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Mailed:
March 6, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marcon

Serial No. 76596736

Robert Victor Marcon (pro se).

Barbara A. Gaynor, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Zervas and Kuhlke, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On June 9, 2004, Robert V. Marcon (proceeding pro se)
filed an application under Trademark Act Sections 1(b) and
44(d), 15 U.S.C. §§ 1051(b) and 1126(d), for registration
of the mark L'OREAL PARIS (in standard character form) on
the Principal Register for goods ultimately amended to
"aloe vera drinks" in International Class 32.

The examining attorney has refused registration of
applicant's mark pursuant to Section 2(a) of the Trademark
Act, 15 U.S.C. 1052(a), on the ground that applicant's mark

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consists of or comprises matter which falsely suggests a connection with L'Oréal, S.A. ("L'Oréal"), which the examining attorney states is a French cosmetics and beauty products company.

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Trademark Act Section 2(a) states, in relevant part,

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it - (a) consists of or comprises ... matter which may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.

In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in *Notre Dame*, required that the following four

elements be satisfied in order to establish a false suggestion of a connection under Trademark Act Section

2(a):

(i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed.

Id. at 429.

In this ex parte proceeding, it is the Office which must establish the elements relating to the "plaintiff's" name, which is the name with which the examining attorney asserts the applicant's mark falsely suggests a connection. Because we find that the Office has not established the fourth factor set forth in *Buffett*, namely, that L'Oréal is of sufficient fame or reputation to consumers in the United States that, when applicant's mark is used on its goods, a connection between the marks and company would be presumed, we reverse the refusal of registration.

We first address one preliminary matter, i.e., the examining attorney's submission of an entry for "L'Oréal" from wikipedia.org. Although Wikipedia entries have inherent limitations because an article at any given time

may contain significant misinformation, "the Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information." *In Re IP Carrier Consulting Group*, 84USPQ2d 1028 (TTAB 2007). In this case, the examining attorney submitted the Wikipedia entry with her denial of applicant's request for reconsideration. Inasmuch as applicant did not have an opportunity to rebut the Wikipedia evidence, we accord it no probative value.¹

In contending that L'Oréal "is world-famous," the examining attorney relies on the following evidence taken from the Internet:

"[T]he L'Oreal Group has developed activities in the field of cosmetics, and is the world leader in the cosmetics industry. The L'Oreal Group is also active in luxury goods and in the dermatological and pharmaceutical fields."
loreal.com

"Why is L'Oreal USA the leading beauty company in America? *** L'Oreal USA is a leader in beauty:
#1 Professional Salon Products (Matrix)
#1 Ethnic Hair Care (Soft Sheen/Carson)
#1 Mass Market Hair Color (L'Oreal Paris)

¹ While the opportunity to request remand to submit new evidence is available to an applicant, the evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Trademark Rule 2.142(d). Thus, in view of the inherent limitations of Wikipedia entries, examining attorneys should submit these entries prior to a request for reconsideration.

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#1 Mass Market Cosmetics (Maybelline)
#1 Prestige Men's Fragrances (Ralph Lauren)
#1 Overall beauty brand (L'Oreal Paris)

*** Always on the leading edge of technology for its industry, L'Oreal research produces several hundred patents a year. This prolific activity places us in the top 100 research companies in the nation, ahead of all of our competitors.

L'Oreal is the leading beauty company in the United States, in Canada, in Mexico - and in the world!"

lorealusa.com

"The world's leading beauty company - revealed!"

lorealparisusa.com

Based on the URL addresses, as well as the content on the webpages, these three websites appear to be L'Oréal's own websites. Because L'Oréal controls the content of these websites, their probative value is very limited; it would be an easy matter for the owner of a website to include information that suited its own position, whether or not it was true. Accordingly, in view of the source of the information in the websites, we have given this evidence very limited weight.

The examining attorney also submitted excerpts from a search for "l oreal" (with a space between the letters "l" and "o") on the Nexis database. Most of the results refer to L'Oréal in an indirect manner and have little bearing on the question before us regarding the fame or reputation of the French cosmetics and beauty products company. See,

e.g., excerpt from the December 17, 2001 *Cox News Service* article, "L'Oreal consulting makeup artist Collier Strong offers the following hints to go from office to party in a matter of minutes." Additionally, the examining attorney's Nexis search located only forty-eight stories, which is a relatively low number and does not support her position that L'Oréal is a "very famous" company.

