

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

MARK: ION
SERIAL NO.: 78/409,343
APPLICANT: Beauty Holding Company, Inc.
FILING DATE: April 28, 2004
INTERNATIONAL
CLASS NO.: 3

NOTICE OF APPEAL

In accordance with Rule 2.141 of the Trademark Rules of Practice, applicant, Beauty Holding Company, Inc., hereby appeals to the Honorable Trademark Trial and Appeal Board from the decision refusing registration of the above-identified trademark. Applicant submits herewith a check for one hundred dollars (\$100.00). Please deduct any underpayment of requisite fees, or credit any overpayment to, the Deposit Account of Foley & Lardner LLP, Account No. 06-1450. Applicant wishes to advise the Board that on April 3, 2006, applicant filed its Response to Office Action Dated October 3, 2005.

Dated: 3 April 2006

04/12/2006 GTHDHAS2 00000022 78409343

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100.00 DP

CERTIFICATE OF MAILING

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VA 22313-1451 on April 3, 2006

Kate C. O'Connell

Respectfully submitted,
FOLEY & LARDNER LLP

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RESPONSE TO OFFICE ACTION OF OCTOBER 3, 2005

This is in response to the Office Action of October 3, 2005, in which the Trademark Attorney made final her refusal to grant the subject application on the grounds that such registration would be contrary to Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. § 1052(d). For the reasons set forth below, Applicant respectfully requests the Trademark Attorney to reconsider her refusal and to pass the subject application for publication.

For years, Applicant, including predecessors-in-interests, have sold hair care preparations under the mark ION. Applicant owns multiple registrations for its ION mark, including the following:

(i) Registration Number 1,320,267, filed May 13, 1981, and registered February 19, 1985, for “[p]ersonal [d]etergent for [u]se on the [h]air and [b]ody, [h]air [m]oisturizing [t]reatment, [h]air [r]econstructor [t]reatment, [h]air [f]inishing [t]reatment, [h]air [p]ermanent [w]aving [t]reatment, and [h]air [f]ixative” (emphasis added); and,

(ii) Registration Number 3,071,641, filed March 2, 2002 and registered March 21, 2006, for “[h]air care preparations [and] hair colorants” (emphasis added).

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Applicant now seeks registration of the mark ION for “hair bleaching preparations” (hereinafter “Subject Mark”). “Hair bleaching preparations” constitute both a “hair care preparation” and a “hair colorant.” *See, e.g.,* Exhibits 1 - 3 (attached hereto).

The Trademark Attorney has cited Registration Number 2,902,821 (hereinafter “Cited Registration”) for the below depicted mark which is registered for “[c]osmetics, namely, cleansing beauty oil, cleansing beauty gel, beauty emulsion, face cream, beauty mask gel, beauty essence oil for personal use, eye care cream, pure essential oil for personal use, massage cream, facial mask, compacts, perfume, skin cleansing cream, *hair waving lotion, hair dye*, skin cleansing lotion and essential oils for personal use” (emphasis added):



The Cited Registration was filed May 1, 2003, registered November 16, 2004, and claims a Section 44 priority date of April 18, 2003.

As is clear from the foregoing, Applicant, not the owner of the Cited Registration, have clear priority (including priority of registration) in the mark ION for *all* hair care preparations. Furthermore, even with respect to the specific hair care preparations referenced in the Cited Registration, Applicant has clear priority, including, *inter alia*, hair permanent waving treatment *vis-à-vis* hair waving lotion, and hair colorant *vis-à-vis* hair dye. Under such circumstances, Applicant respectfully suggests that the Section 2(d) refusal is inappropriate.

