draws consumers' attention to the fact that SHEER & SHINE functions as a mark, not merely two adjectives describing the cosmetics, as asserted by the Examining Attorney.

As the Examining Attorney is aware, it is well-established that "[t]he mark that comprises the 'double entendre' will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services." TMEP § 1213.05(c); see *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-700 (2d Cir. 1961) (finding that the mark

POLY PITCHER for polyethylene pitchers is both descriptive of the plastic ingredient of the product and is reminiscent or suggestive of Molly Pitcher of revolutionary times); *Am. Historic Racing Motorcycle Ass'n, Ltd. v. Team Obsolete Promotions*, 33 F. Supp. 2d 1000, 1005 (M.D. Fla. 1998), *aff'd*, 233 F.3d 577 (11th Cir. 2000) (finding that BEARS, an abbreviation for the descriptive phrase "British-European-American Racing Series," is arbitrary, not descriptive, because of the double entendre of an animal and an abbreviation).

As stated above, the Examining Attorney interprets the terms SHEER and SHINE based on their definitions as an adjective and a verb, respectively. However, when SHEER and SHINE are both defined as verbs, the overall phrase has a new meaning. As stated in the definition from Merriam-Webster provided by the Examining Attorney, "sheer" – as a verb – means "to turn suddenly" or "to deviate from a course." Further, "shine" – as a verb – means "be[ing] very good or successful at an activity," as stated in the definition from Merriam-Webster provided by the Examining Attorney. Therefore, an alternative meaning of SHEER & SHINE is to deviate from a course and then be very good or successful at an activity. In this play on words, the phrase SHEER & SHINE can be interpreted to encourage the women who use Applicant's cosmetics to deviate from the standard path ("sheer") and succeed on a new path ("shine"). In view of the multiple meanings of both terms included in the definition provided by the Examiner, many of which are plausible (but not descriptive) meanings when used in the context of Applicant's goods, understanding the nature of Applicant's goods requires multiple cognitive steps. This is the hallmark of a suggestive, rather than merely descriptive mark.

Based on all of this information, Applicant asserts that its mark is inherently distinct, rather than merely descriptive, and is entitled to registration on the Principal Register.

**C. Any Doubt Should be Resolved in Favor of Applicant.**

“‘[A]n applicant need not conclusively establish distinctiveness but need only establish a prima facie case’ to warrant publication of a mark for opposition.” *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. 916, 919 (T.T.A.B. 1983) (cited with approval in *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988)). Moreover, any doubt with respect to whether a mark is descriptive or suggestive must be resolved in favor of the applicant, and borderline cases should pass to publication. *See In re Grand Metro. Foodservice Inc.*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994) (finding MUFFUNS for muffins not merely descriptive); *see also In re Priefert Mfg. Co., Inc.*, 222 U.S.P.Q. 731, 733 (T.T.A.B. 1984) (finding HAY DOLLY not merely descriptive of trailer for hauling hay); *In re Hormel & Co.*, 218 U.S.P.Q. 286, 287 (T.T.A.B. 1983) (finding FAST’N EASY not merely descriptive of “pre-cooked meats”). As the Board held in *In re Gourmet Bakers, Inc.*,

The distinction between marks which are “merely descriptive” and marks which are “suggestive” is so nebulous that more often than not it is determined largely on a subjective basis with any doubt in the matter being resolved in applicant’s behalf on the theory that any person who believes that he would be damaged by the registration will have an opportunity under Section 13 to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.

173 U.S.P.Q. 565, 565 (T.T.A.B. 1972).

Applicant has established a prima facie case of the suggestive nature of Applicant’s mark such that the application should be passed to publication. Any doubts concerning the mark should be resolved in Applicant’s favor and the refusal withdrawn.

### III. CONCLUSION

Having fully responded to the issues raised in the Office Action, Applicant respectfully requests that the refusal raised in the Office Action be withdrawn and that its application be approved for publication.

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