

## **OFFICE ACTION RESPONSE**

Date: January 17, 2020  
Mark: UPPER CANADA SOAP  
Serial: 88604985

The applicant hereby requests that the examiner reconsider and place this mark on the Principal Register, as the following proves that the mark has become distinctive in the industry for the products and services covered through its continuous use since 1969 in USA.

/Stephen Flatt/  
Stephen Flatt, President  
January 17, 2020

## **REVISION OF GOODS IN CLASS 03**

Applicant accepts the examiner's recommended goods in class 03, as per below:

*Pre-moistened cosmetic wipes for the face; facial masks; Under-eye enhancers; Cosmetic facial mud masks; cosmetic cream masks; skin care preparations, namely, facial masks for skin peels; make-up remover lotions; bath products and personal care items, namely, body lotion, body cream, body wash, body scrub, **non-medicated** hand wash, hand cream and non-medicated bath salts; non-medicated foot care products, namely, foot creams, lotions, scrubs, and skin masks; Hand masks for skin care; Gel eye masks; Cleaner for cosmetic brushes*

## **DECLARATION OF ACQUIRED DISTINCTIVENESS**

The applicant hereby requests that the examiner please reconsider putting this application on the Principal Register. Due to its long term use in Canada, the USA and around the world as evidenced below, the brand UPPER CANADA SOAP has acquired distinctiveness for the class 03 goods listed above and many others.

**Upper Canada Soap** is synonymous with personal care products under the same name, since 1985. On-line, worldwide, one can find 1000's of references to "Upper Canada Soap" products, simply by typing in that name to any of dozens of search engines, USPTO's TESS, WIPO and TMView international trademark databases, most social media outlets, and dozens of industry specific publications and events.

Please see evidence below:

- 1) **Previous Use In Part – in USA**

ANTI-STRESS BY UPPER CANADA	2353096 Registered Since 2000 (in use since 1985)
NATURALLY UPPER CANADA	1938475 Registered Since 1995
BODY TRUFFLES BY UPPER CANADA	3625112 Registered from 2009 to 2017

- 2) **International Trademarks**

Upper Canada Soap has 7 trademark registrations in Canada using the combined terms "UPPER CANADA" covering personal hygiene and other products over many class codes (03, 04, 05, 08, 10, 16, 21, 25, 28, 29, 30) showing use dating back to 1969.

Via catalog, and later on-line sales, the products covered by all 7 Canadian trademarks and the 3 USA trademarks have been available for purchase in the USA for over 40 years.

The Use In Commerce date of 1985 refers to the date when the products were shipped to USA, to be sold from USA outlets. However, the brand was available for sale to USA customers as early as 1969 via catalog.

3) **Search Engine Presence**

No related (personal hygiene) products come up in a keyword search for “UPPER CANADA SOAP” other than those manufactured and sold by the applicant Upper Canada, clearly showing the name is unique and well known in the industry.

--A search on Google search engine returns 20.7 million results.

--A search on Bing search engine returns 1.76 million results.

--A search on Yahoo search engine returns 1.76 million results.

--A search on Yippy search engine returns 5.12 million results.

--A search on AOL search engine returns 5.21 million results.

--A search on YouTube returned over a dozen videos on the brand.

--A search on LinkedIn returns 3 company pages with 1000's of followers and dozens of employees.

--A search on Facebook returns a company page and 100's of product related posts going back at least 10 years.

--Relevant results were returned in other search engines: DUCK DUCK GO, INTERNET ARCHIVE, YIPPY, ASK, EXCITE, DOGPILE, PINTEREST, among others.

4) **Purchase Availability**

Anyone in the USA, and worldwide can search for and buy 1000's of Upper Canada Soap products on-line, such as:

Amazon (available worldwide on-line)

Walmart (available worldwide on-line)

Ross Stores, Inc. (USA, retail stores only)

E-bay (available worldwide on-line)

Flipkart.com (available worldwide on-line)

Hudson's Bay (available worldwide on-line)

1Outlets.com (available worldwide on-line)

Kitchen Stuff Plus (available worldwide on-line)

Total Beauty (available worldwide on-line)

Better Homes & Gardens (available worldwide on-line)

5) **Award and Mentions**

In 2009 and again in 2014, Upper Canada and its manufactured products are mentioned in BeautyGeek.com, for sale in Canada, USA and 10 other countries.

In 2016 Stephen Flatt, Founder of Upper Canada, was among 23 finalists of the Canadian Entrepreneur of the Year award for excellence.

6) **Sales and Advertising**

Packaging and advertising on 1000's of products worldwide carry the manufacturer's name Upper Canada Soap, identifying those products, and have done so since 1985.

**USA Sales**

2019	\$41,000,000
2018	\$40,000,000
2017	\$38,000,000
2016	\$31,000,000
2015	\$25,000,000

**International Advertising** (tradeshows, catalog printing, website management)

2019	\$300,000
2018	\$300,000
2017	\$300,000
2016	\$300,000
2015	\$300,000

Upper Canada attends various US industry and trade shows every year. They also attend International trade shows every year, where existing and potential US customers visit their booth.

7) **Social Media**

LinkedIn

A search on "Upper Canada" returns 2 pages for Upper Canada Soap, counting nearly 2000 followers. Stephen Flatt, President, and at least 49 employees are active in various industry groups relating to consumer products, beauty, and manufacturing, where their posts on any subject are identified with Upper Canada Soap and available to millions worldwide.

Glassdoor

An independent employee survey shows Upper Canada Soap to be a great place to work.

Facebook

A search on "Upper Canada" returns multiple references, dated over 10 years, to the Upper Canada Soap page, which has nearly 2000 followers.

YouTube

A search on "Upper Canada" returns multiple videos posted by Upper Canada Soap, dating back to 2010, watched by 100's of 1000's of viewers worldwide since that time.

Twitter

A search on "Upper Canada" returns multiple references, dated over 10 years, to the Upper Canada Soap page, which has nearly 1500 active followers.

Pinterest

A search on "Upper Canada" returns multiple active references, dated over 10 years, to the Upper Canada Soap page.

8) **UNIQUENESS OF MARK**

4 of the 5 marks currently alive at the USPTO including the term "UPPER CANADA" belong to the applicant

Current Search:

"UPPER CANADA"[BI,TI,MI,PI,MP,TL] AND "LIVE"[LD]

docs: 5 occ: 28

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88604985		UPPER CANADA SOAP	TSDR	LIVE
2	88545217		UPPER CANADA	TSDR	LIVE
3	86952768	5745880	GOODERHAM CANADIAN WHISKY CANADIEN ESTD1832 YORK, UPPER CANADA & WORTS	TSDR	LIVE
4	75444060	2353096	ANTI-STRESS BY UPPER CANADA	TSDR	LIVE
5	74603311	1938475	NATURALLY UPPER CANADA	TSDR	LIVE