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

Proceeding	91184456
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Submission	Motion to Amend Pleading/Amended Pleading
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

L'ORÉAL'S NOTICE OF MOTION
TO AMEND ITS NOTICE OF OPPOSITION
AND MEMORANDUM IN SUPPORT

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NOTICE OF MOTION

Pursuant to Rule 15(a) of the Federal Rules of Civil Procedure and Sections 507.01 and 507.02 of the Trademark Trial and Appeal Board Manual of Procedure, L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby moves the Trademark Trial and Appeal Board (the "Board") for leave to amend its Notice of Opposition as set forth in the proposed Amended Notice of Opposition attached as Exhibit A to the Declaration of Natalie G. Furman, dated June 29, 2009, submitted herewith. L'Oréal also respectfully moves the Board to suspend the proceeding pending resolution of this motion and, upon decision, to reset the close of L'Oréal's testimony period to thirty (30) days following the date of the order.

L'ORÉAL'S MEMORANDUM IN SUPPORT OF MOTION

L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") submits this memorandum in support of its motion to amend the Notice of Opposition in this proceeding against Robert Victor Marcon ("Applicant"), in order to add as a separate ground for its opposition Applicant's lack of bona fide intent to use its mark. Opposer's proposed amended pleading is attached to the declaration of Natalie G. Furman, dated June 29, 2009 ("Furman Decl."), submitted herewith.

I. PRELIMINARY STATEMENT

By this motion, L'Oréal seeks leave to amend its Notice of Opposition in order to assert an independent claim that Applicant lacked the requisite bona fide intent to use L'OREAL PARIS ("Applicant's Mark"), at the time he filed his application, thereby rendering the application invalid. During the course of discovery, L'Oréal sought to obtain information and documents regarding Applicant's bona fide intent to use L'OREAL PARIS in commerce. Applicant's responses

and supplemental responses to Opposer's discovery requests, as well as subsequent communications, reveal that Applicant does not have any documentary evidence or any other objective evidence whatsoever to substantiate a bona fide intent to use Applicant's Mark. Furthermore, other applications admittedly owned by Applicant further support Opposer's belief that Applicant lacked the requisite bona fide intent to use. Opposer now has a basis for asserting a claim that Applicant lacked the statutorily required bona fide intent to use Applicant's Mark in commerce at the time of filing, and continuing to date, and that registration should be denied on that additional basis, and accordingly seeks to amend its Notice of Opposition.

Amendments to pleadings should be liberally granted whenever it is necessary for the furtherance of justice and would not be prejudicial to the rights of the other party. Opposer's motion for leave to amend should therefore be granted, because allowing the amendment would not prejudice Applicant in any way and because a lack of bona fide intent – if proven at trial – would mean that Applicant's application is invalid as a matter of law, such that that registration of Applicant's Mark must be refused. Justice requires granting L'Oréal's motion.

II. FACTUAL BACKGROUND

L'Oréal's Notice of Opposition alleges likelihood of confusion under 15 U.S.C. §1052(d) and dilution under 15 U.S.C. §1125(c). The parties have engaged in discovery and, on January 9, 2009, L'Oréal filed a Motion on Consent for an Extension of the Discovery and Trial Periods in order to give the parties time to resolve certain discovery disputes; that motion was granted on January 14, 2009 and discovery subsequently closed on April 11, 2009.

During the discovery period, L'Oréal served Applicant with requests for admissions, interrogatories, and document requests that sought, among other things, information and documents regarding Applicant's bona fide intent to use Applicant's mark in commerce, Applicant's

apparent pattern of seeking to register numerous well-known or famous marks for disparate goods, and Applicant's intent to use each of those marks in commerce at the time of filing each application. Furman Decl., ¶ 4, Ex. B. Believing Applicant's responses to be deficient, L'Oréal sent Applicant a first deficiency letter on January 7, 2009, providing extensive detail regarding, among other things, its belief that L'Oréal's requests regarding Applicant's bona fide intent to use the L'OREAL PARIS mark as well as Applicant's other applied-for marks are within the permissible scope of discovery. *Id.*, ¶ 5, Ex. C. Following receipt of Applicant's supplemental responses, Opposer sent a second deficiency letter on February 27, 2009, in response to which Applicant further supplemented his responses. *Id.*, ¶ 6, Ex. D. On June 24, 2009, the parties conferred by telephone, and agreed to submit testimony in the form of affidavits or declarations rather than via depositions. L'Oréal sent Applicant a proposed stipulation to that effect on June 26, 2009, and awaits a response. *Id.*, ¶ 7, Ex. E.

The cumulative effect of Applicant's responses and supplemental responses to L'Oréal discovery requests – including Applicant's complete lack of documentary evidence or any other objective evidence, apparent lack of capacity or experience needed to manufacture or otherwise offer the stated goods, vague allusions to use through licensing or outsourcing, failure to take any concrete actions or develop any concrete plans for use, and pattern of filing intent-to-use applications for disparate goods under well-known or famous marks – provides a basis for L'Oréal to believe that Applicant lacked (and continues to lack) the requisite bona fide intent to use the mark. For example, L'Oréal discovery requests and Applicant's responses and supplemental responses include the following:

Opposer's Request for Admission No. 37. Applicant did not have a bona fide intent to use each of Applicant's Marks in commerce at the time that he filed an application for each of Applicant's Marks with the PTO.[1]

Applicant's Response: The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. As for the Applicant's other applications – the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

Applicant's Supplementary Response: The Applicant disagrees with said statement. That is, the Applicant has always had a bona fide intent to use said marks.

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[1] Applicant's Marks is defined in the Definitions and Instructions ¶ 4 as "any and all marks for which the Applicant has filed applications before the U.S. Patent and Trademark Office, regardless of whether those applications are currently pending, have been registered, or have been abandoned," and Requests for Admissions Nos. 27-33 refer to Applicant's intent-to-use applications for NESTLE for "over the counter medications, namely, analgesics; sleep aids; cold and flu medications; EVIAN for "ice cream; sherbet; and frozen confections;" BUDWEISER, ABSOLUT, FINLANDIA, and NESCAFÉ for various beverages; HEINEKEN, COORS, and DOM PERIGNON for "meat juices;" JACK DANIELS for "cigars, cigarettes, and chewing tobacco;" BAYER for non-medicated breath fresheners, mouthwash, and gargle; and CHANEL for "scented stationery and greeting cards."

Opposer's Request for Admission No. 38. Applicant does not have a bona fide intent to use Applicant's L'OREAL PARIS Mark in commerce, and did not have such intent at the time of filing the application that is the subject of this proceeding.

Applicant's Response: The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. As for the Applicant's other applications – the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

Opposer's Request for Admission No. 39. Applicant's purpose in applying for Applicant's L'ORÉAL PARIS Mark and/or other of Applicant's Marks is to make a philosophical point about trademark protection.

Applicant's Response: The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make a philosophical point about trademark protection. As for the Applicant's other applications – the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be

allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

Applicant's Supplementary Response: The Applicant disagrees with the Opposers. That is, the Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make a philosophical point about trademark protection.

Opposer's Request for Admission No. 45. Applicant has never manufactured or sold aloe vera drinks.

Applicant's Response: The Applicant acknowledges said statement.[2]

Opposer's Request for Admission No. 46. Applicant has no capacity and/or intention to manufacture or sell aloe vera drinks.

Applicant's Response: The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. In todays [sic] business world the capacity to manufacture, distribute and sell does not always rest on a persons [sic] actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch.

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[2] In response to Opposer's first deficiency letter, Applicant's Supplementary Responses clarify that Applicant's uses of the term "acknowledges" is an admission, and Applicant's use of "disagrees" is to be understood as a denial.

Applicant's Supplementary Response: The Applicant disagrees with said statement. That is, the Applicant does not lack the capacity to manufacture or sell aloe vera drinks.

Opposer's Interrogatory No. 5. State all facts that support and evidence Applicant's alleged bona fide intent to use Applicant's Mark in commerce on or in connection with aloe vera drinks as of the filing date of Application Serial No. 76/596,736 and continuing to date.

Applicant's Response: The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. In todays [sic] business world the capacity to manufacture, distribute and sell does not always rest on a persons [sic] actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation. Moreover, the Applicant wishes to inquire as to the definition of "bona fide intent" for many successful people have made fortunes in business begun from humble beginnings or were contrary to expert opinion. Microsoft, Dell, and Federal Express were all such companies yet against all odds not only prevailed but triumphed. In this same light the Applicant, for example, has successfully filed, prosecuted, and appealed his mark in the U.S.A., and is now currently engaged in these opposition proceedings with out the obvious benefits and insight afforded by a seasoned trademark attorney. Thus, is this not a reasonable example of "bona fide intent." [sic] for if it is not the Applicant has truly squandered many years foolishly. The Applicant believes that he

genuinely possesses "bona fide intent" and will employ this same zeal in his efforts to successfully commercialize his trademark and product once approved.

Applicant's Supplementary Response: The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and will begin to do so once his mark is approved. Although the Applicant has not formalized any business plans nor produced or sold any wares the Applicant contends that he is not required to do so until his mark has been approved. The Applicant has, however, searched the internet for manufacturers of aloe vera drinks and has found various companies that offer such products. Though no printouts or documents were kept such companies include Aloe Farms Inc., Genereux Ltd., Psb Co Ltd, and Tobe Inc. The Applicant also believes that there are many other companies like these in the marketplace. Thus, the Applicant will, once his mark is approved, begin by first approaching these companies to outsource the manufacture of his aloe vera drinks. Once a supply source is secured the Applicant will then approach various nearby clubs, bars, and restaurants to test market sales and streamline logistics. Moreover, and as previously stated, the capacity to manage, manufacture, distribute and sell in today's business world does not always rest on a persons [sic] actual personal abilities or physical facilities. Such things can be hired, joint ventured or procured via outsourcing. Licensing is also a practical means of business and just as viable a means as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will begin as previously mentioned and then adjudicate and review prevailing market conditions and finally pursue one or more of options expressed above as is his right. Ergo, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

Opposer's Interrogatory No. 11. Identify and describe all agreements between Applicant and any third party concerning the use and/or registration of Applicant's Mark (or any feature, portion, part, element, or component of Applicant's Mark0, including but not limited to, license agreements, consent agreements, coexistence agreements, assignments and settlement agreements.

Applicant's Response: The questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposer but rather is directed at gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks [sic] for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

Applicant's Supplementary Response: There are none at this time.

Opposer's Document Request No. 4. All documents evidencing Applicant's bona fide intent to use Applicant's Mark in the United States on or in connection with aloe vera drinks.

Applicant's Response: No such documents exist, however, the Applicant is unaware of any current USPTO trademark rules and regulations or legal precedent defining what is and what is not "bona fide intent". As such, the Applicant will restate that he has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. Second, the Applicant believes that in todays [sic] business world the capacity to manufacture, distribute and sell does not always rest on a persons [sic] actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review

prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation. Third, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

Applicant's Supplementary Response: The information previously stated is all that is. Hard copies do not exist.

Opposer's Document Request No. 9. Documents sufficient to identify all types of media (including but not limited to newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Applicant intends to advertise, promote, offer, feature, display or sell aloe vera drinks under Applicant's Mark.

Applicant's Response: No such documents exist.

Opposer's Document Request No. 10. Documents sufficient to show all forms and all manners of appearance in which Applicant has depicted, displayed and/or used, or intends to depict, display and/or use Applicant's Mark, including but not limited to all designs, logos, and stylizations.

Applicant's Response: No such documents exist.

See Furman Decl. ¶¶ 4-6, Exs. B-D.

In addition, Opposer's deficiency letters to Applicant provided detailed information about the relevance of its inquiries regarding Applicant's bona fide intent to use the mark. For

example, the first deficiency letter, sent on January 7, 2009, stated (1) that "the requirement that Applicant have a bona fide intent to use the mark in commerce is a guard against misuse of the intent-to-use system by applicants who seek to register marks for improper purposes .... An applicant's complete lack of documentary evidence regarding its intent to use the mark, as well as evidence that an applicant has filed numerous other applications for disparate goods without the capacity or plans to produce any such goods, could be factors in establishing whether an applicant had a bona fide intent to use the applied-for mark in connection with the applied-for goods" (and citing cases) and (2) "Applicant's history and pattern of filing intent-to-use applications for marks that are identical to previously-registered famous or well-known marks is relevant (i) to Applicant's good or bad faith in selecting the L'OREAL PARIS mark at issue in this proceeding and (ii) to Applicant's bona fide intent to use that mark in commerce, and Applicant's possible misuse of the intent-to-use system. Far from being irrelevant and immaterial, the information sought is directly relevant both to the likelihood of confusion analysis and the dilution analysis." Furman Decl. ¶ 5, Ex. C. Opposer's second deficiency letter, dated February 27, 2009, reiterates that "Applicant's history and pattern of filing intent-to-use applications for marks that are identical to previously-registered foreign or well-known marks is relevant to ... Applicant's bona fide intent to use the involved mark in commerce and its possible misuse of the intent-to-use system. *Id.*, ¶ 6, Ex. D.

Based on Applicant's cumulative responses to Opposer's discovery requests and deficiency letters, Opposer believes it has a sufficient basis to state a claim regarding Applicant's lack of bona fide intent to use the mark, and moves to amend its Notice of Opposition to set forth such allegations and to add such claim.

III. ARGUMENT

Under Rule 15(a) of the Federal Rule of Civil Procedure, amendments to pleadings should be freely given at any stage of the proceedings when justice requires, unless the new claim is legally insufficient or the amendment would be prejudicial to the other party. *Forman v. Davis*, 371 U.S. 178, 182 (1962) ("Rule 15(a) declares that leave to amend shall be freely given when justice so requires; this mandate is to be heeded. If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claim on the merits") (internal quotations and citations omitted). The same standard, quite naturally, applies to motions to amend a Notice of Opposition before the Board. Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 507.02. As the Board stated in *Karsten Mfg. Corp. v. Editoy AG*, 79 U.S.P.Q.2d 1783, 1786 (T.T.A.B. 2006), "Rule 15(a) ... encourages courts to look favorably on motions to amend when justice so requires. In deciding such a motion, the Board will grant the motion unless entry of the proposed amendment would violate settled law or would be prejudicial to applicant."

A. L'Oréal's Proposed Amendment to the Notice of Opposition Is Legally Sufficient

For the purposes of amending its Notice of Opposition, Opposer need only properly state a claim, and need not prove its merits. TBMP § 507.02. The statutory language that allows for trademark applications on an intent-to-use basis requires that an applicant have a "bona fide" intent to use the applied-for mark in commerce and that the application be filed "under circumstances showing the good faith of such a person." 15 U.S.C. 1051(b). Without a bona fide intent to use, an application filed on the basis of Section 1(b) is invalid and the mark is not entitled to registration.

The legislative history of the Trademark Law Revision Act of 1988 indicates that Congress intended "bona fide intent to use" to refer to an intent to use in the ordinary course of

trade, and must be a firm intent rather than a hope or wish. *See generally* J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 19:14, at 19-20 (4th ed. 2007) (bona fide intent to use is not established "simply by an officer of the applicant later testifying, 'yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future'"). Bona fide intent to use must be measured by objective facts regarding an applicant's actions, not by self-serving statements regarding an applicant's state of mind, and an "applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce." *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q.2d 1351, 1355 (T.T.A.B. 1994).

The Board has held that a complete lack of documentary evidence can be sufficient to prove that that applicant lacked the requisite bona fide intent to use the mark, stating that absent adequate countervailing facts, "the absence of any documentary evidence on the part of the applicant regarding such intent [to use its mark in commerce] is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b)." *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993). *See also Intel Corp. v. Emeny*, Opposition No. 91123312, 2007 WL 1520948, at *7 (T.T.A.B. May 15, 2007) (no bona fide intent to use where applicant failed to produce evidence or information regarding marketing plans, business plans, or any other objective substantiating evidence); *Boston Red Sox Baseball Club, L.P. v. Sherman*, 88 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2008) (no bona fide intent to use where applicant failed to produce any documentary evidence regarding trademark searches, specimens, labels, or advertising plans); *L.C. Licensing Inc. v. Berman*, 86 U.S.P.Q.2d 1883, 1892 (T.T.A.B. 2008) (no bona fide intent to use where discovery responses failed to produce any facts that "explain or outweigh the failure of applicant, when he filed the application, to have documents which support his claimed intent to use).

Furthermore, in addition to an absence of documentary evidence or any other objective evidence suggesting a bona fide intent to use, certain activities or circumstances provide affirmative indications that an applicant lacks a bona fide intent. Such activities include "an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce under the applied-for marks during the pendancy of the applications," *Lane Ltd*, 33 U.S.P.Q.2d at 1355-56, and lack of industry-relevant experience, *Boston Red Sox*, 88 U.S.P.Q.2d at 1587.

By amending its Notice of Opposition to state that Applicant has no documentary evidence or other objective evidence of its bona fide intent to use the L'OREAL PARIS mark in connection with aloe vera drinks and that Applicant has filed intent-to-use applications for a disparate range of goods for which it has no industry expertise or direct capacity, L'Oréal states a valid claim that the application at issue should be refused for lack of the bona fide intent required by 15 U.S.C. § 1051(b).

B. Opposer's Proposed Amendments Will Not Cause Prejudice to Applicant

The proposed amendment to the Notice of Opposition will not prejudice Applicant. Applicant does not need to take discovery regarding his own intent to use the mark in question, as such facts are entirely within his own knowledge and possession, and Applicant was aware that L'Oréal was seeking such information.

The Board repeatedly has held that there is no prejudice from a motion to amend where the facts at issue are within the applicant's control, and additional discovery is not needed. *Vignette Corp. v. Marino*, Opposition No. 91158854, 2005 WL 1801611, *2 (T.T.A.B. July 26, 2005) (not citable as precedent) ("because applicant would not require discovery on the issue of his own

bona fide intent to use the involved mark in commerce, applicant will not be prejudiced by entry of the proposed amendment); *Glad Prods. Co. v. Illinois Tool Works, Inc.*, 62 U.S.P.Q.2d 1538, 1540 (T.T.A.B. 2002) (allowing proposed amendment would not cause prejudice where "facts pertaining to the new allegations reside with respondent"); *Coach, Inc. v. Mourges*, Opposition No. 91125621, 2004 WL 341248 (T.T.A.B. Feb. 18, 2004) (not citable as precedent) (no prejudice where applicant does not need additional discovery to address the allegations); *Cashflow Techs., Inc. v. Netdecide*, Cancellation No. 30363, 2002 WL 192410 (T.T.A.B. Feb. 7, 2002) (not citable as precedent) (same). Furthermore, the Board can reopen discovery for Applicant's benefit if doing so would be needed to mitigate any prejudice to Applicant. *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216 (T.T.A.B. 1990).

