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

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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'ORÉAL PARIS

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

TRIAL BRIEF OF OPPOSER L'ORÉAL S.A. AND L'ORÉAL USA, INC.

REDACTED
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Summary of the Argument

L'ORÉAL S.A. and L'ORÉAL USA, INC. (together, "L'Oréal" or "Opposer") have been selling cosmetics, skin care, hair care, and hair color products around the world for 100 years and in the United States for more than 50 years under the L'ORÉAL and L'ORÉAL PARIS brand names. During that time, the L'ORÉAL Marks (defined below) have become among the most famous, widely-recognized and distinctive trademarks in the United States. Robert Victor Marcon ("Applicant") now seeks to capitalize on the fame and success of the L'ORÉAL Marks by filing an intent-to-use application for L'ORÉAL PARIS for aloe vera beverages. Registration should be refused because consumers are likely to be confused, the L'ORÉAL Marks are likely to be diluted, and because Applicant, who has a history and pattern of filing intent-to-use applications for famous marks owned by others, such as HEINEKEN, JACK DANIEL'S, CHANEL, BAYER, ABSOLUT, BUDWEISER and EVIAN, among others, lacks a bona fide intent to use the L'ORÉAL PARIS mark.

Procedural History

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." The examining attorney refused to register the proposed mark under Trademark Act § 2(a), 15 U.S.C. § 1052(a), on the ground that it falsely suggests a connection with Opposer. Applicant appealed on October 18, 2006. The Board reversed and remanded, stating that the Trademark Office had not met its burden of proving that L'ORÉAL was of sufficient fame that Applicant's proposed mark would be presumed connected to it. The Board noted, however, that the Trademark Office had "limited facilities for acquiring evidence" in reviewing prima facie cases, and "hasten[ed] to point out" that a "different and more complete record, such as might be adduced in an inter partes proceeding" may well cause the Board to arrive at a different result. *In re Marcon,* 2008 WL

906602, at *7-8 (T.T.A.B. Mar. 6, 2008). On May 6, 2008, Applicant's mark was published for opposition. On June 4, 2008, L'Oreal filed its notice of opposition.

The Record

The record consists of: the subject application, Serial No. 76/596,736; the pleadings, namely, Opposer's Notice of Opposition dated June 4, 2008, Applicant's Answer dated July 8, 2008, Opposer's Amended Notice of Opposition dated June 29, 2009, and Applicant's Answer to the Amended Notice of Opposition dated February 8, 2010; Opposer's Notice of Reliance dated June 9, 2010 and exhibits thereto, which includes the testimony declarations[1] of Opposer's witnesses Sanjay J. Devi, dated June 9, 2010 and exhibits thereto (the "Devi Decl."), Mark Brooks, dated June 8, 2010 and exhibits thereto (the "Brooks Decl."), Lisa J. Capparelli, dated June 9, 2010 and exhibits thereto (the "Capparelli Decl."), and Natalie G. Furman, dated June 9, 2010 and exhibits thereto (the "Furman Decl."). Opposer's Notice of Reliance also includes certified copies of Opposer's federal registrations and pending applications for the following eight (8) L'ORÉAL marks (collectively with all common law rights therein and with the L'ORÉAL PARIS mark, the "L'ORÉAL 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'ORÉAL ENDLESS	Registered	3,109,618	Lipstick (Class 3)

[1] The parties have stipulated to testimony by declaration.

L'ORÉAL 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'ORÉAL 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'ORÉAL 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'ORÉAL INFINIUM	Registered	3,453,735	Hair spray (Class 3)
L'ORÉAL OUR WORLD	Pending Application	77/354,359	Line of kid's shampoos and conditioners (Class 3)

The record also includes Applicant's Notice of Reliance dated August 6, 2010 and exhibits thereto.

The Issue

The sole issue in this opposition proceeding is whether Applicant is entitled to registration of the mark L'ORÉAL PARIS for the goods identified in application Serial No. 76/596,736, namely, "aloe vera drinks" in Class 32.

The Facts

Opposer L'Oréal is a leading cosmetics company in the United States and worldwide in terms of revenue, product volume and brand recognition. Capparelli Decl. at ¶ 4. The company and its brands, including most notably L'ORÉAL and L'ORÉAL PARIS, are among the most famous in the United States, indeed in the world. *Id.* Along with its registered L'ORÉAL marks, L'Oréal has common law rights in L'ORÉAL PARIS for a wide range of personal care products and

services. L'Oréal's line includes a full range of cosmetics, makeup, skin care, hair care and hair color products, and is available in all fifty states and throughout the world. Capparelli Decl. at ¶ 5.

L'Oréal has marketed, promoted and sold its products bearing the L'ORÉAL and L'ORÉAL PARIS marks in the United States for more than fifty years. *Id.* at ¶ 3. As early as 1980, L'Oréal USA (then known as Cosmair) generated U.S. sales in excess of two hundred million ($200,000,000) dollars. Devi Decl. at ¶ 4. That is the equivalent of more than five hundred million ($500,000,000) dollars in today's dollars. By 1984, that figure tripled to six hundred million ($600,000,000) dollars (*Id.*), the equivalent of approximately one and one-half billion ($1,500,000,000) dollars today.

Sales under the L'ORÉAL PARIS mark for the four years leading up to Applicant's June 2004 application (2000 through 2003) were approximately four billion ($4,000,000,000) dollars. Devi Decl. at ¶ 8. Those sales have continued to expand, as revenues from 2004 through 2009 were approximately seven billion ($7,000,000,000) dollars. *Id.* Annual sales for products sold under the L'ORÉAL PARIS mark are now approximately one billion two hundred million ($1,200,000,000) dollars. *Id.* at ¶ 9.

