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

Proceeding	91226815
Party	Defendant Advanced Polymer Inc.
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Attachments	Answer to Opposition No. 91226815.pdf(661796 bytes )

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

In the Matter of Serial No. 86/704,515

For the Mark: *Caresse*

Filed on July 24<sup>th</sup> 2015,

Published on the *Official Gazette* on February 9<sup>th</sup>, 2016

CONOPCO, INC.,

Opposer,

-against-

Opposition No: 91226815

ADVANCED POLYMER, INC.,

Applicant

**Answer to Notice of Opposition**

Advanced Polymer, Inc., (“Defendant”) or (“Applicant”), a corporation organized and existing under the laws of Washington state, currently located at 8661 South 208<sup>th</sup> Street, Unit 103, Washington 98031, strongly believes that the registration of Mark CARESSE (stylized), Class 3, will not cause any damage to Conopco, Inc. (“Opposer”). The following responses are grounds to Opposer’s allegations related to the CARESSE Mark:

1. Defendant admits and understands that the Opposer being one of the largest and well-established manufacturer of a variety of soaps, body washes, and skin care products under “CARESS” brand. However, Defendant’s “CARESSE”, is one of a few acrylic monomers produced under KERAKUSE brand and is designed specifically for professional and licensed manicurists to use on nail beds only. It is intended for commercial use only at nail salons.
2. Defendant admits that Opposer’s products bearing CARESS Mark being most widely-used and best-selling personal cleaning products.

3. Defendant admits that CARESS products being advertised and sold for personal use and care to general public.
4. Defendant admits that Opposer's CARESS Mark being famous and entitled to protection for products related to personal and skin
5. Defendant admits that most of skin and personal care products listed in the opposition by Opposer were registered before Defendant's CARESSE product.
6. Defendant admits the validity and the incontestable registrations of all Opposer's personal care products based on evidence presented in the opposition.

**Applicant's CARESSE (Stylized) Mark**

7. CARESSE is a high grade acrylic monomer used as intermediate product to be mixed with a specialized resin a few seconds before being applied and sculpted on nail beds. The final product hardens and becomes inert on nail beds of customers after being cured. It is labeled as a "SUPERIOR PERFORMANCE ACRYLIC MONOMER" and "flammable" chemical and by itself has no purpose or function. CARESSE cannot be applied directly on the skin as stated on label to "Avoid all skin contact" and must be handled according to "MSDS" (referring to Material Safety Data Sheet). Therefore, it is categorized as a "fingernail sculpting liquid", and not as a skin care product. (Exhibits A and B).
8. The name CARESSE was initially used to differentiate a high grade monomer from other grades of monomers used in French manicure, all bearing KERAKUSE brand and logo and manufactured by Advanced Polymer, Inc. CARESS is only available at a few nail suppliers and can only be purchased by licensed nail salons or manicurists. The product and has limited exposure to the public. Due to limited selection at the time of application, Class 3 was selected based on how closely it describes Defendant's Mark for a "fingernail sculpting liquid".

**False Suggestion of a Connection, 15 U.S.C. § 1052 (a) &  
Likelihood of Confusion, 15 U.S.C § 1052 (d)**

9. Information presented above identifies obvious difference between Opposer's products and Defendant's CARESSE, both having different purposes, as well as different types of customers.
10. Defendant acknowledges Opposer's priority and the long time use of the House Mark CARESS mentioned in the opposition and has no intention to challenge Opposer's use of CARESS House Mark for personal use or skin care. Defendant's Mark was created specifically for an acrylic monomer for licensed manicurists to use in French manicure.
11. Defendant acknowledges that CARESS has been famous and all CARESS products were registered before Defendant's Mark. However, Defendant's CARESSE is created for licensed manicurists as opposed to Opposer's products which are sold to general consumers.
12. Defendant acknowledge that CARESSE Mark sounds slightly similar to Opposer's Mark, but its appearance and font used are significantly and distinctly different than the Mark used by Opposer. (Exhibit A)
13. All goods listed in the opposition for CARESS are for skin care and personal use, whereas Defendant's CARESSE is a chemical to be used on nail beds only. Defendant's product is not intended to be used on the skin as state on the label. In fact, labeling and packaging has the following information printed on CARESSE labels:

Front (Exhibit A)

- a. **"SUPERIOR PERFORMANCE ACRYLIC MONOMER"**.
- b. **"KeraKuse"** brand and logo prominently displayed directly above CARESSE's Mark.
- c. **"FOR PROFESSIONAL USE ONLY"**.

