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

Proceeding	91188736
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.

Plaintiffs/Opposers

v.

ANASTASIA MARIE LABORATORIES, INC.

Defendant/Applicant

Opposition No.

91188736

**OPPOSERS' RESPONSE TO APPLICANT'S MOTIONS TO AMEND AND FOR SUMMARY  
JUDGMENT ON ITS AMENDED COUNTERCLAIMS**

On January 14, 2010, Opposers filed a Motion to Dismiss Counterclaims (now styled Opposers' Motion for Summary Judgment) and a Motion to Amend its Pleaded Registrations (which are the subject of those counterclaims).

On February 12, 2010 Applicant filed its Response to Opposers' Motion to Amend (to which Opposers timely filed a Reply brief on March 1, 2010) and on that same date responded to Opposers' Motion to Dismiss Counterclaims (now styled Opposers' Motion for Summary Judgment) with a Cross Motion for Summary Judgment, and with a Motion to Amend its originally pleaded Counterclaims.

In its suspension order of March 5, 2010, the Board observed that Opposers' Motion to Amend its Registrations appears germane to the matters presented on its motion for summary judgment. In that same order, the Board set the time for Opposers to respond to Applicant's Cross Motion for Summary Judgment until March 15, 2010, and also extended the time for Opposers to respond to Applicant's Motion to Amend its Pleading until that same date.

On March 11, 2010 Opposers filed a Stipulated/Consent Motion to Extend its time to respond to Applicant's Motions until March 30, 2010, which is still awaiting action by the Board.

With respect to Applicant's Motion to Amend its pleadings, Opposers consider the amended pleadings to be still defective, but have no procedural objection with the TTAB nevertheless first deciding whether the factual evidence now of record in this proceeding<sup>1</sup> is sufficiently clear and convincing to support a finding of the specific knowledge, materiality and intent required to establish fraud on the USPTO, and if so, granting summary judgment to Applicant on its amended Counterclaims<sup>2</sup> and conforming the pleadings accordingly. Conversely, if the Board concludes that the specific evidence now identified by Applicant is not clear and convincing as to all the required elements involved in establishing fraud on the USPTO, Summary Judgment should be granted to Opposers and Applicant's Counterclaims should be dismissed, preferably with prejudice.

With respect to Applicant's Cross Motion for Summary Judgment on its fraud Counterclaims, Opposers remain convinced that their pleaded registrations in class 3 were obtained without any culpable intent to deceive the USPTO into granting a registration to which they knew they were not entitled, a conclusion which is believed to be inescapable from the totality of the evidence and arguments now before the Board in connection with the two pending motions to amend and the two pending motions for summary judgment. Opposers therefore earnestly urge the Board not only to deny Applicant's Cross Motion for Summary Judgment, but also to grant Opposers' Motion for Summary Judgment.

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<sup>1</sup> Including that submitted by Applicant and Opposers in connection with Applicant's Motions to Amend its Counterclaims and for Summary Judgment thereon, and in connection with Opposers' Motions to Amend the involved Registrations and for Summary Judgment on the Counterclaims

<sup>2</sup> Which are limited to Class 3.

**OPPOSERS BRIEF IN OPPOSITION TO APPLICANT'S CROSS MOTION FOR SJ**

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**APPLICANT'S AMENDED PLEADINGS DO NOT ALLEGE ANY INTENT TO DECEIVE.**

In its motion to amend, applicant cites *DaimlerChrysler Corporation and Chrysler, LLC v. American Motors Corporation*, Cancellation No. 92045099 (January 14, 2010, hereinafter "*Daimler/Chrysler*"), which is a precedential TTAB decision that specifically addressed the impact of the CAFC's decision *In re Bose Corp.* (Fed. Cir., Aug. 31, 2009, hereinafter "*Bose*").

*Bose* had held a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO. The CAFC in *Bose* also reaffirmed its prior decision in *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336 (Fed. Cir. 1997, hereinafter "*Metro Traffic*") that fraud can only be found if there is "a willful intent to deceive." 104 F.3d at 340, and agreed with the TTAB's prior reasoning in *Metro Traffic* that absent "a **conscious**<sup>3</sup> effort to obtain for his business a registration **to which he knew it was not entitled**", there was no fraud.

In accordance with *Bose*, *DaimlerChrysler* specifically held "where a pleading asserts that a known misrepresentation, on a material matter, is made **to procure a registration**, the element of intent, indispensable to a fraud claim, has been sufficiently pled." However, *Daimler/Chrysler* went on to "note **that the preferred practice for a party alleging fraud** in a Board opposition or cancellation proceeding is **to specifically allege** the adverse party's **intent to deceive the USPTO**, so that there is no question that this indispensable element has been pled".

Significantly, Applicant's amended pleadings not only contain no specific allegation of intent to deceive the USPTO, they do not even allege that the misrepresentation was "made to procure" the

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<sup>3</sup> Unless indicated otherwise, throughout this brief **bold type** is being applied to selected portions of the quoted text to focus the Board's attention on what are believed to be especially relevant language.

registration, but rather merely allege that the statements in question were made "in the procurement of that registration".

In any event, it is clear from *Metro Traffic* and *Bose* that the culpable knowledge and intent underlying fraud on the PTO can not simply be inferred from knowledge of the commercial reality (namely when and how the listed products or services were being commercially distributed) that differed in certain material respects from what was presented to the examiner, absent at least some culpable knowledge that such differences would indeed be material to the scope and validity of any registration resulting therefrom.

#### **APPLICANT'S EVIDENCE OF DECEPTIVE INTENT IS NOT CLEAR AND CONVINCING<sup>4</sup>**

##### ***There is no direct evidence of intent to Deceive***

From Applicant's failure to plead intent to deceive and from the absence of any admissions or other direct evidence of such intent in its brief, one can assume that Applicant has no credible evidence (direct or otherwise) of such intent, other than possibly the specific factual evidence set forth in its Motion for Summary Judgment on its Fraud Counterclaims from which Applicant would have the Board indirectly infer such intent.

##### *Applicant improperly presumes Intent from unsubstantiated innuendos*

Rather than providing any concrete evidence of specific intent, Applicant merely points to Opposer Anastasia Soare's (hereinafter "AS") sworn declaration concerning certain admitted mistakes in papers filed during prosecution of the two registrations which are the subject of Applicant's counterclaims, and setting forth certain circumstances under which those mistakes were made, then baldly concludes that "Opposers' excuses defy reality".

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<sup>4</sup> The clear and convincing standard is discussed at length in both *Bose* and *DaimlerChrysler*.

To support its allegation that Opposers "must have known that they were deceiving the PTO", Applicant alleges "a pattern of conduct perpetuated over 2 years consisting of a reckless disregard of the truth so egregious that it rises to the level of fraud"; however, a careful examination of AS' conduct shows nothing inconsistent with her sworn testimony that any mistakes in the Declarations which bear her name<sup>5</sup> were simply the result of her not fully understanding the legal significance (i.e. the materiality) of the content of the documents in question and her failure to make a careful examination of lengthy and confusing lists and referenced documents. Moreover, as discussed in more detail hereinafter, Applicant fails to suggest any credible motive for the "fraud", and many of the cited mistakes were not material, let alone known to be material.

*Applicant's brief mischaracterizes Opposers' Discovery responses.*

In footnote 2 on page 9 of its brief in Opposition to Opposer's Motion for Summary Judgment and in support of its Cross Motion for Summary Judgment, Applicant asserts without any explanation or documentation that "Opposer's belief system as to truth is apparently not limited to PTO filings. In discovery, Opposer stated that **she** never heard of Applicant before the instant matter. Yet, in 2005, Opposer had instructed **her** then counsel to obtain Applicant's signature on a co-existence agreement due to the PTO's 2(d) refusal of Opposers' applications Serial Nos. 76/632,130 and 76/632/127 based upon Applicant's priority."

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<sup>5</sup> Although the entire prosecution history is presumably available to the Board under the doctrine of judicial notice, a copy of said Declarations as downloaded by the undersigned from The USPTO portal with certain portions highlighted is attached for the Board's convenience as Ex-TDR1 (page 7), Ex-TDR2, & Ex-TDR3 (page 3). Note that TDR3 was not actually signed by AS, but by her then counsel on "behalf of Applicant".

This is an apparent reference to the Opposers' response to Interrogatory 3<sup>6</sup>, signed by the undersigned counsel, which Applicant now apparently interprets as encompassing a prior dispute handled by Opposers' former counsel involving section 1(b) applications filed by Applicant's counsel in 2001 and 2005 for other marks and two section 1(a) applications for beauty salon service marks filed in 2005 by Opposers' prior counsel, none of which are involved in the present opposition. In any event, the interrogatory in question appeared to request details of privileged attorney client communications and advice as well as confidential settlement discussions and related attorney work product, and the assertion of privilege was made by the undersigned in good faith<sup>7</sup>.

Not only does Applicant's brief confuse strategic legal decisions by outside counsel with the client's personal "belief system", the response in question timely asserted a claim of privilege and expressly **refused** to divulge the requested information. Moreover, the details of that prior dispute were already known to Applicant and Applicant had not previously objected to the asserted claim of privilege, so it is clear that there was no intent to mislead Applicant, and Applicant was not in fact misled.

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<sup>6</sup> As signed and served on Nov. 13, 2009, Applicant's response read as follows:

**INTERROGATORY NO. 3:**

Describe in detail the circumstances through which you first became aware of AML.

**RESPONSE TO INTERROGATORY NO. 3:**

OPPOSERS incorporate each of their General Objections as though fully stated herein.

OPPOSERS further object that this Interrogatory, and in particular the term "circumstances," is vague and ambiguous. OPPOSERS further object and will **refuse to respond to this**

**Interrogatory to the extent that it calls for information that is subject to the attorney-client privilege and the attorney workproduct doctrine.** Without waiving, and **subject to their**

**objections**, OPPOSERS respond as follows: OPPOSERS first became aware of AML in or about April 2007 when legal counsel for OPPOSERS informed it that AML had filed Application Ser. No. 77/150,306 to register the name "ANASTASIA" as a trademark with the United States Patent and Trademark Office.

<sup>7</sup> Upon further investigation, counsel for Opposers now realizes that the above-quoted response was potentially misleading, and has advised counsel for Applicant that "first became aware" should read "were aware" and "in or about" should read "at least as early as".

***Opposers made innocent mistakes, arguably negligent, at most grossly negligent***

Rather than evidencing a pattern of "reckless disregard for the truth", what is clear from the prosecution history of the two registrations<sup>8</sup> that are the subject of Applicant's counterclaims for cancellation (and of the two inadvertently abandoned duplicate applications that remain abandoned<sup>9</sup>) is a tortuous and confused prosecution involving poorly coordinated efforts by multiple counsel<sup>10</sup>, duplicate filings of identical applications on different days<sup>11</sup> with confused and duplicative<sup>12</sup> listings of goods, inadvertent abandonment of all four applications, piecemeal revival of applications at different times and with different original filing dates, multiple incomplete amendments to allege use in the in one of the applications<sup>13</sup>, submission of inconsistent dates of use for the two applications<sup>14</sup> which matured into the registrations in issue, registrations that each

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<sup>8</sup> Reg'n 2,798,069 dated December 23, 2003 for A ANASTASIA BEVERLY HILLS (stylized and design) which issued from SN 75-833,290, filed 10-27-1999. (the "AABH" mark) and Reg'n 2,821,892 dated March 16,2004 which issued from SN 75-833,810, filed 10-28-1999. (the "ABH" mark).

<sup>9</sup> Declaration of Anastasia Soare dated January 14, 2010 (of record in Opposers' Motion for Summary Judgment as "Ex PB-1"), paragraphs 12 and 22.

<sup>10</sup> Ex PB-1, paragraphs 9, 12, 16-19; 22, 26, 27, & 29,

<sup>11</sup> Ex PB-1, paragraphs 12 and 22.

<sup>12</sup> Both "Body Lotion" and "Body Lotions" were listed under "Skin Care Products"

<sup>13</sup> Amendments to Allege Use and amendments thereto concerning the ABH mark were filed on 6/22/01, 9/9/02, and 4/14/03. Only the 6/22/01 Amendment included a Declaration actually signed by Ms Soare. The 9/9/02 declaration was signed on her behalf by her then counsel, and the 4/14/03 amendment, although intended to "clarify" the prior statement of use, did not include a new Declaration.

<sup>14</sup> 3-0-2000 and 9-0-200 for the words only ABH mark, 9-0-1999 for the stylized AABH mark which included those very same words.

listed duplicative goods<sup>15</sup>, and at least one registration that omitted amendments required by the examining attorney<sup>16</sup>.

***Reasonableness of Declarant's beliefs is not an issue***

*Bose* clearly holds that "the standard for finding intent to deceive is **stricter than the standard for negligence or gross negligence**, even though announced in patent inequitable conduct cases, applies with equal force to trademark fraud cases".<sup>17</sup> *Bose* also holds that there is no "need to resolve the issue of the **reasonableness** as it is **not part of the analysis**. There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive".<sup>18</sup>

***No motive***

*Registrant could have obtained an extension or could have divided out*

in *Daimler/Chrysler*, the entire business plan of AMC Corporation was apparently dependent on acquiring legal rights in a famous mark that had been abandoned by its previous owner, and there was no longer any possibility of getting any further extensions to commence actual use in commerce. Thus AMC Corporation had nothing to lose and everything to gain by falsely claiming to already be using the mark on the listed goods.

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<sup>15</sup> The aforementioned "Body Lotion" and "Body Lotions"; this may account for the discrepancy between Applicant's count of the number of designated specific goods mistakenly included in the original registrations and Opposers.

<sup>16</sup> The ABH registration lists "Bronzing Products" rather than "Bronzing Liquid" and "Eyebrow Color Products" rather than "Eyebrow Color Pencils".

<sup>17</sup> Slip opinion, pages 6-7 (of record in Opposer's Reply re Opposers' Motion to Amend Registrations as "Ex D").

<sup>18</sup> Ex D, page 10

In contrast, Opposers had already commenced use of the mark in commerce on the majority of the listed goods only a few months subsequent to the filing date<sup>19</sup> and once they had received consent from the owner of a potentially conflicting mark cited by the Examining Attorney, they were clearly entitled to a registration covering all of those particular goods. Accordingly, unlike AMC Corporation, had Opposers realized that they were about to commit fraud by seeking immediate registration of their mark for more goods than they were entitled to, they could have easily proceeded to registration with the goods already on sale, and filed a divisional application for any remaining goods which they still intended to sell in the future. Alternatively, they could have simply filed an extension (rather than filing the Statement of Use for the already published AABH mark) or waited until after the mark had been published and a notice of allowance had issued (for the not yet published ABH mark). It just doesn't make sense that Opposers would knowingly and intentionally risk losing the benefits of a valid federal registration covering all the goods they were then selling, just to save the cost of an extension or a second filing fee<sup>20</sup>.

## **DECLARANT'S MISTAKES WERE NOT MATERIAL**

### ***Date of first use***

Applicant places great stress on the fact that the dates of first use and of first use in commerce were erroneous and do not apply to all goods in all classes. However, Applicant does not (and indeed can not) show how such an error is material. See the Board's precedential opinion in *In Re*

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<sup>19</sup> See Declaration of Darrell Baum, attached hereto as "Exhibit DB" and in particular exhibit DB-2 thereof which is an Invoice to Nordstrom dated August 21, 2000 and which documents an order for over 3500 items divided over 150 different stock keeping units with a combined list price of almost \$100,000. A "Confidential" copy of this document has previously been produced to Applicant's counsel as Disclosure Document ABH020110C- ABH020115C.

<sup>20</sup> Which would have allowed any originally listed goods that were still in development to be protected with a divisional application having the same effective filing date.

*Kathleen Hiraga v. Sylvester J. Arena*, (hereinafter *Hiraga*) Cancellation No. 92047976 (TTAB, March 18, 2009), in which the Board clearly states on page 14 and 15 of the slip opinion:

However, the critical question in this case [the mark issued from a use based application] is whether the mark was in use in connection with the identified goods as of the filing date of his use-based application. That is, if the mark was in use in commerce as of the filing date, then **the claimed date of first use, even if false, does not constitute fraud because the first use date is not material to the Office's decision to approve a mark for publication.** *Standard Knitting, Ltd.*, 77 USPQ2d at 1926; *Colt Industries Operating Corp. v. Olivetti Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983) [**"The [Trademark] Examining Attorney gives no consideration to alleged dates of first use in determining whether conflicting marks should be published for opposition."**].

