

ESTTA Tracking number: **ESTTA1005946**

Filing date: **10/02/2019**

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	ICON S.R.L.		
Entity	Limited Liability Company	Citizenship	Italy
Address	Via G. Di Vittorio, 11 Cadriano di Granarolo dell'Emilia Bologna, I-40057 ITALY		

Attorney information	Dennis H. Cavanaugh D H Cavanaugh Associates 555 Fifth Avenue FL 17 New York, NY 10017 UNITED STATES dhc@dhcavanaugh.net 212-856-7210		
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Applicant Information

Application No	88415387	Publication date	09/03/2019
Opposition Filing Date	10/02/2019	Opposition Period Ends	10/03/2019
Applicant	United Beauty Brands, LLC 811 West Seventh Street Los Angeles, CA 90017 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 2017/05/00 First Use In Commerce: 2017/05/00 All goods and services in the class are opposed, namely: Body oil; body scrub; body lotion; facial lotion; skin cleansing lotion; facialcream; body cream; skin cream; cosmeticpreparations for body care; body sprays; body gels for cosmetic purposes; bath bombs; non-medicated body soaks; bath foam; non-medicated skin and facial cleansers; essential oils for aromatherapy use; shower mists, namely, cosmetic preparations for the shower; scented room sprays; deodorants for body care; fragrances and perfumery

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration	3725751	Application Date	10/31/2008
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No.			
Registration Date	12/15/2009	Foreign Priority Date	NONE
Word Mark	O WAY		
Design Mark			
Description of Mark	The mark consists of the letter "O" located above a horizontal line appearing above the word "WAY".		
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Hair care and cleaning preparations, inparticular shampoos, creams, mascaras, beauty serums, mousse, hair dyeing, colouring and decolouring preparations and products, namely, hair colorants, hair decolourants, cosmetics based on hydrogen peroxide</p> <p>Class 005. First use: First Use: 0 First Use In Commerce: 0 [Medicated hair preparations; pharmaceutical preparations, namely, anticoagulants, antidepressants, appetite suppressants; sanitary preparations for medical use]</p>		

Attachments	79062756#TMSN.png(bytes) Icon v United Beauty Brands - OUAI Notice of Opposition.pdf(75243 bytes)
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Signature	/Dennis H. Cavanaugh/
Name	Dennis H. Cavanaugh
Date	10/02/2019

NOTICE OF OPPOSITION

Pursuant to Trademark Rule 2.102, ICON S.R.L., an Italian limited liability company having an office and place of business at Via G. Di Vittorio, 11, Cadriano di Granarolo dell'Emilia, I-40057 Bologna, Italy (“Opposer” or “Icon”), believes that it is and will be damaged by registration of the mark shown in Application Serial No. 88/415,387 in International Class 3, and therefore opposes the same. As grounds for its opposition it alleges that:

1. The Applicant, United Beauty Brands, LLC (“Applicant”), is upon information and belief, a California limited liability company with a principal address at 811 West Seventh Street, Los Angeles, California 90017.

2. On or about May 3, 2019, Applicant filed the above-referenced trademark application under Section 1A to register the mark OUAI for “Body oil; body scrub; body lotion; facial lotion; skin cleansing lotion; facial cream; body cream; skin cream; cosmetic preparations for body care; body sprays; body gels for cosmetic purposes; bath bombs; non-medicated body soaks; bath foam; non-medicated skin and facial cleansers; essential oils for aromatherapy use; shower mists, namely, cosmetic preparations for the shower; scented room sprays; deodorants for body care; fragrances and perfumery” in International Class 3.

3. Opposer adopted and has been using the mark OWAY in interstate commerce since at least as early as November 16, 2005, as a trademark to identify its products. Opposer continues to use the trademark to identify its hair care and cleaning preparations, and such use has never been abandoned.

4. Icon was founded in 1948 in Bologna, Italy. It has a presence in over 70 countries worldwide. Icon markets a wide range of hair care and treatment products for men and women.

