IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of L'OREAL

Mark: REPLICA
Serial No. 88/285,792

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Commissioner of Trademarks
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OFFICE ACTION RESPONSE

In an Office Action issued on April 15, 2019 (the "Office Action"), the Examining Attorney has refused registration of the REPLICA mark (the "Mark") Serial No. 88/285,792 (the "Application") in International Class 3 for (as amended contemporaneously herewith)"perfumed soaps; perfumes; eau de cologne; toilet waters; eau de parfum; personal deodorants; cleaning and air fragrancing preparations; scented body lotions and creams; essential oils; shaving preparations; aftershave preparations" (the "Goods") pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis that the Mark is confusingly similar to U.S. Registration No. 2,407,572 for REPLICA for "manually operated hand pump for spraying liquid out of receptacles" in International Class 8 and "cosmetic make-up applicators, perfume atomizers sold empty, perfume sprayers sold empty, applicators and distribution apparatus for perfumes, vaporizers for perfumes sold empty and parts therefore" in International Class 21(sometimes also referred to as the "Cited Mark"). L'OREAL ("Applicant") respectfully requests that the Examining Attorney consider the arguments below to reverse her finding and approve the Application for publication.

ARGUMENT

The test for likelihood of confusion under Section 2(d) of the Lanham Act is "whether the applicant's mark so resembles any registered mark(s) as to be likely to cause confusion or mistake, when used on or in connection with the goods or services identified in the application." TMEP § 1207.01. The Lanham Act does not provide a "mechanical test for determining likelihood of confusion." *Id.* Rather, certain factors must be weighed to assess whether confusion is likely as set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Notably, "not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 U.S.P.Q.2d 1257, 1259 (Fed. Cir. 2010). As set forth below, the relevant *Du Pont* factors supports a finding that the Applicant's Mark and the Cited Mark can co-exist in the marketplace without confusion. That is: (1) the marks viewed in their entireties create different commercial impressions; (2) Applicant's Goods and those of Registrant travel in different channels of trade, are sold under different conditions and target different consumers; and (3) there is no evidence that the Cited Mark is famous.

(1) The Marks Create Entirely Distinguishable Commercial Impressions

To determine the likelihood of confusion between two marks, those designations must be considered as the public perceives them. *Martin v. Crown Zellerbach Corp.*, 422 F.2d 918, 165 U.S.P.Q. 171 (C.C.P.A. 1970), cert. denied, 400 U.S. 911 (1970); *Opryland USA v. Great Am. Music Show*, 970 F.2d 847, 851, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992). That is, "**[d]etermining whether there is a likelihood of confusion requires careful consideration of the overall commercial impression** created by each mark." *In re Nat'l Data Corp.*, 753 F.2d

1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); TMEP § 1207.01(b)(iii)) (emphasis added). "**Commercial impression" refers to "what the probable impact will be on the ordinary purchaser in the marketplace**." *T.W. Samuels Distillery, Inc. v. Schenley Distillers, Inc.*, 458 F.2d 1403, 1404, 173 U.S.P.Q. (BNA) 690, 691 (C.C.P.A. 1972) (emphasis added). As a result, **the use of identical, even dominant, words in common does not automatically mean that two marks are similar**. *Freedom Sav. & Loan v. Vernon Way*, 757 F.2d 1176, 1183 (11th Cir. 1985). Instead, it is the impression that the mark as a whole creates on the average reasonably prudent buyer that is important." McCarthy on Trademarks § 23:41 (6th ed. 2013).

As applied here, the above rules support a finding that there is no likelihood of confusion between REPLICA for cl. 3 fragrances and related scented preparations and the Cited Mark for cls. 8 and 21 receptacles and parts therefor sold empty. That is, the impact of REPLICA as applied to the parties' different goods supports a finding that consumers will attribute such different meaning to the two that the same are not likely to be confused. On the one hand the Applicant's Mark, REPLICA, used in connection with fragrances and other scented products, suggests that the product in question is a reproduction or new interpretation of a familiar scent or moment. In fact, Applicant's REPLICA Goods are marketing under product names such as a "beach walk," "coffee break" "under the lemon tree" and "by the fireplace," among others, all of which further reinforce the notion that REPLICA refers to the scent being an imitation of some other smell encountered in one's life. The commercial impression created by Applicant's Mark is actually unmistakable in that it is spelled out on its labels which read "**REPRODUCTION OF FAMILIAR SCENTS AND MOMENT OF VARYING LOCATION AND PERIODS**" in each case under the REPLICA mark.

An example of such a label which is also the subject of U.S. Registration No. 5,838,582 is reproduced below for reference along with a screenshot of Applicant's product labels as featured on its website[1].

