

THIS DECISION IS NOT A  
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

GCP

Mailed: August 15, 2012

Opposition No. 91202898

L'Oréal S.A. and L'Oréal  
U.S.A., Inc.

v.

Mikhail Levitin T/A Mikhail  
Levitin Institute

**Before Bucher, Zervas, and Bergsman,  
Administrative Trademark Judges.**

**By the Board:**

Mikhail Levitin T/A Mikhail Levitin Institute  
("applicant") seeks to register the mark "FOREAL Foréal by  
Mikhail" in standard characters for "anti-aging cream" in  
International Class 3.<sup>1</sup>

L'Oréal S.A. and L'Oréal U.S.A., Inc. ("opposers")  
have filed a notice of opposition to registration of  
applicant's mark. As grounds for opposition, opposers  
allege priority of use and that applicant's mark, when used  
on the identified goods, so resembles opposer's previously

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<sup>1</sup>Application Serial No. 85270272, filed on March 17, 2011, based  
on an allegation of a *bona fide* intention to use the mark in  
commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

used and registered L'ORÉAL-formative marks for various beauty products, including, cosmetics, skin and hair care products, perfumery and related goods and services, as to be likely to cause confusion, mistake or to deceive under Section 2(d) of the Trademark Act. Opposers have also alleged a claim of dilution.

On December 12, 2011, applicant filed his answer denying the salient allegations of the notice of opposition.

This case now comes before the Board for consideration of applicant's combined motion (filed April 19, 2012) (1) to dismiss for failure to state a claim, (2) for judgment on the pleadings and (3) for summary judgment. Opposers filed a response to applicant's motion on May 15, 2012.<sup>2</sup>

In support of his combined motion, applicant essentially argues that he is entitled to judgment solely because the notice of opposition refers to applicant's mark in all upper-case letters, i.e., FOREAL FOREAL BY MIKHAIL, rather than with the mixed upper- and lower-case letters of the mark as filed, namely, FOREAL Foréal by Mikhail.

The fact that opposers have referred to applicant's mark in all upper-case letters in their notice of

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<sup>2</sup>By order dated May 7, 2012, the Board allowed opposers until May 15, 2012, in which to respond to applicant's combined motion.

opposition is of no legal significance and does not support applicant's combined motion for judgment in his favor for the reasons set forth below.

By definition, applicant's standard characters mark is not limited to any particular stylization, but rather is depicted in Latin characters without any claim to any particular font, style, size or color. Neither Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a), nor Office practice creates a legal distinction between upper- and lower-case letters having any relevance to how applicant's mark appears in the notice of opposition. Notwithstanding the foregoing, we have considered applicant's combined motion and find the following:

Motion to Dismiss

When the defense of failure to state a claim upon which relief may be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer. Fed. R. Civ. P. 12(b); TBMP § 503.01 (3d ed. rev. 2012) (emphasis added). Here, applicant's request for dismissal based upon failure to state a claim upon which relief may be granted was filed approximately 3½ months after he filed his answer. Accordingly, to the extent applicant's combined motion

seeks relief under Fed. R. Civ. P. 12(b)(6) for failure to state a claim, the motion is denied as untimely.

Notwithstanding the foregoing, the Board, *sua sponte*, reviewed opposers' pleading and finds that, although opposers have properly pleaded their standing and their claim of priority and likelihood of confusion, opposers have nonetheless failed to plead properly their claim of dilution. Specifically, opposers have failed to allege affirmatively that their pleaded L'ORÉAL-formative marks became famous prior to the filing date of applicant's intent-to-use application. *See Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, the Board will allow opposers time to perfect their dilution claim within the time frame provided below, failing which opposers' dilution claim will be dismissed with prejudice.

Motion for Judgment on the Pleadings

A motion for judgment on the pleadings provides a means of disposition of cases when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. *See Fed. R. Civ. P. 12(c)*. Such a motion is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the

non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992); *Int'l Telephone and Telegraph Corp. v. Int'l Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1367 et seq. (1990).