In addition, Applicant was made aware through the course of discovery that L'Oréal was seeking information about his bona fide intent to use the mark, and his pattern of filing other applications for famous or well-known marks without the requisite intent to use. L'Oréal served several discovery requests seeking information about Applicant's bona fide intent to use, as well as detailed information in its deficiency letters regarding L'Oréal's view that Applicant may have lacked the statutorily-required intent. Applicant had the opportunity to submit evidence or explanations regarding his intent to use the mark. Accordingly, Applicant will not be prejudiced in any way if the motion to amend is granted.

C. Allowing L'Oréal's Proposed Amendment is in the Interest of Justice

Where possible, proceedings before the Board should be fully adjudicated on the merits, provided that there is no prejudice to applicant. *Id.* If L'Oréal ultimately prevails on the issue of whether Applicant lacked the requisite intent-to-use at the time that he filed his 1(b) application, the application itself is invalid, and the mark will not be entitled to registration.

Allowing such mark to proceed to registration would violate the purpose of the intent-to-use scheme and would be in derogation of the principles and purposes of Lanham Act. Because there is no prejudice to Applicant, justice requires that L'Oréal be allowed to make its case at trial and have its claim adjudicated on the merits.

IV. CONCLUSION

For the foregoing reasons, L'Oréal motion for leave to amend its Notice of Opposition should be granted.

Dated: June 29, 2009

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman

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75 E. 55th Street
New York, New York 10022
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that the foregoing L'OREAL'S NOTICE OF MOTION TO AMEND ITS NOTICE OF OPPOSITION AND MEMORANDUM IN SUPPORT was served this 29th day of June, 2009, by delivering a true and correct copy of same by UPS delivery, postage pre-paid to:

Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Rosetta Kromer

Rosetta Kromer

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

DECLARATION OF NATALIE G. FURMAN IN SUPPORT OF
OPPOSER'S MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION

I, Natalie G. Furman, declare as follows:

1. I am an attorney employed by the firm of Paul, Hastings, Janofsky & Walker LLP, attorneys of record for Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") in this opposition proceeding.

2. I submit this declaration in support of Opposer's Motion for Leave to Amend its Notice of Opposition. The facts set forth in this declaration are based upon my personal knowledge, except where stated to be "upon information and belief" in which case I believe such information to be true.

3. Attached hereto as Exhibit A is L'Oréal's proposed Amended Notice of Opposition, with new matter appearing in bold in Paragraphs 22-40.

4. Attached hereto as Exhibit B is a true and correct copy of L'Oréal's discovery requests, including requests for admissions, interrogatories, and document requests, and a true and correct copy of Applicant's "Response to Opposers' Requests."

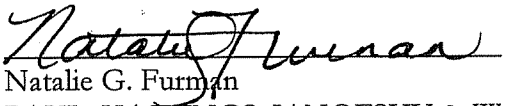
5. Attached hereto as Exhibit C is a true and correct copy of L'Oréal's first letter to Applicant regarding perceived deficiencies in Applicant's discovery responses, and Applicant's first "Response to Opposers' Requests (Supplementary)."

6. Attached hereto as Exhibit D is a true and correct copy of L'Oréal's second letter to Applicant regarding continuing perceived deficiencies in Applicant's discovery responses and supplemental responses, and Applicant's second "Response to Opposers' Requests (Supplementary)."

7. Attached hereto as Exhibit E is a true and correct copy of L'Oréal's letter to Applicant enclosing a proposed stipulation that the parties may submit testimony by affidavit or declaration rather than by deposition. Applicant and counsel for L'Oréal discussed the stipulation in principle on June 24, 2009, and counsel for L'Oréal mailed the letter and proposed stipulation, along with an amended disclosure of witnesses, to Applicant on June 26, 2009.

I declare under penalty of perjury that the foregoing in true and correct pursuant to 28 U.S.C. § 1746.

Dated: New York, NY
June 29, 2009



Natalie G. Furman
PAUL, HASTINGS, JANOFSKY & WALKER LLP
75 East 55th Street
New York, NY 1002
(212) 318-6000 (telephone)
(212) 318-6847 (facsimile)

CERTIFICATE OF SERVICE

I hereby certify that the foregoing DECLARATION OF NATALIE G. FURMAN IN SUPPORT OF OPPOSER'S NOTICE OF MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION was served this 29th day of June, 2009, by delivering a true and correct copy of same by UPS delivery, postage pre-paid to:

Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Rosetta Kromer

Rosetta Kromer

EXHIBIT A

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

[PROPOSED] AMENDED NOTICE OF OPPOSITION

L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") believes that it will be damaged by registration of the mark L'OREAL PARIS by Applicant Robert Victor Marcon ("Marcon" or "Applicant") for "aloe vera drinks" in Class 32 as shown in Application Serial No. 76/596,736, and hereby opposes same on the following grounds:

1. L'Oréal S.A. is a French société anonyme having a place of business at 14 rue Royale, Paris, France 75008.

2. L'Oréal USA, Inc. is a Delaware corporation with a principal place of business at 575 Fifth Avenue, New York, New York 10017, and is the exclusive licensee of L'Oréal S.A. trademarks, including the L'ORÉAL brand name, in the United States.

3. L'Oréal and its affiliates are now, and for many years have been, engaged in the development, manufacture, distribution, marketing and sale of nearly all categories of beauty products, including cosmetics, hair care products, skin care products, perfumery, and related goods

and services. L'Oréal's products are distributed through various channels, including beauty salons, department stores, specialty stores, drugstores, food stores, and other mass merchandise stores.

4. L'Oréal is the owner of, among others, the following federal trademark registrations and published or allowed applications for L'ORÉAL- formative marks as well as of common law rights in marks containing the word L'OREAL (collectively, the "L'OREAL Marks"):

Mark	Status	Reg./Ser. #	Goods/Services
L'ORÉAL	Registered	661,746	Hair colorings, color rinses, hair bleaches, color developers, color intensifiers, and hair conditioners (Class 3)
L'ORÉAL (Stylized)	Registered	540,541	Rouge, face cream, hair lotion, hand cream, eye shadow, face lotion, perfume, cologne, nail polish, suntan oil and face powder (Class 3)
L'OREAL ENDLESS	Registered	3,109,618	Lipstick (Class 3)
L'OREAL E-STRAT CHALLENGE	Registered	3,115,751	Education services, namely providing university level training courses and organizing academic competitions in the fields of marketing, business, and economics (Class 41)
L'OREAL PROFESSIONNEL ELITE	Registered	3,081,932	Conducting a loyalty incentive reward program for independent beauty salons whereby participating member salons can redeem earned points for selected rewards (Class 35)
L'OREAL TECHNIQUE	Registered	3,281,234	Shampoos; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use (Class 3)

L'OREAL PREMIUM	Allowed Application	77/034,330	Perfume, toilet water; gels, salts for the bath and the shower not for medical purposes; toilet soaps, body deodorants; cosmetics, namely, creams, milks, lotions, gels and powders for the face, the body and the hands; non-medicated sun care preparations; make-up preparations; shampoos; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use (Class 3)
L'OREAL MATCH	Allowed Application	78/887,070	Cosmetics (Class 3)
L'OREAL INFINIUM	Published Use-Based Application	78/685,333	Hair spray (Class 3)
L'OREAL HEAT CURL	Allowed Application	76/608,926	Mascara (Class 3)
L'OREAL TIME STOP	Allowed Application	78/686,350	Hair colorants (Class 3)
L'OREAL OUR WORLD	Pending Application	77/354,359	Line of kid's shampoos and conditioners (Class 3)
L'ORÉAL VOLUME COLLAGENE	Pending Application	77/461,637	Mascaras (Class 3)
L'OREAL EXTRA VOLUME COLLAGENE	Pending Application	77/477,820	Mascaras (Class 3)

Copies of registration certificates printed from the USPTO Web site and/or records from the USPTO Trademark Applications and Registrations Retrieval System (TARR) for the above references are annexed hereto as Exhibit A.

5. Each of the registrations identified in paragraph 4 constitutes *prima facie* evidence of the validity of the mark and of L'Oréal's ownership of and exclusive right to use the marks in commerce, and provides constructive notice of ownership thereof by L'Oréal.

6. L'Oréal also has common law rights in the L'ORÉAL PARIS trademark and service mark in connection with a wide range of personal care products and services.

7. L'Oréal's rights in L'ORÉAL and in L'ORÉAL PARIS predate and are superior to those asserted by Applicant in the subject application.

8. L'Oréal is one of the world's largest beauty products companies.

9. L'Oréal, including its affiliates and predecessors-in-interest, has used the L'ORÉAL brand name in the United States since at least the 1950s.

10. For more than fifty years, L'Oréal, including its affiliates and predecessors-in-interest, has produced, advertised, promoted, distributed, and sold personal care products in interstate commerce under its L'ORÉAL mark.

11. L'ORÉAL is widely acknowledged as one of the most recognized and famous trademarks in the world. The L'ORÉAL brand is identified as one of the world's "100 Top Brands" by Business Week/Interbrand (ranked number 51 in the world in 2007) and as one of the world's "Top 100 Most Powerful Brands" by Millward Brown Optimor (ranked number 46 in the world in 2007). Copies of those rankings are attached hereto as Exhibit B.

12. L'Oréal, including its affiliates and predecessors-in-interest, has used L'ORÉAL PARIS as a trademark in the United States and throughout the world for many years. L'ORÉAL PARIS is among the world's largest and best known beauty brands, and includes a wide range of personal care products sold in interstate commerce.

13. Some of L'Oréal's well-known products sold under the L'ORÉAL PARIS brand include the PREFERENCE, NATURAL MATCH, FERIA, and COULEUR EXPERTE hair color products; VIVE PRO hair care preparations; ADVANCED REVITALIFT, AGE PERFECT, MEN'S EXPERT, SKIN GENESIS, SUBLIME GLOW, and SUBLIME BRONZE skincare preparations; the STUDIO LINE hair styling products; BARE NATURALE, COLOUR RICHE,

TRUE MATCH, and WEAR INFINITE cosmetics collections; VOLUMINOUS, DOUBLE EXTEND, TELESCOPIC, and VOLUME SHOCKING mascaras, and the HIP HIGH INTENSITY PIGMENT line.

14. Many products under the L'ORÉAL PARIS brand contain botanicals ingredients, minerals, and nutrients, such as aloe, green tea, Vitamin E, Vitamin C, soy proteins, calcium, pomegranate, and apricot oils.

15. L'ORÉAL PARIS products are widely available in the United States at national mass retailers, drug stores, and supermarkets, including Albertson's, CVS, Duane Reade, Eckerds, K-Mart, Long's, Rite-Aid, Target, Walgreens, and Wal-Mart, in addition to L'ORÉAL PARIS stores. In addition, "Style Space" events are conducted throughout the United States to provide personalized beauty information and consultation services to consumers under the L'ORÉAL PARIS brand.

16. L'ORÉAL PARIS products are promoted by world-famous celebrities and spokespeople, such as Diane Keaton, Andie MacDowell, Beyoncé Knowles, Claudia Schiffer, Aishwarya Rai, Eva Longoria, Heather Locklear, Kerry Washington, Milla Jovovich, Penelope Cruz, and Scarlett Johansson. Under its L'ORÉAL PARIS brand, L'Oréal is the exclusive cosmetics sponsor of the Emmy-nominated television show Project Runway, and has been the show's exclusive cosmetics sponsor since its first season.

17. L'Oréal, under its L'ORÉAL PARIS brand, is also one of the largest corporate fundraisers for ovarian cancer research and awareness. For over a decade, L'Oréal has helped raise millions of dollars through fundraising initiatives including the annual COLOR OF HOPE cosmetics collection, the COLOR OF HOPE jewelry collection, and sponsorship of the prestigious L'Oréal Legends Gala, all under its L'ORÉAL PARIS brand.

18. L'ORÉAL PARIS products are routinely praised by both consumers and editors, and are frequently awarded "best product" awards and accolades in fashion and style magazines. For

example, Allure Magazine awarded L'ORÉAL PARIS SKIN GENESIS its prestigious "Breakthrough Award" in its 2007 Best of Beauty Awards issue; InStyle Magazine selected L'ORÉAL PARIS TRUE MATCH concealer as a "Best Beauty Buy" of 2006; and L'ORÉAL PARIS COLOUR RICHE LIPCOLOUR in Sugar Plum was one of 56 products awarded a Readers' Choice Award in Allure Magazine. Consumers and professionals have come to know and trust the L'ORÉAL and L'ORÉAL PARIS brands, and recognize products and services offered in connection with those marks as originating only with Opposer.

19. As a direct result of the continued prominence and visibility of L'Oréal, the L'ORÉAL Marks, and the L'ORÉAL PARIS brand, the expenditure of hundreds of millions of dollars in advertising and promotion over the years on the L'ORÉAL PARIS brand alone, and millions more on charitable endeavors and other promotional activities with respect to L'Oréal and the L'ORÉAL Marks, and the long and extensive use of the L'ORÉAL Marks and L'ORÉAL PARIS mark, those marks each have acquired widespread recognition and an outstanding reputation among consumers and the trade, have become famous, and symbolize L'Oréal's extensive and valuable goodwill throughout the United States.

20. On information and belief, Applicant is an individual residing at 3471 Sinnicks Avenue, Niagara Falls, Ontario, Canada L2J 2G6.

21. On June 9, 2004, Applicant filed the intent-to-use application at issue herein, Serial No. 76/596,736 seeking to register the mark L'ORÉAL PARIS in Class 32 for "aloe vera drinks."

22. On information and belief, Applicant has never manufactured, sold, licensed or partnered with any other entity to manufacture or sell aloe vera drinks.

23. On information and belief, at the time Applicant filed the application at issue and continuing to date, Applicant did not and does not have the capacity to manufacture, distribute, or sell aloe vera drinks.

24. On information and belief, at the time Applicant filed the application at issue and continuing to date, Applicant has not developed a business plan, conducted any test marketing, contacted any potential partners, developed any logos or packaging, or undertaken any other concrete activities in preparation for use of the applied-for mark with the applied-for goods.

25. Applicant also is the owner of Application Serial No. 76/596,738, an intent-to-use application for NESTLE for "over the counter medications, namely, analgesics; sleep aids; cold and flu medications."

26. Applicant also is the owner of Application Serial No. 76/577,011 for EVIAN for "ice cream; sherbet; and frozen confections."

27. Applicant also is the owner of Application Serial No. 78/288,366 for HEINEKEN for "meat juices."

28. Applicant also is the owner of Application Serial No. 78/288,364 for COORS for "meat juices, and meat juice concentrates."

29. Applicant also is the owner of Application Serial No 78/288,358 for DOM PERIGNON for "meat juices, and broth comprising meat juices."

30. Applicant also is the owner of Application Serial No. 78/288,361, an intent-to-use application for BUDWEISER for beverages.

31. Applicant also is the owner of Application Serial No. 78/288,367 for ABSOLUT for beverages.

32. Applicant also is the owner of Application Serial No 78/288,365 for FINLANDIA for beverages.

33. Applicant also is the owner of Application Serial No 76/596,735 for NESCAFÉ for beverages.

34. Applicant also is the owner of Application Serial No. 76/596,734 for JACK DANIEL'S for "cigars, cigarettes, and chewing tobacco."

35. Applicant also is the owner of Application Serial No 76/596,737 for BAYER for "non-medicated breath fresheners delivered via aerosol spray; non-medicated mouthwash and gargle."

36. Applicant also is the owner of Application Serial No 76/596,733 for CHANEL for "scented stationery and greeting cards."

37. On information and belief, Applicant has never manufactured, sold, or partnered with any other entity to manufacture or sell over-the-counter medications, frozen desserts, meat juices, beverages, tobacco-related products, breath fresheners and mouthwashes, or stationery and greeting cards.

38. On information and belief, at the time Applicant filed the applications referenced in Paragraphs 25-36 and continuing to date, Applicant did not and does not have the capacity to manufacture, distribute, or sell over-the-counter medications, frozen desserts, meat juices, beverages, tobacco-related products, breath fresheners and mouthwashes, or stationery and greeting cards.

39. On information and belief, at the time Applicant filed the applications referenced in Paragraphs 25-36 and continuing to date, Applicant has not developed a business plan, conducted any investigation, conducted any test marketing, contacted any potential partners, developed any logos or packaging, or undertaken any other concrete activities in preparation for use of the applied-for marks with the applied-for goods.

40. On information and belief, at the time Applicant filed the application at issue and continuing to date, Applicant did not have and does not have a bona fide intent to use L'OREAL PARIS in commerce under circumstances demonstrating Applicant's good faith.

As such, the application at issue is invalid and Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1051(b).

41. Applicant's mark L'ORÉAL PARIS so resembles Opposer's L'ORÉAL Marks, trade name and L'ORÉAL PARIS mark, and each of them, as to be likely, when applied to Applicant's goods, to cause confusion or mistake or to deceive. As such, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

42. Applicant's L'ORÉAL PARIS mark so closely resembles Opposer's previously registered L'ORÉAL Marks, previously used L'ORÉAL Marks and trade name, and previously used L'ORÉAL PARIS mark, as to dilute or be likely to cause dilution of the distinctive quality of Opposer's famous L'ORÉAL Marks and L'ORÉAL PARIS mark. As such, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1125(c).

43. For the foregoing reasons, L'Oréal believes it will be damaged by the registration of the mark L'ORÉAL PARIS shown in Application Serial No. 76/596,736 for "aloe vera drinks" in Class 32.

44. This Opposition is timely filed and accompanied with a filing fee of $300.00.

45. WHEREFORE, L'Oréal requests that the registration sought by Applicant be refused, that the Notice of Opposition be sustained, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: June 29, 2009

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: _____

Robert L. Sherman
Natalie G. Furman
75 E. 55th Street
New York, New York 10022
212-318-6000
Attorneys for Opposer

EXHIBIT B

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") respond to the following requests for admissions by serving written responses on the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, within thirty (30) days from the date of service. These requests are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to correct and supplement its responses in a timely manner if Applicant learns that any response is incorrect or incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

1. The terms "Applicant" and "you" refer to Robert Victor Marcon, and Marcon's partners, joint venturers, agents, attorneys, successors-in-interest, predecessors-in-interest, employees and any others acting on behalf of Marcon or over whom Marcon has control.