In 2004, the year Applicant filed the application at issue, the PREFERENCE, EXCELLENCE, FERIA, COULEUR, EXPERTE, VIVE Shampoos and Conditioners, STUDIO LINE, ENDLESS, and COLOUR RICHE product lines, all sold under the L'ORÉAL PARIS mark, were each among the top ten by market share in their respective product categories. *Id.* at ¶ 10. Those products alone generated more than six hundred million ($600,000,000) dollars in sales that year. *Id.*

L'Oréal supports the L'ORÉAL and L'ORÉAL PARIS brands with substantial advertising and promotion expenditures. *Id.* at ¶ 11. For the years 2000 through 2004, L'Oréal spent more than two hundred million ($200,000,000) dollars each year to advertise products under

the L'ORÉAL PARIS mark in the United States. Capparelli Decl. at ¶ 10. For example, in 2003, L'Oréal reported media expenditures for L'ORÉAL PARIS in the United States in excess of two hundred eighty-nine million ($289,000,000) dollars; in 2004, that figure exceeded three hundred million ($300,000,000) dollars. *Id.* For each of the past five years (2005 through 2009), L'Oréal has spent more than three hundred million ($300,000,000) dollars in reported media spending to advertise products under the L'ORÉAL PARIS mark in the United States. *Id.* at ¶ 11. The L'ORÉAL PARIS brand continues to grow in visibility with the consuming public.

L'Oréal USA's ad spend consistently ranks among the highest in the United States. Capparelli Decl. at ¶ 9. For the past decade (2000 through 2009), L'Oréal USA has been among the top thirty national advertisers, as ranked by the annual report of "100 Leading National Advertisers" in Advertising Age Magazine, one of the advertising and marketing industry's leading and most respected publications. The annual report prepares its rankings by monitoring U.S. media spending in newspapers, consumer magazines, cable and network television networks, radio, internet sites, as well as direct mail, promotions and special events. See Furman Decl., Exs. H-1 to H-10, for the methodology and ranking from Advertising Age's 100 Leading Advertisers for the years 2000 through 2009.

Advertising Age's 2001 rankings reported that L'Oréal's total advertising spending in 1999 and 2000 was nine hundred twenty-one ($921,000,000) million dollars and nine hundred eight-seven ($987,000,000) million dollars, respectively, making L'Oréal the 29th largest advertiser in the country. Furman Decl., Ex. H-1. That figure increased to one billion two hundred thirty-nine million ($1,239,000,000) dollars in 2003, ranking L'Oréal 22nd. Furman Decl., Ex. H-4.

L'Oréal television commercials run on such well-known programs as the Academy Awards, the Superbowl, the Golden Globes, and the Screen Actors Guild Awards, which have viewership in the tens of millions, and which L'Oréal also sponsors. Capparelli Decl. at ¶¶ 13-16.

L'ORÉAL and L'ORÉAL PARIS brand advertising features world-famous celebrity spokespersons, including Andie MacDowell, Diane Keaton, Beyoncé Knowles, Claudia Schiffer, Penelope Cruz, Heather Locklear, Scarlett Johansson, Evangeline Lily, Elizabeth Banks, Eva Longoria, Freida Pinto, Dayle Haddon, Doutszen Kroues, Kerry Washington, Milla Jovovich, Aishawarya Rai, Kate Del Castillo, Linda Evangelista and Kate Del Castillo. *Id.* at ¶ 17; Opposer's Not. Of Opp. at ¶ 16. They, quite naturally, bring much attention to the brand.

L'Oréal, under its L'ORÉAL PARIS brand, is also one of the largest corporate fundraisers for ovarian cancer research and awareness. For more than a decade, L'Oréal has helped raise millions of dollars through partnership with the Ovarian Cancer Research Fund and through fundraising initiatives, including the annual COLOR OF HOPE cosmetics and jewelry collections, and sponsorship of the prestigious L'Oréal Legends Gala, all conducted under its L'ORÉAL PARIS mark. Since 1997, L'Oréal has raised more than eighteen million ($18,000,000) dollars for ovarian cancer research under the L'ORÉAL PARIS mark. Capparelli Decl. at ¶ 20.

L'Oréal's commitment to enhancing women's lives extends to its partnership with UNESCO, begun in 1998, to create the "For Women In Science Program," which provides awards and recognition to promote women in the sciences. *Id.* at ¶ 22.

L'Oréal is a longtime sponsor of Glamour Magazine's "Women of the Year" awards. In 2004, L'Oréal also sponsored a national television broadcast of the awards, with entertainment provided by Grammy-winner Alicia Keys. The last airing of that awards show was at the end of 2006, and achieved coverage of eighty-eight (88%) percent of the total U.S. *Id.* at ¶ 21.

L'Oréal's enormous investment in its L'ORÉAL and L'ORÉAL PARIS marks, the products it sells and the causes it supports have generated great recognition and goodwill in those marks. Devi Decl. ¶ 15. As a result, L'ORÉAL and L'ORÉAL PARIS are among the best known brands in the United States, and worldwide. *Id.* at ¶ 13. Nationally, in Advertising Age's annual

report of "100 Leading National Advertisers," discussed above, L'Oréal ranks in the top 20, regardless of product category. Furman Decl., Exs. H1-H8. Worldwide, Interbrand Corporation and *BusinessWeek* Magazine consistently include L'Oréal in their annual report of the world's "100 Top Brands." See Furman Decl., Exs. G1-G8 for rankings and methodology. In 2002, L'Oréal was the fifty-fourth most valuable global brand across all business sectors. Furman Decl., Ex. G-1. In 2003, L'Oréal ranked forty-seventh. Furman Decl., Ex. G-2. Its global brand value was estimated at five billion six hundred million ($5,600,000,000) dollars in 2003. *Id.*

The quality of its products and its extensive brand exposure has brought L'Oréal vast amounts of unsolicited media coverage. Furman Decl., Ex. I. A search for "L'Oréal" and "L'Oréal Paris" in the LexisNexis U.S. news database for news articles from 1985 through 2009 produces hundreds of U.S. articles in nearly each of those years, in an array of local and national papers and magazines. *Id.* Articles dating back to at least 1985 appear in major papers including the New York Times, Los Angeles Times, Wall Street Journal, Chicago Tribune, and Washington Post, among many others. *Id.* Among the early articles is coverage of L'Oréal's marketing success and success in sales of innovative products such as its Freestyle Mousse introduced in 1983. Furman Decl., Ex. I, Part 11, p. 137, William Meyers, *Cosmair Makes a Name For Itself*, N.Y. Times, May 12, 1985.

