

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: May 12, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Roy G. Geronemus, M.D., P.C.

Serial No. 76238774

Douglas A. Miro of Ostrolenk, Faber, Gerb & Soffen, LLP for
Roy G. Geronemus, M.D., P.C.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K.
Margaret Le, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 10, 2001, Roy G. Geronemus, M.D., P.C. (a New
York corporation) filed an application to register on the
Principal Register the mark LASER TONING for services
ultimately amended to read "medical services, namely, skin
rejuvenation" in International Class 42. The application
is based on applicant's claimed dates of first use and
first use in commerce of March 1999 and December 1999,
respectively.

In the first Office action, the Examining Attorney, inter alia, refused registration of the mark as merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). In response, applicant stated that it did not consider the mark to be merely descriptive, but nevertheless requested that the application be amended to seek registration on the Supplemental Register.

The Examining Attorney "noted" applicant's amendment to the Supplemental Register, but again refused registration on the Principal Register on the basis that the mark is generic for the identified services. Applicant responded with argument that its mark is not generic and is not merely descriptive, but is suggestive; and that the mark is eligible for registration on the Principal Register, but alternatively, applicant would agree to registration on the Supplemental Register.

A different Examining Attorney issued the next Office action, stating that "Applicant amended to the Supplemental Register..." and making final the refusal to register the mark as generic for the identified services, citing Sections 2(e)(1) and 23 of the Trademark Act, 15 U.S.C.

§§1052(e)(1) and 1091. (Final Office action, November 14, 2002.)¹

Applicant filed an appeal to the Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

In applicant's request for reconsideration and in the briefing of this appeal, applicant has maintained its position that registration should be allowed on the Principal Register and, alternatively, that applicant would agree to registration on the Supplemental Register. The second Examining Attorney continued, made final and briefed, the refusals under Section 2(e)(1) for the Principal Register and Section 23 for the Supplemental Register. See TMEP §816 (4th ed. 2005).

It appears from the entire prosecution history that the Examining Attorney and applicant have treated the application as seeking registration on the Principal Register and, in the alternative, on the Supplemental Register. The ultimate legal question presented by the final refusal to register is whether the term LASER TONING is generic and therefore unregistrable on the Principal

¹ Section 2(e)(1) of the Trademark Act, of course, is not an appropriate basis for refusal for application for registration on the Supplemental Register.

Register under Section 2(e)(1) and on the Supplemental Register under Section 23.

The Office bears the burden of proving that the proposed trademark is generic, and genericness must be demonstrated through "clear evidence." See *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, *unpubl'd*, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994), citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

In support of his refusal to register applicant's applied-for mark as generic, the Examining Attorney submitted (i) printouts of pages from applicant's website; (ii) printouts of pages from various published stories and from third-party websites; and (iii) copies of excerpted stories retrieved from the Nexis database, all to show

generic use of the term "laser toning." Examples of the evidence follow (emphasis added):

HEADLINE: Nonablative Lasers Can Repair Sun Damaged Skin
...new layer of collagen leads to improved skin tone and texture, and a decrease in wrinkles and scars. This procedure is known as **laser toning**. ...
...and may be preceded by a 30-minute application of a topical anesthetic cream. Following **laser toning** procedures, the skin may appear red and blotchy for a period of several hours. ...
...extensive sun damage and skin aging, who have undergone other invasive laser or surgical procedures. In these older patients, **laser toning** is used to improve the skin texture and color and return the skin to its youthful appearance.
"Health & Medicine Week," September 16, 2002;

HEADLINE: Banish Wrinkles in an Hour!
(For a While, Anyway)
...
Lasers
Nonablative laser treatment: Also called **laser toning**, this procedure uses a combination of minimally invasive lasers--like the Nd/YAG and diode--to encourage the growth of new collagen. "We try to stimulate collagen within the skin's dermis, the deeper layer of the skin," said Dr. Roy Geronemus, a dermatologist and director of the Laser and Skin Surgery Center of New York, who helped develop the technique. ...
"The New York Times," June 24, 2001;²

² It is noted that this article refers to applicant's principal. The impact of this article will be addressed infra.