2. The term "Opposer" or "L'Oréal" shall mean, except where otherwise stated, Opposer L'Oréal S.A. and L'Oréal USA, Inc., L'Oréal S.A.'s and L'Oréal USA, Inc.'s parents, subsidiaries, partners, joint venturers, affiliates, agents, attorneys, successors-in-interest, predecessors-in-interest, employees and any others acting on behalf of L'Oréal S.A. and/or L'Oréal USA, Inc., or over whom L'Oréal S.A. and/or L'Oréal USA, Inc. have control.

3. The term "Applicant's Mark" shall mean the L'ORÉAL PARIS mark that is the subject of U.S. Application Serial No. 76/596,736, and that is the subject of this Opposition proceeding.

4. The term "Applicant's Marks" shall mean any and all marks for which the Applicant has filed applications before the U.S. Patent and Trademark Office, regardless of whether those applications are currently pending, have been registered, or have been abandoned.

5. The term "Opposer's L'ORÉAL PARIS Mark" shall mean L'Oréal's rights in the mark L'ORÉAL PARIS, whether at common law or registered.

6. The term "Opposer's L'ORÉAL Mark" shall mean L'Oréal's rights in the mark L'ORÉAL, including as the subject of U.S. Registration Nos. 661,746 and 540,541, as well as common law rights.

7. The term "document" shall mean, without limitation, every writing or record of every type and description that is or has been in the possession, control or custody of Applicant or of which Applicant has knowledge, whether handwritten, photocopied, telecopied, printed,

electronic or in any other media, including without limitation: correspondence, including e-mail correspondence, invoices, contracts, purchase orders, memoranda, tapes, stenographic or handwritten notes, studies, publications, books, pamphlets, pictures, films, voice recordings, artwork, sketches, drawings, labels, maps, graphs, reports, surveys, minutes, or statistical compilations; every copy of such writing or record where the original is not in the possession, custody or control of Applicant and every copy of every such writing or record where such copy is not an identical copy of an original or where such copy contains any commentary or notation whatsoever that does not appear on the original.

8. The term "date" means the exact day, month and year, if ascertainable; if not ascertainable, the closest approximation that can be made by means of relationship to other events or matters.

9. The term "and" as well as "or" shall be construed both disjunctively and conjunctively, as necessary, to bring within the scope of this request those documents which might otherwise be construed to be outside its scope.

10. Wherever a singular form appears, it also shall be construed as plural, and vice versa, as necessary, to bring within the scope of this request all documents or responses which might otherwise be construed to be outside its scope.

11. The terms "concerning" or "regarding" means reflecting, referring to, incorporating, comprising, touching upon, indicating, evidencing, affirming, denying, or relevant to, in addition to its other customary and usual meaning, and includes, but is not limited to, discussing, constituting, pertaining to, describing, evidencing, identifying, touching upon and/or summarizing.

12. As used herein, "identify" or to "state the identity of" means:

(a) In the case of a person who is an individual: to state the full name, present or last known residence or address (designating which) and present or last known position or business affiliation (designating which); job title; employment address; business and residence telephone numbers of each individual;

(b) In the case of a company, partnership, corporation, proprietorship, association, or other organization or entity, to state: the full name and present or last known address and telephone number; the legal form of such entity or organization; if incorporated; the identity of the person or persons having knowledge of the matter with respect to which the company is named; and the identity of its chief executive officer;

(c) In the case of an act or omission, to state: a description of that act or omission; when it occurred; where it occurred; the identity of the person or persons performing said act (or in the case of an omission, the identity of the person or persons failing to act); the identity of all persons who have knowledge, information or belief about the act or omission; when the act or omission first became known; and the circumstances and manner in which such knowledge was first obtained;

(d) In the case of an oral communication, to state: the date, subject matter, communicator, communicatee, nature of communication, whether it was recorded, and the identity of any witness thereto;

(e) In the case of a document, to state: the identity of the person or persons who prepared it, the sender and recipient, if any; the title or a description of the general nature of its subject; the date of preparation; the date and manner of distribution and publication, if any; the location of each copy and the identity of the present custodian; the identity of the person or

persons who can identify it; the contents of the document verbatim; and if privilege is claimed, the specific basis therefor. In lieu of the foregoing, a copy of the document may be supplied.

13. Each interrogatory or request shall be read to be inclusive rather than exclusive. Accordingly, "including" means "including without limitation." The word "all" includes "any" and vice versa. The past tense includes the present tense and vice versa. The masculine form of any word includes the feminine form and vice versa.

14. Each person responding to interrogatories or requests for admission is required to furnish responsive information within that person's knowledge or the personal knowledge of its, his or her attorneys, agents, employees or other representatives.

15. Each person responding to the document requests is required to furnish responsive documents within that person's possession, custody or control or within the possession, custody or control of its, his or her attorneys, agents, employees or other representatives.

16. Each objection, if any, shall be set forth with specificity and shall include a statement of the grounds for the objection.

17. If any document requested to be identified or produced has been destroyed, provide the following additional information as to each such document:

(a) the date of destruction;

(b) the reason for the destruction;

(c) the identification of the person who destroyed the document; and

(d) the identification of any person who directed that the document be destroyed.

18. If any of these interrogatories cannot be answered in full, respond to the extent possible, specifying the reasons for the inability to respond to the remainder of the interrogatory, and state whatever information or knowledge is available concerning the unanswered portion.

19. In responding to requests for admissions, if a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter, and when good faith requires that a party qualify an answer or deny only part of the matter, the answer must specify the part admitted and qualify or deny the rest. The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.

20. If any responsive information, communication or document is withheld on the basis of any claim of privilege, identify such information, communication or document withheld, state the privilege being relied upon or claimed and the basis for the claim, and identify all persons or entities who have had access to such information, communication or document.

21. Applicant must supplement its responses to all discovery requests as required by Fed. R. Civ. P. 26(e).

REQUESTS FOR ADMISSIONS

1. Each document that Applicant has produced or will produce in response to Opposer's discovery requests is genuine and authentic for purposes of admission into evidence during the testimony periods in this opposition proceeding.

2. Opposer's rights in Opposer's L'ORÉAL Mark and in Opposer's L'ORÉAL PARIS Mark predate the filing by Applicant of the subject application for Applicant's Mark.

3. Applicant has not used Applicant's Mark in commerce.

4. Applicant's Mark is identical to Opposer's L'ORÉAL PARIS Mark.

5. The first term in Applicant's Mark is identical to Opposer's L'ORÉAL Mark.

6. The first term in Applicant's Mark is identical to Opposer's trade name.

7. "L'ORÉAL" is the dominant term of the two terms comprising Applicant's Mark.

8. L'Oréal is one of the largest cosmetics and personal care products companies in the world and in the U.S.

9. L'Oréal is one of the best known cosmetics and personal care products companies in the world and in the U.S.

10. L'ORÉAL is one of the best known and widely recognized brands in the world and in the U.S.

11. Opposer's L'ORÉAL Mark is famous.

12. Opposer's L'ORÉAL PARIS Mark is famous.

13. Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are famous in connection with cosmetics and personal care.

14. Opposer's L'ORÉAL Mark is widely recognized by the general public.

15. Opposer's L'ORÉAL PARIS Mark is widely recognized by the general public.

16. Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are widely recognized in connection with cosmetics and personal care.

17. The L'Oréal trade name, Opposer's L'ORÉAL Mark, and Opposer's L'ORÉAL PARIS Mark are and for a long time have been widely marketed and promoted to a broad class of consumers through television advertisements, print media, and on the Internet.

18. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available through several channels of trade, including but not limited to drug stores, supermarkets, cosmetics stores and beauty care establishments, and on the Internet.

19. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available at stores where other personal care goods are sold.

20. Products bearing Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark are available at stores where herbal, mineral, and botanical products (such as vitamins and supplements, health foods, and health drinks) are sold.

21. Applicant was aware of Opposer prior to applying for Applicant's Mark.

22. Applicant was aware of Opposer's L'ORÉAL PARIS Mark prior to applying for federal registration of Applicant's Mark.

23. Applicant was aware of Opposer's L'ORÉAL Mark prior to applying for federal registration of Applicant's Mark.

24. Applicant selected Applicant's Mark at least in part because of the wide-spread recognition of Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark.

25. Applicant selected Applicant's Mark because of the wide-spread recognition of Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark.

26. Applicant has filed several other applications with the U.S. Patent and Trademark Office ("PTO") for marks that he knows are, or he intends to be, identical to previously-registered famous or well-known marks.

27. Applicant filed an intent-to-use trademark application with the PTO for NESTLE for "over the counter medications, namely, analgesics; sleep aids; cold and flu medications" (Application Serial No. 76/596,738).

28. Prior to filing his application to register NESTLE, Applicant was aware of the prior registrations for and/or the extensive trademark use of NESTLE by the owner of that mark in connection with flavored milk and milk-based beverages, water, infant formula, chocolates and candies, ice-cream bars, dietary supplements, and/or bottled water.

29. Applicant filed an intent-to-use trademark application with the PTO for BUDWEISER for various types of beverages, including "water, still water, mineral water, spring water ... sparkling water ... juices, flavored drinks ... non-alcoholic beverages, preparations for making beverages, syrups" (Application Serial No. 78/288,361).

30. Prior to filing his application to register BUDWEISER, Applicant was aware of the prior registrations for and/or the extensive trademark use of BUDWEISER by the owner of that mark in connection with beer, drinking vessels and/or other products.

31. Applicant filed an intent-to-use trademark application with the PTO for EVIAN for "ice cream; sherbet; and frozen confections" (Application Serial No. 76/577,011).

32. Prior to filing his application to register EVIAN, Applicant was aware of the prior registrations for and/or the extensive trademark use of EVIAN by the owner of that mark in connection with, among other things, natural mineral waters; "skin care lotion sold in an atomizer preparation" and various other personal care products including creams, lotions, perfumery, and cosmetics; dietary food supplements; water-based mineral supplements; and a variety of beverages including fruit and vegetable juices, lemonade, ginger beer, and sorbet drinks.

33. Applicant has also filed intent-to-use applications with the PTO for, among other things, HEINEKEN for "meat juices" (Ser. No. 78/288,366); ABSOLUT for various beverages including beer, mineral water, sparkling water, and juices (Ser. No. 78/288,367); FINLANDIA for various beverages including water, juices, and flavored drinks (Ser. No. 78/288,365); COORS for "meat juices, and meat juice concentrates" (Ser. No. 78/288,364); JACK DANIEL'S for "cigars, cigarettes, and chewing tobacco" (Ser. No. 76/596,734); DOM PERIGNON for "meat juices, and broth comprising meat juices" (Ser. No. 78/288,358); BAYER for "non-medicated breath fresheners delivered via aerosol spray; non-medicated mouthwash and gargle" (Ser. No. 76/596,737); NESCAFÉ for ""distilled spirits; liqueurs; cordials; and alcoholic coolers, namely; distilled spirit based and malt based" (Ser. No. 76/596,735); and CHANEL for "scented stationery and greeting cards" (Ser. No. 76/596,733).

34. Prior to filing each and every application identified in Request for Admissions No. 33, Applicant was aware of the prior registrations for and/or the extensive trademark use of the subject mark by a large or well-known company, and of the fame or general public recognition of such mark.

35. Applicant's decision to apply for each of Applicant's Marks, including each of the marks identified in Requests for Admissions Nos. 27-33 and Applicant's Mark at issue in this proceeding, was based at least in part on Applicant's awareness of the prior existence of an identical famous or well-known mark.

36. Applicant's decision to apply for each of Applicant's Marks, including each of the marks identified in Requests for Admissions Nos. 27-33 and Applicant's Mark at issue in this proceeding, was based on Applicant's awareness of the prior existence of an identical famous or well-known mark.

37. Applicant did not have a bona fide intent to use each of Applicant's Marks in commerce at the time that he filed an application for each of Applicant's Marks with the PTO.

38. Applicant does not have a bona fide intent to use Applicant's L'ORÉAL PARIS Mark in commerce, and did not have such intent at the time of filing the application that is the subject of this proceeding.

39. Applicant's purpose in applying for Applicant's L'ORÉAL PARIS MARK and/or other of Applicant's Marks is to make a philosophical point about trademark protection.

40. Applicant initially applied to use Applicant's Mark in connection with several products, including perfumes and fragrances; vitamin, mineral and herbal supplements and

combinations thereof; aloe vera drinks; shaving balms, lotions, creams, and soaps; topical skin balms, namely sunscreens, tanning balms, lotions, creams, and combinations thereof; candles; and shaving implements.

41. At the time of filing the application for Applicant's Mark, Applicant was aware that Applicant's Mark as used in connection with perfumes and fragrances; shaving balms, lotions, creams, and soaps; and sunscreens and tanning balms would create a likelihood of confusion with Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark, and specifically that it would create a likelihood of confusion with Opposer's L'ORÉAL mark that is the subject of Registration No. 540,541 for "rouge, face cream, hair lotion, hand cream, eye shadow, face lotion, perfume, cologne, nail polish, suntan oil and face powder."

42. At the time of filing the application for Applicant's Mark, Applicant signed a declaration stating that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in identical form thereto or in such new [sic] resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive...."

43. Applicant signed such declaration despite being aware of Opposer's existing registrations for L'ORÉAL and common law use of L'ORÉAL and L'ORÉAL PARIS in connection with cosmetics in general, and specifically despite being aware of Opposer's registration for L'ORÉAL for goods that are identical or very closely related to goods identified in Applicant's application, namely, perfume and cologne, face cream, face lotion, and hand cream; and suntan oil.

44. On or about July 14, 2005, in response to an Office Action that issued from the PTO, Applicant amended his application to (a) state that "the wares or goods herein associated with

the mark 'L'ORÉAL PARIS' will not be manufactured or produced in, or will have any other connection with, the geographic location named in the mark," and (b) cancel all goods other than "aloe vera drinks."

45. Applicant has never manufactured or sold aloe vera drinks.

46. Applicant has no capacity and/or intention to manufacture or sell aloe vera drinks.

47. To the extent that Applicant intends to offer aloe vera drinks under Applicant's Mark, Applicant chose the name L'ORÉAL PARIS because consumers associate that mark with Opposer's L'Oréal name and Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

48. To the extent that Applicant intendd to offer aloe vera drinks under Applicant's Mark, Applicant intends to trade on the goodwill and brand awareness developed by L'Oréal in Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

49. Aloe vera is an ingredient commonly used in and associated with personal care products, such as but not limited to body lotions, skin creams, after-tanning creams and lotions, hair care products and/or cosmetics.

50. Aloe vera is more commonly associated with skin care products than with beverages.

51. Prior to applying for Applicant's Mark, Applicant was aware that Opposer sells personal care products, including but not limited to skin creams and cosmetics.

52. Prior to applying for Applicant's Mark, Applicant was aware that aloe vera is used in personal care products, including but not limited to skin creams and cosmetics.

53. Prior to applying for Applicant's Mark, Applicant was aware that aloe vera is used in the types of products sold under Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

54. Prior to applying for Applicant's Mark, Applicant was aware that L'Oréal uses herbal, mineral, and botanical ingredients in products offered under Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

55. Personal care products and herbal, mineral, and botanical products, such as but not limited to herbal supplements or beverages, often emanate from the same source.

56. Personal care products and herbal, mineral, and botanical products, such as but not limited to supplements or beverages, often move through the same channels of trade.

57. Products offered under Opposer's L'ORÉAL Mark and/or Opposer's L'ORÉAL PARIS Mark are sold at stores that also carry herbal, mineral, and botanical products, such as but not limited to supplements or beverages.

58. Drugstores and supermarkets offer both beverages and personal care products such as skin creams.

59. Consumers encountering Applicant's Mark in the marketplace are likely to associate the mark with Opposer, with Opposer's L'ORÉAL PARIS Mark and/or with Opposer's L'ORÉAL Mark.

60. Prior to applying for Applicant's Mark, Applicant was aware that consumers would be likely to believe that aloe vera products offered under Applicant's Mark emanate from the same

source as personal care products offered under Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark, or are approved by or affiliated with L'Oréal.

61. Applicant is not aware of any other well-known mark utilizing L'ORÉAL.

62. Applicant is not aware of trademark use of the mark L'ORÉAL PARIS by any entity other than L'Oréal.

63. L'Oreal is listed as a surname for fewer than ten individuals or families in the United States, according to a "people search" on the 411.com Internet site.

64. Oreal is listed as a surname for fewer than thirty five (35) individuals or families in the United States, according to a "people search" on the 411.com Internet site.

65. Kodak is a famous trademark.

66. Kodak is listed as a surname for at least 100 individuals or families in the United States, according to a "people search" on the 411.com Internet site.

67. Kodak is a more commonly listed surname than L'Oreal or Oreal in the United States.

68. Buick is a famous trademark.

69. Buick is listed as a surname for approximately 300 individuals or families in the United States, according to a "people search" on the 411.com Internet site.

70. Buick is a more commonly listed surname than L'Oreal or Oreal in the United States.

71. DuPont is a famous trademark.

72. DuPont or Du Pont is listed as a surname hundreds of individuals or families in the United States, according to a "people search" on the 411.com Internet site. According to that site, DuPont or Du Pont is listed as a surname for more than 300 individuals or families in the state of California alone, approximately another 300 individuals or families in the state of Texas alone, and approximately another 300 individuals or families in the state of New York alone.

73. DuPont or Du Pont is a more commonly listed surname than L'Oreal or Oreal in the United States.

74. The word PARIS as used in connection with Applicant's goods is geographically misdescriptive.

Dated: September 29, 2008

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman

Robert L. Sherman
Natalie G. Furman
75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

OPPOSER'S FIRST SET OF INTERROGATORIES

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") answer the following interrogatories, in writing and under oath, by serving written responses on the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, within thirty (30) days from the date of service. These interrogatories are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to correct and supplement its responses in a timely manner if Applicant learns that any response is incorrect or incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

The Definitions and Instructions contained in Applicant's First Set Of Requests for Admissions served herewith are incorporated by reference and shall apply to these requests.

INTERROGATORIES

1. State the date of and describe the reasons for the selection of Applicant's Mark, including the consideration of any other marks and/or any other goods or services, and identify the person(s) with the most knowledge of the selection of Applicant's Mark and goods.