*No effect on scope of protection*

Although required by the Lanham Act, the dates of use entered in a 1(b) intent to use application have no practical import on the mark once it is registered on the Principal Register. The nationwide constructive use date and the international convention priority is calculated from the filing date. The period for opposition is calculated from the publication date. Renewal deadlines, establishment of incontestability, and presumption of abandonment are calculated from the registration date.

*Only one date is required per class and only one date is printed on registration*

Section 903.08 of TMEP<sup>21</sup> is instructive:

If more than one item of goods or services is specified in a particular class, **the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class.** It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on

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<sup>21</sup> [September 2009 revision]

various items on differing dates, so that it would be cumbersome to designate the dates for all items individually. *See Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (PTO 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PTO 1951).

There must be at least one specified item in a class to which the specified dates pertain. Where the dates of use do not pertain to all items, the applicant **should** designate the particular item(s) to which they do pertain. 37 C.F.R. §§2.34(a)(1)(v), 2.76(c), and 2.88(c).

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Where more than one date is specified for a particular class, the earliest date will be printed in the *Official Gazette* and, if a registration issues, on the certificate of registration. The *Official Gazette* and registration certificate will not indicate which item is specified.

*Can be corrected after publication/registration*

TMEP 1609.07 (Dates of Use) is instructive:

The USPTO will accept an amendment changing the dates of use, **even if the amended dates are later than the dates originally set forth in the registration.** *See In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r Pats. 1980); *Grand Bag & Paper Co., Inc. v. Tidy-House Paper Products, Inc.*, 109 USPQ 395 (Comm'r Pats. 1956). However, the USPTO will not enter an amendment if the amended dates are later than the dates that would have been accepted during examination.

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For the ABH mark, the Notice of Allowance was dated June 3, 2003. No extension was sought. So any use date prior to December 3, 2003 would be acceptable.

For the ABH mark, the application was not approved for publication until October 23, 2003, so any use date prior to that date would be acceptable.

***Could have obtained even broader protection by simply reciting "cosmetics"***

As noted in Opposers Motion for Summary Judgment, "Cosmetics" was an acceptable goods designation in June 2001, while both applications were still pending before the examining attorney.<sup>22</sup> According to official guidance<sup>23</sup> published on the FDA website at <http://www.fda.gov/Cosmetics/GuidanceComplianceRegulatoryInformation/ucm074201.htm>,

The Federal Food, Drug, and Cosmetic Act 1 (FD&C Act) defines "cosmetics" by their intended use, as "articles intended to be rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body...for cleansing, beautifying, promoting attractiveness, or altering the appearance" [FD&C Act, sec. 201(i)]. Among the products included in this definition are **skin moisturizers, perfumes, lipsticks, fingernail polishes**, eye and facial makeup preparations, shampoos, permanent waves, hair colors, toothpastes, and deodorants, as well as any material intended for use as a component of a cosmetic product.

Accordingly, had Opposers instead used the simple designation "cosmetics", their registration would arguably have covered all of the recited goods in class 3 except potpourri and room fragrances<sup>24</sup>.

**DECLARANT DID NOT "KNOW" HER DECLARATIONS WERE FALSE AND MATERIAL**

*Not a native English speaker*

Opposer was born and educated in Romania and had a limited knowledge of English when she arrived in California in 1989.<sup>25</sup>

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<sup>22</sup> See Ex P1-A to Opposers' Motion for Summary Judgment, and in particular, entry 80.

<sup>23</sup> Attached hereto as Ex-FDA.

<sup>24</sup> Neither of which is presently of commercial importance to Opposers. See paragraph 40 of Ex-PB-1.

*Not a lawyer*

The requirement that the use be "in the normal course of trade" is set forth in the Lanham act, but does not appear in the Declaration.

Applicant apparently confuses declarant's current understanding as to date of use in commerce with her understanding of that term in 2001-2003.<sup>26</sup>

*Listing of goods was external*

Opposer AS signed only two Declarations concerning use: the 2001 ABH Declaration<sup>27</sup> and the 2003 AABH Declaration<sup>28</sup>. The 2001 ABH Declaration did not include any list of goods. It was attached to an amendment, but the amendment itself did not list any goods, but merely referred to "the goods as stated in the application". Moreover the included specimens included four different products.<sup>29</sup>

The 2003 Declaration was part of a Statement of Use in the AABH application, it merely referred to the Notice of Allowance. The signature on the Declaration looks like it was hastily made, and the date is missing.<sup>30</sup>

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<sup>25</sup> Ex PB-1, paragraphs 3 & 4.

<sup>26</sup> Ex PB-1, paragraphs 21, 31,

<sup>27</sup> Ex TDR-1

<sup>28</sup> Ex TDR-3

<sup>29</sup> Ex PB-1, paragraph 20.

<sup>30</sup> Ex PB-1, paragraph 20.

*Multiple categories and multiple examples within each category*

Applicant has found 57 separately enumerated "goods" in each of the registrations. But nowhere in the application were they so numbered, rather they were grouped into categories separated by semicolons:

potpourri  
cosmetics  
skin care products;  
body cleansing products  
fragrance products  
room fragrances.

## **SENIORITY**

Applicant makes much ado in its brief as to the purported lack of skincare products in Opposers original line when it was introduced in 2000 and the lack of any such products on its website as recently as March 2009<sup>31</sup>. Even if true, that would be of little or no legal relevance in this matter. However, in fact, Opposers were selling skin care products before Applicant commenced use of its ANASTASIA mark

***Registrant launched its ANASTASIA BEVERLY HILLS brand in March 2000***

*Sales in salon promoted with nationwide publicity and advertising*

See paragraphs 5, 9, & 11 of Baum Declaration dated March 31, 2010 (Ex DB) and included Exhibit DB-5.

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<sup>31</sup> Apparently Applicant has not looked hard enough. See the attached Declaration of John May, Ex JMM.

*Included some skin care products from very beginning*

See paragraphs 6, 9 & 10 of Ex-DB and included Exhibits DB-1 p2 & DB-2

*National distribution through Nordstrom starting in October 2000*

See paragraph 8 of Ex-DB and included Exhibit DB-4. This is further confirmed by the WWD article cited by Applicant as Exhibit C

***Applicant's claimed date of first use of "ANASTASIA" as TM was in May 2000***

See Exhibit AML 3 from the 30b6 discovery deposition of Anastasia Marie Laboratories, taken on October 14, 2009. Although the application states "at least as early as May 23, 2000", the lack of any documented use prior to that date is implicitly conceded by the opening paragraph of Applicant's brief, which claimed that the ANASTASIA brand has been used on its products "for nearly 10 of those years"<sup>32</sup>.

*Applicant was still using "Anastasia Marie" as its trademark in July 2001*

See Exhibit AMC 10 from the discovery deposition of Anastasia Marie Chehak, taken on October 13, 2009. On July 24, 2001, "Anastasia Marie, President" signed a Section 8 & 9 Declaration of Use in Commerce stating that it "is using the mark [A ANASTASIA MARIE plus design] in commerce".<sup>33</sup>

*Applicant's president is still using the name "Anastasia Marie Chehak*

See Exhibit B to Applicant's Motion for Summary Judgment

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<sup>32</sup> The brief was dated February 12, 2010, so "nearly 10 years" before that date would be in late spring or early summer of 2000.

<sup>33</sup> During her deposition, Applicant's president and CEO explained that between May 2000 and July 2001 there was a phasing out of the ANASTASIA MARIE brand and a phasing in of the ANASTASIA brand.

## CONCLUSION

The landscape has changed noticeably since Applicant asserted its "fraud" counterclaims in March 2009. *Bose* and *Daimler/Chrysler* have now made it clear that intent to deceive cannot simply be inferred from negligent or even reckless (unreasonable) conduct, the falsehood must be material and the perpetrator must have knowledge that his/her falsehoods will result in rights to which he/she is not entitled. Without any smoking gun and without any demonstrable motive, a finding of willful deception cannot possibly be proven "up to the hilt" by "clear and convincing" evidence. To hold otherwise will neither serve the efficient administration of justice nor will it achieve the purpose of the Lanham Act to protect consumers and their trusted sources from passing off and other unfair competitive practices.

Applicant's focus on errors in date of first use is misplaced, that such errors are not material is clear from *Hiraga*.

The facts in this case are clear. Opposers adopted their ANASTASIA BEVERLY HILLS marks in good faith and have accrued much good will. Skin care products and makeup are closely related products, and both are considered "cosmetics". Opposers "eyebrow" line has included skin care products such as After Tweeze Cream and Pre Tweeze Gel from the very beginning. There never was any fraudulent intent to deceive the USPTO into granting a registration to which Opposers knew they were not entitled. The public is best served by amending Opposers' registrations to reflect today's competitive reality, not by cancelling them in their entirety.

Respectfully submitted

/JMM/  
John M May  
Attorney for OPPOSERS

Dated: March 31, 2010

CERTIFICATE OF SERVICE  
(First Class Mail)

The undersigned hereby certifies that a printed copy of this OPPOSITION TO APPLICANT'S MOTIONS is being served this date upon APPLICANT's counsel, by first class priority mail addressed to

Law Offices Of Daphne Sheridan Bass  
921 26th St  
Santa Monica, Ca 90403-2203

/JMM/  
John M May  
Attorney for Opposers

Dated: March 31, 2010

TRADEMARK  
01-9403

AC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. PATENT AND TRADEMARK OFFICE

2001 JUL -3 A 10 43

In re the application of:  
**A.A.S. COSMETICS, INC.**

U.S. PATENT AND TRADEMARK OFFICE

Serial Number: 75/833,810

Examining Attorney: WOOD, C.

Filed: October 28, 1999

Law Office: 106

For: **ANASTASIA BEVERLY HILLS**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513  
BOX AAU FEE



06-22-2001

U.S. Patent & TMO/TM Mail Rpt. Dt. #40

AMENDMENT TO ALLEGE USE UNDER 37 C.F.R. § 2.76

Dated: June 19<sup>th</sup>, 2001

Dear Sir:

Applicant requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 *et seq.*, as amended). Two (2) specimens showing the mark as used in commerce are submitted with this amendment.

Applicant is using the mark in commerce or in connection with the goods as stated in the application.

The mark was first used at least as early as March, 2000. The mark was first used in interstate commerce regulable by Congress, at least as early as September, 2000.

The fee for this Amendment to Allege Use is enclosed pursuant to 37 C.F.R. § 2.6. It is believed that no additional fees are required. However, if additional fees

07/02/2001 EPINA1 00000432 75833810

01 FC:362

100.00 OP

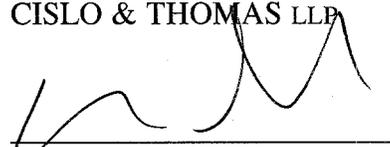


EX TDR-1

are necessary, the Trademark Examiner is hereby authorized to charge Applicant's Attorney's Deposit Account No. 03-2030 for any additional fees due.

Respectfully submitted,

CISLO & THOMAS LLP



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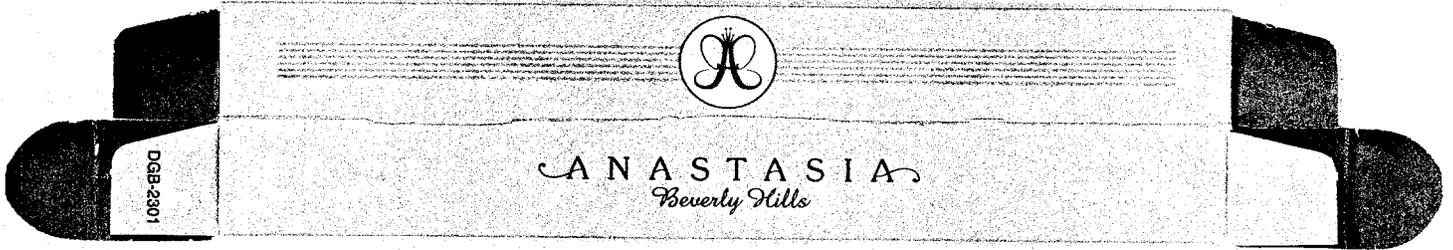
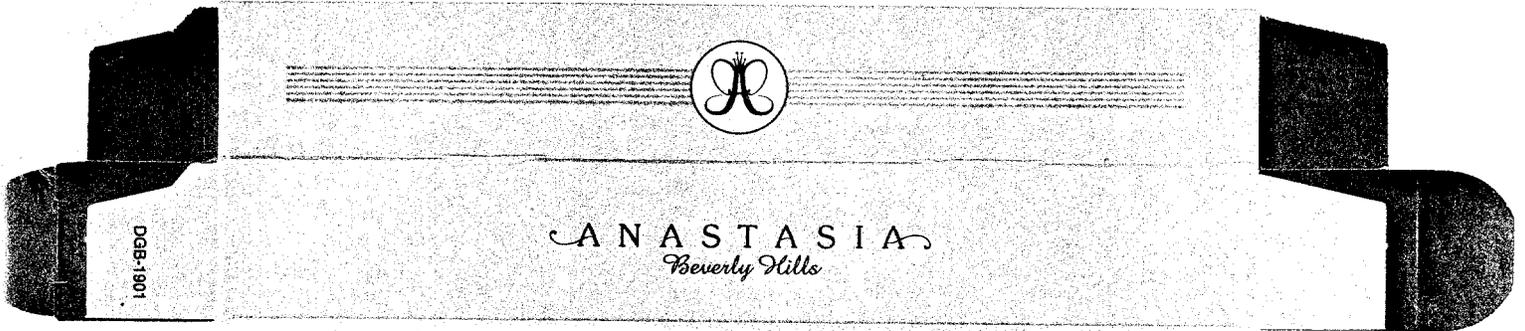
Daniel M. Cislo  
Reg. No. 32,973

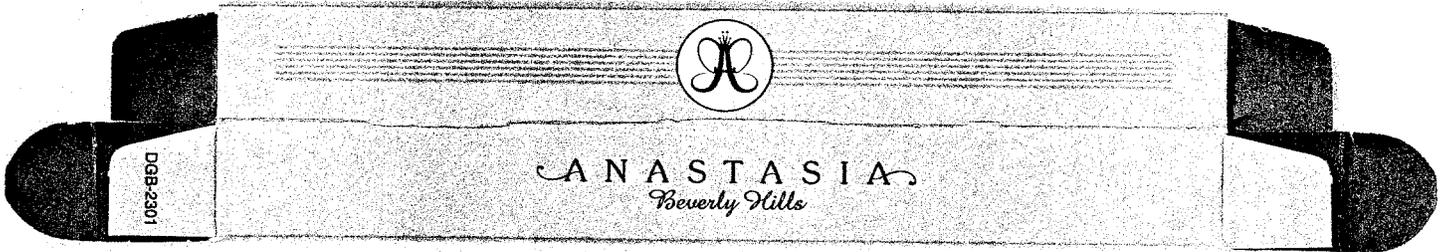
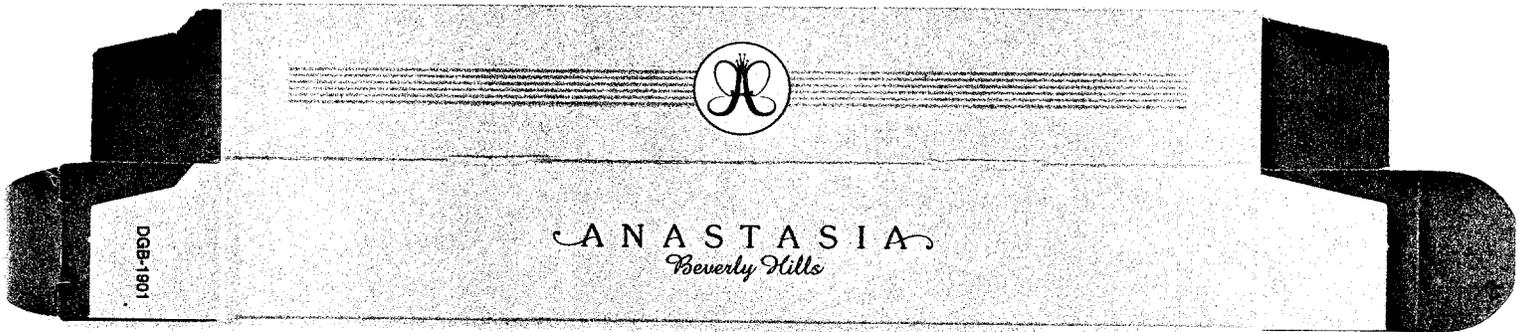
Date: June 19<sup>th</sup>, 2001

