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

Proceeding	91184456
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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**

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

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PRELIMINARY STATEMENT

Were it not for the immeasurable harm that would befall Opposer were the Board to allow Applicant to obtain a registration for L'ORÉAL PARIS for aloe vera drinks, Opposer would be content to rely on the record and its trial brief. Applicant provides nothing in its notice of reliance or brief that would justify dismissal of L'Oréal's notice of opposition or grant of a registration to Applicant. However, because Applicant attempts to pirate L'Oréal's very house mark, a few critical points are worth highlighting.[1]

- Applicant utterly ignores L'Oréal's common law rights in its L'ORÉAL PARIS mark, established over decades of exclusive and continuous use, billions of dollars spent in advertising and promoting the mark and billions of dollars in sales under the mark, all resulting in enormous consumer recognition and good will.
- Applicant has provided no material record evidence and does not even attempt to tie his baseless arguments to the record. His personal, subjective views, presented as argument, cannot substitute for record evidence and must be disregarded.
- Applicant completely fails to address the likelihood of dilution that his applied-for mark would create.
- Applicant filed an unrestricted application, but now argues for a redefined scope of goods, consumers and channels of trade.
- Applicant's arguments regarding his claimed *bona fide* intent to use are legally and factually deficient.

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[1] Applicant's brief should be rejected in its entirety for failing to follow the requirement that it be double-spaced. 37 CFR §2.126(a)(1). Due to that failure, it is not known whether Applicant honored the page limitation requirement.

ARGUMENT

A. Opposer's Common Law Rights

It is not clear whether Applicant does not fully appreciate L'Oréal's common law rights, or simply has no response to them. Applicant's failure to deal with them, however, will not make them go away.

Applicant takes a position as if L'Oréal's common law use of L'ORÉAL PARIS never happened. His trial brief completely ignores L'Oréal's common law rights in L'ORÉAL PARIS and instead selectively addresses three registrations for L'ORÉAL. The Board is respectfully referred to pages 3-10 of Opposer's Trial Brief ("Opp. Trial Brief") and the references to the record cited therein for the overwhelming showing of fame, strength, consumer recognition, advertising, promotion and sales that L'Oréal has made of its L'ORÉAL PARIS mark.[2] Applicant fails to address those and other facts in the record that establish L'Oréal's common law rights to the L'ORÉAL PARIS mark -- rights that are at the heart of this opposition proceeding.

Applicant also erroneously alleges that L'Oréal abandoned the L'ORÉAL PARIS mark, contained in Serial No. 77099987. Applicant's Trial Brief ("App. Trial Brief"), 33. In fact, the abandoned application to which Applicant refers was for a specific container design, which also happened to display the L'ORÉAL PARIS word mark. That abandoned application is for a specific product package design and does not affect L'Oréal's common law rights in its L'ORÉAL PARIS word mark. L'Oréal has never abandoned its L'ORÉAL PARIS mark. To the contrary, the record demonstrates that over a period of decades L'Oréal has expended enormous resources continuously promoting and using L'ORÉAL PARIS, and has generated billions of dollars in sales as a result.

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[2] If by failing to address L'Oréal's rights in L'ORÉAL PARIS, Applicant believes he nonetheless can distinguish his mark from L'ORÉAL simpliciter, his belief is misguided. There is and can be no record evidence that the two are not viewed as identifying the same source, namely, Opposer.

Opp. Trial Brief, 4. Applicant has failed to refute L'Oréal's common law rights in L'ORÉAL PARIS.

