

**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  
**Defendant (Applicant(s)):** Robert Victor Marcon  
**Plaintiffs (Opposer(s)):** L'Oreal USA, Inc. and L'Oreal S.A.  
**Plaintiffs' Attorney:** Robert L. Sherman  
**Reply Number:** Communication - K  
**Number of Pages:** Thirty-five (35)

**CERTIFICATE OF MAILING (USPTO)**

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

**Certified Mail Serial No.:** 7008 1830 0002 1389 3858  
**Date of Deposit:** 22 December 2010  
**Depositor's Signature:** Robert Marcon (Robert Marcon)

**CERTIFICATE OF SERVICE (PLAINTIFFS)**

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

**Certified Mail Serial No.:** 7008 1830 0002 1389 3988  
**Date of Deposit:** 22 December 2010  
**Depositor's Signature:** Robert Marcon (Robert Marcon)



**CASE PARTICULARS**

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**DEFENDANT (APPLICANT) INFORMATION**

**Name of Defendant:** 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

**PLAINTIFF (OPPOSER) INFORMATION**

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

**Plaintiffs' Attorney:** Robert L. Sherman,  
Paul, Hastings, Janofsky & Walker LLP  
**Mailing Address:** Street: 75 East 55th Street  
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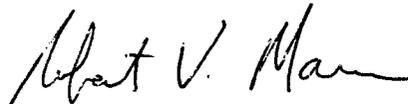
**IN THE MATTER OF an Opposition by  
L'Oreal USA, Inc. and L'Oreal S.A.  
to Application Serial No. 76/596,736 filed by  
Robert Victor Marcon  
for the trademark "L'OREAL PARIS"  
(Opposition No. 91184456)**

**COMMUNICATION - K  
DEFENDANT'S TRAIL BRIEF**

This communication presents the Defendant's Trail Brief of which a full and complete copy has also been sent to the Plaintiffs' representative, namely, Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP located at 75 East 55th Street, New York, New York, U.S.A., 10022.

This concludes the Defendant's Trail Brief.

Respectfully submitted,



Robert V. Marcon,  
Defendant Pro Se  
22 December 2010

102 **SUMMARY OF THE ARGUMENTS**

103 The Defendant, Robert Victor Marcon, submitted a intent-to-use trademark application for  
104 the mark "L'OREAL PARIS", Serial No. 76/596,736, on June 9, 2004. Said application claims priority  
105 from the Canadian application, Serial No. 1,201,383, filed December 11, 2003. The Defendant  
106 contends that his U.S. application is registrable based on the facts that mark is not confusing with  
107 the marks of the Plaintiffs nor does it dilute the Plaintiffs' marks. The Defendant will also show that  
108 he has always had a genuine bona fide intent to use the applied for mark "L'OREAL PARIS" in  
109 commerce. Finally, the Defendant will address those points currently brought forth by the Plaintiffs  
110 regarding the Defendant's other applied for marks.

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113 **PROCEDURAL HISTORY**

114 On June 9, 2004, the Defendant filed the intent-to-use trademark application at issue herein,  
115 namely, application Serial No. 76/596,736 for the mark "L'OREAL PARIS" with wares "Aloe vera  
116 drinks" in Class 32. The examining attorney refused to register the proposed mark under  
117 Trademark Act >2(a), 15 U.S.C. > 1052(a), on the ground that it falsely suggested a connection with  
118 the Plaintiffs. The Defendant appealed on October 18, 2006. The Board reversed and remanded,  
119 stating that the Trademark Office had not met its burden of proving that L'OREAL was of sufficient  
120 fame that the Defendant's proposed mark would be presumed connected to it. The Board noted,  
121 however, that the Trademark Office had "limited facilities" for acquiring evidence" in reviewing  
122 prima facie cases, and "hasten[ed] to point out" that a "different and more complete record, such  
123 as might be adduced in an inter parties proceeding" may well cause the Board to arrive at a different  
124 result. In re Marcon, 2008 WL 906602, at \*7-8 (T.T.A.B. Mar. 6, 2008). On May 6, 2008 the  
125 Defendant's mark was published for opposition. On June 4, 2008 the Plaintiffs filed their notice of  
126 opposition.

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129 **THE RECORD**

130 The record consist of the Defendant's "Notice of Reliance" dated August 6, 2010 and exhibits  
131 thereto, and also the Plaintiffs' "Notice of Reliance" dated June 9, 2010 and exhibits thereto.

135 **THE ISSUE**

136 The sole issue in this opposition proceeding is whether the Defendant is or is not entitled  
137 to register the trademark "L'OREAL PARIS" for the goods identified in application Serial No.  
138 76/596,736 for the wares "aloe vera drinks" in Class 32.

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141 **THE FACTS**

142 The Defendant, Robert Victor Marcon, submitted an intent-to-use trademark application  
143 Serial No. 76/596,736 for the mark "L'OREAL PARIS" on June 9, 2004 which claims priority from the  
144 Canadian application, Serial No. 1,201,383, filed December 11, 2003. The goods identified in said  
145 application include the wares "aloe vera drinks" in Class 32.

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148 **TABLE OF AUTHORITIES**

- 149 (1) In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 653 (CCPA 1973) first  
150 stated on page 5 of this correspondence.
- 151 (2) In re Dixie Rest., Inc., 105F.3d 1405, 1406-07, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997  
152 from In re Majestic Distilling Co. (Fed. Cir. Jan. 2, 2003) first stated on page 7 of this  
153 correspondence.

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156 **LEGAL ARGUMENTS**

157 In has long been established in trademark law that the scope of a trademark is determined  
158 by whether there is a "likelihood of confusion" between that trademark and another trademark in  
159 the minds of the consuming public. In other words, the court determines the likelihood of  
160 confusion by focusing on the question whether the purchasing public would mistakenly assume that  
161 the applicant's goods originate from the same source as, or are associated with, the goods in the  
162 cited registrations. Fortunately, the criteria used in the determination of the "likelihood of confusion"  
163 has been well established in the Federal Court where it is commonly known as the "DuPont factors".  
164 Thus, aided by the application of the factors set out in "In re E.I. du Pont de Nemours & Co., 476  
165 F.2d 1357, 177 USPQ 653 (CCPA 1973), hereinafter referred to as the Dupont factors, the TTAB  
166 and the courts are guided, on a case by case bases, in making the determination of the "likelihood  
167 of confusion".

168           The DuPont factors used by the court comprise the following thirteen points and are listed  
169 below as follows:

170

171           (1)     the similarity or dissimilarity of the marks in their entireties as to appearance, sound,  
172                    connotation, and commercial impression;

173

174           (2)     the similarity or dissimilarity and nature of the goods described in an application or  
175                    registration or in connection with which a prior mark is in use;

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177           (3)     The similarity or dissimilarity or established, likely-to-continue trade channels;

178

179           (4)     the conditions under which and buyers to whom sales are made such as impulse vs.  
180                    careful or sophisticated purchasing;

181

182           (5)     the fame of the prior mark;

183

184           (6)     the number and nature of similar marks in use on similar goods;

185

186           (7)     the nature and extent of any actual confusion;

187

188           (8)     the length of time during and the conditions under which there has been concurrent  
189                    use without evidence of actual confusion;

190

191           (9)     the variety of goods on which a mark is or is not used;

192

193           (10)    the market interface between the applicant and the owner of a prior mark;

194

195           (11)    the extent to which applicant has a right to exclude others from use of its mark on  
196                    its goods;

197

198           (12)    the extent of potential confusion; and

199

200           (13)    any other established fact probative of the effects of use.

201 Id. at 1361, 177 USPQ at 567. However, it should also be noted that not all of the DuPont  
202 factors may be relevant or of equal weight in a given case, and "any one of the factors may control  
203 a particular case, "In re Dixie Rests., Inc., 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir.  
204 1997) from In re Majestic Distilling Co. (Fed. Cir. Jan. 2, 2003).

205 Nonetheless, the Dupont factors do provide a basis of sound and practical review that the  
206 courts have found to be just.

207 In this light, the Defendant has therefore applied to register the mark "L'OREAL PARIS" for  
208 "Aloe vera drinks" in Class 32. The mark was applied for on June 9, 2004 and claims priority from  
209 the corresponding Canadian application filed December 11, 2003.

