

2 January 2020

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Trademark Attorney
Law Office 115
US Patent and Trademark Office
(by electronic filing only)

Re: U.S. trademark application for GLASS SKIN REFINING SERUM
Serial #88398985 - Docket #675006UST
Response to Section 2(e)(1) refusal raised by Office Action dated July 3, 2019

Dear Mr. French:

The above-referenced Office Action refused registration of the instant application for use of GLASS SKIN REFINING SERUM in connection with “Cosmetics; Make-up; Non-medicated skin care preparations” because the applied-for mark is purportedly merely descriptive of Applicant’s goods.

While matter that "merely describes" the goods on or in connection with which it is used is not registrable on the Principal Register, suggestive marks (like fanciful and arbitrary marks) are "inherently distinctive" marks that are registrable on the Principal Register without proof of secondary meaning. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). As stated in TMEP §1209.01(a), “**Therefore, a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.**” (Emphasis added).

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, the latter which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985).

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the significance that the mark would have to the average purchaser of the goods or services in the marketplace. *Id.*; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831; *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001); *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Datapipe*,

Inc., 111 USPQ2d 1330 (TTAB 2014). Sources for considering the context in which the mark is or may be used include websites, publications, labels, packages, advertising material, and explanatory text on specimens for the goods and services. See *In re N. C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs, Inc.*, 236 F.3d at 1342; *In re Abcor Dev. Corp.*, 588 F.2d 811 at 814.

While a term does not necessarily need to describe all of the purposes, functions, characteristics, or features of a product to be considered "merely descriptive," it must at least describe one significant function, attribute, or property to be considered "merely descriptive." *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219. For instance, "SPEEDI BAKE" for frozen dough was found to fall within the category of suggestive marks (i.e., not descriptive marks) because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread. See *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985).

Applicant submits that the applied-for mark is, at least, suggestive. Therefore, the mark is registrable on the Principle Register without proof of secondary meaning. Specifically, Applicant submits that the term GLASS SKIN inherently fails to provide an immediate description of a significant ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods. The product does not contain glass. The product is not intended to be used on glass. Nor would a consumer believe that the product would give skin the exact qualities and characteristics of glass. Rather, an average purchaser encountered with the term GLASS SKIN would require imagination, thought, or perception to reach a conclusion as to the nature of the goods – the hallmark of a suggestive mark. Specifically, a consumer would initially be reminded of the qualities of glass – i.e., a smoothness of finish with transparency that allows light to shine through. The average purchaser would then have to connect those qualities to similar, albeit not identical, desirable qualities in a complexion. Applicant notes that the characteristics of glass might well “vaguely suggest a desirable characteristic” as was the case in *In re George Weston Ltd.*, but the desirable characteristics of glass are not identical to those invoked in relation to the desirable characteristics of a complexion. That is, while a complexion may be “luminous,” “smooth,” or “radiant,” those characteristics merely evoke characteristics of glass – they do not actually provide the same transparency and associated characteristics of glass. Thus, the qualities of glass that may be evoked in the mind of a user would require imagination, thought, or perception regarding how those qualities may be reflected in the complexion of skin that may be attained through use of the product.

Evidence that the term GLASS SKIN is suggestive is also present in the materials cited by the Examining Attorney to indicate that GLASS SKIN “is a ‘fancy name for clear, luminous, seemingly transparent skin.’”

‘Glass skin is a term for exceptionally smooth, even-toned and lustrous skin that’s so flawless it has the appearance of glass.’” To support the alleged descriptive nature of the term GLASS SKIN, the Examining Attorney relies on two websites –Devon Ableman, *This Woman’s “Glass Skin” Skin-Care Routine Is Going Viral*, Allure, October 23, 2017, <https://www.allure.com/story/viral-glass-skin-skin-care-routine> (hereinafter the “Allure Site”) and Janeca Racho, *What is Glass Skin and How to Achieve It*, Dermstore, October 12, 2018, <https://dermstore.com/blog/what-is-glass-skin/> (hereinafter the “Dermstore site”).

However, Applicant submits that these sites fail to establish that the term GLASS SKIN would have significance with the average purchaser of the goods in the marketplace so as to immediately inform the purchaser of a significant quality of the goods. Applicant notes that both the Allure Site and the Dermstore Site include an explanation of the term GLASS SKIN rather than simply using the term in a manner that would indicate the meaning of the term would be clear to the average purchaser reading the articles cited by the Examiner. Rather, both articles provide explanatory information regarding the term that indicates GLASS SKIN refers to a *seemingly* transparent skin that is “clear” and “luminous” or “exceptionally smooth, even-toned and lustrous that has the *“appearance of glass.”* Such explanations reflect the exact thought process required by an average purchaser to arrive at the significance of the term GLASS SKIN to the applied-for goods – namely that some imagination, thought, or perception would be required to understand the significance of the term GLASS SKIN to desirable qualities of the complexion of a user.

Furthermore, Applicant notes that the USPTO has treated other similar marks as non-descriptive¹. For instance, in the prior registrations cited by the Examiner, a number of the applications were examined without a descriptiveness rejection or disclaimer requirement being raised for the terms GLASS and SKIN. Namely, U.S. App. No. 88/225,846 for GLASS SKIN was examined with a requirement to disclaim SKIN without also a disclaimer of GLASS. In addition, U.S. App. No. 88/200,645 for NOORFACE SKIN GLASS was registered with SKIN disclaimed but not GLASS. Thus, Applicant submits that treatment of these applications is relevant to show that GLASS SKIN is not merely distinctive of the goods recited in the present application.

As a result, Applicant requests that the Examiner withdraw the 2(e)(1) refusal and permit the application to proceed to registration.

¹ Applicant recognizes, per TMEP §1209.03(a), that third-party registrations are not conclusive on the question of descriptiveness, but submits that the treatment discussed here is a relevant consideration that the mark may be considered as not descriptive.

Applicant also notes that the Examining Attorney noted a number of prior filed applications including Serial #88173650 and Serial #88264301, both of which have now been abandoned.

Lastly, Applicant notes that the Examining Attorney has advised that this response to the refusal may include evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. See 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.

In the event the foregoing evidence and arguments are not found persuasive, Applicant wishes to amend the present application to seek registration on the Supplemental Register. The Examining Attorney indicated a requirement to disclaim SERUM. Such a disclaimer is provided herewith.

Respectfully submitted,



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