

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86599728
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/86599728/large
LITERAL ELEMENT	M10 MEN
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO

ARGUMENT(S)

I. Introduction

On April 16, 2015 Applicant filed an application for registration of the mark M10 MEN and Design (“Applicant’s Mark”). The Examining Attorney issued a Final Office Action on February 29, 2016. The Office Action has been received and its contents carefully noted. The Examining Attorney refused the above-referenced application under Section 2(d) for likelihood of confusion with the Cited Mark M1, Reg. No. 4576126 (“Cited Mark”), registered for “skin moisturizers, body wash, shaving creams, aftershave, pre-shave creams and liquids.” In addition, the Examining Attorney noted that the specimen was not properly verified and that the Applicant is required to pay an additional processing fee of \$50 because Applicant did not file its previous response via the TEAS system. Applicant submits herewith a Declaration that the submitted substitute specimen was in use at the filing date, and provides the additional required \$50 fee.

In addition, for the reasons detailed below, Applicant respectfully submits that there is no likelihood of confusion between Applicant’s Mark and the Cited Mark, M1. First, the marks have now co-existed in the marketplace for five years without any instances of actual confusion. Coexistence without actual confusion is strong evidence that Applicant’s Mark is not likely to cause confusion. Second, Applicant’s Mark is distinguishable in appearance, sound, connotation, and commercial impression. Finally, short marks that only incorporate single letters and numbers used in connection with cosmetics, including Registrant’s mark, are inherently weak as there is extensive evidence of coexistence of these marks in the industry. As a result, consumers have been conditioned to distinguish these marks from each other. Accordingly, Applicant respectfully requests that the 2(d) refusal be withdrawn and that Application Serial No. 86/599,728 be passed to publication.

II. Applicant’s M10 MEN Mark has not caused actual confusion with Cited M1 Mark during Four Years of Coexistence in the U.S. Marketplace.

As set forth in the attached Declaration of Ann Marie McDonald, the M10 MEN & Design Mark has been widely visible to U.S. consumers since 2012, as this mark has been widely advertised in well-known magazines and on Applicant’s website. In addition, Applicant has been selling M10 MEN & Design products via its web site since 2011. During this five year period of coexistence with the cited M1 mark, Applicant has not become aware of any instances of confusion. As noted by the T.T.A.B., when there is a “reasonable opportunity for

confusion to occur, the lack of any reported confusion weighs against a finding of likely confusion.” *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q. 2d 1645, 1662 2010 WL 595586 (T.T.A.B 2010). *See In re E. I. Du Pont De Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973).

III. Many Same Single-Letter Marks Followed by a Number Coexist In the Cosmetics Field

In the final Office Action, the Examining Attorney concludes that there is a likelihood of confusion between Applicant’s M10 MEN and Design mark and the M1 mark of HEB Grocery Company because the structure of the two marks is such that consumers cannot easily distinguish them. More specifically, as part of the confusion analysis, the Examining Attorney states, “Additionally, when comparing marks that consist of a series of two or more letters, confusion may be likely even if letters are not identical or in the same order. It is more difficult to remember a series of arbitrarily arranged letters than to remember words or **figures**: that is, confusion is more likely between arbitrarily arranged letters than between other types of marks.” (emphasis added). The Examining Attorney continues with an illustration of this principle citing a C.C.P.A case involving the marks Z.B.T and T.Z.L.B, in which the marks were found confusingly similar. Next, the Examining Attorney extends this reasoning about arbitrarily arranged letters to marks that are comprised of a single letter followed by a number. Applicant respectfully submits that consumers perceive a single letter followed by a number very differently than they perceive randomly arranged letters. In fact, Applicant respectfully argues that marks consisting of a single letter followed by a number are much easier to remember and differentiate. In other words, M1, which would be pronounced “M- one” by consumers, is easily distinguished from M10, which would be pronounced “M-ten.” Moreover, M10 is only one part of Applicant’s mark, as there are the additional elements of “Men” and the design to further differentiate it from that of the cited M1 mark. Indeed, M10 MEN & Design and the Cited M1 mark are visually distinguishable. Applicant’s Mark uses a “10” not a “1”, and the addition of MEN and the design element substantially distinguish the overall look of this mark from the cited two-digit M1 mark. “Additions to marks may be sufficient to avoid likelihood of confusion if...thematter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is descriptive or diluted.” TMEP 1207.01(b)(ii). As outlined below, Applicant respectfully submits that the co-existence of many marks comprised of a letter followed by a number in the cosmetics field shows that the M and 1 elements are weak, and therefore other elements of Applicant’s mark should be given significant weight in the confusion analysis.