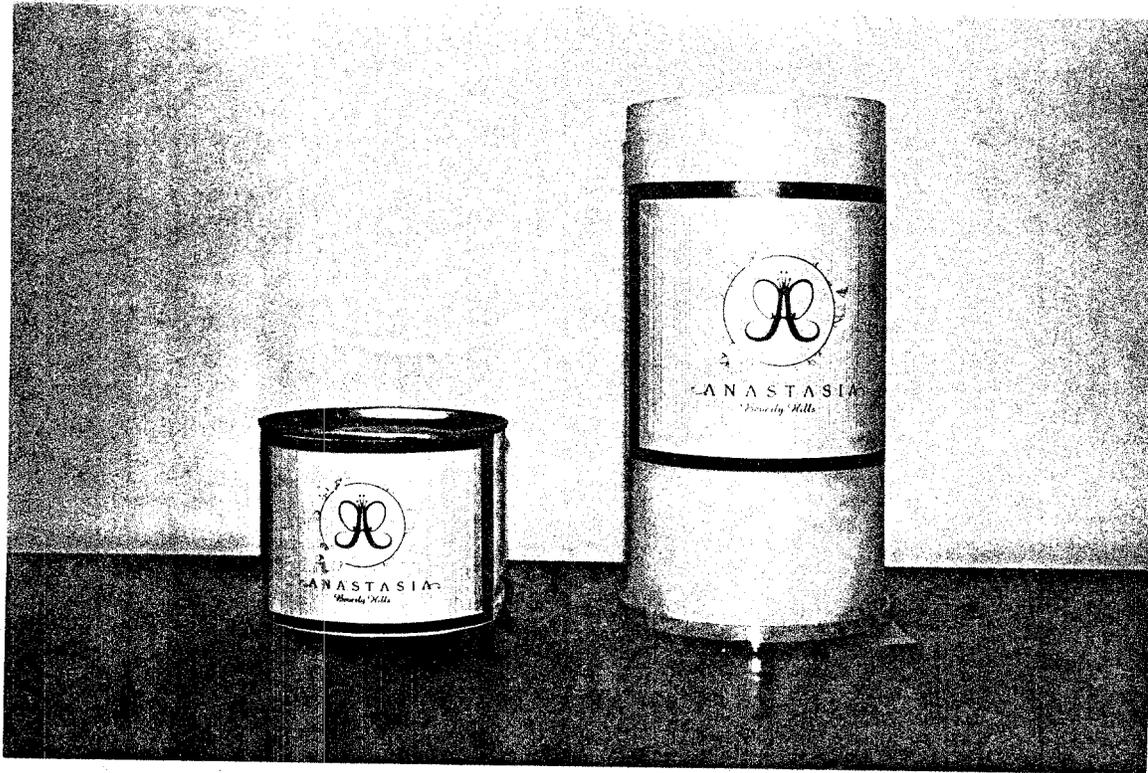
Enclosures

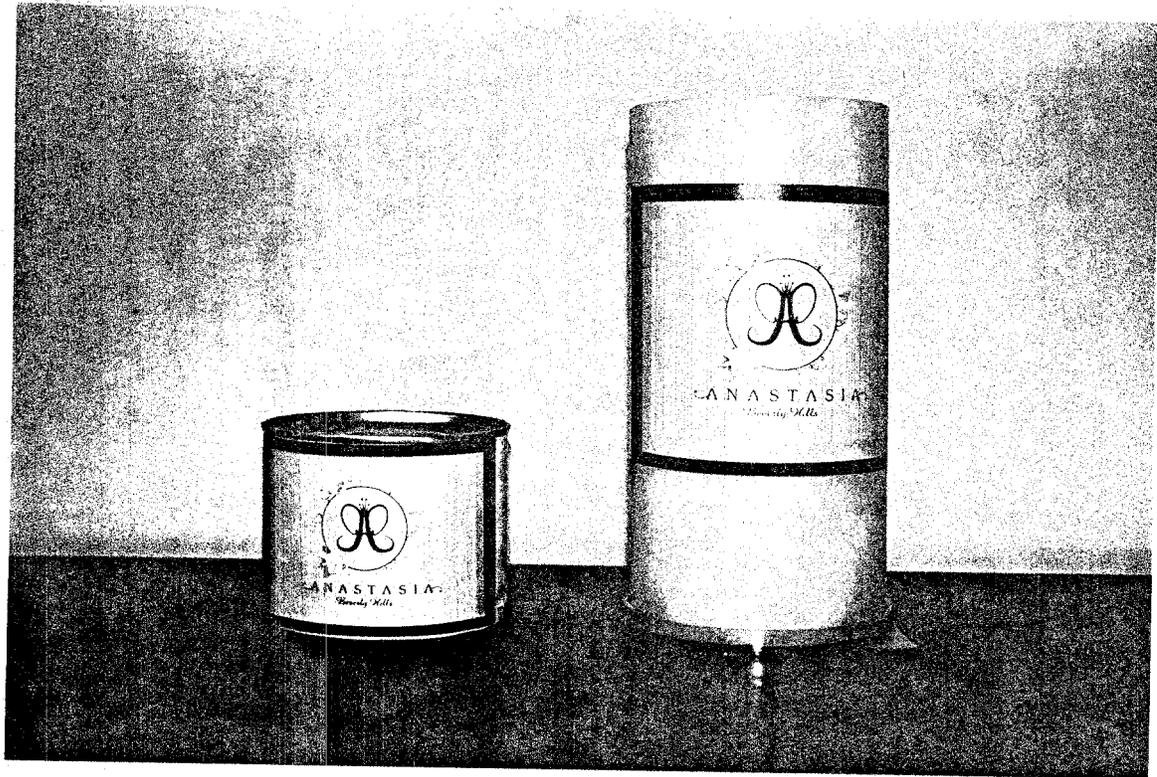
Original Specimens (2)  
Photographs of Specimens (2)

CISLO & THOMAS LLP  
233 Wilshire Boulevard, Suite 900  
Santa Monica, California 90401-1211  
Tel: (310) 451-0647  
Fax: (310) 394-4477  
www.cislo.com









# DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the Application or any resulting registration, declares that he is properly authorized to exercise this Amendment to Allege Use on behalf of the Applicant; he believes the Applicant to be the owner of the mark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

A.A.S. COSMETICS, INC.

Date: ~~April~~ 22, 2001

*Mary*  
AJ for AS  
per

*Anastasia*

Signature

*Anastasia Socarr*

Print Name

*President*

Title

## DECLARATION

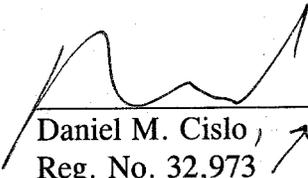
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The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the Application or any resulting registration, declares that he is properly authorized to <sup>with</sup> exercise this Amendment to Allege Use on behalf of the Applicant; he believes the Applicant to be the owner of the mark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

Respectfully submitted,

CISLO & THOMAS LLP

Date: September <sup>4<sup>th</sup></sup>   , 2002

  
\_\_\_\_\_  
Daniel M. Cislo, <sup>→</sup>  
Reg. No. 32,973 <sup>in</sup>

*believe 2 Applicant*

Ex TDR-2

TRADEMARK

01-9779

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Anastasia Beverly Hills, Inc.

Serial Number: 75/833,290

Date Filed: October 27, 1999

International Classes: 03, 04, 08, 021

For: A ANASTASIA BEVERLY HILLS Logo

STATEMENT OF USE UNDER SECTION 2.88 AND TRANSMITTAL THEREOF

Box FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

08/27/2003 KSONCHAM 00000051 75833290

01 FC:6003

400.00 OP

2003 AUG 28 PM 12:00

T.M.S.D.  
I.T.U. UNIT

Dear Sir:

Transmittal and filing of the attached Statement of Use Under Section 1(d) is proper as the Examining Attorney issued a Notice of Allowance on June 3, 2003, less than six (6) months from mailing this Statement of Use.

The mark was first used at least as early as September 1999 and was first used in interstate commerce, regulable by Congress, at least as early as September 1999 for:

*Potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eye liners, lip coverings, lip stick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow promade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye-area creams, facial masques, facial serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions,*



08-08-2003

Page 1 of 1

EX TDR-3

*body toners, body astringents, and hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, and fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances,* in International Class 3;

*Candles,* in International Class 4;

*Eyebrow tweezers and eyebrow grooming scissors,* in International Class 8; and

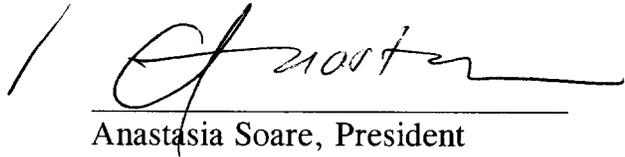
*Cosmetic brushes,* in International Class 21.

Applicant uses the mark for the same goods as specified in the Examining Attorney's Notice of Allowance and uses it on the goods or on packaging for the goods as is customary in the trade in the manner specified in the Application. Two (2) specimens showing the mark as used in commerce are submitted herewith for each class.

**DECLARATION**

The undersigned hereby declares: that she is an officer of Applicant corporation and is authorized to make this declaration on behalf of Applicant; that she believes Applicant to be the owner of the mark sought to be registered; that Applicant has used the mark in commerce on or in connection with the goods specified in the Notice of Allowance; that to the best of her knowledge and belief, no other person, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive. The facts in this statement are true; and all statements made of her own knowledge are true and statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of this Application or any registration resulting from it.

ANASTASIA BEVERLY HILLS, INC.

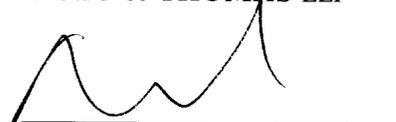
  
Anastasia Soare, President

Date: \_\_\_\_\_, 2003  
Month and day

The fee for this Statement of Use is enclosed. It is believed that no additional fees are required. However, if additional fees are necessary, the Trademark Examiner is hereby authorized to charge Applicant's attorney's deposit account no. 03-2030 for any additional fees due.

Respectfully submitted,

CISLO & THOMAS LLP

  
\_\_\_\_\_  
Daniel M. Cislo, Esq.

Date: August 5, 2003

Enclosures

Specimens  
Check & Acknowledgement Postcard

CISLO & THOMAS LLP  
233 Wilshire Boulevard, Suite 900  
Santa Monica, California 90401-1211  
Tel: (310) 451-0647  
Fax: (310) 394-4477  
www.cislo.com

Z:\TMDOCS\01-9779\DECLARATION OF USE.DOC

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

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ANASTASIA BEVERLY HILLS, INC.	)	
ANASTASIA SOARE	)	Opposition No. 91,188,736
ANASTASIA SKIN CARE, INC.	)	
	)	
Opposers	)	<b>OPPOSERS' MOTION TO</b>
	)	<b>DISMISS</b>
v.	)	<b>COUNTERCLAIMS</b>
	)	
ANASTASIA MARIE LABORATORIES, INC.	)	
	)	
Applicant	)	

---

**EXHIBIT PB-1**

(Declaration of Anastasia Soare)



drawing, and mathematics during college, and trained professionally as an Esthetician in Romania before moving with my family to California in 1989.

4. At the time I relocated to California, I had only a limited knowledge of English, and spoke with a strong accent. However, my skills as an esthetician (and in particular those for eyebrow shaping and waxing) were recognized by others in my field, and after obtaining my license in 1990, I rapidly developed my own clientele.

5. I formed Opposer ASC on or about January 29, 1997, and its Beverly Hills skincare salon opened on Bedford Drive in Beverly Hills in July 1997. That salon has always provided a full range of cosmetic and skincare services including application of makeup, makeup lessons, facials, anti-aging treatments for the eyes and face, removal of unwanted hair (waxing) from the face and body, as well as my signature eyebrow shaping services.

6. From its inception, the clientele of our Beverly Hills salon was not limited to local residents, but has always included numerous visitors from out of state and from other countries, many of whom make appointments on a regular basis with me personally for my eyebrow shaping services. Over the years, our clientele has included celebrities such as Oprah, Madonna, Jennifer Lopez, Naomi Campbell, Jada Pinkett Smith, Lara Flynn Boyle, Melissa Etheridge, Penelope Cruz, Sharon Stone, and others.

7. My experience and continued interest in the science of aesthetics have enabled me to achieve a nationwide reputation as an expert in aesthetics, cosmetics and skin care. I have appeared on many nationally broadcast television shows such as Today, Oprah, Fox Business Channel, Extreme Makeover, Access Hollywood, Xtra, Entertainment Tonight. My story has been featured in the pages of top publications such as Wall Street Journal, Vogue, W, Town & Country, Elle, InStyle, Allure, Entertainment Weekly, Newsweek, People, Flaunt and Los Angeles Magazine.

8. At the time we opened our Beverly Hills salon in 1997, it was my intention to develop my own line of cosmetics, skincare, and "lifestyle" products which would be used in the salon and also sold at retail both in the salon and at selected retail outlets.

9. On or about February 24, 1999, with financial support from Mr Arnold Simon, I founded AAS (which later changed its name to ABH), with myself as President and Howard Barnaby of Robin, Blecker & Daley ("RB&D) as trademark counsel. We decided to adopt the distinctive phrase "ANASTASIA BEVERLY HILLS" as our house mark, and I retained Bird Designs to design a new logo.

10. By September 1999, we were actively working with various suppliers (including established makers of high-quality cosmetics and toiletries and associated packaging in New York, Italy, and Japan) to develop new skincare and cosmetics products for national distribution by Opposer ABH, to be labeled with the ANASTASIA BEVERLY HILLS name and logo.

11. At about that same time, I was engaged in planning for a remodel of our salon in which the signage of our salon was to be changed from simply "Anastasia" to "ANASTASIA Beverly Hills" (with the newly adopted logo), so that our existing clients and prospective customers would clearly identify a common source with a nationwide reputation for excellence for both our existing services and our future products.

#### **Prosecution of Registration No. 2821892**

12. On or about October 26, 1999, as President of AAS, I signed an intent-to-use trademark application bearing docket number B877-003 for the ANASTASIA BEVERLY HILLS word mark for goods in Classes 3, 4, 5, 8 and 21 (the "ABH Mark "). I understand that the application subsequently was filed in duplicate by RB&D on October 27, 1999 under serial number 75833289 (which I understand is now "DEAD"), and on October 28, 1999 under serial number 75833810 (the "ABH Application").

13. The ABH Application included a Declaration (the "1999 ABH Declaration") which stated that I believed AAS "to be entitled to use such mark in commerce" and that to the best of my knowledge and belief "no other firm, corporation or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as to be likely, when used in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive."

14. The ABH Application listed a large number of "goods" and stated that "Applicant has a bona fide intention to use the mark in commerce in connection with the above-identified goods" and that the "mark will be used on labels and packaging for the goods."

15. The 1999 ABH Declaration did not itself make any explicit reference to any specific goods, and I did not conduct a careful review of the "goods" listed in the body of the application or have a clear understanding of what it means to "use the mark in commerce", other than to note that the listing of "goods" included all the product categories (including cosmetics and grooming tools, skin care products, and fragrance products) that I was planning to market under the brand name "Anastasia Beverly Hills."

16. On or about October 24, 2000 Debra L. Johnson ("DLJ"), whom I had previously retained as counsel for ABH, apparently requested an extension to respond to an April 24, 2000 office action. On February 5, 2001 a notice of abandonment of the ABH Application was apparently mailed to RB&D, based on failure to timely/completely respond to the April 24, 2000 office action.

17. Sometime subsequent to February 5, 2001, I retained Cislo and Thomas ("C&T") as our new trademark counsel. On or about March 29, 2001, C&T filed what I understood to be a complete response to the April 24, 2000 office action, as well as a Petition to Revive the ABH Application which was prepared by C&T and signed by myself on or about March 22, 2001. The Petition to Revive stated

that the failure to "timely/completely respond" by our prior counsel happened "apparently inadvertently," and that "Applicant" had only recently become aware of that abandonment.

18. On or about June 22, 2001, C&T filed an Amendment to Allege Use dated June 19, 2001 (the "2001 ABH Amendment"), and on or about September 9, 2002 a second Amendment to Allege Use dated September 4<sup>th</sup>, 2002 (the "2002 ABH Amendment"). The 2002 Amendment was subsequently "clarified" by a third Amendment to Allege Use filed on or about April 14, 2003 and dated April 10, 2003 (the "2003 ABH Clarification").

19. The 2001 ABH Amendment was prepared by C&T and I signed the Declaration, dated May 22, 2001 ("2001 ABH Declaration"), that appears on page 7 of the 2001 ABH Amendment. The 2001 ABH Declaration stated my belief that, among other things, ABH was the owner of the ANASTASIA BEVERLY HILLS word mark and that the mark "is now in use in commerce."

