

To: Lisa M. Gigliotti(lisa.gigliotti@loreal.com)
Subject: U.S. Trademark Application Serial No. 97119483 - UP TO SNOW GOOD - NYX
Sent: August 26, 2022 10:45:45 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[5618570](#)

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97119483

Mark: UP TO SNOW GOOD

Correspondence Address:

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NEW YORK NY 10001 UNITED STATES

Applicant: L'Oreal USA Creative, Inc.

Reference/Docket No. NYX

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NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 26, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Section 2(d) Refusal - Likelihood of Confusion
- Identification of Goods Requires Amendment
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark SNOW BEAUTY CO. in U.S. Registration No. 5318570. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Applicant has applied to register the mark UP TO SNOW GOOD in standard characters for use in connection with “Lipstick, lip gloss; lip creams; lip scrub; lip balm; highlighter; eyeshadow; eyeshadow primer; make-up setting spray” in International Class 3.

Registrant’s mark is SNOW BEAUTY CO. in standard characters for use in connection with “cosmetics” in International Class 3.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Although there is no mechanical test to determine the dominant element of a mark, consumers would be more likely to perceive a distinctive term, even if suggestive, rather than a generic or descriptive term as the source-identifying feature of the mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059-60 (TTAB 2017) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009)).

In this case, the distinctive term in Applicant's mark is the word SNOW due to the mark's play on words by replacing the word "no" in the phrase "up to no good" with the word SNOW. This play on words makes the term SNOW the distinctive element of the mark.

In analyzing the registered mark, disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Here, the words BEAUTY CO. are disclaimed in the registration rendering the word SNOW the dominant element of the registered mark.

The dominant element of both marks is the identical word SNOW. These words are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these words are likely to engender the same connotation and overall commercial impression when considered in connection with Applicant's and Registrant's respective goods. *Id.*

Consumers familiar with Registrant's mark are likely to confuse Applicant's mark as a slogan for Registrant's goods.

Because the marks look and sound similar and create the same commercial impression, the marks are considered confusingly similar for likelihood of confusion purposes.

Relatedness of the Goods

The compared goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registration uses broad wording to describe cosmetics, which presumably encompasses all goods of the type described, including Applicant's more narrow lipstick, lip gloss, lip creams, lip

scrub, lip balm, highlighter, eyeshadow, eyeshadow primer, and make-up setting spray . *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, Applicant's and Registrant's goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, Applicant's and Registrant's goods are also related.

Because the marks are similar and the goods are related and legally identical, there is a likelihood of confusion as to the source of Applicant's goods. Therefore, Applicant's mark is not entitled to registration pursuant to Section 2(d) of the Trademark Act.

Although Applicant's mark has been refused registration, Applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if Applicant responds to the refusal, Applicant must also respond to the requirement set forth below.

IDENTIFICATION OF GOODS REQUIRES AMENDMENT

Applicant must clarify the wording "highlighter" in the identification of goods in International Class 3 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite because it does not make clear what the goods are. Further, this wording could identify goods in more than one international class. For example, "highlighter make-up" are in International Class 3 and "highlighter pens" are in International Class 16.

Applicant may substitute the following wording, if accurate:

Class 3: Lipstick, lip gloss; lip creams; lip scrub; lip balm; highlighter **make-up**; eyeshadow; eyeshadow primer; make-up setting spray

Class 16: highlighter pens

NOTE: Applicant is not required to add the additional class, but must comply with the multiple-class application requirements below. The above wording in **bold** is suggested wording.

Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, Applicant may not substitute different goods or add goods not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the goods sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods will further limit scope, and once goods are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). See TMEP §1402.04.

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods that are classified in at least two (2) classes; however, Applicant submitted a fee sufficient for only one (1) class. In a multiple-class application, a fee for each class is required. 37 C.F.R. §2.86(a)(2), (b)(2); TMEP §§810.01, 1403.01. For more information about adding classes to an application, see the [Multiple-class Application webpage](#).

Therefore, Applicant must either (1) restrict the application to the number of classes covered by the fees already paid, or (2) submit the fees for each additional class.