210 Second, the Defendant has found no other registration that contains or utilizes only those  
211 words. However, the Defendant has found other registrations belonging to the Plaintiffs that do  
212 contain elements of the Defendant's mark namely the words "L'OREAL" and/or "PARIS" but only  
213 three of these registrations actually predate the Defendant's application. These three registrations  
214 belong to "L'Oreal Societe Anonyme France, one of the Plaintiffs herein, and can be viewed along  
215 with all other live marks belonging to the Plaintiff in Exhibit-14 of the Defendant's Notice of  
216 Reliance. For the reader's convenience these three registrations will now be listed below:

- 217
- |     |     |                    |  |
|-----|-----|--------------------|--|
| 218 | (1) | Registration No.:  | 0540541  |
| 219 |     | Filing Date:       | May 11, 1950   |
| 220 |     | Registration Date: | April 3, 1951  |
| 221 |     | Trade-mark:        | <b>L'OREAL</b>   |
| 222 |     | Registrant:        | L'Oreal Societe Anonyme France                                 |
| 223 |     | Wares:             | Rouge, face cream, hair lotion, hand cream, eye shadow, face   |
| 224 |     |                    | lotion, perfume, cologne, nail polish, suntan oil, and face    |
| 225 |     |                    | powder.  |
| 226 |     | Status:            | Currently active.  |
| 227 |     |                    |  |
| 228 | (2) | Registration No.:  | 0661746  |
| 229 |     | Filing Date:       | June 25, 1956  |
| 230 |     | Registration Date: | May 13, 1958   |
| 231 |     | Trade-mark:        | <b>L'OREAL</b>   |
| 232 |     | Registrant:        | L'Oreal Societe Anonyme France                                 |
| 233 |     | Wares:             | Hair colorings, color rinses, hair bleaches, color developers, |

234 color intensifiers, and hair conditioners.

235 Status: Currently active.

236

237 (3) Registration No.: 3109618

238 Filing Date: October 16, 2001

239 Registration Date: June 27, 2006

240 Trade-mark: **L'OREAL ENDLESS**

241 Registrant: L'Oreal Societe Anonyme France

242 Wares: Lipstick.

243 Status: Currently active.

244

245 These three registered marks are the only marks belonging to the Plaintiffs and which  
246 predate the Defendant's mark. Thus, while the Plaintiffs have included in their submission of  
247 evidence most of their registrations and applications only those three detailed above should be  
248 considered. The reason being, is because the law specifically states that in any intellectual property  
249 claim, be it a trade-mark, patent, copyright or industrial design, time is of the essence. That is, any  
250 application, registration, piece of evidence, action or undertaking is time based and so forms a  
251 chronological barrier to any claim or opposition not predating the event in question. Since the  
252 Defendant's application predates most of the Plaintiffs' registrations and applications, save the three  
253 listed above, they should not be considered in this opposition proceeding for the very reasons  
254 stipulated above.

255 That said, the Defendant will begin his analysis of the evidence herein presented by both  
256 parties utilizing the guidance of the DuPont factors.

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259 **Dupont Factor Number One:**

260 The first Dupont factor analyzes the similarity in appearance, sound, connotation, and  
261 commercial impression. The first Dupont factor is generally thought to be the most important for  
262 if the marks are not similar in any way none of the other factors are going to really matter. It is also  
263 well understood that when this factor is used the similarity or dissimilarity of the marks **in their**  
264 **entirety** must be analyzed and that includes not just the words used in the marks but also any  
265 pictorial or artistic representations or renderings therein.

266 Thus, if the marks in question are analyzed using this premise it can be clearly seen that the

267 Defendant's mark comprises the words "L'OREAL PARIS". However, the Plaintiffs' first two marks  
268 utilize the word "L'OREAL" with the last mark comprising the words "L'OREAL ENDLESS". In this  
269 respect the only commonality is the word "L'OREAL".

270 The Defendant has also noted that trademark law, at a general level, seeks to protect the  
271 goodwill represented by particular marks, enabling consumers to readily recognize products and  
272 their source and to prevent consumer confusion between products and between sources of  
273 products. The marks, therefore, enable consumers to make informed and independent decisions  
274 about quality and other product characteristics. However, the law also seeks to protect the  
275 linguistic commons by denying mark holders an exclusive interest in words that do not identify  
276 goodwill attached to products or product sources but rather are used for their common meaning  
277 or meanings not indicative of products and product sources.

278 To balance these competing interests, trademark law has developed a spectrum of the  
279 "distinctiveness of marks". Thus, in declining order of distinctiveness, marks are referred to as: (1)  
280 arbitrary or fanciful (coined); (2) suggestive; (3) descriptive; or (4) generic. The more distinctive a  
281 mark, the more protection it receives.

282 Thus, "arbitrary" marks are based on existing words used in ways unconnected with their  
283 common meaning, such as APPLE computer or SHELL gasoline. "Fanciful" marks are made-up  
284 words that are invented to describe the product or source, such as KODAK or EXXON. Arbitrary  
285 and fanciful marks clearly do not threaten the linguistic commons, as they are considered inherently  
286 distinctive and therefore valid without the holder having to make any other showing.

287 "Suggestive" marks connote, without describing, some quality, ingredient, or characteristic  
288 of the product, and include such marks as L'EGGS pantyhose and GLASS DOCTOR window repair.  
289 Suggestive marks are also considered inherently distinctive and valid.

290 "Descriptive" marks merely describe a function, use, characteristic, size, or intended purpose  
291 of the product, such as YELLOW PAGES telephone directories and 5 MINUTE glue. Additionally,  
292 this class of mark further includes those that are geographically descriptive, such as BOSTON beer  
293 produced by a Boston-based brewer, BANK OF AMERICA, and MISS U.S.A..

294 No descriptive mark can serve as a valid trademark without evidence of secondary meaning.  
295 "Secondary meaning" in connection with geographically descriptive marks means that the mark no  
296 longer causes the public to associate the goods with the geographical location, but to associate the  
297 goods with a particular product or source of the product. In this manner, KENTUCKY fried chicken  
298 and AMERICAN airlines are geographically descriptive marks that have established secondary  
299 meaning in consumers' minds, causing consumers to recognize a brand or source of fried chicken

300 or air travel, rather than the places, Kentucky and America.

301 Distinguishing between a suggestive mark and descriptive mark can be difficult. However,  
302 if a mark imparts information directly it is descriptive but if it stands for an idea which requires some  
303 operation of the imagination to connect it with the goods then it is suggestive. Even an abbreviation  
304 of a descriptive term which still conveys to the buyer the descriptive connotation of the original  
305 term will still be held to be descriptive.

306 On the other hand, "Generic" words which are "the common name of a product" or "the  
307 genus of which the particular product is a species" can never be valid marks under any  
308 circumstances. Thus, LITE BEER for light beer, CONVENIENT STORE for convenience stores, and  
309 POLO shirts for polo shirts cannot serve as trademarks.

310 It is also common for the USPTO and the courts to translate marks utilizing foreign words  
311 into English when comparing marks. That is, words from modern languages are generally translated  
312 into English. However, the doctrine of foreign equivalents is not an absolute rule and should be  
313 viewed merely as a guideline. Thus, it is applied only when it is likely that the ordinary American  
314 purchaser would stop and translate the word into its English equivalent.

315 Dead languages, on the other hand, are not normally translated unless the terms or words  
316 used are readily understood by the general public.

317 With these thoughts in mind the Defendant ask the reader to refer to his "Notice of  
318 Reliance" and in particular Exhibit-4 which details the purpose of "Elision" in the French language.  
319 Elision, therefore, is or simply refers to the suppression of a final unstressed vowel usually occurring  
320 immediately before another word beginning with a vowel. The term also refers to the orthographic  
321 convention by which the deletion of a vowel is reflected in writing, and indicated with an  
322 apostrophe. In written French, elision (both phonetic and orthographic) is obligatory for certain  
323 words. Thus, the phrases "le arbre" would become "l'arbre", "le homme" would become "l'homme",  
324 and "Le Oreal" would become "L'Oreal".

