

This Opinion is Not
Citable as Precedent
of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chanel, Inc.

Serial No. 76/174,403

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Before Hohein, Walters and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant seeks registration of ULTRA CORRECTION for
"skin care preparations, namely moisturizer," in
International Class 3.¹ In his initial office action, the
examining attorney required applicant to enter a disclaimer
of exclusive rights to the term CORRECTION. Applicant

¹ The application was filed on the basis of applicant's intent to use the mark in commerce. Prior to briefing of this appeal, applicant filed an amendment alleging that the mark is in actual use in commerce and has been since August 16, 2001.

responded by noting its disagreement with the examining attorney's rationale for making the requirement and with the sufficiency of the evidence set forth in support of the requirement.

The examining attorney made the requirement final, thereby refusing to approve the mark for publication absent entry of the disclaimer. See Section 6 of the Trademark Act, 15 U.S.C. §1056. Applicant appealed and requested reconsideration. The request was denied, the appeal was resumed, and has been fully briefed. Applicant did not request an oral argument. We affirm the requirement for a disclaimer.

The examining attorney contends that "the term 'correction' and its immediate grammatical derivatives are commonly used in the relevant trade to denote a general type or class of cosmetics and skin care products which purport to reduce or reverse the effects of aging on the skin." Brief, p. 2. Acknowledging applicant's argument that, if the term is descriptive at all, it is only descriptive of products known as "concealers or cover-ups" but not moisturizers,² the examining attorney argues that,

² "The only Class 3 goods identified with the term 'correction' are concealers or cover-ups, which are skin-toned color cosmetics for concealment of blemishes and other imperfections. They are not moisturizers, nor are they related to moisturizers." Applicant's Brief, p. 2.

if applicant is correct, then the term is deceptively misdescriptive as used by applicant for a moisturizer. Either way, the examining attorney reasons, the term must be disclaimed as an unregistrable component of applicant's composite mark.

We are, then, left with the question whether the examining attorney has made of record sufficient evidence to establish that the term CORRECTION will be perceived as merely descriptive or deceptively misdescriptive when used in conjunction with applicant's product. In assessing the evidence and the likely perception of the term as used by applicant, we do so from the point of view of the average or ordinary consumer in the class of prospective purchasers for applicant's product. See **In re Omaha National Corporation**, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). Moreover, whether a term is merely descriptive (or deceptively misdescriptive) is determined not in the abstract, but in relation to the goods or services for which registration of the term is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser because of the manner of its use. See **In re Bright-Crest, Ltd.**, 204 USPQ 591, 593 (TTAB 1979).

In regard to the issue of descriptiveness, "[w]hether consumers could guess what the product is from consideration of the mark [or in this case, the term] alone is not the test." **In re American Greetings Corp.**, 226 USPQ 365, 366 (TTAB 1985). However, the evidence will have to establish that CORRECTION immediately describes an ingredient, quality, characteristic or feature of applicant's product or conveys information regarding the nature, function, purpose or use of the product. See **In re Abcor Development Corp.**, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978); and **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). In regard to the issue of deceptive misdescriptiveness, the evidence would have to show that the term CORRECTION misdescribes the goods; and also show that it is deceptive, that is, that consumers would be likely to believe the misrepresentation. **In re Quady Winery Inc.**, 221 USPQ 1213, 1214 (TTAB 1984).

To support the disclaimer requirement, the examining attorney has made of record printouts from the Office's computerized database of registered marks and pending applications, and excerpts of articles retrieved from the NEXIS database of publications and wire service reports. We also have considered the specimen of use filed by the applicant with its amendment to allege use, and the reprint

of a web page (submitted by applicant) that features applicant's product for sale at www.macys.com. Additional material which applicant has made of record, and which we also have considered, includes web pages retrieved from the internet, additional reprints from the Office's database of registered marks, and a full reprint (retrieved from the internet) of an article submitted by the examining attorney only in excerpt form (as retrieved from the NEXIS database).

