

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.:** 76596736
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
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13 **CERTIFICATE OF MAILING**

14 **Certification:** This correspondence is being deposited with the U.S. Postal
15 Service as Certified First Class Mail in an envelope addressed
16 to, "U.S. Patent and Trademark Office, Trademark Trial and
17 Appeal Board, P.O. Box 1451, Alexandria, VA, U.S.A., 22313-
18 1451".

19 **Certified Mail Serial No.:** 7006 0810 0005 0399 0718

20 **Date of Deposit:** 8 July 2008

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22 **Depositor's Signature:** Robert Marcon (Robert Marcon)
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25 **Certification:** A copy of this correspondence is being deposited with the U.S.
26 Postal Service as Certified First Class Mail in an envelope
27 addressed to, "Robert L. Sherman, Paul, Hastings, Janofsky &
28 Walker LLP, 75 East 55th Street, New York, NY, U.S.A., 10022.

29 **Certified Mail Serial No.:** 7006 0810 0005 0399 0817

30 **Date of Deposit:** 8 July 2008

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



CASE PARTICULARS

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APPLICANT INFORMATION

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Other Communications: Telephone: (905) 354-2543

OPPOSER'S 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

Opposer's Attorney: Robert L. Sherman,
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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"

COMMUNICATION - A
STATEMENT OF RESPONSE

This is a response to the Office Letter mailed (June 5, 2008) by the Trademark Trial and Appeal Board to the Applicant herein, namely, Robert Victor Marcon. Said Office Letter consists of a "NOTICE OF OPPOSITION" to the allowance of the Applicant's trademark "L'OREAL PARIS" (Serial No. 76596736) that was initiated by L'Oreal USA, Inc., and L'Oreal S.A. (collectively, "L'Oreal" or "Opposer") and was executed by the Opposer's Attorney on June 4, 2008.

Therefore, in accordance with current trademark protocols and procedures the Applicant will argue for the allowance of his mark "L'OREAL PARIS" as the Applicant believes said mark is registrable. Note also, the Applicant will respond to the statements and allegations put forth by the Opposer's Attorney in said "Notice of Opposition" in a similar order as was presented therein.

The Applicant's response to said Opposition is as follows:

1. The Applicant acknowledges the statements made therein.
2. The Applicant acknowledges the statements made therein.
3. The Applicant is without knowledge or information sufficient to form a belief as to the validity of the Opposer's statement.

93 4. The Applicant acknowledges that the Opposer is the owner of the
94 registrations and other filings claimed in statement No.4. However, the
95 Applicant only acknowledges registrations 3109618, 0661746, and 0540541,
96 and the respective wares defined therein as having any possible legal
97 significance towards the Applicant's mark. All other federal registrations
98 claimed by the Opposer are subsequent to the filing of the Applicant's mark
99 thereby giving legal priority to the Applicant and not the Opposer.

100 As for the Opposer's allowed, published, and pending applications --
101 these to are subsequent to the Applicant's filing and as such, priority rights
102 superior to those of the Applicant cannot be claimed therein.

103 As regards the common law rights currently claimed by the Opposer
104 -- the Applicant is without knowledge or information sufficient to form a
105 belief as to the validity of said rights.

106
107 5. Though the Opposer may use all of its registered and allowed marks the
108 Applicant only acknowledges the Opposer's registered marks 3109618,
109 0661746, and 0540541 and the respective wares specifically defined therein
110 as having any possible legal significance towards the Applicant's mark. All
111 other registrations as well as all allowed, published, and pending
112 applications are subsequently to the filing made by the Applicant and thus
113 cannot claim any legal priority.

114
115 6. The Applicant is without knowledge or information sufficient to form a
116 belief as to the validity of any common law rights claimed by the Opposer
117 in the L'OREAL PARIS trademark and service mark.

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119 7. The Applicant only acknowledges the Opposer's claim to the exclusive use
120 and ownership of the registered marks 3109618, 0661746, and 0540541, and
121 the respective wares specifically defined therein. Consequently, the
122 Applicant's rights predate and are superior to those declared by the
123 Opposer notwithstanding, of course, the three registered marks named

124 above and any common law rights entitled the Opposer.

125

126 8. The Applicant acknowledges L'OREAL to be one of the world's largest
127 beauty products companies.

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129 9. The Applicant is without knowledge or information sufficient to form a
130 belief as to the validity of the Opposer's statement.

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132 10. The Applicant is without knowledge or information sufficient to form a
133 belief as to the validity of the Opposer's statement.

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135 11. The Applicant is without knowledge or information sufficient to form a
136 belief as to the validity of the Opposer's statement.

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138 12. The Applicant is without knowledge or information sufficient to form a
139 belief as to the validity of the Opposer's statement.

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141 13. The Applicant is without knowledge or information sufficient to form a
142 belief as to the validity of the Opposer's statement.

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145 belief as to the validity of the Opposer's statement.

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147 15. The Applicant is without knowledge or information sufficient to form a
148 belief as to the validity of the Opposer's statement.

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150 16. The Applicant is without knowledge or information sufficient to form a
151 belief as to the validity of the Opposer's statement.

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153 17. The Applicant is without knowledge or information sufficient to form a
154 belief as to the validity of the Opposer's statement.

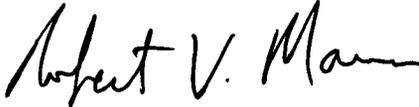
- 155 18. The Applicant is without knowledge or information sufficient to form a
156 belief as to the validity of the Opposer's statement.
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- 158 19. The Applicant is without knowledge or information sufficient to form a
159 belief as to the validity of the Opposer's statement.
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- 161 20. The Applicant acknowledges the statement made by the Opposer.
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- 163 21. The Applicant acknowledges the statement made by the Opposer.
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- 165 22. The Applicant disagrees with the Opposer in that the Applicant claims that
166 his mark, when applied to the Applicant's goods, does not cause confusion,
167 mistakenness or deception with any of the Opposer's marks or their
168 respective wares. As such, the Applicant's mark fully complies with all
169 aspects of Section 15 U.S.C. 1052(d).
170
- 171 23. The Applicant maintains that his mark is fully compliant with Section 15
172 U.S.C. 1125(c). As such, the Applicant disagrees with the Opposer in that
173 the Applicant claims that his mark, when applied to the Applicant's goods,
174 does not closely resemble the Opposer's previously registered L'OREAL
175 marks, previously used L'OREAL marks and trade name, and previously
176 used L'OREAL PARIS mark, so as to dilute or be likely to cause dilution of
177 the distinctive quality of the Opposer's L'OREAL marks and L'OREAL PARIS
178 mark.
179
- 180 24. The Applicant contends that the application "L'Oreal Paris", serial number
181 76/596,736 for "aloe vera drinks", conforms with all aspects of current
182 trademark law. As such, the Opposer's assertions that it would be
183 damaged by the registration of said mark are unfounded and unwarranted.
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- 185 25. The Applicant therefore submits that the Opposer's claims, as so far

Opposition No. 91184456; Mark: L'OREAL PARIS; Appl. No. 76596736; Comm-A

186 presented, are without legal foundation and as such, the Applicant
187 requests that the Opposer's current opposition be removed and the mark
188 L'OREAL PARIS, as detailed in application serial number 76/596,736 for
189 "aloe vera drinks" in class 32, be allowed.

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191 26. This response has been executed by the Applicant this 8th day of July 2008.
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193 Respectfully submitted,

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198 Robert V. Marcon,
199 Applicant Pro Se

200 8 July 2008