

ESTTA Tracking number: **ESTTA841886**

Filing date: **08/25/2017**

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

Proceeding	91224515
Party	Defendant Christopher N. Ciko
Correspondence Address	CHRISTOPHER N NCIKO 21613 ANZA AVE TORRANCE, CA 90503-6425 UNITED STATES Email: cciko30@gmail.com
Submission	Brief on Merits for Defendant
Filer's Name	Christopher N. Ciko
Filer's email	c@formula39.com, cciko30@gmail.com
Signature	/Christopher N. Ciko/
Date	08/25/2017
Attachments	defendantbrief.pdf(163937 bytes) EXHIBIT A.pdf(68336 bytes) EXHIBITB.pdf(3335744 bytes) Exhibit C.pdf(3749172 bytes)

August 23, 2017

Defendant's Brief

Trademark Application Serial No.: 86/433293 for the mark: Formula 39
Filed October 24, 2014
Published September 22, 2015

Opposition No. 91224515

The critical issue in most Trademark Oppositions is brand confusion for the typical consumer of that product; however, in this matter the first question is if the Plaintiff has a defensible mark, because GENERIC marks are not protected. SEE EXHIBIT A, UNITED STATES PATENT AND TRADEMARK SEARCH SYSTEM DOCUMENT. The document identifies Erno Laszlo Inc. as the owner of PHORMULA NO. 3-9 with a DISCLAIMER stating: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FORMULA" APART FROM THE MARK AS SHOWN." Plaintiff has disclaimed exclusive rights to use the word "FORMULA." As for the rest of their mark, the abbreviation of the word number, "NO." is not protectable under United States Trademark law. All that remains of their mark are the numbers 3 and 9 which, standing alone, are not protectable. Formula 39 Inc. and Defendant Christopher N. Ciko must be granted full rights to use our Trademark Formula 39.

The second critical issue in this Opposition is whether a typical consumer is likely to confuse Erno Laszlo Brand product Phormula No. 3-9 with Formula 39 Brand product, Formula 39. There has not been a single confused consumer because of one reason; there is no likelihood of confusion between the marks. [SEE EXHIBIT B. ANSWER TO INTERROGATORIES 18-24]

The measure for federal trademark infringement, 15 U.S.C. § 1114, and federal unfair competition, 15 U.S.C. § 1125(a)(1)(A), is by identical standards. See [A & H III, 166 F.3d at](#)

[202.](#)^[5] To prove either form of Lanham Act violation, a plaintiff must demonstrate that (1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) the defendant's use of the mark to identify goods or services causes a likelihood of confusion. See [Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.](#), 214 F.3d 432, 437 (3d Cir.2000). The plaintiff bears the burden of proof. See [American Home Prods. Corp. v. Barr Labs., Inc.](#), 834 F.2d 368, 371 (3d Cir.1987).

It is undisputed that Erno Laszlo Inc. owns Phormula No. 3-9 and Christopher N. Ciko owns Formula 39, therefore the only issue in the case is likelihood of confusion. Plaintiff has responded through answers to Interrogatories 18 -24 that there has never been a single instance of confusion which they have been made aware. [EXHIBIT B PLAINTIFF'S ANSWER TO INTERROGATORIES 18 - 24]

A likelihood of confusion exists when "consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark." [Dranoff-Perlstein Assocs. v. Sklar](#), 967 F.2d 852, 862 (3d Cir.1992). The Court in *Lapp* set forth factors that may be used to determine the likelihood of confusion in cases of directly competing goods, at least when the marks are not identical, accords with the approaches of the Second, Sixth, Eighth, and Ninth Circuits, which also have approved using multi-factored tests, developed for noncompetitive goods, in the competitive goods arena. See [Banff, Ltd. v. Federated Dep't Stores, Inc.](#), 841 F.2d 486, 490 (2d Cir.1988); [Jet, Inc. v. Sewage Aeration Sys.](#), 165 F.3d 419, 421-22 (6th Cir.1999); [Duluth News-Tribune v. Mesabi Publ'g Co.](#), 84 F.3d 1093, 1096 (8th Cir.1996); [Dr. Seuss Enters., L.P. v. Penguin Books U.S.A., Inc.](#), 109 F.3d 1394, 1404 (9th Cir.1997). The *Lapp* factors should be employed to test for likelihood of confusion. Therefore, likelihood of confusion for both competing and noncompeting goods should be tested with reference to the following:

- (1) the degree of similarity between the owner's mark and the alleged infringing mark;
- (2) the strength of the owner's mark;
- (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) the length of time the defendant has used the mark without evidence of actual confusion arising;
- (5) the intent of the defendant in adopting the mark;
- (6) the evidence of actual confusion;
- (7) whether the goods, competing or not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties' sales efforts are the same;
- (9) the relationship of the goods in the minds of consumers, whether because of the near-identity of the products, the similarity of function, or other factors;
- (10) other facts suggesting that the consuming public might expect the prior owner to manufacture both products, or expect the prior owner to manufacture a product in the defendant's market, or expect that the prior owner is likely to expand into the defendant's market.

The single most important factor in determining likelihood of confusion is mark similarity. See [Fisons, 30 F.3d at 476](#). The test for such similarity is "whether the labels create the same overall impression when viewed separately." *Id.* (quoting [Banff, Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486, 492 \(2d Cir. 1988\)](#)). Marks are confusingly similar if ordinary consumers would likely conclude that [the two products] share a common source, affiliation, connection or sponsorship."

Defendant contends that Erno Laszlo house mark should be a part of the similarity of marks analysis. The entire Erno Laszlo product line is built around the name Erno Laszlo. The packaging of the product is all ERNO LASZLO. [SEE EXHIBIT C ERNO LASZLO PRODUCTS PACKAGING]

ERNO LASZLO made the brand famous because he was the skin care guru to the stars. This is quoted from the Erno Laszlo website entitled HERITAGE:

“The Birth of Bespoke

Having perfected the world’s most coveted complexions from Europe to Hollywood, Dr. Erno Laszlo brought his bespoke skincare philosophy to New York City in 1927. There, he introduced his storied clients – from Greta Garbo and Jackie O. to Audrey Hepburn and Marilyn Monroe – to his signature double cleanse and cultivated the brand’s customized approach to skincare.”

Bespoke beauty is key. Bespoke is defined as, “made to fit a particular person.” (Webster’s dictionary) And later, “...the brand’s customized approach to skincare.” No one is going to forget Erno Laszlo because it’s about personalized service. You would never forget personalized skin care service. No one will forget Erno Laszlo. Erno Laszlo is the marque and Phormula No. 3-9 is just one of hundreds of products over the years.

Simply look at the labeling of any Erno Laszlo product and you will see the name Erno Laszlo dominates every image. You need reading glasses to see the name phormula 3-9. It’s all about Erno Laszlo, because no sensible business would spend any marketing money on a product name that

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.