

07/20/01

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Paper No. 20  
RFC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Lancome Parfums et Beaute & Cie

Serial No. 75/377,087

**Karen Wuertz** of Baker Botts L.L.P. for Lancome Parfums et Beaute & Cie.

Dominick J. Salemi, Trademark Examining Attorney, Law Office **107** (Thomas Lamone, Managing Attorney).

Before **Cissel**, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 21, 1997, applicant filed the above-referenced application to register the mark "LIP PAINT" on the Principal Register for "makeup preparations, namely lipstick," in Class 3. The application was based on: (i) applicant's assertion that it possessed a bona fide intention to use the mark in commerce with the United States on the specified goods, and (ii) applicant's claimed priority based upon its French application. A copy of the

registration which issued in France as a result of that application was subsequently submitted, along with an English translation thereof.

The application filed in the United States is now before the Board on appeal from a final refusal to register under Section 2(e)(1) of the Lanham Act on the ground that applicant's mark is merely descriptive of the goods set forth in the application. Simply put, the Examining Attorney takes the position that "LIP PAINT" is a name for a type of lipstick or is a synonym for the word "lipstick."<sup>1</sup>

Applicant has disclaimed the word "LIP" apart from the mark as a whole, but contends that the combination of words sought to be registered is suggestive, rather than merely descriptive, within the meaning of the Act because the word "PAINT" is usually encountered in connection with liquid coloring agents which are brushed or sprayed onto whatever object is to be painted, whereas applicant's products are sticks of colored paste which are applied to lips as cosmetics to provide both color and moisture. Applicant further argues that the thought process which

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<sup>1</sup> Although on p.2 of his appeal brief the Examining Attorney states that "[t]o one familiar with makeup or cosmetics, the designation LIP PAINT will be understood as the name of a product like eyeliner or foundation," throughout most of the record in this application he has taken the position that "LIP PAINT" will be understood to describe or otherwise refer to "lipstick."

purchasers would need to go through to attribute descriptive meaning to "LIP PAINT" in connection with its product, which is not paint for the lips, makes its mark suggestive, rather than merely descriptive within the meaning of Section 2(e)(1) of the Act.

Both applicant and the Examining Attorney filed briefs on appeal, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether the mark "LIP PAINT" is merely descriptive as applied to makeup preparations, namely lipstick. Based on careful consideration of the record and arguments before us in this appeal, we find that the record herein does not support the Examining Attorney's conclusion that this mark is merely descriptive of applicant's goods.

The test for determining whether a mark is merely descriptive within the meaning of the Lanham Act is well settled. A mark is unregistrable under Section 2(e)(1) of the Act if it immediately and forthwith conveys information about a significant quality, characteristic, function, feature, purpose or use of the goods with which it is used. In re Gyulay, 870 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986). The determination of

descriptiveness must be made not in the abstract, but rather in relation to the goods as they are identified in the application, considering the context in which the mark is or will be used in connection with the goods, and the possible significance the mark would have in that context to the average purchaser of such products. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The Examining Attorney bears the burden of establishing with evidence that the term sought to be registered is merely descriptive of the goods specified in the application. Whether a mark is merely descriptive or is only suggestive of the goods with which it is or will be used has been recognized as a question of a highly subjective nature, and any doubts in regard to this issue are resolved in favor of the applicant. In re Aid Laboratories, Inc., 221 USPQ 215 (TTAB 1983).

Simply put, in the case now before us, the Examining Attorney has failed to meet his burden of establishing that in this country, if lipstick purchasers were presented with applicant's mark, "LIP PAINT," in connection with applicant's product, they would immediately understand the term sought to be registered as conveying significant information about the nature of the goods.

Evidence establishing mere descriptiveness can take many forms, including dictionary definitions, advertisements, purchaser declarations, surveys, trade journals, newspapers and other publications. The only evidence submitted by the Examining Attorney in support of his refusal to register in this case are excerpts from publications retrieved from the Nexis database. Including the excerpts made of record by the Examining Attorney in response to the request for reconsideration filed by applicant after the refusal to register had been made final, there are twenty-two small segments of articles from various publications.

