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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Maria Fatima Rizzo

Serial No. 75461632

**Kenneth Florek** of Hedman & Costigan, P.C. for Maria Fatima Rizzo.

**Edward Nelson**, Trademark Examining Attorney, Law Office 106 (Margaret K. Le, Managing Attorney).

Before Cissel, Walters and Chapman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 3, 1988, the above-identified applicant applied to register the mark shown below

SEPIA

on the Principal Register as a trademark for "cosmetics, cosmetic cream," in Class 3. The basis for filing the application was applicant's assertion that she had a bona

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fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of the goods with which applicant intends to use it. The Examining Attorney held that the term at issue is merely descriptive because it identifies "the color and/or shading which will result from the use of applicant's goods." Attached to the refusal to register in support of this finding was a dictionary definition of the word "sepia" as a noun naming a "Color," "a dark grayish yellow brown to dark or moderate olive brown;" and as an adjective indicating "the color sepia."<sup>1</sup> Applicant was also advised that the identification-of-goods clause was unacceptably indefinite, requiring amendment to specify the goods with which applicant intended to use the mark. The words "cosmetics, namely, skin creams," were suggested by the Examining Attorney as an acceptable identification of goods.

Applicant responded by amending the application to identify the goods as "cosmetics, namely foundation,

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<sup>1</sup> The American Heritage Dictionary of the English Language, Third Edition, 1992, electronic version.

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corrector, powder, blush, eye shadow, eyeliner, mascara, lipstick, lip liner, lip gloss, and skin cream," and by arguing that the refusal to register was not well taken. In this regard, applicant stated that her cosmetics are offered in a wide array of colors and shades, and that "use of applicant's products will not result in the user's skin turning a dark grayish yellow brown to a moderate olive brown color." Additionally, applicant argued that "sepia" has a number of definitions, including "an ink or pigment," "a picture or drawing done in the pigment," and "a photograph done in a brown tint." Noting that only one definition is that of a color, applicant argued that because a color is not the primary definition of the word, the primary significance of the word cannot be said to be that of the color, and that therefore the mark cannot be held to be merely descriptive of the goods set forth in the application.

The Examining Attorney was not persuaded by applicant's arguments on the issue of mere descriptiveness, nor did he accept the proposed amendment to the identification-of-goods clause. He reiterated his conclusion that because the dictionary definition indicates that "sepia" identifies "a number of different colors or shades," and the goods are a variety of cosmetic

preparations used for coloring or shading, the word is merely descriptive of the goods. Additionally, he held that the word "corrector" in the amended identification goods was unacceptable because it is indefinite, and required applicant to amend the identification to specify the commercial name of this product.

Applicant responded by deleting the term "corrector" and substituting therefore the term "skin tone corrector." In addition, applicant presented additional arguments against the refusal to register based on mere descriptiveness. Applicant contended that whether or not the word describes a color or shade does not render its use as a trademark for cosmetics merely descriptive, and asserted that the term sought to be registered, in connection with the specified cosmetics, does not immediately convey information concerning the ingredients, qualities or characteristics of the goods.

The Examining Attorney apparently accepted the amendment to the identification-of-goods clause, but maintained and made final the refusal to register under Section 2(e)(1) of the Act. He concluded that "[s]leepia is by definition a color which describes the effective or intended result use of the goods will have upon the human

skin as a cream or skin tone corrector, to wit, to adjust the color or appearance of the skin."

Applicant responded to the final refusal to register with another amendment to the identification-of-goods clause in the application, deleting reference to cosmetic creams and skin tone corrector. This time, the goods were identified as "cosmetics, namely foundation, powder, blush, eye shadow, eyeliner, mascara, lipstick, lip liner, and lip gloss."

The Examining Attorney apparently accepted the amendment to the identification of goods, but he maintained the refusal to register, attaching excerpts retrieved from an automated database of newspapers and magazines wherein in the word "sepia" is used in connection with "skin" and "complexion." In one example, a woman is described as "a sepia-skinned knockout." In another, a man is described as having "dark eyes and sepia skin." Yet another describes and "elegant" woman as having "sepia-colored skin."

Applicant's response was to amend the application to request registration on the Supplemental Register. In support of the amendment, applicant submitted a "Declaration of Use," claiming use of the mark in connection with the goods specified in the application in interstate commerce as early as February of 1999.

Noting that "sepia" "denotes the color or appearance of the skin that will be created as result of the use of the goods by the purchasing public," the Examining Attorney stated that "sepia" "simply cannot act as a source indicator of the goods." Accordingly, he refused registration on the Supplemental Register under Section 23 of the Act, 15 U.S.C. Section 1091, on the ground that the mark is not capable of identifying applicant's goods and distinguishing them from those of others.

