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

Proceeding	79246019
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Applied for Mark	ROMY
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIALS AND APPEALS BOARD**

Applicant	Michel Mercier
Serial No.	79/246,019
Trademark	ROMY
Law Office: 116	Trademark Attorney: Doritt Carroll

**APPLICANT'S APPEAL BRIEF**

Applicant, Michel Mercier, has appealed the Trademark Examining Attorney's refusal to register the trademark ROMY in International Class 021 for "Hair brushes, hair combs, hair styling comb and brushes, rotary hair brushes, electrically heated hair brushes" (the "Applicant's Goods").

The Examining Attorney refused registration under Trademark Act §2(d), 15 U.S.C. §1052(d), on the grounds that the mark is likely to be confused with U.S. Registration No. 5,477,794 for ROMY in International Class 003 for "Non-medicated soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; make-up preparations; make-up removing preparations; cosmetic preparations for baths; cleansing milk for toilets purposes; cosmetic skin-tanning preparations; cosmetic skin care preparations; depilatory preparations; nail care preparations; antiperspirants; hair dyes; shampoos; hair conditioners; hair sprays; oils for toiletry purposes; lotions for cosmetic use" (the "Registrant's Goods").

When determining the likelihood of confusion, the Examining Attorney's determination must be based on an analysis of all probative factors in evidence that are relevant to factors bearing

on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the present case, while the marks may be identical, the goods are vastly different and the channels of trade for the respective goods are different. The fact that a number of other marks containing ROMY or a phonetic equivalent currently coexist without confusion for same or related goods also highly suggests that the addition of another ROMY in the marketplace will not create a likelihood of consumer confusion. After careful evaluation of all of the relevant *Du Pont* factors, the argument tips in the favor of registration of Applicant's mark.

### **FACTS AND PROSECUTION HISTORY**

Applicant filed its application to register the mark ROMY on November 22, 2018 under Section 66 of the Lanham Act and extending protection for the Applicant's Goods in the United States. The Examining Attorney issued an Office Action dated November 26, 2018, refusing registration under Trademark Act § 2(d), 15 U.S.C. §1052(d), on the ground that the mark was confusingly similar to U.S. Registration No. 5,477,794 and also objecting to description of goods in Class 021. On June 5, 2019, Applicant filed a Response to the Office Action arguing against the refusal to register and amending the description of goods.

The Examining Attorney issued another Office Action on June 27, 2019 and issued a final refusal, again based on a likelihood of confusion with U.S. Registration No. 5,477,794 and an objection to the amended description of goods in Class 021. Applicant filed a Request for Reconsideration After Final Action, together with a Notice of Appeal to Trademark Trial and Appeal Board ("Board"), on December 27, 2019 further arguing against the refusal to register and further amending the description of goods. The Board suspended the appeal and remanded the application to the Examining Attorney for consideration of the Request for Reconsideration. On

December 31, 2019, the Examining Attorney issued an Office Action maintaining the refusal under Section 2(d) and withdrawing the objection to the description of goods and notified the Board to resume the Appeal. Applicant now submits its brief of the appeal.

### **ISSUE ON APPEAL**

Whether Applicant's mark is likely to cause confusion with the cited registration within the meaning of Section 2(d).

### **ARGUMENT**

#### **A. APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REGISTRATION**

To determine whether a likelihood of confusion exists under Section 2(d), the Board follows the test articulated in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1367, 177 USPQ 563 (CCPA 1973). The *Du Pont* test requires balancing the following factors, when relevant:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity of and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).

6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
10. The market interface between applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i.e., whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

*See In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361. The Court expressly disavows that any one factor is necessarily dispositive in the analysis of confusion. An examining attorney’s determination must be based on an analysis of all probative factors in evidence that are relevant to the analysis of likelihood of confusion. An examining attorney cannot merely rely on the similarity of the marks and the supposed similarity of goods to refuse registration on the grounds of likelihood of confusion where the balance of the evidence indicates that there is a *de minimis* likelihood of confusion. *Electronic Design and Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ 2d 1388, 1391 (Fed. Cir. 1992) (“We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.”) (*quoting Witco Chem. Co. v. Whitfield Chem. Co.*, 164 USPQ 43, 44-45 (CCPA 1969).