For more than twenty years, L'Oréal has been recognized as both a product leader and a leader in developing a strong image among consumers. For example, an October 1999 article in Advertising Age Magazine titled, "Sharp Print, Sharp Colors Score for L'Oréal," noted that L'Oréal has "succeeded in building an upscale brand image among mass brands," and that, "with the consolidation of its haircare, cosmetics, and fragrance units in 1997, became the largest spender in the beauty category." Furman Decl., Ex. I-2, at 39-40. Another Advertising Age article titled, "Unilever Stamps Corporate Name on All Packages," dated March 1, 2004, quotes Andrew Jergens Company's Vice President of Marketing and Sales, who referred to the display of corporate brands

on product packaging for sub-brands as "the L'Oréal effect," and credited L'Oréal's success with influencing the global marketing trend. Furman Decl., Ex. I-2, pp. 29-30.

L'Oréal has commissioned a Corporate Image Study every year from 2001 through 2007. Brooks Decl. at ¶ 6. The 2003 and 2004 Corporate Image Studies involved face-to-face computer assisted personal interviews over a three to four week period with a nationally representative sample of more than one thousand (1,000) women ages fifteen (15) or older. That methodology changed somewhat for the 2007 Corporate Image Study, for which data were collected using an online survey among a nationally representative sample of women between sixteen (16) and sixty-four (64) years of age, with more than two thousand (2,000) interviews.

In the April 2003 Corporate Image Study prepared for the L'ORÉAL PARIS brand, among the key findings were that consumers are very familiar with L'Oréal, with the L'ORÉAL brand for makeup known by more than two-thirds (——) of respondents, with products sold under that brand used by —————— of them. Brooks Decl., Ex. M-1, at 15. In addition, a majority of respondents agreed that L'ORÉAL "——." *Id.* at 67.

In the May 2004 Corporate Image Study prepared for the L'ORÉAL PARIS brand, respondents gave L'ORÉAL the third best score in brand evaluation (Brooks Decl., Ex. M-2, at 9, 12); that L'ORÉAL enjoys high levels of both unaided awareness (—— of respondents) and aided awareness (—— of respondents) (*Id.* at 12); several product lines sold under the L'ORÉAL PARIS mark were "——————————————————," with many of the L'ORÉAL PARIS products having consumer awareness of greater than ——————percent (*Id.* at 14); that approximately one-fourth of respondents "strongly agree" that L'ORÉAL "——

[redacted]." (*Id.* at 86).

In the August 2007 Corporate Image Study prepared for the L'ORÉAL PARIS brand, total awareness of the L'ORÉAL brand is [redacted] percent among women between sixteen (16) and sixty-four (64) years of age. Brooks Decl. at ¶ 9. More than half of women [redacted] surveyed stated that L'ORÉAL is their preferred brand. Brooks Decl., Ex. M-3, at 38.

Numerous L'ORÉAL PARIS products have won awards or commendations from popular press including magazines such as Allure, Cosmopolitan, Elle, Essence, Family Circle, Fitness, Glamour, Good Housekeeping, Health, InStyle, Ladies Home Journal, Latina, Life & Style, Marie Claire, Real Simple, Redbook, Self, Seventeen, Shape, Teen Vogue, and Women's Health. Capparelli Decl. at ¶ 19. 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 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. Brooks Decl. at ¶ 8. See Ex. N-2 of the Capparelli Decl. for a summary of awards won by L'ORÉAL PARIS products in the years 2005 through 2010.

L'Oréal is so well recognized as an important cosmetics company that the Chain Drug Review ran a special series of articles about L'Oréal in honor of its 100-year anniversary. Articles in that issue refer to L'Oréal as the world's largest stand-alone beauty supplier and state that L'Oréal captures more than fifteen percent (15%) of the global cosmetics market. *See* "L'Oreal 100:

A Century of Inspiration and Creation," Chain Drug Review, June 29, 2009, attached to the Furman Decl. as part of Ex. I.

Products sold under the L'ORÉAL and L'ORÉAL PARIS marks are available, and have been from a time long prior to Applicant's filing date, at drug stores, supermarkets, and mass merchandisers throughout the United States, including leading national retailers such as Wal-Mart, Target, Rite-Aid, Duane Reade, Walgreen's, CVS, Kmart, and Kroger, as well as online at Internet sites such as www.drugstore.com. Capparelli Decl. at ¶ 7.

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." Applicant's mark L'ORÉAL PARIS is identical to Opposer's L'ORÉAL PARIS mark and virtually identical to Opposer's previously registered L'ORÉAL marks. Aloe vera is a common ingredient in cosmetics, and L'Oréal uses aloe vera and other botanicals in a number of its products. Capparelli Decl. at ¶¶ 32, 34. L'Oréal markets some products with names and/or packaging that appear similar to beverage names and/or packaging. *Id.* at ¶ 33. Use of the L'ORÉAL PARIS mark on Applicant's goods is likely to cause confusion or mistake or to deceive consumers into believing that Applicant's goods emanate from the same source as the hundreds of products extensively sold and marketed under Opposer's L'ORÉAL PARIS mark. As such, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

For any consumers who are not likely to be confused, the use of L'ORÉAL PARIS by Applicant would dilute and diminish the extraordinary goodwill that L'Oréal has developed through its investment of billions of dollars and decades of effort. Applicant's mark is therefore not entitled to registration pursuant to 15 U.S.C. § 1125(c). Finally, Applicant has failed to demonstrate a bona fide intent to use the applied-for mark in commerce, a statutory requirement for an intent-to-use applicant. Registration of Applicant's mark should be refused.