325 Thus, as stated before, when recognized foreign words are encountered within a trademark  
326 and well understood in the U.S.A. they must be first translated into English before they are  
327 compared. When the French word "L'OREAL" is therefore translated into English it simply mean,  
328 "The Oreal". Clearly, the phrase is but a common proper name as well as surname. Evidence of  
329 this claim is provided by the Defendant's Notice of Reliance, namely, Exhibits 1, 5, 8, and 9.  
330 However, if the term "LOREAL" is used it to is but a simple proper name and surname the evidence  
331 of which can be seen in Exhibits 2 and 6.

332 When the trademark strength of such a word is therefore analyzed it appears to be weak.

333 That is because the word "L'OREAL" is but a word normally found in the linguistic commons of the  
334 United States as well as other nations. More importantly, it does not appear to fit into the definition  
335 of an arbitrary, fanciful or suggestive trademark but rather appears to be descriptive. In other  
336 words, it would be no different in strength than a mark like "BOB'S" for a restaurant chain, "MAC'S"  
337 for say pies, or "JIM'S" for soda pop. Though such marks may acquire secondary meaning and aspire  
338 one day to the principal registry the ambit of protection conferred upon them is generally relegated  
339 to their immediate markets, wares or services and not to unrelated markets, wares or services  
340 never before practised or explored.

341 Consequently, the marks in question are significantly different with the only commonality  
342 between them being a word that is essentially a proper name and surname. Since such words  
343 generally belong to the linguistic commons of the nation and can never truly acquire the strength  
344 of an arbitrary, fanciful or suggestive mark it appears that the first Dupont factor slightly favors the  
345 Defendant.

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348 **Dupont Factor Number Two:**

349 The second Dupont factor deals with the similarity or dissimilarity and nature of the goods  
350 described in an application or registration or in connection with which the prior mark is in use. In  
351 this respect, the second Dupont factor heavily favors the Defendant. That is because the wares  
352 detailed in each of the respective marks are so different in that they cannot be substituted one for  
353 the other, they cannot be used in conjunction with each other, they are directed to different  
354 purposes or functions, and generally used in different settings.

355 Moreover, consumer expectations of a company producing wares like those listed in the  
356 Plaintiffs' marks would not align with those of the Defendant's. That is, the wares of a company  
357 project a certain persona about that company and the persona derived from the Plaintiffs' wares is  
358 dramatically different than the persona associated to the Defendant's wares.

359 For example, "Sunkist" is a trademark that is well known for selling fruit juices. As such, it  
360 would be odd indeed if Sunkist's customers expected it to market such products as Rouge, face  
361 cream, hair lotion, hand cream, eye shadow, face lotion, perfume, cologne, nail polish, suntan oil,  
362 face powder, hair colorings, color rinses, hair bleaches, color developers, color intensifiers, hair  
363 conditioners, and lipstick when such an action would constitute a gross departure from the carefully  
364 crafted persona associated with selling fruit juices.

365 Consequently, this same line of reasoning, the Defendant believes, also applies to the marks

366 herein in question. In other words, expanding sales from cosmetics to fruit juices or conversely  
367 from fruit juices to cosmetics would constitute such an immense departure from the personas  
368 encompassing the existing registrations and respective wares of the Plaintiffs and Defendant that it  
369 would be extremely unlikely not only in practise but also in the barriers preexisting in the minds of  
370 consumers.

371 Second, the Defendant also believes that the Plaintiffs may also argue that their products  
372 contain aloe vera and as such the wares are similar. Such an example is poor at best for the simple  
373 reason that any mark is only associated with the final product itself and not the individual ingredients  
374 or constituents that make up those products. After all, products such as milk may contain vitamin  
375 D, orange juice may be supplemented with calcium, and cereal fortified with multiple vitamins.  
376 Many other unrelated products also employ vitamins, minerals and even herbs but it would be  
377 clearly unreasonable to conclude that the Plaintiffs' wares would also be associated with milk, juice,  
378 cereal or even herbs just because some of their cosmetics, skin creams or shampoos may contained  
379 traces of milk, vitamins, minerals, and herbs. This same analogy also applies to all of the wares  
380 evidenced in this proceeding be they the Plaintiffs' or that of others. That is, the final wares  
381 themselves are what may or may not be found confusing and not the individual ingredients  
382 composing or constituting those wares.

383 Consequently, with such an extreme difference in the parties goods it appears that the  
384 second Dupont factor heavily favors the Defendant.

385

386

387 **Dupont Factor Number Three:**

388 The third Dupont factor examines the similarity or dissimilarity of established, likely-to-  
389 continue trade channels. With regard to this factor the Defendant believes that the trade channels  
390 are different. That is because the Defendant's market size or overall retail territory is much much  
391 larger than that of the Plaintiffs. This premise is made simple by the fact that the wares of the  
392 Plaintiffs are essentially directed to women whereas the wares of the Defendant are directed to  
393 both females and males of all age groups.

394 Second, if one adds to this argument the highly dissimilar nature of the wares in question any  
395 cohabitation of retail venues would not only be minor but also physically remote. That is because  
396 beverage products, in general, are never offered for sale in close proximity of shelves, displays or  
397 departments retailing cosmetics. As such, this greatly diminishes the likelihood of confusion.

398 As further proof of the validity of this premise one need only look to the current trademark

399 registry of the United States Patent and Trademark Office or USPTO.

400 From this trademark registry the Defendant's presents a small sampling of various identical  
401 marks owned by different owners. **Said marks are also relevant for every one was either**  
402 **registered or approved during the same commercial time periods.** Some of these marks may  
403 also be considered famous yet have coexist peacefully for many years with the others listed herein.  
404 This coexistence has also endured despite the fact that many of the wares of the respective marks  
405 seem to be engaged in identical or overlapping areas of business.

406 **It should also be noted that the Defendant's has used these examples because it**  
407 **is the Defendant's understanding that any trademark currently on the registry must be**  
408 **considered valid and in full force if not abandoned or expunged. Thus, these existing**  
409 **trademarks should be able to provide a confirmed base of examples which can be used**  
410 **in any quantitative comparisons or legal illustrations even though such examples do not**  
411 **serve as precedents in the eyes of the Board.**

412 For the reader's convenience, the Defendant has also summarized the similarities between  
413 each of the exemplified groups herein listed below so that the reader may better understand the  
414 Defendant's reasonings.

415

416 **EXAMPLE NUMBER ONE** **EXHIBIT-22**

417 (a) Registration No.: 0870965  
418 Registration Date: June 10, 1969  
419 Trade-mark: **OLD DUTCH**  
420 Registrant: Old Dutch Foods, Inc. Corporation Minnesota,  
421 2375 Terminal Road, St. Paul, Minnesota.  
422 Wares: Cheese-Flavored popcorn, caramel popcorn, [unpopped  
423 popcorn, chow mein noodles,] fried pork skins,[candy,  
424 pickles, mustard,] shelled salted nuts, and processed  
425 potatoes, corn, corn meal and cereals manufactured into  
426 snack foods of varying shapes and forms, namely, chip forms,  
427 flake forms, conical forms, curl forms and generally globular  
428 forms.  
429 Status: LIVE

430

431 (b) Registration No.: 2816720



465 office supplies, namely,] erasers; [drafting and drawing rulers,  
466 pencils, pens, markers, glue for stationery or household use,  
467 paper clips, binders, dispensers or adhesive tapes for  
468 stationery or household purposes, clip boards, stationery,  
469 notepad and pencil sets, notepads, organizers for stationery  
470 use, pencils cases; pencil sharpeners; ... sheet music; credit  
471 cards; bank checks and letter openers].

472 Status: LIVE

473

474 (c) Registration No.: 2448436

475 Registration Date: May 1, 2001

476 Trade-mark: **SPITFIRE**

477 Registrant: S.F. Deluxe Productions, Inc. Corporation California, P.O.  
478 Box 883311, San Francisco, California, 94188.

479 Wares: Clocks; watches and watch cases; jewellery, namely pendant,  
480 lapel pins, ornamental pins, hat pins of precious metal, rings,  
481 chains, ankle bracelets, cuff-links, tie clips, ... items made of  
482 precious metal, namely, figures, figurines, statuettes, cigarette  
483 cases, collector plates, hat ornaments, chess sets, decorative  
484 boxes, candle holders, ashtrays and candlesticks.