2. State the date and describe the circumstances under which Applicant first became aware of Opposer, of Opposer's L'ORÉAL Mark and of Opposer's L'ORÉAL PARIS Mark, and identify the person most knowledgeable of the foregoing.

3. Identify all investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning confusion or the likelihood of confusion between Applicant's Mark and Opposer's L'ORÉAL Mark or Opposer's L'OREAL PARIS Mark, between Applicant and Opposer, and/or between Applicant's products and Opposer's products.

4. Identify all investigations, research, searches, studies, focus groups, and polls that Applicant has ever conducted, received, or seen concerning the availability for use and/or registration of Applicant's Mark or variations thereof.

5. State all facts that support and evidence Applicant's alleged bona fide intent to use Applicant's Mark in commerce on or in connection with aloe vera drinks as of the filing date of Application Serial No. 76/596,736 and continuing to date.

6. State the actual or intended date of first use anywhere and date of first use in the United States commerce of Applicant's Mark in connection with aloe vera drinks.

7. Describe the types or classes of purchasers to whom Applicant has marketed or intends to market aloe vera drinks in connection with Applicant's Mark.

8. Describe the channels of trade through which Applicant has marketed or intends to market aloe vera drinks in connection with Applicant's Mark.

9. Identify all third parties of which Applicant is aware that advertise, promote, offer or sell both personal care products and herbal, mineral, or botanical products, such as but not limited to supplements or beverages.

10. Identify the persons most familiar with Applicant's Mark, Applicant's aloe vera products, Applicant's actual or intended advertising, promotion, and marketing of aloe vera drinks in connection with Applicant's Mark, and Applicant's actual or intended channels of trade and class of consumers for aloe vera drinks.

11. Identify and describe all agreements between Applicant and any third party concerning the use and/or registration of Applicant's Mark (or any feature, portion, part, element, or component of Applicant's Mark), including but not limited to, license agreements, consent agreements, coexistence agreements, assignments, and settlement agreements.

12. Identify all of Applicant's related companies, including predecessors-in-interest, successors-in-interest, parent, subsidiary, and sister corporations, or other persons and state whether any of them intends to use Applicant's Mark, or intends to manufacture, distribute, or sell any products in connection with Applicant's Mark.

13. Identify each expert witness from whom Applicant intends to introduce testimony during its testimony period in this proceeding and provide the information required in Fed. R. Civ. P. 26(a)(2)(B)

Dated: September 29, 2008

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman

Robert L. Sherman
Natalie G. Furman
75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF INTERROGATORIES has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

OPPOSER'S FIRST SET OF DOCUMENT REQUESTS

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and 37 C.F.R. 2.120, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") hereby requests that Applicant Robert Victor Marcon ("Marcon" or "Applicant") produce the documents and things requested below for inspection and copying to L'Oréal at the offices of Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY 10022, or at such other place as agreed to by the parties within thirty (30) days from the date of service. These document requests are continuing and impose upon Applicant the obligations stated in Fed. R. Civ. P. 26, including Applicant's obligation to supplement documents in a timely manner if Applicant discovers that its production is incomplete.

For the convenience of the Board and the parties, Opposer requests that each request be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

The Definitions and Instructions contained in Applicant's First Set Of Requests for Admissions served herewith are incorporated by reference and shall apply to these requests.

REQUESTS FOR DOCUMENTS AND THINGS

REQUEST NO. 1:

All documents and tangible things identified or requested to be identified or comprising the information used, referenced or otherwise incorporated in response to Opposer's First Set Of Interrogatories.

REQUEST NO. 2:

All documents referring or relating to Applicant's consideration of marks and selection and clearance of Applicant's Mark, including but not limited to, searches, investigations, surveys, studies, research, polls, reports and opinions that Applicant has ever conducted, received, or seen concerning the availability for use and/or registration of L'ORÉAL PARIS or variations thereof.

REQUEST NO. 3:

All documents referring or relating to Applicant's consideration of goods or services to be offered in connection with the L'ORÉAL PARIS Mark, including but not limited to, searches, investigations, surveys, studies, research, polls, reports and opinions.

REQUEST NO. 4:

All documents evidencing Applicant's bona fide intent to use Applicant's Mark in the United States on or in connection with aloe vera drinks.

REQUEST NO. 5:

All market surveys, studies or other reports concerning U.S. consumers of products intended to be sold in connection with Applicant's Mark.

REQUEST NO. 6:

Documents sufficient to identify the classes or types of consumers of products intended to be offered, sold, advertised and/or promoted in connection with Applicant's Mark.

REQUEST NO. 7:

Documents sufficient to identify the channels of trade for products intended to be offered, sold, advertised and/or promoted in connection with Applicant's Mark.

REQUEST NO. 8:

Documents sufficient to identify all retail locations, including but not limited to drug stores, salons, and supermarkets, where Applicant intends to offer, sell, advertise, or promote products in connection with Applicant's Mark.

REQUEST NO. 9:

Documents sufficient to identify all types of media (including but not limited to newspapers, magazines, trade journals, direct mail advertising, radio, television, and the Internet) in which Applicant intends to advertise, promote, offer, feature, display, or sell aloe vera drinks under Applicant's Mark.

REQUEST NO. 10:

Documents sufficient to show all forms and all manners of appearance in which Applicant has depicted, displayed, and/or used, or intends to depict, display and/or use Applicant's Mark, including but not limited to all designs, logos, and stylizations.

REQUEST NO. 11:

Documents showing, referring or relating to all third parties of which Applicant is aware that advertise, promote, offer, or sell both cosmetics or personal care goods and herbal, botanical, or mineral products.

REQUEST NO. 12:

All documents referring or relating to the date when and circumstances under which Applicant first became aware of Opposer and Opposer's L'ORÉAL Mark and Opposer's L'ORÉAL PARIS Mark.

REQUEST NO. 13:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning confusion or the likelihood of confusion between Applicant's Mark and Opposer's L'ORÉAL PARIS Mark or Opposer's L'ORÉAL Mark, between Applicant and Opposer, and/or between Applicant's products and Opposer's products.

REQUEST NO. 14:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions that Applicant has ever conducted, received, or seen concerning dilution or the likelihood of dilution of Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark due to Applicant's use or intended use of Applicant's Mark.

REQUEST NO. 15:

All documents comprising, referring, or relating to investigations, surveys, research, polls, focus groups, or opinions concerning the level of fame or recognition of L'Oréal's trade name or

Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark, or any other mark associated with L'Oréal.

REQUEST NO. 16:

All documents comprising, referring, or relating to communications, inquiries, or comments to or from any person referring or relating to Opposer or Opposer's L'ORÉAL Mark or Opposer's L'ORÉAL PARIS Mark.

REQUEST NO. 17:

Documents referring or relating to judicial and/or administrative proceedings in any forum referring or relating to Applicant's Mark or any portion, part, feature, element, or component of Applicant's Mark.

REQUEST NO. 18:

Documents sufficient to identify all names and marks comprised of or containing a mark previously-registered or widely used by another that Applicant has registered, currently uses, intends to use, or has sought to register as a trademark, service mark, or domain name.

REQUEST NO. 19:

Documents comprising, referring, or relating to agreements between Applicant and any third party concerning the use and/or registration of Applicant's Mark, including but not limited to, license agreements, consent agreements, coexistences agreements, assignments, and settlement agreements.

REQUEST NO. 20:

Documents sufficient to identify any and all of Applicant's related companies, including predecessors-in-interest, succcessors-in-interest, parent, subsidiary, and sister corporations, and sufficient to indicate whether any of those related companies uses Applicant's Mark.

REQUEST NO. 21:

All documents referring or relating to each expert witness from whom Applicant intends to introduce testimony during its testimony period in this proceeding, and all documents pertaining to the information required to be disclosed under Fed. R. Civ. P. 26(a)(2)(B), including all communications to or from the expert witness and all final and draft reports prepared by or for the expert witness.

REQUEST NO. 22:

All documents relating to the term L'ORÉAL or L'ORÉAL PARIS or to Opposer L'Oréal not produced in response to any of Opposer's other requests for documents and things.

REQUEST NO. 23:

A copy of the complete file history of Application Serial No. 76/596,736.

REQUEST NO. 24:

A copy of the complete file history of Applicant's Canadian application and opposition proceeding regarding Applicant's Mark.

Dated: September 29, 2008

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman

Robert L. Sherman
Natalie G. Furman
75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for L'Oreal U.S.A., Inc. and L'Oreal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the OPPOSER'S FIRST SET OF DOCUMENT REQUESTS has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, CANADA, by depositing a true copy of the same with UPS, postage prepaid, on September 29, 2008.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)

Opposition No.:	**91184456**
TRADEMARK:	**L'OREAL PARIS**
Application Serial No.:	**76596736**
Applicant(s):	Robert Victor Marcon
Opposer(s):	L'Oreal USA, Inc. and L'Oreal S.A.
Opposer(s) Attorney:	Robert L. Sherman
Reply Number:	Communication - B
Number of Pages:	Two hundred and six (206)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as EXPRESS MAIL in an envelope addressed to, "U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA, U.S.A., 22313-1451".

Express Mail Serial No.: **EB 182588915 US**

Date of Deposit: **30 October 2008**

Depositor's Signature: Robert Marcon **(Robert Marcon)**

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing correspondence has been served on the Opposers' representative "ROBERT L. SHERMAN" by mailing said copy via U.S. Postal Service EXPRESS MAIL to "Robert L. Sherman, Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, NY, U.S.A., 10022".

Express Mail Serial No.: **EQ 678050187 US**

Date of Deposit: **30 October 2008**

Depositor's Signature: Robert Marcon **(Robert Marcon)**

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant:	Robert Victor Marcon	
Mailing Address:	Street:	3471 Sinnicks Avenue
	City/Province:	Niagara Falls, Ontario
	Country:	Canada
	Zip Code:	L2J 2G6
Other Communications:	Telephone:	(905) 354-2543

OPPOSERS' INFORMATION

First Opposer:	L'Oreal USA, Inc.
Mailing Address:	575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications:	Unknown

Second Opposer:	L'Oreal S.A.
Mailing Address:	L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications:	Unknown

Opposers' Attorney:	Robert L. Sherman,	
	Paul, Hastings, Janofsky & Walker LLP	
Mailing Address:	Street:	75 East 55th Street
	City/State:	New York, New York
	Country:	U.S.A.
	Zip Code:	10022
Other Communications:	Telephone:	(212) 318-6000
	e-mail:	rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - B
RESPONSE TO OPPOSERS' REQUESTS

This is a response to the letter mailed (September 29, 2008) by the Opposers' Attorney, namely, Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter consists of three (3) requests which include:

(1) Opposer's First Set of Requests for Admissions (1-74);
(2) Opposer's First Set of Interrogatories (1-13); and
(3) Opposer's First Set of Document Requests (1-24).

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information to the Opposers' Attorney and the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board. Note also, that the Applicant will respond to each request made by the Opposers' Attorney in the same sequence and order as was presented in his letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is also include as reference).

Included in this communication are the following five (5) items totalling two hundred and sixty-eight (268) pages:

(1) Applicant's response to the Opposer's First Set of Requests for Admissions

(1-74);

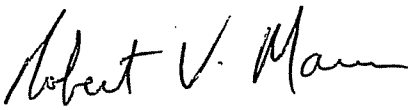
(2) Applicant's response to the Opposer's First Set of Interrogatories (1-13);

(3) Applicant's response to the Opposer's First Set of Document Requests (1-24);

(4) A copy of the aforesaid Attorney letter mailed September 29, 2008; and

(5) Applicant's Notice of Reliance (Applicant's Evidence).

Respectfully submitted,



Robert V. Marcon,
Applicant Pro Se
30 October 2008

Opposer's First Set of Requests for Admissions (1-74)

1. The Applicant acknowledges said statement.

2. The Applicant disagrees with said claim.

First, the USPTO trademark database shows that the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

Second, trademarks must be considered in their entirety and not as dissected items. The Opposer other marks do not consist of the words "L'OREAL PARIS".

Third, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless if the wares were not taken into account. The Opposer's wares are not even remotely similar to the Applicant's sole remaining ware.

Consequently, the Applicant thereby concludes that the Opposers' rights do not predate those of the Applicant.

3. The Applicant acknowledges said statement.

4. The Applicant disagrees with said claim. According to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

5. The Applicant acknowledges said statement.

6. The Applicant acknowledges said statement.

7. Applicant disagrees with said statement.

8. The Applicant is without knowledge or information sufficient to form a belief as

68 to the validity of the Opposers' statement.
69
70 9. The Applicant is without knowledge or information sufficient to form a belief as
71 to the validity of the Opposers' statement.
72
73 10. The Applicant is without knowledge or information sufficient to form a belief as
74 to the validity of the Opposers' statement.
75
76 11. The Applicant is without knowledge or information sufficient to form a belief as
77 to the validity of the Opposers' statement.
78
79 12. The Applicant disagrees with said claim. According to the USPTO trademark
80 database the Opposers do not own or control any "LIVE" trademarks consisting
81 of the words "L'OREAL PARIS". As may regard any common law or any other
82 rights claimed by the Opposer -- the Applicant is without knowledge or
83 information sufficient to form a belief as to the validity of the Opposers' statement.
84
85 13. The Applicant is without knowledge or information sufficient to form a belief as
86 to the validity of the Opposers' statement.
87
88 14. The Applicant is without knowledge or information sufficient to form a belief as
89 to the validity of the Opposers' statement.
90
91 15. The Applicant disagrees with said claim. According to the USPTO trademark
92 database the Opposers do not own or control any "LIVE" trademarks consisting
93 of the words "L'OREAL PARIS". As may regard any common law or any other
94 rights claimed by the Opposer -- the Applicant is without knowledge or
95 information sufficient to form a belief as to the validity of the Opposers' statement.
96
97 16. The Applicant is without knowledge or information sufficient to form a belief as
98 to the validity of the Opposers' statement.
99
00 17. The Applicant is without knowledge or information sufficient to form a belief as

to the validity of the Opposer's statement.

18. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement.

In regards to the mark "L'OREAL" -- the Applicant has seen various products bearing the mark "L'OREAL" in drug stores and supermarkets. However, this is not an unusual situation for drug stores, supermarkets, and large big box stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

19. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement.

In regards to the mark "L'OREAL" -- the Applicant has seen other personal care products sold in the same stores. However, this is not an unusual situation for large retail stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

20. In regards to the mark "L'OREAL PARIS" -- the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

In regards to the mark "L'OREAL" -- the Applicant has seen other said products sold in the same stores. However, this is not an unusual situation for large stores normally sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

21. The Applicant acknowledges said statement.

22. According to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS". Applicant, however, was aware of previous "DEAD" marks consisting of the words "L'OREAL PARIS" which belonged to the Opposers.

23. The Applicant acknowledges said statement.

24. The Applicant disagrees with said statement.

25. The Applicant disagrees with said statement.

26. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

27. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

28. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these

opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

29. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

30. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

31. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

32. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

33. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

34. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

35. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve

only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

36. The question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Such questions being irrelevant and immaterial need not be answered.

In regards to the Applicant's application for the mark "L'OREAL PARIS" the Applicant disagrees with the Opposers. Moreover, the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS" according to the USPTO database.

37. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

38. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

39. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make a philosophical point about trademark protection.

As for the Applicant's other applications -- the question is irrelevant and immaterial in that it does not deal with the subject matter at hand. That is because what is important and cardinal in these opposition proceedings is not whether the Applicant's other applications should or should not be allowed but whether or not the Applicant's mark "L'OREAL PARIS" should or should not be allowed. Superfluous references to unrelated and independent trade-marks applications which have no bearing on this case serve only to cloud the important issues which are truly relevant. Consequently, such questions being irrelevant and immaterial need not be answered.

40. The Applicant acknowledges said statement.

41 The Applicant acknowledges the wares so named therein.

The Applicant, however, disagrees with the Opposers in that the Applicant did not believe that confusion would occur between the Applicant's mark "L'OREAL PARIS" and those of the Opposers since the USPTO trademark database had not revealed any conflicting wares with the Applicant's mark "L'OREAL PARIS".

In addition, according to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

42. The Applicant acknowledges said statement.

43. The Applicant, however, disagrees with the Opposers in that the Applicant did not believe that confusion would occur between the Applicant's mark "L'OREAL PARIS" and those of the Opposers since the USPTO trademark database had not revealed any conflicting wares with the Applicant's mark "L'OREAL PARIS".

Second, according to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

Third, it should be realized that when determining prospective confusion between trademarks the trademarks must be considered in their entirety and not as dissected items. The Opposers' marks do not consist solely of the words "L'OREAL PARIS" and the Opposers' marks "L'OREAL" do not include the word "PARIS" in their constituencies.

Fourth, the fundamental concept of a trademark being granted in relation to certain wares would be rendered meaningless if the nature of wares were not taken into account. This concept is born out by the very fact that the USPTO trademark database contains many identical trademarks that have been and continue to be allowed because they list wares sufficiently different to overt confusion. The Applicant's "L'OREAL PARIS" mark would be no different.

Fifth, the purpose of the U.S. Patent and Trademark Office, as well as any other similar office, is to safeguard existing trademarks. As such, all applications are thoroughly examined and reviewed for that purpose. Thus, if an application is flawed or the applicant erred, in any manner, those errors will be corrected accordingly in a manner specified by the rules and regulation currently existing. No trademark application will be permitted to be approved if it has not met all the legal requirements stipulated in law.

Thus, the Applicant, in prosecuting his application, has deleted or otherwise removed all wares but one. That one remaining ware is "aloe vera drinks". Thus, what is truly in dispute is not the Applicant deleted wares but is sole remaining wares or "aloe vera drinks". With this in mind, the Applicant suggest that the Opposers' Attorney focus on said remaining ware and not upon wares long since cancelled.

44. The Applicant acknowledges said statement.

45. The Applicant acknowledges said statement.

46. The Applicant disagrees with the Opposers. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce. In todays business world the capacity to manufacture, distribute and sell does not always rest on a persons actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch.

47. Applicant disagrees with the Opposers' statement. The Opposers' marks have never been associated, even remotely, with "aloe vera drinks".

48. Applicant disagrees with the Opposers' statement.

Second, according to the USPTO database the Opposers do not own or control any "LIVE" trademarks consisting of the words "L'OREAL PARIS".