Back (Exhibit B)

- a. **"FOR PROFESSIONAL USE ONLY"**.
- b. **"Follow directions of MSDS"** (refers to Material Safety Data Sheet).
- c. **"Avoid all skin contact"**.
- d. **"Flammable"**.
- e. Listed contact information of **"Advanced Polymer, Inc."**

Bottle (Exhibits A and B)

- a. Neck embossed with two identical logos and names "KERAKUSE" (1.5" by 1.5").
- b. Large volume (one gallon) is for commercial use at nail salons.

14. Since CARESSE is a highly flammable chemical, it is transported and distributed as hazardous material and therefore is limited to only qualified nail suppliers. Since its intended for licensed manicurists who are trained to safely handle, use, and dispose this product, it is highly unlikely to find CARESSE to be in the same distribution channels as Opposer's goods or stocked at general business entities such as supermarkets, pharmacies, convenience, or department stores.

Furthermore, professional and business licenses of customers are required at the time of purchase at most nail suppliers.

15. Since Advanced Polymer, Inc. does not manufacture any skin care products for personal use, it is extremely unlikely that Defendant has benefited from Opposer's goodwill. Defendant has never publicly or privately made any false connection or association with any of Opposer's products to either dilute Opposer's Mark or to create confusion.

16. If general customers had inadvertently purchased and applied CARESSE directly on the skin believing it to be a personal care product made by Opposer, then complaints and medical adverse events related to skin injuries would have already been reported either directly to FDA, Opposer, or Defendant. Since Defendant has not received any complaint from either customers, Opposer, FDA, or any other regulatory agencies involving skin injuries caused by Defendant's CARESSE, therefore, it is highly unlikely that Defendant's Mark has caused any confusion, mistake, or dilution to Opposer's Mark.

17. There are no information or statements printed on CARESSE labels or packaging materials as evidence to suggest a connection to Opposer and its House Mark by either approving, authorizing, licensing, sponsoring, endorsing, controlling by Opposer. Similarly, there is no statement or information printed on either the label or the container that associates CARESSE with Opposer. Therefore, there is no violation to Section 2(d), 15.U.S.C § 1052 (d) committed by

Defendant as suggested by Opposer. Furthermore, the following information reveals little similarities between CARESSE of KERAKUSE brand and Opposer's Mark CARESS to confuse or to deceive customers into believing that CARESSE is associated with the Opposer's (Exhibits A and B):

- a. Font used for CARESSE is very different from Opposer's House Marks.
- b. Defendant's brand and logo of KERAKUSE, is prominently printed immediately above CARESSE's label.
- c. The unique design of front label of CARESSE is drastically different from any of Opposer's CARESS labels.
- d. Statement "SUPERIOR PERFORMANCE ACRYLIC MONOMER" printed on front label indicates that this is a chemical, not a finished product to be used on skin. Therefore, its application is different from any of the goods bearing CARESS name.
- e. Statement "FOR PROFESSIONAL USE ONLY" on front label indicated that this product intended for licensed and trained professionals only, not general consumers.
- f. Back labels contains statements such as: "FOR PROFESSIONAL USE ONLY", "FOLLOW DIRECTIONS AND MSDS\*\*", "AVOID ALL SKIN CONTACT", and "FLAMMABLE" to limit its use to professional manicurists and on nails only.

\*\*Refers to Material Safety Data Sheet.