485 Status: LIVE

486

487 (d) Registration No.: 3023484

488 Registration Date: December 6, 2005

489 Trade-mark: **SPITFIRE**

490 Registrant: Spitfire Sunglass Design USA, Inc. Corporation Florida, 3624  
491 N. Fremont #4, Chicago, Illinois, 60613.

492 Wares: Eyewear, namely sunglasses.

493 Status: LIVE

494

495 (e) Registration No.: 3221076

496 Registration Date: March 27, 2007

497 Trade-mark: **SPITFIRE**



531 (d) Registration No.: 3220209  
532 Registration Date: March 20, 2007  
533 Trade-mark: **TEMPEST**  
534 Registrant: Schecter Guitar Research, Inc., Corporation California, 1840  
535 Valpreda Street, Burbank, California, 91504.  
536 Wares: Stringed musical instruments, namely guitars.  
537 Status: LIVE

538  
539

**EXAMPLE NUMBER FOUR**

**EXHIBIT-25**

541 (a) Registration No.: 1400865  
542 Registration Date: July 15, 1986  
543 Trade-mark: **ULTRA-VIM**  
544 Registrant: Pharmacaps, Inc., Corporation New Jersey, P.O. Box 547,  
545 1111 Jefferson Avenue, Elizabeth, New Jersey, 07207.  
546 Wares: Vitamins.  
547 Status: LIVE

548

549 (b) Registration No.: 2547402  
550 Registration Date: March 12, 2002  
551 Trade-mark: **VIM**  
552 Registrant: Guang Yan Corporation, Corporation New York, 141-07  
553 20th Avenue, Suite 502, Whitestone, New York, 11357.  
554 Wares: Nutritional supplements.  
555 Status: DEAD  
556 Cancellation Date: December 20, 2008

557  
558

**EXAMPLE NUMBER FIVE**

**EXHIBIT-26**

560 (a) Registration No.: 0821486  
561 Registration Date: January 3, 1967  
562 Trade-mark: **GREYHOUND**  
563 Registrant: John Capman Limited, Corporation South Africa, Zahlerweg

564 4, 6300 Zug, Switzerland.  
565 Wares: Smoking Tobacco.  
566 Status: LIVE  
567  
568 (b) Registration No.: 1679586  
569 Registration Date: March 17, 1992  
570 Trade-mark: **GREYHOUND**  
571 Registrant: Gouin S.A., Corporation France, 2 Rue Saint-Estephe, 75012,  
572 Paris, France.  
573 Last Owner: House of Greyhound Company Ltd., The Limited Liability  
574 Assignee of United Kingdom, 10 Melville Crescent,  
575 Edinburgh, EH3 7LU, Scotland.  
576 Wares: Wines, sherries, port, liqueurs, whiskeys, bourbons, gins and  
577 vodkas.  
578 Status: LIVE

579  
580

**EXAMPLE NUMBER SIX EXHIBIT-27**

582 (a) Registration No.: 1115781  
583 Registration Date: March 17, 1979  
584 Trade-mark: **FINLANDIA**  
585 Registrant: Oy alko AB, Corporation Finland, Salmisaarenranta, 7 SF-  
586 00180, Helsinki, 18, Finland.  
587 Last Owner: Finlandia Vodka Worldwide Ltd., Corporation Finland,  
588 Porkkalandatu, 24 Helsinki, Finland, 00180.  
589 Wares: Vodka.  
590 Status: LIVE

591

592 (b) Registration No.: 1388433  
593 Registration Date: April 1, 1986  
594 Trade-mark: **FINLANDIA**  
595 Registrant: Atalanta Corporation, Corporation New York, 17 Varick St.,  
596 New York, New York, 10013.

597 Last Owner: Valio Ltd., Corporation Finland, Meijeritie, 6 Helsinki, Finland,  
598 00370.  
599 Wares: Cheese  
600 Status: LIVE  
601  
602

603 **EXAMPLE NUMBER SEVEN**

**EXHIBIT-28**

604 (a) Registration No.: 1554959  
605 Registration Date: September 5, 1989  
606 Trade-mark: TRIUMPH  
607 Registrant: Texas Triumph Seed Co., Inc. DBA Triumph Seed Co., Inc.  
608 Corporation Texas, Hwy. 62 Bypass, PO Box 287, Ralls,  
609 Texas, 79357  
610 Wares: Hybrid grain sorghum seed, hybrid forage sorghum seed,  
611 hybrid sorghum-sudan seed, hybrid corn seed, hybrid  
612 sunflower seed and soybean seed.  
613 Status: LIVE  
614

615 (b) Registration No.: 2028061  
616 Registration Date: January 7, 1997  
617 Trade-mark: TRIUMPH  
618 Registrant: A Classic Time Watch Co., Inc., Corporation New York, 10  
619 West 33rd St., New York, New York, 10001  
620 Wares: Watches.  
621 Status: LIVE  
622

623 (c) Registration No.: 2606359  
624 Registration Date: August 13, 2002  
625 Trade-mark: TRIUMPH  
626 Registrant: Triumph Design Limited, Corporation United Kingdom,  
627 Ashby Road Measham, Swadlincote Derbyshire, DE 12 7 JP  
628 England.  
629 Wares: Beer, ale and lager.

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

630                    Status:                    LIVE  
631  
632                    (d)    Registration No.:        2835907  
633                                       Registration Date:      April 27, 2004  
634                                       Trade-mark:            TRIUMPH  
635                                       Registrant:             Sheltered Wings, Inc., Corporation Wisconsin, Suite Four,  
636                                                          2120 West Greenview Drive, Middletown, Wisconsin, 53562.  
637                                       Wares:                 Binoculars and spotting scopes.  
638                                       Status:                 LIVE  
639  
640                    (e)    Registration No.:        3307828  
641                                       Registration Date:      October 9, 2007  
642                                       Trade-mark:            TRIUMPH  
643                                       Registrant:             Silbaugh, Inc., Corporation Iowa, 1525 NE 36th Street,  
644                                                          Ankeny, Iowa, 50021.  
645                                       Wares:                 Herbicides.  
646                                       Status:                 LIVE  
647  
648                    (f)    Registration No.:        3314640  
649                                       Registration Date:      October 16, 2007  
650                                       Trade-mark:            TRIUMPH  
651                                       Registrant:             Thompson Center Arms Company Inc., corporation New  
652                                                          Hampshire, Farmington Road, P.O. Box 5002, Rochester,  
653                                                          New Hampshire, 03867.  
654                                       Wares:                 Firearms.  
655                                       Status:                 LIVE  
656  
657                    (g)    Registration No.:        3419340  
658                                       Registration Date:      April 29, 2008  
659                                       Trade-mark:            TRIUMPH  
660                                       Registrant:             Lorillard Licensing Company, LLC, Limited Liability Company  
661                                                          North Carolina, 1601 Wachovia Tower, 300 N. Greene St.,  
662                                                          Greensboro, North Carolina, 27401.

663                   Wares:                   Smokeless tobacco, snuff, tobacco powder, namely, snus.  
664                   Status:                   LIVE

665

666

667

**EXAMPLE NUMBER EIGHT**

**EXHIBIT-29**

668

(a)   Registration No.:   0730893

669

Registration Date:   May 1, 1962

670

Trade-mark:         DUTCH BOY

671

Registrant:         Ballantine Produce Co., Inc. DBA Ballantine Produce Co.,  
Corporation California, P.O. Box 185, Sanger, California.

672

673

Wares:             Fresh deciduous Fruits and Grapes.

674

Status:             LIVE

675

676

(b)   Registration No.:   1138549

677

Registration Date:   August 12, 1980

678

Trade-mark:         DUTCH BOY

679

Registrant:         Dutch Boy, Inc., Corporation Pennsylvania, 500 Central Ave.,  
Northfield, Illinois, 60093.

680

681

Last Owner:         SWIMC, INC., Corporation by assignment Delaware PO Box  
657, Newark, Delaware, 19715-0657.

682

683

Wares:             Paints.

684

Status:             LIVE

685

686

(c)   Registration No.:   2456418

687

Registration Date:   May 29, 2001

688

Trade-mark:         DUTCH BOY

689

Registrant:         Sherwin-Williams Company, The Corporation Ohio, 101  
Prospect Avenue, NW Cleveland, Ohio, 44115-1075.