Third, it should be realized that when determining prospective confusion between trademarks the trademarks must be considered in their entirety and not as dissected items. The Opposers' marks do not consist solely of the words "L'OREAL PARIS" and the Opposers' marks "L'OREAL" do not include the word "PARIS" in their constituencies.

Fourth, the fundamental concept of a trademark being granted in relation to certain wares would be rendered meaningless if the nature of wares were not taken into account. This concept is born out by the very fact that the USPTO trademark database contains many identical trademarks that have been and continue to be allowed because they list wares sufficiently different to overt confusion. The Applicant's mark "L'OREAL PARIS" would be no different.

49. The Applicant acknowledges said statement. However, the Opposers, while they may present wares whose compositions contain aloe vera, such examples would be very poor at best for the simple reason that any mark is only associated with the final product itself and not the individual ingredients or constituents that make up those products. After all, products such as milk may contain vitamin D, orange juice may be supplemented with calcium, and cereal fortified with multiple vitamins. Many other unrelated products also employ vitamins, minerals and even herbs but it would be clearly unreasonable to conclude that L'OREAL would also be associated with milk, juice, cereal or even herbs just because some of their cosmetics, skin creams or lotions contained traces of milk, vitamins, minerals or herbs. After all, a person seeking hair dye, cosmetics or skin cream does not contemplate nor go looking for aloe vera drinks (and vice versa). This same analogy also applies to all of the wares evidenced in these opposition proceedings be they the Opposers' or that of others. That is, the final wares themselves are what may or may not be found confusing and not the individual ingredients composing or constituting those wares.

50. Applicant disagrees with the Opposers' statement. In todays business environment beverages containing aloe vera are not uncommon. As to which is the dominant sector, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

51. Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks only.

52. Applicant acknowledges the Opposers' statement.

53. Applicant acknowledges the Opposers' statement.

54. Applicant acknowledges the Opposers' statement.

55. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

56. The term "often" is open ended. As far as the Applicant is aware personal care products such as hair dye, cosmetics, and skin creams are not sold through restaurants, clubs, and bars thereby demonstrating that the channels of trade of different. As such, the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement in regards to all channels of trade.

57. The only remaining ware left to the Applicant is "Aloe Vera Drinks". The Applicant is aware of such products being sold in some establishments that also sell wares under the Opposers' marks and some establishments like restaurants, clubs, and bars that do not. However, the Opposers, while they may present wares whose compositions contain aloe vera, such examples would be very poor at best for the simple reason that any mark is only associated with the final product itself and not the individual ingredients or constituents that make up those products. After all, products such as milk may contain vitamin D, orange juice may be supplemented with calcium, and cereal fortified with multiple vitamins. Many other unrelated products also employ vitamins, minerals and even herbs but it would be clearly unreasonable to conclude that L'OREAL would also be associated with milk, juice, cereal or even herbs just because some of their cosmetics, skin creams or lotions contained traces of milk, vitamins, minerals or herbs. After all, a person seeking hair dye, cosmetics or skin cream does not contemplate nor go looking for aloe vera drinks (and vice versa). This same analogy also applies to all of the wares evidenced in these opposition proceedings be they the Opposers' or that of others. That is, the final wares themselves are what may or may not be found confusing and not the individual ingredients composing or constituting those wares.

Moreover, it is not an unusual situation for drug stores, supermarkets, and large big box stores to sell tens of thousands of different products from a multitude of different companies some of which employ identical marks for similar wares.

58. Applicant acknowledges said statement.

59. Applicant disagrees with said statement.

60. Applicant disagrees with said statement.

61. Applicant acknowledges said statement.

62. Applicant disagrees with said statement because the Opposers do not own or control any live marks consisting of the words "L'OREAL PARIS" according to the USPTO trademark database.

63. The Applicant acknowledges said statement. However, the Applicant has provide further information in regards to the name "L'Oreal" in his "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" also submitted herein. Second, a better result would have been garnered if something like "LEXIS NEXIS" were used.

64. The Applicant acknowledges said statement. However, the Applicant has provide further information in regards to the name "Oreal" in his "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" also submitted herein. Second, a better result would have been garnered if something like "LEXIS NEXIS" were used.

65. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

66. The Applicant acknowledges said statement.

67. The Applicant disagrees with said statement in that the name "L'Oreal" and "Oreal" mean the same thing. That is, in the French language L'Oreal means "The

Oreal" and "Oreal" remains "Oreal". As such, if one considers this fact then the name "Oreal" is more common (see Applicant "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" submitted herein).

68. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

69. The Applicant acknowledges said statement.

70. The Applicant disagrees with said statement in that the name "L'Oreal" and "Oreal" mean the same thing. That is, in the French language L'Oreal means "The Oreal" and "Oreal" remains "Oreal". As such, if one considers this fact then the name "Oreal" is more common (see Applicant "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" submitted herein).

71. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

72. The Applicant acknowledges said statement.

73. The Applicant acknowledges said statement.

74. The Applicant disagrees with said statement in that the name "Paris" is not only considered to be a geographical reference but a proper name and a surname as well. In this respect any mark containing the word "PARIS" would, in the Attorney's view, always be considered as geographically misdescriptive if not from that local. The Applicant believes this not to be the case.

Opposer's First Set of Interrogatories (1-13)

1. The Opposers' question is irrelevant and immaterial in that it does not deal with the subject matter at hand, namely, whether or not the Applicant's mark is

registrable. Superfluous questions regarding trademark origins or genesis are questions non-critical to the outcome of the present case and serve only to cloud the important issues which are truly relevant.

Applicant maintains that questions important to the outcome of this case can be summed up in the following five points. They are:

(a) the inherent distinctiveness of the trade-names and the extent to which they have become known;
(b) the length of time the trade-marks or trade-names have been in use;
(c) the nature of the wares, services or business;
(d) the nature of the trade; and
(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

These five questions, the Applicant believes, determine whether the Applicant's mark would be found confusing with the Opposers' marks. Questions unrelated to these fundamental principles are unwarranted and thus need not be answered.

2. The Opposers' question is irrelevant and immaterial in that it does not deal with the subject matter at hand, namely, whether or not the Applicant's mark is registrable. Superfluous questions regarding trademark origins or genesis are questions non-critical to the outcome of the present case and serve only to cloud the important issues which are truly relevant.

Applicant maintains that questions important to the outcome of this case can be summed up in the following five points. They are:

(a) the inherent distinctiveness of the trade-names and the extent to which they have become known;
(b) the length of time the trade-marks or trade-names have been in use;
(c) the nature of the wares, services or business;
(d) the nature of the trade; and

(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

These five questions, the Applicant believes, determine whether the Applicant's mark would be found confusing with the Opposers' marks. Questions unrelated to these fundamental principles are unwarranted and thus need not be answered.

3. The question is undefined in that the question asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. In regards to the U.S.A. -- the Applicant has not conducted, received nor seen any investigations, surveys, research, polls, focus groups, or opinions concerning confusion or the likelihood of confusion between the Applicant's mark and/or wares and those belonging to the Opposers.

4. The question is undefined in that the question asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. In regards to the U.S.A. -- the Applicant has not conducted, received nor seen any investigations, surveys, research, polls, focus groups, or opinions concerning the availability for use and/or registration of Applicant's mark or variations thereof.

5. The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

In todays business world the capacity to manufacture, distribute and sell does not always rest on a persons actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

Moreover, the Applicant wishes to inquire as to the definition of "bona fide intent" for many successful people have made fortunes in businesses begun from humble beginnings or were contrary to expert opinion. Microsoft, Dell, and Federal Express were all such companies yet against all odds not only prevailed but triumphed. In this same light the Applicant, for example, has successfully filed, prosecuted, and appealed his mark in the U.S.A., and is now currently engaged in these opposition proceedings without the obvious benefits and insight afforded by a seasoned trademark attorney. Thus, is this not a reasonable example of "bona fide intent." for if it is not the Applicant has truly squandered many years foolishly. The Applicant believes that he genuinely possesses "bona fide intent" and will employ this same zeal in his efforts to successfully commercialized his trademark and product once approved.

6. The Applicant's application for the mark "L'OREAL PARIS" was submitted to the USPTO for the United States of America. In this regards there has been no "date of first use" in the U.S.A.. Since the Applicant's mark regards an "intent to use mark" the Applicant believes he has met the letter of the law as the law does not require a "first use" before a trademark application can be made. Questions regarding countries other than the U.S.A. are not within the scope or mandate of these opposition proceedings and thus need not be answered.

7. The type of purchasers that the Applicant intends to market aloe vera drinks includes both male and female encompassing all age groups. The Applicant envisions the product to be a competitor to other beverages such as orange juice, apple juice, lemonade, coffee, tea and other such products.

8. The Applicant intends to market aloe vera drinks primarily to restaurants, clubs and bars and secondarily to grocery stores and other such outlets.

9. In regards to said question -- the Applicant does not know of any such company that markets wares similar to those of the Opposer and also sells aloe vera drinks. In the prosecution of this application even the Examiner could not find any such companies. However, even if such companies could be found it does not set a

precedent for the USPTO trademark roster currently lists many companies utilizing identical marks while selling similar wares without confusion.

10. The Applicant is the only person most familiar with the Applicant's mark, the person most familiar with the Applicant's aloe vera products, the person most familiar with the Applicant's actual or intended advertising, promotion, and marketing of aloe vera drinks in connections with the Applicant's mark, and the person most familiar with the Applicant's actual or intended channels of trade and class of consumers for aloe vera drinks.

However, the Applicant contends that such questions are all irrelevant. That is, the questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

11. The questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

12. The questions are not directed at finding out whether or not the Applicant's mark is confusing with those of the Opposers but rather is directing a gathering extraneous information from the Applicant. Moreover, the questions are also undefined in that the questions asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, they need not be answered.

Opposer's First Set of Document Requests (1-24)

1. No such documents exist.

2. No such U.S. documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

3. No such documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

4. No such documents exist, however, the Applicant is unaware of any current USPTO trademark rules and regulations or legal precedent defining what is and what is not "bona fide intent". As such, the Applicant will restate that he has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce.

   Second, the Applicant believes that in todays business world the capacity to manufacture, distribute and sell does not always rest on a persons actual physical facilities. Such things can be rented, joint ventured or procured via outsourcing. Moreover, licensing is also a practical means of business and just as viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will adjudicate and review prevailing market conditions and finally pursue one or more of options stated above as is his right. Thus, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

   Third, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

5. No such surveys, studies or reports exist.

6. No such documents exist.

7. No such documents exist.

8. No such documents exist.

9. No such documents exist.

10. No such documents exist.

11. No such documents exist. That is, the Applicant does not know of any such company that markets wares similar to those of the Opposers and also sells aloe vera drinks. In the prosecution of this application even the Examiner could not find any such companies. However, even if such companies could be found it does not set a precedent for the USPTO trademark roster currently lists many companies with identical names selling similar wares without confusion.

12. No such documents exist. Applicant is uncertain as to the date of awareness referred to but it predates the Applicant's filing for the mark "L'OREAL PARIS".

13. No such U.S. documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

14. No such U.S. documents exist. Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

15. No U.S. documents, other than the documents sent to the Applicant by the

Opposer regarding the rankings of trademark by Business Week Magazine.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

16. Notwithstanding communications to the Applicant from the Opposer, no such documents exist.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

17. No such documents exist regarding the U.S.A.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

18. This request is not directed at finding out whether or not the Applicant's U.S. trademark application is confusing with the marks of the Opposers but rather is directing a gathering extraneous information from the Applicant not related or relevant to this opposition.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

19. This request is not directed at finding out whether or not the Applicant's U.S. trademark application is confusing with the marks of the Opposers but rather is directing a gathering extraneous information from the Applicant not related or relevant to this opposition.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

20. This request is not directed at finding out whether or not the Applicant's U.S. trademark application is confusing with the marks of the Opposers but rather is directing a gathering extraneous information from the Applicant not related or relevant to this opposition.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

21. No such documents exist.

22. The Applicant will take this opportunity to supply the Opposers with the Applicant's "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" as it seems appropriate at this time to do so. This submission should, therefore, be considered the Applicant's serving of his "NOTICE OF RELIANCE (APPLICANT'S EVIDENCE)" to the Opposers' representative as would be customary in such opposition proceedings (more of less). This should provide the Opposers with the evidence with which the Applicant intends to rely on in these opposition proceedings. As is require by current trademark regulations the Applicant will also supply an original copy to the Trademark Trial and Appeal Board.

23. A copy of the file history of trademark Application Serial No. 76/596,736 is easily accessible to the Opposers and their Attorney by logging on to the governments website "www.uspto.gov" entering "trademarks", then entering "View Full Files (TDR)", and finally entering the application serial number above. The Applicant understands the Opposers' Attorney to be a trademark specialist and as such should know of this website and how to download the requested information accordingly. This website will, therefore, provide the Opposers' Attorney with the information he currently seeks without unnecessarily and needless burdening the

Applicant with the downloading, reproduction, and delivery of the information requested.

24. This request is not directed at finding out whether or not the Applicant's U.S. trademark application is confusing with the marks of the Opposers but rather is directing a gathering extraneous information from the Applicant not related or relevant to this opposition.

Second, the request is undefined in that the request asks for information extraterritorial to the U.S.A. and is thus not within the scope or mandate of these opposition proceedings. As such, non-U.S. references need not be provided.

EXHIBIT C

Atlanta
Beijing
Brussels
Chicago
Frankfurt
Hong Kong
London
Los Angeles
Milan
New York
Orange County
Palo Alto
Paris
San Diego
San Francisco
Shanghai
Tokyo
Washington, DC

(212) 318-6754
nataliefurman@paulhastings.com

January 7, 2009 29172.00141

VIA UPS

Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Re: L'Oréal S.A. and L'Oréal USA, Inc. v. Robert Victor Marcon (Opposition No. 91184456) – Applicant's Responses to Opposer's Discovery Requests

Dear Mr. Marcon:

As mentioned in our telephone conversation this morning, we have reviewed Applicant's Responses to Opposer's First Set of Requests for Admissions, First Set of Interrogatories, and First Set of Document Requests, and are writing, in accordance with 37 C.F.R. 2.120(e), in a good faith effort to resolve numerous deficiencies that we have identified in those responses.

We first address in a general manner a few issues that appear repeatedly in your responses but which are based on erroneous or unsupported objections or assertions of law. We then list and provide further specificity regarding the requests and responses that we believe to be deficient.

As agreed, we will telephone you on Friday, January 9, 2009 at 11:00 in the morning in order to address the deficiencies identified in this letter and your intent to supplement your responses, and so that the parties may discuss an appropriate timeframe or resolution. Please note that if you refuse to serve full and complete supplemental responses to the requests, Opposer reserves the right to take appropriate action before the Board, including but not limited to filing a motion to compel or, ultimately, to preclude evidence.

GENERAL DISCOVERY ISSUES

(1) Applicant must respond to requests with respect to Opposer's common law use of L'OREAL PARIS as well as its registered L'OREAL marks.

The term "Opposer's L'OREAL PARIS Mark" encompasses all of L'Oreal's rights in the mark L'OREAL PARIS, *whether at common law* or registered. (See Opposer's First Set of Requests for Admissions, Definitions and Instructions No. 5). To the extent that Applicant has responded to questions about Opposer's L'OREAL PARIS Mark by referring only to registered marks and failing or refusing to address common law use, Applicant's responses are deficient and require clarification and/or supplementation.

(2) Applicant's objections based on irrelevance or immateriality are unmerited, are unsupported by any authority, and are inconsistent with the broad scope of discovery permitted by the Trademark Trial and Appeal Board.

Applicant objects to several requests as irrelevant and immaterial because, in Applicant's view, the requests do not relate to the likelihood of confusion between the parties' marks. Applicant is incorrect as to the permissible scope of discovery and its obligation to respond.

First, the scope of discovery is very broad, generally permitting discovery of all non-privileged information that is relevant or likely to lead to admissible evidence relating to any claim or defense. Federal Rule of Civil Procedure 26(b)(1), which governs the scope of discovery in Opposition proceedings before the Trademark Trial and Appeal Board (the "TTAB" or the "Board"), specifically states that "[p]arties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter." Fed. R. Civ. P. 26(b)(1). *See also* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 402.01. The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, *beyond any doubt*, that the information sought can have *no possible bearing upon the issues* involved in the particular proceeding." *Varian Associates v. Fairfield-Noble Corporation*, 188 U.S.P.Q. 581, 583 (T.T.A.B. 1975) (emphasis added). The Board has specifically found that "[i]nformation concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TBMP §§ 414(4), 414(19).

Second, Opposer respectfully reminds Applicant that the Notice of Opposition states claims for both likelihood of confusion and dilution of a famous mark.[1] Discovery regarding factors relevant to both of those claims is therefore appropriate. In stating that certain information is irrelevant to the Opposition proceeding, Applicant misstates the factors relevant to the Board's likelihood of confusion analysis and ignores Opposer's dilution claim entirely. Most significantly, Applicant's intent in selecting the mark L'OREAL PARIS is an evidentiary factor relevant to Opposer's allegations of likelihood of confusion and of dilution. *See e.g., DC Comics v. Pan American Grain Mfg. Co., Inc.*, 77 U.S.P.Q.2d 1220 (T.T.A.B. 2005) (applicant's bad faith intent in selecting its mark is strong evidence of a likelihood of confusion); 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (hereinafter "McCarthy") §§ 23:108, 23:110 (4th ed. 2008) (evidence of applicant's intent to deceive or confuse consumers and/or to free-ride on opposer's reputation in selecting its mark is relevant to the likelihood of confusion analysis in an Opposition proceeding); McCarthy § 24:119 (applicant's intent to create an association with opposer's famous mark is relevant as an evidentiary factor for dilution claims); 15 U.S.C. § 1125(c)(2)(B)(v) (junior user's intent in selecting a famous mark is relevant to determining whether there is a likelihood of dilution)). Therefore, information about and documents pertaining to Applicant's selection of the mark L'OREAL PARIS, including any evidence of Applicant's pattern of selecting famous marks, is highly relevant to this Opposition proceeding. Applicant must respond to discovery requests seeking such information and documents.

