

In the October 15, 2018 Office Action, the Examining Attorney initially refused registration of Shiseido Company, Limited's application for the mark SHISEIDO ULTIMATE SUN PROTECTOR (& Design) (Serial No. 88/116,586) covering "Soaps, perfumeries, and cosmetics; non-medicated skin care preparations, hair care preparations, body care cosmetics, and make-up; dentifrices; false nails; false eyelashes; cotton for cosmetic purposes" in Class 3 (hereinafter, Applicant's Mark") on the grounds that ULTIMATE SUN PROTECTOR is merely descriptive. While Applicant agrees to include a disclaimer of the words SUN PROTECTOR, Applicant respectfully disagrees with Examining Attorney's contention that the mark is descriptive in its entirety, as the term ULTIMATE is suggestive when used in connection with the goods offered under Applicant's Mark (the "Proposed Goods").

**I. The Term ULTIMATE in Applicant's Mark is Suggestive**

**A. The Disclaimer Requirement for ULTIMATE is Improper Due to Multiple Potential Meanings for ULTIMATE as Used in the Term "Ultimate Sun Protector"**

A mark is suggestive when one must exercise a "modicum of imagination or thought before one is able to determine the nature of applicant's product." *See Bellsouth Corp. v. Planum Technology Corp.*, 14 U.S.P.Q.2d 1555, 1556 (T.T.A.B. 1990) (holding PHONE FORWARD to be suggestive of a call forwarding service because "the meaning conveyed by applicant's mark is not immediate or direct"); *see also In re On Technology Corp.*, 41 U.S.P.Q. 1475, 1477 (T.T.A.B. 1986); *In re Noble Co.*, 225 U.S.P.Q. 749, 750 (T.T.A.B. 1985) (NOBURST was suggestive as used in connection with a product that reduced likelihood of pipes bursting because a conclusion regarding the nature of the product "requires interpretation by the viewer"). The question of whether a particular term is merely descriptive must be determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term

is used, and the possible significance that the term is likely to have to the average purchaser of those goods. *In re On Technology Corp.*, at 1477. There is often a very subtle distinction between a suggestive term and a merely descriptive term. *In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994). While a merely descriptive mark “immediately tells something about the product,” a mark is suggestive when one must “exercise imagination, thought, or perception to reach a conclusion” as to the nature of the product or services. *In re Noble*, 225 U.S.P.Q. 749 at 750; *see also Plyboo America, Inc. v. Smith & Fong Comp.*, 51 U.S.P.Q.2d 1633 (T.T.A.B. 1999) (asserting that “a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates”).

Here, the term ULTIMATE as incorporated in ULTIMATE SUN PROTECTOR does not immediately or directly describe Applicant’s goods. Furthermore, Applicant respectfully disagrees with the Examining Attorney’s contention that the term ULTIMATE is a term that merely describes the quality or characteristic of a product, when viewed in light of the actual usage and context of Applicant’s Mark. Rather, since the term ULTIMATE when used in connection with SUN PROTECTOR can have several different meanings in the context of the instant application, consumers are required to exercise mature thought, follow a multi-stage reasoning process, or exercise imagination, thought, or perception to reach a conclusion as to the nature of Applicant’s goods. *See In re Grand Metropolitan Food Service Inc.*, 30 U.S.P.Q. 2d 1974 at 1976 (stylized mark “MufFuns” held to project dual meaning of suggestiveness as muffins which are also fun to eat).

For example, the terms “ultimate” and “sun protector” when used in connection with skincare products could mean that the products function in any one of the following ways: (i) by acting as an effective sunblock, (ii) by moisturizing the skin and therefore protecting the skin from the damaging and/or drying effects from the sun, (iii) that the product feels light on the skin and does not feel greasy or heavy, (iv) the product can be used without the fear of it rubbing off and staining the wearer’s clothing or other accessories, (v) the product could be superior for its ability to simultaneously act as a sunblock without clogging the pores of the wearer, (vi) the product will not wear off in the pool or ocean, (vii) that the product can be applied in an easy and uniform way without leaving skin patches vulnerable to sunburn, (viii) the product acts as a hybrid sunblock and tinting cream, rendering it superior to other sunscreen products, (ix) the products are superior in protecting the wearer’s artificial tan (by preserving the “sun” in the wearer’s skin color), (x) the products have superior tinting, tanning or bronzing qualities, or (xi) the products are hybrid face creams, body creams, sunscreens, moisturizers, BB creams, CC creams, and/or foundation products. So, while there is a chance that Applicant’s Mark could be understood to be the “best types [of products] to protect the users from the sun’s exposure,” there is an equal chance that consumers could understand Applicant’s Mark to mean that it is effective for any one of the other skin care features set forth above, and not solely for its protective qualities.