20. When signing the 2001 ABH Declaration, I did not realize that the 2001 ABH Amendment would be interpreted to mean that ABH was claiming that it was then using the mark in any particular way on any specific product other than would be apparent from the specific product specimens which I had provided to counsel: eyebrow highlighting pencils, eye liners, cosmetic wax, candles, cosmetics brushes, and tweezers (I now understand that the latter two specimens were not filed with the 2001 ABH Declaration, but were subsequently filed with the 2002 ABH Amendment).

21. It is my understanding that the ABH Application was published for Opposition on December 23, 2003, and issued on March 16, 2004 (the "ABH Registration"). Prior to the issuance of the ABH Registration, I mistakenly believed that any commercial use of the name "Anastasia Beverly Hills" constituted "use in commerce." In particular, I then believed that, as long as ABH sold or used the goods in the Anastasia Beverly Hills salon, which was clearly

identified with the ABH Mark, then ABH had used the ABH Mark “in commerce on or in connection with the goods.”

**Prosecution of Registration No. 2798069**

22. On or about October 26, 1999, as President of AAS, I signed an intent-to-use application bearing docket number B877-002 for the A ANASTASIA BEVERLY HILLS (stylized) and Design mark for goods in Classes 3, 4, 5, 8 and 21 (the "AABH Mark"), which I understand was subsequently filed in duplicate by RB&D on October 27, 1999 under serial number 78833290 (the "AABH Application"), and on October 28, 1999 under serial number 75833809 (which I understand is now "DEAD").

23. The AABH Application included a Declaration (the "1999 AABH Declaration") which stated that I believed AAS "to be entitled to use such mark in commerce" and that to the best of my knowledge and belief "no other firm, corporation or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as to be likely, when used in connection with the goods of such other person, to cause confusion. or to cause mistake, or to deceive."

24. The AABH Application listed a large number of "goods" and stated that "Applicant has a bona fide intention to use the mark in commerce in connection with the above-identified goods" and that the "mark will be used on labels and packaging for the goods."

25. The 1999 AABH Declaration did not itself make any explicit reference to any specific goods, and I did not conduct a careful review of the "goods" listed in the body of the AABH Application or have a clear understanding of what it meant to "use the mark in commerce," other than to note that the listing of "goods" included all the product categories (including cosmetics and grooming tools, skin care products, and fragrance products) that I was planning to market under the brand name "Anastasia Beverly Hills" and our newly adopted logo.

26. On or about October 24, 2000, DLJ apparently requested an extension to respond to an outstanding office action dated April 24, 2000. On or about February 5, 2001, a notice of abandonment of the AABH Application was apparently mailed to RB&D, based on failure to timely/completely respond to the April 24, 2000 office action.

27. On May 20, 2002, C&T apparently filed in the AABH Application a Petition to Revive the AABH Application which I had previously signed on or about October 23, 2001, together with an Amendment dated May 15, 2002.

28. The AABH Application was Published on March 11, 2003 and a Notice of Allowance was issued on June 3, 2003.

29. On or about August 5, 2003, C&T filed a Statement of Use of the A ANASTASIA BEVERLY HILLS & Design mark, which included a undated Declaration signed by me (the "2003 AABH Declaration") which stated that, among other things, ABH was the owner of the A ANASTASIA BEVERLY HILLS & Design mark and that ABH "has used the mark in commerce on or in connection with the goods specified in the Notice of Allowance."

30. Prior to signing the 2003 AABH Declaration, I did not review the Notice of Allowance and I did not realize that the Notice of Allowance covered goods other than what would be apparent from the product specimens which we had previously provided counsel, namely eyebrow highlighting pencils, eye liners, cosmetic wax, candles, cosmetics brushes, tweezers, exfoliating shower cream, body milk, exfoliating face scrub, hand cream, loose powder, brow powder, eye shadow, body bar soap, and mascara. In particular, I did not realize that the Notice of Allowance specifically included nail polish, nail base coat, and nail top coat; facial toners, facial astringents, facial masques, body toners, body astringents; fragranced bar body toners, and astringents.

31. Furthermore, I did not know that the Statement of Use would be interpreted to mean that ABH was claiming that it was using the mark on each of

those goods in interstate commerce, nor did I understand the legal meaning of "interstate commerce."

32. The AABH Application was apparently published for opposition on March 11, 2003, and issued on December 23, 2003 as Registration No. 1798069 (the "AABH Registration").

### **Basis for Proposed Amendments**

33. I now understand that in the context of trademark rights under US federal trademark law, "in commerce" refers to interstate commerce regulable by Congress, and that "use" means applying the mark to specific "goods" or "services" (or otherwise using the mark to identify the origin or sponsorship of those specific goods and services) in the normal course of trade in those goods or services.

34. In particular, I now understand that "use in commerce" encompasses goods bearing the ABH and AABH Marks that have been distributed by or for ABH to retail stores such as Nordstrom and Sephora which are located in more than one state, goods bearing those marks which are manufactured in one state and are then distributed by or for ABH into another state, goods bearing those marks which are shipped by or for ABH from a distribution center in one state to customers in another state or foreign country, and goods bearing those marks which are sold by or for ABH in one state to customers who transport those goods to other states or countries for use in those other states or countries.

35. It is also my present understanding that a registration based on use in the United States can cover only goods and services for which the mark was actually being used in commerce (as defined above) as of the date of registration.

36. Based on my present understanding of "use in commerce," I hereby confirm that, at least as early as August 5, 2003 (the filing date of the Statement of Use in the AABH Application), the ABH and AABH Marks were actually being

used in commerce, on the product specimens filed in the ABH Application and in the AABH Application. Specifically, at least as early as September 9, 2002 (the filing date of the 2002 ABH Amendment), the ABH and AABH marks were being used in commerce on eyebrow highlighting pencils, eye liners, depilatory wax, candles, cosmetics brushes, and tweezers (the specimens of use filed in the ABH Application) and at least as early as August 5, 2003 (the filing date of the Statement of Use in the AABH Application) on exfoliating shower cream, candles, body milk, exfoliating face scrub, hand cream, loose powder, brow powder, eye shadow, body bar soap, mascara, cosmetics brushes, and tweezers (the specimens of use filed in the AABH Application).

37. Based on my present understanding of "use in commerce" as set forth above, and based on my present understanding of the common trade usage of these terms in connection with cosmetics and skincare products and services, I hereby also confirm that, at least as early as August 5, 2003, the ABH and AABH marks were actually being used in commerce on the following generic goods listed in the ABH and AABH Registrations: foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing products/bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color products/eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel; facial cleansers, facial cleansing bars, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye area creams, facial serums, facial exfoliators, body cream, body lotion/body lotions, body powder, body moisturizers, and hand creams; body cleansing creams, and bar soaps; fragranced creams and lotions; candles; eyebrow tweezers and eyebrow grooming scissors; and cosmetic brushes.

38. I do not profess to be an expert on what constitutes normal trade usages and practices in the field of fragrances and perfumes; however, as of as August 5, 2003, I then believed in good faith and today still believe that the ABH and AABH marks were and are being used in commerce on the following generic

goods listed in the ABH and AABH Registrations: potpourri; perfume, eau de parfum, eau de toilette, eau de cologne; room fragrances.

39. Based upon my present understanding of "use in commerce," on the registration dates of the ABH and AABH marks, to the best of my knowledge and belief, the marks had not been used in commerce on the following generic goods listed in the registrations: nail polish, nail base coat, and nail top coat; facial toners, facial astringents, facial masques, body toners, body astringents; body cleansing gels; fragranced gels, bar body toners, and astringents.

40. Since it now appears that the ABH and AABH Registrations were improperly extended, without any deceptive intent, to cover certain goods on which the ABH and AABH marks had not actually been "used in commerce" as of the date of registration, I, as President of ABH, have instructed our current trademark counsel to seek to amend the registrations to delete such goods. Specifically, we wish to amend the registrations to delete the following goods: nail polish, nail base coat, and nail top coat; facial toners, facial astringents, facial masques, body toners, body astringents; body cleansing gels; fragranced gels, bar body toners, and astringents from the ABH and AABH Registrations.

41. We are not currently promoting for nationwide sale, and presently have no firm plans to do so in the future, the following generic categories of goods listed in the ABH and AABH Registrations: potpourri; facial cleansing bars, facial cleansers, facial exfoliators, body powder; body cleansing products, namely, creams, and bar soaps; perfume, eau de parfum, eau de toilette, eau de cologne; room fragrances; and candles. Although I do not have any reason to believe that these particular types of goods were not validly covered by the original ABH and AABH Registrations, I have instructed counsel to not include those particular goods in any extension or renewal of the ABH and AABH Registrations.

42. It has been recently brought to my attention that inconsistent and/or erroneous dates of first use were inadvertently made of record for the ABH and

AABH Registrations. Based on my present understanding of "use" and "use in commerce", I confirm that the ABH and AABH marks were first used in the Beverly Hills salon at least as early as March 2000 on at least some of the listed goods in classes 3, 8 and 21 (for example, on eyebrow pencils, tweezers and cosmetic brushes) and at least as early as December 2001 for class 4 (candles); we have documentary evidence that those marks were first used in commerce on at least some of the listed goods shipped in the normal course of trade to national accounts such as Nordstrom at least as early as August 2000 for classes 3 and 8 (for example, eyebrow pencils and tweezers), at least as early as October 2000 for class 21 (cosmetic brushes), and at least as early as August 2003 for class 4 (candles).

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

This Declaration is being executed in Beverly Hills, California on January 14, 2010.

\_\_\_\_\_/Anastasia Soare/\_\_\_\_\_  
Anastasia Soare



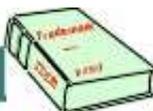


United States Patent and Trademark Office

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# Trademark ID Manual



**Refine Search:**

Documents: 1 - 216 of 216

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	001	Antioxidants and proteins used in the manufacture of cosmetics, beverages, food products and food supplements	A	09 Aug 07	G	N	
2	001	Aqueous aromatic additives for use in the manufacture of room fresheners and cosmetics	M	17 Sep 09	G	Y	
3	001	Botanical extracts for use in making cosmetics	A	01 Jun 01	G	N	
4	001	Chemical additives for use in the manufacture of {indicate general nature of items, e.g., food, pharmaceuticals, cosmetics or indicate for a wide variety of goods, if accurate}	M	01 Nov 01	G	N	
5	001	Collagen used as a raw ingredient in the manufacture of cosmetics	A	23 Apr 09	G	N	T
6	001	Emollient used as an ingredient in the manufacture of cosmetics, toiletries, and pharmaceuticals	A	20 Nov 08	G	N	
7	001	Fermented rice bran for use in the manufacture of cosmetics	A	01 Jul 04	G	N	
8	001	Functionalized silicones for use in the manufacture of personal care and cosmetic compositions	A	01 Dec 05	G	N	
9	001	Glutamic acid as raw materials for use in the manufacture of cosmetics	A	26 Mar 09	G	N	T
10	001	Glycerine for use in the manufacture of {indicate general nature of items, e.g., food, pharmaceuticals, cosmetics or indicate for a wide variety of goods, if accurate}	A	18 Sep 08	G	N	
11	001	Glycerol for use in the manufacture of {indicate general nature of items, e.g., food, pharmaceuticals, cosmetics or indicate for a wide variety of goods, if accurate}	A	18 Sep 08	G	N	
12	001	Lipids used in the manufacture of cosmetics, beverages, food products and food supplements	M	10 Dec 09	G	Y	



36	003	Chalk for cosmetic use	A	20 Jul 04	G	N	T
37	003	Cleaner for cosmetic brushes	A	01 Jun 01	G	N	
38	003	Cleansing creams [cosmetic]	A	20 Jul 04	G	N	T
39	003	Cocoa butter for cosmetic purposes	A	12 Apr 99	G	N	
40	003	Colognes, perfumes and cosmetics	A	08 Nov 07	G	N	T
41	003	Coloring preparations for cosmetic purposes	A	01 Feb 06	G	N	
42	003	Concealers [not acceptable alone, but acceptable in a cosmetics list]	A	01 Oct 94	G	N	
43	003	Cosmetic balls	A	01 Oct 94	G	N	
44	003	Cosmetic creams	A	20 Jul 04	G	N	T
45	003	Cosmetic creams for skin care	A	20 Jul 04	G	N	T
46	003	Cosmetic facial blotting papers	A	01 Aug 05	G	N	
47	003	Cosmetic hair dressing preparations	A	31 Jul 08	G	N	T
48	003	Cosmetic hair regrowth inhibiting preparations	A	07 Aug 08	G	N	T
49	003	Cosmetic masks	A	28 May 09	G	N	
50	003	Cosmetic milks	A	01 Jun 05	G	N	
51	003	Cosmetic oils	A	20 Jul 04	G	N	T
52	003	Cosmetic oils for the epidermis	A	20 Jul 04	G	N	T
53	003	Cosmetic olive oil for the face and body	A	15 Nov 07	G	N	
54	003	Cosmetic pads	A	01 Oct 94	G	N	
55	003	Cosmetic pencils	A	02 Apr 91	G	N	
56	003	Cosmetic preparations for skin renewal	A	04 Sep 01	G	N	
57	003	Cosmetic preparations against sunburn	A	20 Jul 04	G	N	T
58	003	<del>Cosmetic preparations and products for dry skin during pregnancy</del>	D	01 Sep 04	G	Y	T
59	003	<del>Cosmetic preparations and products for enhancing the breasts</del>	D	01 Sep 04	G	Y	T
60	003	<del>Cosmetic preparations and products for skin care</del>	D	01 Sep 04	G	Y	T
61	003	Cosmetic preparations for body care	A	20 Jul 04	G	N	T
62	003	Cosmetic preparations for eye lashes	A	20 Jul 04	G	N	T
63	003	Cosmetic preparations for the care of mouth and teeth	A	20 Jul 04	G	N	T



91	003	Cotton for cosmetic purposes	A	02 Apr 91	G	N	
92	003	Cotton puffs for cosmetic purposes	A	02 Apr 91	G	N	
93	003	Cotton sticks for cosmetic purposes	A	02 Apr 91	G	N	T
94	003	Cotton swabs for cosmetic purposes	A	02 Apr 91	G	N	T
95	003	Cotton wool and cotton sticks for cosmetic purposes	A	17 Jan 08	G	N	T
96	003	Cotton wool for cosmetic purposes	A	08 Nov 07	G	N	T
97	003	Decorative transfers and skin jewels for cosmetic purposes	A	01 Jan 05	G	N	
98	003	Eye compresses for cosmetic purposes	A	01 Jun 01	G	N	
99	003	Eyebrow cosmetics	A	08 Nov 07	G	N	T
100	003	Face creams and cleansers containing benzoyl peroxide for cosmetic purposes	A	19 Feb 09	G	N	
101	003	Face creams for cosmetic use	A	20 Jul 04	G	N	T
102	003	Foams containing cosmetics and sunscreens	A	01 Aug 04	G	N	
103	003	<del>Foundation [not acceptable alone, but acceptable in a list of cosmetics]</del>	D	19 Apr 07	G	Y	
104	003	Gauze for cosmetic purposes	A	01 Jan 05	G	N	
105	003	Gift baskets containing non-medicated bath preparations and cosmetic preparations	A	03 Sep 09	G	N	
106	003	Glitter for cosmetic purposes	A	20 Nov 08	G	N	T
107	003	Grape seed oil for cosmetic use	A	22 May 08	G	N	
108	003	Greases for cosmetic purposes	A	03 Aug 06	G	N	
109	003	Henna for cosmetic purposes	A	20 Jul 04	G	N	T
110	003	Impregnated cleaning pads impregnated with cosmetics	A	05 Mar 09	G	N	T
111	003	Lotions for cosmetic purposes	A	08 Nov 07	G	N	T
112	003	Make-up kits comprised of {indicate cosmetics, e.g., lipstick, lip gloss, etc.}	A	01 Jun 01	G	N	
113	003	Milk for cosmetic purposes	A	21 Aug 08	G	N	T
114	003	Mineral powder for use in cosmetic body wrap applications	A	19 Jun 08	G	N	
115	003	Nail varnish for cosmetic purposes	A	20 Jul 04	G	N	T









210	044	Health spa services for health and wellness of the body and spirit, namely, providing massage, facial and body treatment services, cosmetic body care services	A	19 Mar 09	S	N	
211	044	Health spa services, namely, cosmetic body care services	M	01 Jan 02	S	Y	
212	044	Medical spa services, namely, minimally and non-invasive cosmetic and body fitness therapies	A	05 Nov 09	S	N	
213	044	Non-invasive cosmetic medical procedures	A	08 Mar 07	S	N	
214	044	Performing cosmetic surgical procedures for vaginal rejuvenation	A	16 Jul 09	S	N	
215	044	Provide a website featuring information about holistic cosmetic and plastic surgery practice	A	07 May 09	S	N	
216	044	Skin tanning service for humans for cosmetic purposes	A	19 Apr 07	S	N	T

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## Cosmetics

### Is It a Cosmetic, a Drug, or Both? (Or Is It Soap?)

July 8, 2002

The legal difference between a cosmetic and a drug is determined by a product's intended use. Different laws and regulations apply to each type of product. Firms sometimes violate the law by marketing a cosmetic with a drug claim, or by marketing a drug as if it were a cosmetic, without adhering to requirements for drugs.

