

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

# 77150306

Opposition No.  
91188736

03/19/2009 SWILSON1 00000004 77150306

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APPLICANT'S ANSWER TO OPPOSITION AND COUNTERCLAIM TO CANCEL  
OPPOSERS' PLEADED REGISTRATIONS NOS. 2798069 AND 2821892

ANSWER

Applicant, Anastasia Marie Laboratories, Inc., by its attorney, without waiving its rights pursuant to applicant's Motion to Dismiss Opposition As A Nullity filed concurrently herewith, hereby answers the allegations set forth in the Notice of Opposition as follows:

1. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph I of the Notice of Opposition and, therefore, denies said allegations.



03-16-2009

2. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and, therefore, denies said allegations.

3. Applicant denies the allegations set forth in Paragraph 3 of the Notice of Opposition.

4. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and, therefore, denies said allegations.

5. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and, therefore, denies said allegations.

6. Applicant denies the allegations set forth in Paragraph 6 of the Notice of Opposition.

7. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 7 of the Notice of Opposition and, therefore, denies said allegations.

8. Applicant denies the allegations set forth in Paragraph 8 of the Notice of Opposition.

9. Applicant denies the allegations set forth in Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations set forth in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations set forth in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations set forth in Paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations set forth in Paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations set forth in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in Paragraph 16 of the Notice of Opposition.

## COUNTERCLAIM I

### CANCELLATION OF REGISTRATION NO. 2,798,069

1. Opposers allege that Opposer Anastasia Beverly Hills, Inc. is the owner of Registration No. 2,798,069 issued on December 23, 2003 for the mark A ANASTASIA BEVERLY HILLS & Design in connection with:

potpourri, cosmetics, namely, foundation ,concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, 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, 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, fragranced creams, lotions, gels, bar body toners, astringents; and room fragrances in Class 3, candles in Class 4, eyebrow tweezers, eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.

2. Opposers' Registration No. 2,798,069 for the mark A ANASTASIA BEVERLY HILLS & Design on the foregoing goods issued from Application Serial No. 75833290 filed on October 27, 1999 on an "intent-to-use" basis.

3. On August 8, 2003, Opposers submitted a sworn Declaration signed by Opposer Anastasia Soare, which stated, "Applicant is using the mark in commerce in connection with all of the goods listed by the Examining Attorney in the Notice of Allowance", which stated:

potpourri, cosmetics, namely, foundation ,concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, 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, 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, fragranced creams, lotions, gels, bar body toners, astringents; and room fragrances in Class 3, candles in Class 4, eyebrow tweezers and eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.

4. On information and belief, Opposers are not using, and have never used, the trademark A ANASTASIA BEVERLY HILLS & Design on any of the foregoing goods set out in Paragraph 2 herein except possibly concealer and eyebrow products, namely, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, eyebrow tweezers, eyebrow grooming scissors and cosmetic brushes. Therefore, on information and belief, when Opposers submitted a Statement of Use to the PTO on August 8, 2003, stating that they had first used the mark A ANASTASIA BEVERLY HILLS & Design on "...all the goods listed by the Examining Attorney in the Notice of Allowance" --- such information was false.

5. Upon information and belief, Opposers Anastasia Soare and Anastasia Beverly Hills, Inc. misrepresented the nature of their use in commerce of the alleged mark at the time they

submitted their Notice of Allowance and continued to prosecute the trademark application that led to the registration which is the subject of this counterclaim.

6. Upon information and belief, Opposers procured the registration of the aforesaid mark by false means and/or by knowingly and willfully making false and/or fraudulent declarations or representations to the PTO including, *inter alia*, falsely alleging in a Declaration under 37 CFR §1(A) that Opposers' first use of the mark was on:

potpourri, cosmetics, namely, foundation ,concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, 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, 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 Class 3, candles in Class 4, eyebrow tweezers and eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21 ---

when, on information and belief, Opposers did not then, and do not now, use the mark on any of the foregoing goods except possibly concealer, the foregoing specified eyebrow products and cosmetic brushes.

