

**RESPONSE TO OFFICE ACTION**

In re Application Serial No.: 88/252004  Mark(s): AESTHETIC MEDICAL INTERNATIONAL HOLDINGS GROUP LIMITED & DESIGN  Classes: 44  Applicant: Aesthetic Medical International Holdings Group Limited	TRADEMARK APPLICATION  Law Office: 114  Examining Attorney: Siddharth Jagannathan
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In the Office Action dated March 29, 2019, the Examining Attorney refused registration for the mark AESTHETIC MEDICAL INTERNATIONAL HOLDINGS GROUP LIMITED & Design on the ground that the mark is merely descriptive of the identified services:

Class 044: Surgical aesthetic treatment, including eye surgery, nose surgery, breast surgery, and liposuction; minimally invasive surgery, including body and face sculpting, body and face thread lifts; laser treatments for hair removal, skin tightening, skin resurfacing, and spot removal

Applicant respectfully requests that the refusal be withdrawn, as the mark AESTHETIC MEDICAL INTERNATIONAL HOLDINGS GROUP LIMITED & Design (as seen below):



is suggestive when applied to the services in the application.

**I. APPLICANT’S MARK IS AT LEAST SUGGESTIVE**

“To be refused registration on the Principal Register under §2e(1) of the Trademark Act, 15 U.S.C. §1052 (1), a mark must be merely descriptive or deceptively misdescriptive of the

goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.” TMEP §1209.01(b). “Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.” TMEP §1209.01(a). Suggestive marks may register on the Principal Register without proof of secondary meaning. TMEP § 1209.01(a).

In addition, “[a] mark that vaguely suggests a desirable characteristic of the product, or one that uses the mark in a manner not usually associated with the terms, will be considered suggestive” TMEP §1209.01 (a), *see In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Circ. 2003); *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); *In re Pennwalt Corp.*, 173 USQP 317 (TTAB 1972). Lastly, “a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.” TMEP §1209.01(a).

**A. The Primary Significance of the Subject Mark is Not Descriptive in Nature**

Applicant’s use of the terms “AESTHETIC” and “MEDICAL” does not indicate any primary significance of descriptiveness. Additionally, the Chinese characters stand for “medical” and “beauty”. These terms “aesthetic” and “beauty” do not immediately indicate to the consumer that applicant’s performs plastic surgery and related treatments. The terms are merely desirable characteristics of any surgical treatment whether related to plastic surgery or general surgery. Overall, in addition to successful result, an aesthetic or beautiful result should be the goal of any medical treatment. The Examining Attorney has submitted Wikipedia evidence of “aesthetic medicine” to support the proposition that the mark is descriptive.

However, the term “aesthetics” is also defined as a branch of philosophy that deals with the nature of art, beauty and taste. See Exhibit A. Applicant submits that this dictionary definition is inadequate evidence to support the descriptiveness refusal because aesthetic medicine does not necessarily always refer to the improvement of a person’s appearance. It could also refer to the practice of medicine conducted in a tasteful way.

Indeed, the dictionary evidence supports Applicant’s position that the mark is at least suggestive. The selected definition by the Examiner states in a footnote that in the United States there were more than 11 million aesthetic procedures performed from 2012-2013 and 84.5% of the procedures were non-surgical. To Applicant, this clearly indicates that a consumer hearing “aesthetic medicine” does not understand if they’re dealing with goods/services relating to surgery, topical treatments, treatments to repair cleft lips, burn scars, or reconstructive surgery, etc. The fact is these terms suggest a type of medicine, but do not immediately describe what that medicine is. Even if the terms are considered relevant to an understanding of the nature of Applicant’s goods and services, it does not necessarily result in descriptiveness as “a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.” TMEP § 1209.01(a). Because the terms merely suggest a desirable characteristic of the services, the primary significance of the terms are not descriptive in nature when applied to Applicant’s services.

Similarly, the fact the Examiner points to third party use of the term “aesthetic” in use with beauty procedures does not support that the mark is descriptive. Instead, to Applicant it supports that “aesthetic” suggests a desirable characteristic of any medical procedure. The term is not necessary to describe the services as there are many synonyms to “aesthetic” including “beauty”, “alluring”, “appealing”, “pretty”, “delicate”, “radiant” etc. Applicant submits evidence

as Exhibit B demonstrating that these terms are suggestive in the plastic and cosmetic surgery fields.