690

691

Last Owner:         SWIMC, INC., Corporation Delaware, 300 Delaware  
Avenue, Suite 522, Wilmington, Delaware, 19801-1607.

692

693

Wares:             Applicators for clear and pigmented coatings used in the  
nature of paint, namely, brushes, roller covers and sponges.

694

695

Status:             LIVE

696           These cases are important because any Wal-mart, Zellers, A&P, Sobey's or other similar  
697 store retails tens of thousands of items directly to the public and as such may have web-sites, flyers,  
698 and even business reviews directly displaying or advertising, side by side, identically named products  
699 like those listed above. Yet despite this proximity these identical marks have not been found  
700 confusing. Consequently, reason guides us to the direct conclusion that the fields of commerce  
701 occupied by each of these respective group of marks are sufficiently disparate to avoid confusion  
702 despite their retail proximities.

703           Moreover, when compared to many of the examples detailed above the Defendant's wares  
704 and those listed in the Plaintiffs' registrations are much more polarized and so much less likely to be  
705 found confusing. That is because the Plaintiffs' marks provide wares that are essentially cosmetics  
706 whereas those of the Defendant's are products used for human sustenance. That is, the Plaintiffs'  
707 products cannot be substituted for the Defendant's to alleviate thirst and the Defendant's products  
708 cannot be substituted by the Plaintiffs as a cosmetic. In short, the Plaintiffs' wares, when compared  
709 to the Defendant's wares, cannot be used, combined, nor substituted for the same purpose or in  
710 the same employment, either directly or indirectly, thereby clearly making the Defendant's wares  
711 unique, unrelated and a remote product niche.

712           These observations, it is believe, leads to the conclusion that the third Dupont factor slightly  
713 favors the Defendant.

714  
715  
716           **Dupont Factor Number Four:**

717           The fourth Dupont factor looks at the sophistication of buyers and the conditions under  
718 which sales are made. If the reader begins by first looking at the respective wares in question the  
719 reader will be able to see that the Plaintiffs' wares are clearly directed to women. The Plaintiffs'  
720 advertising, promotion, displays, market positioning, persona, and the products themselves are all  
721 directed to the betterment of female beauty via cosmetics. As such, the Plaintiffs' clearly hopes to  
722 create a brand loyalty by which it can thereby establish a retail foundation to help it grow its retail  
723 cosmetic sales.

724           Consequently, the Defendant contends that the general public is not confused by the  
725 introduction into the market of the Defendant's mark and wares because consumers purchasing the  
726 Plaintiffs' wares are quite sophisticated and meticulous when it regards the purchasing of highly  
727 personal products such as cosmetics. These qualities, the Defendant believes, would also be  
728 consciously employed by the purchasing public when the wares of the Defendant are encounter in

729 a typical retail setting and therefore would be a state of mind that elicits non-confusion rather than  
730 confusion. That is, the consumer would recognize that the Defendant's wares do not originate from  
731 the Plaintiffs.

732 Consequently, it appears that the fourth Dupont factor slightly favors the Defendant as well.  
733

734  
735 **Dupont Factor Number Five:**

736 The fifth Dupont factor deals with the fame of the prior or senior mark(s). Fame, however,  
737 is not just a characteristic that does or does not exist. Rather, fame is a characteristic that varies  
738 along a spectrum from very strong to very weak. Moreover, it is an analysis that the Defendant  
739 believes should cover not only senior mark's present fame but also what its future fame may  
740 comprise. In other words, it should include not just what a mark is but what it might someday  
741 become.

742 With these thoughts in mind the Defendant begins this analysis by first looking at the senior  
743 marks in question and the respective wares included therein. What the Defendant sees in this body  
744 of evidence is that the marks are directed to traditional female beauty products, namely, cosmetics.  
745 The marks and wares also stem or are otherwise descendant from a roster of dead and abandoned  
746 marks which are also exclusively focused upon traditional female beauty products, namely,  
747 cosmetics. Consequently, on this first point the Plaintiffs' fame clearly is intrinsically and innately  
748 cosmetic.

749 The Defendant uses the term cosmetics as defined on page 514 of Webster's Third New  
750 International Dictionary (Unabridged), Published by Merriam-Webster Inc., Copyright 1993, ISBN  
751 0-87779-201-1 and which states:

752  
753 "Cosmetic: 2: a preparation (except soap) to be applied to the human body for  
754 beautifying, preserving, or altering the appearance of a person (as for theatricals) or for  
755 cleansing, coloring, conditioning, or protecting the skin, hair, nails, lips, eyes, or teeth."  
756

757 It is the Defendant's understanding that the Board may take judicial notice of dictionary  
758 definitions, including online dictionaries which exist in printed format. As such, this definition is  
759 applicable.

760 Second, the Defendant next looks to see how these marks and wares were promoted and  
761 finds that the advertising, promotions, displays, market positioning, persona, and the products

762 themselves are all directed to traditional cosmetic goods. Moreover, all the wares are also sold in  
763 forums traditional to that endeavour. In other words, the Plaintiffs have never made any attempt  
764 to extricate themselves from the traditional wares, advertising, promotions, displays, market  
765 positioning, persona and reputation associated with their cosmetics.

766 Third, the Defendant looks to see if the Plaintiffs have ever made an attempt to produce the  
767 wares of the Defendant. In this respect, the obvious answer is no.

768 Next, the Defendant looks to see if the Plaintiffs have ever made an effort to enter the  
769 Defendant's field of commerce. Again, the answer is no.

770 Consequently, the Defendant argues that the Plaintiffs' marks and wares are "**selectively**  
771 **famous**" and thus the fame associated with said marks is insufficient to traverse the chasm that  
772 separates the wares of the Plaintiffs from those of the Defendant.

773 The fifth Dupont factor, therefore, strongly supports the Defendant.  
774  
775

776 **Dupont Factor Number Six:**

777 The sixth Dupont Factor examines the number and nature of similar marks in the USPTO  
778 trademark registry and in commercial use. That is, if the industry is "crowded" with many similar  
779 marks for similar products then confusion would be less likely. A consumer would, in other words,  
780 be used to seeing different but similar marks for similar products and will not necessarily make the  
781 connection that the two different but similar marks must come from the same source.

782 To this end the Defendant refers the Board to Exhibit 12 of his "Notice of Reliance". Here  
783 the Board is able to see a company operating in the United States and which sells a variety of  
784 packaged foods under the name "OREAL" (Oreal in English) which is the exact same word as  
785 "L'OREAL" ("The Oreal" in English) because the word "L'" or "the" adds nothing to the distinctiveness  
786 or strength of a mark.

787 Thus, the Defendant contends that because such a product exists it supports the Defendant's  
788 position that confusion in the market is unlikely.

789 However, the Defendant also argues that if a mark is not arbitrary, fanciful or suggestive but  
790 rather descriptive by definition or geographical in origin than such marks, even a famous one, should  
791 not be able to obtain or otherwise achieve an ambit of protection normally conferred upon  
792 arbitrary, fanciful or suggestive marks. Bestowing an unwarranted level of protection to such marks  
793 would be tantamount to restricting the linguistic commons. For example, if a surname were to be  
794 initially registered on the secondary registry but over time allowed registration on the principle

795 registry its ambit of protection would still be selective. That is because bestowing such marks with  
796 an ambit of protection greater and broader than the fame earned or otherwise established from the  
797 respective goods sold would threaten the linguistic commons of the nation. In other words, the  
798 linguistic commons of a nation is something that cannot be appropriated or extrapolated over a  
799 broad commercial area but rather must be individually earned in each and every business sector  
800 because the linguistic commons inherently belongs to the nation.

801 As such, the Plaintiffs' marks are marks whose roots are based upon both a surname and  
802 proper name. Since such names are, by their very nature, part of the linguistic commons the  
803 Defendant contends that such marks may only aspire to or otherwise achieve "selective protection".

804 Thus, in the case herein before us the Plaintiffs' marks should be allowed an ambit of  
805 protection confined to cosmetics. In this way the Plaintiffs cannot monopolize the linguistic  
806 commons and so deprive the use of such marks to others unjustly.

807 In a manner of speaking, what the Defendant is really trying to say is that the sixth Dupont  
808 factor must not solely be judged upon the mere numerical superiority of a registrant's stable of  
809 marks but the strength, character, and quality of those marks must also be adjudicated in any proper  
810 analysis of the sixth Dupont factor.