It is clear that any one of these commercial impressions could be left on a consumer when viewing products offered under Applicant’s Mark, and that to reach such impressions, the consumer needs to follow multi-stage reasoning processes and exercise imagination to reach a conclusion about the nature of the goods offered under the mark. Further, despite whatever conclusion a consumer may reach as to the characteristics of the goods offered under Applicant’s Mark, due to the sheer number of possibilities of what the proposed goods may actually entail, a

consumer would have to investigate the product further in order to confirm its true characteristics. What is deemed “ultimate” is therefore purely subjective based on the consumer’s perception, need, or personal experience with skin care products, and consequently, the term ULTIMATE does not and cannot have a set descriptive meaning when applied to Applicant’s goods. Accordingly, when the multiple commercial impressions created by the term ULTIMATE as part of the overall mark ULTIMATE SUN PROTECTOR are properly considered, it becomes clear that the reasonably prudent consumer will be required to take more than one logical step to arrive at a precise conclusion as to the particular goods provided by Applicant. *See, e.g., In re Kopy Kat, Inc.*, 182 U.S.P.Q. 372 (C.C.P.A. 1974) (reversing the Trademark Trial and Appeal Board as to a finding of descriptiveness of the mark “WE PRINT-IT IN A MINIT” for a service mark for advice and assistance in connection with the establishment and/or operation of a printing business). Additional information and thought are required to draw any conclusion about the quality or characteristics of Applicant’s goods. This is the essence of a suggestive mark, as there is no “immediate” conveying of information about the quality or characteristic of the proposed goods.

Furthermore, Applicant respectfully submits that the Examining Attorney has mistakenly assigned laudatory characteristics to the instant application without considering the usage of the term in the context of Applicant’s entire Mark. *See, e.g., In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK merely laudatory and descriptive of applicant’s bicycle racks being of superior quality). Despite finding the subject mark for THE ULTIMATE BIKE RACK to be descriptive, in *In re Nett Designs*, the Board confirmed that the term ULTIMATE contains elements of suggestiveness, and based thereon, the Board has a continuing duty to consider the term’s specific “usage, context and other factors that affect the relevant public’s perception of the term” when analyzing a potentially

laudatory phrase. *Id.* at 1341. Unlike the application for THE ULTIMATE BIKE RACK, the instant mark is used in connection with products that function in superior ways separate and apart from their protective qualities from sun exposure, which effectively “slide[s] [Applicant’s Mark] along the continuum between suggestiveness and descriptiveness” and lands toward a finding of suggestiveness, based on the modicum of creativity required to decipher the mark in relation to Applicant’s goods, and based on the context and actual usage of the term “ultimate sun protector.” Applicant therefore submits that the term ULTIMATE as used in SHISEIDO ULTIMATE SUN PROTECTOR (& Design) is suggestive, not merely descriptive.

Lastly, it is well established that the Board has a policy of resolving doubts in the applicant’s favor in ex parte cases. *See In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (descriptiveness rejection); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:51 (5th ed. 2018) (“Because the line between merely descriptive and only suggestive terms is ‘so nebulous,’ the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence which is usually not present in ex parte examination”). Indeed, the Federal Circuit has recognized and approved this practice. *See In re Maverty Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1994). To uphold the descriptiveness refusal here would effectively resolve any doubt on this issue against Applicant, contrary to the practice and precedent of the Board. Accordingly, Applicant urges the Examining Attorney to withdraw her initial refusal.