The Trademark Attorney cited the well established authority that precedent is of little value in deciding the issue of likelihood of confusion, and that each such case must be

determined upon its own unique facts. Applicant, of course, does not contest such authority. However, Applicant is not relying upon the prior decisions of the Patent and Trademark Office, either allowing the Cited Registration or Applicant's Registration Number 3,071,641, as establishing the absence of likelihood of confusion. Rather, based upon the unique facts presented herein, namely Applicant's clear priority of use and registration rights for ION for the goods at issue, Applicant argues that the Section 2(d) refusal is inappropriate.

For the reasons set forth above and in the remainder of the record presented in support of the subject application, Applicant respectfully request the Trademark Attorney to reconsider her refusal and to pass the subject application for publication.

Dated: April 3, 2006

Respectfully submitted,

FOLEY & LARDNER LLP



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APRIL 20, 1999 CORRESPONDENCE RECEIVED IN LAW OFFICE
 OCTOBER 27, 1998 FINAL REFUSAL MAILED
 SEPTEMBER 16, 1998 CORRESPONDENCE RECEIVED IN LAW OFFICE
 MARCH 24, 1998 NON-FINAL ACTION MAILED
 MARCH 13, 1998 ASSIGNED TO EXAMINER



LAVIPHARM *ref.26*

Image

TRADEMARKSCAN®--U.S. Federal

Serial Number: 74386162
Registration Number: 2390655

Status: REGISTERED

USPTO Status: (700) REGISTERED
USPTO Status Date: October 3, 2000

Filed: April 30, 1993
Allowance Filed: October 14, 1997
Published: July 22, 1997
Extension Approved: May 10, 1999
Registered: October 3, 2000

International Class(es):
 3 (Cosmetics and Cleaning Preparations)
 5 (Pharmaceuticals)

Goods/Services:

(INT. CL. 3) ALL PURPOSE PREPARATIONS FOR CLEANING, WASHING, POLISHING, GREASE REMOVAL AND SCRUBBING, NAMELY, FACE CLEANSING PRODUCTS, NAMELY, CLEANING GEL, CLEANSING MILK/LOTION, FACIAL WASH, COLD CREAM, SKIN CLARIFIERS, TONIC LOTION, EMOLLIENTS, SCRUB; PRODUCTS FOR FACE CARE, NAMELY, DAY CREAM, NIGHT CREAM, EYE CREAM/ GEL, NOURISHING CREAM, ANTI-AGE/ANTI-WRINKLE CREAM, FIRMING CREAM, SKIN CLEANSING AND VANISHING CREAM, SERUM, ANTIWRINKLE EYE CREAM, WRINKLE REMOVING SKIN CARE PREPARATIONS, DEPIGMENTATION CREAM, FACE LOTION, MOISTURIZER, MASK; SUN CARE PRODUCTS, NAMELY, FACE CREAM, TINTED CREAM, CREAM FOR THE LIPS, AFTER SUN EMULSION, SUN BLOCK, SUN SCREEN, SELF TANNING CREAM/LOTION; PRODUCTS FOR BODY CARE, NAMELY, EMULSION, OIL, SHOWER AND BATH GEL, SHOWER SCRUB, REGULAR, BODY, DEODORANT AND LIQUID SOAP, HAND CREAM, BODY CREAM AND EMOLLIENT, DEODORANT CREAM, HAIR REMOVING CREAM, POWDER AND SALTS, FOOT POWDER, LOTION FOR THE SKIN, MASSAGE OIL, MOISTURIZER, TONER, SKIN CLARIFIERS AND LIGHTENERS, SLIMMING CREAM; HAIR CARE PRODUCTS, NAMELY, SHAMPOO, OTHER HAIR CLEANING PREPARATIONS, CONDITIONER, RINSE, MASK, HAIR DYES, HAIR BLEACHING, HAIR RELAXING PREPARATIONS, HAIR LIGHTENERS, HYDROGEN PEROXIDE FOR USE ON THE HAIR, HAIR COLOR REMOVERS, HAIR GEL, HAIR STYLING AND STRAIGHTENING PREPARATIONS. HAIR AND WAVING LOTION;

EXHIBIT

1

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