

ESTTA Tracking number: **ESTTA727950**

Filing date: **02/18/2016**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Schwan-STABILO Cosmetics GmbH & Co.		
Entity	Limited liability company	Citizenship	Germany
Address	Schwanweg 1 Heroldsberg, 90562 GERMANY		

Attorney information	Frank M. Caprio Bradley Arant Boult Cummings LLP 200 Clinton Avenue West Suite 900 Huntsville, AL 35801 UNITED STATES wbabcock@babco.com Phone:256-517-5142		
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### Applicant Information

Application No	86736436	Publication date	01/19/2016
Opposition Filing Date	02/18/2016	Opposition Period Ends	02/18/2016
Applicant	L'Oreal 14 Rue Royale Paris, 75008 FRANCE		

### Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Mascara
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2735958	Application Date	09/05/2001
Registration Date	07/15/2003	Foreign Priority Date	05/15/2001
Word Mark	COSMETICS		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Cosmetic pencils of all types, namely eyebrow pencils, eye contour pencils, charcoal pencils, eyeliner pencils, lipsticks, lip liner pencils, eye shadow pencils, mascara; covering and correcting pencils, cosmetic pencils for cheeks and face; make-up remover pencils, perfume pencils, nail white pencils, liquid liner pencils</p> <p>Class 005. First use: First Use: 0 First Use In Commerce: 0 Cosmetic pencils with antiseptic and medical effects, namely eyebrow pencils with antiseptic and medical effects, eye contour pencils with antiseptic and medical effects, charcoal pencils with antiseptic and medical effects, eyeliner pencils with antiseptic and medical effects, lipsticks with antiseptic and medical effects, lipliner with antiseptic and medical effects, eyeshadow pencils with antiseptic and medical effects, mascara with antiseptic and medical effects, covering and correcting pencils with antiseptic and medical effects, pencils for cheeks and face with antiseptic and medical effects, make-up remover pencils with antiseptic and medical effects, liquid liner pencils with antiseptic and medical effects</p>

U.S. Registration No.	3853716	Application Date	12/11/2008
Registration Date	09/28/2010	Foreign Priority Date	NONE

Word Mark	COSMETICS INSPIRATION ENGINEERED
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Design Mark	
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Description of Mark	The mark consists of the terms "COSMETICS INSPIRATION ENGINEERED" to the right of a stylized swan design.
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Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Cosmetics, namely, eyebrow pencils, eyeliner pencils, kohl pencils, lipsticks, lip liner pencils, lip gloss, eye shadow pencils, cover and correction pencils, pencils for cheeks and face, nail whitening pencils, liquid liner pencils, mascara, foundations; facial cosmetic emulsions, facial cosmetic creams, facial cosmetic gels, facial cosmetic tonics, facial cosmetic powder, bleaching cream for skin</p> <p>Class 005. First use: First Use: 0 First Use In Commerce: 0 Medicated cosmetic products with antiseptic and medical effects, namely, eyebrow pencils, eyeliner pencils, kohl pencils, lipsticks, lip liner pencils, lip gloss, eye shadow pencils, cover and correction pencils, pencils for cheeks and face, nail whitening pencils, liquid liner pencils, mascara, medical facial emulsions, medical facial creams, medical facial tonics, medical facial powder</p>
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Frank M. Caprio/
Name	Frank M. Caprio
Date	02/18/2016

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 86/736,436  
Published in the Official Gazette of January 19, 2016

<b>Schwan-STABILO Cosmetics GmbH &amp; Co.,</b>	)	
	)	
<b>Opposer,</b>	)	
	)	
<b>v.</b>	)	<b>Opposition No.:</b>
	)	
<b>L'Oréal,</b>	)	
	)	
<b>Applicant.</b>	)	

**NOTICE OF OPPOSITION**

This Notice of Opposition is brought by Schwan-STABILO Cosmetics GmbH & Co. ("Opposer") in the pending service mark application Serial No. 86/736,436 filed by L'Oréal ("Applicant") for the word mark VOLUMINOUS SWAN, for goods identified in the Application as:

Mascara, in International Class 003.