#### How does the law define a cosmetic?

The [Federal Food, Drug, and Cosmetic Act](#)<sup>1</sup> (FD&C Act) defines cosmetics by their intended use, as "articles intended to be rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body...for cleansing, beautifying, promoting attractiveness, or altering the appearance" [FD&C Act, sec. 201(i)]. Among the products included in this definition are skin moisturizers, perfumes, lipsticks, fingernail polishes, eye and facial makeup preparations, shampoos, permanent waves, hair colors, toothpastes, and deodorants, as well as any material intended for use as a component of a cosmetic product.

#### How does the law define a drug?

The FD&C Act defines drugs, in part, by their intended use, as "articles intended for use in the diagnosis, cure, mitigation, treatment, or prevention of disease" and "articles (other than food) intended to affect the structure or any function of the body of man or other animals" [FD&C Act, sec. 201(g)(1)].

#### How can a product be both a cosmetic and a drug?

Some products meet the definitions of both cosmetics and drugs. This may happen when a product has two intended uses. For example, a shampoo is a cosmetic because its intended use is to cleanse the hair. An antidandruff treatment is a drug because its intended use is to treat dandruff. Consequently, an antidandruff shampoo is both a cosmetic and a drug. Among other cosmetic/drug combinations are toothpastes that contain fluoride, deodorants that are also antiperspirants, and moisturizers and makeup marketed with sun-protection claims. Such products must comply with the requirements for both cosmetics and drugs.

#### What about "cosmeceuticals"?

The FD&C Act does not recognize any such category as "[cosmeceuticals](#)."<sup>2</sup> A product can be a drug, a cosmetic, or a combination of both, but the term "cosmeceutical" has no meaning under the law.

#### How is a product's intended use established?

Intended use may be established in a number of ways. Among them are:

- **Claims stated on the product labeling, in advertising, on the Internet, or in other promotional materials.** Certain claims may cause a product to be considered a drug, even if the product is marketed as if it were a cosmetic. Such claims establish the product as a drug because the intended use is to treat or prevent disease or otherwise affect the structure or functions of the human body. Some examples are claims that products will restore hair growth, reduce cellulite, treat varicose veins, or revitalize cells.
- **Consumer perception, which may be established through the product's reputation.** This means asking why the consumer is buying it and what the consumer expects it to do.
- **Ingredients that may cause a product to be considered a drug because they have a well known (to the public and industry) therapeutic use.** An example is fluoride in toothpaste.

This principle also holds true for essential oils in fragrance products. A fragrance marketed for promoting attractiveness is a cosmetic. But a fragrance marketed with certain "aromatherapy" claims, such as assertions that the scent will help the consumer sleep or quit smoking, meets the definition of a drug because of its intended use.

#### How are the laws and regulations different for cosmetics and drugs?

The following information is not a complete treatment of cosmetic or drug laws and regulations. It is intended only to alert you to some important differences between the laws and regulations for cosmetics and drugs in the areas of approval, good manufacturing practice, registration, and labeling. You should direct questions regarding laws and regulations for drugs to FDA's [Center for Drug Evaluation and Research](#)<sup>3</sup> (CDER).

#### How approval requirements are different

FDA does not have a premarket approval system for cosmetic products or ingredients, with the important exception of [color additives](#)<sup>4</sup>. Drugs, however, are subject to FDA approval. Generally, drugs must either receive premarket approval by FDA or conform to final regulations specifying conditions whereby they are generally recognized as safe and effective, and not misbranded. Currently, certain -- but not all -- over-the-counter (OTC) drugs (that is, non-prescription drugs) that were marketed before the beginning of the OTC Drug Review (May 11, 1972) may be marketed without specific approval pending publication of final regulations under the ongoing OTC Drug Review. Once

a regulation covering a specific class of OTC drugs is final, those drugs must either -

- Be the subject of an approved **New Drug Application (NDA)** [FD&C Act, sec. 505(a) and (b)], or
- Comply with the appropriate **monograph**, or rule, for an OTC drug.

#### What do these terms mean?

- An **NDA** is the vehicle through which drug sponsors formally propose that FDA approve a new pharmaceutical for sale and marketing in the U.S. FDA only approves an NDA after determining, for example, that the data are adequate to show the drug's safety and effectiveness for its proposed use and that its benefits outweigh the risks. The NDA system is also used for new ingredients entering the OTC marketplace for the first time. For example, the newer OTC products (previously available only by prescription) are first approved through the NDA system and their 'switch' to OTC status is approved via the NDA system.
- FDA has published **monographs**, or rules, for a number of OTC drug categories. These monographs, which are published in the Federal Register, state requirements for categories of non-prescription drugs, such as what ingredients may be used and for what intended use. Among the many non-prescription drug categories covered by OTC monographs are -
  - acne medications
  - treatments for dandruff, seborrheic dermatitis, and psoriasis
  - sunscreens

**A note on "new drugs":** Despite the word "new," a "new drug" may have been in use for many years. If a product is intended for use as a drug, no matter how ancient or "traditional" its use may be, once the agency has made a final determination on the status of an OTC drug product it must have an approved NDA or comply with the appropriate OTC monograph to be marketed legally in interstate commerce. Certain OTC drugs may remain on the market without NDA approval pending final regulations covering the appropriate class of drugs.

**Where to learn more about NDAs and OTC monographs:** If you have questions about NDAs and OTC monographs, you should address them to [CDER](#)<sup>5</sup>.

#### How good manufacturing practice requirements are different

Good manufacturing practice (GMP) is an important factor in assuring that your cosmetic products are neither adulterated nor misbranded. However, no regulations set forth specific GMP requirements for cosmetics. In contrast, the law requires strict adherence to GMP requirements for drugs, and there are regulations specifying minimum current GMP requirements for drugs [[Title 21 of the Code of Federal Regulations](#)<sup>6</sup> (CFR), parts 210 and 211]. Failure to follow GMP requirements causes a drug to be adulterated [FD&C Act, sec. 501(a)(2)(B)].

#### How registration requirements are different

FDA maintains the [Voluntary Cosmetic Registration Program](#)<sup>7</sup>, or VCRP, for cosmetic establishments and formulations [21 CFR 710 and 720]. As its name indicates, this program is voluntary. In contrast, it is mandatory for drug firms to register their establishments and list their drug products with FDA [FD&C Act, sec. 510; 21 CFR 207].

#### How labeling requirements are different

A cosmetic product must be labeled according to cosmetic labeling regulations. See the Cosmetic Labeling Manual for guidance on cosmetic labeling. OTC drugs must be labeled according to OTC drug regulations, including the "Drug Facts" labeling, as described in 21 CFR 201.63. Combination OTC drug/cosmetic products must have combination OTC drug/cosmetic labeling. For example, the drug ingredients must be listed alphabetically as "Active Ingredients," followed by cosmetic ingredients, listed in order of predominance as "Inactive Ingredients."

#### And what if it's "soap"?

Soap is a category that needs special explanation. That's because the regulatory definition of "soap" is different from the way in which people commonly use the word. Products that meet the definition of "soap" are exempt from the provisions of the FD&C Act because -- even though Section 201(i)(1) of the act includes "articles...for cleansing" in the definition of a cosmetic -- Section 201(i)(2) excludes soap from the definition of a cosmetic.

#### How FDA defines "soap"

Not every product marketed as soap meets FDA's definition of the term. FDA interprets the term "soap" to apply only when --

- The bulk of the nonvolatile matter in the product consists of an alkali salt of fatty acids and the product's detergent properties are due to the alkali-fatty acid compounds, and
- The product is labeled, sold, and represented solely as soap [21 CFR 701.20].

#### If a cleanser does not meet all of these criteria...

If a product intended to cleanse the human body does not meet all the criteria for soap, as listed above, it is either a cosmetic or a drug. For example:

If a product --

- consists of detergents or
- primarily of alkali salts of fatty acids and
- is intended not only for cleansing but also for other cosmetic uses, such as beautifying or moisturizing,

it is regulated as a cosmetic.

If a product --

- consists of detergents or
- primarily of alkali salts of fatty acids and
- is intended not only for cleansing but also to cure, treat, or prevent disease or to affect the structure or any function of the human body,

it is regulated as a drug.

If a product --

- is intended solely for cleansing the human body and
- has the characteristics consumers generally associate with soap,
- does not consist primarily of alkali salts of fatty acids,

it may be identified in labeling as soap, but it is regulated as a cosmetic.

---

**Links on this page:**

1. <http://www.fda.gov/RegulatoryInformation/Legislation/FederalFoodDrugandCosmeticActFDCA/default.htm>
2. <http://www.fda.gov/Cosmetics/ProductandIngredientSafety/ProductInformation/ucm127064.htm>
3. <http://www.fda.gov/Drugs/default.htm>
4. <http://www.fda.gov/ForIndustry/ColorAdditives/default.htm>
5. <http://www.fda.gov/Drugs/default.htm>
6. [http://ecfr.gpoaccess.gov/cgi/t/text/text-idx?sid=eaffaa6a0a59218b8a1262809111389&c=ecfr&tpl=/ecfrbrowse/Title21/21tab\\_02.tpl](http://ecfr.gpoaccess.gov/cgi/t/text/text-idx?sid=eaffaa6a0a59218b8a1262809111389&c=ecfr&tpl=/ecfrbrowse/Title21/21tab_02.tpl)
7. <http://www.fda.gov/Cosmetics/GuidanceComplianceRegulatoryInformation/VoluntaryCosmeticsRegistrationProgramVCRP/default.htm>

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

ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.

Plaintiffs/Opposers

v.

ANASTASIA MARIE LABORATORIES, INC.

Defendant/Applicant

Opposition No.

91188736

I, John May, declare as follows:

1. I am an active member of the California Bar and counsel for Opposers in this matter.
2. On March 7 of this year, I logged onto the Anastasia.net website and navigated from the home screen to the products page to the brows page and then to the after tweeze cream page.
3. The attached Exhibit JMM-1 is printout of what I found on that page. Page 2 of that exhibit is an enlarged view of a portion of page 1, showing the texts that are revealed under the Description, Beauty Tips, and Ingredients tabs. I note that the Description tab includes the phrase "as it moisturizes the skin" and that the Beauty Tips mentions "any other area on the face where redness occurs".
4. I showed this page to my client's trademark administrator, and she confirmed that this particular page has not changed at any time during 2009 or 2010.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

This Declaration is being executed at Los Angeles, California on March 31, 2010.

/JMM/  
John May

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**ANASTASIA**  
*Beverly Hills*

**PRODUCT CATEGORIES**

- > ALL PRODUCTS
- > Brows
- > Eyes
- > Face
- > Skincare
- > Brushes
- > Tools
- > Kits
- > Giveaways



[Products](#) :: [Brows](#) :: After Tweeze Cream



### After Tweeze Cream

Style: ABH01-08002  
Price: \$20.00  
Save 0%

Description	Beauty Tips	Ingredients
Soothe and refresh your skin after tweezing as never before with Anastasia's exclusive formula. This formulation is wrapped in restorative chamomile extracts as it moisturizes the skin and the subtle green tint naturally masks redness.		
<p><b>BROW KNOW-HOW:</b> Apply this soothing cream to the entire brow area after tweezing, as well as to any other area on the face where redness occurs.</p>		
<p>NET WT. 19.85 g / 0.7 Oz. WATER/EAU/AQUA, PROPYLENE GLYCOL, C12-15 ALKYL BENZOATE, CETYL ALCOHOL, GLYCERYL STEARATE, TITANIUM DIOXIDE (CI 77891), ROSA CANINA FRUIT OIL, ISOPROPYL MYRISTATE, STEARIC ACID, GLYCERIN, TOCOPHERYL LINOLEATE, CARBOMER, POLYAMINO SUGAR CONDENSATE, LECITHIN, HONEY/MIEL/MEL, CHOLESTEROL, CHAMOMILLA RECUTITA (MATRICARIA) EXTRACT, ESCULIN, UREA, TRIETHANOLAMINE, TRISODIUM EDTA, PHENOXYETHANOL, METHYLPARABEN, PROPYLPARABEN, BUTYLPARABEN, ISOBUTYLPARABEN, ETHYLPARABEN, IRON OXIDES (CI 77492), CHROMIUM HYDROXIDE GREEN (CI 77289) &lt;8912&gt;</p>		

■ ADD TO WISHLIST ■ TELL A FRIEND

**Product Options**

Quantity:

[Add to Makeup Bag](#)

**Tell a Friend**

Your Name:

Your E-Mail Address:

Friend's E-Mail Address:

[Send to Friend](#)

**Product Recommendations**

Customers who bought this product also bought the following products:

- [Angled Cut Brush Small #15](#)
- [Mini Wax Kit](#)
- [Go Brow](#)

**Customer Ratings**

Current Average Rating: ★★★★★

Your Rating:

[Rate It!](#)

**Customer Reviews**

There have been no reviews for this product. Be the first to review this product by using the form below!

ABOUT ANASTASIA
SITEMAP
ANASTASIA SOARE
PRIVACY POLICY
TERMS AND CONDITIONS

**THE DEFINITIVE BROW EXPERT™**

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Ex JMM-1 p2

## After Tweeze Cream

Style: ABH01-08002

Price: \$20.00

Save 0%

Description	Beauty Tips	Ingredients	
-------------	-------------	-------------	--

Soothe and refresh your skin after tweezing as never before with Anastasia's exclusive formula. This formulation is wrapped in restorative chamomile extracts as it moisturizes the skin and the subtle green tint naturally masks redness.

### **BROW KNOW-HOW:**

Apply this soothing cream to the entire brow area after tweezing, as well as to any other area on the face where redness occurs.

NET WT. 19.85 g / 0.7 Oz.