Additionally, Applicant's mark is AESTHETIC MEDICAL INTERNATIONAL HOLDINGS GROUP LIMITED & Design. The mark is a unitary mark that is not "merely descriptive" of Applicant's goods. It is well established that "the fact that a term sought to be registered may consist of two or more terms which are descriptive of features of a product does not necessarily render their combination in a compound expression descriptive within the meaning of the Trademark Act." In re Geo. A. Hormel & Co. , 218 U.S.P.Q. 286 (T.T.A.B 1983) (FAST'N EASY held not "merely descriptive" of pre-cooked meats). See In re Reynolds Metals Co. , 480 F.2d 902 (C.C.P.A 1973) (BROWN-IN-BAG not "merely descriptive" of transparent glass covers for cooking utensils); In re Colgate-Palmolive Co. , 160 U.S.P.Q. 212 (T.T.A.B. 1968) (QUICK-SOFT not "merely descriptive" of fabric softener). Applicant's mark consists of six separate terms "AESTHETIC", "MEDICAL", "INTERNATIONAL", "HOLDINGS", "GROUP", and "LIMITED" that, when combined, create a suggestive mark. Not only that, but when the Examiner considers the additional Chinese characters all incorporated into the mark, a unique impression is created.

Lastly, Applicant's use of the terms "INTERNATIONAL HOLDINGS GROUP LIMITED" may refer to an entity, but even if the mark were comprised of a combination of merely descriptive terms (which is not the case here), it is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968). Here, the combination of the terms and the stylized Chinese characters taken together results in a mark with a unique meaning and impression as the mark must be viewed as a whole its literal and design elements.

### **B. The Mark Does Not Immediately Describe the Applicant's Services**

In order to be merely descriptive, Applicant's mark must immediately convey information as to the services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.* 211 USQP 1199, 1204-1205 (TTAB 1981). Applicant's mark does not immediately describe the goods and services listed in the application with any degree of particularity. As discussed, the terms "aesthetic" and "medical" can be interpreted in multiple ways. A consumer encountering the mark would have to pause and use thought and/or imagination to conclude that Applicant offers treatments relating to physical beauty.

### **C. The Doctrine of Foreign Equivalents does not Apply to Applicant's Mark**

The Chinese characters found in the mark are not so common that the average consumer would immediately translate the characters into its English language equivalent. *See McCarthy on Trademarks and Unfair Competition*, §23:36 (when it is unlikely that an American buyer will actually translate a foreign word mark and will take it as it is, then use of the foreign equivalent gives an improper and skewed view of the marketplace). Moreover, the doctrine of foreign equivalents has no application in a case like this one where the foreign language terms "medical", "beauty", "international", are accompanied by other English terms like "AESTHETIC MEDICAL INTERNATIONAL HOLDINGS GROUP LIMITED".

In this case, Applicant is limited to using the mark in its design. The foreign terms are the most prominent and the English terms follow. *See French Transit v. Modern Coupon Systems*, 818 F. Supp. 635, 29 U.S.P.Q.2d 1626 (S.D.N.Y. 1993) (the doctrine of foreign equivalents does not apply when the mark is made up of a combination of foreign and English words). See also TMEP §1209.03(g) "...marks comprised of a term from a foreign language used with an English term may be found registrable if the commercial impression created by the

combination differs from that which would be created by two English words. *See In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988) (LA YOGURT for yogurt registrable on Principal Register with a disclaimer of "YOGURT"); *In re Sweet Victory, Inc.*, 228 USPQ 959 (TTAB 1986) (GLACE LITE held not descriptive for ice creams, sherbets, frozen yogurts, and nondairy frozen desserts); *In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984) (LE CASE not merely descriptive of jewelry boxes and gift boxes and, therefore, registrable with a disclaimer of "CASE"). Similarly, here, the mark is a design featuring both foreign and English terms that result in a mark that is not descriptive when encountered by consumers.

## **II. TRANSLITERATION AND TRANSLATION REQUIRED**

The Examining Attorney requests that to permit proper examination of the application, Applicant must submit a transliteration of the non-Latin characters in the mark. Applicant submits that the characters transliterate to “medical beauty international”.

## **III. DESCRIPTION OF MARK**

Applicant accepts the description of the mark as proposed by the Examining Attorney and has addressed same in the response form: The mark consists of four Chinese characters above the wording AESTHETIC MEDICAL INTERNATIONAL HOLDING GROUP LIMITED.

## **IV. CONCLUSION**



Applicant maintains the use of the mark as show \_\_\_\_\_ in this application, is suggestive, not merely descriptive of the services, and the Examining Attorney’s evidence does not support a finding to the contrary. Additionally, the doctrine of foreign

equivalents is not applicable in this case because the mark features both foreign and English terms. Therefore, the mark should proceed to registration. Applicant reminds the Examiner that any doubts regarding a determination under Section 2(e)(1) must be resolved in favor of the Applicant. *See, In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2D 1974 (TTAB 1994); *In re Conductive Services, Inc.*, 220 USPQ 84, 86 (TTAB 1983). For all these reasons, Applicant requests the refusal be withdrawn, and the application be approved for publication.

Respectfully submitted,

Date: September 30, 2019

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