

ESTTA Tracking number: **ESTTA84546**

Filing date: **06/08/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	L'Oreal USA Creative, Inc.
Granted to Date of previous extension	06/10/2006
Address	575 Fifth Avenue New York, NY 10017 UNITED STATES

Correspondence information	L'Oreal USA Creative, Inc. 575 Fifth Avenue New York, NY 10017 UNITED STATES rls@paulhastings.com, robertsberman@paulhastings.com Phone:212-318-6037
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Applicant Information

Application No	78523430	Publication date	04/11/2006
Opposition Filing Date	06/08/2006	Opposition Period Ends	06/10/2006
International Registration No.	NONE	International Registration Date	NONE
Applicant	ColBar LifeScience Ltd. 9 Hamenofim St. Ackerstein Tower A Herzelia, 46725 ISRAEL		

Goods/Services Affected by Opposition

Class 001. All goods and sevicees in the class are opposed, namely: Chemicals for use as ingredients in the manufacture of cosmetics, cosmeceuticals and pharmaceutical preparations
Class 003. All goods and sevicees in the class are opposed, namely: Cosmetic preparations for use in aesthetic treatment of skin conditions, and the cosmetic reconstructing and augmentation of tissues and organs
Class 005. All goods and sevicees in the class are opposed, namely: Pharmaceutical preparations for use in the treatment of skin conditions, reconstructing and augmentation of tissues and organs; surgical implants comprising living and natural tissue; and surgical implants comprising collagen based material

Attachments	Notice Of OppositionGLYMATRIX.pdf (8 pages)(545834 bytes)
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Signature	Robert Sherman /rls/
Name	L'Oreal USA Creative, Inc.
Date	06/08/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/523,430
Published in the Official Gazette on April 11, 2006
Mark: GLYMATRIX

_____)	
L'Oréal USA Creative, Inc.,)	
)	
Opposer,)	
)	
v.)	
)	
ColBar LifeScience Ltd.,)	Opposition No. _____
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer, L'Oréal USA Creative, Inc. ("L'Oréal" or "Opposer"), believes it will be damaged by the registration of GLYMATRIX by applicant ColBar LifeScience Ltd. ("Applicant") in Class 1 for "chemicals for use as ingredients in the manufacture of cosmetics, cosmeceuticals and pharmaceutical preparations;" Class 3 for "cosmetic preparations for use in aesthetic treatment of skin conditions, and the cosmetic reconstructing and augmentation of tissues and organs;" and Class 5 for "pharmaceutical preparations for use in the treatment of skin conditions, reconstructing and augmentation of tissues and organs; surgical implants comprising living and natural tissue; and surgical implants comprising collagen based material."

Opposer hereby opposes the registration of GLYMATRIX, by and through its undersigned attorneys, based on the following grounds:

1. L'Oréal is a Delaware corporation having a business address of 575 Fifth Avenue, New York, NY 10017.

2. L'Oréal and its affiliates are now and for many years past have been engaged in the development, manufacture, distribution, marketing and sale of nearly all categories of beauty products, including skin care products, sun care products, hair care products and cosmetics, as well as salon-oriented products. L'Oréal's products are distributed through various channels, which include department stores, specialty stores, drugstores, food stores, mass merchandisers and beauty salons.

3. L'Oréal is the owner of, *inter alia*, the following trademarks and federal trademark registrations and applications for MATRIX and variations thereof (collectively, the "MATRIX Mark"). Those registrations that have achieved incontestable status are denoted by an asterisk:

Mark	Reg. No./ Appln. Ser. No.	Reg. Date/ Status	Goods/Services
MATRIX	2,529,847	01/15/2002	Printed material, namely, newsletters in the field of hair care distributed to and through professional salons and professionals in the hair care trade
MATRIX	1,569,113*	12/05/1989	Skin care preparations, namely cleansing wash, foaming gel wash, skin freshener, purifying toner, exfoliating scrub, revitalizing masque, hydrating lotion, moisturizing lotion and cream, night cream, firming eye cream, and regeneration skin supplement
MATRIX	2,226,310*	02/23/1999	Hair care products, namely, shampoos, conditioners, rinses, styling lotions, gels,