- g. CARESSE being sold in bulk (one gallon) container with different packaging material, type, and design than any Opposer's goods currently being marketed. Also, the container's neck is embossed with 2 identical KERAKUSE logos. (Exhibits A and B)
- h. Both physical and chemical properties of CARESSE bear absolutely no resemblance to either soap, skin care, lotion or detergent of CARESS. It is a purple liquid with very strong odor and can be used only in ventilated area as stated on back label.
- i. Opposer currently does not have any acrylic monomer available on the market for professional manicurists to use.

**Dilution, 15 U.S.C § 1125 (C)**

18. Defendants repeats responses and evidences set forth above to appropriately acknowledge or challenge each and every allegation made by Opposer.

19. Defendant acknowledges that CARESS is Opposer's famous House Mark for personal care products. However, Defendant created products specifically for manicurists to use on nail beds. Furthermore, Defendant does not manufacture any skin care products.
20. Defendant does not intend to compete, impair, or cause damage to Opposer Mark and strongly believes that the CARESSE Mark bears no resemblance to Opposer's to violate 15 U.S.C. § 1125 (c)(2)(B). Since CARESSE can only be found at nail suppliers and nail salons only for professional manicurists to use, its availability and exposure to general public is limited and therefore should not affect the distinctiveness of CARESS Mark of Opposer. Should there be any available data supporting evidences of Opposer's Mark being diluted or tarnished by Defendant's CARESSE, Defendant will cancel the application of CARESSE Mark, apply for a new Mark, and revise the label for its acrylic monomer.
21. The concurrent used of Defendant's Mark shall not cause any harm to the Opposer's Mark or reputation due significant differences mentioned above, as well as the lack of evidence associated with the Defendant's Mark with Opposer's CARESS. Opposer's goods are for skin care whereas Defendant's CARESSE is a chemical created for application on the nails.
22. Defendant strongly believes that the registration for concurrent use of CARESSE House Mark will not cause dilution to the Opposer's Mark by blurring or tarnishing the distinctiveness of Opposer's Mark as explained above.

In conclusion, Defendant would appreciate approval of Application Serial No. 86/704,515 for concurrent use for CARESSE House Mark since its use and will not compete, cause any damage, or dilute the Opposer's House Mark due to differences in types products and markets being served. Should there be any supporting evidences presented by Opposer that Defendant's Mark has diluted, caused confusion, or caused mistake, or to deceive with the intent to damage its reputation, Defendant will cancel the

application for its Mark and apply for a different Mark. Exhibits A and B are attached to this response as supporting evidences for the approval of concurrent use of the CARESSE Mark.

