

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 )  
 )  
 Opposers, )  
 )  
 v. )  
 )  
 ANASTASIA MARIE LABORATORIES, INC. )  
 )  
 Applicant. )

77/150, 306

Opposition No. 91188736



06-06-2011

U.S. Patent & TMO/TM Mail Rpt. Dt. #01

**BRIEF IN REPLY TO OPPOSITION TO MOTION TO COMPEL AND FOR  
EXTENSION OF TIME**

Pursuant to 37 CFR § 2.127(a), Applicant hereby replies to Opposers' brief in opposition to its motion to compel and for an extension of time. Although Opposers have produced a significant number of additional documents following the filing of the motion to compel, continuing to provide documents even after filing its opposition brief, and have radically revised their responses to the two interrogatories in the motion to compel, Opposers continue to withhold information and documents.

The filing of Applicant's motion to compel has resulted in extensive revisions of the answers to the two interrogatories as to interruptions in use of the marks and, finally, in the production of critical sales documents for 2000-2004. These responses and documents show that even after deletion of most products in the registration, Opposers have fraudulently maintained the registration for many products remaining in the registrations.<sup>1</sup> Nevertheless, for the reasons

<sup>1</sup> Applicant's motion for summary judgment for cancellation based on fraud resulted in the deletion by Opposers of most of the products in its registrations in class 3: "potpourri", "loose powder", "eye shadow base", "bronzing products", "nail polish", "nail base coat", "nail top coat", "facial cleansers", "facial cleansing bars", "facial toners", facial astringents", "facial masques", "facial exfoliators", "body cream", "body lotion", "body powder", "body

discussed below, the production in response to the four document production requests and the responses to the two interrogatories fall far short of Opposers' obligations.

Applicant therefore requests that the Trademark Trial and Appeal Board specifically order that Opposers (1) produce documents which show the first sale of each product sold under Opposers' marks, not merely the products in the "amended registrations" (document request 3); (2) either admit that Opposers' claim of priority as to skin care products is based solely on alleged use of its marks for "after-tweeze cream" or produce additional documents to show other alleged uses (document request 23); (3) produce the critical product sales records from 2005-2010, which are still inexcusably being withheld (document request 9); (4) explain why the revealing sales records entitled "Sales by Item Detail" from 2000-2004 which Opposers have finally produced are allegedly "incomplete" and why certain initial pages of reports for each year do not identify the products (though the products are identified in the remaining pages) (document request 9); (5) produce a spreadsheet showing semi-annual sales of each product from 2000-2010 (document request 9); (6) produce documents showing annual income from rendering services, also inexcusably withheld (document request 10); and (7) provide complete and non-evasive responses to interrogatory nos. 10 and 11.

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moisturizers", "body lotions", "body toners", "body astringents", "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". However, Opposers still retained the following products in class 3: "foundation", "concealer", "pressed powder", "eye shadow"<sup>1</sup>, "blush", "eye shadows", "mascara", "eyeliners", "lip coverings", "lipstick", "lip gloss", "lip liners", "eyebrow color pencils", "eyebrow pencils", "eyebrow powder", "eyebrow pomade", "eyebrow gel", "facial moisturizers", "eye creams", "eye gels", "eye-area moisturizers", "eye-area gels", "eye-area creams", and "facial serums".

## 1. The Documents Relating to Claims of First Use and Priority

In document request no. 3, Applicant asked that Opposers produce documents sufficient to show the earliest sale under the marks of each of the products remaining in the registrations and the earliest sale for each product “in commerce”.

In response to the motion to compel, Opposers refer to the documents attached to their Response as Exhibit B, which purport to show shipments of two products in March, 2000, to the “ABH Salon” (Opp. Br. p. 5); documents attached as Exhibit D which purportedly show shipments of four products to the ABH Salon in April, 2000 (Opp. Br. p. 6); documents attached as Exhibit E which are falsely alleged to “reflect sales of ABH-branded goods by the ABH Salon during the period from January 1, 2000, through March 31, 2000”(Opp. Br. p. 6)<sup>2</sup>; and an invoice to a Nordstrom store in August of 2000 reflecting the “sale and shipment to a Nordstrom store in Iowa of each type of Class 3 product described in ABH’s *amended* registrations for the ABH Marks, including the ABH-branded skincare product After Tweeze Cream”. (Opp. Br. p. 6).