Mark	Reg. No./ Appln. Ser. No.	Reg. Date/ Status	Goods/Services
			glazes, tonics, permanent waves, hair coloring preparations, color additives, bleaches, hair polish, styling foams, leave-in curl retention preparations, hair spray
MATRIX & Design	1,539,973*	05/23/1989	Non-medicated hair care preparations
MATRIX SYNERGY SALON SUCCESS CLUB	1,555,023*	09/05/1989	Providing hair salons with sales kits consisting of a collection of sales promotion and advertising materials, articles, information, and product samples
MATRIX COLOR GALLERY	78/624,026	Allowed on 4/18/2006	Hair color
MATRIX MEN STYLE CONTROL SYSTEM	78/694,765	Published for opposition on 5/9/2006	Hair products, namely, shampoos, conditioners, hair thickening preparations, hair gel, hair wax, hair paste and combination shampoo and condition; Anti-dandruff shampoo
MATRIX GLOBAL TEXTURE INSTITUTE & Design	78/664,562	Approved by examining attorney for publication on 5/24/2006	Hair straighteners, hair relaxers, neutralizers, hair treatment preparations and permanent wave preparations
MATRIX	78/869,703	Pending	Cosmetics

Mark	Reg. No./ Appln. Ser. No.	Reg. Date/ Status	Goods/Services
MATRIX COLOR INSPIRATION	78/854,861	Pending	Conducting distributor and salon incentive award programs to promote the sale and distribution of hair color and hair care products; conducting salon loyalty reward programs for independent beauty salons; educational, training and informational services in the field of hair care, hair coloring and hair styling for salon professionals; conducting classes, seminars and workshops in the field of hair salon operations and salon management and distributing educational materials in connection therewith; providing information to independent salons concerning the use, sale and promotion of hair care products via the Internet
MATRIX DESTINATION	78/674,560	Pending	Educational services, namely, conducting workshops, classes, seminars and demonstrations relating to hair care, hair styling and hair color products and techniques and hair salon operations and management for professional hair stylists, hair colorists and hair salon owners

A copy of the USPTO Trademark Application and Registration Retrieval System records for the above registrations and applications are attached hereto as Exhibit A.¹

4. L'Oréal acquired rights in MATRIX prior to any rights that may be asserted by Applicant in the subject application.

¹ On January 1, 2001, Matrix, then owner of U.S. Registration Nos. 1,555,023, 1,539,973, 1,569,113 and 2,226,310, assigned those registrations to L'Oréal. Copies of the recorded

(continued...)

5. L'Oréal offers a comprehensive line of hair care, hair color and hair texturizing products and services under its well-known MATRIX Mark. Introduced in 1980, that line has grown to include a wide range of shampoo, conditioning, styling and finishing products, as well as various salon products including hair color and texturizing lotions. L'Oréal has also offered, from time to time, MATRIX skin care preparations.

6. For more than two decades, L'Oréal (including its predecessor-in-interest) has produced, advertised, promoted, distributed and sold, *inter alia*, professional hair care and related products in interstate commerce under its famous MATRIX Mark.

7. Some of L'Oréal's well-known lines of professional hair care products sold under the MATRIX house mark include BIOLAGE, MATRIX ESSENTIALS, SLEEK.LOOK, AMPLIFY, OPTI.SMOOTH, LOGICS, VAVOOM, SOCOLOR, CURL.LIFE, and COLOR.SMART.

8. L'Oréal's MATRIX products are available in tens of thousands of salons throughout North America, as well as in other parts of the world.