B. Applicant Has Failed To Address The Likelihood Of Dilution

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. Opp. Trial Brief, 25-27. Nowhere in Applicant's submissions does he even attempt to refute the fact that the applied-for mark is likely to dilute by blurring the distinctiveness and strength of Opposer's L'ORÉAL and L'ORÉAL PARIS marks. Because Applicant's and Opposer's marks are identical, and in light of the distinctiveness, fame and exclusive use of the L'ORÉAL and L'ORÉAL PARIS marks by Opposer, and the clear showing of Applicant's intention to create an association between his and Opposer's mark, the application in question should be rejected on the basis of likelihood of dilution. *Id.*

C. Applicant Filed An Unrestricted Application

Many of Applicant's arguments are made as if his application were restricted as to channels of trade and class of customer. It is not. Accordingly, as a matter of law, Applicant's goods must be presumed to travel in all channels customary for such goods and to be sold to all customers who purchase such goods. Opp. Trial Brief, 18-20. When that is done, there is enormous overlap in, if not identity of, where and to whom the parties' respective goods are sold. *Id.*

D. Applicant Has Failed To Demonstrate A *Bona Fide* Intent To Use

As a matter of law, *i.e.*, based on controlling precedent, Applicant has failed to establish a *bona fide* intent to use the subject mark as of the date his application was filed. He has stated under oath that, as of the date he filed his application, no documents existed that would

demonstrate such an intent. None -- no marketing plans, no business plans, no advertising plans, no manufacturing plans, no trademark searches, no supplier agreements -- nothing. *Id.* at 22-25.

Moreover, Applicant admits that he has no industry-relevant experience in producing or selling aloe vera drinks. *Id.* at 24, n. 16. He merely points out, years after filing his application, that there are producers of aloe vera that he might choose to contact some undetermined time in the future. *Id.* at n. 18; App. Trial Brief, 32. His conduct is legally deficient to satisfy the requirement of *bona fides.*

Whether Applicant's motivation is that of a trademark pirate or of a self-proclaimed critic of the U.S. legal system, intent on making a mockery of U.S. statutes and regulations, viewing his conduct objectively and in the context of all the surrounding circumstances leaves him far short of the *bona fides* and good faith necessary to obtain a registration based on an intent to use. *See* Opp. Trial Brief at 22-25.

E. Applicant's Analysis Of The *DuPont* Factors Is Misguided

Applicant's trial brief contains a section on each of the *DuPont* factors. His arguments are strained and lack record evidence to support them. Many are wrong as a matter of law.

For ease of reference, Applicant's arguments regarding each of the factors is addressed below.

1. Similarity in appearance, sound, connotation and commercial impression

Applicant goes through linguistic gymnastics in an effort to convince this Board that the parties' marks (Opposer's L'ORÉAL and L'ORÉAL PARIS versus Applicant's L'ORÉAL PARIS) somehow are different. His arguments concerning elision, common translation and understanding, foreign equivalents and surname are tortured, baseless and illogical, and have no

support in the record.[3] For example, Applicant's claim that L'Oréal is no different from Bob's, Mac's or Jim's is not easy to follow, especially after he acknowledges that Opposer has established secondary meaning in L'ORÉAL. *See* App. Trial Brief, 10-11.

2. Similarity of Goods

In this age of conglomerates, mergers and acquisitions, as well as considering what constitutes related goods in a world of constant change, Applicant's definition, that goods must be able to be substituted, used with or used for the same purpose in order to be considered related, has no legal basis and must be rejected.[4] The simple fact is that aloe vera used in, for example, L'Oréal's skin care products and to be used in Applicant's drinks are much more closely related than his juice and cereal examples. Opp. Trial Brief, 16-18.

3. Trade Channels

The Board is respectfully referred to the application at issue, Opposer's Trial Brief at 18-20, and page 3, supra. Applicant's application is unrestricted as to trade channels and class of purchaser. He first argues that his aloe vera drinks are likely to be sold in the same stores that carry L'Oréal's products. He than predicts that the parties' respective products will not be sold side-by-side, and then argues that this equates to no likelihood of confusion. His logic and argument are contrary to law[5].

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[3] No matter how many times one reads Applicant's brief, one cannot make sense of his "The Oreal" argument.

[4] "Related goods are those 'products which would be reasonably thought by the buying public to come from the same source if sold under the same mark.'" *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 37 (2d Cir. 1945). "The goods . . . do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. . . . The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source." TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1207.01(a)(i) (5th ed. 2007) (citing *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404 (C.C.P.A. 1975).