We also acknowledge applicant's submission of copies of the file histories for three registrations it has obtained for marks that include the term CORRECTION, and reprints of information about the status of these registrations retrieved from the Office's registration database. While we have not ignored these file histories and registrations, we can give them little weight. See **In re Nett Designs Inc.**, 236 F.3d 1399, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board... must assess each mark on the record of public perception submitted with the application.")

One evidentiary dispute must be considered before we discuss the evidence. Applicant has objected to some of

the NEXIS excerpts submitted by the examining attorney, because they are derived from articles that appeared in foreign publications. The examining attorney, in contrast, argues that "the rationale of prior precedent" that discounts such publications as not reflective of the understanding of consumers in the United States "seems questionable in the current electronic information age," when "all of the sources [of the examining attorney's periodical evidence] are readily available to U.S. consumers via a few keystrokes." Brief, p. 4. Applicant acknowledges that U.S. consumers likely would have little difficulty in obtaining such information, but argues that the rationale for discounting foreign publications as evidence of the descriptiveness of a term stems from "the fact that there are different customs or usage of terms in different countries." Reply Brief, pgs. 4-5.

The Board has expressed some agreement with the point made by the examining attorney, subject to case by case review of the probative value of foreign publications available through electronic means. See **In re Jose Remacle**, __ USPQ2d __ (TTAB 2002) (Application serial no. 75/932,290) (November 18, 2002).³ In each case, the Board

³ Decision available at: <http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2002/75932290.pdf>

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can decide, inter alia, whether "customs or usage" render the foreign publications devoid of probative value.

Nevertheless, in the case at hand, we find sufficient evidence to support the disclaimer requirement without resort to the foreign publications; their consideration would, however, only bolster the basis for the requirement.

The two registrations referenced by the examining attorney are nos. 2,450,253 and 2,454,186, for a design mark (in one registration it also includes the word OBAGI). Both registrations list the goods as "skin care preparations, namely, cream, lotion, astringent, exfoliant, moisturizer, cleansing lotion, lightener, blending cream, **corrector cream**, emollient, toner, clarifier, eye cream, sun screen and sun block," in International Class 3 and "medicated skin care preparations, namely, medicated cream, lotion, exfoliant, lightener, blending cream, **correction cream**, emollient," in International Class 5. An application referenced by the examining attorney, filed by the owner of the two registrations referenced above, and for which a notice of allowance has issued, is for the mark "OMP INC" (and design) for goods identified as "non-medicated skin care preparations, namely, skin creams, lotions and solutions for the body, hands and face, skin clarifiers, sun block and sun screen, skin cleansing creams

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and lotions, skin lighteners, skin toners, skin moisturizers, skin exfoliants, cleansing gels, creams, lotions and solutions and aloe vera based gel, astringents for cosmetic purposes, skin emollients, eye creams, blending creams, skin masks, **corrector creams**; and cosmetics, namely, cream foundation, liquid foundation, **correcting cream**, concealing cream, lipstick, lip liner, eye shadow, eye liner, blush, mascara, facial loose powder, facial pressed powder, tinted skin moisturizer and nail polish; non-medicated protective lip care preparations, namely, lipstick, lip balm, lip gloss, lip cream, lip lotion and lip emollient," in International Class 3 and "medicated skin care preparations, namely, medicated cream, lotion, astringent, exfoliants, moisturizer, cleansing cream, cleansing lotion, skin lightener, blending cream, **correction cream**, mask, emollient, toner, clarifiers, eye cream, sun screen and sun block, skin lightener with sun screen; topical analgesic; and pharmaceutical preparations for the treatment of skin disorders," in International Class 5. (emphasis added)⁴

⁴ The examining attorney also made of record information regarding another application, by a different entity, that included references to "corrector cream" and "correction cream" in the respective Class 3 and Class 5 identifications. However, while the mark in that application has since been registered, the identifications apparently were limited during examination,

The NEXIS excerpts submitted by the examining attorney include the following (emphasis added):

Headline: ERASING TIME'S LINES[:] PRODUCTS EFFECTIVE AGAINST WRINKLES AND SAGGING, BUT DON'T EXPECT MIRACLES

...still alive, his search for the Fountain of Youth probably would end at a pharmacy or department store cosmetics counter where tiny jars and tubes promise to get rid of crow's-feet, laugh lines and other telltale signs of aging.