Consumers’ ability to differentiate marks comprised of a particular letter followed by different numbers – particularly in the cosmetics field-- is illustrated by a review of the U.S. Register where many such marks coexist. This coexistence demonstrates that consumers are used to distinguishing particular entities’ marks by the different numbers and other design elements despite of the common letter. “Third party registrations may be relevant to show that a mark [is]...socommonly used that the public will look to other elements to distinguish the source of the goods.” TMEP 127.01(d)(iii); *see also In Re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.”). A small subset of these relevant marks is set forth below.

Mark/Name	App. No./Reg. No.	Status/Key Dates	Full Goods/Services	Owner	Disclaimer
S3 (Stylized)	RN: 3860434 SN: 77950998	Registered October 12, 2010	(Int'l Class: 03) cosmetic creams for skin care; exfoliants for skin; facial cleansers...	S3 Skincare, LLC	

S2	RN: 4079946	Registered January 3, 2012	(Int'l Class: 03) cosmetic preparations for the hair and scalp; cosmetics...	Cosquim, S.A De C.V. (Mexico Corp.)	
S5	RN: 4188706	Registered August 14, 2012	(Int'l Class: 03) anti-aging moisturizer, anti- bacterial soap, beauty serums, cosmetic preparations for skin care...	Good Ventures LTD.	
S4 SUN SURF SAND SNOW (Stylized)	RN: 4620242	Registered October 14, 2014 Int'l Class:03 First Use:March 4, 2013 Filed: February 18, 2014 Application Published:	(Int'l Class: 03) sunscreen creams; body lotions; aloe vera gel for cosmetic purposes; beauty serums; cosmetic preparations for skin care...	Kerby, Dawn (United States Citizen)	"SUN SURF SAND SNOW"
A3 and Design	RN: 3006038	Registered	(Int'l Class: 03) cosmetics in general...	Aquimpexspa S.R.L. (No Country Provided Not Provided) Via Giuseppe Longhi, 21 I-20900 Monza (Mb) Italy	
A+4 and Design	RN: 4092063	Registered January 24, 2012	(Int'l Class: 03) cosmetics...	America A&4 International Group Limited	
AA69 (Stylized)	RN: 4443916	Registered December 3, 2013	(Int'l Class: 03) cakes of toilet soap; cleaning and washing preparations; cleaning preparations; cosmetics...	Feel Life Bioscience International Co.,Limited (China Corp.) China, The	
A2 DERMSOLUTIONS	RN: 4487438 SN: 85892197	Registered February 25, 2014 Int'l Class:03 First Use:March 7, 2012	(Int'l Class: 03) cosmetic creams for skin care;	Dr. Amy Adams	"DERMSOLUTIONS"