All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Baroid Drilling Fluids, Inc.*, 24 USPQ2d at 1049. A party may not obtain judgment on the pleadings if the nonmoving party's pleading, the allegations of which are accepted as true, raises issues of fact that, if proved, would establish that the nonmoving party is entitled to judgment. *Id.*; see also Wright & Miller, § 1368 at 525-26.

As noted above, the Board finds that opposers' allegations sufficiently set forth their claim for priority and likelihood of confusion.<sup>3</sup> Applicant, however, has

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<sup>3</sup>Inasmuch as the Board has found opposers' dilution claim deficiently pleaded, the Board has not considered applicant's

denied the salient allegations in opposers' notice of opposition with respect to this asserted claim.

Specifically, applicant has denied the allegations in the notice of opposition which allege that (1) the parties' respective marks are similar and (2) the parties' respective goods are related. See ¶¶ 19-20 of applicant's answer filed on December 28, 2011. Thus, applicant's own denial of these allegations raises, at a minimum, genuine disputes of material fact in regard to essential elements of opposers' claim of likelihood of confusion.

Accordingly, applicant's motion for judgment on the pleadings as to opposers' asserted claim of likelihood of confusion is denied.

Motion for Summary Judgment

Under Fed. R. Civ. P. 56(a), applicant has the initial burden of demonstrating that there is no genuine dispute of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). We find that applicant, as the moving party, has

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request for judgment on the pleadings with regard to this claim. Similarly, the Board has not considered applicant's request for summary judgment regarding opposers' deficiently-pleaded dilution claim. See *infra*.

failed to discharge his initial burden of making a *prima facie* showing that there are no genuine disputes of material fact, and that he has failed to demonstrate that he is entitled to judgment as a matter of law, on opposers' claim of likelihood of confusion. Specifically, applicant has failed to present any evidence to establish that there is not a likelihood of confusion between the parties' respective marks. Applicant has merely argued that he is entitled to judgment because opposers have referred to his mark in the notice of opposition in all capital letters. Such an argument, standing alone, is not sufficient to discharge applicant's initial burden.

Accordingly, to the extent applicant's combined motion seeks judgment in his favor under Fed. R. Civ. P. 56(a), the motion is denied.

In view of the foregoing, applicant's combined motion (1) to dismiss for failure to state a claim, (2) for judgment on the pleadings, and (3) for summary judgment is **denied** in its entirety.

Proceedings herein are resumed. Opposers are allowed **twenty days** from the mailing date of this order in which to file an amended notice of opposition which includes a proper claim of dilution pursuant to the guidelines set forth herein, failing which opposers' dilution claim will

be dismissed with prejudice and the case will solely proceed on opposers' asserted claim of priority and likelihood of confusion.

In turn, applicant is allowed twenty days from the date on the certificate of service of opposers' amended pleading in which to file and serve his answer or otherwise respond to the amended notice of opposition.<sup>4</sup>

Trial dates, beginning with the deadline for expert disclosures, are reset as follows:

Expert Disclosures Due	10/13/2012
Discovery Closes	11/12/2012
Plaintiff's Pretrial Disclosures	12/27/2012
Plaintiff's 30-day Trial Period Ends	2/10/2013
Defendant's Pretrial Disclosures	2/25/2013
Defendant's 30-day Trial Period Ends	4/11/2013
Plaintiff's Rebuttal Disclosures	4/26/2013
Plaintiff's 15-day Rebuttal Period Ends	5/26/2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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<sup>4</sup>To the extent opposers' fail to file an amended notice of opposition pursuant to this order, applicant's answer filed on December 28, 2011 will remain applicant's operative pleading in this case.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**Pro Se Information**

It is noted that applicant intends to represent himself in this proceeding. While Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, applicant should note that Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement,

whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service.

It is recommended that applicant obtain a copy of the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and is available for a fee from U.S. Government Printing Office on the World Wide Web at <http://bookstore.gpo.gov>.

Strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.<sup>5</sup>

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<sup>5</sup> The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is also available on the World Wide Web at <http://www.uspto.gov>.