

ESTTA Tracking number: **ESTTA182795**

Filing date: **12/21/2007**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Cosmetic Warriors Ltd.		
Entity	Corporation	Citizenship	United Kingdom
Address	29 High Street Poole, Dorset, BH15 1AB UNITED KINGDOM		

Attorney information	John A. Clifford Merchant & Gould P.O. Box 2910 Minneapolis, MN 55402 UNITED STATES dockmpls@merchantgould.com, dmattessich@merchantgould.com, jclifford@merchantgould.com Phone:612.332.5300		
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**Applicant Information**

Application No	77210127	Publication date	11/27/2007
Opposition Filing Date	12/21/2007	Opposition Period Ends	12/27/2007
Applicant	Make-Up Art Cosmetics Inc. 767 Fifth Avenue New York, NY 10153 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: Cosmetics; Non-medicated skin care preparations; Fragrances for personal use
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2282428	Application Date	02/25/1997
Registration Date	10/05/1999	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, dentifrices, cosmetic depilatory creams, personal deodorants, preparations for the care of the hair, shampoos, soaps, and essential oils for personal use Class 005. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 [medicated hair care, skin care, teeth care and nail care preparations]

U.S. Registration No.	2853483	Application Date	11/25/2002
Registration Date	06/15/2004	Foreign Priority Date	08/14/2002
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries		

U.S. Registration No.	3102767	Application Date	01/06/2005
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	LUSH FRESH HANDMADE COSMETICS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1996/06/00 First Use In Commerce: 2002/12/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use		

U.S. Registration No.	3001303	Application Date	04/27/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1996/05/00 First Use In Commerce: 1996/06/00		

	Catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags
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U.S. Registration No.	3008685	Application Date	04/27/2004
Registration Date	10/25/2005	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid skin moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use		

U.S. Application No.	78747180	Application Date	11/04/2005
Registration Date	NONE	Foreign Priority Date	06/21/2005
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: Hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; Beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; Beauty salon services; Aromatherapy services; Skin care salon services; Massage services; Nail care and manicure services; Trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; Counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations		

Attachments	75247408#TMSN.gif ( 1 page )( bytes ) 76627078#TMSN.jpeg ( 1 page )( bytes ) 78408741#TMSN.jpeg ( 1 page )( bytes ) 78408752#TMSN.jpeg ( 1 page )( bytes ) 78747180#TMSN.jpeg ( 1 page )( bytes ) moisturelush_20071221154312.pdf ( 7 pages )(315064 bytes ) Certified Copy of LUSH.pdf ( 2 pages )(660403 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/daniellemattessich/
Name	Danielle I. Mattessich
Date	12/21/2007

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

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Cosmetic Warriors Ltd.,		)	
	Opposer,	)	Opposition No. _____
		)	Application No. 77/210127
v.		)	Mark(s): <b>MOISTURELUSH</b>
		)	
Make-Up Art Cosmetics, Inc.		)	
	Applicant.	)	
<hr/>		)	

**NOTICE OF OPPOSITION**

Cosmetic Warriors Ltd. (“Cosmetic Warriors” or “Opposer”), a corporation duly organized and existing under the laws of the United Kingdom, with a mailing address of 29 High Street Poole, Dorset BH15 1AB, United Kingdom, believes that it will be damaged by the registration of the MOISTURELUSH mark (“Mark”) shown in application Serial No. 77/210127, filed on June 19, 2007 by Make-Up Art Cosmetics Inc. (“MAC” or Applicant), a Delaware corporation with a mailing address of 767 Fifth Avenue, New York, New York 10153, and hereby opposes registration of the Mark. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark MOISTURELUSH for "cosmetics, non-medicated skin care preparations, and fragrances for personal use" in International Class 3 (Serial No. 77/210127). The application is based on Applicant's intention to use the mark in commerce under §1(b) of the Lanham Act.
2. Applicant's Mark published for opposition on November 27, 2007. This Notice of Opposition is timely filed.

3. Opposer is the owner of the following U.S. Trademark Registrations and pending application(s):

**LUSH**, U.S. Reg. No. 2,282,428, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, dentifrices, cosmetic depilatory creams, personal deodorants, preparations for the care of the hair, shampoos, soaps, and essential oils for personal use, in International Class 3. Said registration was registered on the Principal Register on October 5, 1999 and was based on an application filed in the U.S. Patent and Trademark Office on February 25, 1997 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application. Said registration is also incontestable. See attached registration.