The refusal to register under Section 2(d) should be reversed for the following reasons: (1) the goods associated with the respective marks are sufficiently different to avoid confusion, (2) the goods associated with the respective marks travel in different trade channels, (3) the presence of other third party “ROMY” registrations weaken the strength of the mark, and (4) the Registrant’s Mark is primarily used with another Registrant’s mark HYLAB, which further weighs against the likelihood of confusion.

**B. THE APPLICANT’S GOODS ARE DISTINCT FROM THOSE IDENTIFIED IN THE CITED REGISTRATION**

Even if the marks are considered similar or even identical, that does not end the inquiry as to the likelihood of confusion. A finding that confusion is likely requires a determination that the goods are sufficiently related and consumers will be confused as to their source. In conducting this analysis, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 USPQ2d 1157, 1162 (Fed. Cir. Mar. 26, 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d

1498, 1500 (TTAB 2010).

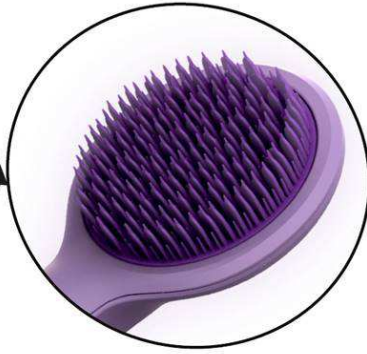
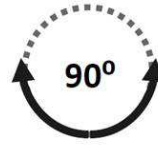
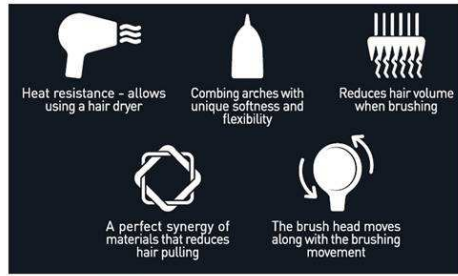
In this case, the Applicant's Goods are sufficiently narrow and different to avoid confusion with the identification of goods in the Cited Registration. The Applicant's Goods cover *hair tools*, namely "hair brushes, hair combs, hair styling comb and brushes, rotary hair brushes, electrically heated hair brushes" in Class 21. In contrast, the Registrant's Goods cover *cosmetic and makeup* products, namely "non-medicated soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; make-up preparations; make-up removing preparations; cosmetic preparations for baths; cleansing milk for toilets purposes; cosmetic skin-tanning preparations; cosmetic skin care preparations; depilatory preparations; nail care preparations; antiperspirants; hair dyes; shampoos; hair conditioners; hair sprays; oils for toiletry purposes; lotions for cosmetic use" in Class 3. As shown from the plain language found in the Application and the Cited Registration, the goods are not legally identical, they are different and are classified in different International Classes.

Applicant's ROMY hair brush is shown below:



Michel Mercier  
PROFESSIONAL

## Romy



Thin Hair



Normal Hair



Thick Hair

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This is in contrast to Registrant's products which are directed to a customized made to measure skincare system, which includes a specialized formulator device sold together with capsules containing formulation ingredients for various skincare products, as described in more detail below.



These products are completely different from Applicant's hair brush product and are not related at all. Moreover, a consumer will not confuse these products because they are not generally



related and are in fact completely different and perform a completely different function (hair tools v. products for skin care).

It is well-settled that even in cases where the marks are identical and used on goods or services in the same category, the finding of a likelihood of confusion is not automatic, especially when the goods or services are not related. *See In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (no likelihood of confusion between PLAYERS for shoes and PLAYERS for men's underwear); *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between EDS for power supplies or battery chargers versus E.D.S. for computer services); *In re Reach Electronics, Inc.*, 175 USPQ 734 (TTAB 1972) (finding no likelihood of confusion between REAC for measuring, testing and computing equipment and REACH for communication equipment).

Further, even a general relationship between the goods or services is insufficient to establish a likelihood of confusion. *See General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690, 694 (TTAB 1977); *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975).