811 With these thoughts in mind, it appears that the sixth Dupont factor supports the Defendant.  
812  
813

814 **Dupont Factor Number Seven:**

815 The seventh Dupont Factor looks at actual confusion. That is, has there been any actual  
816 instances of confusion by consumers regarding the marks in question. If so then this would suggest  
817 that the marks are confusingly similar.

818 However, since the progress of the Defendant's mark has only reached the oppositional  
819 phase on its journey to registration, there is no relevant body of evidence upon which to draw upon  
820 in order to properly analyze or investigate any actual confusion that may have been experienced.

821 Consequently, the Defendant holds that this factor is also a draw neither supporting the  
822 Defendant nor the Plaintiffs.  
823  
824

825 **Dupont Factor Number Eight:**

826 The eighth Dupont Factor seeks to examine the length of any concurrent use, between two  
827 marks, without actual confusion. In other words, if two marks have been in use at the same time

828 over an extended period and there have been no instances of actual consumer confusion then this  
829 is an indication that the marks are not in fact confusingly similar.

830 However, since the progress of the Defendant's mark has only reached the oppositional  
831 phase on its journey to registration, there is no relevant body of evidence upon which to draw upon  
832 in order to properly analyze or investigate any actual confusion that may have been experienced  
833 during a time of concurrent use.

834 Consequently, the Defendant, once again, holds that this factor is a draw neither supporting  
835 the Defendant nor the Plaintiffs.

836

837

838 **Dupont Factor Number Nine:**

839 The ninth Dupont Factor assesses the variety of goods on which a mark is used. Thus, if a  
840 mark is only used on one type of goods, cosmetics for example, it is less likely that a consumer will  
841 believe that a different type of goods is made by the same business, even if the trademark is similar.  
842 In contrast, if a mark is used on a wide variety of goods confusion may be more likely as a consumer  
843 will more readily believe that a different type of product is made by the same company. This  
844 concept is similar to what the Defendant refers to as "selective fame" and is a fame that, the  
845 Defendant believes, justly applies to the Plaintiffs' marks and wares as well.

846 Thus, by applying these guideline to the case at hand the evidence suggests that confusion  
847 is unlikely for the simple reason that the Plaintiffs' only field of business is cosmetics and they have  
848 never ventured outside this domain. If then, the disparity of the wares are also factored in along  
849 with the fact that the Plaintiffs' advertising, promotion, displays, market positioning, persona, and  
850 the products themselves are all directed to cosmetics it becomes increasing clear that confusion  
851 would be highly unlikely.

852 Additionally, this narrow and ultra small focus of the Plaintiffs' business model arguably  
853 constrains their capacity for growth into other fields of commerce.

854 The evidence therefore suggests that this Dupont factor highly favors the Defendant.

855

856

857 **Dupont Factor Number Ten:**

858 The tenth Dupont Factor asks whether any market interface has occurred between an  
859 applicant and the owner of a prior mark. That is, has the prior owner consented to the use of the  
860 other mark owner? If so, this may suggest a lack of confusion.

861 Alternately, a second question would ask whether they have agreed to take steps to  
862 minimize the potential confusion for consumers by, for example, agreeing to continue using each  
863 mark only for certain goods, or in certain areas, or with certain marketing limitations? If so, this may  
864 help to avoid confusion but it could also indicate the possibility for such confusion.

865 Yet another question would inquire whether the prior owner failed to take steps to prevent  
866 the other owner from registering or using the mark? That may indicate a lack of confusion as well.

867 Thus, in regards to these questions there has been no dialogue between the parties herein  
868 save to say that the last question posed above has been clearly answered via the opposition herein  
869 commenced by the Plaintiffs.

870 However, while the Plaintiffs have initiated an opposition to the Defendant's mark the  
871 Defendant believes that the Plaintiffs would have initiated an opposition against any other application  
872 utilizing the word "L'OREAL". As such, even this third point actually remains unanswered.

873 Consequently, this Dupont factor also points to a draw due to the lack of evidence.

874  
875  
**Dupont Factor Number Eleven:**

876 The eleventh Dupont factor investigates the right of the applicant to exclude others. In  
877 other words, does the applicant have a long-standing and well-known trademark associated with  
878 a specific type of goods? This may weigh in favor of finding no confusion and allowing registration  
879 of the application, to avoid the confusion that would result from others taking advantage of the  
880 applicant's goodwill and inability to protect their trademark.

881 However, since the Defendant mark is but an intent-to-use application and thus no historical  
882 past associated with the goods found in said application there is really no reason to apply this  
883 Dupont factor to this opposition proceeding.

884 As such, this Dupont factor does not add any additional support to either side and thus  
885 should be considered a draw.  
886

887  
888  
**Dupont Factor Number Twelve:**

889 The twelfth Dupont factor seeks to explore if any confusion is likely to be "de minimus", or  
890 otherwise minor and unimportant. It also looks to see if there will be substantial or material  
891 confusion that can cause real problems. In other words, this factors seeks to establish whether or  
892 not consumers will believe that they will be getting one thing but instead get another.  
893

894 In this respect, the Defendant believes that any confusion arising out of his future commercial  
895 activities will be minor and unimportant if not nonexistent. This conclusion is justly derived from the  
896 fact that the Defendant's mark is different from those of the Plaintiffs', the Plaintiffs' marks are not  
897 highly distinctive, the goods of the parties herein are extremely disparate, the fame of the Plaintiffs'  
898 marks being selectively famous of or otherwise confined to, women's cosmetics, and the fact that  
899 the Plaintiffs have never venturing outside their current business activities or field of commerce.

900 It is therefore held that these factors would not cause consumers to believe or to think that  
901 they would be getting something other than that presumed purchased.

902 Consequently, the Defendant contends that this Dupont factor favors the Defendant and not  
903 the Plaintiffs.

904

905

906

**Dupont Factor Number Thirteen:**

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The thirteenth Dupont factor investigates whether there are any other established facts probative of the effect of use. In this respect, the Defendant refers the Board to the evidence provided in Exhibits 13-15 of the Defendant's Notice of Reliance.

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Beginning with Exhibit-13, the reader is clearly able to see the Plaintiffs' main internet site the address of which is "www.loreal.com". From this site the address of the company's headquarters is listed, namely, L'Oreal International, 41, Rue Martre, 92217 Clichy Cedex France, 33 1 47 56 70 00, along with various other sections such as "Our Company", "Brands", "Careers", etc., etc..

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Exhibit-14, on the other hand, lists and details all of the Plaintiffs' live registrations. It also lists related applications. However, as stated before above, only three registrations predate the Defendant's filing date. Nonetheless, even if these other registered marks are analyzed the reader will note that every last one deals exclusively with cosmetics save for the mark "L'OREAL E-STRAT CHALLENGE" which deals with advertising, advertising services, and education services. Consequently, these other marks do not expand the ambit of protection beyond cosmetics as the Defendant has argued in detail above.

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923

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926

Referring now to Exhibit-15, the reader is provided with a extensive selection of the Plaintiffs' goods as sold in Wal-Mart stores throughout the United States. In these excerpts the reader should note the marks listed in Exhibit-14 being used on the wares shown in Exhibit-15. But the reader should also note that in each and every ware listed in Exhibit-15 the word "PARIS" also appears below the registered mark. This observation is of great importance because any mark

927 which is inherently geographical is given only a minimal ambit of protection.

928         The Defendant therefore believes that the Plaintiffs' know this and so have tried to obscure  
929 this geographical fact by registering marks devoid of the word "PARIS" in order to garner a greater  
930 ambit of protection. Later the Plaintiffs' add the geographical designation or reference known as  
931 "PARIS" to the goods in order to boost the significance of the wares origins. Said origin is, in fact,  
932 the city of Paris, France and said city is a world famous center of both fashion and cosmetics. It is  
933 not, however, a world famous center of aloe vera drinks.

934         Thus, what the Plaintiffs' are trying to do is to have their cake and eat it to. In other words,  
935 they claim their marks to be strong, unique, and famous yet add a geographical designation to their  
936 goods covertly. It is a designation, the Defendant contends, that will materially influence a  
937 substantial portion of the relevant consumers to purchase the Plaintiffs' products or services by the  
938 geographic meaning of the mark.