WATER/EAU/AQUA, PROPYLENE GLYCOL, C12-15 ALKYL BENZOATE, CETYL ALCOHOL, GLYCERYL STEARATE, TITANIUM DIOXIDE (CI 77891), ROSA CANINA FRUIT OIL, ISOPROPYL MYRISTATE, STEARIC ACID, GLYCERIN, TOCOPHERYL LINOLEATE, CARBOMER, POLYAMINO SUGAR CONDENSATE, LECITHIN, HONEY/MIEL/MEL, CHOLESTEROL, CHAMOMILLA RECUTITA (MATRICARIA) EXTRACT, ESCULIN, UREA, TRIETHANOLAMINE, TRISODIUM EDTA, PHENOXYETHANOL, METHYLPARABEN, PROPYLPARABEN, BUTYLPARABEN, ISOBUTYLPARABEN, ETHYLPARABEN, IRON OXIDES (CI 77492), CHROMIUM HYDROXIDE GREEN (CI 77289) <8912>

# Trademark/Service Mark Application, Principal Register

## TEAS Plus Application

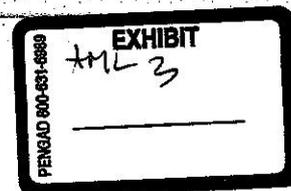
Serial Number: 77150306

Filing Date: 04/06/2007

*NOTE: Data fields with the \* are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
<b>MARK INFORMATION</b>	
*MARK	<u>ANASTASIA</u>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ANASTASIA
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	ANASTASIA MARIE LABORATORIES, INC.
*STREET	6520 North Western Avenue Suite 103
*CITY	Oklahoma City
*STATE (Required for U.S. applicants)	Oklahoma
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	73116
PHONE	(310) 829-2805
FAX	(310) 829-9018



EMAIL ADDRESS	daphneb@earthlink.net
AUTHORIZED TO COMMUNICATE VIA EMAIL	No
<b>LEGAL ENTITY INFORMATION</b>	
* TYPE	CORPORATION
* STATE/COUNTRY OF INCORPORATION	Oklahoma
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
* INTERNATIONAL CLASS	003
* FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
* FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
* DESCRIPTION	Body cream
* FILING BASIS	SECTION 1(a)
* FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
* FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
SPECIMEN FILE NAME(S)	\\TICRS2\EXPORT12\771\503 77150306.xml\FTK0003.JPG
SPECIMEN DESCRIPTION	A carton bearing the mark containing the product
* DESCRIPTION	Body lotion
* FILING BASIS	SECTION 1(a)
* FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
* FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
SPECIMEN FILE NAME(S)	\\TICRS2\EXPORT12\771\503 77150306.xml\FTK0003.JPG
SPECIMEN DESCRIPTION	A carton bearing the mark containing the product
* DESCRIPTION	Hand cream
* FILING BASIS	SECTION 1(a)
* FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
* FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
SPECIMEN FILE NAME(S)	\\TICRS2\EXPORT12\771\503 77150306.xml\FTK0003.JPG

SPECIMEN DESCRIPTION	A carton bearing the mark containing the product
*DESCRIPTION	Hand lotions
*FILING BASIS	SECTION 1(a)
*FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
*FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
SPECIMEN FILE NAME(S)	<u>\\TICRS2\EXPORT12\771\503</u> <u>77150306.xml\FTK0003.JPG</u>
SPECIMEN DESCRIPTION	A carton bearing the mark containing the product
*DESCRIPTION	Skin cleansing lotion
*FILING BASIS	SECTION 1(a)
*FIRST USE ANYWHERE DATE	At least as early as 05/23/2000
*FIRST USE IN COMMERCE DATE	At least as early as 05/23/2000
SPECIMEN FILE NAME(S)	<u>\\TICRS2\EXPORT12\771\503</u> <u>77150306.xml\FTK0003.JPG</u>
SPECIMEN DESCRIPTION	A carton bearing the mark containing the product
<b>ADDITIONAL STATEMENTS INFORMATION</b>	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	The applicant claims ownership of U.S. Registration Number(s) 1992623, 3117475, and 1631250.
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
SECTION 2(f)	The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.
<b>ATTORNEY INFORMATION</b>	
NAME	Daphne Sheridan Bass
ATTORNEY DOCKET NUMBER	Daphne Sheridan Bass

FIRM NAME	Law Offices of Daphne Sheridan Bass
STREET	921 26th Street
CITY	Santa Monica
STATE	California
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>CORRESPONDENCE INFORMATION</b>	
*NAME	Daphne Sheridan Bass
FIRM NAME	Law Offices of Daphne Sheridan Bass
*STREET	921 26th Street
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FAX	(310) 829-9018
*EMAIL ADDRESS	daphneb@earthlink.net
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	1
FEE PER CLASS	275
TOTAL FEE DUE	275
<b>SIGNATURE INFORMATION</b>	

* SIGNATURE	/daphne sheridan bass/
* SIGNATORY'S NAME	Daphne Sheridan Bass
SIGNATORY'S POSITION	Attorney to Applicant
* DATE SIGNED	04/05/2007
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Fri Apr 06 02:39:05 EDT 2007
TEAS STAMP	USPTO/FTK-71.116.135.54-2 0070406023905078968-77150 306-3704579cb6dd603522323 6f2de97c5f79b-CC-1157-200 70406022451269456

PTO Form 1476 (Rev 9/2006)  
OMB No. 0651-0003 (Exp 09/30/2008)

## Trademark/Service Mark Application, Principal Register

### TEAS Plus Application

Serial Number: 77150306

Filing Date: 04/06/2007

To the Commissioner for Trademarks:

MARK: ANASTASIA (Standard Characters, see mark)

The literal element of the mark consists of ANASTASIA. The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, ANASTASIA MARIE LABORATORIES, INC., a corporation of Oklahoma, having an address of 6520 North Western Avenue Suite 103, Oklahoma City, Oklahoma, United States, 73116, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

**For specific filing basis information for each item, you must view the display within the Input Table.**

International Class 003: Body cream; Body lotion; Hand cream; Hand lotions; Skin cleansing lotion

If the applicant is filing under Section 1(b), intent to use, the applicant declares that it has a bona fide

intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(b), as amended.

If the applicant is filing under Section 1(a), actual use in commerce, the applicant declares that it is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

If the applicant is filing under Section 44(d), priority based on foreign application, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on a specified foreign application(s). 15 U.S.C. Section 1126(d), as amended.

If the applicant is filing under Section 44(e), foreign registration, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and submits a copy of the supporting foreign registration(s), and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The applicant claims ownership of U.S. Registration Number(s) 1992623, 3117475, and 1631250.

The applicant hereby appoints Daphne Sheridan Bass of Law Offices of Daphne Sheridan Bass, 921 26th Street, Santa Monica, California, United States, 90403 to submit this application on behalf of the applicant. The attorney docket/reference number is Daphne Sheridan Bass.

Correspondence Information: Daphne Sheridan Bass  
921 26th Street  
Santa Monica, California 90403  
(310) 829-2805(phone)  
(310) 829-9018(fax)  
daphneb@earthlink.net (authorized)

A fee payment in the amount of \$275 will be submitted with the application, representing payment for 1 class(es).

#### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion,

or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /daphne sheridan bass/ Date: 04/05/2007

Signatory's Name: Daphne Sheridan Bass

Signatory's Position: Attorney to Applicant

RAM Sale Number: 1157

RAM Accounting Date: 04/06/2007

Serial Number: 77150306

Internet Transmission Date: Fri Apr 06 02:39:05 EDT 2007

TEAS Stamp: USPTO/FTK-71.116.135.54-2007040602390507

8968-77150306-3704579cb6dd6035223236f2de

97c5f79b-CC-1157-20070406022451269456

ANASTASIA

PRU  
#1

XXII/T01120US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: A ANASTASIA MARIE plus design

Registration No.: 1,631,250

COMBINED DECLARATION OF USE IN COMMERCE  
AND APPLICATION FOR RENEWAL UNDER §§ 8 & 9

To the Assistant Commissioner for Trademarks

ANASTASIA MARIE LABORATORIES, INC.  
(a Oklahoma corporation)  
6520 NORTH WESTERN AVENUE  
SUITE 103  
OKLAHOMA CITY, OKLAHOMA 73116

07-31-2000  
U.S. Patent & TMO/TM Mail Rpt Dt. #10

The above-identified owner is using the mark shown in the above-identified registration in commerce on or in connection with *all* of the goods identified in the existing registration.

The owner is using the mark in interstate commerce on or in connection with the goods identified above as evidenced by the attached specimen showing the mark as currently used in commerce.

The registrant requests that the registration be renewed for the goods identified above.

POWER OF ATTORNEY

Registrant hereby appoints Marvin Petry, Thomas P. Sarro, Ross F. Hunt, Jr., Linda R. Poteate and Kevin R. Klein, each a member of the Bar of the State of Virginia, Douglas E. Jackson and William E. Jackson, each a member of the Bar of the District of Columbia, Brewster Taylor, a member of the Bar of the State of Massachusetts and B. Aaron Schulman, a member of the Bar of the State of Maryland, of the firm of Larson & Taylor, PLC, with offices at 1199 North Fairfax Street, Suite 900, Alexandria, Virginia 22314, its attorneys to prosecute this

08/04/2000 LNICKELS 00000142 1631250

01 FC:365 400.00 OP  
02 FC:372 100.00 OP

EXHIBIT  
Lef's JMC  
10 Dup  
Suz 10/31/09

application for renewal and to transact all business in the Patent and Trademark Office in connection with the registration.

**DECLARATION**

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that she is properly authorized to execute this document on behalf of the owner and that all statements made of her own knowledge are true; and that all statements made on information and belief are believed to be true.

**ANASTASIA MARIE LABORATORIES, INC.**

7/24/2000  
(Date)

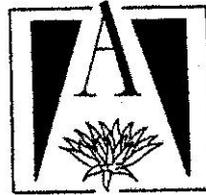
Anastasia Marie  
*Anastasia Marie, President*

Int. Cl.: 3

Prior U.S. Cl.: 51

**United States Patent and Trademark Office** **Reg. No. 1,631,250**  
Registered Jan. 15, 1991

**TRADEMARK  
PRINCIPAL REGISTER**



**ANASTASIA  
MARIE**

ANASTASIA MARIE, INC. (OKLAHOMA COR-  
PORATION)  
SUITE 103  
DOWNING PLACE, 6520 N. WESTERN  
AVENUE  
OKLAHOMA CITY, OK 73116

FOR: SKIN CREAM, BATH & BODY OIL,  
SHAVING GEL, IN CLASS 3 (U.S. CL. 51).

FIRST USE 12-14-1989; IN COMMERCE  
12-27-1989.

THE NAME "ANASTASIA MARIE" IN THE  
MARK DOES IDENTIFY A PARTICULAR  
LIVING INDIVIDUAL.

SER. NO. 74-024,948, FILED 2-2-1990.

MICHAEL A. SZOKE, EXAMINING ATTOR-  
NEY

THERAPEUTIC  
DIAPEDIC® FOOT  
CREAM



DIABETIC  
PURE SKIN THERAPY®

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

ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.

Plaintiffs/Opposers

Opposition No.

v.

91188736

ANASTASIA MARIE LABORATORIES, INC.

Defendant/Applicant

Declaration of Darrell Baum

I, Darrell Baum, declare as follows:

1. I am currently a sales and marketing consultant, specializing in the marketing and brand management of cosmetics and skin care products. I have a MBA and more than 20 years experience in marketing, developing new brands, managing brands, retail sales and account management.
2. I was hired by Anastasia Soare ("AS"), the president of what was then known as A.A.S. Cosmetics, Inc. ("AAS") and is now known as Anastasia Beverly Hills, Inc. ("ABH") in August 1999 to manage product development and marketing of a new line of cosmetics and skin care products then under development by AS with the assistance of the New York office of AAS, which AS intended to market under the newly adopted "Anastasia Beverly Hills" brand.
3. I left AAS/ABH at the end of 2000 to become Brand Manager at Sebastian Hair Care.
4. While I was at AAS/ABH, I was based in Beverly Hills, California and worked under the direct supervision of AS. During that time, we took over responsibility for certain production and distribution activities (including contract manufacturing, warehousing and distribution) which previously had been handled by the New York office of AAS.

5. I had two assistants, one primarily involved with product development, the other with advertising and promotion. I was primarily responsible for marketing and sales. One of our responsibilities was to ensure that the products and all related promotional materials were properly labeled and included appropriate descriptions/instructions.

6. Exhibit DB-1 is a copy of some of my notes from the 1999-2000 time period which I kept in the normal course of business, which included proposed text for instructions and descriptions for various products including a skin care product having the generic name "After Tweeze Cream"

7. Exhibit DB-2 is a copy of a shipping document maintained in the normal course of business reflecting an interstate shipment on March 16, 2000 of After Tweeze Cream from our manufacturing contractor in New York (who would have already loaded the bulk cream into individual plastic tubes preprinted with the Anastasia Beverly Hills name and logo (similar to that of the Pre Tweeze Gel shown in Exhibit DB-3) to our distribution contractor in New Jersey (who would assemble the individual products into kits and/or other containers and ship the finished goods to our customers).

8. Exhibit DB-4 is a copy of the first 5 pages of a paid invoice maintained in the normal course of business reflecting an interstate shipment on August 21, 2000 of After Tweeze Cream and other finished goods from our distribution contractor in New Jersey to a Nordstrom distribution center in Iowa.

9. Exhibit DB-5 is a copy of an article from WWD dated April 14, 2000 which documents the fact that we were selling at least some products from our newly launched Anastasia Beverly Hills line in Beverly Hills California in late March 2000. At that time, AS had already hired a full time makeup consultant to demonstrate the Anastasia Beverly Hills branded cosmetics products to the clients of her Beverly Hills salon, and had provided that make up consultant with a dedicated space in the salon with a product display case and a makeup chair.

10. Based on my present recollection of our product marketing activities at AAS/ABH in the 1999-2000 as refreshed by the above mentioned exhibits, I am now quite certain that Anastasia Beverly Hills branded cosmetics and skin care products including the After Tweeze

Cream were being shipped in intrastate commerce and were being sold in California at least as early as March 2000.

11. As best I can recall, the daily sales revenue from those Anastasia Beverly Hills branded products in the salon following the product line launch in March 2000 met or exceeded our expectations and was seldom less than \$1000 and frequently exceeded \$2000. I would expect a substantial portion of those sales were to out of state tourists who were aware of Anastasia's reputation as an expert on eyebrows, and who were visiting the salon for the first time.

12. I understand that this declaration will be filed with the Trademark Trial and Appeal Board of the US Patent and Trademark Office in connection with an ongoing trademark dispute between ABH and Anastasia Marie Laboratories, Inc. ("AML"). I currently have no financial interest in either ABH or AML, but I continue to do consulting work for ABH.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

This Declaration is being executed in West Hollywood, California on March 31, 2010.

\_\_//Darrell Baum//\_\_\_\_\_

Darrell Baum

This lightweight gel formulated with aloe vera, chamomile and peppermint oil calms and cools the brow area minimizing discomfort associated with tweezing.

Directions: Gently pat a small amount on to the area of the brow to be tweezed. Allow thirty seconds before tweezing. Reapply as necessary.

Active Ingredients: Benzocaine 2%

Caution: For external use only. Avoid direct contact with eyes and immediate eye area. If contact occurs rinse eyes with water. Discontinue use of product if irritation occurs. If irritation persists consult a doctor. Not intended for use on children.

Pre-tweeze

After tweezing this luxurious cream formulated with chamomile, vitamin C and vitamin E helps to calm, soothe and refresh the skin. Our exclusive anti-redness formula can be used on the brow area or any other area of the face where redness may occur.

Caution: For external use only. Avoid direct contact with eyes and immediate eye area. If contact occurs rinse eyes with water. Discontinue use of product if irritation occurs. If irritation persists consult a doctor. Not intended for use on children.

After Tweez

KOLMAR LABORATORIES, INC.  
11 King Street  
P.O. Box 1111  
Port Jervis, NY 12771-0154

S H I P P E R

Page: 1 ✓  
Shipper ID: 0050297  
Print Date: 03/14/00  
Ship Date: 3/16/00

Sold To: 6412  
ANASTASIA  
SKIN & BODY CARE SALON  
ATTN: ACCOUNTS PAYABLE  
438 N. BEDFORD DRIVE  
BEVERLY HILLS, CA 90210

Ship To: 6412A  
ADS INC.  
105-107 STONEHURST COURT  
NORTHVALE, NJ 07647

Ship Via:  
FOB Point: PORT JERVIS, N.Y.

Mode of Transport:  
Carrier Shipment Ref: 0050297  
Vehicle ID:

=====  
Purchase Order: KOL-1501  
Order: 26573  
Order Line: 3

Item: 1501  
ATER TWEEZE CREAM .7oz.  
BROW KIT

Lot/Serial	Ref	Batch Code	Day Code	Qty To Ship	Cont / QtyPer
1925038	1086318	J1	0073D	5,000. EA	10 @ 500.0
Order Line Total:				5,000.	10
Shipper Total:					10



Ex DB-3

ANASTASIA BEVERLY HILLS, INC.

11933 Wilshire Blvd  
Los Angeles, CA 90025

**Invoice**

Date	Invoice #
8/21/2000	82

<p><b>Bill To</b></p> <p>Nordstrom Accounts Payable Vendor #1235613 PO Box 870 Seattle, WA 98111</p>	<p><b>Ship To</b></p> <p>Nordstrom DC #299 Michigan Ave #299 5050 Chavanelle Road Dubuque, IA 52002</p>
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**PAID**

P.O. Number	Terms	Rep	Ship	Via	F.O.B.	Project
CS450548	Net 30 Days		8/21/2000			
Quantity	Item Code	Description			Price Each	Amount
21	0120-075	Brow Powder-Perfect Ash Blonde			25.00	525.00
21	0120-076	Brow Powder-Perfect Medium Ash			25.00	525.00
15	0120-077	Brow Powder-Golden Blonde			25.00	375.00
16	0120-078	Brow Powder-Perfect Brunette			25.00	400.00
9	0120-079	Brow Powder-Perfect Strawburn			25.00	225.00
9	0130-080	Brow Pomade-Strawburn			25.00	225.00
18	0130-081	Brow Pomade-Golden Blonde			25.00	450.00
21	0130-082	Brow Pomade-Ash Blonde			25.00	525.00
21	0130-083	Brow Pomade-Medium Ash			25.00	525.00
21	0130-084	Brow Pomade-Ultimate Brown			25.00	525.00
15	0130-085	Brow Pomade-Brunette			25.00	375.00
6	0130-086	Brow Pomade-Natural Black			25.00	150.00
21	0140-000	Pre Tweeze Gel			25.00	525.00
45	0150-000	After Tweeze Cream			35.00	1,575.00
141	0170-000	Brow Gel			20.00	2,820.00
15	0220-080	Brow Pencil-Strawburn			19.00	285.00
24	0220-081	Brow Pencil-Golden Blonde			19.00	456.00
36	0220-082	Brow Pencil-Ash Blonde			19.00	684.00
72	0220-083	Brow Pencil-Medium Ash			19.00	1,368.00
72	0220-084	Brow Pencil-Ultimate Brown			19.00	1,368.00
39	0220-085	Brow Pencil-Brunette			19.00	741.00
3	0250-080	Brow Kit-Strawburn			195.00	585.00
6	0250-081	Ultimate Brow Kit-Golden Blonde			195.00	1,170.00
6	0250-082	Ultimate Brow Kit-Ash Blonde			195.00	1,170.00
12	0250-083	Ultimate Brow Kit-Medium Ash			195.00	2,340.00
9	0250-085	Ultimate Brow Kit-Brunette			195.00	1,755.00
150	0260-000	Tweezer			28.00	4,200.00
18	0010-001	Lipstick-Venus			20.00	360.00
9	0010-002	Lipstick-Elektra			20.00	180.00
6	0010-003	Lipstick-Billie			20.00	120.00
15	0010-004	Lipstick-Juliet			20.00	300.00
12	0010-005	Lipstick-Callas			20.00	240.00
9	0010-006	Lipstick-Desdemona			20.00	180.00
					<b>Total</b>	

ANASTASIA BEVERLY HILLS, INC.