**LUSH**, U.S. Reg. No. 2,853,483, used in connection with bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries, in International Class 35. Said registration was registered on the Principal Register on June 15, 2004 and was based on a foreign registration filed in the United Kingdom on August 14, 2002, which is a date prior to the date of filing of Applicant's application.



**LUSH**, U.S. Reg. No. 3,102,767, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use, in International Class 3. Said registration registered on the Principal Register on June 13, 2006 and was based on an application filed in the U.S. Patent and Trademark Office on January 6, 2005 alleging a date of first use of June 1996, which is a date prior to the date of filing of Applicant's application.

**LUSH**, U.S. Reg. No. 3,001,303, used in connection with catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags, in International Class 16. Said registration registered on the Principal Register on September 27, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on April

27, 2004 alleging a date of first use of May 1996, which is a date prior to the date of filing of Applicant's application.

**LUSH**, U.S. Reg. No. 3,008,685, used in connection with perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid skin moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use, in International Class 3. Said registration registered on the Principal Register on October 25, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on April 27, 2004 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

**LUSH**, U.S. Application Serial No. 78/747180, intended to be used on hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; beauty salon services; aromatherapy services; skin care salon services; massage services; nail care and manicure services; trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations, in International Class 44. Said application is based on Opposer's intention to use the mark in U.S. commerce and was filed on November 4, 2005, which is a date prior to the date of filing of Applicant's application.

4. Opposer's registered marks are valid and subsisting, and are prima facie evidence of Opposer's exclusive right to use said mark in commerce on the goods specified in each registration. Opposer's LUSH mark, Reg. No. 2,282,428, is incontestable. In view of the highly similar marks, and the identical nature of the cosmetic products of the respective parties, it is alleged that Applicant's mark so resemble Opposer's registered and pending marks, as to be likely to cause confusion, or to cause mistake, or to deceive.

5. Since at least as early as April 10, 1995, Opposer has used the LUSH mark in the United States. Said use has been continuous since the date of first use and has not been abandoned.
6. Opposer has advertised and promoted its LUSH mark extensively. Opposer has also made substantial sales under said mark. As a result of such use and promotion, Opposer's mark has developed and represents valuable goodwill inuring to the benefit of Opposer. Opposer operates approximately sixty (60) retail stores in at least (25) twenty-five states under its LUSH trademark in the United States, operates and an online retail store at [www.lush.com](http://www.lush.com), and will soon open more brick and mortar stores. Opposer sells a wide variety of cosmetic products for personal care, including skin care, hair care, facial care, hand/body care products, and fragrances under the LUSH brand.
7. Opposer has priority with respect to the mark at issue in this opposition. Opposer has had priority of use of the LUSH mark long before the June 19, 2007 filing date noted in Applicant's application.
8. Applicant's MOISTURELUSH mark is confusingly similar in sight, sound, meaning and commercial impression to Opposer's LUSH marks. The marks have a confusingly similar appearance, sound, meaning and commercial impression, and the goods of the parties are identical and highly related cosmetic products.
9. Applicant's mark is deceptively similar to Opposer's marks. The marks have a confusingly similar appearance, sound, meaning and commercial impression, and the goods of the parties are identical and highly related cosmetic products.
10. Due to the highly similar nature of Applicant's claimed mark and Opposer's previously used and registered marks, and the identical and highly similar nature of the cosmetic products of the respective parties, consumers and potential consumers are likely to

believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

11. Upon information and belief, the goods provided by Opposer under its LUSH marks and the goods intended to be provided by Applicant under its LUSH mark will be promoted and sold in the same channels of trade to the same consumers or class of consumers.
12. The use and registration by Applicant of the mark MOISTURELUSH for Applicant's goods is likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used LUSH marks, again resulting in damage to Opposer.
13. Applicant's mark dilutes and weakens Opposer's marks in violation of Opposer's rights, causing dilution of the distinctive qualities of the Opposer's marks.
14. Because of the identical nature of the goods and the similarities of the marks in overall appearance, sound, meaning and commercial impression, use and registration of the term MOISTURELUSH by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer. Applicant's product will look like a new, specialty *moisturizing* line extension of Opposer's LUSH products.
15. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer.
16. Registration of the mark shown in Application Serial No. 77/210127 (MOISTURELUSH) will result in damage to Opposer under the provisions of §2 (a) and