Mark that is the subject of U.S. Registration No. 5,838,582.

Screenshot of Applicant's official webpage offering its "UNDER THE LEMON TREES" product under the REPLICA mark

[1] A copy of Applicant's website offering the Goods and TSDR copies of Applicant's various registrations and pending applications for REPLICA labels are attached as Exhibit A hereto.

The label reads REPLICA followed by the statement "**REPRODUCTION OF FAMILIAR SCENTS AND MOMENT OF VARYING LOCATION AND PERIODS**" further followed by the product name "UNDER THE LEMON TREES" and a product description as "relaxing and bright lemon." This same exact format is followed on each of Applicant's various REPLICA products and scents. In reviewing the above and the context in which the Applicant's Mark is encountered by a consumer, it is clear that the commercial impression conveyed by REPLICA is a very specific one calling on consumers to use their imagination to remember a place, moment or time. In this way, Applicant's Mark promises to transport a consumer back in time, through his or her senses, to that REPLICAted moment, place or thing. What is unquestionable is that REPLICA, as used by Applicant refers very specifically to the contents of the bottle being sold.

In contrast, the Cited Mark is used by Registrant as a supplier of various kinds of generic pumps, vaporizers and applicators as packaging for other businesses' products (as further described in Section 2 below). A review of Registrant's use of REPLICA indicates that the Cited Mark is used as the name of a product line in its business-to-business catalogue in which its products are featured and offered for sale to businesses. A copy of Registrant's catalogue featuring its REPLICA line of products, a part of which was submitted as its most recent specimen with the United States Patent and Trademark Office ("USPTO") is attached hereto as Exhibit B. Of note, the catalogue description of the Registrant's REPLICA product line refers to it as a set of smaller-sized containers with capabilities that are comparable (*i.e.* which replicate) the bigger ones. In this way, a purchaser of Registrant's goods (*i.e.* a manufacturer of personal care products *choosing a bottle for its design and functionality*) would understand REPLICA for these smaller-sized bottles and vaporizers to mean that they function *just as well* as the larger,

standard-size receptacles. Even without that additional context, REPLICA for bottles and containers sold empty creates a different impact than does Applicant's REPLICA for perfumes. That is, REPLICA, by definition, conveys the notion that the product offered "imitates" something. In the context of a perfume, it is clear (particularly as used by Applicant on its labels as shown above) that it is the scent, *i.e.* the contents of the bottle and not the bottle itself, that is intended to reproduce or imitate something, namely another smell. In comparison, REPLICA for empty containers designed to be filled and rebranded for resale by the purchaser thereof is likely to be viewed as referring to the bottle itself. A purchaser of Registrant's goods (a "Reseller") is likely to look for and focus on the specific attributes of the bottle. As a result, such a Reseller's understanding of REPLICA will almost unequivocally relate to the functionality or other characteristic of the bottle as imitating something else. One interpretation could be that the bottle or its functionality "replicates" a well-known bottle-shape for an unrelated product (e.g. liquor bottle). Another, interpretation of REPLICA in that context might be that the bottle imitates an antique perfume bottle by using an applicator rather than a vaporizer. Finally, Registrant's REPLICA could refer to the shape resembling a common symbol, idea or expression (*e.g.* for a bottle shaped like a star,

REPLICA would be understood to mean it replicates a star).

Finally, in the context of Registrant's catalogue information and as noted above, the REPLICA line, might also be understood to mean that the smaller REPLICA bottles "replicate" the larger ones in some way or another. ***What is clear, and most relevant here, is that however many interpretations may be attributed to REPLICA in the context of empty receptacles and bottles marketed to be repurposed and resold, the idea that the contents of that bottle replicate a familiar scent (i.e. the very image conveyed by the Applicant's Mark) is distinctly not one of***

them. Accordingly, despite the general rule that a likelihood of confusion *may* result when there are similar terms or phrases appearing in two marks, an important and relevant exception applies here where the Cited Mark and the Applicant's Mark, ***viewed in the context of how they are marketed,*** convey significantly different commercial impressions. *See, e. g., Shen Manufacturing Co. v. Ritz Hotel Ltd*., 393 F.3d 1238, 73 U.S.P.Q.2d (BNA) 1350 (Fed. Cir. 2004)(finding RITZ and THE RITZ KIDS to create different commercial impressions).

2) ***Applicant's Goods and those of Registrant travel in different channels of trade, are sold under different conditions and target different consumers***

As noted, because it is a balancing test, the similarity of the marks on its own is not always sufficient to establish a likelihood of confusion. T.M.E.P. § 1207.01(a)(i). "If goods or services in question are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." *Id*. (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012)(affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark).