7. Upon information and belief, Opposers Anastasia Soare and Opposer Anastasia Beverly Hills, Inc.'s false statements were made with the intent to induce authorized agents of the PTO to grant the aforementioned registration and, reasonably relying upon the truth of said false statements, the PTO did, in fact, grant the aforementioned registration to Opposer Anastasia Beverly Hills, Inc.

8. Upon information and belief, Opposer Anastasia Soare and Opposer Anastasia Beverly Hills, Inc. knew at the time it was made that the statement of first use made in the application that ultimately matured into Registration No. 2,798,069 was false.

9. Opposer Anastasia Beverly Hills, Inc. would not have received Registration No. 2,798,069 for all the goods identified therein but for Opposer Anastasia Soare's willful material misrepresentation in the Declaration which Opposer Anastasia Soare signed and filed with the Amendment to Allege Use.

10. Applicant accordingly alleges that the application which resulted in Registration No. 2,798,069 constituted a fraud upon the U.S. Patent and Trademark Office.

11. In the alternative, upon information and belief, the mark of Registration No. 2,798,069 has never been used in commerce in connection with any of the goods listed in the registration except possibly concealer, the foregoing specified eyebrow products and cosmetic brushes.

12. Applicant avers that it is damaged by the continued ownership by Opposer Anastasia Beverly Hills of Registration No. 2,798,069, because Opposers have opposed the registration of Applicant's mark ANASTASIA based upon asserted likelihood of confusion and dilution, "deceptiveness" and "false suggestion of a connection", among others, with the goods identified in Registration No. 2,798,069.

13. In view of the above grounds, Opposers are not entitled to continue registration of their alleged mark, since Opposers, upon information and belief, committed fraud in the procurement of the registration.

WHEREFORE, Applicant respectfully prays that Registration No. 2,798,069 be cancelled.

## COUNTERCLAIM II

### CANCELLATION OF REGISTRATION NO. 2,821,892

14. Opposers have alleged that Opposer Anastasia Beverly Hills, Inc. is the owner of Registration No. 2,821,892 issued on December 23, 2003 for the mark ANASTASIA BEVERLY HILLS in connection with:

potpourri, cosmetics, namely, foundation ,concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, 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, 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 Class 3, candles in Class 4, eyebrow tweezers and eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.

15. Opposers' Registration No. No. 2,821,892 for the mark ANASTASIA BEVERLY HILLS & Design on the aforementioned goods issued from Application Serial No. 75833810 filed on October 28, 1999 on an "intent-to-use" basis.

16. On May 22, 2001, Opposer Anastasia Soare signed a sworn Declaration, which stated that "...the trademark is now in use in commerce." Opposer Anastasia Soare's Declaration was filed with the PTO on June 22, 2001 with an Amendment to Allege Use stating that the mark was in use in commerce "... with the goods as stated in the application", and that the mark was first used in interstate commerce "...at least as early as September, 2000."

17. On information and belief, Opposers are not using, and have never used, the mark ANASTASIA BEVERLY HILLS on any of the goods set out in Application Serial No. 75833810 except possibly concealer and eyebrow products, namely, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, eyebrow tweezers, eyebrow grooming scissors and cosmetic brushes. Therefore, on information and belief, when Opposer Anastasia Beverly Hills submitted an Amendment to Allege Use to the PTO on June 22, 2001 stating that it had first used the mark ANASTASIA BEVERLY HILLS "...with the goods as stated in the application" --- such information was false.

18. Upon information and belief, Opposers Anastasia Soare and Anastasia Beverly Hills, Inc. misrepresented the nature of their use in commerce of the alleged mark at the time they submitted their Amendment to Allege Use and continued to prosecute the trademark application that led to the registration which is the subject of this counterclaim.

19. Upon information and belief, Opposers procured the registration of the aforesaid mark by false means and/or by knowingly and willfully making false and/or fraudulent declarations or representations to the PTO including, *inter alia*, falsely alleging in a Declaration under 37 CFR §1(A) that Opposers' first use of the mark was on:

potpourri, cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, 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, 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 Class 3, candles in Class 4, eyebrow tweezers and eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21 ---

when, on information and belief, Opposers did not then, and do not now, use the mark on any of the foregoing goods except possibly concealer, the foregoing specified eyebrow products and cosmetic brushes.