Third, the requirement that Applicant have a bona fide intent to use the mark in commerce is a guard against misuse of the intent-to-use system by applicants who seek to register marks for improper purposes, such as to preclude others from using a mark, to weaken another party's trademark rights, to make a philosophical statement about the scope of trademark protection, or for any reason other than having an actual intent to use the mark in commerce. An applicant's complete lack of documentary evidence regarding its intent to use the mark, as well as evidence that an applicant has filed numerous other applications for disparate goods without the capacity or plans to produce any such goods, could be factors in establishing whether an applicant had a bona fide intent to use the applied-for mark in connection with the applied-for goods. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507-08 (T.T.A.B. 1993) (discussing the meaning of "bona fide intent to use" and holding that "[t]he fact that applicant ... admits that it does not have a single document regarding its intent to use [the mark at issue] is a factor to be considered in deciding the issue of whether applicant's intent is bona fide"); *Lane Ltd. v. Jackson International Trading Co.*, 33 U.S.P.Q.2d 1351, 1355-56 (T.T.A.B. 1994) (discussing the legislative history of the Trademark Law Revision Act of 1988 regarding the meaning of the term "bona fide intent to use" and citing specific examples of

[1] We note, as a clarifying point for your benefit, that although dilution forms a basis for Opposition in an inter partes proceeding, it is not a ground for ex parte refusal to register a mark by the Trademark Office, and the Trademark Office would therefore have had no occasion to consider the factors relevant to a dilution analysis. *See generally* McCarthy § 24:100.

circumstances that could cast doubt on or disprove an applicant's bona fide intent to use, including "an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce under the applied- for marks during the pendency of the applications").

The requests regarding Applicant's other marks are therefore relevant, and a response is required.

(3) Applicant's objections based on "extraterritoriality" are unsupported by any authority. As an applicant seeking a U.S. trademark registration, Applicant must provide the requested discovery.

Applicant objects to several requests and refuses to provide responses or documents to the extent that the requests may seek information or documents "extraterritorial" to the United States, but provides no authority for its position. As an applicant for a United States trademark registration, who is seeking the protection of United States trademark law, Applicant cannot rely on extraterritoriality as an objection to providing responses. U.S. discovery rules permit discovery outside the United States using traditional discovery tools, such as interrogatories and document requests, when a party is subject to the personal jurisdiction of the court or agency. *See generally Double J. of Broward, Inc. v. Skalony Sportwear GmbH*, 21 U.S.P.Q.2d 1609 (T.T.A.B. 1991) (discussing *Société Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522 (1987)); McCarthy § 20:114. Applicant must supplement his responses under the Federal Rules of Civil Procedure.

SPECIFIC REQUESTS FOR ADMISSIONS AND RESPONSES

As an initial matter, please confirm that Applicant's use of the term "acknowledges" (e.g., "Applicant acknowledges the Opposers' statement") is to be understood as an admission, and that the term "disagrees" (e.g., "Applicant disagrees with the Opposers' statement") is to be understood as a denial, under Fed. R. Civ. P. 36.

Request for Admission No. 2

Fed. R. Civ. P. 36(a)(4) provides that Applicant must admit so much of the request as is true ("when good faith requires that a party qualify an answer or deny only part of a matter, the answer must specify the part admitted and qualify or deny the rest"). The request asks Applicant to admit that "Opposer's rights in Opposer's L'OREAL Mark and in Opposer's L'OREAL PARIS Mark predate the filing by Applicant of the subject application for Applicant's Mark." As stated above, the term "Opposer's L'OREAL PARIS Mark" includes common law use of that mark. Applicant's comments regarding dissection of the marks and the parties' respective goods are irrelevant to the inquiry. Please supplement Applicant's response to respond to the question of whether Opposer's

rights – by registration or by common law – in L'OREAL and L'OREAL PARIS predate the filing of the application that is the subject of this Opposition proceeding. Please also clarify which portion of the response relates to which mark.

Request for Admission Nos. 4, 18, 19, 20, 22

Please clarify and/or supplement Applicant's response in light of the fact that the term "Opposer's L'OREAL PARIS Mark" includes the common law trademark.

Request for Admission Nos. 26-37, 39

Applicant's history and pattern of filing intent-to-use applications for marks that are identical to previously-registered famous or well-known marks is relevant (i) to Applicant's good or bad faith in selecting the L'OREAL PARIS mark at issue in this proceeding and (ii) to Applicant's bona fide intent to use that mark in commerce, and Applicant's possible misuse of the intent-to-use system. Far from being irrelevant and immaterial, the information sought is directly relevant both to the likelihood of confusion analysis and to the dilution analysis. Please respond to the requests.

Request for Admission No. 41

Please clarify and/or supplement Applicant's response in light of the fact that the term "Opposer's L'OREAL PARIS Mark" includes the common law trademark.

In addition, Applicant's response is unclear regarding whether "Applicant was aware that Applicant's Mark as used in connection with perfumes and fragrances; shaving balms, lotions, creams, and soaps; and sunscreens and tanning balms would create a likelihood of confusion with Opposer's L'OREAL Mark ... and specifically that it would create a likelihood of confusion with Opposer's L'OREAL mark that is the subject of Registration No. 540,541 for 'rouge, face cream, hair lotion, hand cream, eye shadow, face lotion, perfume, cologne, nail polish, suntan oil and face powder.'" Please clarify the response with respect to Opposer's L'OREAL Mark as distinct from Opposer's L'OREAL PARIS Mark.

Request for Admission No. 43

Please clarify and/or supplement Applicant's response in light of the fact that the term "Opposer's L'OREAL PARIS Mark" includes the common law trademark.

In addition, Applicant's reply is not responsive to the inquiry. Applicant's reference to the "nature of wares" is irrelevant, because the request relates to the filing of the application and the signing of the declaration, at which time the application included perfumes and fragrances, shaving balms, lotions, creams and soaps, and sunscreens and tanning balms

(as admitted by Applicant and supported by the record). Applicant's explanation regarding the Trademark Office's role in safeguarding existing trademarks is also irrelevant, because the inquiry relates to Applicant's knowledge and actions, not to those of the Trademark Office. Accordingly, please respond to Request for Admission No. 43, specifically whether Applicant signed the referenced declaration while (i) being aware of Opposer's existing registration for L'OREAL in connection with cosmetics, (ii) being aware of Opposer's common law use of L'OREAL and L'OREAL PARIS in connection with cosmetics, (iii) being aware of Opposer's registration for L'OREAL for goods that are identical or very closely related to goods identified in Applicant's application (i.e., perfume and cologne, face cream, face lotion, and hand cream and suntan oil).

Request for Admission No. 46

Pursuant to Fed. R. Civ. P. 36(a)(4), Applicant must admit so much of the request for admission as is true. Please clarify Applicant's response regarding whether Applicant lacks the capacity to manufacture or sell aloe vera drinks.

Request for Admission No. 47

Applicant's reply is not responsive to the inquiry. Specifically, the request does not address whether consumers associate Opposer's marks with aloe vera drinks, but whether consumers associate the L'OREAL PARIS name with Opposer's L'Oreal name, Opposer's L'OREAL Mark, and Opposer's L'OREAL PARIS Mark. Please respond accordingly.

Request for Admission No. 48

Please clarify and/or supplement Applicant's response in light of the fact that the term "Opposer's L'OREAL PARIS Mark" includes the common law trademark. In addition, Applicant's response is not responsive to the specific request, which addresses whether Applicant intends to trade on the goodwill and brand awareness developed by Opposer in its marks (regardless of the goods at issue). Please respond accordingly.

Request for Admission No. 50

Applicant's response that "beverages containing aloe vera are not uncommon" is not responsive to the inquiry. Please clarify that Applicant's statement that it does not have sufficient information to respond to "which is the dominant sector" is intended as a response to which sector is more commonly associated with aloe vera (i.e., that Applicant's use of "dominant" refers to the dominance of the association in the mind of the consumer, rather than to the market size).

Request for Admission No. 51

Applicant's response to this request is limited to Opposer's L'OREAL Marks. Please confirm that Applicant is denying any awareness that Opposer sold personal care products under other marks (including but not limited to the L'OREAL PARIS Mark).

Request for Admission No. 62

Please clarify and/or supplement Applicant's response in light of the fact that the term "Opposer's L'OREAL PARIS Mark" includes the common law trademark.

SPECIFIC INTERROGATORIES AND RESPONSES

Interrogatory Nos. 1-2

Applicant's characterization of these requests as "superfluous questions regarding trademark origins or genesis [that] are questions non-critical to the outcome of the present case and serve only to cloud the important issues which are truly relevant" is without merit, and Applicant's objections based on irrelevance and immateriality are improper. As explained above, information about a party's selection and adoption of its mark, information about a defendant's awareness of plaintiff's use of plaintiff's mark, and information about the identity and location of persons having knowledge of any discoverable matter are all clearly proper subjects for discovery. TBMP §§ 402.01, 414. Accordingly, please provide complete responses.

Interrogatory Nos. 3-4

As explained above, information about use of Applicant's Mark in the United States, or regarding confusion between the parties' marks, is discoverable regardless of whether the information was obtained or is maintained within or outside of the United States. Please clarify whether any such information exists and, if so, identify as requested.

Interrogatory No. 5

Please confirm that Applicant's filing of its trademark application is the only fact that supports and evidences Applicant's bona fide intent to use Applicant's Mark in commerce *as of the filing date* and continuing to date.

Interrogatory No. 9

Applicant's reply is not directly responsive to the question. Applicant states that it does not know of any company "that markets wares similar to those of Opposer and also sells aloe vera drinks." However, the interrogatory requests that Applicant state any third party of which it is aware that offers both personal care products and *herbal, mineral, or botanical products*. The inquiry is not limited to aloe vera drinks. Please respond to the interrogatory as asked.

Interrogatory Nos. 11-12

Applicant appears to be objecting to these interrogatories as irrelevant and as overly broad to the extent that they seek "information extraterritorial to the U.S.A." As stated above, however, the scope of discovery is broad and discovery is "generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding." That is clearly not the case with the requested information, which is relevant to Applicant's intent and ability to use Applicant's Mark, and potentially to other relevant information such as channels of trade, likely consumers, and good or bad faith in applying for the mark. Accordingly, please respond to the requests.

Interrogatory No. 13

Applicant failed to respond to Interrogatory No. 13. Please do so.

SPECIFIC DOCUMENT REQUESTS AND RESPONSES

Document Request Nos. 2-3

As mentioned above, documents located outside of the United States are discoverable under the Federal Rules of Civil Procedure. Please produce the requested documents, or confirm that none exist.

Document Request No. 4

As mentioned above, documents located outside of the United States are discoverable under the Federal Rules of Civil Procedure. Please produce the requested documents, or confirm that Applicant has no documentary evidence regarding its bona fide intent to use Applicant's Mark in commerce in the United States.

Document Request No. 11

Applicant's reply is not directly responsive to the request. Applicant states that no responsive documents exist because Applicant does not know of any company "that markets wares similar to those of Opposer and also sells aloe vera drinks." However, the document request seeks "[d]ocuments showing, referring or relating to all third parties of which Applicant is aware that advertise, promote, offer, or sell both cosmetics or personal care goods and *herbal, mineral, or botanical products*" (emphasis added). The inquiry is not limited to aloe vera drinks. Please respond to the request as asked.

Document Request Nos. 13-17

As mentioned above, documents located outside of the United States are discoverable under the Federal Rules of Civil Procedure. Please produce the requested documents, or confirm that none exist.

Document Request No. 18

To the extent that Applicant objects to this request as irrelevant, we note again that information about Applicant's pattern or history of applying for a mark previously-registered or widely used by another party is directly relevant to Applicant's good or bad faith adoption of the mark, which is a factor in both likelihood of confusion analysis and dilution analysis, and to Applicant's purported bona fide intent to use the mark in commerce. That objection therefore does not stand. In addition, to the extent that Applicant objects to this request based on extraterritoriality, we note that as mentioned above, documents located outside of the United States are discoverable under the Federal Rules of Civil Procedure. Please produce the requested documents, or confirm that none exist.

Document Request Nos. 19-20

Applicant appears to be objecting to these interrogatories as irrelevant and as overly broad to the extent that they seek "information extraterritorial to the U.S.A." As stated above, however, the scope of discovery is broad and discovery is "generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding." That is clearly not the case with the requested information, which is relevant to Applicant's intent and ability to use Applicant's Mark, and potentially to other relevant information such as channels of trade, likely consumers, and good or bad faith in applying for the mark. Accordingly, please produce the requested documents, or confirm that none exist.

Document Request No. 24

The information sought by this request may be relevant to or likely to lead to admissible evidence relating to the claims or defenses in this Opposition Proceeding, and, as such, is within the permissible scope of discovery. Please produce relevant non-privileged documents.

We recognize that it may take some time to prepare supplemental responses. In all events, as mentioned when we spoke earlier, we believe that a sixty day extension of the discovery period and subsequent trial dates makes sense, and we request your consent to such an extension. Absent your consent, we are prepared to move the Board to grant such an extension in the interest of ensuring an orderly proceeding. For our conversation on Friday, January 9, 2009, please be prepared to inform us of whether you consent to a sixty day extension, as well as of your willingness to address the deficiencies identified in this letter and your intent to supplement your responses. As mentioned, Opposer reserves the right to take appropriate action before the Board, including a motion to compel and/or preclude, if you refuse to supplement the discovery responses. However, we hope that will not be necessary and that the parties can resolve the discovery matters amicably and with minimal expense.

Very truly yours,

Natalie G. Furman
for PAUL, HASTINGS, JANOFSKY & WALKER LLP

cc: Robert L. Sherman, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)

Opposition No.:	**91184456**
TRADEMARK:	**L'OREAL PARIS**
Application Serial No.:	**76596736**
Applicant(s):	Robert Victor Marcon
Opposer(s):	L'Oreal USA, Inc. and L'Oreal S.A.
Opposer(s) Attorney:	Robert L. Sherman
Reply Number:	Communication - C
Number of Pages:	One hundred and thirty-six (136)

CERTIFICATE OF SERVICE

Certification: The undersigned hereby certifies that a true and complete copy of the foregoing correspondence has been served on the Opposers' representative "ROBERT L. SHERMAN" by mailing said copy via the U.S. Postal Service using FIRST CLASS CERTIFIED MAIL, postage prepaid, to "Robert L. Sherman, Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, New York, U.S.A., 10022".

Certified Mail Serial No.: **7006 2760 0002 7851 3877**

Date of Deposit: **7 February 2009**

Depositor's Signature: Robert Marcon **(Robert Marcon)**

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant:	Robert Victor Marcon	
Mailing Address:	Street:	3471 Sinnicks Avenue
	City/Province:	Niagara Falls, Ontario
	Country:	Canada
	Zip Code:	L2J 2G6
Other Communications:	Telephone:	(905) 354-2543

OPPOSERS' INFORMATION

First Opposer:	L'Oreal USA, Inc.
Mailing Address:	575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications:	Unknown

Second Opposer:	L'Oreal S.A.
Mailing Address:	L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications:	Unknown

Opposers' Attorney:	Robert L. Sherman,	
	Paul, Hastings, Janofsky & Walker LLP	
Mailing Address:	Street:	75 East 55th Street
	City/State:	New York, New York
	Country:	U.S.A.
	Zip Code:	10022
Other Communications:	Telephone:	(212) 318-6000
	e-mail:	rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - C
RESPONSE TO OPPOSERS' REQUESTS (SUPPLEMENTARY)

This is a response to the letter mailed January 7, 2009 by the Opposers' representative, namely, Natalie Furman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter consists of three (3) requests which include:

(1) General Discovery Issues;
(2) Specific Requests for Admissions and Responses;
(3) Specific Interrogatories and Responses; and
(4) Specific Document Requests and Responses.

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information and/or documents to the Opposers' representative as appropriate.

Note also, that the Applicant will respond to each request made by the Opposers' representative in the same sequence and order as was presented in her letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is herein included as reference).

Included also in this communication are the following four (4) items totalling one hundred and thirty-six (136) pages:

(1) Applicant's response to the Opposers' "Specific Requests for Admissions and Responses";

(2) Applicant's response to the Opposers' "Specific Interrogatories and Responses";

(3) Applicant's response to the Opposers' "Specific Document Requests and Responses";

(4) Corresponding documents to the above responses as appropriate; and

(5) A copy of the aforesaid Attorney letter mailed January 7, 2009.

Respectfully submitted,

Robert V. Marcon,
Applicant Pro Se
7 February 2009

Applicant's Supplementary Response To The Opposers' "Specific Requests for Admissions and Responses"

Initial Matter

The Applicant will confirm the Applicant's use of the term "acknowledges" is to be understood as an "ADMISSION", and that the term "disagrees" is to be understood as a "DENIAL" under Fed. R. Civ. P.36..

Request for Admission No.2

In regards to the Opposers' "L'OREAL" mark -- the Applicant acknowledges said statement. In regards to the Opposers' "L'OREAL PARIS" mark -- the Applicant disagrees with said statement as there are no registered marks or applications utilizing the words "L'OREAL PARIS" that predate the Applicant's filing. In regards to the Opposers' common law "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.4

Applicant acknowledges said statement. That is, the Applicant's mark is identical to the Opposers' claimed "L'OREAL PARIS" common law mark.

Request for Admission No.18

Applicant acknowledges said statement.

Request for Admission No.19

Applicant acknowledges said statement.

Request for Admission No.20

Applicant acknowledges said statement.

Request for Admission No.22

Applicant was aware of the dead "L'OREAL PARIS" marks belonging to the Opposer prior to applying for federal registration of the Applicant's mark. However, in regards to the Opposers' claimed common law marks bearing the words "L'OREAL

PARIS" the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.26

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks

belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.27

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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Request for Admission No.28

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks

do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.29

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including

whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers' and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.30

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon**

the issues involved in the particular proceeding." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.31

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating**

to any claim or defence".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers' and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

399 Request for Admission No.32

400 In the Opposers' current letter to the Applicant the Opposers have stated on Page
401 2 that "the scope of discovery is very broad, generally permitting discovery of all non-
402 privileged information **that is relevant or likely to lead to admissible evidence relating**
403 **to any claim or defence**".

404 Furthermore, the Opposers have remarked that "The Board has clearly stated that
405 "[i]t has been generally held that the requirement of relevance must be construed
406 liberally and that discovery should, therefore, be generously allowed **unless it is clear,**
407 **beyond any doubt, that the information sought can have no possible bearing upon**
408 **the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble
409 Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

410 The Opposers have also declared that the Board has specifically found
411 "[i]nformation concerning a party's selection and adoption of its **involved mark** is
412 generally discoverable (particularly of a defendant)" and that "information concerning a
413 defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including
414 whether defendant has actual knowledge thereof, and, if so, when and under what
415 circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

416 The Applicant therefore maintains that the Board's intentions are directed to
417 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
418 and not to other marks extraneous to that directive. Since the Applicant's other marks
419 do not consist, comprise nor utilize any portion or element of the Opposers' registered,
420 common law or proposed marks the Applicant's other marks are clearly extraneous to
421 these opposition proceedings and so will have no possible bearing upon the issues
422 involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond
423 any doubt" irrelevant and so the request need not be answered.