If these excerpts had provided the Board with a basis upon which we could conclude that "LIP PAINT" is often used in connection with lipstick and therefore would be understood by purchasers to refer to lipstick or to some feature or characteristic of lipstick, this evidence would have satisfied the Examining Attorney's burden of supporting the refusal to register. As applicant points out, however, the majority of the evidence submitted in support of the refusal to register is irrelevant to our inquiry, and the few examples which could be interpreted as supporting the refusal are either unclear or, as applicant puts it, "scattered, random, idiosyncratic uses," and as

such, are not a sufficient basis upon which to conclude that the mark would be understood to provide descriptive information about applicant's goods. If the term "LIP PAINT" were, as the Examining Attorney contends, in use as descriptive terminology in connection with a type of lipstick, surely more evidence than this would be readily available to demonstrate that purchasers would attribute such a descriptive meaning to the term.

We turn, then, to an analysis of the twenty-two excerpts from published articles that constitute the entire support offered by the Examining Attorney for the refusal to register. To begin with, more than half of them are either from foreign publications or show use of the term in a foreign context. Examples include excerpts of articles published by The Financial Times (London), The Independent (London), The Daily Mail (London), and the Calgary Herald. Others either quote people in Great Britain or indicate a foreign context by stating the price of products in pounds sterling.

As this Board has repeatedly held, examples of descriptive use in foreign publications of the term sought to be registered have no probative value on the issue of descriptiveness in this country. A term may be generic for a product as used in publications in another country, but

absent a showing that such publications have a significant circulation in the United States, they can be given no weight in determining consumer perceptions in the United States. In re Consolidated Cigar Corp., 13 USPQ2d 1481 (TTAB 1989). In resolving whether a mark is merely descriptive under the Lanham Act, its meaning to people who do not constitute the purchasing public for such goods in this country is irrelevant.

Two of the twenty-two excerpts show use of the term "lip paint" in what appears to be a historical context. One refers to "lip paint" in 5000 B.C.; another refers to a law condemning "lip paint" passed in 1770 by the British Parliament. Neither of these references is relevant in determining what significance the mark would have in contemporary times to people in the United States.

The remaining excerpts submitted by the Examining Attorney in support of his contention that "LIP PAINT" would be understood as a reference to the nature of applicant's products also fall short of doing so. A 1993 article published in the Washington Post discusses a prostitute "who covers her scarred face with white-lead makeup and mercuric sulphide lip paint that will kill her as surely as labor in the mills is slowly killing Mor's sons." We have no idea what "mercuric sulphide lip paint"

is, but it does not appear from this quotation to be ordinary lipstick. Another excerpt, this one from the Baltimore Sun, mentions "lip paint" in apparent reference to stage makeup used by clowns to cover only their lower lips.

Other excerpts do refer to "lip paint," but it is not at all clear that the term is being used in reference to lipstick. For example, a quoted article from Newsday refers to both "nostril paint" and to "lip paint." These do not appear to be ordinary consumer cosmetics like lipstick. Two of the remaining references refer to the same product, "Kiehl's Pink Shine," as "lip paint," but without indicating that it is a lipstick. Another excerpt refers to "lip-paint as pouted in the film by Uma Thurman," which could be a reference to stage makeup. The final excerpt is from something called Children's Business, and although it refers to "cosmetics such as lip paint," it is not at all clear that "lip paint" is being used in reference to or as a synonym for "lipstick." In other words, these excerpted stories did not give sufficient context to understand the term "lip paint" in the stories.

In summary, the evidence submitted by the Examining Attorney falls far short of establishing that in this country, prospective purchasers of lipstick would

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understand "LIP PAINT" either as another term for "lipstick" or as conveying information about a significant feature or characteristic of lipstick. As noted above, even if we were to have any doubt on this issue, it would be necessary to resolve it in favor of the applicant.

Decision: The refusal to register under Section 2(e)(1) of the Act is reversed.

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