20. Upon information and belief, Opposers Anastasia Soare and Opposer Anastasia Beverly Hills, Inc.'s false statements were made with the intent to induce authorized agents of the PTO to grant the aforementioned registration and, reasonably relying upon the truth of said false statements, the PTO did, in fact, grant the aforementioned registration to Opposer Anastasia Beverly Hills, Inc.

21. Upon information and belief, Opposer Anastasia Soare and Opposer Anastasia Beverly Hills, Inc. knew at the time it was made that the statement of first use made in the application that ultimately matured into Registration No. 2,821,892 was false.

22. Opposer Anastasia Beverly Hills, Inc. would not have received Registration No. 2,821,892 for all the goods identified therein but for Opposer Anastasia Soare's willful material misrepresentation in the Declaration which Opposer Anastasia Soare signed and filed with the Amendment to Allege Use.

23. Applicant accordingly alleges that the application which resulted in Registration No. 2,821,892 constituted a fraud upon the U.S. Patent and Trademark Office.

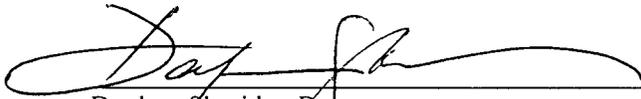
24. In the alternative, upon information and belief, the mark of Registration No. 2,821,892 has never been used in commerce in connection with any of the goods listed in the registration except possibly concealer, the foregoing specified eyebrow products and cosmetic brushes.

25. Applicant avers that it is damaged by the continued ownership by Opposer Anastasia Beverly Hills of Registration No. 2,821,892, because Opposers have opposed the registration of Applicant's mark ANASTASIA based upon asserted likelihood of confusion and dilution, "deceptiveness" and "false suggestion of a connection", among others, with the goods identified in Registration No. 2,821,892 .

26. In view of the above grounds, Opposers are not entitled to continue registration of their alleged mark, since Opposers, upon information and belief, committed fraud in the procurement of the registration.

· WHEREFORE, Applicant respectfully prays that Registration No. 2,821,892 be cancelled.

Dated: March 14, 2009 Respectfully submitted,



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Attorney for Applicant  
Anastasia Marie Laboratories, Inc.

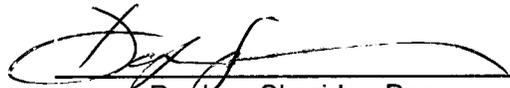
**CERTIFICATE OF SERVICE BY EXPRESS MAIL**

Mark : ANASTASIA  
Serial No. : 76/372999  
Opposition No.: 91188736

I hereby certify that copies of the attached ANSWER TO OPPOSITION AND COUNTERCLAIMS TO CANCEL REGISTRATIONS WITH APPROPRIATE FILING FEES was addressed to the following parties and deposited with the United States Postal Service by Express Mail, postage prepaid, on March 16, 2009:

1. John M. May, Esq.  
Anastasia Beverly Hills, Inc.  
438 N. Bedford Dr.  
Beverly Hills, CA 90210
2. Anastasia Beverly Hills, Inc.  
438 N. Bedford Dr.  
Beverly Hills, CA 90210

Dated: March 16, 2009

  
Daphne Sheridan Bass

**CERTIFICATE OF SERVICE BY EXPRESS MAIL**

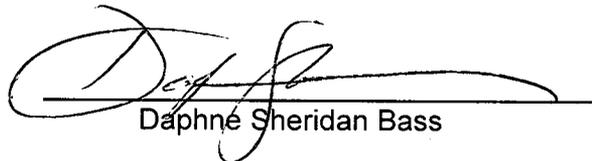
Mark : ANASTASIA

Serial No. : 76/372999

Opposition No.: 91188736

I hereby certify that copies of the attached **ANSWER TO OPPOSITION AND COUNTERCLAIMS TO CANCEL REGISTRATIONS AND APPROPRIATE FILING FEES** are addressed to the Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 and are being deposited with the United States Postal Service by Express Mail on March 16, 2009.

Dated: March 16, 2009

  
Daphne Sheridan Bass