A87	RN: 3477550 SN: 77149505	Registered 8 & 15 June 9, 2014	(Int'l Class: 03) cosmetics...	Aeropostale, Inc.	
A-CUBIC A3 and Design	RN: 4725730 SN: 79134708	Registered April 28, 2015	(Int'l Class: 03) cosmetics...	Asahi Kasei Fibers Corporation (Japan Corp.)	
A-125 (Stylized)	RN: 960045	Renewed May 29, 2013	(Int'l Class: 052) heavy duty detergent and odor counteractant	Ecolab Usa Inc.	
J2 and Design	SN: 86674928	Allowed - Intent to Use Notice of Allowance Issued February 16, 2016	(Int'l Class: 03) body wash; body scrub; bubble bath; body oil; hygiene wipes impregnated with a cleaning preparation; non- medicated feminine hygiene wash; body powders; lip balm...	Jj Aquisitions, LLC	
J 2 and Design	RN: 4020521	Registered August 30, 2011	(Int'l Class: 03) organic skin care products, namely, face lotion, facial washes, beauty serums, exfoliants for the face, body creams, toners, night cream, eye cream	Jeffrey James LLC (Los Angeles California 90049	
B3-T (Stylized)	SN: 79182891	Published June 14, 2016	(Int'l Class: 03) cosmetics and cosmetic preparations for skin care...	Rationale Skincare Pty LTD	
B-4 PLAY	RN: 4122249 SN: 77914879	Registered	(Int'l Class: 03) facial skin protector, namely, facial balm...	Beaumont Products, Inc.	
BB10	RN: 4339642	Registered	(Int'l Class: 03) non-medicated skin care preparations	Beautybank Inc.	

B.8 PROYOUTH TECHNOLOGY	RN: 4522792	Registered April 29, 2014	(Int'l Class: 03) cosmetics...	Bioceutica LLC	"TECHNOLOGY"
B 2 ORGANIC and Design	RN: 3731249	Registered 8 & 15 May 17, 2016	(Int'l Class: 03) organic cosmetics;	Fisk Industries, Inc.	
B21	RN: 2947174	Renewed	(Int'l Class: 03) skin creams, skin lotions...	Orlane S.A. (France Jt. Stock Co.)	
B21	RN: 2982534	Renewed	(Int'l Class: 03) cosmetics, cosmetics for face...	Orlane S.A. (France Jt. Stock Co.)	
T3	RN: 3320517 SN: 78727602	Registered	(Int'l Class: 03) cosmetics, namely, a facial moisturizer and a cleanser	Precision Dermatology, Inc. (Delaware Corp.)	
T3 (Stylized)	RN: 3320516 SN: 78727600		(Int'l Class: 03) cosmetics, namely, a facial moisturizer and a cleanser	Precision Dermatology, Inc. (Delaware Corp.)	
T4 DAILY DEFENSE (Stylized)	RN: 4654844	Registered	(Int'l Class: 03) cosmetic creams for skin care..	Tzone Skin Care	"DAILY"
T5 SUPER FRUIT COMPLEX and Design	RN: 3713779	Registered	(Int'l Class: 03) cosmetics containing fruit extracts	Tarte, Inc.	"FRUIT COMPLEX"
E/4	SN: 86607863	Allowed - Intent to Use	(Int'l Class: 03) perfumes; colognes; eau de toilette; non-medicated oils and creams for the body; body lotions; hand lotions . . .	Dorothy Lata	
E+46 ELEMENTS FROM SWEDEN (Stylized)	RN: 4223859	Registered October 16, 2012	(Int'l Class: 03) soaps for personal use; perfumery, essential oils, cosmetics, hair lotions . . .	E+46 Elements From Sweden Ab (Sweden Aktiebolag) Fornstigen 1	"FROM SWEDEN"

				Se-151 52 Sodertalje Sweden	
G2 SKIN GOOD & GORGEIOUS and Design	RN: 4417769	Registered October 15, 2013	(Int'l Class: 03) age spot reducing creams; beauty balm creams; beauty creams; beauty creams for body care; body cream; cosmetic hand creams . . .	G2 Skin Usa, Inc.	"SKIN"
G12	SN: 86797822	Allowed - Intent to Use Notice of	(Int'l Class: 03) body creams; cosmetic creams for skin care; cosmetic preparations . . .	Shop Latino Network S. De R.L. De C.V. (Mexico Corp.)	

As a result of multiple similarly structured third party registrations, “there is an inherent weakness in a mark comprised in whole or in part of the word in question and that, therefore, the question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other.” *In re Melville*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991).