In fact, the only document produced which purports to show first sales to an actual customer is Exhibit C. Opposers’ counsel has represented that “all goods sold by ABH to Nordstrom were ABH-branded goods” (Opp. Br. p. 7). Accepting Opposers’ representation, however, Opposers’ claim that the invoice shows first sales in commerce of the products “described in ABH’s amended registrations” is only partly responsive to the document request,

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<sup>2</sup>This statement is in direct contradiction to counsel’s assertion both earlier in his brief that “ABH launched its ABH-branded line of products in the Anastasia Beverly Hills Salon... in March of 2000” (Opp. Br. p. 2) and his assertion less than a page later that the documents reflect use of the marks on “After Tweeze Cream at least as early as March, 2000” and to all the evidence ( including a declaration by Opposer Anastasia Soare herself and the article reflecting an interview with her attached as Ex. A), previously provided by Opposers in the case. The statement is also in contradiction to the documents themselves which purport to show sales by “Anastasia Cosmetics” rather than by the “ABH Salon”.

which requests documents showing first use of each product sold under the marks and is not limited to products in the “amended registrations”.<sup>3</sup>

Further, Opposers’ claim of use of the ABH marks for the goods in the “amended registrations” is based on the false premise that Opposers’ “after-tweeze cream” is the same product as the products listed in its amended registrations (i.e. “facial moisturizers”, “facial serums”, “eye-area creams”, “eye creams” and “eye-area moisturizers”) and that “pre-tweeze gel” is the same product as the “eye gels” and “eye-area gels” listed in the registration<sup>4</sup>.

Therefore, it is requested that the Board order that Opposers produce documents which show first sales of **all** of the products with which the marks have been used, including but not necessarily limited to each separately listed product in the original registrations with which the marks have been used.

Document request 23 requests “documents that support Opposers’ position of having prior rights with respect to the use of “ANASTASIA” as or in a mark for skin care products”. Opposers simply state that the documents produced in response to document request no. 3 “also reflect that Opposers used the ABH Marks on After Tweeze Cream at least as early as March 2000”. Applicant requests that the Board order that Opposers either clarify that their claim of priority as to skin care products is based solely on “After Tweeze Cream” (a product which is not

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<sup>3</sup> Indeed, in her declaration filed with Opposers’ Motion to Dismiss Applicant’s Counterclaims, Anastasia Soare made claims of use for numerous products not listed in the “amended registrations” (Soare Declaration ¶¶ 36-38).

<sup>4</sup> As is evident from Opposers’ Ex. D, “after-tweeze cream” and “pre-tweeze gels” are eyebrow products. They are applied to the eyebrow area and are designed to sooth the brow area and minimize the irritation, tenderness, and redness of the brow area above the eye before and after tweezing. After-tweeze cream is a different product from the “facial serum” or “facial moisturizers” in the registrations. Facial moisturizers are designed to make the external layers of the skin softer and more pliable by providing hydration to the skin, and facial serums, often used in combination with facial moisturizers, are applied to the face to either exfoliate the skin or deliver antioxidants. Neither of Opposers’ eyebrow products used to provide hydration or antioxidants to the skin. Nor are the after-tweeze cream and pre-tweeze gel the same product as “eye-area creams”, “eye creams”, “eye-area moisturizers” and “eye gels”, which are applied to the under-eye area for reducing dark circles, repairing damage around the eyes, reducing wrinkles beneath the eyes, and firming and revitalizing the under-eye area. Finally, even if a product could be put to the same use as another product (e.g. a bat for a golf driver or a rake for a putter), it does not become that other product. See attached Ex. B.

even listed in the registrations) or that Opposers produce the remaining documents on which they would try to rely to show priority as to skin care products.

## **2. Documents Showing Sales of Products and Rendering of Services Under the Marks**

A year and a half after document request 9 was made and after Applicant's motion to compel was filed and served, Opposers produced sales documents at least for 2000-2004, claiming that "[o]n or about April 29, 2011, Opposers located a Quickbooks file, containing historical sales and accounts receivable information, on one of ABH's computer servers" which has enabled Opposers to produce reports "entitled 'Sales by Item Detail' for the years 2000 through 2004" (Opp. Br. p. 8). These critical documents were produced to Applicant on May 16, 2011.