§2 (d) and §43 (c) (1) of the U.S. Trademark Act, 15 U.S.C. § 1052, §1125 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to these applications be sustained and that the registration of the proposed mark LUSH set forth therein be refused. Please direct all correspondence to the attention of:

John A. Clifford  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910  
Tel: 612-336-4616 Fax: 612-332-9081

Opposer hereby appoints: John A. Clifford, Danielle I. Mattessich, Scott M. Oslick, Brian H. Batzli, Gregory C. Golla, Scott W. Johnston, D. Randall King, Andrew S. Ehard, Christopher J. Schulte, and Brent Routman and as its attorneys with the full power to represent the Opposer in connection with this proceeding.

Respectfully submitted,

COSMETIC WARRIORS LTD.,

By its attorneys,

Date: 12-21-07

  
\_\_\_\_\_  
John A. Clifford  
Danielle I. Mattessich  
MERCHANT & GOULD P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910  
Tel. 612.336.4616  
Fax 612.332.9081

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served upon the following attorney of record for Applicant by Certified First Class Mail (with a copy via e-mail, uspto@estee.com), postage pre-paid, this 21 day of December, 2007:

LESLEY A. MORADIAN  
THE ESTEE LAUDER COMPANIES  
767 FIFTH AVENUE  
42ND FLOOR-TRADEMARK DEPT.  
NEW YORK, NY 10153



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Danielle I. Mattessich

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2,428

# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

July 09, 2007

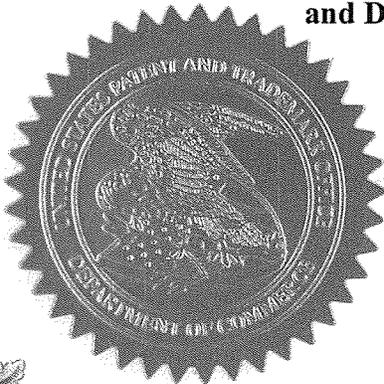
THE ATTACHED U.S. TRADEMARK REGISTRATION 2,282,428 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 10 YEARS FROM *October 05, 1999*

CANCELLED SECTION 8 PARTIAL & 15  
CLASS(ES) CANCELLED:  
*INT CL 005*

SAID RECORDS SHOW TITLE TO BE IN:  
*COSMETIC WARRIORS LIMITED*  
*A ENGLAND CORPORATION*

By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office



A handwritten signature in black ink, appearing to read "P. Swain".

P. SWAIN  
Certifying Officer

Int. Cls.: 3 and 5

Prior U.S. Cls.: 1, 4, 6, 18, 44, 46, 50, 51 and 52

Reg. No. 2,282,428

**United States Patent and Trademark Office**

Registered Oct. 5, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**LUSH**

LUSH LTD. (UNITED KINGDOM CORPORATION)  
29 1/2 HIGH STREET  
POOLE, DORSET BH15 1AB, UNITED KINGDOM

FOR: PERFUMES; NON-MEDICATED TOILET AND COSMETIC PREPARATIONS, NAMELY, LOTIONS, POWDERS AND CREAMS FOR USE ON THE SKIN, DENTIFRICES, COSMETIC DEPILATORY CREAMS, PERSONAL DEODORANTS, PREPARATIONS FOR THE CARE OF THE HAIR, SHAMPOOS, SOAPS, AND ESSENTIAL OILS FOR PERSONAL USE, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 4-10-1995; IN COMMERCE 6-0-1996.

FOR: ~~MEDICATED HAIR CARE, SKIN CARE, TEETH CARE AND NAIL CARE PREPARATIONS~~, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 4-10-1995; IN COMMERCE 6-0-1996.

OWNER OF UNITED KINGDOM REG. NO. 2013346, DATED 3-7-1995, EXPIRES 3-7-2005.

SER. NO. 75-247,408, FILED 2-25-1997.

LESLEY LAMOTHE, EXAMINING ATTORNEY