Indeed, the co-existence of so many marks sharing a particular letter followed by a number demonstrates that cosmetics consumers are accustomed to looking at other elements to distinguish source of various goods. In the instant case, consumers will look to the “MEN” term as well as the design to distinguish Applicant’s goods from the goods provided under the Cited Mark.

IV. Applicant Requests That that Application Serial No. 86599728 Be Allowed

For the foregoing reasons, Applicant respectfully submits that Applicant’s Mark, M10 MEN and design, is not likely to be confused with the mark in the Cited Mark. Accordingly, Applicant respectfully requests that the 2(d) refusal be withdrawn.

GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	003
DESCRIPTION	Cosmetic preparations for skin care
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/25/2012
FIRST USE IN COMMERCE DATE	At least as early as 02/25/2012
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	003
DESCRIPTION	Cosmetic preparations for skin care
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 02/25/2012
FIRST USE IN COMMERCE DATE	At least as early as 02/25/2012

STATEMENT TYPE	"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use]. OR "The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use" [for an illegible specimen].
PAYMENT SECTION	
NUMBER OF PAYMENTS REFUSED OR CHARGED BACK	1
ADDITIONAL FEE PROCESSING FOR EACH PAYMENT(S) REFUSED OR CHARGED BACK	50
TOTAL FEES DUE	50
SIGNATURE SECTION	
ORIGINAL PDF FILE	HS_3898152171-155452154_ . Signed Declaration of Ann Marie MacDonald.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\865\997\86599728\xml9\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\997\86599728\xml9\RFR0003.JPG
SIGNATORY'S NAME	Ann Marie MacDonald
SIGNATORY'S POSITION	President
SIGNATORY'S PHONE NUMBER	312-321-4200
RESPONSE SIGNATURE	/Susan H. Frohling/
SIGNATORY'S NAME	Susan H. Frohling
SIGNATORY'S POSITION	Attorney of Record
SIGNATORY'S PHONE NUMBER	312-321-4200
DATE SIGNED	08/29/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Aug 29 16:54:05 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XX.XXX.XXX-2 0160829165405794767-86599 728-5501634888a1b8e633589 a9321523fdc1efa385b36f24a d6855034a3e9a9275b83-DA-3 787-20160829155452154709

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **86599728** M10 MEN (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86599728/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

I. Introduction

On April 16, 2015 Applicant filed an application for registration of the mark M10 MEN and Design (“Applicant’s Mark”). The Examining Attorney issued a Final Office Action on February 29, 2016. The Office Action has been received and its contents carefully noted. The Examining Attorney refused the above-referenced application under Section 2(d) for likelihood of confusion with the Cited Mark M1, Reg. No. 4576126 (“Cited Mark”), registered for “skin moisturizers, body wash, shaving creams, aftershave, pre-shave creams and liquids.” In addition, the Examining Attorney noted that the specimen was not properly verified and that the Applicant is required to pay an additional processing fee of \$50 because Applicant did not file its previous response via the TEAS system. Applicant submits herewith a Declaration that the submitted substitute specimen was in use at the filing date, and provides the additional required \$50 fee.

In addition, for the reasons detailed below, Applicant respectfully submits that there is no likelihood of confusion between Applicant’s Mark and the Cited Mark, M1. First, the marks have now co-existed in the marketplace for five years without any instances of actual confusion. Coexistence without actual confusion is strong evidence that Applicant’s Mark is not likely to cause confusion. Second, Applicant’s Mark is distinguishable in appearance, sound, connotation, and commercial impression. Finally, short marks that only incorporate single letters and numbers used in connection with cosmetics, including Registrant’s mark, are inherently weak as there is extensive evidence of coexistence of these marks in the industry. As a result, consumers have been conditioned to distinguish these marks from each other. Accordingly, Applicant respectfully requests that the 2(d) refusal be withdrawn and that Application Serial No. 86/599,728 be passed to publication.

II. Applicant’s M10 MEN Mark has not caused actual confusion with Cited M1 Mark during Four Years of Coexistence in the U.S. Marketplace.