Argument

A. Applicant's Registration of the L'OREAL PARIS Mark is Likely to Cause Confusion

Pursuant to Section 2(d) of the Lanham Act, an applicant will be denied registration of a mark if the mark "so resembles" a mark previously registered or used in the United States "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In determining whether a mark is registrable, the Board determines whether there is a likelihood of confusion "by focusing on the question whether the purchasing public would mistakenly assume that the applicant's goods originate from the same source as, or are associated with, the goods in the [prior] registration." *In re Majestic Distilling Co.*, 315 F.3d 1311, 1314-15 (Fed. Cir. 2003).

Likelihood of confusion is "determined on a case-by-case basis, aided by application of the several factors set out in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)." *Lloyd's Food Prods. Inc. v. Eli's, Inc.*, 987 F.2d 766 767 (Fed. Cir. 1993). Not all of the *DuPont* factors necessarily apply or are given equal weight to every situation, and any one of the factors may control a given case. *In re Majestic Distilling*, 315 F.3d at 1315 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07 (Fed. Cir. 1997); *In re E. I. DuPont*, 476 F.2d at 1361-62 ("The evidentiary elements are not listed . . . in order of merit. Each may from case to case play a dominant role."). Likelihood of confusion "is determined from the probative facts in evidence." *Specialty Brands v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 671 (Fed. Cir. 1984).

The relevant *DuPont* factors, which demonstrate that consumers are likely to be confused by registration and use of Applicant's mark for "aloe vera drinks," are addressed in turn below.

1. The L'ORÉAL Marks Are Strong and Famous

In cases such as this one, "[w]hen an opposer's trademark is a strong, famous mark, it can never be of 'little consequence.' The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name." *Specialty Brands*, 748 F.2d at 675. *See also Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986) ("[R]egistered trademarks are presumed to be distinctive and should be afforded the utmost protection.").

In determining the strength of a mark, the Board is required to consider both its inherent strength based on the nature of the mark, and its market strength. *Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1898-99 (T.T.A.B. 2006) (sustaining opposition in large part because of fame of opposer's mark). "A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim . . . that the mark is inherently distinctive for the goods." *Id.* at 1899.

The L'ORÉAL Marks are among the strongest in the world, and in the U.S. Those that are registered on the Principal Register, in accordance with Sections 7 and 33 of the Lanham Act, enjoy a presumption of distinctiveness. *Lois Sportswear*, 799 F.2d at 871. Seven of the eight registrations that are among the marks on which L'Oréal relies are incontestable.[2] Those incontestable registrations constitute conclusive evidence of the validity of the marks and of Opposer's ownership and exclusive right to use the L'ORÉAL Marks for the goods identified in the respective registrations. *See* 15 U.S.C. § 1115(b). Applicant did not submit any evidence rebutting the presumption of validity and distinctiveness with respect to the eighth registration.

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[2] *See* U.S. Registration Nos. 661,746; 540, 541; 3,109,618, 3,115,751; 3,081,932; 3,281,234; and 3,453,735 annexed as Exs. E1-E7 to Opposer's Notice of Reliance.

One of the ways in which the strength of a mark is evaluated is by the extent to which it has acquired distinctiveness, "*i.e.* fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition." *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003). As noted above, for more than fifty years, L'Oréal has marketed, promoted, and sold its products bearing the L'ORÉAL and L'ORÉAL PARIS marks in the U.S.. *See supra*, at 4. Opposer spent more than two hundred million ($200,000,000) dollars annually for the years 2000 through 2004 to advertise products sold under the L'ORÉAL PARIS mark in the United States. That figure for each of the past five years (2005-2009) grew to more than three hundred million ($300,000,000) dollars. *See supra*, at 4-5. Sales of L'ORÉAL PARIS products for the four years leading up to Applicant's application were approximately four billion ($4,000,000,000) dollars. *See supra*, at 4. L'Oréal also receives vast unsolicited media coverage, another indicator of fame, from fashion and style magazines, advertising industry publications, and retail industry publications for the quality of its products, the scale of its marketing undertakings, and its status as a leader in the cosmetics industry. *See supra*, at 7, 9. Opposer's decades of exclusive and continuous use and extensive promotion has resulted in the L'ORÉAL Marks' becoming famous, and among the very strongest marks in the United States, and in the world. *See supra*, at 4-10. *See also In re Majestic Distilling*, 315 F.3d at 1317 (citing cases where decades of use evidenced the strength of the marks at issue).

In view of the length of time that Opposer's L'ORÉAL Marks have been in the market, coupled with the success of the products sold under those marks, any question regarding the strength of the L'ORÉAL Marks must be decided in Opposer's favor. As the Federal Circuit has made clear:

> The law has clearly been well settled . . . that the field from which trademarks can be selected is unlimited, and there is therefore no excuse for even approaching the well-known trademark of a

> competitor, that to do so raises "but one inference – that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark," and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Specialty Brands, 748 F.2d at 676) (quoting *Plainters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924-25 (C.C.P.A. 1962).

