

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
 2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
 3 **(TRANSMITTAL INFORMATION AND MAILING CERTIFICATION)**
 4

5 **Opposition No.:** 91184456
 6 **TRADEMARK:** L'OREAL PARIS
 7 **Application Serial No.:** 76/596,736
 8 Applicant(s): Robert Victor Marcon
 9 Opposer(s): L'Oreal USA, Inc. and L'Oreal S.A.
 10 Opposer(s) Attorney: Robert L. Sherman
 11 Reply Number: Communication - H
 12 Number of Pages: Fifteen (15)
 13
 14
 15

16 **CERTIFICATE OF MAILING (USPTO)**

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

20 **Certified Mail Serial No.:** 7008 1830 0002 1389 3803
 21 **Date of Deposit:** 8 February 2010

22 **Depositor's Signature:** Robert Marcon (Robert Marcon)
 23
 24
 25
 26

27 **CERTIFICATE OF SERVICE (OPPONENTS)**

28 I hereby certify that a true and complete copy of the foregoing correspondence has been served
 29 on the Opposers' representative "ROBERT L. SHERMAN" by mailing said copy via U.S. Postal
 30 Service CERTIFIED MAIL to "Robert L. Sherman, Paul, Hastings, Janofsky & Walker LLP, 75 East
 31 55th Street, New York, NY, U.S.A., 10022".

32 **Certified Mail Serial No.:** 7008 1830 0002 1389 3728
 33 **Date of Deposit:** 8 February 2010

34 **Depositor's Signature:** Robert Marcon (Robert Marcon)
 35



CASE PARTICULARS

36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51
52
53
54
55
56
57
58
59
60
61
62
63
64
65
66
67
68

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

69
70
71
72
73
74
75
76
77
78
79
80
81
82
83
84
85
86
87
88
89
90
91
92
93
94
95
96
97
98
99
100
101

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 - H
RESPONSE TO OPPOSERS' AMENDED NOTICE OF OPPOSITION

This is a response to the letter mailed on June 29, 2009 by Natalie G. Furman for 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 the Opposers' "Amended Notice of Opposition" which further includes 19 new allegations, namely, allegations 22-40.

The Applicant will therefore respond to these new allegations in the same order as they were presented in the Opposers' "Amended Notice of Opposition" (copy enclosed) and will begin with allegation No. 22.

Respectfully submitted,



Robert V. Marcon,
Applicant Pro Se
8 February 2010

102
103
104
105
106
107
108
109
110
111
112
113
114
115
116
117
118
119
120
121
122
123
124
125
126
127
128
129
130
131
132
133
134

AMENDED NOTICE OF OPPOSITION
Opposers' New Request For Admissions (22-40)

New Request for Admission No. 22

The Applicant admits said statement to be true.

New Request for Admission No. 23

The Applicant denies said allegation.

New Request for Admission No. 24

The Applicant denies said allegation.

New Request for Admission No. 25

The Applicant admits said statement to be true.

New Request for Admission No. 26

The Applicant admits said statement to be true.

New Request for Admission No. 27

The Applicant admits said statement to be true.

New Request for Admission No. 28

The Applicant admits said statement to be true.

New Request for Admission No. 29

The Applicant admits said statement to be true.

New Request for Admission No. 30

The Applicant admits said statement to be true.

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76/596,736; Comm-H

135 New Request for Admission No. 31

136 The Applicant admits said statement to be true.

137

138 New Request for Admission No. 32

139 The Applicant admits said statement to be true.

140

141 New Request for Admission No. 33

142 The Applicant admits said statement to be true.

143

144 New Request for Admission No. 34

145 The Applicant admits said statement to be true.

146

147 New Request for Admission No. 35

148 The Applicant admits said statement to be true.

149

150 New Request for Admission No. 36

151 The Applicant admits said statement to be true.

152

153 New Request for Admission No. 37

154 The Applicant admits said statement to be true except for beverages, particularly, bottled
155 water.

156

157 New Request for Admission No. 38

158 The Applicant denies said allegation.

159

160 New Request for Admission No. 39

161 The Applicant denies said allegation.

162

163 New Request for Admission No. 40

164 The Applicant denies said allegation.

165

166 This concludes the Applicant's responses to the new requests for admissions (numbers 22-
167 40) taken from the Opposers' Amended Notice of Opposition dated June 29, 2009.

168
169
170
171
172
173
174
175
176
177
178

Respectfully submitted,



Robert V. Marcon,
Applicant Pro Se
8 February 2010

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 COLLAGÈNE	Pending Application	77/461,637	Mascaras (Class 3)
L'OREAL EXTRA VOLUME COLLAGÈNE	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