Based on the biodynamic, zero-mile, organic, and fair-trade ingredients, Icon creates agricosmetic treatments and rituals combining extraordinary performance with healthful formulations which have a high concentration of botanical ingredients. Icon has a profound belief in respect for the environment and for promoting waste reduction. Each and every formulation, packaging, material, individual article or tool is designed to have a minimal environmental impact and to be long-lasting or reusable and composted or transformed into a new resource. Its products' high concentration of botanical active ingredients and their incredible effectiveness when applied in the right amount make them perfect for a wide variety of uses. Icon packages its formulations in glass bottles and jars and aluminum tubes which are reusable and recyclable. Icon avoids using unnecessary packaging and wrapping materials. All of its tools, items and articles are made of wood, glass, aluminum, organic regenerated cotton, recycled paper and many other natural ecological materials.

5. Opposer is the owner of the following registration for the mark OWAY on the Principal Register, which registration is valid and subsisting and has never been abandoned: Registration No. 3,725,751, issued December 15, 2009, for "Hair care and cleaning preparations, in particular shampoos, creams, mascaras, beauty serums, mousse, hair dyeing, colouring and decolouring preparations and products, namely, hair colorants, hair decolourants, cosmetics based on hydrogen peroxide" in International Class 3.

6. Applicant's filing date of May 3, 2019 is subsequent to Opposer's date of first use of its OWAY mark, November 16, 2005. Applicant's claimed dates of first use, May 2017, are also subsequent to Opposer's date of first use of its OWAY mark, November 16, 2005, and the date of Opposer's registration of its OWAY mark, December 15, 2009. Thus, priority is not at issue.

7. Applicant's mark OUAI is confusingly similar in sight, sound and meaning to Opposer's OWAY mark. Applicant's mark is virtually identical to Opposer's mark. Consequently,

Applicant's mark so closely resembles Opposer's mark as to be likely to be confused with and mistaken for Opposer's mark. As a result, there is a significant likelihood of confusion between Applicant's mark and Opposer's mark.

8. Applicant's products are closely related to and/or encompass one or more of the products of Opposer, thus increasing the likelihood of confusion that may result from registration and use of Applicant's mark. Indeed, products of the type covered by both Applicant's application and Opposer's registration for OWAY often emanate from and are likely to be perceived by consumers as emanating from and/or being offered under the same trademark.

9. Opposer has invested substantial time, effort and money in using and promoting its OWAY mark and the goods bearing it. Through such prior use, promotion and advertising, Opposer has built up a valuable and protectable goodwill associated with its OWAY mark. By virtue of Opposer's continuous, exclusive and widespread use of its OWAY mark it has become well-known by the relevant purchasing public as a trademark of Opposer.

10. Registration of Applicant's mark is likely to cause the relevant purchasing public to be confused, misled or deceived, and to falsely believe that Applicant's goods are affiliated, associated, approved, sponsored, licensed or authorized by Opposer or others authorized or licensed by Opposer to use the OWAY mark. Persons familiar with Opposer's mark are likely to purchase Applicant's products believing they are marketed by, affiliated with or endorsed by Opposer, when in fact they are not.

11. Registration of Applicant's mark is likely to cause harm and damage to Opposer and its mark by causing confusion, mistake and/or deception as to the respective rights of the parties and as to the source of the products marketed and sold bearing Applicant's mark, and by constituting a

cloud on Opposer's prior established rights in its OWAY mark. Such registration would give Applicant at least a *prima facie* right to use Applicant's mark, thereby causing continuing serious and irreparable harm to Opposer's rights in its mark, its business and to the goodwill of such business symbolized by Opposer's mark. Registration of Applicant's mark will also tend to reduce the distinctiveness, value and goodwill of Opposer's mark.

WHEREFORE, Opposer believes that it will be damaged by registration of the Applicant's mark in International Class 3, Application Serial No. 88/415,387, and opposes registration thereof on the grounds set forth above. Opposer further prays that Application Serial No. 88/415,387 be rejected, and that registration of Applicant's mark therein sought for the goods specified therein in International Class 3 be denied and refused.

Dated: New York, New York
October 2, 2019

Respectfully submitted,

ICON S.R.L.

/Dennis H. Cavanaugh/

By: _____

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