As the Board stated in *General Electric*:

It is, however, not enough to find one term that may generically describe the goods. More must be shown: that is, *a commercial or technological relationship must exist between the goods such that the use of the trademark in commercial transactions on the goods is likely to produce opportunities for purchasers or users of the goods to be misled about their source or sponsorship.*

*General Electric*, 197 USPQ at 694 (emphasis supplied); *see also Harvey Hubbell*, 188 USPQ at 520 ("In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties"). There is no opportunity in this instance for

purchasers or users of the goods to be misled about their source or sponsorship.

Moreover, numerous cases have found no likelihood of confusion between even identical marks for goods and services used in a common industry – where the goods and services are different from each other and the record does not provide a sufficient evidentiary basis for inferring they would be encountered by the same consumers *under circumstances leading to confusion as to source*. See *Hi Country Foods Corp v. Hi Country Beef Jerky*, 4 USPQ2d 1169 (TTAB 1987) (no confusion likely between HI-COUNTRY for fruit juice and HI-COUNTRY for meat snacks); *Borg-Warner Chemicals, Inc. v. Helena Chemical Co.*, 225 USPQ 222 (TTAB 1983) (finding BLENDEX for stabilizing chemical composition of fertilizers/pesticides not likely to cause confusion with BLENDEX for synthetic resins used in industrial arts); *In re Fesco*, 219 USPQ 437 (TTAB 1983) (finding no likelihood of confusion between FESCO for farm machinery distributorships and FESCO for fertilizer processing machinery and equipment); *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1978). Again, there are no circumstances in this instance that will lead to confusion as to source.

The Examining Attorney's argument that several companies provide a variety of personal care goods, including goods similar to Applicant and the Cited Registrant, does not prove anything other than the goods may travel in the same trade channel, which Applicant disagrees with as explained in more detail below. It cannot be concluded that this leads to consumer confusion when other *DuPont* factors point to non-confusion. Even if the same consumers encounter these goods, there are no circumstances under which consumers will be confused as to source. As explained further below, the Cited Registrant's mark is primarily used in conjunction with another Registrant's mark, HYLABS, and the products under the Cited Registrant's mark are rather specialized and targeted towards a particular group of consumers interested in preparing their own

skincare products.

Thus, there is insufficient evidence to conclude that the goods of the respective parties are sufficiently related to cause confusion. In fact, due to the arguments above (and below), the conclusion is quite to the contrary. This factor is therefore in favor of publication of Applicant's mark.

**C. GOODS UNDER THE REGISTRANT'S MARK AND THE APPLICANT'S MARK ARE SOLD VIA DIFFERENT TRADE CHANNELS TO DIFFERENT CUSTOMERS**

The Applicant and the Registrant have different channels of distribution targeted at different groups of consumers. A skincare company, such as the Registrant, is not typically perceived by the consumer as a hair tool brand, such as the Applicant. This is even more true when consumers who buy products under the Cited Registrant's mark can only do so through the Registrant's website that explains the nature and character of their products, as explained in more detail below. No purchaser would confuse a hairbrush with highly personalized skincare products that have to be made in a consumer's home.

Registrant is a French company. Its business focuses on tailor-made freshly formulated skin care products, i.e. the Registrant sells cosmetics ingredients and a special mixer by which they offer a user to obtain a freshly made to measure skin care product. Registrant's website, <https://www.romy.paris/>, provides that it produces "a personal skincare lab, creates your skincare dose that evolves with the rhythm of your life thanks to a large selection of encapsulated active ingredients to personalize your skincare base, every day." The Registrant sells formulas that are not sold in general stores or personal care retailers, such as Sephora, etc. Instead, Registrant's

products are only available from their foreign website and are made to be home-mixed by the purchaser with a special device. *See* a printout from the Registrant's website, attached as **Exhibit A**. Registrant does not sell hair tools, such as hair brushes, etc. and in fact does not sell products in the United States at all, as their only sales are via a French based website (*see* evidence including Registrant's admission that products are not sold in the USA, attached as **Exhibit B**).