The fee for adding classes to a TEAS Standard application is \$350 per class. See 37 C.F.R. §2.6(a)(1)(iii). For more information about adding classes to an application, see the [Multiple-class Application webpage](#).

The Application identifies goods in more than one international class; therefore, Applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fee already paid (view the [USPTO's current fee schedule](#)). The application identifies goods that are classified in at least two (2) classes; however, Applicant submitted a fee sufficient for only one (1) class. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 37 C.F.R. §2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, see the [Multiple-class Application webpage](#).

RESPONSE GUIDELINES

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "[Responding to Office Actions](#)" and the informational [video "Response to Office Action"](#) for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

(4) STANDARD CHARACTER MARK

Snow Beauty Co.

Mark Punctuated

SNOW BEAUTY CO.

Translation

Goods/Services

- IC 003. US 001 004 006 050 051 052.G & S: Cosmetics. FIRST USE: 20180100. FIRST USE IN COMMERCE: 20180800

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Design Code

Serial Number

87585079

Filing Date

20170826

Current Filing Basis

1A

Original Filing Basis

1B

Publication for Opposition Date

20180130

Registration Number

5618570

Date Registered

20181127

Owner

(REGISTRANT) Hwang, Jessica Snow INDIVIDUAL UNITED STATES 13304 Hymeadow Circle Austin TEXAS 78729

Priority Date

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEAUTY CO." APART FROM THE MARK AS SHOWN

Description of Mark

Type of Mark

TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 26, 2022 for
U.S. Trademark Application Serial No. 97119483

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

Statistics for Case 97119483						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	*up*[bi,ti] not dead[ld]	68944	0	0	0	0:02
2	(*to* *two* *tu*)[bi,ti] not dead[ld]	407952	0	0	0	0:01
3	*snow*[bi,ti] not dead[ld]	2486	0	0	0	0:01
4	*good*[bi,ti] not dead[ld]	16302	0	0	0	0:01
5	1 and 2 and 3 and 4	2	0	2	2	0:00
6	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld]	4394	0	0	0	0:14
7	*g{"ou":3}d*[bi,ti] not dead[ld]	22414	0	0	0	0:01
8	1 and 2 and 6 and 7	2	0	2	2	0:14
9	6 and (1 2 7)	418	0	64	64	0:14
10	1 and 2	9260	0	0	0	0:01
11	6 and (7 10)	29	0	29	29	0:14
12	7 and 10	107	0	107	107	0:01
13	6 and 7	16	0	16	16	0:14
14	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld] and "003"[cc]	1066	0	0	0	0:13
15	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld] and ("003" "035" "042" a, b "200")[ic]	769	0	0	0	0:14
16	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld] and ("003" "035" a, b "200")[ic]	585	0	0	0	0:14
17	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld] and ("003" a, b "200")[ic]	233	0	233	233	0:14
18	*{"scz"}{"n":2}{"ow"}*[bi,ti] not dead[ld] and ("016" a, b "200")[ic]	179	0	179	179	0:14
19	*g{"ou":3}d*[bi,ti] not dead[ld] and ("003" a, b "200")[ic]	1220	0	0	0	0:01
20	*g{"ou":3}d*[bi,ti] not dead[ld] and ("016" a, b "200")[ic]	1365	0	0	0	0:01
21	(*gud* *g{"ou":2:3}d*)[bi,ti] not dead[ld] and ("016" a, b "200")[ic]	848	0	0	0	0:02
22	(*gud* *g{"ou":2:3}d*)[bi,ti] not dead[ld] and ("003" a, b "200")[ic]	951	0	0	0	0:01
23	*snow*[bi,ti]	7521	0	0	0	0:00
24	*good*[bi,ti]	42111	0	0	0	0:00
25	23 and 24	15	0	7	7	0:00
26	"oreal usa creative"[ow]	3503	0	0	0	0:01
27	"oreal usa creative"[ow] and "snow"[bi,ti]	1	0	1	1	0:01

Session started 08/26/2022 10:06 pm

Session ended 08/26/2022 10:29 pm

Total search duration 154.00

Session duration 22 minutes 34 seconds

Adjacency Level 1

Near Level 1