Stores that once carried just a few selections of cold creams and moisturizers now offer a variety of anti-sagging creams, **wrinkle correctors**, line erasers and skin-firming lotions.

Each line of cosmetics generally has at least three products that promise younger-looking skin, giving shoppers at least 35 choices at most stores.

The good news is that dermatologists say these products work. They can reduce some lines, make skin a little firmer and stop some of the pollutants and sun...

--*Detroit Free Press* (August 5, 2001); Byline: "Brenda Rios Free Press Business Writer"

Headline: Uber Creams; IF THEY COST \$100 PLUS, WHAT MUST THEY DO?

...share of these ingredients, simplifying the search for the fountain of youth.

That's what Moorehouse likes about her cream. "This one cream does it all—it has antioxidants, it is a good exfoliant, it moisturizes and within weeks I had a more even skin tone and my face felt softer, more hydrated."

Moorehouse became hooked—and she's hardly the only one splurging on **face creams that promise correction, retention and prevention**. The NPD Group, which tracks beauty and retail trends, reports that skin-care products—specifically anti-aging ones—showed the highest growth among department-store cosmetics last year, increasing their total sales by 6 percent to \$1.7 billion last year. ...

because the references to these and other items are not among the goods in the resulting registration.

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--*Chicago Tribune* (May 20, 2001); Byline: "By Marisa Fox. Marisa Fox writes about beauty and fashion from New York."

A third excerpt, from the *San Francisco Chronicle* (November 25, 2001), by itself, is a bit cryptic. However, applicant has placed the entire article in the record. Its headline reads "Facing winter head-on[:] A simple moisturizer isn't enough when the weather goes south" and the byline is "Cynthia Robins, Chronicle Beauty Writer." This article reports that "winter skin" is "tight and dry"; that "[t]emporary fixes like a good moisturizer can make your skin feel better," but the "best kind of moisturizer, particularly in the winter, will aid and abet the skin in taking care of itself, and should contain some kind of AHA (alpha hydroxy acid) or glycolic." The article goes on to provide advice about proper use of such products. In a sidebar piece on "WEATHER-PROOFING SKIN" readers are provided with a "very simple four-step system" to "protect and defend" their skin. This piece reminds readers to "cleanse," "hydrate," "correct" and "protect" their skin. The sidebar also recommends products. Those products that "correct" are "AHAs [which] are in a sense anti-oxidants as well as exfoliants and do double duty. They hold down free-radical production."

Applicant's product, according to the web page showing the product for sale at www.macys.com, is a "highly effective lightweight lotion. Skin is firmed, resculpted and thoroughly hydrated. The look of wrinkles is dramatically reduced. Boosts skin's natural processes at all levels. Most effective when used after exclusive massage based on principles of plastic surgery. SPF 10 provides UV protection." On the specimen carton for applicant's product is the following introduction for a listing of the benefits of use: "Lightweight lotion with synergistically effective ingredients that act simultaneously to **correct** every sign of age." (emphasis added)

Applicant insists that the "distinction between color cosmetics and skin care products (including moisturizers) is important." Brief, p. 2. Applicant argues that its evidence, including web pages and information on registrations for other marks shows that "correction" is used in Class 3 only for color cosmetics, not moisturizers, and that the term "correction" could not be found at all in searches for that term on the www.sephora.com and www.gloss.com websites, which feature beauty products. Applicant also minimizes the significance of the NEXIS excerpts, irrespective of whether they are from U.S. or

foreign publications, and even the full article from *The San Francisco Chronicle*, because only one uses the precise term "correction," while the others use "corrects," "corrector(s)," or "corrective." In direct contrast to the examining attorney, applicant argues that uses of any term other than "correction" per se are not relevant to our inquiry. Finally, applicant argues at length that its success in obtaining registrations for three other marks containing the term CORRECTION is "clear evidence that Applicant has trademark rights in the term CORRECTION for moisturizers" and that it "would be most unreasonable to require a disclaimer for this mark [ULTRA CORRECTION], and thereby limit Applicant's exclusive rights in the term CORRECTION, which has already been granted as a result of the recently issued previous registrations." Brief, p. 6.⁵