HEADLINE: Uncovering Beauty: Inspired To Show A "New You" To The World?...

...**Laser Toning** Also called "photopeel." Makes skin glow. Firms up collagen over time.

Cost: Hundreds of dollars.

Procedure: Using gentle laser and light energy on the skin. Unlike deep laser skin resurfacing, these lighter procedures don't remove skin from the surface and don't create skin wounds...

"Better Homes and Gardens," February 1, 2002;

Island Dermatology and Laser Institute
in Palm Beach, Florida

Cooltouch Laser

...

Laser toning is the new buzz heard in the offices of cosmetic dermatologists and plastic surgeons around the country. A new technique of facial rejuvenation, **laser toning** is a long-sought-after way to return the glow to aging skin without undergoing the trauma of skin resurfacing.

Good skin tone is a mark of youthful appearance. When you see a well-toned face, you're not just seeing tight skin; it's more about that special luster or sheen of the skin....

...

Doctors and patients have found that four or five toning treatments, a month or so apart, progressively bring about a tightening of the skin as well as a reduction of fine wrinkles and small scars. But it's [sic] primary effect is to bring the glow back to your facial skin. **Laser toning** has been shown to reduce or delay the signs of aging, postpone more aggressive treatments and/or prolong the results of previous treatments.

...

The medical term for **laser toning** is non-ablative collagen tightening. "Non-ablative" means tissue is not vaporized or otherwise peeled off the face as happens with skin resurfacing.

Why doesn't the toning treatment hurt the surface of your skin?

For one thing, **laser toning** uses different types of light energy than laser resurfacing does.

...

Many people can benefit from **laser toning**. The ideal candidate is 45-70 years old, ...

www.islanddermatology.com;

Welcome to Coastal Dermatology (Mystic, Connecticut)

...

Daniella Duke, M.D., M.P.H.

...We also offer a variety of ... skin rejuvenation treatments, including ... chemicals peels, laser resurfacing, ... **laser toning** treatments.

www.coastaldermatology.com; and

Martin J. Luftman, M.D.

Plastic and Reconstructive Surgery
(Lexington, Kentucky)

...

Procedures Performed

Body Contouring

Tummy Tuck

Liposuction

Breast Surgery

Augmentation

Reduction...

Facial Rejuvenation

Blepharoplasty

Browlift

Facelift

...

Laser Skin Resurfacing

...

Our office also provides the following services...

Skin Care

Permanent Cosmetics

Laser Toning

Laser Vascular Treatments

www.liposite.com.

The following statements are quoted from applicant's website:

Laser-Toning Facial Rejuvenation From
The Laser & Skin Surgery Center of New York
The Ultimate Workout For Your Face

...

Safe enough for all pigmentation and skin types, **Laser-Toning** Facial Rejuvenation delivers laser energy through your skin's surface to gently stimulate collagen growth and to tighten and soften the appearance of skin, leaving you with a visibly firm and glowing face; and

Laser Skin Surgery News
In This Issue

...

Laser Toning for a Youthful Appearance
New Leg Vein Treatments
Lasers to Treat Specific Medical Problems

...

Advances in Laser Hair Removal

...

www.laserskinsurgery.com.

The Examining Attorney argues that the term "laser toning" is understood by the relevant purchasing public as a generic name for applicant's services as shown by, inter alia, the uses in general circulation publications, such as "Better Homes and Gardens" and "The New York Times" to refer to a skin rejuvenation procedure, and by the websites

of several dermatologists or other doctors who use the term in their practices to name one of the procedures they offer; that applicant cannot register a generic term even if it was the first to use the term, this being true whether a term became generic recently or over a long period of time; and that trademark rights are not static, and eligibility to register must be determined based on the facts and evidence of record at the time registration is sought.