Applicant appears to argue that "L'Oréal" and "Paris" are common surnames.[3] Applicant's Notice of Reliance includes short lists of United States residents with a surname of "Loreal," "Oreal," or "Paris." *See* Applicant's Not. of Rel., Exhs. 5-8. Applicant's argument is unpersuasive. The Lanham Act excepts from trademark protection marks that are "*primarily* merely a surname" (emphasis added). 15 U.S.C. 1052(e)(4). Applicant fails to demonstrate that "L'Oréal" is primarily merely a surname. The number of "L'Oréal" and "Oréal" surnames in the United States is extremely modest. They are used in that manner with far less frequency than, for example, Buick and DuPont, the very marks cited in the legislative history of the Lanham Act as examples of famous marks.[4] Clearly, neither BUICK nor DUPONT nor the L'ORÉAL Marks are primarily merely surnames. Moreover, Applicant fails to demonstrate that the mark "L'Oréal Paris" is a surname. It is improper to dissect a mark and to separately analyze the individual words that it may incorporate. *See, e.g., In re Hutchinson Tech., Inc.*, 852 F.2d 552, 554-55 (Fed. Cir. 1988) ("[T]he Board improperly dissected the [HUTCHINSON TECHNOLOGY] mark and did not consider what impression the mark in its entirety would have on the purchasing public). Applicant undertakes the same improper dissection when arguing that L'ORÉAL PARIS is primarily geographically

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3 *See* Applicant's Not. of Rel., Exs. 1-9.

4 *See* Opposer's Not. of Rel., Exs. L1-L4.

descriptive pursuant to 15 U.S.C. 1052(e)(2).[5] *Id.* We trust it will not escape the Board's attention that if Applicant's arguments were valid, he would not be entitled to a registration.

Applicant has failed to submit evidence showing that Opposer's L'ORÉAL Marks are anything less than exceedingly strong, indeed famous. Such failure requires the Board to accord Opposer broad and encompassing protection. *See Tea Bd. of India*, 80 U.S.P.Q.2d at 1900. Opposer has developed substantial consumer recognition and valuable goodwill in its L'ORÉAL Marks. *See supra*, at 4-10. The L'ORÉAL Marks are among the most famous and most popular in the United States, and throughout the world. *Id.* They are strong and famous by any standard.

2. The Parties' Marks are Identical in Appearance, Sound, Connotation and Commercial Impression

In a likelihood of confusion analysis, "two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods." *Yves Saint Laurent Fashion B.V. v. Goldfinger Hawaii, Inc.*, Opposition No. 91118017, 2007 WL 1520947, at *8 (T.T.A.B. May 15, 2007) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24 (C.C.P.A. 1976)). The marks need not be identical to be in conflict, but the more similar the marks, the more likely it is that confusion will result. *See, e.g., Frehling Enters. Inc. v. Int'l Select Group, Inc.*, 192 F.3d 1330, 1336 (11th Cir. 1999) (ruling the marks BELL'S OGETTI and OGETTI were "strikingly similar in sight, sound and meaning").

Here, Applicant's mark is absolutely identical to Opposer's L'ORÉAL PARIS mark nearly identical to its L'ORÉAL mark. Compared to Opposer's L'ORÉAL mark, Applicant's mark is "strikingly similar in sight, sound and meaning," much like the court in *Frehling Enters. Inc.* found the marks BELL'S OGETTI and OGETTI to be strikingly similar. *Id.* Applicant also admits that

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[5] *See* Applicant's Not. of Rel., Ex. 10.

the first term in Applicant's mark is identical to Opposer's L'ORÉAL mark.[6] Applicant's mark is likely to be perceived as identifying a new line or product sold under Opposer's L'ORÉAL and L'ORÉAL PARIS marks. Consumers are accustomed to encountering new products sold by an established company where the identical mark is used on a new product line, while maintaining consumer recognition of the brand. To grant registration to Applicant's mark would permit Applicant to ride on the coattails of more than fifty years of goodwill, effort and investment by L'Oréal, and likely would cause confusion among consumers. "[W]hen balancing the interests in a famous, established mark against the interests of a newcomer, [the Board is] compelled to resolve doubts on this point against the newcomer." *Specialty Brands*, 748 F.2d at 674.

3. Relatedness of the Parties' Goods

The similarity between an applicant's goods and the goods sold under a prior mark is a key factor in finding likelihood of confusion. *In re E. I. DuPont*, 476 F.2d at 1361. "It is not necessary that Opposer's and Applicant's goods be identical or even competitive to support a finding of likelihood of confusion." *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1635 (T.T.A.B. Apr. 22, 2009) (citing *In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812, 1815 (T.T.A.B. 2001) and *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1387 (T.T.A.B. 1991)). Rather, it is "sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief as to a common source or affiliation." *Id.*

Moreover, the greater the degree of similarity between an applicant's mark and an opposer's registered mark, the less the degree of similarity required between the applicant's and opposer's goods to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 U.S.P.Q.2d

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[6] *See* Opposer's First Set of Requests for Admissions, Request No. 5, annexed as Ex. D-1 to Opposer's Not. of Rel., and Applicant's "Response to Opposers' Request," Response No. 5, annexed as Ex. D-2 to Opposer's Not. of Rel.

at 1815; *In re Concordia Int'l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983). Where, as here, Applicant's mark is identical to Opposer's L'ORÉAL PARIS mark, and essentially identical to Opposer's L'ORÉAL mark, there need only be a viable relationship between the goods to find that there is a likelihood of confusion. *See In re Thor Tech, Inc.*, 90 U.S.P.Q.2d at 1636 (citing *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993)) ("[E]ven when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source."). *A fortiori*, Opposer's and Applicant's marks are not only identical, but also Opposer's marks are famous by any standard.

