

To: Med-Aesthetic Solutions, Inc. (ndg@techmark.com)

Subject: U.S. TRADEMARK APPLICATION NO. 87440645 - SALTFACIAL L'AVANTAGE - N/A - Request for Reconsideration Denied - Return to TTAB

Sent: 2/25/2019 10:36:10 AM

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION
SERIAL NO. 87440645

MARK: SALT FACIAL
L'AVANTAGE

87440645

CORRESPONDENT

ADDRESS:

NEIL D
GREENSTEIN
TECHMARK
1968 S COAST
HWY#1636
LAGUNA BEACH,
CA 92651

**GENERAL TRADEMARK
INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: Med-
Aesthetic Solutions, Inc.

**CORRESPONDENT'S
REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT

E-MAIL ADDRESS:

ndg@techmark.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 2/25/2019

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement made final in the Office action dated March 8, 2018, is maintained and continue to be final: Disclaimer. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

EXAMINING ATTORNEY'S RESPONSE TO NEW ARGUMENTS AND EVIDENCE

In an attempt to overcome this requirement, the applicant has amended its identification of goods to the following (additional limiting language **bolded** and underlined):

Class 10: *Medical apparatus and instruments for abrading, peeling and resurfacing tissue, **sold exclusively to licensed medical professionals**; Medical apparatus, namely, light based devices for performing medical and aesthetic skin treatment procedures; phototherapeutic apparatus for medical purposes, namely, a LED (light emitting diode) light source for medical and aesthetic skin treatments, **sold exclusively to licensed medical professionals**; medical apparatus using ultrasound for performing medical and aesthetic skin treatment procedures, **sold exclusively to licensed medical professionals***

Although the amendment does not limit the sale of every good in the identification of services to licensed medical professionals (Medical apparatus, namely, light based devices for performing medical and aesthetic skin treatment procedures), even if it had, this amendment would not overcome the disclaimer requirement.

In arguing that the "SALTFACIAL" portion of the mark is not merely descriptive, the applicant focuses on three themes: the proper consumers for determining descriptiveness are licensed medical professionals; two third-party registrations negate the disclaimer requirement and control the registrability of this mark; and the applicant's goods do not perform beauty treatments for the face.

A. Proper Consumer to Determine Descriptiveness

The applicant argues medical professionals are the proper consumer to determine descriptiveness based on the Federal Circuit's holding in *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-964; 67 U.S.P.Q. 2D (BNA) 1778, (Fed. Cir., 2007)(citing *In re MBNA A, Bank N.A.*, 340 F.3d 1328 (Fed. Cir. 2003)). In *MBNA*, the court held, "a mark is merely descriptive if the **ultimate** consumers immediately associate it with a quality or characteristic of the product." *Id.* at 1332. Additionally, the court held in *MBNA* that, "it is the perception of the **ultimate** consumer that sets the standards for determining mere descriptiveness." *Id.* at 1335 (citing *Nett Designs*, 236 F.3d at 1341 (Fed. Cir. 2001)). Contrary to the holdings in these cases, the applicant has conflated "purchaser" with "consumer." In *MBNA*, the Federal Circuit established the consumer, not the purchaser, determines descriptiveness. In addition to the evidence provided in the previous Office Actions, the evidence attached here

comprised of YouTube videos, videos posted on Facebook, third-party websites, or articles written by third-parties, further demonstrates the average person is the ultimate consumer of the applicant's goods because the goods are used to perform beautifying face treatments on them. Because the average person uses the applicant's goods, the average person is the proper consumer to determine whether the "SALTFACIAL" portion of the proposed mark is merely descriptive when used in connection with the applicant's goods. Assuming *arguendo* that medical professionals are the relevant consumers to determine whether the "SALTFACIAL" portion of the proposed mark is merely descriptive, the applicant has not demonstrated medical professionals will not immediately know the applicant's goods are for beautifying the face with salt. A single declaration from an allegedly unbiased medical professional unaffiliated with the applicant does not establish medical professionals will not immediately know the purpose of the applicant's goods from the proposed mark. Conversely, on his LinkedIn post, Dr. Jason Emer clearly understands the applicant's goods are for providing facials. See attached evidence.

"Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods are, but "whether someone who knows what the goods are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Mueller Sports. Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018). In this case, the proper consumer is the average person because of the manner in which the applicant's goods are used. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). The evidence referenced above demonstrates consumers will understand the purpose of the applicant's goods is to beautify the face using salt because the applicant or third-parties extoll the benefits of using the applicant's goods to perform beautifying facial treatments with salt. Since consumers will understand the purpose of the applicant's goods when encountering the proposed mark, the "SALTFACIAL" portion of the proposed mark is merely descriptive.

Lastly, the applicant has cited the holding in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F. 2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983) as a basis for claiming the "SALTFACIAL" portion of the proposed mark is not descriptive because medical professionals are sophisticated. This case is not analogous to the case at bar because the analysis of sophisticated purchasers revolves around a likelihood of confusion *inter partes* dispute, not an *ex parte* merely descriptive refusal. Essentially, the District Court in this case found that sophisticated consumers would not be confused as to the source of the parties' goods; the case does not address descriptiveness. Because *Astra* does not address descriptiveness, the applicant's reliance on this case is misplaced.

B. Third-party Registrations

The applicant argues because the Office has permitted the registration of Registration Nos. 4317059, "HYDRAFACIAL" and 3341027, "HYDRAFACIAL MD" used in connection with medical instruments for peeling and resurfacing tissue, demonstrates "FACIAL" is not a descriptive term when used in connection with the applicant's goods. As already articulated in the Final Office Action, neither the examining attorney nor the Board are bound by prior decisions involving different records. Even if the examining attorney or the Board were bound by previous decisions, the third-party registrations cited by the applicant are not analogous to the applicant's mark.

First, third-party registrations featuring goods the same as or similar to applicant's goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *E.g.*, *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (quoting *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992)); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). The attached third-party registrations use the term "FACIAL" in connection with goods that are the same as or similar to the applicant's goods and all of these third-party registrants have disclaimed "FACIAL" or have registered their marks on the Supplemental Register. Even though the applicant has pejoratively characterized the examining attorney's actions as clearly substituting his own personal beliefs for evidence of what is perceived in the marketplace, what is clear from the attached third-party registrations is the applicant's industry has acknowledged "FACIAL" is descriptive when used in connection with the applicant's goods.

Second, the applicant's citation of the "HYDRAFACIAL" marks are examples of unitary marks. See TMEP 1213.05. Obviously, the applicant is already aware of this concept: why else would the applicant choose to display its mark as a compound word, rather than as two separate words? See TMEP 1213.05(a). Of the remaining marks on the register that have not disclaimed "FACIAL" when used in connection with goods that are the same or similar to the applicant's goods, all of the marks have not disclaimed "FACIAL" because the wording is included in a non-descriptive unitary phrase. See attached third-party registrations. Because the "HYDRAFACIAL" marks are non-descriptive unitary marks and the applicant's mark is not, the applicant's reliance on these marks as a basis for the registration of its mark is misplaced.

Third, of the marks on the register that use "HYDRA" in connection with goods that are the same as or similar to the applicant's goods, the registrants have not disclaimed "HYDRA" nor have they registered their marks on the Supplemental Register. See attached third-party registrations. Additionally, the Office has not required the disclaimer of "HYDRA" in Application No. 88108594. Because the Office has not held "HYDRA" descriptive when used in connection with goods the same as or similar to applicant's goods, "HYDRA" is distinctive and at least suggestive. Since the "SALTFACIAL" portion of the applicant's mark is descriptive and "HYDRA" is distinctive, the applicant's reliance on any registration with the wording "HYDRA" used in connection with goods the same as or similar to the applicant's goods as a rationale for overcoming the disclaimer requirement is wrong.

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