The following evidence of record also has little probative value for the reasons stated:

1. Search results for "L'Oreal Paris" on the Metacrawler search engine, with sixty entries in the list. Some of the entries are not in English and some are too brief to allow us to associate the entries with the cosmetics company. Other excerpts appear to reference "L'Oréal Paris" tangentially, such as the entry for *beverlycenter.com* which specifies driving directions and store locations for a particular mall, and the entry for *verveonline.com* which simply states in relevant part, "L'Oréal Paris and Elite India in" See *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) ("[e]vidence of actual use of a phrase by a website has far greater probative value than ... search summaries" on the Google search engine.)
2. Registrations containing the term "L'Oreal." The examining attorney maintains that "the owner of all of the marks that contain the word 'L'OREAL' in the United States, except for the present application, is the French company, L'Oreal." Brief at unnumbered p. 4. The fact that a particular entity may own registrations does not show that the entity is famous, or that people would know either the registered marks or the entity which owns them.

3. The excerpt from wireimage.com which states, "Presented by L'Oreal Paris, the Australian Film Institute's annual awards show got under way in Melbourne this week, honoring artistic and technical achievements by Australian filmmakers and actors." This excerpt concerns activities by L'Oreal in Australia and not in the United States.²

4. An excerpt and webpages mentioning fundraising activities and awards by L'Oréal, namely:

"L'Oreal Paris and Netaya are proud to assist in raising money to support The Ovarian Cancer Research Fund."
amazon.com

"On May 5, Kelly George -- a third-year Chemistry doctoral student -- received an award from the L'Oreal USA for Women in Science program for her research and contributions to organic chemistry."
Daily Pennsylvanian via University Wire, May 27, 2004

"L'Oréal Paris is proud to announce that it will continue to celebrate the spirit of community achievement and volunteerism with its second Women of Worth program."
csrwire.com

We have no way of ascertaining what exposure the article and webpages may have had. One appears to have been in a college newspaper in 2004, and another appears to be a wire service report. Given that the Internet is a repository for all kinds of statements and information which may or

² The excerpt from beautifulreview.com, i.e., "L'Oreal Paris is just one of the 22 brands that are under the umbrella of worldwide cosmetics giant L'Oreal" does not indicate

may not be accessed by the public, the mere fact that these three references were retrieved by an Internet search is insufficient to show that the company L'Oréal has any fame or reputation.

We also note that the following evidence is in the record:

"Jacques Correze, 79, the chairman of the U.S. marketing arm of the cosmetics giant L'Oreal, announced in Paris his resignation"
Arkansas Democrat-Gazette, June 27, 1991.

"Diane Keaton has a new role. The Oscar-winning actress, who is 60, will star as a spokesperson for L'Oreal Paris and its brands."
usatoday.com

Looking at all the evidence submitted by the examining attorney, we find that these references do not establish L'Oréal's fame or reputation, even in the context of an ex parte proceeding.³

In view of the foregoing, we find that the Office has not met its burden of proving that L'Oréal is of sufficient fame or reputation to consumers in the United States that a connection between applicant's mark and that company would

activity in the United States; this excerpt too has limited probative value.

³ Both the Federal Circuit, our primary reviewing court, and the Board have recognized the "limited facilities for acquiring evidence" faced by the Office in obtaining evidence supporting a prima facie case. See *In re Budge Mfg., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 - 1261 (Fed. Cir. 1988); *In re Squaw Development Co.*, 80 USPQ2d 1264, 1271 - 1272 (TTAB 2006).

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be presumed. In view of this finding, we need not discuss the other *Buffett* factors. We hasten to point out, however, that on a different and more complete record, such as might be adduced in an inter partes proceeding, we might arrive at a different result on the issue of whether applicant's mark falsely suggests a connection with L'Oréal.

DECISION: The refusal to register the mark under Section 2(a) of the Trademark Act is reversed.