Here, there is more than a "viable relationship" between Applicant's "aloe vera drinks" and Opposer's goods sold under the L'ORÉAL and L'ORÉAL PARIS marks, which consist of cosmetics including makeup, skin care, hair care, and hair color, among others. In view of the common practice of marketing and selling cosmetics and beverages for health and beauty enhancement, and given the fame of the L'ORÉAL brand and marks, consumers cannot help but believe that Applicant's goods emanate from L'Oréal.[7] For example, Evian S.A., a French beverage company, owns trademarks in the United States that cover skin and hair care products, makeup, as well as food and beverage products derived from fruits, vegetables, vitamins, and minerals under the same mark.[8] Other companies that market beverages as skin care products, or sell beverages and cosmetics under the same mark, include Pepsi (under its Aquarian, Pepsi, and Mountain Dew marks), Snapple, Hershey's, SkinCola, and Borba, among others. *See* Furman Decl, Ex. J. The strategy of those companies to market and sell both beverages and cosmetics under the same brand shows that consumers are accustomed to seeing and associating beverages and nourishment,

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7 *See* Ex. J of the Furman Decl. for trademark registrations and internet materials showing third-party promotion and sales of cosmetics and beverages emanating from the same source.

8 *See* U.S. Registration Nos. 2,904,034; 2,821,896; 2,822,102 annexed as part of Ex. J to the Furman Decl.

including nutritional supplements, with beauty and skin care. Just as a consumer is likely to assume that an Evian skin moisturizer comes from the Evian beverage company, a consumer likely would confuse Applicant's L'ORÉAL PARIS "aloe vera drinks" as emanating from Opposer's L'ORÉAL PARIS brand of beauty products.

Consumers' recognition that aloe vera is a common ingredient in cosmetics is another reason Applicant's "aloe vera drinks" and Opposer's cosmetics goods are related. L'Oréal uses aloe vera and other botanicals in a number of its products. *See supra*, at 10. Aloe's strong tie to cosmetics is reflected in the ALOE-formative trademarks registered by companies that produce skin care and hair care products.[9] In fact, aloe is more strongly associated with cosmetics than with beverages: as of June 2010, there were one hundred fourteen (114) active federal registrations and applications in the USPTO records for ALOE-formative marks for Class 3 goods (cosmetics), and only thirty (30) ALOE-formative marks for Class 32 (light beverages).[10] It, therefore, is highly likely that the consuming public would confuse Applicant's L'ORÉAL PARIS "aloe vera drink" as emanating from Opposer's L'ORÉAL PARIS line of products.

Companies are known to market beverages and cosmetics under the same trademark, and aloe vera is commonly associated with cosmetics. Applicant's applied-for mark is identical to Opposer's strong and famous mark. Therefore, Applicant's goods and Opposer's goods are sufficiently related to support a finding of a strong likelihood of confusion.

4. The Parties' Channels of Trade Are the Same

Where there is no limitation on the channels of trade contained in the identification of goods or services, "it is presumed that the recitations encompass all [goods and] services of the type described, that they move in all normal channels of trade, and that they are available to all

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[9] *See, e.g.*, U.S. Registration Nos. 3,172,463 and 3,694,382 annexed as part of Ex. K to the Furman Decl.

[10] *See, e.g.*, U.S. Registration Nos. 3,172,463 and 3,694,382 annexed as part of Ex. K to the Furman Decl.

potential consumers." *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 U.S.P.Q.2d 1887, 1889 (T.T.A.B. 2007). "It is not significant, either in law or in fact, that the channels of trade for opposer's [goods] may actually be broader than applicant's channels of trade. To the extent the channels of trade and purchasers overlap, they are in part identical." *Tea Bd. of India*, 80 U.S.P.Q.2d at 1897. Unless the application or registration provides evidence to the contrary, the Board must assume that the channels of trade are identical. *Id.*

Applicant's application is based on its intent to use the subject mark. It contains no restriction on the channels of trade through which it intends to sell his goods.[11] Thus, the channels of trade covered by Applicant's application comprise all of the channels through which beverages are sold in the ordinary course which, quite naturally, include the same channels in which skin care, hair care, cosmetics and related products are sold, *e.g.*, supermarkets, drug stores, mass merchandisers, and the like. *Venture Out Props.*, 81 U.S.P.Q.2d at 1893. Thus, Applicant's and Opposer's channels are the same. Opposer's registrations for its L'ORÉAL Marks similarly are silent on the channels of trade through which the identified goods are sold.[12] Those registrations, therefore, are entitled to the broadest scope of protection when it comes to where the identified goods are sold. *In re Smith & Mehaffey*, 31 U.S.P.Q.2d 1531, 1532 (T.T.A.B. 1994) ("[S]ince the identification is unrestricted as to channels of distribution, [the Board] must consider the goods to travel in all channels appropriate for goods of this type."); *Venture Out Props.*, 81 U.S.P.Q.2d at 1893. In fact, the goods sold under Opposer's L'ORÉAL and L'ORÉAL PARIS marks are sold through a wide range of channels, including traditional retail outlets (e.g. Wal-Mart, Target), drugstore chains (*e.g*, CVS, Walgreen's), food outlets (*e.g.*, Kroger), as well as online. *See supra*, at 10.

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11 *See* Appln. Serial No. 76/596,736.

12 *See* U.S. Registration Nos. 661,746; 540,541; 3,109,618; 3,115,751; 3,081,932; 3,281,234; and 3,453,735 annexed as Exs. E1-E7 to Opposer's Notice of Reliance.

As a practical matter, given the expanse of trade channels through which L'Oréal sells goods under its L'ORÉAL and L'ORÉAL PARIS marks, the parties' goods are destined to be sold through the same retail channels. As a matter of law, the channels of trade are identical, and this factor supports a finding of likelihood of confusion.