424 However, though the Applicant declines to respond to this request, the Applicant
425 will inform the Opposers that any records or documentation regarding the filing,
426 prosecution and/or appeal of the Applicant's other marks are readily available to the
427 Opposers' and their Attorney by logging on to the United States Patent and Trademark
428 Office at "www.uspto.gov" and selecting the trademarks section. All trademarks
429 belonging to the Applicant can easily be found by entering the Applicant's name therein.
430 Next, all files belonging to each mark sought can be viewed by searching "View Full
431 Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.33

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the

465 Opposers' and their Attorney by logging on to the United States Patent and Trademark
466 Office at "www.uspto.gov" and selecting the trademarks section. All trademarks
467 belonging to the Applicant can easily be found by entering the Applicant's name therein.
468 Next, all files belonging to each mark sought can be viewed by searching "View Full
469 Files (TDR)" and entering the serial number for the mark desired.
470 The Applicant presumes that the Opposers' Attorney is fully aware of the
471 information provided therein and how to access it. If the Opposers' Attorney so desires
472 he may, therefore, quickly reference these marks and download and print the information
473 needed without unduly and unnecessarily burdening the Applicant.
474
475 Request for Admission No.34
476 In the Opposers' current letter to the Applicant the Opposers have stated on Page
477 2 that "the scope of discovery is very broad, generally permitting discovery of all non-
478 privileged information **that is relevant or likely to lead to admissible evidence relating**
479 **to any claim or defence**".
480 Furthermore, the Opposers have remarked that "The Board has clearly stated that
481 "[i]t has been generally held that the requirement of relevance must be construed
482 liberally and that discovery should, therefore, be generously allowed **unless it is clear,**
483 **beyond any doubt, that the information sought can have no possible bearing upon**
484 **the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble
485 Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).
486 The Opposers have also declared that the Board has specifically found
487 "[i]nformation concerning a party's selection and adoption of its **involved mark** is
488 generally discoverable (particularly of a defendant)" and that "information concerning a
489 defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including
490 whether defendant has actual knowledge thereof, and, if so, when and under what
491 circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).
492 The Applicant therefore maintains that the Board's intentions are directed to
493 admissions, interrogatories, and documents regarding only the plaintiff's **involved mark**
494 and not to other marks extraneous to that directive. Since the Applicant's other marks
495 do not consist, comprise nor utilize any portion or element of the Opposers' registered,
496 common law or proposed marks the Applicant's other marks are clearly extraneous to
497 these opposition proceedings and so will have no possible bearing upon the issues

involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers' and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

Request for Admission No.35

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found "[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

<u>Request for Admission No.36</u>

In the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding**." Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found

"[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

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The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

<u>Request for Admission No.37</u>

The Applicant disagrees with said statement. That is, the Applicant has always had a bona fide intent to use said marks.

<u>Request for Admission No.39</u>

The Applicant disagrees with the Opposers. That is, the Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and not to make

a philosophical point about trademark protection.

Request for Admission No.41

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusing with the Applicant's mark. In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark. In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.43

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusion with the Applicant's mark. In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark. In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.46

The Applicant disagrees with said statement. That is, the Applicant does not lack the capacity to manufacture or sell aloe vera drinks.

Request for Admission No.47

The Applicant disagrees with said statement.

Request for Admission No.48

The Applicant disagrees with said statement.

Request for Admission No.50

The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.51

Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks. In regards to the Opposers' "L'OREAL PARIS" common law rights -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

Request for Admission No.62

Applicant acknowledges said statement.

Applicant's Supplementary Response To The Opposers' "Specific Interrogatories and Responses"

Interrogatory No.1

The Applicant selected the mark "L'OREAL PARIS" because it has bilingual qualities and was not registered, at the time of filing, for the wares the Applicant submitted. Second, the Applicant did not consider any other variation of the "L'OREAL PARIS" mark that he filed. Third, the Applicant was the person most knowledgeable in the selection of the mark and goods therein. Fourth, the date of selection was approximately one month before filing the application in Canada or around mid November 2003.

Interrogatory No.2

The Applicant is unaware of the exact time that he became aware of the "L'OREAL" (registered) and the "L'OREAL PARIS' (abandoned) marks but it does predate the filing of the Applicant's application.

In regards to the Opposers' "L'OREAL PARIS" common law rights -- the Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposers' statement.

The Applicant is also the person most knowledgeable with the foregoing.

Interrogatory No.3

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents.

Interrogatory No.4

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents.

Interrogatory No.5

The Applicant has always had a bona fide intent to use the mark "L'OREAL PARIS" in commerce and will begin to do so once his mark is approved. Although the Applicant has not formalized any business plans nor produced or sold any wares the Applicant contends that he is not required to do so until his mark has been approved. The Applicant has, however, searched the internet for manufactures of aloe vera drinks and has found various companies that offer such products. Though no printouts or documents were kept such companies include Aloe Farms Inc., Genereux Ltd., Psb Co Ltd, and Tobe Inc. The Applicant also believes that there are many other companies like these in the marketplace. Thus, the Applicant will, once his mark is approved, begin by first approaching these companies to outsource the manufacture of his aloe vera drinks. Once a supply source is secured the Applicant will then approach various nearby clubs, bars, and restaurants to test market sales and streamline logistics.

Moreover, and as previously stated, the capacity to manage, manufacture, distribute and sell in today's business world does not always rest on a persons actual personal abilities or physical facilities. Such things can be hired, joint ventured or procured via outsourcing. Licensing is also a practical means of business and just as

viable a means of business as creating such companies from scratch. Thus, upon allowance of the Applicant's mark the Applicant will begin as previously mentioned and then adjudicate and review prevailing market conditions and finally pursue one or more of the options expressed above as is his right. Ergo, by the Applicant's reasoning, the Applicant has shown bona fide intent as the business methods herein stated offer viable options regarding commercial implementation.

Interrogatory No.9

Basically, the only third parties to which the Applicant is aware are those mentioned in the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents.

Interrogatory No.11

There are none at this time.

Interrogatory No.12

There are none at this time.

Interrogatory No.13

There are none.

Applicant's Supplementary Response To The Opposers' "Specific Document Requests and Responses"

Document Request No.1

In regards to the prior answer given by the Applicant the Applicant will further

clarify said answer as follows: "The Applicant has provided all necessary documents in accordance with the answers so given by the Applicant."

Document Request No.2

No such documents exist.

Document Request No.3

No such documents exist.

Document Request No.4

The information previously stated is all that is. Hard copies do not exist.

Document Request No.11

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents. The Applicant therefore believes that he is not required to duplicate and provide said documents to the Opposers since the Opposers themselves are the originators of said documents and therefore have all of said documents already in their possession.

Document Request No.13

There are none except for the documents that the Opposers have themselves submitted to the Canadian Intellectual Property Office (Opposition Board) during current opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are therefore already in the Opposers' possession as they are the originators of said documents. The Applicant therefore believes that he is not required to duplicate and provide said documents to the Opposers since the Opposers themselves are the originators of said documents and therefore have all of said documents already in their possession.

762 Document Request No.14

763 There are none except for the documents that the Opposers have themselves
764 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
765 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
766 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
767 therefore already in the Opposers' possession as they are the originators of said
768 documents. The Applicant therefore believes that he is not required to duplicate and
769 provide said documents to the Opposers since the Opposers themselves are the
770 originators of said documents and therefore have all of said documents already in their
771 possession.
772
773 Document Request No.15

774 There are none except for the documents that the Opposers have themselves
775 submitted to the Canadian Intellectual Property Office (Opposition Board) during current
776 opposition proceedings regarding the "APPROVAL" of the Applicant's Canadian
777 application for the mark "L'OREAL PARIS" (Serial No. 1,201,383). These documents are
778 therefore already in the Opposers' possession as they are the originators of said
779 documents. The Applicant therefore believes that he is not required to duplicate and
780 provide said documents to the Opposers since the Opposers themselves are the
781 originators of said documents and therefore have all of said documents already in their
782 possession.
783
784 Document Request No.16

785 No such documents exist other than those relating to the Applicant's trademark
786 application in Canada (Serial No. 1,201,383) and the Applicant's corresponding
787 trademark application in the United States (Serial No. 76/596,736). The Canadian
788 documents regarding the filing and prosecution of the Applicant's mark are herein
789 enclosed. Documents regarding the Opposers' Canadian opposition to the Applicant's
790 mark are already in the Opposers' possession as they are the originators of said
791 documents. As for the documents regarding the Applicant's U.S. application these
792 documents are public property and are readily available and downloadable from the
793 United States Patent and Trademark Office (uspto.gov) respectively. This website will
794 allow the Opposers easy access to all of the desired documents as the case may be. The

Applicant presumes that the Opposers' Attorney is familiar with this procedure.

Document Request No.17

No such documents exist other than those relating to the Applicant's trademark application in Canada (Serial No. 1,201,383) and the Applicant's corresponding trademark application in the United States (Serial No. 76/596,736). The Canadian documents regarding the filing and prosecution of the Applicant's mark are herein enclosed. Documents regarding the Opposers' Canadian opposition to the Applicant's mark are already in the Opposers' possession as they are the originators of said documents. As for the documents regarding the Applicant's U.S. application these documents are public property and are readily available and downloadable from the United States Patent and Trademark Office (uspto.gov) respectively. This website will allow the Opposers easy access to all of the desired documents as the case may be. The Applicant presumes that the Opposers' Attorney is familiar with this procedure.

Document Request No.18

Documents relating to said names and marks are already in the possession of the Opposers as said documents form part of the Opposers' evidence submitted to the Canadian Intellectual Property Office (Opposition Board). In any event said other marks are readily available at both the Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office websites respectively as the Applicant has only ever applied for a trademark in Canada and the United States.

In addition, the Opposers' current letter to the Applicant the Opposers have stated on Page 2 that "the scope of discovery is very broad, generally permitting discovery of all non-privileged information **that is relevant or likely to lead to admissible evidence relating to any claim or defence**".

Furthermore, the Opposers have remarked that "The Board has clearly stated that "[i]t has been generally held that the requirement of relevance must be construed liberally and that discovery should, therefore, be generously allowed **unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.**" Varian Associates v. Fairfield-Noble Corporation, 188 U.S.P.Q. 581,583 (T,T.A.B. 1975)(emphasis added).

The Opposers have also declared that the Board has specifically found

"[i]nformation concerning a party's selection and adoption of its **involved mark** is generally discoverable (particularly of a defendant)" and that "information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's **involved mark**, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable." TTMP >> 414(4), 414(19).

The Applicant therefore maintains that the Board's intentions are directed to admissions, interrogatories, and documents regarding only the plaintiff's **involved mark** and not to other marks extraneous to that directive. Since the Applicant's other marks do not consist, comprise nor utilize any portion or element of the Opposers' registered, common law or proposed marks the Applicant's other marks are clearly extraneous to these opposition proceedings and so will have no possible bearing upon the issues involved or outcome thereof. Thus, the Applicant contends that said marks are "beyond any doubt" irrelevant and so the request need not be answered.

However, though the Applicant declines to respond to this request, the Applicant will inform the Opposers that any records or documentation regarding the filing, prosecution and/or appeal of the Applicant's other marks are readily available to the Opposers and their Attorney by logging on to the United States Patent and Trademark Office at "www.uspto.gov" and selecting the trademarks section. All trademarks belonging to the Applicant can easily be found by entering the Applicant's name therein. Next, all files belonging to each mark sought can be viewed by searching "View Full Files (TDR)" and entering the serial number for the mark desired.

The Applicant presumes that the Opposers' Attorney is fully aware of the information provided therein and how to access it. If the Opposers' Attorney so desires he may, therefore, quickly reference these marks and download and print the information needed without unduly and unnecessarily burdening the Applicant.

<u>Document Request No.19</u>

No such documents exist.

<u>Document Request No.20</u>

No such documents exist.

861 Document Request No.24

862 The Canadian documents regarding the filing and prosecution of the Applicant's
863 mark (Serial No. 1,201,383) are herein enclosed. The documents regarding the Opposers'
864 Canadian opposition to the Applicant's mark are already in the Opposers' possession as
865 they are the originators of said opposition. The Applicant therefore believes that he is
866 not required to duplicate and provide said documents to the Opposers since the
867 Opposers themselves are the originators of said documents and therefore already have
868 all of said documents in their possession.

EXHIBIT D

File Copy

Paul Hastings

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(212) 318-6754
nataliefurman@paulhastings.com

February 27, 2009

29172.00141

VIA UPS

Mr. Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Re: L'Oréal S.A. and L'Oréal USA, Inc. v. Robert Victor Marcon (Opposition No. 91184456) – Applicant's Responses to Opposer's Deficiency Letter and Supplemental Responses to Opposer's Discovery Requests

Dear Mr. Marcon:

We have received and reviewed your supplemental responses to L'Oréal's discovery requests. A number of the responses remain deficient. Accordingly, we are writing again, in accordance with 37 C.F.R. 2120(e), in a good faith effort to resolve the outstanding deficiencies. We hope to resolve those issues between the parties, but if you decline to respond and to supplement your responses adequately, we reserve the right to take appropriate action before the Trademark Trial and Appeal Board (the "Board"), including a motion to compel, a motion to test the sufficiency of admissions, and/or a motion to preclude.

Request for Admission No. 22

You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's

statement" with regard to Opposer's common law use of L'ORÉAL PARIS. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was aware or was not aware of Opposer's use of its L'ORÉAL PARIS Mark at the time that Applicant filed the application for L'ORÉAL PARIS, and accordingly must respond to the request for admission.

Request for Admission Nos. 26-36

Applicant has declined to respond to these requests, but the arguments are unavailing. The Board's rules and decisions do not support your assertion that the Board limits discovery to the involved mark, where information about other marks may be relevant to issues involved in the proceeding. *See, e.g., Varian Associates v. Fairfield-Nobel Corporation*, 188 U.S.P.Q. 581, 583 (T.T.A.B. 1975). First, as stated in our prior letter, Applicant's history and pattern of filing intent-to-use applications for marks that are identical to previously-registered famous or well-known marks is relevant to Applicant's good or bad faith in its selection and adoption of the involved mark; further, it is relevant to Applicant's bona fide intent to use the involved mark in commerce and its possible misuse of the intent-to-use system. It is directly relevant to both the likelihood of confusion analysis and the dilution analysis with regard to the involved mark, and is a proper subject for discovery. Second, Opposer has not made any discovery requests regarding Applicant's knowledge of Opposer's marks other than those involved in the proceeding; your comments regarding "plaintiff's involved marks" are inapt. Finally, Applicant's suggestion that responding to those requests for admissions would be unduly burdensome is without merit. Requests for Admissions Nos. 26-36 merely seek Applicant's admission or denial regarding factual information that is, by its nature, within Applicant's knowledge; responding to such requests imposes virtually *no* burden on Applicant. Applicant must respond to the requests. If Applicant maintains its objection, Applicant must explain why making an admission or denial of those requests would be unduly burdensome to Applicant.

Request for Admission No. 41

You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant was aware at the time that it filed its application that Applicant's Mark as used in connection with perfumes and fragrances, shaving balms, lotions, creams, and soaps, and sunscreens and tanning balms would create a likelihood of confusion with Opposer's common law use of L'ORÉAL PARIS. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was aware or was not aware of a likelihood of confusion between its application for L'ORÉAL PARIS on cosmetics products and Opposer's use of L'ORÉAL PARIS on cosmetics products, and accordingly must respond to the request for admission.

Request for Admission No. 43

You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant signed a declaration stating, in part, that no other entity has the right to use the mark in commerce, despite being aware of Opposer's common law use of L'OREAL PARIS in connection with cosmetics in general. That response remains deficient, because the request seeks information about a matter that is, by its nature, within

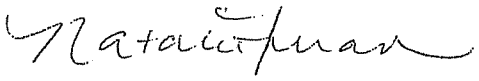
Applicant's knowledge. Applicant either did or did not sign the declaration despite being aware of Opposer's use of L'ORÉAL PARIS in connection with cosmetics in general, and accordingly must respond to the request for admission.

Request for Admission No. 51
You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant was aware, prior to applying for Applicant's Mark, that Opposer sells personal care products, including but not limited to skin creams and cosmetics under the L'ORÉAL PARIS Mark. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was or was not aware that Opposer sells personal care products including skin creams and cosmetics, and accordingly must respond to the request for admission.

Document Request Nos. 16-18
Although Opposer disagrees with Applicant's arguments and maintains that it is entitled to production of the documents requested, in a good faith effort to minimize the burden on Applicant, Opposer is willing to accept, in lieu of production of said documents, a written stipulation, in the form enclosed, that all documents printed from the USPTO Web site relating to trademark applications owned by Applicant are authentic, valid, and admissible, may made of record through a notice of reliance, and may be relied on as evidence. If you prefer to stipulate to such rather than producing the requested documents, please supplement your response to Document Request Nos. 16-18 by referring to the stipulation regarding the pertinent documents and return a signed copy of the enclosed stipulation to us along with your responses.

Please provide us with supplemental responses to the aforementioned requests by March 6, 2009. Please note that I will be traveling away from the office through March 22, 2009. Kindly address all correspondence to Robert L. Sherman, Esq. during that time. As mentioned, if you fail to respond or to provide sufficient responses, we will proceed to take appropriate action before the Board.

Very truly yours,



Natalie G. Furman
for PAUL, HASTINGS, JANOFSKY & WALKER LLP

Enclosure
cc: Robert L. Sherman, Esq.

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM USPTO WEB SITE

Pursuant to Trademark Trial and Appeal Board Manual of Procedure §§ 702, 704, and 705, Opposer and Applicant hereby stipulate that all documents printed from the USPTO Web site relating to trademark applications owned by Applicant are authentic, valid, and admissible, may made of record through a notice of reliance, and may be relied on as evidence.