Registrant's goods are specifically targeted towards a niche group of consumers that are interested in mixing their own skincare products at home. Applicant submits that not every general consumer would be interested in buying a special device and separate ingredients for mixing their own skincare products at home. In fact, most people prefer buying premade products that are easy to use, requiring minimal time and effort.

Thus, the targeted consumers of the goods under the Cited Registrant's mark are sophisticated enough to not confuse Applicant's hair tools and Registrant's made to measure cosmetic products. The differences in the goods are particularly important where the purchasers of the goods in question are sophisticated and less prone to confusion. *See In Merck KGAA*, 2006 WL 1723553 (TTAB June 13, 2006) (based on the identification of goods and services, the overlapping consumers are sophisticated and exercise a degree of care when making a purchases, so this factor weighs against a finding of likelihood of confusion). This is particularly true because the consumers of Registrant's goods have to go to the Registrant's website to educate themselves about the process of mixing the skincare products and then purchase specific formula ingredients and a specialized device to mix the products at home. Furthermore, the Registrant's skincare system is a high-end luxury product that is sold at the \$450 price point (£350.00)<sup>1</sup>. A screenshot

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<sup>1</sup> The Registrant's website lists other products that are a lower price point, such as capsules, bases cleanses and shots. However, as is clear from the Registrant's website, all of those products can

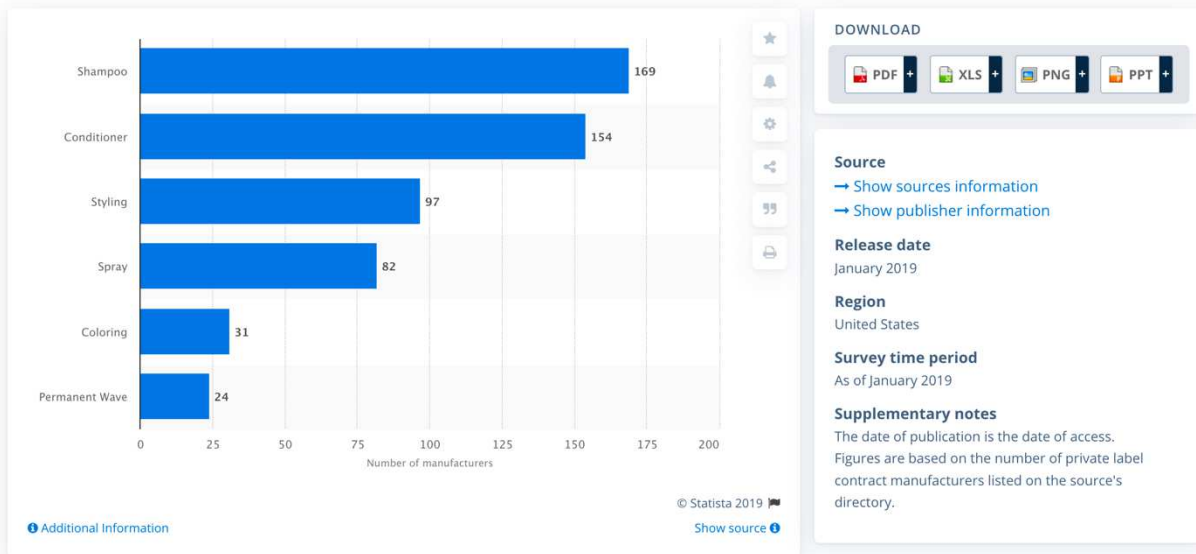
from the Registrant’s website showing exemplary pricing for the Registrant’s skincare system is attached hereto as **Exhibit C**. It is unlikely that consumers looking to buy very specialized high end luxury skin care products, such as Registrant’s, would encounter the Applicant’s hair brush products.

Furthermore, the Examining Attorney states that the goods (hair brushes and skin care products) are sold together, however, this is not common, but rather an exception. There are approximately 169 contract manufactures in the US that make shampoo, 154 that make conditioner, and 97 that make styling products.