[5] See *Paco Rabanne Parfums, S.A. v. Norco Enters., Inc.*, 680 F.2d 891, 893 (2d Cir. 1982) ("[I]t is well established that products need not be sold side by side for a plaintiff to show that there is a likelihood of confusion"); *Sally Beauty Co., Inc. v. Beautyco, Inc.*, 304 F.3d 964, 974 (10th Cir. 2002) (holding that where parties have similar or competing products marketed to consumers through

Applicant's various examples at pages 13-22 of his trial brief may not be relied on by the Board inasmuch as the record does not establish whether the various cited trademark owners (of the same mark) are affiliated, related, are party to a license agreement, or are otherwise acting with consent of the other(s).

4. Purchase Conditions (impulse v. careful)

Applicant argues that L'Oréal's customers are sophisticated. By doing so, Applicant addresses the wrong audience. The pertinent question is whether *prospective purchasers of Applicant's goods* are likely to be confused. He then argues that since *he believes* L'Oréal's customers are sophisticated, the same level of care should be attributed to all members of the general purchasing public (presumably, his prospective purchasers). There is nothing in the record regarding the level of sophistication of the relevant class of purchasers. Because the subject application is unrestricted, there is overlap, if not identity, between the classes of customers of the respective parties. Even under Applicant's theory, one class (L'Oréal's) is wholly subsumed within the other (Applicant's).

5. Fame

Applicant does not even attempt to refute the fame of L'Oréal's marks. Under some theory with which L'Oréal is not familiar, Applicant argues that fame can vary from "very strong to very weak." It is not clear what constitutes very weak fame. Applicant also argues that fame should not be measured now, but what it may become. Applicant's arguments may be unique, but they are unavailing. His argument of how fame is affected by the goods with which the mark is used has been addressed at factor 2, above, at page 5.

6. Similar Marks Used on Similar Goods

L'Oréal's use has been *continuous* and *exclusive* for 50 years in the United States, and for 100 years worldwide. There is nothing in the record, as there cannot be, that refutes that.

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similar commercial channels, the "relatedness of goods" factor weights in favor of the senior trademark owner, *even where the parties' products do not compete in the same retail outlets*).

Applicant now claims there is a packaged foods company doing business in the United States under the name "Oreal" (as if that would matter even if true). There is no evidence in the record that anyone uses that name.

7. Actual Confusion

8. Concurrent Use

Applicant presents no argument on these factors.

9. Variety of Goods on Which mark is Used

Applicant reverts to his "selective fame" argument and claims L'Oréal's only use is on "cosmetics" as if "cosmetics" is a single product. At the outset, Opposer points out that L'ORÉAL PARIS is Opposer's house mark. It appears on the hundreds of different products sold under the company name. See Opp. Trial Brief, 3-10, for the magnitude of use and the sales generated under that mark.

10. Market Interface

Applicant is attempting to misappropriate L'Oréal's mark without permission.

11. Applicant's Right to Exclude Others

Applicant has no right, and can have no right, in the mark, and has no right to exclude others. This factor also begs the question of why Applicant referenced OREAL packaged foods, and whether that reference precludes Applicant's registration and calls into question the legitimacy of the oath accompanying his application.

12. Extent of Potential Confusion

Among Applicant's reasons for arguing that confusion is likely to be *de minimis* is that the parties' marks are different. It is not obvious what Applicant is looking at when making that argument. He provides no basis or reason why every single unit he would sell would not be

perceived as emanating from L'Oréal. Opposer is unaware of any legal doctrine that excuses confusion simply because it is caused by a small producer.