As set forth in the attached Declaration of Ann Marie McDonald, the M10 MEN & Design Mark has been widely visible to U.S. consumers since 2012, as this mark has been widely advertised in well-known magazines and on Applicant’s website. In addition, Applicant has been selling M10 MEN & Design products via its web site since 2011. During this five year period of coexistence with the cited M1 mark, Applicant has not become aware of any instances of confusion. As noted by the T.T.A.B., when there is a “reasonable opportunity for confusion to occur, the lack of any reported confusion weighs against a finding of likely confusion.” *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q. 2d 1645, 1662 2010 WL 595586 (T.T.A.B 2010). *See In re E. I. Du Pont De Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973).

III. Many Same Single-Letter Marks Followed by a Number Coexist In the Cosmetics Field

In the final Office Action, the Examining Attorney concludes that there is a likelihood of confusion between Applicant’s M10 MEN and Design mark and the M1 mark of HEB Grocery Company because the structure of the two marks is such that consumers cannot easily distinguish them. More specifically, as part of the confusion analysis, the Examining Attorney states, “*Additionally, when comparing marks that consist of a series of two or more letters, confusion may be likely even if letters are not identical or in the same order. It is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures: that is, confusion is more likely between arbitrarily arranged letters than between other types of marks.*”

(emphasis added). The Examining Attorney continues with an illustration of this principle citing a C.C.P.A case involving the marks Z.B.T and T.Z.L.B, in which the marks were found confusingly similar. Next, the Examining Attorney extends this reasoning about arbitrarily

arranged letters to marks that are comprised of a single letter followed by a number. Applicant respectfully submits that consumers perceive a single letter followed by a number very differently than they perceive randomly arranged letters. In fact, Applicant respectfully argues that marks consisting of a single letter followed by a number are much easier to remember and differentiate. In other words, M1, which would be pronounced “M- one” by consumers, is easily distinguished from M10, which would be pronounced “M-ten.” Moreover, M10 is only one part of Applicant’s mark, as there are the additional elements of “Men” and the design to further differentiate it from that of the cited M1 mark. Indeed, M10 MEN & Design and the Cited M1 mark are visually distinguishable. Applicant’s Mark uses a “10” not a “1”, and the addition of MEN and the design element substantially distinguish the overall look of this mark from the cited two-digit M1 mark. “Additions to marks may be sufficient to avoid likelihood of confusion if...thematter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is descriptive or diluted.” TMEP 1207.01(b)(ii). As outlined below, Applicant respectfully submits that the co-existence of many marks comprised of a letter followed by a number in the cosmetics field shows that the M and 1 elements are weak, and therefore other elements of Applicant’s mark should be given significant weight in the confusion analysis.

Consumers’ ability to differentiate marks comprised of a particular letter followed by different numbers – particularly in the cosmetics field-- is illustrated by a review of the U.S. Register where many such marks coexist. This coexistence demonstrates that consumers are used to distinguishing particular entities’ marks by the different numbers and other design elements despite of the common letter. “Third party registrations may be relevant to show that a mark [is]...socommonly used that the public will look to other elements to distinguish the source of the goods.” TMEP 127.01(d)(iii); *see also In Re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.”). A small subset of these relevant marks is set forth below.

Mark/Name	App. No./Reg. No.	Status/Key Dates	Full Goods/Services	Owner	Disclaimer
S3 (Stylized)	RN: 3860434 SN: 77950998	Registered October 12, 2010	(Int'l Class: 03) cosmetic creams for skin care; exfoliants for skin; facial cleansers...	S3 Skincare, LLC	
S2	RN: 4079946	Registered January 3, 2012	(Int'l Class: 03) cosmetic preparations for the hair and scalp; cosmetics...	Cosquim, S.A De C.V. (Mexico Corp.)	
S5	RN: 4188706	Registered August 14, 2012	(Int'l Class: 03) anti-aging moisturizer, anti-bacterial soap, beauty serums, cosmetic preparations for skin care...	Good Ventures LTD.	
S4 SUN SURF SAND SNOW (Stylized)	RN: 4620242	Registered October 14, 2014 Int'l Class:03	(Int'l Class: 03) sunscreen creams; body lotions; aloe vera gel for	Kerby, Dawn (United States Citizen)	"SUN SURF SAND SNOW"