939         The Defendant further believes that such attempts to circumvent the fundamental spirit of  
940 trademark law should not be encouraged. Consequently, the Defendant believes that when a mark  
941 is registered on the principal registry devoid of geographical interpretations yet geographical  
942 meanings are later attached to these same wares in order to boost the significance of the wares  
943 origins then those registrations should be considered geographical and so apportioned a much  
944 smaller ambit of protection than would otherwise be had.

945         Therefore, it is submitted that the thirteenth Dupont factor favors the Defendant and not  
946 the Plaintiffs.

947

948

#### 949         **Summarization of the Dupont Factors**

950         The thirteen Dupont factors have now been reviewed and the resulting sum of evidence  
951 squarely favors the Defendant. That is, most of the Dupont factor either strongly or slightly support  
952 the Defendant's case with all others resulting in a draw. Consequently, the preponderance of the  
953 evidence supports the conclusion that the Defendant's mark and goods are not confusing with the  
954 Plaintiffs' marks and goods and is therefore registrable.

955

956

#### 957         **Other Factors of Notable Importance**

958         To begin, the reader will kindly refer to Exhibit-19 in the Defendant's "Notice of Reliance".  
959 Here the reader will find a complete roster of all of the Defendant's trademark applications both

960 live and dead.

961           Second, the Plaintiffs have accused the Defendant in their "Trial Brief" of having a history and  
962 pattern of filing intent-to-use applications for famous marks owned by others, such as "HEINEKEN",  
963 "JACK DANIEL'S", "CHANEL", "BAYER", "ABSOLUT", "BUDWEISER", and "EVIAN", among others,  
964 and lacks a bona fide intent to use the "L'OREAL PARIS" mark in commerce.

965           In response to these accusations the Defendant presents the reader with Exhibits 20 and 21  
966 of his "Notice of Reliance" which detail the past commercial activities of the Defendant's "L'OREAL  
967 PARIS" and other marks.

968           The reason for the presentation of this evidence stems directly from the provisions of the  
969 Trademark Act which states that an applicant must have a bona fide intent to use the mark in  
970 commerce in the ordinary course of trade, and not merely to reserve a right in a mark. However,  
971 the determination of whether an applicant has a bona fide intention to use the mark in commerce  
972 is to be a fair, objective determination based on all the circumstances.

973           As such, the determination of whether the applicant had the requisite bona fide intent to use  
974 the mark is to be based on objective evidence of such intent. The applicant's mere statement of  
975 subjective intention, without more, would be insufficient to establish the applicant's bona fide  
976 intention to use the mark in commerce.

977           However, in this determination the opposer has the initial burden of demonstrating by a  
978 preponderance of the evidence that the applicant lacked bona fide intent to use the mark on the  
979 identified goods. If the opposer meets this initial burden of proof, the burden of production shifts  
980 to the applicant to rebut the opposer's prima facie case by offering additional evidence concerning  
981 the factual circumstances bearing upon its intent to use its mark in commerce.

982           One way in which an opposer can establish its prima facie case of no bona fide intent is by  
983 proving that the applicant has no documentary evidence to support its allegation in the application  
984 of its claimed bona fide intent to use the mark in commerce as of the application filing date.

985           Thus, if the opposer makes out its prima facie case by showing that the applicant lacks  
986 documentary evidence to support its allegation of bona fide intent the burden shifts to the applicant  
987 to come forward with evidence which would adequately explain or outweigh his failure to provide  
988 such documentary evidence.

989           Applying these principles to the present case the reader will find that the information  
990 presented in Exhibit-21 displays a number of dead trademark applications. These first four in  
991 particular are of notable interest and include the marks "NUTRADENT", "ABSOLUTWATER",  
992 "ABSOLUT WATER", and "ROCKLIN". If now the reader will turn to Exhibit-21 these four marks

993 will help to determine the Defendant's true bona fide intent.

994 Beginning with the mark "NUTRADENT" the reader will notice that the Defendant not only  
995 invented and patented a number of new dental flosses but also tried to commercialize them. Much  
996 time and effort was expended in setting up prototypes for production and logistical frameworks  
997 were started. However, the Defendant could not arrange the final production runs of the product  
998 because there was no interest in any of the manufacturing entities contacted to produce the  
999 product. This also proved to be the case in the other wares listed therein.

1000 However, when the Defendant submitted the dental floss patents to Johnson & Johnson,  
1001 Johnson & Johnson began producing, what they say, was a brand new and innovative floss not tied  
1002 to the Defendant's patents.

1003 In any case, the amount of work, time, and money spent on the project was substantial  
1004 though fruitless.

1005 In the next case or those regarding the marks "ABSOLUTWATER" and "ABSOLUT WATER"  
1006 the process reached critical mass in that the Defendant actually designed a original bottle, had molds  
1007 made, designed a label, sourced two bottlers and a bottle maker, set up the logistical network  
1008 required with distributors and retailers and finally succeeded in selling product. Unfortunately, V&S  
1009 Vin Sprit Aktiebolog of Sweden challenged the Defendant in Federal Court to stop his commercial  
1010 activities. The Defended had to stop even though his marks had been approved by the Canadian  
1011 Intellectual Property Office.

1012 In this case, as in the one before, the amount of work, time, and money spent on the project  
1013 was even more but still fruitless.

1014 In the last case, namely, the "ROCKLIN" mark the Defendant designed and patented an  
1015 entirely new fuel supply system for small internal combustion engines that reduced environmental  
1016 pollution, increased durability, and increased torque.

1017 Though no actual prototypes were made there was substantial interest from states like  
1018 California. However, not a single small engine manufacturer showed any interest. This may have  
1019 been due to the possibility, as General Motors said in its letter, that any improvements realized by  
1020 a new engine design would have become mandated by California. This would have resulted in the  
1021 forced conversion of existing factories to the new design and most likely is a situation undesirable  
1022 to current small engine manufacturers. Thus, if the design remained uncommercialized this forced  
1023 conversion would not happen.

1024 As a result, the Defendant then tried to go public on the pink sheets with a brand new  
1025 company called "ROCKLIN". The pink sheets are a forum for small companies to go public in order

1026 to raise funds to expedite the commercialization of new ideas and inventions or to raise capital for  
1027 existing operational requirements. In any event, this venue also proved fruitless.

1028 Finally, if the reader looks to Exhibit-20 the reader will notice that there are a number of  
1029 "aloe vera" manufacturers listed therein. Many of these companies produce packaged aloe vera juice  
1030 and are willing to make "private label" products for individual companies with business interest like  
1031 those of the Defendant. This is a course of action which the Defendant is clearly able to pursue and  
1032 would provide an inexpensive starting point for any product launch. Moreover, this is a means of  
1033 commercialization not unknown to the Defendant for it is, in fact, the very way he first  
1034 commercialized wares utilizing his "ABSOLUT WATER" mark in Canada.

1035 Since the Defendant has approximately one year to commercialize his product in order to  
1036 complete the registration process the Defendant felt that he did not need to fully undertake the  
1037 time, effort, and high cost associated with this undertaking until the opposition against his mark,  
1038 initiated by the Plaintiffs herein, had been dismissed.

1039 Thus, what these exhibits have unequivocally and resoundingly demonstrated is that in each  
1040 and every trademark application in which the Defendant has been granted allowance he has  
1041 vigorously pursued commercialization. Moreover, these commercialization efforts were always  
1042 conducted in a forthright manner utilizing business practices commonly found and accepted  
1043 throughout the United States and the world. These actions, therefore, are not the actions of an  
1044 applicant without bona fide intent but rather are the actions of an applicant whose motives are  
1045 genuine, sincere, and honest for the applicant has consistently proceeded in a course of action that  
1046 is logical and reasonable, obeying all current trademark regulations as written and intended instead  
1047 of dishonestly pursuing commercialization via fraudulent, dishonest or unethical means.

1048 Consequently, the Plaintiffs' charge that the Defendant lacks any bona fide intent to use the  
1049 applied for mark "L'OREAL PARIS" in commerce is a charge without foundation or merit and thus  
1050 should be rightfully dismissed from any further consideration.

