

**IN THE UNITED STATES**  
**PATENT AND TRADEMARK OFFICE**

LAW OFFICE No. 111  
In re Application of: Church & Dwight Co., Inc.  
To Register the Trademark: FLAWLESS CONTOUR  
Serial No. 88405185  
Office Action Mailing Date: June 22, 2019

**RESPONSE**

This Response is submitted on behalf of Church & Dwight Co., Inc. (“Applicant”) in reply to the Office Action dated June 22, 2019 (the “Office Action”) regarding Application Serial No. 88405185 for the FLAWLESS CONTOUR mark (the “Mark”).

In the Office Action, the Examining Attorney asserts that a disclaimer is required of the wording CONTOUR as merely descriptive of Applicant’s goods because, specifically, “[i]t refers to its use for creating shape of something, a body or sculpture.”


The Examining Attorney also contends that the “Facial toning apparatus for cosmetic use” goods filed in Class 10 should be classified in Class 3.

Applicant respectfully disagrees with Examining Attorney’s analysis and conclusion. With this Response, Applicant requests that the Examining Attorney reconsider the disclaimer requirement and the classification of “Facial toning apparatus for cosmetic use.”

With respect to the classification of goods, the “Facial toning apparatus for cosmetic use” goods are properly classified in Class 10. The Acceptable Identification of Goods and Services Manual (“ID Manual”) includes “Facial toning machines for cosmetic use” goods in Class 10. *See Exhibit A.* The ID Manual includes entries that are acceptable as written. *See* TMEP 1402.04.

While Applicant’s identification includes “apparatus” instead of “machines” as in the ID Manual, these words are synonyms and can be used interchangeably. See Exhibit B, “Apparatus,” Thesaurus.com, <https://www.thesaurus.com/browse/apparatus> (accessed Dec. 10, 2019). As such, Applicant’s “Facial toning apparatus for cosmetic use” goods are acceptable as written based on the near identity with the acceptable “Facial toning machines for cosmetic use” goods in the ID Manual.

Further, prior registrations, consistent with the ID Manual, include “Facial toning apparatus” goods in Class 10. A representative list of third-party registrations follows in Table 1 and compiled in Exhibit C.

<b>Table 1</b>		
Reg. No.	Mark	Goods/Services
5307245	ARBONNE INTELLIGENCE	Class 10: Facial toning apparatus for cosmetic use
5249199	GENIUS ULTRA	Class 10: Facial toning apparatus for cosmetic use
5302596		Class 10: Facial toning apparatus for cosmetic use
5376598	ARBONNE	Class 10: Facial toning apparatus for cosmetic use
5405809	MARK TRAYNOR	Class 10: Facial toning apparatus for cosmetic use in the nature of an elastic headband with eye and hook fasteners for facial skin lifting; facial toning apparatus for cosmetic use comprised of an elastic band, medical tape, and fasteners used to lift facial and neck skin
5538952	EAR UP	Class 10: Medical apparatus and instruments for use in facial massage and cosmetic treatment of the face and skin, namely, facial toning apparatus for cosmetic use
5708979	PAVLYSH	Class 10: Facial toning apparatus for cosmetic use, namely, jade rollers

Applicant appreciates that each application is examined on its own merit. However, requiring classification of Applicant's "Facial toning apparatus for cosmetic use" goods in Class 3 would be inconsistent with both the ID Manual and prior third-party registrations where the same or similar wording is in Class 10. Accordingly, Applicant respectfully submits that the identification of goods as-filed is properly classified in whole in Class 10.

With respect to the disclaimer, the evidence provided with the Office Action does not support that CONTOUR is merely descriptive of the nature, purpose, characteristic or function of the identified goods. The burden of presenting a prima facie case that a term is merely descriptive to justify a proper rejection under Section 2(e)(1), and thus a disclaimer of that term, is not met. To carry this burden, there must be *substantial* evidence. See *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (the Federal Circuit "looks[s] only for substantial evidence, or more than a scintilla of evidence, in support of the PTO's prima facie case"). The evidence relied upon in the Office Action is far below the substantiality required for a prima facie case that CONTOUR is merely descriptive. In fact, the evidence is insufficient as it consists of a *single* dictionary definition of "contour."