		First Use:March 4, 2013 Filed: February 18, 2014 Application Published:	cosmetic purposes; beauty serums; cosmetic preparations for skin care...		
A3 and Design	RN: 3006038	Registered	(Int'l Class: 03) cosmetics in general...	Aquimpexspa S.R.L. (No Country Provided Not Provided) Via Giuseppe Longhi, 21 I-20900 Monza (Mb) Italy	
A+4 and Design	RN: 4092063	Registered January 24, 2012	(Int'l Class: 03) cosmetics...	America A&4 International Group Limited	
AA69 (Stylized)	RN: 4443916	Registered December 3, 2013	(Int'l Class: 03) cakes of toilet soap; cleaning and washing preparations; cleaning preparations; cosmetics...	Feel Life Bioscience International Co.,Limited (China Corp.) China, The	
A2 DERMSOLUTIONS	RN: 4487438 SN: 85892197	Registered February 25, 2014 Int'l Class:03 First Use:March 7, 2012	(Int'l Class: 03) cosmetic creams for skin care;	Dr. Amy Adams	"DERMSOLUTIONS"
A87	RN: 3477550 SN: 77149505	Registered 8 & 15 June 9, 2014	(Int'l Class: 03) cosmetics...	Aeropostale, Inc.	
A-CUBIC A3 and Design	RN: 4725730 SN: 79134708	Registered April 28, 2015	(Int'l Class: 03) cosmetics...	Asahi Kasei Fibers Corporation (Japan Corp.)	
A-125 (Stylized)	RN: 960045	Renewed May 29, 2013	(Int'l Class: 052) heavy duty detergent and odor counteractant	Ecolab Usa Inc.	

J2 and Design	SN: 86674928	Allowed - Intent to Use Notice of Allowance Issued February 16, 2016	(Int'l Class: 03) body wash; body scrub; bubble bath; body oil; hygiene wipes impregnated with a cleaning preparation; non-medicated feminine hygiene wash; body powders; lip balm...	Jj Aquisitions, LLC	
J 2 and Design	RN: 4020521	Registered August 30, 2011	(Int'l Class: 03) organic skin care products, namely, face lotion, facial washes, beauty serums, exfoliants for the face, body creams, toners, night cream, eye cream	Jeffrey James LLC (Los Angeles California 90049	
B3-T (Stylized)	SN: 79182891	Published June 14, 2016	(Int'l Class: 03) cosmetics and cosmetic preparations for skin care...	Rationale Skincare Pty LTD	
B-4 PLAY	RN: 4122249 SN: 77914879	Registered	(Int'l Class: 03) facial skin protector, namely, facial balm...	Beaumont Products, Inc.	
BB10	RN: 4339642	Registered	(Int'l Class: 03) non-medicated skin care preparations	Beautybank Inc.	
B.8 PROYOUTH TECHNOLOGY	RN: 4522792	Registered April 29, 2014	(Int'l Class: 03) cosmetics...	Bioceutica LLC	"TECHNOLOGY"
B 2 ORGANIC and Design	RN: 3731249	Registered 8 & 15 May 17, 2016	(Int'l Class: 03) organic cosmetics;	Fisk Industries, Inc.	
B21	RN: 2947174	Renewed	(Int'l Class: 03) skin creams, skin lotions...	Orlane S.A. (France Jt. Stock Co.)	
B21	RN: 2982534	Renewed	(Int'l Class: 03) cosmetics, cosmetics for face...	Orlane S.A. (France Jt. Stock Co.)	
T3	RN: 3320517	Registered	(Int'l Class: 03)	Precision	