9. Thousands of educational events are held annually in classrooms, on stage and in salons by or on behalf of L'Oréal's MATRIX products and services. Those events include demonstrations of the newest methods of cutting, coloring and texturizing, and presentations on business building strategies for salons. A newsletter published under the MATRIX Mark, with a

(...continued)

assignments from the Assignment Division of the U.S. Patent and Trademark Office for those registrations are attached hereto as Exhibit B.

circulation in excess of 200,000 is distributed bi-monthly, and covers a wide variety of topics, including color formulas, new product introductions and hair style trends.

10. More recently, the Matrix Global Academy in New York City was opened, occupying more than 11,000 square feet of state-of-the-art training facilities, and offering a wide range of courses to salon owners and stylists.

11. Consumers and professionals have come to know and trust L'Oréal's MATRIX brand for its premium hair care and related products and services to such an extent that the MATRIX brand is among the most recognizable and famous in the field. As a result, it now is the number one brand in hair care products sold through salons. Printouts from the www.matrix.com web site are annexed hereto as Exhibit C.

12. As a direct result of the continued prominence and visibility of MATRIX products, they long ago acquired widespread recognition and an outstanding reputation among consumers and the trade. Such consumer and trade acceptance has resulted in a brand that is among the most successful of its kind.

13. L'Oréal has exercised great care, skill and diligence in conducting its business, and has maintained uniform standards of high quality in making and selling its MATRIX products. By virtue of those high standards, more than twenty-five years of continuous and substantially exclusive use, and the expenditure of tens of millions of dollars in advertising and promotion, the MATRIX Mark has become famous and symbolizes L'Oréal's extensive and valuable goodwill throughout the United States.

14. On information and belief, Applicant is an Israeli corporation, having a business address of 9 Hamenofim St., Ackerstein Tower A, Herzelia 46725, Israel.

15. On November 29, 2004, Applicant filed the application at issue herein (Serial No. 78/523,430), seeking to register the mark GLYMATRIX on the basis of a foreign registration granted in Israel for goods in Class 1 for “chemicals for use as ingredients in the manufacture of cosmetics, cosmeceuticals and pharmaceutical preparations;” Class 3 for “cosmetic preparations for use in aesthetic treatment of skin conditions, and the cosmetic reconstructing and augmentation of tissues and organs;” Class 5 for “pharmaceutical preparations for use in the treatment of skin conditions, reconstructing and augmentation of tissues and organs; surgical implants comprising living and natural tissue; and surgical implants comprising collagen based material;” and Class 10 for “surgical and medical apparatus for reconstructing tissues and organs; artificial protein-based implants.”

16. Applicant’s mark GLYMATRIX so closely resembles L’Oréal’s MATRIX Mark as to be likely, when used on or in connection with Applicant’s goods, to cause confusion or mistake or to deceive, so that registration thereof would damage L’Oréal. As such, Applicant’s mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

17. On information and belief, Applicant began its use of GLYMATRIX after L’Oréal’s MATRIX Mark became famous.

18. Because of the fame of L’Oréal’s MATRIX Mark and the similarity of GLYMATRIX to the MATRIX Mark, Applicant’s use of GLYMATRIX dilutes the ability of

L'Oréal's famous MATRIX Mark to identify L'Oréal's goods. As such, Applicant's mark is not entitled to registration under 15 U.S.C. § 1052(f).

19. Because of the similarity of the parties' marks and their respective goods and/or services, Applicant's use of GLYMATRIX likely will result in consumer confusion as to source, affiliation, connection or association with L'Oréal. Opposer believes it will be damaged by the registration of Applicant's proposed mark within the meaning of 15 U.S.C. § 1063(a).

This Notice of Opposition, including exhibits, is being filed in duplicate, along with a filing fee of \$900.00.

WHEREFORE, L'Oréal respectfully requests that

- (i) the registration sought by Applicant be refused;
- (ii) the Notice of Opposition be sustained; and
- (iii) the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: June 8, 2006

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: 

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