The situation at issue here is exactly that which is described in *Coach Servs* above. That is, on one hand, Applicant sells high-end luxury fragrances and related cosmetics to end-consumers at retail (in beauty stores or beauty e-commerce websites) such as Sephora brick and mortar stores or on Sephora.com[2]. On the other hand, Registrant is a "leading global supplier of a broad range of innovative dispensing, sealing and active packaging solutions for the beauty,

[2] See Exhibit C.

personal care, home care, prescription drug, consumer health care, injectables, food and beverage markets."[3] Simply put, Registrant is the supplier of packaging materials designed to be repurposed and resold by companies like Applicant to encase and market its core product offerings, (*e.g.* cosmetics, food, home care or drugs) to end consumers.[4] While Registrant's goods target businesses in need of packaging solutions for their products to be resold, Applicant targets men and women looking for luxury fragrances and scented products for the personal use. In this way, Applicant sells its goods by the item and directly to end-consumers through retail, while Registrant is a business-to-business operation selling its products in large quantities at wholesale. ***As such, not only do the parties' goods travel in different channels of trade and target different customers, but those trade channels and consumers are so distinguishable in fact that there is virtually no overlap between them. In other words, the parties' goods would virtually never be marketed in the same place or to the same person under the REPLICA name.***

Moreover, a company that uses Registrant's REPLICA line of goods to encase and package its end-product and sell it to end consumers, would never sell it under the REPLICA mark. Rather, the relevant container, once purchased from Registrant, is re-branded with the trademark of the Reseller to indicate the source of its ***contents***—as the source of the bottle that point becomes irrelevant.[5] In fact, the Registrant's specimen filed with the USPTO clearly illustrates this as it shows only its REPLICA products as repurposed and resold by Resellers under only their house mark *e.g.* "Dream Angels," or "Cartier." Clearly then, end-consumers are never presented with Registrant's use of REPLICA.

[3] See Printout from Registrant's official business website attached hereto as Exhibit D.
[4] See *Id*.
[5] See above at Exhibit B.

What is also clear is that a business seeking to buy containers in which to package its goods, including fragrances, would not be looking for such products on the shelves of a retail store selling its very competitors' products in individual quantities to end-consumers. As such, there is no situation under which a reseller, coming across Registrant's supply of REPLICA receptacles in a business-to-business catalogue would later be confused as to the source of Applicant's REPLICA perfumes in a retail store. This is particularly true here where the degree of care that is applied by a reseller purchasing packaging for its core products (a key business decision for any consumer-product company) is one that is likely to involve great research and attention to detail as to quality and source. In other words, even if a business seeking to purchase Applicant's REPLICA perfumes knew of Registrant's REPLICA line of packaging goods (and even assuming there was any remote possibility of that purchaser making a connection between the two, which Applicant has shown above is nearly impossible) the amount of care and decision-making that would go into that process would necessarily dispel any possibility of confusion. In other words, nothing about Registrant's or Applicant's common use of REPLICA in the different contexts at play here would allow either to free-ride on each other's goodwill.

Based on the above, regardless of any similarity between the marks (which, as shown in Section 1, is minimized by the strikingly different commercial impressions created by each mark), **the very fact that the products would never be encountered in the same trade channel or offered for sale to the same consumers, unquestionably negates any likelihood of consumer confusion.**

3) There is no evidence that the Registered Mark is Famous

Finally, in determining a likelihood of confusion, the Examining Attorney may also consider the level of fame associated with the prior registrant. *In re E.I. du Pont de Nemours &*

Co., 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973). In this particular instance, the Examining Attorney has submitted no evidence demonstrating that the Cited Mark has acquired a level of fame and/or notoriety such that the ordinary consumer would immediately believe that Applicant's services marketed under the REPLICA mark actually emanate from and/or are otherwise associated with the Registrant. Furthermore, the record is devoid of any evidence in the nature of either of the registrant's and Applicant's sales/profits and advertising. This additional factor weighs heavily against a finding of likely confusion.

Accordingly, there is room on the Register for Applicant's Mark in cl. 3 to peacefully co-exist with the Cited Mark in cls. 8 and 21. Applicant's Mark creates an entirely different commercial impression than does the Cited Mark, the parties' goods travel in different trade channels and are marketed to different customers under different conditions such that there is virtually no possibility of confusion between the marks.

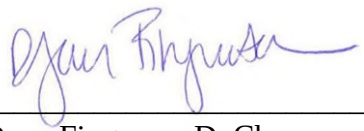
CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the Application be approved for publication.

Dated: October 14, 2019

Respectfully submitted,

PRYOR CASHMAN LLP



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