We disagree with applicant's assertion that the only relevant evidence is that which would show use of

⁵ Applicant also appears to lay blame for the disparate treatment of its applications at the feet of the "mystified" male examining attorney who has required the disclaimer in this instance. Reply Brief, pgs. 3-4. [The file histories for applicant's three previous registrations, which applicant submitted, reveal that those applications were examined by female examining attorneys.] We make no assumptions about the familiarity of any of the examining attorneys with cosmetics. Of course, any such familiarity, or lack thereof, would be irrelevant to each examining attorney's inquiry, which must be based on the evidence that applicant and each examining attorney put into each record, and must be focused on likely perception of a term or mark by the relevant public.

"correction" per se with moisturizers. A product that, like applicant's, is used "to correct" can aptly be called a "corrector" or "corrective" and the result when the product is used is a "correction." Thus each of the terms can be descriptive insofar as one term may describe the product, another may describe its action or effect, and another may describe the result obtained. Accordingly, we consider the NEXIS evidence, *The San Francisco Chronicle* article, and registration evidence as probative of the existence of a class of cosmetic products intended to moisturize or hydrate and, at the same time, effect corrections in one's skin. That applicant has submitted copies of some registrations or web pages that show correction also is a term used for a different class of products known as concealers or color cosmetics does not reduce the probative value of the evidence regarding skin care products that correct skin itself rather than correct color imbalances.

We also disagree with applicant's contention that correction is only used for concealers or color cosmetics. The two registrations made of record by the examining attorney list products that appear to be in the class of products known as concealers or color correctors, e.g., "lightener" and "blending cream" and "toner." But they

also list products that appear to treat rather than mask the condition of the skin, e.g., "astringent, exfoliant, moisturizer," and "emollient." We find nothing in the record that would support the contention that the listing, in these registrations, of "corrector cream" and "correction cream" are references solely to color correctors, as opposed to skin correctors. Indeed, because identifications, in the absence of limitations, are presumed to include all products within the scope of the terms employed, registrant could be referring to both types of products. Further, the application that the examining attorney has made of record specifically lists "corrector creams," "correcting cream, concealing cream," and "blending cream, correction cream." There does not appear to be any reason to assume that "correcting cream" and "correction cream" are references to concealers, when there is a separate listing for "concealing cream."⁶

Likewise, the NEXIS excerpts and *San Francisco Chronicle* article clearly discuss products which are more than just color correctors and work to correct deficiencies or problems in the skin itself. Applicant's product, by

⁶ In addition, insofar as "correction cream" is identified as a Class 5 medicated product, this clearly is more than a mere concealer or color product.

the legends on its own carton also work on the skin itself. The specimen carton refers to the product as an "anti-wrinkle restructuring lotion," which "boosts natural processes" by which "skin is 'bonded' to its support system"; wrinkles are "reduced"; skin is "firmed and resculpted"; the product provides "continuous hydration"; and "protects against UVA/UVB rays and skin-damaging free radicals."

On this record, we can only conclude that applicant's product is much more than a mere moisturizer and is to be considered within that class of products that corrects skin problems. As such, we find the term "correction" to be an apt description of the type of moisturizer and of the result the user will obtain for his or her skin. We cannot concern ourselves with applicant's other registrations, which are not before us. *Nett Designs, supra*. Therefore, disclaimer of the merely descriptive term CORRECTION is appropriate in this case. Applicant has not argued that the mark is unitary or presents a unique commercial impression such that disclaimer of the merely descriptive term is not necessary.

Because we find "correction" to be descriptive of applicant's product, we do not reach the alternative issue

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of whether the term is deceptively misdescriptive of applicant's product.

Decision: The requirement under Section 6 of the Trademark Act, 15 U.S.C. § 1056, for a disclaimer of "CORRECTION" apart from the mark as a whole, is affirmed.

The refusal of registration in the absence of a disclaimer will be set aside and the mark published for opposition if applicant, no later than 30 days from the mailing date hereof, submits an appropriate disclaimer. See Trademark Rule 2.142(g).