The Application was published in the Official Gazette on January 19, 2016.

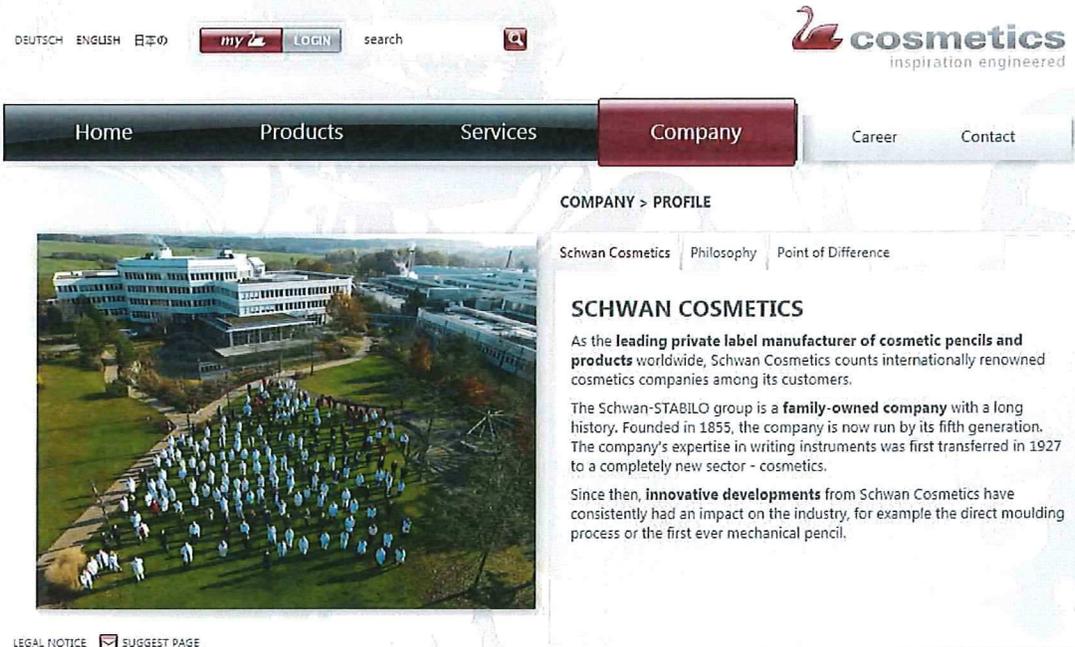
Opposer believes it will be damaged by the registration or extension of protection of this trademark and hereby opposes registration of the same, alleging as follows:

1. Opposer is a German limited liability company having its principal place of business at Schwanweg 1 - 90562 Heroldsberg, Germany.
2. Opposer's company name, "Schwan-STABILO Cosmetics" begins with the term, "Schwan," which is pronounced as "SWAN."

3. Opposer is known world-wide as “Schwan Cosmetics” (pronounced as “Swan” Cosmetics).

4. Opposer’s logo includes a design of a swan, as shown on its goods and on its website, both as shown below:





5. Opposer is well-known in the cosmetics industry, and has been in the cosmetics industry since at least as early as 1927.

6. Opposer currently is and has been in the cosmetics business in the United States, with a principal place of business located at Schwan Cosmetics USA, Inc. 3202 Elam Farms Parkway, Murfreesboro, Tennessee 37127 USA

7. Opposer offers under its marks an extensive line of eye make-up products, to include mascara.

8. Opposer is the owner of U.S. Registration No. 2,735,958 for the mark,



(pronounced, "SWAN COSMETICS"),

for goods identified in the registration as:

Cosmetic pencils of all types, namely eyebrow pencils, eye contour pencils, charcoal pencils, eyeliner pencils, lipsticks, lip liner pencils, eye shadow pencils, **mascara**; covering and correcting pencils, cosmetic pencils for cheeks and face; make-up remover pencils, perfume pencils, nail white pencils, liquid liner pencils, in International Class 003

and

Cosmetic pencils with antiseptic and medical effects, namely eyebrow pencils with antiseptic and medical effects, eye contour pencils with antiseptic and medical effects, charcoal pencils with antiseptic and medical effects, eyeliner pencils with antiseptic and medical effects, lipsticks with antiseptic and medical effects, lipliner with antiseptic and medical effects, eyeshadow pencils with antiseptic and medical effects, mascara with antiseptic and medical effects, covering and correcting pencils with antiseptic and medical effects, pencils for cheeks and face with antiseptic and medical effects, make-up remover pencils with antiseptic and medical effects, liquid liner pencils with antiseptic and medical effects, in International Class 005.