Consumer Goods & FMCG › Cosmetics & Personal Care

PREMIUM +

### Number of contract manufacturers of hair care products in the United States as of January 2019, by product category



The majority of manufacturers do not make brushes. Accordingly, brushes and hair products with the same brand are not likely to be perceived by a purchaser as having the same

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only be used as a part of the overall skincare system, which much include the specialized formulator device, which retails for about \$450.

origin. Furthermore, there is a difference between a hair product company that might have one or two skin care products, and a cosmetic products company that might have some hair care products.

Thus, considering the above facts and evidence, the Applicant's and the Registrants' goods are not likely to be sold to the same consumers and travel in the same channels of trade.

#### **D. ROMY IS WEAK BY VIRTUE OF THIRD-PARTY USE**

The differences in the marks is made more important by the relatively common occurrence of ROMY (or phonetic equivalents thereof) as a trademark in the relevant industry.

The sixth *Du Pont* factor concerns the extent to which multiple parties use the same terms. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Even where the record lacks proof of actual third-party use and the extent of third-party use, third-party registration evidence may show that a term carries a highly suggestive connotation in the relevant industry and therefore may be considered somewhat weak. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

Below are the most relevant active U.S. trademark registrations that include the term "ROMY" and/or similar variations of such term:

- 1- US TM Registration No. 4,342,828 (ROMI) in IC 003; 005; 007; 008; and 020
- 2- US TM Registration No. 5,258,618 (ROMY) in IC 009; 016; 025; and 041;
- 3- US TM Registration No. 4,976,618 (ROMY & AKSEL) in IC 009; 018; IC; and 025;
- 4- US TM Registration No. 5,510,684 (ROMY & AKSEL) in IC 009; 024; 025; and 035;

5- US TM Registration No. 4,766,293 (ROMY & RAY) in IC 025.

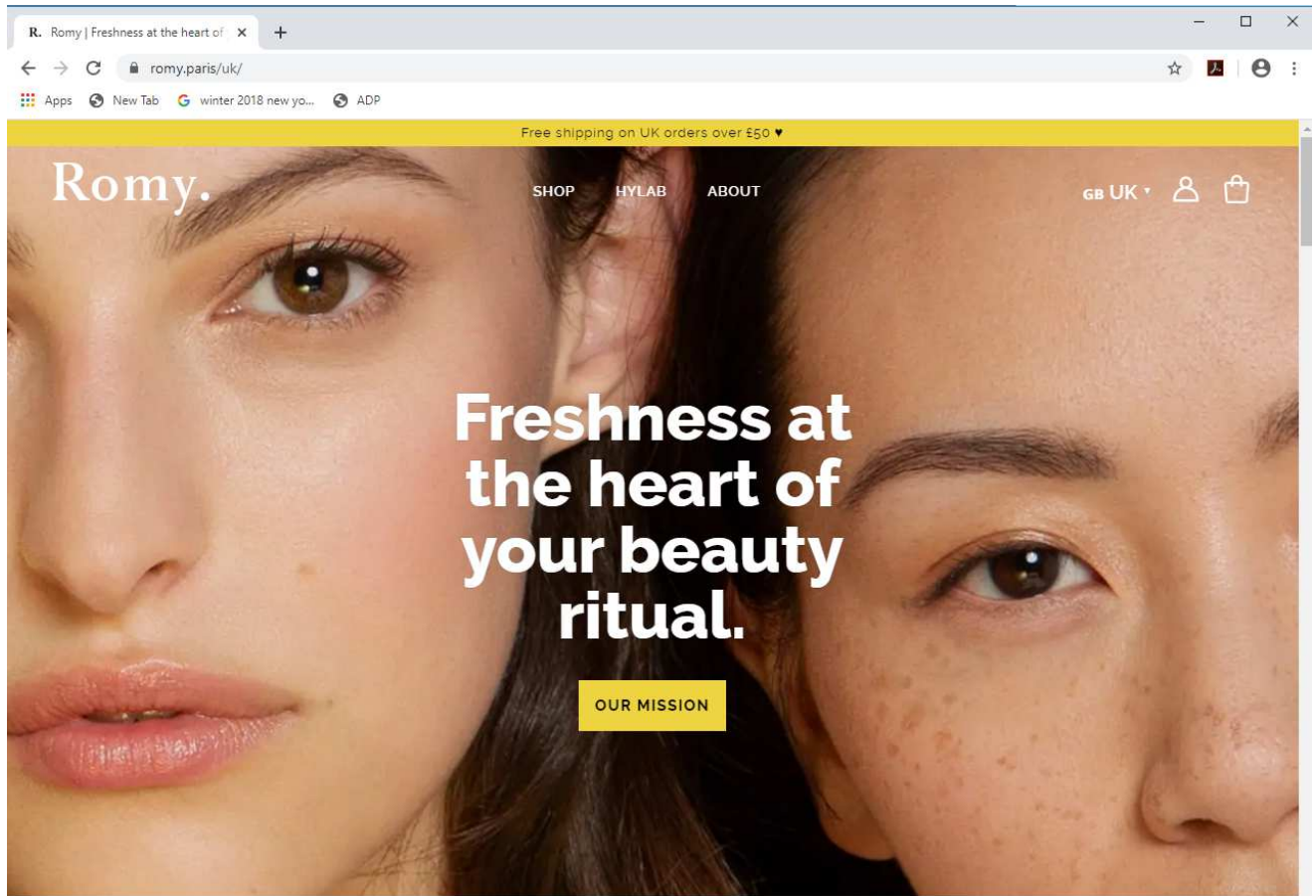
The TSDR records are attached as **Exhibit D**. These third-party marks are all used in connection with personal care products and related products, yet are all registered in the Trademark Office and owned by different entities.