# Invoice

11933 Wilshire Blvd  
Los Angeles, CA 90025

Date	Invoice #
8/21/2000	82

<p><b>Bill To</b></p> <p>Nordstrom Accounts Payable Vendor #1235613 PO Box 870 Seattle, WA 98111</p>	<p><b>Ship To</b></p> <p>Nordstrom DC #299 Michigan Ave #299 5050 Chavanelle Road Dubuque, IA 52002</p>
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**PAID**

P.O. Number	Terms	Rep	Ship	Via	F.O.B.	Project
CS450548	Net 30 Days		8/21/2000			

Quantity	Item Code	Description	Price Each	Amount
12	0010-007	Lipstick-Opera	20.00	240.00
12	0010-008	Lipstick-Diva	20.00	240.00
9	0010-009	Lipstick-Ella	20.00	180.00
12	0010-010	Lipstick-Diana	20.00	240.00
12	0010-011	Lipstick-Piaf	20.00	240.00
12	0010-012	Lipstick-Carmen	20.00	240.00
12	0010-013	Lipstick-Morganne	20.00	240.00
9	0010-014	Lipstick-Eva	20.00	180.00
21	0010-015	Lipstick-Despina	20.00	420.00
30	0010-016	Lipstick-Mirage	20.00	600.00
30	0010-017	Lipstick-Turandot	20.00	600.00
18	0010-018	Lipstick-Amor	20.00	360.00
12	0010-019	Lipstick-Norvina	20.00	240.00
30	0010-020	Lipstick-Cio Cio San	20.00	600.00
30	0010-021	Lipstick-Musetta	20.00	600.00
18	0010-022	Lipstick-Rosalinde	20.00	360.00
12	0010-023	Lipstick-Cornelia	20.00	240.00
12	0010-024	Lipstick-Pandora	20.00	240.00
12	0010-025	Lipstick-Elizabeth	20.00	240.00
30	0010-026	Lipstick-Seville	20.00	600.00
12	0010-027	Lipstick-Empress	20.00	240.00
12	0010-028	Lipstick-Mimi	20.00	240.00
9	0010-029	Lipstick-Victoria	20.00	180.00
24	0010-030	Lipstick-Bassey	20.00	480.00
18	0020-031	Lipgloss-Garcelle	25.00	450.00
36	0020-032	Lipgloss-Audrey	25.00	900.00
27	0020-033	Lipgloss-Hope	25.00	675.00
36	0020-034	Lipgloss-Karynne	25.00	900.00
24	0020-035	Lipgloss-Amy	25.00	600.00
21	0020-036	Lipgloss-Yoko	25.00	525.00
15	0030-000	Lipsheer	25.00	375.00
18	0240-115	Lip Liner-Chinese Red	19.00	342.00
30	0240-116	Lip Liner-Natural	19.00	570.00
			<b>Total</b>	

ANASTASIA BEVERLY HILLS, INC.

# Invoice

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8/21/2000	82

<p><b>Bill To</b></p> <p>Nordstrom Accounts Payable Vendor #1235613 PO Box 870 Seattle, WA 98111</p>	<p><b>Ship To</b></p> <p>Nordstrom DC #299 Michigan Ave #299 5050 Chavanelle Road Dubuque, IA 52002</p>
--	---

**PAID**

P.O. Number	Terms	Rep	Ship	Via	F.O.B.	Project
CS450548	Net 30 Days		8/21/2000			
Quantity	Item Code	Description			Price Each	Amount
48	0240-117	Lip Liner-Dusty Rose			19.00	912.00
21	0240-118	Lip Liner-Maple			19.00	399.00
30	0240-119	Lip Liner-Primrose			19.00	570.00
6	0240-120	Lip Liner-Scarlet			19.00	114.00
		Lip Liner-Scarlet				
18	0240-121	Lip Liner-Burnt Sienna			19.00	342.00
18	0240-122	Lip Liner-Brick			19.00	342.00
18	0240-123	Lip Liner-Raisin Brown			19.00	342.00
36	0240-124	Lip Liner-Charred Plum			19.00	684.00
15	0110-057	Eyeshadow-Patina			20.00	300.00
21	0110-058	Eyeshadow-Aubergine			20.00	420.00
12	0110-059	Eyeshadow-Grenadine			20.00	240.00
21	0110-060	Eyeshadow-Truffle			20.00	420.00
6	0110-061	Eyeshadow-Latte			20.00	120.00
12	0110-062	Eyeshadow-Straw			20.00	240.00
12	0110-063	Eyeshadow-Midnight			20.00	240.00
6	0110-064	Eyeshadow-Havana			20.00	120.00
21	0110-065	Eyeshadow-Petal			20.00	420.00
18	0110-066	Eyeshadow-2001			20.00	360.00
9	0110-067	Eyeshadow-Dove			20.00	180.00
24	0110-068	Eyeshadow-Chamois			20.00	480.00
9	0110-069	Eyeshadow-Bambi			20.00	180.00
21	0110-070	Eyeshadow-Illumination			20.00	420.00
6	0110-071	Eyeshadow-Caviar			20.00	120.00
18	0110-072	Eyeshadow-Pixie			20.00	360.00
					<b>Total</b>	

ANASTASIA BEVERLY HILLS, INC.

11933 Wilshire Blvd  
Los Angeles, CA 90025

# Invoice

Date	Invoice #
8/21/2000	82

Bill To
Nordstrom Accounts Payable Vendor #1235613 PO Box 870 Seattle, WA 98111

**PAID**

Ship To
Nordstrom DC #299 Michigan Ave #299 5050 Chavanelle Road Dubuque, IA 52002

P.O. Number	Terms	Rep	Ship	Via	F.O.B.	Project
CS450548	Net 30 Days		8/21/2000			
Quantity	Item Code	Description			Price Each	Amount
12	0110-073	Eyeshadow-Mahogany			20.00	240.00
15	0110-074	Eyeshadow-Haze			20.00	300.00
108	0160-087	Mascara-Night Black			20.00	2,160.00
81	0160-088	Mascara-Night Amethyst			20.00	1,620.00
18	0180-089	E/s Trio Shadow-La Boheme			42.00	756.00
18	0180-090	E/s Trio shadow-Faust			42.00	756.00
30	0180-091	E/s Trio shadow-Turandot			42.00	1,260.00
18	0180-092	E/s Trio shadow-Nabuco			42.00	756.00
15	0180-093	E/s Trio shadow-Tosca			42.00	630.00
27	0180-094	E/s Trio shadow-Otello			42.00	1,134.00
18	0190-095	E/I Matte J Pencil-Matte Hallo			21.00	378.00
24	0190-096	E/I Matte J Pencil-Matte Buff			21.00	504.00
42	0190-097	E/I Matte J Pencil-Matte Camille			21.00	882.00
33	0190-098	E/I Matte J Pencil-Matte Apricot			21.00	693.00
27	0190-099	E/I Matte J Pencil-Matte Shell			21.00	567.00
18	0190-100	E/I Matte J Pencil-Matte Pastel			21.00	378.00
33	0210-101	E/I Frost J Pencil-Chiffon Shimmer			21.00	693.00
48	0210-102	E/I Frost J Pencil-Damask Shimmer			21.00	1,008.00
36	0210-103	E/I Frost J Pencil-Rose Shimmer			21.00	756.00
24	0210-104	E/I Frost J Pencil-Petal Shimmer			21.00	504.00
48	0210-105	E/I Frost J Pencil-Lace Shimmer			21.00	1,008.00
48	0210-106	E/I Frost J Pencil-Sand Shimmer			21.00	1,008.00
15	0230-107	Eye Liner-Silver Coal			19.00	285.00
18	0230-108	Eye Liner-Amethyst Glow			19.00	342.00
9	0230-109	Eye Liner-Midnight Glow			19.00	171.00
15	0230-110	Eye Liner-Taupe			19.00	285.00
18	0230-111	Eye Liner-Deep Black			19.00	342.00
18	0230-112	Eye Liner-Dark Brown			19.00	342.00
18	0230-113	Eye Liner-Seal Brown			19.00	342.00
9	0230-114	Eye Liner-Forest Glow			19.00	171.00
15	0040-037	Oil Free Makeup-Clair			42.50	637.50
21	0040-038	Oil Free Makeup - Porc Beige			42.50	892.50
27	0040-039	Oil Free Makeup - Delicate Beige			42.50	1,147.50
					<b>Total</b>	

ANASTASIA BEVERLY HILLS, INC.

11933 Wilshire Blvd  
Los Angeles, CA 90025

# Invoice

Date	Invoice #
8/21/2000	82

<b>Bill To</b>
Nordstrom Accounts Payable Vendor #1235613 PO Box 870 Seattle, WA 98111

**PAID**

<b>Ship To</b>
Nordstrom DC #299 Michigan Ave #299 5050 Chavanelle Road Dubuque, IA 52002

P.O. Number	Terms	Rep	Ship	Via	F.O.B.	Project
CS450548	Net 30 Days		8/21/2000			
Quantity	Item Code	Description			Price Each	Amount
33	0040-040	Oil Free Makeup - Beige Cameo			42.50	1,402.50
18	0040-041	Oil Free Makeup - Classic Beige			42.50	765.00
9	0040-042	Oil Free Makeup - Warm Beige			42.50	382.50
9	0040-043	Oil Free Makeup - Bronze Beige			42.50	382.50
6	0040-044	Oil Free Makeup - Intense Beige			42.50	255.00
12	0050-037	Moisturizing Makeup - Clair			42.50	510.00
21	0050-038	Moisturizing Makeup - Porc Beige			42.50	892.50
27	0050-039	Moisturizing Makeup - Del Beige			42.50	1,147.50
30	0050-040	Moisturizing Makeup - Beige Cameo			42.50	1,275.00
15	0050-041	Moisturizing Makeup - Classic Beige			42.50	637.50
9	0050-042	Moisturizing Makeup - Warm Beige			42.50	382.50
9	0050-043	Moisturizing Makeup - Bronze Beige			42.50	382.50
6	0050-044	Moisturizing Makeup - Intense Beige			42.50	255.00
33	0060-045	Concealer - Light			25.00	825.00
48	0060-046	Concealer - Medium			25.00	1,200.00
27	0060-047	Concealer - Deep			25.00	675.00
36	0070-045	Pressed Powder - Light			40.00	1,440.00
48	0070-046	Pressed Powder - Medium			40.00	1,920.00
36	0070-047	Pressed Powder-Deep			40.00	1,440.00
18	0080-045	Loose Powder-Light			40.00	720.00
27	0080-046	Loose Powder-Medium			40.00	1,080.00
18	0080-047	Loose Powder-Deep			40.00	720.00
18	0080-048	Loose Powder-Shimmer			40.00	720.00
30	0090-049	Blush-Bliss			32.50	975.00
27	0090-050	Blush-Angel			32.50	877.50
15	0090-051	Blush-Cocoa			32.50	487.50
24	0090-052	Blush-Scirroco			32.50	780.00
21	0090-053	Blush-Mistral			32.50	682.50
21	0090-054	Blush-Divine			32.50	682.50
21	0090-055	Blush-Biscotti			32.50	682.50
30	0090-056	Blush-Glow			32.50	975.00
100	0310-000	Cosmetic Sharpener			5.00	500.00
					<b>Total</b>	97,950.00

LEIKS SIMONS IMPROVEMENT/2 BUILDING A BUZZ/14

Wor Wear Post ... Daily Newspaper • April 14, 2000 Vol. 179, No. 73 \$1.75

# WINDYFRIDAY

Beauty

## Anastasia: Brows to Blush

**NEW YORK** — Anastasia Soare, eyebrow architect to the stars, has built a booming business on word of mouth alone. Now she's taking the same slow-build approach with her new signature makeup line, Anastasia Beverly Hills.

The collection of 150 stock-keeping units was introduced at Anastasia's Beverly Hills salon in late March, and she says that the response has been phenomenal. "I wanted my client to get the message," said the expert plucker, who established a reputation at Juan Juan in Beverly Hills, then opened her own salon in 1997, where she tends to the brows of celebrities such as Kate Capshaw, Rita Wilson and Cameron Diaz. "I'm offering them beautiful packaging and beautiful quality. These are women who drive for two hours to get their eyebrows done and

they have high expectations." Anastasia is targeting retail sales of \$1 million in 2000 for the collection at her salon.

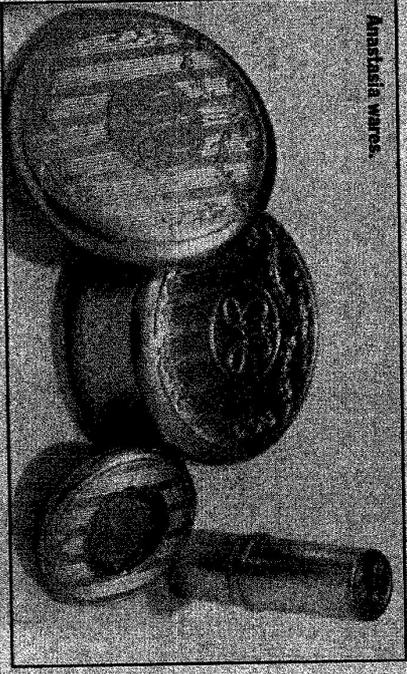
The makeup will be rolled out to a handful of Nordstrom doors starting in June and will debut at Bergdorf Goodman in August. Anastasia is targeting a distribution of about 100 doors by the end of 2001.

Anastasia worked on the packaging with French designer Etienne Lardel, and finally settled on a French antique look with contemporary touches. "I thought we needed to combine the beauty of a vintage look with 21st-century technology," she explained. "After all, this is the year 2000." The compact are faux antique silver and the lids on the eye shadows and brow powder have portals in the middle so that users can see the shades. "My clients say they love to

display the products on their vanity and not hide them in a drawer," continued Anastasia. "You can put everything out."

She also paid particular attention to the formulations, choosing ultrasilky textures and feminine, wearable shades. "The feel of everything is workable, very natural looking shades. You can be 18 or 50, it doesn't matter — you can wear my basic colors."

A full range of products is available, including lipstick, lippliner, eye shadow, eyeliner, mascara, pressed powder, loose powder, concealer, blush, oil-free liquid foundation and moisturizing liquid foundation. In addition, there are numerous eyebrow products such as brow powder, brow pomade, pre-tweeze gel, after-tweeze gel, brow gel and brow pencil. Prices range from \$19 for a li-



Anastasia wires.

pliner to \$47.50 for Moisturizing Liquid Foundation. Lipsticks will retail for \$20.

Anastasia started the company with partners Arnold and Deborah Simon. Arnid, as he is known, is the chairman and chief executive officer of Aris Industries, which markets apparel under names like XOXO. Perry Ellis and Baby Phat. Deborah Simon, a member of the board of directors at Aris, is in charge of overseas sales

for Anastasia. Rather than advertising, Anastasia intends to promote the line herself on TV programs and via word of mouth. "I feel confident that this makeup line will work exactly like my eyebrow business," she said. "I already have clients who came in because their friends said, 'You have to throw out all your makeup and try these products.'"

—AA

# United States Court of Appeals for the Federal Circuit

2008-1448  
(Opposition No. 91/157,315)

IN RE BOSE CORPORATION,

Appellant.