Applicant disagreed with the Examining Attorney's contention that a color designation cannot act as a source indicator of cosmetics. Citing third-party registrations on the Principal Register for the marks "RED," "SNOW WHITE" and "LA BLANCHE" which had been made of record responsive to an earlier Office Action, applicant argued that her mark is plainly capable of functioning as a trademark for cosmetics, and that as such, registration on the Supplemental Register should be allowed. Additionally, applicant argued that even if a word has descriptive significance in connection with particular products, a distinctive display of such word nonetheless qualifies for registration, so that applicant's stylized version of the word "sepia" in the case at hand makes her mark capable of

being recognized by consumers as a source indicator for her products.

Once again, the Examining Attorney was not persuaded by applicant's arguments, and the refusal to register the mark on the Supplemental Register was continued and made final. Additional excerpts from various publications and web sites were enclosed. In each, "sepia" is used to identify the color of the particular cosmetics with which the term is used. Examples include "Sepia Eye Shadow"; "Lip Glaze in Sepia"; lipstick identified as "Max Factor Sepia"; gel liners in "sepia and violet"; and other lipsticks in "colors like Scarlet Fire, Purple Haze, Sepia, Brown Sugar and Pink Satin."

With respect to the third-party registrations cited by applicant, the Examining Attorney noted that such registrations are not determinative of the issue of mere descriptiveness, and that each case must be decided on its own merits. Based on the evidence of record, he concluded that "[t]he term SEPIA is a designation devoid of any modicum of uniqueness, ingenuity, or originality, and as such is not registerable upon the Supplemental Register."

Applicant filed a timely Notice of Appeal. Both applicant and the Examining Attorney filed briefs on appeal, and applicant filed a reply brief. Then the Board

remanded the application to the Examining Attorney for consideration of whether registration on the Supplemental Register was appropriate in view of the fact that no specimens had been filed in connection with applicant's claim of use of the mark, as well as for the Examining Attorney to consider whether the display of the word "sepia" is sufficient to support registration on the Supplemental Register even if the word itself is not registrable in connection with the goods set forth in the application, as amended.

On remand, the Examining Attorney held that the word is not presented in a distinctive display and is not inherently distinctive in connection with the specified goods. He found that the mark sought to be registered creates no commercial impression apart from the ordinary meaning of the word "sepia." He also required additional specimens of use of the mark.

Applicant responded by submitting the required specimens and arguing that the word "sepia" is not generic because it does not name any cosmetic products, but instead functions as the trademark for applicant's goods. Further, applicant argued that her mark, by virtue of its stylized presentation, creates a commercial impression separate and apart from any of the multiple meanings of the word

"sepia." Applicant contended that she is not attempting to register a stylized version of a generic term such as "cosmetics," but rather that she seeks to register a distinctive stylization of a merely descriptive word in connection with her products. Under these circumstances, applicant argues, registration on the Supplemental Register is mandated because the mark is capable of identifying applicant's goods and distinguishing them from similar goods from other sources.

The Examining Attorney concluded that the stylized presentation of the term is not so distinctive that it creates a separate commercial impression apart from the word itself. Accordingly, he maintained the refusal to register on the Supplemental Register and returned to the application to the Board for determination of the appeal on its merits.

After careful consideration of the issues presented in this appeal in light of the statute, the relevant legal precedents and the arguments and evidence presented by both applicant and the Examining Attorney, we hold that applicant's mark is not registrable on the Supplemental Register because it is not capable of identifying applicant's cosmetics and distinguishing them from similar products emanating from other sources. Simply put, while

"sepia" is not a generic term, in the sense that it is not the name of any particular cosmetic product, the term is nonetheless incapable of distinguishing cosmetics from any single source because, as the record shows, it is used to identify a color of the goods, irrespective of their source, and hence must remain in the public domain, so that any seller or manufacturer of cosmetics retains the ability to tell prospective purchasers that its goods are available in the color sepia. A shopper considering buying lipstick, for example, upon viewing such goods bearing the mark applicant seeks to register, will understand from the mark that the goods bearing it are colored sepia. This record does not support applicant's contention that such a person will understand the term as indicating that applicant is the source of such goods.

Although, as noted above, applicant has argued that the stylization in which the word "sepia" is presented creates a commercial impression separate and apart from that of the word alone, this argument is unpersuasive. The stylization employed in the lettering which comprises this mark is neither unique nor particularly unusual. It creates no special commercial impression apart from the word in its ordinary sense. Under these circumstances, the style of lettering employed by applicant does not make this

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otherwise ordinary term capable of functioning as a trademark. The absence of this capability is fatal to registration on the Supplemental Register.

We note that the Examining Attorney is correct in his contention that he is not bound by the third-party registrations cited by applicant to reach a different conclusion. As he stated in his Office Action, each case must be decided on its own merits and record. In re Nett Designs, Inc., 736 F.3d 1339, 57 USPQ2d 1546 (Fed. Cir. 2001).

Decision: The refusal to register under Section 23 of the Lanham Act is affirmed.