13. Other

Throughout its brief Applicant conflates registration with use. He does so with respect to L'Oréal's basis for this opposition; he does so with respect to non-use or what he calls "abandonment." Whether based on a misunderstanding of the facts and law, or based on an intentional tactic, Applicant may not convert this proceeding into one involving 3 of Opposer's registrations only, while ignoring 50 years of continuous and exclusive use. L'Oréal has the right to rely, and relies, on its common law rights as well as on its registrations. Moreover, just because one of its marks contains the word "Paris" does not, 50 years later, render it merely geographical.

With respect to Applicant's *bona fide* intent and good faith, Applicant argues that the Board should ignore his other efforts to register marks owned by others, but fails to explain why such conduct, also exhibited in this proceeding, does not bear on his *bona fide* intent. It does, and quite negatively. Applicant presents nothing to distinguish this proceeding from the others (regarding *bona fides*) and comes up with no objective or documentary evidence as of the application filing date that supports a *bona fide* intent to use L'ORÉAL PARIS for aloe vera drinks.

In his effort to justify his actions with respect to the other known marks he attempted to register, Applicant does not point to a single instance of documenting his intent *on or before* the filing date of his application. His claim that "there was no interest in any of the manufacturing entities contacted to produce the product" should be viewed as code for no one wanted to expose himself to a claim of trademark infringement. Indeed, in one case (ABSOLUT), Applicant was sued.

Applicant's reference to a public listing of aloe vera suppliers is irrelevant and, at best, is too little too late. By his own sworn admission, he had not contacted anyone to advance his

aloe vera drink project as of the date of his application. Opp. Trial Brief, 24 n. 17. The chronology of events, even if accepted, is fatal to his position. Coming up with a non-descript, public list, produced for the first time with a notice of reliance, is insufficient.

Applicant points to certain trademark applications that were not pursued to registration as the basis for his argument that L'Oréal had abandoned L'ORÉAL PARIS. Nothing could be further from the truth. As a matter of law his definition of abandonment is just plain wrong. Applicant conflates abandonment of an application which, of course, is without prejudice, with abandonment of use of a mark. In addition to its various L'ORÉAL registrations, L'Oréal has never abandoned L'ORÉAL PARIS, which it has used continuously in this country for 50 years. Additionally, Opposer's L'ORÉAL PROFESSIONEL PARIS registration was registered not because of a determination of no likelihood of confusion with Applicant's pending application, but because of L'Oréal's use of its own name and mark and the existence of its other registrations.

F. L'ORÉAL And L'ORÉAL PARIS Are Not Merely A Surname Or Geographically Descriptive

Applicant argues that L'ORÉAL is a common proper name and surname, and is not entitled to the protections afforded to arbitrary, fanciful or suggestive trademarks. App. Trial Brief, 10-11. That argument is unpersuasive. *See* Opp. Trial Brief, 14. Applicant does not refute that L'Oréal appears as a surname in the United States far less frequently than, for example, Buick and DuPont, both cited in the legislative history of the Lanham Act as examples of famous marks. *Id.*

Applicant may not argue that L'ORÉAL PARIS is primarily geographically descriptive by dissecting the mark. *Id.* at 14. The distinctiveness of L'ORÉAL PARIS as a trademark must be considered in its entirety. Taken as a whole, it is not primarily geographically descriptive. *Id.* at 14-15. If L'ORÉAL PARIS is indeed merely geographically descriptive, that would necessarily mean that Applicant's application must be denied. *Id.* at 15.

Even if L'ORÉAL and L'ORÉAL PARIS were merely descriptive when first adopted and used by Opposer, which they were not, Opposer easily has established that those marks have acquired secondary meaning. Through evidence of decades of use, hundreds of millions of dollars per year in ad spend, billions of dollars per year in sales volume and evidence of enormous brand recognition, Opposer has overwhelmingly shown that the consuming public associates the L'ORÉAL and L'ORÉAL PARIS marks with Opposer. Opp. Trial Brief, 4-9.

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: January 10, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing REPLY BRIEF OF OPPOSER L'ORÉAL S.A. and L'ORÉAL USA, INC. was served on Applicant this 10th day of January, 2011 by delivering a true and correct copy of same by First Class Mail to:

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