Charles Hieken, Fish & Richardson P.C., of Boston, Massachusetts, argued for appellant. With him on the brief was Amy L. Brosius.

Raymond T. Chen, Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were Thomas V. Shaw and Christina J. Hieber, Associate Solicitors.

Susan J. Hightower, Pirkey Barber LLP, of Austin, Texas, argued for amicus curiae, American Intellectual Property Law Association. With her on the brief was William G. Barber. Of counsel on the brief was James H. Pooley, American Intellectual Property Law Association, of Arlington, Virginia.

Appealed from: United States Patent and Trademark Office  
Trademark Trial and Appeal Board

Exhibit D

# United States Court of Appeals for the Federal Circuit

2008-1448  
(Opposition No. 91/157,315)

IN RE BOSE CORPORATION,

Appellant.

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

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DECIDED: August 31, 2009

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Before MICHEL, Chief Judge, DYK, and MOORE, Circuit Judges.

MICHEL, Chief Judge.

The Trademark Trial and Appeal Board (“Board”) found that Bose Corporation (“Bose”) committed fraud on the United States Patent and Trademark Office (“PTO”) in renewing Registration No. 1,633,789 for the trademark WAVE. Bose Corp. v. Hexawave, Inc., 88 USPQ2d 1332, 1338 (T.T.A.B. 2007). Bose appeals the Board’s order cancelling the registration in its entirety. Because there is no substantial evidence that Bose intended to deceive the PTO in the renewal process, we reverse and remand.

## I. BACKGROUND

Bose initiated an opposition against the HEXAWAVE trademark application by Hexawave, Inc. (“Hexawave”), alleging, inter alia, likelihood of confusion with Bose’s prior registered trademarks, including WAVE. Bose, 88 USPQ2d at 1333. Hexawave

counterclaimed for cancellation of Bose's WAVE mark, asserting that Bose committed fraud in its registration renewal application when it claimed use on all goods in the registration while knowing that it had stopped manufacturing and selling certain goods. Id.

The fraud alleged by Hexawave involves Bose's combined Section 8 affidavit of continued use and Section 9 renewal application ("Section 8/9 renewal"),<sup>1</sup> signed by Bose's general counsel, Mark E. Sullivan, and filed on January 8, 2001. Bose, 88 USPQ2d at 1335. In the renewal, Bose stated that the WAVE mark was still in use in commerce on various goods, including audio tape recorders and players. Id. at 1333. The Board found that (1) Bose stopped manufacturing and selling audio tape recorders and players sometime between 1996 and 1997; and (2) Mr. Sullivan knew that Bose discontinued those products when he signed the Section 8/9 renewal. Id. at 1334-35.

At the time Mr. Sullivan signed the Section 8/9 renewal, Bose continued to repair previously sold audio tape recorders and players, some of which were still under warranty. Bose, 88 USPQ2d at 1335. Mr. Sullivan testified that in his belief, the WAVE mark was used in commerce because "in the process of repairs, the product was being transported back to customers." Id. The Board concluded that the repairing and shipping back did not constitute sufficient use to maintain a trademark registration for goods. Id. at 1337. It further found Mr. Sullivan's belief that transporting repaired goods

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<sup>1</sup> Federal trademark registrations issued on or after November 16, 1989, remain in force for ten years, and may be renewed for ten-year periods. To renew a registration, the owner must file an Application for Renewal under Section 9. In addition, at the end of the sixth year after the date of registration and at the end of each successive ten-year period after the date of registration, the owner must file a Section 8 Declaration of Continued Use, "an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce. . . ." 15 U.S.C. § 1058(b)(1); see also, id. §§ 1058, 1059.

constituted use was not reasonable. Id. at 1338. Finally, the Board found that the use statement in the Section 8/9 renewal was material. Id. As a result, the Board ruled that Bose committed fraud on the PTO in maintaining the WAVE mark registration and ordered the cancellation of Bose's WAVE mark registration in its entirety. Id. Later, the same panel denied Bose's Request for Reconsideration. Bose Corp. v. Hexawave, Inc., Opposition No. 91157315, 2008 WL 1741913 (T.T.A.B. Apr. 9, 2008).

Bose appealed. Because the original appellee Hexawave did not appear, the PTO moved, and the court granted leave to the Director, to participate as the appellee. We have jurisdiction pursuant to 15 U.S.C. § 1071(a) and 28 U.S.C § 1295(a)(4)(B).

## II. DISCUSSION

This court reviews the Board's legal conclusions de novo. In re Int'l Flavors & Fragrances Inc., 183 F.3d 1361, 1365 (Fed. Cir. 1999). We review the Board's factual findings for substantial evidence. Recot, Inc. v. Becton, 214 F.3d 1322, 1327 (Fed. Cir. 2000).

A third party may petition to cancel a registered trademark on the ground that the "registration was obtained fraudulently." 15 U.S.C. § 1064(3). "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." Torres v. Cantine Torresella S.r.l., 808 F.2d 46, 48 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co., 377 F.2d 1001, 1004 (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and,

obviously, any doubt must be resolved against the charging party.” Smith Int’l, Inc. v. Olin Corp., 209 USPQ 1033, 1044 (T.T.A.B. 1981).

The Court of Customs and Patent Appeals (“CCPA”), our predecessor whose decisions are binding on this court, explained that, before the PTO, “[a]ny ‘duty’ owed by an applicant for trademark registration must arise out of the statutory requirements of the Lanham Act,” which prohibit an applicant from making “knowingly inaccurate or knowingly misleading statements.” Bart Schwartz Int’l Textiles, Ltd. v. Fed. Trade Comm’n, 289 F.2d 665, 669 (CCPA 1961). Therefore, the court stated that, absent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation. King Auto., Inc. v. Speedy Muffler King, Inc., 667 F.2d 1008, 1011 n.4 (CCPA 1981).

Mandated by the statute and caselaw, the Board had consistently and correctly acknowledged that there is “a material legal distinction between a ‘false’ representation and a ‘fraudulent’ one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like.” Kemin Indus., Inc. v. Watkins Prods., Inc., 192 USPQ 327, 329 (T.T.A.B. 1976). In other words, deception must be willful to constitute fraud. Smith Int’l, 209 USPQ at 1043; see also Woodstock’s Enters. Inc. (Cal.) v. Woodstock’s Enters. Inc. (Or.), 43 USPQ2d 1440, 1443 (T.T.A.B. 1997); First Int’l Servs. Corp. v. Chuckles, Inc., 5 USPQ2d 1628, 1634 (T.T.A.B. 1988); Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955, 962 (T.T.A.B. 1986).

Several of our sister circuits have also required proof of intent to deceive before cancelling a trademark registration. See, e.g., Far Out Prods., Inc. v. Oskar, 247 F.3d

986, 996 (9th Cir. 2001) (stating that an affidavit was fraudulent only if the affiant acted with scienter); Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 877-78 (8th Cir. 1994) (per curiam) (“In order to show that an applicant defrauded the PTO the party seeking to invalidate a mark must show that the applicant intended to mislead the PTO.”); Meineke Discount Muffler v. Jaynes, 999 F.2d 120, 126 (5th Cir. 1993) (“To succeed on a claim of fraudulent registration, the challenging party must prove by clear and convincing evidence that the applicant made false statements with the intent to deceive [the PTO.]”); San Juan Prods., Inc. v. San Juan Pools of Kan., Inc., 849 F.2d 468, 472 (10th Cir. 1988) (stating that in determining whether a statement is fraudulent, courts must focus on the “declarant’s subjective, honestly held, good faith belief” (internal quotation marks and emphasis omitted)); Money Store v. Harriscorp Fin., Inc., 689 F.2d 666, 670 (7th Cir. 1982) (“Fraud will be deemed to exist only when there is a deliberate attempt to mislead the Patent Office into registering the mark.”).

The Board stated in Medinol v. Neuro Vasx, Inc. that to determine whether a trademark registration was obtained fraudulently, “[t]he appropriate inquiry is . . . not into the registrant’s subjective intent, but rather into the objective manifestations of that intent.” 67 USPQ2d 1205, 1209 (T.T.A.B. 2003). We understand the Board’s emphasis on the “objective manifestations” to mean that “intent must often be inferred from the circumstances and related statement made.” Id. (internal quotation marks omitted) (quoting First Int’l Serv., 5 USPQ2d at 1636). We agree. However, despite the long line of precedents from the Board itself, from this court, and from other circuit courts, the Board went on to hold that “[a] trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it

knows or should know to be false or misleading.” Id. (emphasis added). The Board has since followed this standard in several cancellation proceedings on the basis of fraud, including the one presently on appeal. See Bose, 88 USPQ2d at 1334.

By equating “should have known” of the falsity with a subjective intent, the Board erroneously lowered the fraud standard to a simple negligence standard. See Iletto v. Glock, Inc., 565 F.3d 1126, 1155 (9th Cir. 2009) (“Knowing conduct thus stands in contrast to negligent conduct, which typically requires only that the defendant knew or should have known each of the facts that made his act or omission unlawful. . . .”); see also Davis v. Monroe County Bd. of Educ., 526 U.S. 629, 642 (1999) (explaining that in Gebser v. Lago Vista Independent School District, 524 U.S. 274 (1998), the Court “declined the invitation to impose liability under what amounted to a negligence standard—holding the district liable for its failure to react to teacher-student harassment of which it knew or should have known. Rather, [the Court] concluded that the district could be liable for damages only where the district itself intentionally acted in clear violation of Title IX by remaining deliberately indifferent to acts of teacher-student harassment of which it had actual knowledge.”).

We have previously stated that “[m]ere negligence is not sufficient to infer fraud or dishonesty.” Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1582 (Fed. Cir. 1991). We even held that “a finding that particular conduct amounts to ‘gross negligence’ does not of itself justify an inference of intent to deceive.” Kingsdown Med. Consultants, Ltd. v. Hollister Inc., 863 F.2d 867, 876 (Fed. Cir. 1988) (en banc). The principle that the standard for finding intent to deceive is stricter than the standard for negligence or gross negligence, even though announced in patent inequitable conduct

cases, applies with equal force to trademark fraud cases. After all, an allegation of fraud in a trademark case, as in any other case, should not be taken lightly. San Juan Prods., 849 F.2d at 474 (quoting Anheuser-Busch, Inc. v. Bavarian Brewing Co., 264 F.2d 88, 92 (6th Cir. 1959)). Thus, we hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.

Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis. Of course, “because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” Star Scientific, Inc. v. R.J. Reynolds Tobacco Co., 537 F.3d 1357, 1366 (Fed. Cir. 2008). When drawing an inference of intent, “the involved conduct, viewed in light of all the evidence . . . must indicate sufficient culpability to require a finding of intent to deceive.” Kingsdown, 863 F.2d at 876.

The Board in Medinol purportedly relied on this court’s holding in Torres to justify a “should have known” standard. The Board read Torres too broadly. In that case, Torres obtained the trademark registration for “Las Torres” below a tower design. Torres, 808 F.2d at 47. The trademark was registered for use on wine, vermouth, and champagne. Id. In the renewal application, Torres submitted an affidavit stating that the mark as registered was still in use in commerce for each of the goods specified in the registration. Id. He even attached a specimen label with the registered mark displayed. Id. In fact, Torres was not using the mark as registered. Id. Instead, five

years prior to the renewal application, Torres had admittedly altered the mark to “Torres” in conjunction with a different tower design. Id. In addition, Torres knew that even the altered mark was in use only on wine. Id. In other words, the registrant knowingly made false statements about the trademark and its usage when he filed his renewal application. Id.

True, the court concluded that

If a registrant files a verified renewal application stating that his registered mark is currently in use in interstate commerce and that the label attached to the application shows the mark as currently used when, in fact, he knows or should know that he is not using the mark as registered and that the label attached to the registration is not currently in use, he has knowingly attempted to mislead the PTO.

Id. at 49. However, one should not unduly focus on the phrase “should know” and ignore the facts of the case, i.e., the registrant “knows.” Doing so would undermine the legal framework the court set out in Torres. Indeed, in Torres, the court cited various precedents—some persuasive, others binding on the court—and reemphasized several times that (1) fraud in trademark cases “occurs when an applicant knowingly makes false, material representations,” (2) the Lanham Act imposes on an applicant the obligation not to “make knowingly inaccurate or knowingly misleading statements,” and (3) a registrant must also “refrain from knowingly making false, material statements.” Id. at 48. The “should know” language, if it signifies a simple negligence or a gross negligence standard, is not only inconsistent with the framework set out elsewhere in Torres, but would also have no precedential force as it would have conflicted with the precedents from CCPA. See Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988). Certainly, the prior CCPA decisions cited in the Torres opinion were precedents binding on the Torres court. See S. Corp. v. United States, 690 F.2d 1368,

1369 (Fed. Cir. 1982). In fact, they still bind us because they have never been overturned en banc.<sup>2</sup>

Metro Traffic Control, Inc. v. Shadow Network Inc., 104 F.3d 336 (Fed. Cir. 1997) further supports our reading that the Torres holding does not deviate from the established rule that intent to deceive is required to find fraud. In Metro Traffic Control, the court cited Torres and reaffirmed that fraud can only be found if there is “a willful intent to deceive.” 104 F.3d at 340. As a result, the court agreed with the Board that the applicant’s statements, “though false, were not uttered with the intent to mislead the PTO.” Id. at 340-41. Because the applicant’s “misstatements did not represent a ‘conscious effort to obtain for his business a registration to which he knew it was not entitled,’” the court affirmed the Board’s ruling of no fraud. Id. at 341; see also L.D. Kichler Co. v. Davoil, Inc., 192 F.3d 1349, 1352 (Fed. Cir. 1999) (remanding the case so the district court may determine whether the trademark applicant “knowingly submitted a false declaration with an intent to deceive”).

Applying the law to the present case, Mr. Sullivan, who signed the application, knew that Bose had stopped manufacturing and selling audio tape recorders and players at the time the Section 8/9 renewal was filed. Therefore, the statement in the renewal application that the WAVE mark was in use in commerce on all the goods, including audio tape recorders and players, was false. Because Bose does not

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<sup>2</sup> The PTO argues that under Torres, making a submission to the PTO with reckless disregard of its truth or falsity satisfies the intent to deceive requirement. We need not resolve this issue here. Before Sullivan submitted his declaration in 2001, neither the PTO nor any court had interpreted “use in commerce” to exclude the repairing and shipping repaired goods. Thus, even if we were to assume that reckless disregard qualifies, there is no basis for finding Sullivan’s conduct reckless.

challenge the Board's conclusion that such a statement was material, we conclude that Bose made a material misrepresentation to the PTO.

However, Mr. Sullivan explained that in his belief, Bose's repairing of the damaged, previously-sold WAVE audio tape recorders and players and returning the repaired goods to the customers met the "use in commerce" requirement for the renewal of the trademark. The Board decided that Bose's activities did not constitute sufficient use to maintain a trademark registration. See Bose, 88 USPQ2d at 1335-37. It also found Sullivan's belief not reasonable. Id. at 1338. We do not need to resolve the issue of the reasonableness as it is not part of the analysis. There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. Smith Int'l, 209 USPQ at 1043. Sullivan testified under oath that he believed the statement was true at the time he signed the renewal application. Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim.

We hold that Bose did not commit fraud in renewing its WAVE mark and the Board erred in canceling the mark in its entirety. Indeed, the purpose of the Section 8/9 renewal is "to remove from the register automatically marks which are no longer in use." Torres, 808 F.2d at 48 (quoting Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 887 (CCPA 1969)). When a trademark registrant fulfills the obligation to refrain from knowingly making material misrepresentations, "[i]t is in the public interest to maintain registrations of technically good trademarks on the register so long as they are still in use." Morehouse, 407 F.2d at 888. Because "practically all of the user's

substantive trademark rights derive” from continuing use, when a trademark is still in use, “nothing is to be gained from and no public purpose is served by cancelling the registration of” the trademark.<sup>3</sup> Id.

We agree with the Board, however, that because the WAVE mark is no longer in use on audio tape recorders and players, the registration needs to be restricted to reflect commercial reality. See Bose, 88 USPQ2d at 1338. We thus remand the case to the Board for appropriate proceedings.

### III. CONCLUSION

For these reasons, the Board’s decision is reversed and remanded.

### IV. COSTS

Each party shall bear its own costs.

REVERSED and REMANDED

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<sup>3</sup> Indeed, even though the Board cancelled the registration of the WAVE trademark, it continued to analyze Bose’s common law right in the mark. Eventually, the Board found likelihood of confusion and rejected Hexawave’s application to register trademark HEXAWAVE. Bose, 88 USPQ2d at 1342-43.