Having finally produced these documents, Opposers now incredibly claim that these daily "Sales by Item" reports do not in fact show "sales by item", claiming that they "summarize total sales of ABH-branded products, but do not constitute a complete record of sales of individual ABH-branded product sold by Opposers because complete computerized records of such sales were never created" (Opp. Br. p. 8). As is evident from Opposers' own Exhibit F, the documents do not "summarize total sales of ABH-branded products". Since these reports show (with the exception of certain initial pages) complete sales by item and day records, why are such records "incomplete" and why are Opposers representing that "complete computerized records of such sales were never created"? Why, finally, as exemplified by Exhibit F, do only the first few pages of the records for certain years identify the products sold as "product" whereas the remaining pages identify the specific products sold? Opposers delayed a year and a half to produce sales records from 2000-2004 but now, without explanation, attempt to represent that they are somehow "incomplete" so that the information contained within these documents cannot

be used to show the falsity of their claims of use. Applicant requests that Opposers be ordered to explain why the sales records are “incomplete” and to explain why products are identified only as “product” on the initial pages of some of the annual reports.

Opposers still have not produced sales records for ABH-branded products from 2005-2010 even though Opposers state that they have “in the regular course of business, keep detailed, computerized records of its sales and inventory using Fishbowl software” (Opp. Br. p. 9). In lieu of producing sales information, Opposers have produced an alleged summary of shipments of ABH-branded goods from the ABH warehouse to wholesalers for each six month period from 2005 through 2010. (Opp. Br. p. 9). It is now evident that Opposers could easily generate a similar spreadsheet showing actual sales of the products from 2000-2010. Notwithstanding Opposers’ absurd assertions that the documents produced which show shipments of products provide a more accurate picture of sales than would be provided by “detailed sales by item” reports of the kind produced for 2000-2004 (Opp. Br. pp. 9-10), Opposers should be ordered to produce the documents showing “sales by item” for 2005-2010 as well as spreadsheets showing actual sales for each six month period from 2000-2010 of each of the ABH-branded products.

With respect to document production request no. 10 relating to annual income received from salon services under the marks, Opposers are now maintaining that they simply do “not have documents, other than the hard-copy reports already produced to AML, breaking down the dollar value per year of each individual service rendered in the ABH Salon” other than the “Operator Service Commission Reports” for three months in 2000, one month in 2001, and two months in 2002. (Opp. Br. p. 10). Opposers are seeking to avoid the production of documents by misrepresenting what was requested – Applicant requests documents showing the annual income from rendering salon services under the marks, not documents showing a break-down by

specific service and service provider. Applicant requests that the Board order that Opposers produce the documents showing annual income from rendering salon services under the marks.

### **3. Responses to Interrogatories Relating to Interruption in Use**

In response to Applicant's motion to compel, Opposers have expanded their answers to Interrogatory Nos. 10 and 11 from a paragraph to a seven page essay. However, while the information provided in those seven pages shows that Opposers have been significantly misrepresenting their rights and certainly shows that the declarations of use filed in Opposers' registrations during the litigation were false, as shown by the attached material filed under seal, the answers remain misleading and incomplete. Opposers should be ordered to provide complete responses as to **all** products in connection with which sales have been interrupted.

**TRADE SECRET/COMMERCIALY SENSITIVE MATERIAL**

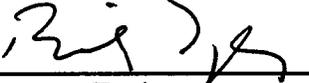
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#### 4. Extension of Time

As is evident from the foregoing, because of Opposers' continuing evasiveness and efforts to prevent meaningful discovery that would show the full extent of their misrepresentations, it is necessary to extend discovery by at least sixty days following the resumption of proceedings to follow up on the discovery which has resulted from the motion to compel and which will result from the Board's order. Further, as Applicant's counsel informed Opposing counsel in a letter on February 25 (after the settlement discussions between Applicant's new counsel and Opposers' counsel failed), the parties have agreed that there is a likelihood of confusion between their marks as to skincare products, and Applicant intends to amend its counterclaims for cancellation to allege priority and likelihood of confusion. This will also make the counterclaims consistent with the petition for cancellation which was filed by Applicant counsel's predecessor a year earlier (Cancellation No. 92052119). Because of the newly discovered information resulting from the motion to compel, Applicant now also intends to add claims for abandonment to its counterclaims.

Respectfully Submitted,

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**June 6, 2011**

**Certificate of Service**

I hereby certify that a true copy of the foregoing Brief in Reply to Opposition to Motion to Compel and for an Extension of Time and the attached Exhibit B were sent via via U.S. first class mail on June 6, 2011, to John May, Berliner & Associates, 555 West Fifth Street, 31st Floor, Los Angeles, CA 90013, and via email to John May at [jmay@berliner-ip.com](mailto:jmay@berliner-ip.com).