Dated: March _____, 2009

ROBERT VICTOR MARCON

By: _____
Robert Victor Marcon

3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6 CANADA
905-354-2543

Applicant

PAUL, HASTINGS, JANOFSKY & WALKER LLP

By: _____
Robert L. Sherman
Natalie G. Furman

75 E. 55th Street
New York, New York 10022
212-318-6000

Attorneys for Opposer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)

Opposition No.:	**91184456**
TRADEMARK:	**L'OREAL PARIS**
Application Serial No.:	**76/596,736**
Applicant(s):	Robert Victor Marcon
Opposer(s):	L'Oreal USA, Inc. and L'Oreal S.A.
Opposer(s) Attorney:	Robert L. Sherman
Reply Number:	Communication - D
Number of Pages:	Fifteen (15)

CERTIFICATE OF SERVICE

Certification: The undersigned hereby certifies that a true and complete copy of the foregoing correspondence has been served on the Opposers' representative "ROBERT L. SHERMAN" by mailing said copy via the U.S. Postal Service using FIRST CLASS CERTIFIED MAIL, postage prepaid, to "Robert L. Sherman, Paul, Hastings, Janofsky & Walker LLP, 75 East 55th Street, New York, New York, U.S.A., 10022".

Certified Mail Serial No.: 7003 1680 0001 7602 8153

Date of Deposit: 9 March 2009

Depositor's Signature: Robert Marcon **(Robert Marcon)**

CASE PARTICULARS

APPLICANT INFORMATION

Name of Applicant:	Robert Victor Marcon	
Mailing Address:	Street:	3471 Sinnicks Avenue
	City/Province:	Niagara Falls, Ontario
	Country:	Canada
	Zip Code:	L2J 2G6
Other Communications:	Telephone:	(905) 354-2543

OPPOSERS' INFORMATION

First Opposer:	L'Oreal USA, Inc.
Mailing Address:	575 Fifth Ave., New York, NY, U.S.A., 10017
Other Communications:	Unknown
Second Opposer:	L'Oreal S.A.
Mailing Address:	L'Oreal S.A., 14 rue Royale, Paris, France, 75008
Other Communications:	Unknown

Opposers' Attorney:	Robert L. Sherman,	
	Paul, Hastings, Janofsky & Walker LLP	
Mailing Address:	Street:	75 East 55th Street
	City/State:	New York, New York
	Country:	U.S.A.
	Zip Code:	10022
Other Communications:	Telephone:	(212) 318-6000
	e-mail:	rls@paulhastings.com

IN THE MATTER OF an Opposition by
L'Oreal USA, Inc. and L'Oreal S.A.
to Application Serial No. 76/596,736 filed by
Robert Victor Marcon
for the trademark "L'OREAL PARIS"
(Opposition No. 91184456)

COMMUNICATION - D
RESPONSE TO OPPOSERS' REQUESTS (SUPPLEMENTARY)

This is a response to the letter mailed February 27, 2009 by the Opposers' representative, namely, Natalie Furman of Paul, Hastings, Janofsky & Walker LLP to the Applicant herein, namely, Robert Victor Marcon. Said letter regards the Applicant's Responses to Opposers' Deficiency Letter and Supplemental Responses to Opposer's Discovery Requests. The Opposers claim that a number of responses remain deficient and therefore request that said deficiencies be answered or supplemented accordingly.

Therefore, in accordance with current trademark protocols and procedures the Applicant will provide the requested information and/or documents to the Opposers' representative as appropriate.

Note also, that the Applicant will respond to each request made by the Opposers' representative in the same sequence and order as was presented in her letter thereby avoiding unnecessary paperwork and duplication (a copy of the Attorney's letter is herein included as reference).

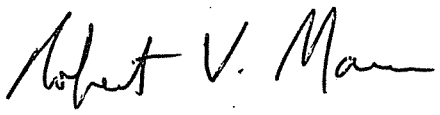
Included in this communication are the following three (3) items totalling one sixteen (16) pages:

(1) Applicant's supplementary response to the Opposers' "Specific Requests for Admissions and Responses";

(2) Applicant's supplementary response to the Opposers' "Specific Document Requests and Responses"; and

(3) A copy of the aforesaid Attorney letter mailed February 27, 2009.

Cordially,



Robert V. Marcon,
Applicant Pro Se
9 March 2009

Applicant's Supplementary Response To The Opposers' "Specific Requests for Admissions and Responses"

Request for Admission No.22

Applicant was aware of the dead "L'OREAL PARIS" marks belonging to the Opposer prior to applying for federal registration of the Applicant's mark. However, in regards to the Opposers' claimed common law marks bearing the words "L'OREAL PARIS" the Applicant was not aware of the Opposer's use of its "L'OREAL PARIS" mark.

Request for Admission No.26

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant admits to having filed for other U.S. trademark applications that are identical to previously registered marks.

Request for Admission No.27

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.28

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges Opposers' statement in regards to flavored milk and milk-based beverages, water, chocolates, candies, ice-cream bars and bottled water but not infant formula or dietary supplements.

Request for Admission No.29

Although the Applicant still maintains that the question is irrelevant and

immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.30

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.31

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.32

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges Opposers' statement in regards to natural mineral water only and not the others.

Request for Admission No.33

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission. As such, the Applicant acknowledges the Opposers' statement.

Request for Admission No.34

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission.

Applicant disagrees with the Opposers' statement. That is, the Applicant was aware of the prior registrations, both live and dead, of the referred to trademarks. However, as regards the extent of their fame and general public recognition the Applicant is without knowledge sufficient to form a belief as to or gauge the scope of said fame and general public recognition. Consequently, the Applicant cannot give a definitive admission in this regards.

Request for Admission No.35

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission.

Applicant disagrees with said statement.

Request for Admission No.36

Although the Applicant still maintains that the question is irrelevant and immaterial to these opposition proceedings the Applicant will answer the request for admission.

Applicant disagrees with said statement.

Request for Admission No.41

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusing with the Applicant's mark.

In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark.

In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark simply because the Applicant did not know then nor does he know now what "common law rights" are.

Request for Admission No.43

The Applicant disagrees with said statement. That is the Applicant did not believe that at the time of filing the Opposers' "L'OREAL" mark would be confusion with the Applicant's mark.

In regards to the Opposers' dead "L'OREAL PARIS" marks -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark.

In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark simply because the Applicant did not know then nor does he know now what "common law rights" are.

Request for Admission No.51

Applicant acknowledges the Opposers' statement as it regards the Opposers' "L'OREAL" marks.

In regards to the Opposers' common law rights in the "L'OREAL PARIS" mark -- the Applicant did not believe that at the time of filing there would be confusion with the Applicant's mark simply because the Applicant did not know then nor does he know now what "common law rights" are.

Applicant's Supplementary Response To The Opposers' "Specific Document Requests and Responses"

Document Request No.16

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return

one (1) copy to the Applicant for his files.

Document Request No.17

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return one (1) copy to the Applicant for his files.

Document Request No.18

The Applicant consents to the Opposers' proposal and so will sign the enclosed document entitled "STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM THE USPTO WEB SITE". This should therefore satisfy the Opposer document request.

Take note that the Applicant has signed three (3) copies. Please sign and return one (1) copy to the Applicant for his files.

Paul Hastings

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February 27, 2009 29172.00141

VIA UPS

Mr. Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Re: L'Oréal S.A. and L'Oréal USA, Inc. v. Robert Victor Marcon (Opposition No. 91184456) – Applicant's Responses to Opposer's Deficiency Letter and Supplemental Responses to Opposer's Discovery Requests

Dear Mr. Marcon:

We have received and reviewed your supplemental responses to L'Oréal's discovery requests. A number of the responses remain deficient. Accordingly, we are writing again, in accordance with 37 C.F.R. 2120(e), in a good faith effort to resolve the outstanding deficiencies. We hope to resolve those issues between the parties, but if you decline to respond and to supplement your responses adequately, we reserve the right to take appropriate action before the Trademark Trial and Appeal Board (the "Board"), including a motion to compel, a motion to test the sufficiency of admissions, and/or a motion to preclude.

Request for Admission No. 22
You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's

statement" with regard to Opposer's common law use of L'ORÉAL PARIS. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was aware or was not aware of Opposer's use of its L'ORÉAL PARIS Mark at the time that Applicant filed the application for L'ORÉAL PARIS, and accordingly must respond to the request for admission.

Request for Admission Nos. 26-36

Applicant has declined to respond to these requests, but the arguments are unavailing. The Board's rules and decisions do not support your assertion that the Board limits discovery to the involved mark, where information about other marks may be relevant to issues involved in the proceeding. *See, e.g., Varian Associates v. Fairfield-Nobel Corporation*, 188 U.S.P.Q. 581, 583 (T.T.A.B. 1975). First, as stated in our prior letter, Applicant's history and pattern of filing intent-to-use applications for marks that are identical to previously-registered famous or well-known marks is relevant to Applicant's good or bad faith in its selection and adoption of the involved mark; further, it is relevant to Applicant's bona fide intent to use the involved mark in commerce and its possible misuse of the intent-to-use system. It is directly relevant to both the likelihood of confusion analysis and the dilution analysis with regard to the involved mark, and is a proper subject for discovery. Second, Opposer has not made any discovery requests regarding Applicant's knowledge of Opposer's marks other than those involved in the proceeding; your comments regarding "plaintiff's involved marks" are inapt. Finally, Applicant's suggestion that responding to those requests for admissions would be unduly burdensome is without merit. Requests for Admissions Nos. 26-36 merely seek Applicant's admission or denial regarding factual information that is, by its nature, within Applicant's knowledge; responding to such requests imposes virtually *no* burden on Applicant. Applicant must respond to the requests. If Applicant maintains its objection, Applicant must explain why making an admission or denial of those requests would be unduly burdensome to Applicant.

Request for Admission No. 41

You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant was aware at the time that it filed its application that Applicant's Mark as used in connection with perfumes and fragrances, shaving balms, lotions, creams, and soaps, and sunscreens and tanning balms would create a likelihood of confusion with Opposer's common law use of L'ORÉAL PARIS. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was aware or was not aware of a likelihood of confusion between its application for L'ORÉAL PARIS on cosmetics products and Opposer's use of L'ORÉAL PARIS on cosmetics products, and accordingly must respond to the request for admission.

Request for Admission No. 43

You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant signed a declaration stating, in part, that no other entity has the right to use the mark in commerce, despite being aware of Opposer's common law use of L'OREAL PARIS in connection with cosmetics in general. That response remains deficient, because the request seeks information about a matter that is, by its nature, within

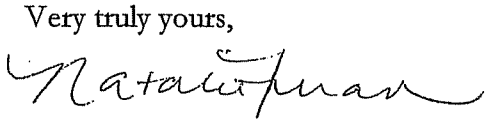
Applicant's knowledge. Applicant either did or did not sign the declaration despite being aware of Opposer's use of L'ORÉAL PARIS in connection with cosmetics in general, and accordingly must respond to the request for admission.

Request for Admission No. 51
You have responded that "Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement" with regard to whether Applicant was aware, prior to applying for Applicant's Mark, that Opposer sells personal care products, including but not limited to skin creams and cosmetics under the L'ORÉAL PARIS Mark. That response remains deficient, because the request seeks information about a matter that is, by its nature, within Applicant's knowledge. Applicant either was or was not aware that Opposer sells personal care products including skin creams and cosmetics, and accordingly must respond to the request for admission.

Document Request Nos. 16-18
Although Opposer disagrees with Applicant's arguments and maintains that it is entitled to production of the documents requested, in a good faith effort to minimize the burden on Applicant, Opposer is willing to accept, in lieu of production of said documents, a written stipulation, in the form enclosed, that all documents printed from the USPTO Web site relating to trademark applications owned by Applicant are authentic, valid, and admissible, may made of record through a notice of reliance, and may be relied on as evidence. If you prefer to stipulate to such rather than producing the requested documents, please supplement your response to Document Request Nos. 16-18 by referring to the stipulation regarding the pertinent documents and return a signed copy of the enclosed stipulation to us along with your responses.

Please provide us with supplemental responses to the aforementioned requests by March 6, 2009. Please note that I will be traveling away from the office through March 22, 2009. Kindly address all correspondence to Robert L. Sherman, Esq. during that time. As mentioned, if you fail to respond or to provide sufficient responses, we will proceed to take appropriate action before the Board.

Very truly yours,



Natalie G. Furman
for PAUL, HASTINGS, JANOFSKY & WALKER LLP

Enclosure
cc: Robert L. Sherman, Esq.

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

In the Matter of Application Serial No. 76/596,736
Published in the Official Gazette on May 6, 2008
Mark: L'OREAL PARIS

L'ORÉAL S.A. and L'ORÉAL USA, INC., Opposer, v. ROBERT VICTOR MARCON, Applicant.	Opposition No. 91184456

STIPULATION REGARDING AUTHENTICITY AND ADMISSIBILITY OF PAGES PRINTED FROM USPTO WEB SITE

Pursuant to Trademark Trial and Appeal Board Manual of Procedure §§ 702, 704, and 705, Opposer and Applicant hereby stipulate that all documents printed from the USPTO Web site relating to trademark applications owned by Applicant are authentic, valid, and admissible, may made of record through a notice of reliance, and may be relied on as evidence.

Dated: March 6, 2009

ROBERT VICTOR MARCON

By: Robert Victor Marcon
Robert Victor Marcon

3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6 CANADA
905-354-2543

Applicant

PAUL, HASTINGS, JANOFSKY & WALKER LLP

By: Robert L. Sherman
Robert L. Sherman
Natalie G. Furman

75 E. 55th Street
New York, New York 10022
212-318-6000

Attorneys for Opposer

EXHIBIT E

Paul Hastings

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(212) 318-6754
nataliefurman@paulhastings.com

June 26, 2009 29172.00141

VIA UPS

Robert Victor Marcon
3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6
CANADA

Re: L'Oréal v. Marcon – Opposition No. 91184456

Dear Mr. Marcon:

As agreed by telephone on June 24, 2009, we have prepared and enclosed a proposed Stipulation to Submit Testimony by Affidavit or Declaration. If you have any concerns with the Stipulation as drafted, please contact us immediately by telephone so that we may resolve any such concerns and, if necessary, prepare a new draft. Otherwise, please sign the Stipulation and return it to us by mail, so that we may countersign and file with the Trademark Trial and Appeal Board.

We have also enclosed a copy of L'Oréal S.A. and L'Oréal USA, Inc.'s Amended Pre-trial Disclosures regarding additional witnesses, as well as a countersigned copy of our earlier Stipulation Regarding Authenticity and Admissibility of Pages Printed From USPTO Web Site for your records.

Sincerely,

Natalie Furman

Natalie G. Furman
for PAUL, HASTINGS, JANOFSKY & WALKER LLP

Enclosures

cc: Robert L. Sherman, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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STIPULATION TO SUBMIT TESTIMONY BY AFFIDAVIT OR DECLARATION

Pursuant to Trademark Rule 2.123(b), 37 C.F.R. § 2.123(b), and Trademark Trial and Appeal Board Manual of Procedure § 703.01(b), L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") and Robert Victor Marcon ("Applicant") hereby stipulate and agree that the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit or declaration by such witness or witnesses during the appropriate testimony period. Nothing herein shall prevent a party from taking testimony by oral deposition of any witness for rebuttal, or from objecting to testimony on the grounds of competency, relevance, admissibility, materiality and/or any other grounds that would be available to it if testimony by oral deposition took place.

Dated: June 26, 2009

ROBERT VICTOR MARCON

By: _____
Robert Victor Marcon

3471 Sinnicks Avenue
Niagara Falls, Ontario
L2J 2G6 CANADA
905-354-2543

Applicant

PAUL, HASTINGS, JANOFSKY & WALKER LLP

By: _____
Robert L. Sherman
Natalie G. Furman

75 E. 55th Street
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212-318-6000

Attorneys for Opposer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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OPPOSER'S AMENDED PRETRIAL DISCLOSURE OF WITNESSES

Pursuant to Trademark Rule 2.121(e), 37 C.F.R. 2.121(e), and Rule 26(a)(3) of the Federal Rules of Civil Procedure, Opposer L'Oréal S.A. and L'Oréal USA, Inc. (collectively, "L'Oréal" or "Opposer") makes the following amendments to its pretrial disclosures of witnesses, without waiving or intending to waive, but on the contrary preserving and intending to preserve the right, at any time, to revise, correct, supplement, clarify and/or amend the disclosures set forth herein as additional information and/or witnesses become known or available.

The following individuals are expected to or may testify, either by oral testimony or by affidavit if the parties so stipulate in writing under Trademark Rule 2.123(b), 37 C.F.R. 2.123(b), in addition to or instead of the witnesses disclosed by Opposer in its May 26, 2009 pretrial disclosure of witnesses:

Roseanne Fama, Vice President, L'Oréal Paris, New Product Development. Expected testimony and exhibits regarding the extent and nature of use, and intended use, of the L'OREAL PARIS and L'OREAL marks; sales, advertising, and promotion of the L'OREAL PARIS and L'OREAL marks; consumer awareness of the L'OREAL PARIS and L'OREAL marks; fame of the L'OREAL PARIS and L'OREAL marks; and relatedness of L'Oréal's goods and the goods for which Applicant has applied to use its mark.

Sandrine Gadol, Vice President, L'Oréal Paris, Marketing – Strategic Development and Communications, L'Oreal Paris Skincare. Expected testimony and exhibits regarding the extent and nature of use, and intended use, of the L'OREAL PARIS and L'OREAL marks; sales, advertising, and promotion of the L'OREAL PARIS and L'OREAL marks; consumer awareness of the L'OREAL PARIS and L'OREAL marks; fame of the L'OREAL PARIS and L'OREAL marks; and relatedness of L'Oréal's goods and the goods for which Applicant has applied to use its mark.

Each of the aforementioned individuals is employed by L'Oréal with the following address and telephone number:

575 Fifth Avenue
New York, New York 10017-2450
212-984-4000

Dated: June 26, 2009

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY
& WALKER LLP

By: Robert L. Sherman

Robert L. Sherman
Natalie G. Furman
75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for L'Oréal U.S.A., Inc. and L'Oréal S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of Opposer's Pretrial Disclosure of Witnesses has been served upon Robert Victor Marcon, 3471 Sinnicks Avenue, Niagara Falls, Ontario, L2J 2G6, CANADA, by depositing a true copy of the same with UPS on June 26, 2009.

Natalie G. Furman

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

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Dated: March 6, 2009

ROBERT VICTOR MARCON
By: Robert Victor Marcon
Robert Victor Marcon

3471 Sinnicks Avenue
Niagara Falls, Ontario
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