Respectfully submitted, the 2<sup>nd</sup> of June, 2016

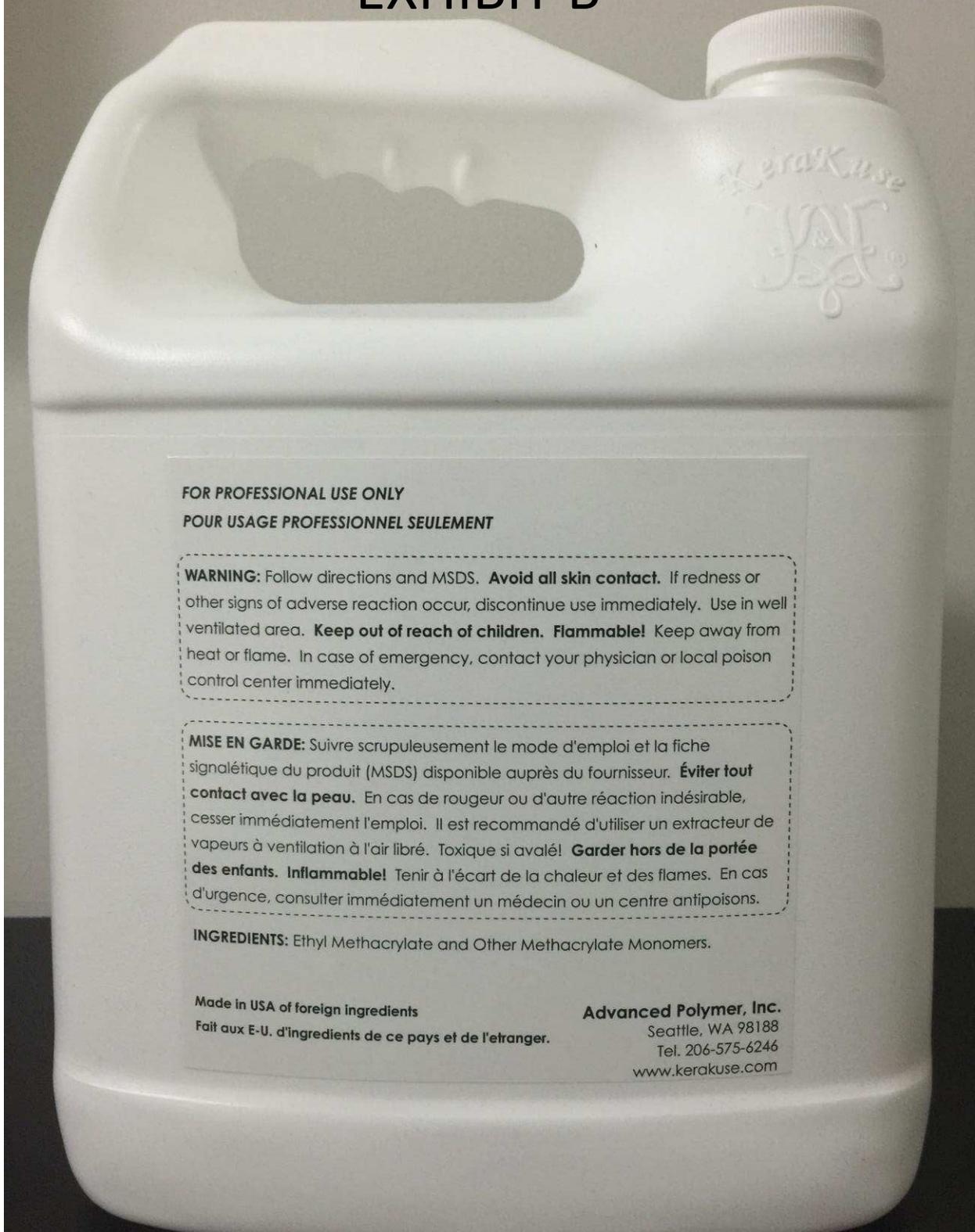
A handwritten signature in black ink, reading "Andry Hong", written over a horizontal line.

Andry Hong  
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# EXHIBIT A



# EXHIBIT B



**FOR PROFESSIONAL USE ONLY**  
**POUR USAGE PROFESSIONNEL SEULEMENT**

**WARNING:** Follow directions and MSDS. **Avoid all skin contact.** If redness or other signs of adverse reaction occur, discontinue use immediately. Use in well ventilated area. **Keep out of reach of children. Flammable!** Keep away from heat or flame. In case of emergency, contact your physician or local poison control center immediately.

**MISE EN GARDE:** Suivre scrupuleusement le mode d'emploi et la fiche signalétique du produit (MSDS) disponible auprès du fournisseur. **Éviter tout contact avec la peau.** En cas de rougeur ou d'autre réaction indésirable, cesser immédiatement l'emploi. Il est recommandé d'utiliser un extracteur de vapeurs à ventilation à l'air libre. Toxique si avalé! **Garder hors de la portée des enfants. Inflammable!** Tenir à l'écart de la chaleur et des flammes. En cas d'urgence, consulter immédiatement un médecin ou un centre antipoisons.

**INGREDIENTS:** Ethyl Methacrylate and Other Methacrylate Monomers.

Made in USA of foreign ingredients  
Fait aux E-U. d'ingrédients de ce pays et de l'étranger.

**Advanced Polymer, Inc.**  
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the Answer to Opposition No. 91226815 was mailed via First Class Mail on 2<sup>nd</sup> of June, 2016, with sufficient postage in an envelope addressed to:

Lisa Rosaya  
Baker & McKenzie LLP  
452 Fifth Avenue  
New York, New York 10018

A handwritten signature in black ink, appearing to read "Andry Hong", written over a horizontal line.

ANDRY HONG