	SN: 78727602		cosmetics, namely, a facial moisturizer and a cleanser	Dermatology, Inc. (Delaware Corp.)	
T3 (Stylized)	RN: 3320516 SN: 78727600		(Int'l Class: 03) cosmetics, namely, a facial moisturizer and a cleanser	Precision Dermatology, Inc. (Delaware Corp.)	
T4 DAILY DEFENSE (Stylized)	RN: 4654844	Registered	(Int'l Class: 03) cosmetic creams for skin care..	Tzone Skin Care	"DAILY"
T5 SUPER FRUIT COMPLEX and Design	RN: 3713779	Registered	(Int'l Class: 03) cosmetics containing fruit extracts	Tarte, Inc.	"FRUIT COMPLEX"
E/4	SN: 86607863	Allowed - Intent to Use	(Int'l Class: 03) perfumes; colognes; eau de toilette; non-medicated oils and creams for the body; body lotions; hand lotions . . .	Dorothy Lata	
E+46 ELEMENTS FROM SWEDEN (Stylized)	RN: 4223859	Registered October 16, 2012	(Int'l Class: 03) soaps for personal use; perfumery, essential oils, cosmetics, hair lotions . . .	E+46 Elements From Sweden Ab (Sweden Aktiebolag) Fornstigen 1 Se-151 52 Sodertalje Sweden	"FROM SWEDEN"
G2 SKIN GOOD & GORGEOUS and Design	RN: 4417769	Registered October 15, 2013	(Int'l Class: 03) age spot reducing creams; beauty balm creams; beauty creams; beauty creams for body care; body cream; cosmetic hand creams . . .	G2 Skin Usa, Inc.	"SKIN"
G12	SN: 86797822	Allowed - Intent to Use Notice of	(Int'l Class: 03) body creams;	Shop Latino Network S. De	

			cosmetic creams for skin care; cosmetic preparations . . .	R.L. De C.V. (Mexico Corp.)	
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As a result of multiple similarly structured third party registrations, “there is an inherent weakness in a mark comprised in whole or in part of the word in question and that, therefore, the question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other.” *In re Melville*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991).

Indeed, the co-existence of so many marks sharing a particular letter followed by a number demonstrates that cosmetics consumers are accustomed to looking at other elements to distinguish source of various goods. In the instant case, consumers will look to the “MEN” term as well as the design to distinguish Applicant’s goods from the goods provided under the Cited Mark.

IV. Applicant Requests That that Application Serial No. 86599728 Be Allowed

For the foregoing reasons, Applicant respectfully submits that Applicant’s Mark, M10 MEN and design, is not likely to be confused with the mark in the Cited Mark. Accordingly, Applicant respectfully requests that the 2(d) refusal be withdrawn.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 003 for Cosmetic preparations for skin care
Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/25/2012 and first used in commerce at least as early as 02/25/2012 , and is now in use in such commerce.

Proposed: Class 003 for Cosmetic preparations for skin care

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/25/2012 and first used in commerce at least as early as 02/25/2012 , and is now in use in such commerce. Applicant hereby submits one(or more) specimen(s) for Class 003 .

"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] **OR** **"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use"** [for an application based on Section 1(b) Intent-to-Use]. **OR** **"The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use"** [for an illegible specimen].

FEE(S)
Fee(s) in the amount of \$50 is being submitted.

SIGNATURE(S)

Declaration Signature

Original PDF file:

[HS_3898152171-155452154_ . Signed Declaration of Ann Marie MacDonald.pdf](#)

Converted PDF file(s) (2 pages)

[Signature File1](#)

[Signature File2](#)

Signatory's Name: Ann Marie MacDonald
Signatory's Position: President
Signatory's Phone Number: 312-321-4200

Request for Reconsideration Signature

Signature: /Susan H. Frohling/ Date: 08/29/2016

Signatory's Name: Susan H. Frohling
Signatory's Position: Attorney of Record

Signatory's Phone Number: 312-321-4200

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

RAM Sale Number: 86599728
RAM Accounting Date: 08/30/2016

Serial Number: 86599728
Internet Transmission Date: Mon Aug 29 16:54:05 EDT 2016
TEAS Stamp: USPTO/RFR-XX.XX.XXX.XXX-2016082916540579
4767-86599728-5501634888a1b8e633589a9321
523fdc1efa385b36f24ad6855034a3e9a9275b83
-DA-3787-20160829155452154709

DECLARATION OF ANN MARIE MACDONALD.