Applicant respectfully submits that the mental leap between CONTOUR and Applicant's goods is far from instantaneous, thus, indicating suggestiveness rather than mere descriptiveness. A term is merely descriptive, and requires a disclaimer, within the meaning of Section 2(e)(1) if it "*immediately conveys* knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (emphasis added). The immediate idea must be conveyed with a "degree of *particularity*." *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) (emphasis added).

Going further, this single dictionary entry relied upon is characterized as “[referring] to its use for creating shape of something, a body or sculpture.” This characterization misstates the definitions. The first definition provided is “the shape of the outside edge of something.” There is no reference to “creating shape.” Instead, this first definition merely refers to a “shape.” The second definition provided is “a line on a map joining points that are the same height above or below sea level.” This is just not relevant.

Applicant’s inclusion of CONTOUR in the Mark is too vague to immediately impart any information about the use, function, or purpose of the massage apparatus goods. CONTOUR in the Mark is at least suggestive because the term fails to describe with enough particularity a specific attribute about the goods. Indeed, all objects have a “shape.” *See In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) (finding THE MONEY SERVICE suggestive of financial services pertaining to the transfer of funds from remote locations because it “falls short of describing applicant’s services in any one degree of particularity.”).

The Examining Attorney has not articulated what quality or attribute of Applicant’s goods is directly described through Applicant’s use of CONTOUR. The bare assertion is that CONTOUR “refers to its use for creating shape of something, a body or sculpture.” But, as discussed above, the single dictionary entry does not support that assertion. The first definition merely refers to a “shape,” a quality shared by all objects. A broad generalization is not enough to find CONTOUR as merely descriptive; instead it points that a term is suggestive as some imagination, thought, or perception is required by a consumer when encountering that term.

A purchaser who knows what the products are will not immediately understand CONTOUR to convey information about them. *See DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). CONTOUR, as meaning

“the shape of the outside edge of something,” is not a quality or characteristic of a massage apparatus. Instead, CONTOUR is at least suggestive since it requires some imagination and reasoning by the purchaser when encountering the Mark. By way of example, a consumer must decide what meaning (if any) CONTOUR has as a “shape” in the context of a massage apparatus. The term CONTOUR does not *immediately* convey to consumers information about a feature, characteristic, or use of a massage apparatus. The term CONTOUR is vague as to how or what a massage apparatus means as a shape. Even if CONTOUR may tell consumers something general about the goods, but without being specific or immediately telling consumers anything with a degree of particularity because the information conveyed is still somewhat vague and indirect, then the term is suggestive and no disclaimer is required. *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (“SPEEDI BAKE only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread”).

Moreover, no disclaimer of the wording CONTOUR is required as the Mark is a unitary mark. “A disclaimer of a descriptive [or generic] portion of a composite mark is unnecessary only where the form or degree of integration of that element in the composite makes it obvious that no claim other than of the composite would be involved. That is, if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary.” *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. *See* TMEP 1213.05. This inquiry focuses on “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of

the mark." *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

Factors to determine whether matter is part of unitary mark are whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services. *See* TMEP 1213.05 (citing *Dena Corp.*, 950 F.2d at 1561, 21 USPQ2d at 1052). In other words, when the mark creates a distinct meaning or commercial impression that is more than the sum of its parts, then the mark is unitary. If the mark is unitary, then no disclaimer is required.