5. The Parties' Goods are Inexpensive and Are Sold to Impulse Purchasers As Well As to Unsophisticated Consumers

"When the products are relatively low-priced and subject to impulse buying, the likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M. C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). Even if the goods themselves are found to be different, that fact would "not compel a conclusion that consumers may not confuse the origin of the [goods] in hasty, economically painless, transactions." *Id.* Further, the potential for confusion where the goods at issue are relatively low-priced is further enhanced by the significance of a famous mark. *Id.*

The subject application contains no limitation on the types of purchasers to whom the Applicant's "aloe vera drinks" will be sold and is silent on the issue of the price point at which Applicant's goods will be sold.[13] Therefore, with respect to this factor, Applicant's target consumers also are considered to be consumers of cosmetics, skin care and hair care products, *i.e.* the public at large. *See Octocom Sys., Inc. v. Houston Computer Sevs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("it was not error . . . for the board to give no weight to OSI's evidence purporting to show that OCTOCOM modems are bought by a particular class of purchasers . . . . Because OSI seeks an *unrestricted* registration, such evidence as there is of a specific class of customers did not relate to a *material* fact.") (emphasis in original). Opposer's registrations for the L'ORÉAL Marks also are unrestricted, as is Applicant's application.

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[13] *See* Appln. Serial No. 76/596,736.

Members of the public generally constitute the potential purchasers of both parties' goods. There is no established, generally-accepted sophistication level for the purchasers of skin care, hair care and cosmetic products, and certainly none in the record. The subject application and the registrations for the L'ORÉAL Marks cover relatively inexpensive goods. The actual and prospective purchasers consist of unsophisticated purchasers and include impulse buyers. This factor strongly supports a finding of likelihood of confusion.

6. No Evidence of Similar Marks for Similar Goods

There is no evidence in the record of the use by third parties of any marks or goods similar to those of Opposer. Annexed to Applicant's Notice of Reliance is evidence of a product marketed as "O'real Krispy Fried Chicken Mix" sold by Real Foods Ltd, and a Canadian wrestler known a Ivan Koloff whose personal, off-stage name is Oreal Perras.[14] The purpose for Applicant's reference to them is not obvious. Being generous to Applicant, they are utterly irrelevant and *de minimis*. Opposer's L'ORÉAL Marks are distinctive in the marketplace. This factor strongly favors a finding of likelihood of confusion.

7. Lack of Actual Confusion is Irrelevant Because Applicant Has Not Yet Used the Proposed Mark

The application is based on Applicant's intent to use the subject mark. Quite naturally, there is no evidence of actual confusion. As the Federal Circuit has previously stated, "[t]he lack of evidence of actual confusion carries little weight." *In re Majestic Distilling*, 315 F.3d at 1317. *A fortiori*, where the applicant has filed an intent-to-use application and has not yet begun use, the opportunity for confusion does not exist.

8. The Potential for Confusion is Substantial

L'Oréal sells and advertises its goods nationwide under the L'ORÉAL and L'ORÉAL PARIS marks. Although Applicant relies on an intent-to-use application, the potential

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[14] *See* Applicant's Not. of Rel., Exs. 9 and 12.

for confusion is substantial in that the L'ORÉAL and L'ORÉAL PARIS marks are famous and well-known throughout the country. Wherever and however Applicant may advertise and sell his L'ORÉAL PARIS aloe vera drinks, consumers everywhere are likely to be confused as to the source of those goods as emanating from or being somehow connected or affiliated with Opposer. Where, as here, the marks are identical and, as used by Opposer, famous, there is likely to be not only prospective confusion, but also post-sale confusion in the mind of anyone who sees Applicant's goods after they have been purchased by another. *See Lois Sportswear*, 799 F.2d at 871. The potential for confusion is substantial.

9. There is No Interface Between Applicant and Opposer

There is no issue here regarding priority. Applicant has no connection of any kind to Opposer. Opposer has not granted Applicant any form of permission to register or use L'ORÉAL PARIS.

B. Applicant Lacks a Bona Fide Intent To Use The Applied-For Mark in Commerce

The statutory provision that permits trademark applications to be based on an intent to use requires an applicant to have a "bona fide intent to use" the applied-for mark in commerce, and for the application to be filed "under circumstances showing the good faith of such a person." 15 U.S.C. 1051(b). Absent a showing of 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 Act of 1988 makes clear that Congress intended "bona fide intent to use" to mean 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, 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 extant at the time of application 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 made clear that the lack of documentary evidence can be sufficient to prove that an applicant lacked the requisite bona fide intent, pointing out that absent adequate countervailing facts, "the absence of any documentary evidence on the part of the applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intent 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).

A fortiori, certain circumstances constitute affirmative proof that an applicant lacks a bona fide intent to use an applied-for mark, in the absence of documentary evidence or other objective evidence to the contrary. Such circumstances 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 pendency 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.

Here, Applicant admits that he has no documents evidencing a bona fide intent to use the L'ORÉAL PARIS mark for aloe vera drinks.[15] Applicant also admits that he has no industry-relevant experience manufacturing or selling aloe vera drinks.[16] Applicant has not developed a business plan, contacted any potential partners, developed any logos or packaging, or undertaken any other concrete activities in preparation for use of the applied-for mark in connection with the identified goods.[17] Rather, Applicant resorts to a *post hoc* generalized reference to outsourcing and licensing as potential strategies to use the applied-for mark at an unspecified time in the future.[18]

The record also shows that Applicant has a history and pattern of filing intent-to-use applications for a disparate range of products for which he has no industry-relevant experience, and where the applied-for marks are identical to some of the best known, previously-registered trademarks in the country.[19] Applicant's other applications include HEINEKEN for "meat juices," JACK DANIEL'S for "cigars, cigarettes, and chewing tobacco," CHANEL for "scented stationery and greeting cards," SOUTHERN COMFORT for various beverages including beer, water, and juices, BAYER for "non-medicated breath fresheners . . . non-medicated mouthwash and gargle,"

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15 *See* Opposer's First Set of Document Requests, Request Nos. 4, 9 and 10, annexed as Ex. D-1 to Opposer's Not. of Rel., and Applicant's "Response to Opposers' Request," Response Nos. 4, 9 and 10 at pp. 23-24, annexed as Ex. D-2 to Opposer's Not. of Rel.

