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Subject: U.S. Trademark Application Serial No. 79246019 - ROMY - 07494-T0001A - EXAMINER BRIEF

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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 79246019

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EXAMINING ATTORNEY'S APPEAL BRIEF

International Registration No. 1435744

Statement of the Case

The applicant has appealed the examining attorney's refusal to register the mark ROMY, Ser. No. 79246019, for "hair brushes, hair combs, hair styling comb and brushes, rotary hair brushes, electrically heated hair brushes," based upon a likelihood of confusion with U.S. Reg. No. 5477794 for ROMY 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” under the terms of Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Statement of Facts

This application was filed on November 22, 2018, based upon a request for extension of protection pursuant to Trademark Act Section 66(a).

On December 6, 2018, the examining attorney’s refusal to register was processed and transmitted to the applicant. The examining attorney refused registration based upon a likelihood of confusion with U.S. Reg. No. 5477794 for ROMY. The examining attorney also required the applicant to clarify the nature of the entity applying for the mark and to provide a more definite identification of goods.

The applicant responded on June 5, 2019, arguing against a likelihood of confusion and addressing the informalities.

On June 27, 2019, the examining attorney made final her refusal based upon a likelihood of confusion. The examining attorney accepted the applicant’s clarification regarding its entity type, and made final her requirement for a more definite identification of goods.

The applicant requested reconsideration on December 27, 2019. The applicant argued against a likelihood of confusion. The applicant also submitted a correct identification of goods. The corrected identification of goods was entered.

On December 31, 2019, the examining attorney denied reconsideration of the likelihood of confusion issue.

This appeal followed.

Issue

Is there a likelihood of confusion between Ser. No. 79246019 for ROMY for “hair brushes, hair combs, hair styling comb and brushes, rotary hair brushes, electrically heated hair brushes,” and U.S. Reg. No. 5477794 for ROMY 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” under the terms of Trademark Act Section 2(d), 15 U.S.C. §1052(d)?

Argument

I. The Board Should Consider Only Evidence Properly Made of Record

The examining attorney objects to the applicant’s inclusion of evidence not made of record prior to appeal. At page 15 and page 17 of the applicant’s brief, the applicant has included evidence that was not submitted prior to this appeal. This evidence consists of a screen capture from the registrant’s web site and a series of customer reviews of the registrant’s products. The applicant also has stated that the registrant’s goods sell for \$450. The applicant claims to have submitted proof of this as Exhibit C to its appeal brief. (Br. at 11-12). The applicant’s appeal brief does not include an Exhibit C. Even if Exhibit C were present, the evidence referred to was not introduced prior to the appeal.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because the applicant’s new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Inn at St. John’s, LLC*, 126 USPQ2d 1742,

1744 (TTAB 2018); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

II. **The Marks Themselves Are Identical**

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (*quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, the applicant's mark is ROMY and the registrant's mark is ROMY. These marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods. *Id.*

Therefore the marks are confusingly similar.

III. **The Parties' Goods Are Related**

In a likelihood of confusion case, the parties' goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The applicant's goods are:

Hair brushes, hair combs, hair styling comb and brushes, rotary hair brushes, electrically heated hair brushes.

The registrant's goods are:

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.

As an initial matter, the applicant and the registrant both provide products to be used on hair. Further, in her first office action in this case, the examining attorney made of record evidence that hair brushes like the applicant's frequently are sold together with hair preparations like the registrant's, specifically shampoo, conditioner, and hair styling products. The evidence included screen captures showing that Aveda, Redken, and Drybar all offer both types of products. In connection with her final refusal, the examining attorney supplemented the record with further evidence that Nexxus, John Paul Mitchell, R+Co, and Oribe all offer both hair brushes and hair care preparations including shampoo and conditioner under a single mark. This evidence is sufficient to demonstrate that the applicant's and the registrant's goods are related.

In arguing against this evidence, the applicant has attempted to narrow the registrant's identification of goods with external evidence. The applicant argues that the registrant offers a "customized made to measure skin care system" (Br. at 7) only available from the registrant's web site (Br. at 10). The registrant's identification of goods, however, contains no such limitations. Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903

F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

The applicant next contends that the registrant's mark ROMY invariably is used with the registrant's house mark HYLABS. Again, the registration for ROMY standing alone must be taken at face value; the registrant is under no obligation to make sure that its ROMY trademark is accompanied by the HYLABS house mark.

The applicant also refers to a chart that shows the number of contract manufacturers of hair products in the United States. This chart is not helpful for several reasons. First, a manufacturer domiciled outside the U.S. still may sell products here (for example, the famous L'Oreal products originate in France).¹ Second, a "contract" manufacturer is just one type of company; other types of companies also may make hair products. Finally, the chart does not provide any information about how many makers of shampoo and conditioner also make hair brushes. The bar on the chart labeled "styling" does not necessarily refer to brushes and the applicant has not included a definition of the term "styling" product. In fact, it appears more likely that "styling" as used in the chart would be taken in its ordinary meaning, in which it refers to preparations used for styling the hair such as mousse and finishing cream. Nothing in the chart discusses a relationship between hair styling preparations and hair brushes. Without further explanation of its meaning, the chart proves very little.

The applicant further argues that ROMY is dilute due to third party use. To prove this, the applicant relies upon only five registrations, two of which include other distinctive wording.

¹ Moreover, the argument that the registrant is not making proper use of its trademark does not belong in this appeal. That argument would be appropriate only in a cancellation proceeding. Collateral attacks on the cited registration are not available in this forum. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv).

Moreover, only the applicant and the registrant use ROMY to identify products for use on the hair; ROMY therefore is not dilute in connection with these goods.²

Finally, the applicant argues that consumers of the goods in question are sophisticated. The applicant states that the registrant's goods cost \$450, and claims that evidence of this is attached as Exhibit C. No Exhibit C was attached to the appeal to the examining attorney. More importantly, as discussed previously, this evidence was not made of record prior to appeal. The evidence that the applicant did make of record prior to appeal showed that the registrant's starter kit cost only 34.90€. See evidence attached to response dated December 27, 2019. Beyond that, even if consumers of the goods could be considered sophisticated and discriminating, it is settled that "even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and related goods [and/or services]."³ *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015) (citing *In re Research & Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); see also *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). The identity of the marks and the relatedness of the goods "outweigh any presumed sophisticated purchasing decision." *In re i.am.symbolic, llc*, 116 USPQ2d at 1413 (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)); see also *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

Thus, the examining attorney has demonstrated with evidence that many companies offer both hair brushes and hair care preparations. The applicant has not supported its claims that the

² Again, the applicant claims to have attached copies of these registrations in an exhibit to the appeal brief. No exhibits were attached to the applicant's appeal brief. The applicant did, however, make of record certain TESS printouts prior to the appeal. The printouts are incomplete. The examining attorney, however, has treated these registrations as being part of the record.

³ The applicant's brief states, "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." (Br. at 13). The applicant does not state why this is so, or support this claim with any evidence.

products travel in different channels of trade, that the word ROMY is dilute, or that consumers of such products are sophisticated. A likelihood of confusion exists between two identical marks for ROMY when the examining attorney has proven that hair brushes and hair care preparations are related goods.

Conclusion

The parties' marks are identical. The examining attorney has shown that it is common for the applicant's goods and the registrant's goods to be sold by a single entity using a single mark, making the goods related. Accordingly, the examining attorney's refusal to register the applicant's mark based upon a likelihood of confusion with U.S. Reg. No. 5477794 should be *affirmed*.

Respectfully submitted,

/Doritt Carroll/

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