The average purchaser recognizes FLAWLESS CONTOUR as a unitary mark. Purchasers will not break apart the Mark into the distinct words comprising the mark because the neither the wording FLAWLESS nor CONTOUR by itself points to the goods. Any descriptive significance of CONTOUR is lost in the mark as a whole. *See In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509, 511 (TTAB 1974) (consumers will call for applicant's product as E GEM notwithstanding the fact that they would recognize the descriptive significance of the letter "E").

The existence of third-party registrations for similar services on the Principal Register with *no disclaimer* of CONTOUR despite it appearing as a separate word demonstrates that the wording CONTOUR in Applicant's mark is suggestive. *See* TMEP 1207.01(d)(iii) ("[t]hird-party registrations may be relevant to show that the mark or portion of the mark is descriptive [or] suggestive"); *United Foods Inc. v. J.R. Simplot Co.*, USPQ2d 1172 (TTAB 1987) ("[Third-party registrations] may show that a particular word has descriptive or suggestive significance as applied to certain goods or services."). Examples are listed below in Table 2 and compiled in Exhibit D.

<b>Table 2</b>		
Reg. No	Mark	Goods/Services

5387600	CONTOUR WAVE	Class 10: Cosmetic apparatus using ultrasound for performing aesthetic skin treatment procedures
5697969	STK CONTOUR	Class 10: Massage apparatus
5552166	CONTOUR THÉRAPIE	Class 10: Cupping products for massage therapy, namely, silicone cupping glasses; therapeutic silicone cups for cupping therapy; therapeutic cups for cupping therapy; facial cups for cupping therapy; massage brushes; massage therapy set consisting therapeutic cups, massage brush, instruction manual and accessories in the nature of fitted bag for set; massage mitts; hair-and beauty care instruments, namely, massage apparatus, and parts therefor; electrical and nonelectrical massage apparatus for health and body care; massage devices, namely, non-electric apparatus for Shiatsu-style massage and electric apparatus for Shiatsu-style massage; head massage apparatus; esthetic massage apparatus
4879944	COOL CONTOUR	Class 10: Therapeutic cold wraps used to reduce inflammation and reduce pain; shaped therapeutic wraps, namely, water activated foot wraps, knee wraps, shoulder wraps and back wraps used to reduce inflammation and reduce pain
5434592	MICRO-CONTOUR	Class 3: Cosmetics for highlighting and contouring the face
5313206	CONTOUR INTUITIVE	Class 3: Cosmetics
5504754	THE CALI CONTOUR	Class 3: Cosmetics

5782163	CONTOURS RX	Class 3: Adhesive tapes for cosmetic purposes; cosmetic pencils; eye illuminator, namely, under eye concealers; and skin masks
5017920	CONTOURS RX	Class 3: eyelid correcting strips for cosmetic purposes
4929314	CONTOUR EFFECTS	Class 3: Cosmetics and make-up; Cosmetics in general, including perfumes
5140395	SELF-CONTOUR	Class 3: Cosmetics
4785425	DIAMOND CONTOUR	Class 3: Cosmetics; Class 5: Medicated cosmetics
4434977	CONTOUR CENTER	Class 44: Cosmetic and plastic surgery; Liposuction and surgical body shaping services; medical assistance services; Medical, hygienic and beauty care; Nutrition counseling

Again, Applicant appreciates that each application is examined on its own merit. However, requiring a disclaimer of CONTOUR would be inconsistent with prior third-party registrations for the same or related goods.

Finally, the Board has acknowledged that “[o]n the spectrum of distinctiveness, the dividing line between merely descriptive and suggestive is a fine one.” *See In re Gyulay*, 820 F.2d at 1216. Applicant submits that when doubt exists whether a term is descriptive, the clear weight of authority holds that “such doubt should be resolved in favor of the applicant” by allowing publication of the application for opposition. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Jose Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). The same should be true in this case.

### **CONCLUSION**



For all of the reasons stated herein, Applicant respectfully requests that its FLAWLESS CONTOUR mark be approved for publication in the Official Gazette with the goods as-filed in Class 10 and without a disclaimer of CONTOUR.