16 *See* Opposer's First Set of Requests for Admission, Request No. 45, annexed as Ex. D-1 to Opposer's Not. of Rel., and Applicant's "Response to Opposers' Request," Response No. 45 at p. 14, annexed as Ex. D-2 to Opposer's Not. of Rel.

17 *See* Opposer's First Set of Interrogatories, Interrogatory Nos. 5 and 11, annexed as Ex. D-1 to Opposer's Not. of Rel., Applicant's "Response to Opposers' Request (Supplementary)," Responses No. 5 and 11, annexed as Ex. D-3 to Opposer's Not. of Rel.,

18 *See* Opposer's First Set of Requests for Admission, Request No. 46, annexed as Ex. D-1 to Opposer's Not. of Rel., and Applicant's "Response to Opposers' Request," Response No. 46 at p. 14, annexed as Ex. D-2 to Opposer's Not. of Rel.

19 *See* Opposer's Not. of Rel., Exhs. C1-C18,

ABSOLUT and ABSOLUT WATER for various beverages including beer, water, and juices; FINLANDIA for various beverages including water, juices, and flavored drinks; COORS for meat juices and meat juice concentrates; BUDWEISER for various beverages including water, juices, and non-alcoholic beverages; DOM PERIGNON for meat juices and broth; NESCAFÉ for alcoholic beverages; EVIAN for distilled spirits, ice cream, sherbert, frozen confections; and TIM HORTONS for alcoholic beverages, ice cream, frozen yogurt, edible nuts.[20] They all are cases of attempted trademark piracy by an applicant with "an excessive number of intent-to-use applications" as compared to "the number of products the applicant is likely to introduce," *Lane Ltd.* 33, U.S.P.Q. at 1355-56. The record shows that most of those trademark applications are now abandoned or dead. Applicant's Not. of Rel., Ex. 19.

The cumulative effect of the above record – including Applicant's complete lack of documentary evidence or any other objective evidence that he can/will use the mark, lack of capacity or experience needed to manufacture or otherwise offer the identified goods, vague allusions to use through licensing or outsourcing, failure to take any concrete actions or to develop any concrete plans for use and, most importantly, Applicant's pattern of filing intent-to-use applications for disparate goods under the well-known or famous marks of others demonstrate that Applicant objectively lacks the requisite bona fide intent to use the L'ORÉAL PARIS mark in connection with aloe vera drinks, or that he filed the application in good faith. The application should be refused on that basis alone.

C. Applicant's Registration of the L'ORÉAL PARIS Mark is Likely to Dilute and Diminish the Source-Identifying Quality of Opposer's L'ORÉAL and L'ORÉAL PARIS Marks

The federal anti-dilution statute accords protection to the owner of a famous mark against another who uses the famous mark in a way that is "likely to cause dilution" of the

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[20] *Id.*

distinctiveness or goodwill of that mark. 15 U.S.C. § 1125(c). Applicant's mark should be refused registration because it is likely to dilute by blurring the distinctiveness and strength of Opposer's L'ORÉAL Marks.

"Dilution by blurring" is the association of a famous mark with another mark, arising from the similarity between the two, that impairs the distinctiveness of the famous mark. 15 U.S.C. § 1125(c)(2)(B). The factors for determining likelihood of dilution by blurring include: 1) similarity of the marks; 2) distinctiveness of the famous mark; 3) degree to which the owner of the famous mark is engaged in substantially exclusive use of the mark; 4) the degree of recognition of the famous mark; 5) whether the junior user intended to create an association with the famous mark; and 6) any actual association between the marks. *Id.*. It is a separate form of relief from Section 2(d) of the Lanham Act because the anti-dilution statute protects against the erosion of a mark's distinctiveness that may occur in the absence of confusion. *See generally*, J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 24:69 (4th ed. 2007).

Opposer has established that factors 1 through 4 above strongly support a finding of likelihood of dilution. Applicant's applied-for mark is identical to Opposer's L'ORÉAL Marks. *See supra*, at 15-16. The L'ORÉAL Marks are highly distinctive, indeed famous, (*see supra*, at 12-15), are being used exclusively by Opposer (*see supra*, at 2-3, 12-13), and are well-recognized in the United State and throughout worldwide (*see supra*, at 5-10). The sixth factor – actual association between the marks – is neutral because at issue is an intent-to-use application and Applicant has not yet used the applied-for mark.

The fifth factor is unavoidable when one considers the totality of the surrounding circumstances and the pattern of filing numerous intent-to-use applications, where the applied-for marks are identical to some of the best known, previously-registered trademarks in America. *See supra*, at 24-25. Applicant's clear strategy and intent is to create an association between his marks

and the famous marks of others, and to piggy back on the strength and goodwill that L'Oréal and those other trademark owners built over many years and at great expense. Pirating Opposer's house mark can lead to no other conclusion than that Applicant's intention was to create an association with Opposer's marks.

In light of the identity of Applicant's and Opposer's marks, the distinctiveness, fame, and exclusive use of the L'ORÉAL Marks by Opposer, and the clear showing of Applicant's intention to create an association between his and Opposer's marks, Applicant's intent-to-use application should be refused registration based on a likelihood of dilution.

Conclusion

Based on the foregoing, L'Oréal respectfully requests that the Board sustain the opposition and refuse to register the subject application on the basis of likelihood of confusion, lack of bona fide intent to use on the part of Applicant, and likelihood of dilution.

ORAL ARGUMENT IS REQUESTED

Dated: November 22, 2010

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing TRIAL BRIEF OF OPPOSER L'ORÉAL S.A. and L'ORÉAL USA, INC. was served on Applicant this 22nd day of November 2010 by delivering a true and correct copy of same by First Class Mail to:

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Edith R. Lopez