  
\_\_\_\_\_  
Brewster Taylor

# EXHIBIT B

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*This Season   Grow. Cook. Eat.*

[Home](#) » [Beauty & Personal Care](#) » [Skin Care Products](#) » [Eye Creams](#) » [Definition of Under-Eye Cream](#)

## Definition of Under-Eye Cream

Skin-care regimens differ from individual to individual, varying by age, skin type, skin concerns and objectives and personal choice. Sales people behind beauty counters usually insist that any person's optimal daily skin-care regimen should consist of a cleanser, toner, serum, moisturizer and under-eye cream. Cosmetics companies have even developed different products for nighttime use, urging customers to purchase an even broader range of products. While not everyone opts for serums, exfoliators and night creams in the skin-care regimen, under-eye cream use is as common as a daily moisturizer.

### The Eye Area

The skin around the eyes is significantly thinner than the rest of the facial skin, making it more sensitive to both natural and external factors. Aging affects the orbital skin faster than other areas of the face, and effects from external factors such as sun exposure, smoking and caffeine first become visible in this area. The skin around the eyes can lose its elasticity and collagen more easily than other areas of the face. Cosmetic companies use these facts about the orbital skin to design products and treatments especially for that area, and to market the products as necessary parts of the skin-care regimen formulated differently than facial moisturizers.

### Skin Conditions of the Eye Area

Because the eyes are used constantly for expression, the fine lines that come with aging are first exhibited in this facial skin area, and can

be deepened with other factors, such as sun damage and poor health habits. The appearance of crow's feet are an aging eye-area concern. In addition to wrinkles, under-eye concerns also include dark circles and puffiness. Dryness is another concern, as it can make fine lines and wrinkles appear deeper.

## Functions of Under-Eye Cream

Under-eye creams aim to moisturize the orbital skin, and some claim to provide continuous hydration for extended periods of time. Beyond moisturizing, eye creams target various orbital skin conditions. Corrective eye creams promise to reduce the appearance of fine lines and wrinkles. Some under-eye creams are designed to reduce the appearance of dark circles and/or reduce puffiness. Eye creams that promise preventative benefits are formulated with antioxidants in the ingredients to protect the skin area from environmental influences. Anti-aging eye creams aim to deliver both corrective and preventative benefits.

## Application

Eye cream is applied to the cleansed orbital skin before the facial moisturizer. It is applied by dabbing a small amount of the product under and around the eye, and slightly massaging the product into the skin. Rubbing the orbital area is frowned upon, since the eye area is so sensitive to movement and the stretching of the skin. Eye cream can be used in the morning and at night, although its use at either time is optional.

## Expert Insight

The claims of cosmetic companies and consumers about the effectiveness and need for eye creams varies so widely that the matter of eye cream necessity is absolutely subjective. However, Linda Wells, longtime beauty editor for Allure magazine and author of "Allure: Confessions of a Beauty Editor," suggests in her book that eye creams aren't necessary at all in skin care. The use of under-eye cream to treat and protect the orbital skin is undoubtedly a personal choice.

### Related Topics

[Under Eye Treatments](#)

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## References

"Eye Skin Care Info Pack." SmartSkinCare.com, September 2009

"Caring for The Skin Around the Eyes." Mediniche.com

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- 3. Anti-Wrinkle Power/Speed
  
- 4. Long Term Results
- 5. Product Safety
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## The 5 Top-Rated Eye Creams

### #1 Prototype #37-C

	Suggested Retail Price:
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## Facial Serum vs. Facial Moisturizer

By Jen Adkins , About.com Guide

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### **Question:** Facial Serum vs. Facial Moisturizer

Are you finding it hard to decide what's better for your skin: a facial serum or a facial moisturizer? Here's what you need to know.

### **Answer:**

While facial serums can give you added moisture, the main reason you'd want to use a facial serum is to get added nutrients into deeper layers of your skin that a regular moisturizer is not able to reach. You can get many types of serums such as anti-aging serums, skin brightening serums and even acne preventative serums. You apply the serum after your toner and before your moisturizer.

A moisturizer has larger molecules than a serum. This means that a moisturizer will not penetrate the skin as far as a serum will. While serums deposit nutrients, moisturizers are meant to deposit moisture and hydration your skin.

Of course skin care companies would like to make you believe that you need both, but of course that is not true. If you have a problem with your skin that you'd like to improve, such as dark spots or early aging signs, a serum can help. Also, if your skin is very oily, a serum can give you enough hydration. But, if your skin is happy with your regular moisturizer alone, there is no need to rush off to buy a serum.