1051 The next point that the Defendant wishes to make is that of trademark abandonment. The  
1052 is, if the owner of a mark ceases to use the mark without an intent to resume use in the reasonably  
1053 foreseeable future, the mark is said to have been "abandoned". Once abandoned, a mark returns  
1054 to the public domain and may, in principle, be appropriated for use by others in the marketplace in  
1055 accordance with the basic rules of trademark priority. Thus, once held abandoned, a mark falls into  
1056 the public domain and is free for all to use. While acquiescence may bar suit against one person,  
1057 abandonment opens rights to the whole world. Abandonment paves the way for future possession  
1058 and property in any other person.

1059           A trademark is abandoned when its use has been discontinued with intent not to resume  
1060 such use. In this respect, case law requires a showing of: (1) non-use by the legal owner; and (2)  
1061 no intent to resume use in the reasonably foreseeable future by the legal owner. Three consecutive  
1062 years of non-use creates a presumption that the legal owner intended not to resume use. This  
1063 presumption may be rebutted with evidence of either actual use or an intent to resume use but the  
1064 ultimate burden of proof remains always on the party claiming a mark has been abandoned.

1065           In this case, the evidence is most favorable to the Defendant. The reason being is that the  
1066 Plaintiffs have basically abandoned the use of the word "PARIS" within the stable of their marks save  
1067 one. Thus, even though the mark "L'OREAL PROFESSIONNEL PARIS" (Registration No. 3668568)  
1068 exists today its filing dated of August 12, 2008 does not predate the Defendant's filing date.  
1069 Moreover, current mark is different from the original and so seems to be an attempt to continue  
1070 the original filed December 19, 1996 (Registration No. 2200948) and not abandoned as of August  
1071 6, 2005. Since a period of time of greater than three years have passed the Defendant contends that  
1072 the original mark was abandoned without intent to resume commercial use. The original mark  
1073 "L'OREAL PROFESSIONNEL PARIS" was then modified and resubmitted. However, due to the fact  
1074 that the original mark was abandoned and its replacement modified from the original mark the  
1075 Defendant maintains that this new filing should be treated as a new mark altogether. Since this new  
1076 mark does not predate the Defendant's filing date this mark, namely, the mark "L'OREAL  
1077 PROFESSIONNEL PARIS", Registration No. 3668568, filed August 12, 2008 should not be given any  
1078 legal consideration as it does not predate the Defendant's filing date.

1079           It is also interesting to note that during the prosecution of the "L'OREAL PROFESSIONNEL  
1080 PARIS" mark filed August 12, 2008 and detailed above the Defendant's mark for "L'OREAL PARIS"  
1081 was still alive and in force. Since the Plaintiff's mark was eventually approved and duly registered  
1082 there must have been no confusion found by the trademark examiner assigned to the case. The  
1083 Defendant therefore postulates that because the assigned examiner did not find any conflicts  
1084 between the Defendant's mark and the submitted mark "L'OREAL PROFESSIONNEL PARIS" then  
1085 the Defendant's mark is not confusing with any of the Plaintiffs' other marks as well since the  
1086 Plaintiffs' other marks are even more different than the one referenced herein.

1087           Second, the Defendant has also noticed that every other mark belonging to the Plaintiffs'  
1088 which possessed the word "PARIS" has been abandoned. This marks include, but are not limited  
1089 to: "L'OREAL PARIS", Serial No. 77099987, filed February 6, 2007, abandoned March 1, 2007;  
1090 "L'OREAL PARIS LE LOUNGE", Serial No. 76473840, filed December 11, 2002, abandoned  
1091 February 18, 2005; "L'OREAL PARIS VIVE", Serial No. 76527427, filed June 24, 2003, abandoned

1092 August 4, 2008.

1093 While all of these abandoned marks clearly show the Plaintiffs' disinterest in the "L'OREAL  
1094 PARIS" connotations the reader should take note that the only mark which the Plaintiffs' possessed  
1095 that was identical to the mark of the Defendant was abandoned. Thus, as the Defendant has noted  
1096 above such marks are free to be acquired by any other person because acquiescence may bar suit  
1097 against one person, abandonment opens rights to the whole world. Abandonment thus paves the  
1098 way for future possession and property in any other person.

1099 Consequently, the Defendant believes that such widespread abandonment by the Plaintiffs  
1100 of marks utilizing the word "PARIS" strongly supports the Defendant's position that his mark is  
1101 registrable.

1102 The last point which the Defendant wishes to make regards the Defendant other applied for  
1103 marks which the Plaintiffs have submitted to the Board for review. The Plaintiffs' have emphatically  
1104 stated "Registration should be refused because consumers are likely to be confused, the L'OREAL  
1105 Marks are likely to be diluted, and because Applicant, who has a history and pattern of filing intent-  
1106 to-use applications for famous marks owned by others, ...".

1107 However, the only relevant entries are those associated with the subject of this opposition  
1108 proceeding. That is, only those references dealing with the Defendant's application for the intent-  
1109 to-use mark "L'OREAL PARIS" should be given any consideration. All other references are really  
1110 immaterial or otherwise extraneous to the present case and should therefore be disregarded for  
1111 they principally detail the Defendant's other trade-mark applications and other unrelated matters  
1112 not germane to the proceedings herein, namely, whether or not the Defendant's intent-to-use  
1113 proposed mark "L'OREAL PARIS" is or is not registrable.

1114 Moreover, the fact that the Defendant has filed multiple trade-mark applications for various  
1115 wares and services is not prohibited by the Trademark Law nor does it by itself constitute evidence  
1116 that the Defendant does not intend to use the marks, wares, and services applied for respectively.  
1117 If the Board takes into account the time, effort, and money spent upon each and every mark that  
1118 the Defendant has been approved for the Plaintiffs' arguments fall flat.

1119 Moreover, one must also realize that while on the one hand, well-known mark owners may  
1120 say that people should not reap where they have not sown, that bad faith should be punished, that  
1121 people who sidle up to their well-known marks are guilty of dishonest commercial practice.  
1122 **However, these vituperations lead nowhere because one might as well say that the well-**  
1123 **known mark owner is reaping where it has not sown when it stops a trader in a**  
1124 **geographic or market field remote from the owner's field from using the same or a similar**

1125 **mark uncompetitively."**

1126 In this light the Defendant believes that the proper course for any trademark applicant is to  
1127 obey the law as written. That law states that any person or business entity who feels that they are  
1128 entitled to a mark may apply to the United States Patent and Trademark Office (USPTO) for  
1129 registration. If in that course of action the USPTO finds the mark without merit registration will be  
1130 refused. If, however, the mark is found to be deserving of registration that right will be  
1131 appropriately given. To say that the mere act of applying for a trademark, even a plurality of them,  
1132 when the applicant has followed not only the letter of the law but the spirit therein is to  
1133 malevolently suppress the commercial rights of the nations citizenry.

1134 In other words, no trademark holder has ever been harmed by a trademark application and  
1135 the mere act of doing so does not constitute a collateral attack on any existing mark. That is  
1136 because any intent-to-use application granted registration, by definition, could never diminish nor  
1137 compromise the present value found in any other existing trademark because if it did it would not  
1138 have been granted registration.

1139 In any event, the Defendant maintains that these other referenced marks belonging to the  
1140 Defendant do not provide any meaningful debate nor do they add any fitting examples regarding the  
1141 registrability of the Defendant's proposed mark "L'OREAL PARIS". As such, this body of evidence  
1142 should be dismissed or otherwise removed from the Board's consideration.

1143

1144 **CLOSING REMARKS**

1145 In the end, one must therefore ask whether the evidence and legal arguments submitted by  
1146 the Plaintiffs herein are sufficiently sound to deny the registration of the Defendant's applied for  
1147 mark. In the Defendant's view, the answer is no because the Plaintiffs' case does not reach the  
1148 threshold required to support a finding of confusion or a lack of bona fide intent. Moreover, the  
1149 Defendant believes that he has successfully argued that this opposition is without merit and should  
1150 therefore be removed. Consequently, the Defendant respectfully requests the removal of said  
1151 opposition and the allowance of his mark "L'OREAL PARIS".

1152 Very respectfully,

1153 

1154 Robert Victor Marcon,

1155 Applicant Pro Se,

1156 22 December 2010

1157