The evidence demonstrates that consumers in the relevant field already encounter multiple trademarks featuring the term ROMY (or its phonetic equivalents) owned by different parties. Given the number of registrations for goods in the relevant field featuring the term ROMY, the Registrant's mark is entitled to a narrow scope of protection. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

In light of the differences between the goods and channels of trade for the respective marks, as discussed above, the refusal to register should be withdrawn.

**E. REGISTRANT'S MARK IS PREDOMINANTLY USED TOGETHER WITH ANOTHER HOUSE MARK, HYLAB**

Applicant points out that the Registrant's mark is predominantly used on the Registrant's skincare products together with another mark, HYLAB. This is very apparent from review of the Registrant's website at <https://www.romy.paris/uk/>. For example, the website home page has only three clickable menu tabs on top – "SHOP," "HYLAB," and "ABOUT" – see below:



Under the “SHOP” tab, the majority of products are listed under the HYLAB mark, e.g. HyLab Discovery Kit, HyLab Capsules, HyLab Bases, etc. (see a screenshot attached hereto as **Exhibit E**). It appears that at least some of the product packaging also features the HYLAB mark (and other packaging only lists “R.” mark) – see a screenshot below:





Since the consumers can only purchase the Registrant’s products from its website, they will be inevitably encountering the Registrant’s ROMY mark together with prominently featured HYLAB mark. In fact, as is clear from the Registrant’s website, all of its skincare products under the Registrant’s mark center around its “personal skincare lab” – HYLAB. Thus, consumers will most likely recognize the name HYLAB (and not ROMY) as the source indicator for the Registrant’s goods, as evidenced by customers reviews on the Registrant’s website at <https://www.romy.paris/uk/they-talk-about-us/> reproduced below:

## LE JOURNAL DES FEMMES



"Always powerful active ingredients, a compact format, a more accessible price. The new personal skincare lab HyLab may be emulated."

## BEAUTY FORUM



"No more impersonal skincare, now, with HyLab, the personal skincare lab, you can create your daily skincare dose in a few minutes and, especially, adapt it to your skin's needs."

## COSMETICS BUSINESS



"HyLab allows users to customise their skin care formula depending on their needs. With 12 active ingredients to choose from, the products range from Sorghum Juice, to help tackle signs of ageing, to Mexican Aloe Vera to improve hydration. Customers can choose from up to two ingredients at each time to use with Romy's Primary Face Cream."

All of this minimizes the likelihood of confusion with the Applicant's mark and respective goods under the mark and weighs against finding the likelihood of confusion.

Accordingly, Applicant requests that the Board reverse the Examiner and allow Applicant's application to proceed towards registration.