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**Resilience Lift Extreme**  
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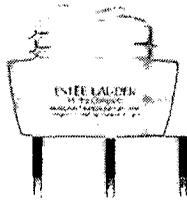
Anti-Wrinkle

**Time Zone**  
Anti-Line/Wrinkle Eye Creme  
★★★★★ (41 reviews)  
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Gentle anti-aging benefits  
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## EYES

- Fine Lines & Wrinkles
- Dryness
- Dark Circles
- Puffiness

### skincare: eyes: fine lines & wrinkles

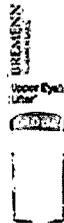
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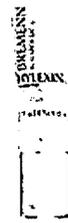
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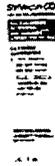
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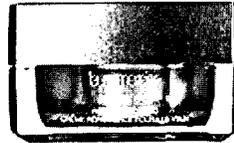
[Lancome GENIFIQUE EYE Youth Activating Eye Concentrate](#), \$59



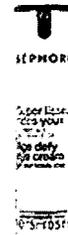
[Perricone MD Eye Lift Synergy](#) (\$145 Value), \$95



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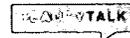
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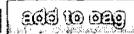
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After tweezing, this luxurious cream formulated with chamomile, Vitamin C and Vitamin E helps to calm, soothe and refresh the skin. This exclusive anti-redness formula can be used on the brow area or any other area of the face where redness may occur.

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**After Tweeze™ Soothing Cream**

Meet our 2007 CEW Award Winner. After you tweeze and before going out to meet the world, make sure to treat yourself and soothe tender brow areas with our calming, moisturizing cream.

**Tips & Tricks**

Use the soft wand for precise, gentle-glide application of this rich blend of moisturizers and calming extracts. Quickly absorbs to help soothe skin post tweezing or waxing. Helps counteract post-tweezing redness and inflammation.



ZOOM



\$10 QTY. 1

**BEAUTY SCOOP**

If you have super extra-sensitive skin — we recommend tweezing the day before an important appointment or event. But when you're in a pinch, try these 3 easy steps for a fast flawless look:

- 1) use an ice cube (or cold water) to close pores on just-tweezed brow areas
- 2) pat dry and apply **After Tweeze Soothing Cream**
- 3) follow-up with a light coat of concealer to cover any excess redness, wait at least five minutes before applying make-up.

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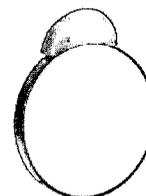
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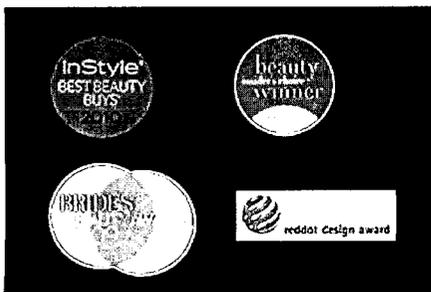
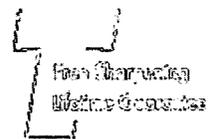
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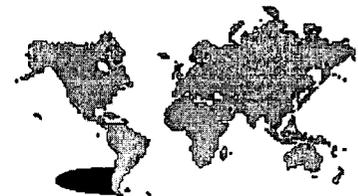


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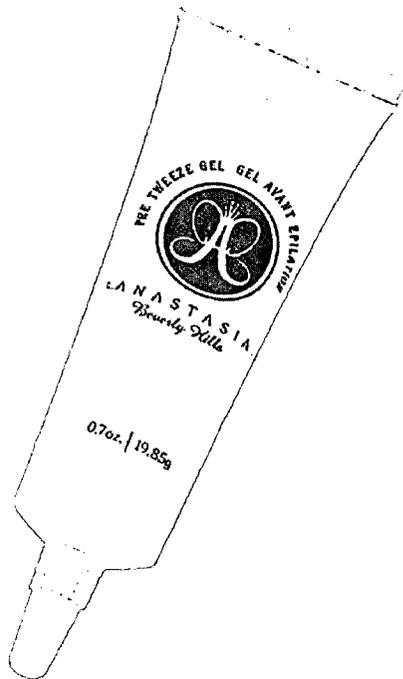
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## Anastasia Pre-Tweeze Gel

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### DETAILS

Formulated with aloe vera, chamomile and peppermint oils, this lightweight gel calms and cools the skin as it prepares the brows for tweezing.

0.7 oz. tube.  
By Anastasia; made in the USA.

item #13092U

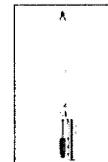
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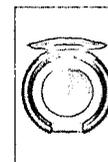
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