Citing *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, supra, 4 USPQ2d at 1143, applicant argues that the Examining Attorney's evidence does not meet the required burden of proof, namely, "a substantial showing... based on clear evidence"; and that in the Merrill Lynch case the Court held there was not clear evidence that the financial community used the term (CASH MANAGEMENT ACCOUNT) generically, and there was no evidence that the term had been used prior to being introduced by Merrill Lynch. Applicant argues that in the case now before the Board, all of the Examining Attorney's evidence is recent and occurred after applicant's date of first use in 1999 (including one article in which Dr. Roy Geronemus is quoted); that not enough time has elapsed for the term to be considered generic; and that "at most, the evidence submitted by the

Examining Attorney has shown that the mark is highly descriptive, but that is not a basis for refusing registration on the Supplemental Register." (Brief, p. 6, emphasis in original.)³

The test for determining whether a designation is generic, as applied to the goods or services in the application, turns upon how the term is perceived by the relevant public. See *Loglan Institute Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). See also, *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

Based on the recitation of services herein, and the printouts from applicant's website, we find that the answer to the first Marvin Ginn question, namely, the genus of the involved services herein, is "medical services, namely,

³ Applicant later argues that its mark is not merely descriptive, but rather is "suggestive" of its services. (Brief, p. 9.)

skin rejuvenation treatments done through the use of laser."

We turn then to the second Marvin Ginn question, namely, whether the term "laser toning" is understood by the relevant public primarily to refer to the service of providing skin rejuvenation treatments through the use of laser.

The Examining Attorney's evidence establishes that the term "laser toning" is generic for applicant's medical skin rejuvenation services. We point out that in the Merrill Lynch case, supra, 4 USPQ2d at 1143, the evidence "showed recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was the appellant." That is not the case herein. Even in the story from "The New York Times" in which Dr. Geronemus is quoted, the use of "laser toning" remains a generic use, referring to "nonablative laser treatment: Also called laser toning..." with no reference in the excerpt that "laser toning" is a service mark owned by his corporate entity. That is, the uses of record in general circulation publications and third-party websites of several other doctors do not show mixed uses. To the contrary, all are generic uses of the term "laser toning" with regard to skin rejuvenation services. See *In re Boston Beer Co. L.P.*, 198

F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); In re A La Vielle Russie, Inc., 60 USPQ2d 1895 (TTAB 2001); Continental Airlines Inc. v. United Airlines Inc., 53 USPQ2d 1385 (TTAB 1999); In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999); In re Central Sprinkler Co., 49 USPQ2d 1194 (TTAB 1998); and In re Conus Communications Co., 23 USPQ2d 1717 (TTAB 1992).

Even assuming *arguendo* that the term "laser toning" was initially used by applicant as a service mark, the term is clearly now used by the dermatology industry as the generic name of the involved service, and the relevant public so understands the term. The Court pointed out in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 13 (CCPA 1982), "that trademark rights are not static and that the right to register must be determined on the basis of the factual situation as of the time when registration is sought."

In this case, the record shows that others in the industry use the term in a generic manner. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). And a generic term is not subject to appropriation as a trademark or service mark because generic terms should be freely available for use by competitors. See 2 J. Thomas McCarthy, McCarthy on

Trademarks and Unfair Competition, §§12:2 and 12:59 (4th ed. 2004).

We find that the evidence of record establishes that the term "laser toning" is understood by the relevant public primarily as the generic name for a skin rejuvenation procedure whereby a laser is used to promote a better tone or glow to the skin. Both prongs of the Marvin Ginn test having been met, we find that applicant's proposed mark is generic.

Because genericness is the ultimate in mere descriptiveness, the term is prohibited from registration on the Principal Register by Section 2(e)(1) of the Trademark Act. Further, because a generic term is incapable of distinguishing applicant's services from those of others, it is prohibited from registration on the Supplemental Register by Section 23 of the Trademark Act.

Decision: The refusals to register on the Supplemental Register and on the Principal Register are affirmed.