**B. USPTO Precedent Indicates that the Term ULTIMATE is Not Considered Merely Descriptive with Respect to Class 3 Goods**

Applicant submits that there are numerous registrations in Class 3 containing the term ULTIMATE in which no disclaimer of the term was required. A potential applicant, when making

its determination regarding whether a proposed mark is registrable, is entitled to a certain degree of reliance on the USPTO’s treatment of similar marks. The Court of Appeals for the Federal Circuit, in *In re Merrill, Lynch, Pierce, Fenner and Smith, Inc.*, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987), specifically held that the analysis of whether a mark is descriptive is to be undertaken “in accordance with practice and precedent.” The USPTO has previously determined on multiple occasions that ULTIMATE, as an individual word, is not descriptive as applied to goods in Class 3, specifically for cosmetic, skincare and haircare products.

A search in TESS for all marks in Class 3 containing the term ULTIMATE results in 502 records, 161 of which are active. The term ULTIMATE is not disclaimed in 134, or 83%, of those active records. Furthermore, a large majority of these marks, in which ULTIMATE is not disclaimed, cover goods similar to Applicant’s goods. Below are some representative examples:

<b>Mark</b>	<b>Reg. No.</b>	<b>Goods Covered in Class 3</b>	<b>Disclaimer</b>
SKINCEUTICALS ULTIMATE UV DEFENSE	3,119,560	Non-medicated skin care preparations, namely, sunscreen	“UV” disclaimed
ULTIMATE LIFT EYE CRÈME	4,827,602	Non-medicated skin care preparations	“eye crème” disclaimed
ULTIMATE LIFT EYE GEL	4,337,300	Non-medicated skin care preparations	“eye gel” disclaimed
ULTIMATE LIFT FIRMING SERUM	4,557,469	Non-medicated skin care preparations	“firming serum” disclaimed
ULTIMATE LIFT NECK CRÈME	4,728,278	Non-medicated skin care preparations	“neck crème” disclaimed
ULTIMATE LIFTING CREME	2,714,469	Creams for the face, body and eyes	“lifting creme” disclaimed
ANEW ULTIMATE NIGHT	3,038,462	Skin care products, namely, facial moisturizer	“night” disclaimed
LIVE ULTIMATE WHOLE SKIN CARE	4,645,287	Cosmetic creams for skin care	“skin care” disclaimed

MAHOGANY'S ULTIMATE BODY CARE (& Design)	5,659,744	Cosmetics; non-medicated skin care preparations; cosmetic bodycare preparations	"body care" disclaimed
SATIN SMOOTH ULTIMATE	4,475,710	Moisturizing preparations for the skin; non-medicated balms for use on lips, and undereyes; non-medicated skin care creams and lotions; non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels	NONE
SK-II LXP ULTIMATE REVIVAL CREAM	3,319,641	Skin care products, namely non-medicated skin care lotions and creams	"cream" disclaimed
ULTIMATE ALOE	2,176,201	Non-medicated lotions, namely, topical gels for the skin	"aloe" disclaimed
ULTIMATE CLEAR	4,956,115	Cleaning preparations; cosmetic preparations for the bath and shower; non-medicated skin care preparations; oils, creams and lotions for the skin; make-up and make-up removing preparations; tissues, pads or wipes impregnated or pre-moistened with personal cleansing or cosmetic lotions; beauty masks, facial packs	NONE
ULTIMATE COLORCARE	3,556,700	Hair care preparations	"colorcare" disclaimed
ULTIMATE ESSENTIAL MOUTHCARE	2,159,720	Dentifrice and non-medicated mouthwash	"mouthcare" disclaimed)

A quick survey of the active registrations on the USPTO register reveals that even when the term ULTIMATE was used directly in connection with a descriptive term, the term ULTIMATE was not required to be disclaimed. Therefore, if ULTIMATE was truly considered descriptive or merely laudatory, marks such as ULTIMATE LIFTING CREME, SKINCEUTICALS ULTIMATE UV DEFENSE, and ULTIMATE ALOE, among others, would be denied registration on the Principal Register. These marks therefore serve as proof that the USPTO does not consider the term ULTIMATE to be descriptive of Applicant's goods.

In conclusion, Applicant contends that the term ULTIMATE as used in SHISEIDO ULTIMATE SUN PROTECTOR (& Design) is not descriptive of the Proposed Goods, but rather, is clearly suggestive.

**CONCLUSION**

Applicant requests that the Examiner withdraw the descriptiveness refusal and approve the instant application for registration. Prompt and favorable action is respectfully requested.