1. The undersigned, being hereby warned that willful, false statements and the like so made are punishable by fine or imprisonment or both, declare as follows.

2. I am the President of Miracle 10 Cosmetics Inc. the applicant of Application No. 86599728 for M10 MEN & Design ("Miracle 10"), and have personal knowledge of the facts set out in this Declaration.

3. In my position of President at Miracle 10, Inc., I am familiar with marketing and sales of skincare products bearing the M10 MEN & Design and the MIRACLE 10 trademarks in the United States.

4. Since as least as early as March of 2011, Miracle 10 has sold into the United States a number of skincare products, such as cleansers, moisturizers, sunscreen creams, anti-aging creams and serums, scrubs, toners, and shave and after shave products, solely through online sales at its website <http://www.miracle10.com>. The products for women are sold under the MIRACLE 10 trademark and this mark was registered in the United States Trademarks Office under registration no.4293822 on February 26, 2013. The products for men are sold under the M10 MEN design mark. The M10 part of the mark is a derivative of the main brand mark MIRACLE 10.

5. Miracle 10, and its predecessor, The Plastic Surgery Skincare Clinic Inc., have provided high quality skincare services and products in Canada for over 15 years. The superior, high end products were developed with the assistance of chemists, and anti-aging specialists and contain quality active ingredients, such as DMAE, peptides, Coenzyme Q-10, vitamins, minerals and botanical extracts. The product formulations are proprietary, fragrance free, paraben-free and not tested on animals. These products reduce and slow the signs of aging, minimize pore size, heal the look of acne and improve skin elasticity, texture and tone. The products are not inexpensive and retail in the range of \$27.00 to \$225.00 CDN.

6. As noted above, sales of these products into the United States began at least as early as March 2011. Approximate annual sales figures for the MIRACLE 10 product line, including the line sold under the name M10 Men, for each year since 2011 are set out below:

2011: \$1,934.

2012: \$10,112.

2013 \$15,136.

2014 \$14,975.

2015 \$12,996.

2016(to date): \$3,379.

7. Both the MIRACLE 10 and the M10 MEN products have been promoted strongly on Miracle 10's website. In 2012, the site received at least 3,766 hits from U.S. consumers, in 2013 the site received at least 6,427 hits from U.S. consumers, in 2014, the site received at least 7,212 hits from U.S. consumers, in 2015, the site received at least 5,483 hits from U.S. consumers and in 2016, to date, the site received at least 3,491 hits from U.S. consumers.

9. In addition, the MIRACLE 10 and the M10 MEN products have been advertised and featured in the following publications, distributed between the years 2012 and 2016 in the United States: **Beauty Fashion Magazine, December 2012; Vanity Fair Magazine, May 2013, New Beauty Magazine in January 2014 and January 2015.**

10. In addition, between 2012 and 2016, radio commercials promoting the MIRACLE 10 and the MEN 10 MEN products have been broadcast frequently on station CHUM-FM, which broadcasts are received throughout the greater Buffalo area of upstate New York.

11. In the more than five years that the M10 MEN products have been sold into the United States, I am not aware of any instances of M10 MEN products being confused by consumers with the HEB Grocery's line of skincare products sold in association with the mark M1.

Declared at Toronto, Ontario, this 29th day of August, 2016

A handwritten signature in blue ink, appearing to read "Ann Marie MacDonald", written over a horizontal line.

Ann Marie MacDonald

Title: President

RAM SALE NUMBER: 86599728
RAM ACCOUNTING DATE: 20160830

INTERNET TRANSMISSION DATE:
2016/08/29

SERIAL NUMBER:
86/599728

Description	Fee Code	Transaction Date	Fee	Number Of Classes	Total Fees Paid
	9101	2016/08/29	50	1	50