9. Opposer is the owner of Registration No. 3,853,716 for the mark,



(pronounced, “SWAN COSMETICS

INSPRATION ENGINEERED”), for goods identified in the registration as:

Cosmetics, namely, eyebrow pencils, eyeliner pencils, kohl pencils, lipsticks, lip liner pencils, lip gloss, eye shadow pencils, cover and correction pencils, pencils for cheeks and face, nail whitening pencils, liquid liner pencils, **mascara**, foundations; facial cosmetic emulsions, facial cosmetic creams, facial cosmetic gels, facial cosmetic tonics, facial cosmetic powder, bleaching cream for skin, in International Class 003

and

Medicated cosmetic products with antiseptic and medical effects, namely, eyebrow pencils, eyeliner pencils, kohl pencils, lipsticks, lip liner pencils, lip gloss, eye shadow pencils, cover and correction pencils, pencils for cheeks and face, nail whitening pencils, liquid liner pencils, **mascara**, medical facial emulsions, medical facial creams, medical facial tonics, medical facial powder, in International Class 005.



10. Opposer has used the mark (pronounced, "SWAN COSMETICS"), in connection with its goods for approximately 15 years.



11. Opposer has used the mark (pronounced, "SWAN COSMETICS INSPIRATION ENGINEERED"), in connection with its goods for approximately 8 years.

12. Opposer's and Applicant's marks are likely to be confused. The marks share common pronunciation of "swan" which is likely to cause confusion. The Applicant's "swan" element is likely to cause consumer confusion with Opposer's long-used image of a swan in its marks. The fact that the marks are used in connection with identical goods is likely to cause confusion. The goods have common and/or overlapping channels of trade which also will be likely to cause confusion.

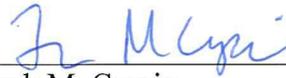
13. Opposer has expended significant resources in efforts to promote and advertise its marks, and Opposer's goodwill in the marks will be harmed by Applicant's registration of the mark identified in Serial No. 86/736,436.

14. Based on the likelihood of confusion and the prior use of Opposer's marks, Applicant's mark should be refused registration.

Therefore, Opposer respectfully requests that this opposition be sustained, and the registration of application Serial No. 86-736,436 for the mark VOLUMINOUS SWAN sought by Applicant be refused.

The Application is in one (1) International Class, and a total fee of \$300.00 under 37 CFR § 2.6(a)(17) is enclosed. The Commissioner is authorized to charge any further fees required to Deposit Account Number 504293, in the name of Bradley Arant Boult Cummings LLP.

Respectfully submitted,



Frank M. Caprio  
*Counsel for Opposer,*  
*Schwan-STABILO Cosmetics GmbH*  
*& Co.*

BRADLEY ARANT BOULT  
CUMMINGS LLP  
200 Clinton Avenue, Suite 900  
Huntsville, Alabama 35801  
Phone: (256) 517-5100  
Fax: (256) 517-5200  
[fcaprio@babbc.com](mailto:fcaprio@babbc.com)

**CERTIFICATE OF SERVICE**

I hereby certify that on February 18<sup>th</sup>, 2016, I caused the foregoing **NOTICE OF OPPOSITION** to be served by United States mail, postage prepaid, in an envelope addressed to:

Robert L. Sherman  
Paul Hastings LLP  
75 East 55<sup>th</sup> Street  
New York, NY 10022

[rls@paulhastings.com](mailto:rls@paulhastings.com)

*Attorney of Record for L'Oréal*

By: 