

ESTTA Tracking number: **ESTTA373820**

Filing date: **10/18/2010**

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

Notice of Opposition

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

Opposer Information

Name	ZIA Cosmetics, Inc.		
Entity	Corporation	Citizenship	California
Address	58 South Service Road, Suite 250 Melville, NY 11747 UNITED STATES		

Attorney information	Robert W. Smith, Esq. McCarter & English, LLP 100 Mulberry Street 4 Gateway Center Newark, NJ 07101 UNITED STATES rsmith@mccarter.com, kknoll@mccarter.com Phone:973-622-4444		
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Applicant Information

Application No	85018839	Publication date	10/05/2010
Opposition Filing Date	10/18/2010	Opposition Period Ends	11/04/2010
Applicant	WTFN, INC. 20950 LASSEN STREET CHATSWORTH, CA 91311 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: BATH AND BODY PERSONAL CARE PRODUCTS, NAMELY BATH OIL AND GEL, BODY LOTION, GEL AND CREAMS, BODY BUTTER, SKIN SUGAR SCRUB, AFTER BATH OIL, BODY AND MASSAGE OILS, NON-MEDICATED BUST ENHANCING AND FIRING GELS AND LOTIONS, HAIR SHAMPOO AND CONDITIONER, HAIR CONDITIONING OIL, BODY FRAGRANCES

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2422418	Application Date	04/29/1996
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	ZIA		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1994/03/00 First Use In Commerce: 1994/03/00 cosmetics, namely, skin moisturizing lotions, cremes and gels, enzyme peels, liquid and powder make-up, cleansers, toners, essential oils for personal use, facial masks, hydrating cremes, tanning cremes, sun block cremes and lotions, eye oils and body lotions		

U.S. Registration No.	3326784	Application Date	10/28/2005
Registration Date	10/30/2007	Foreign Priority Date	NONE

Word Mark	ZIA BRILLIANCE
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 003. First use: First Use: 2006/05/00 First Use In Commerce: 2006/05/00 Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels, lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles, toner, cleanser, eye cream, sun block and sunscreen preparations		
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U.S. Registration No.	3452667	Application Date	09/06/2007
Registration Date	06/24/2008	Foreign Priority Date	NONE

Word Mark	ZIA SKIN BASICS
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Design Mark	<h1>ZIA SKIN BASICS</h1>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; creams to smooth wrinkles and diminish the appearance of wrinkles; skin toners, skin cleansers; eye creams and gels; skin exfoliants; sun block and sunscreen preparations		

U.S. Registration No.	3452456	Application Date	06/28/2007
Registration Date	06/24/2008	Foreign Priority Date	NONE

Word Mark	ZIA ULTIMATES
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Design Mark	<h1>ZIA ULTIMATES</h1>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; skin toners; skin cleansers; eye creams and gels; sun block and sunscreen preparations; facial masks; skin exfoliants; self sun-tanning creams		

U.S. Registration No.	3470661	Application Date	06/28/2007
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	ZIA		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: First Use: 1984/00/00 First Use In Commerce: 1984/00/00 Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; skin toners; skin cleansers; eye creams and gels; sun block and sunscreen preparations; facial masks; skin exfoliants; non-medicated microdermabrasion skin scrub creams, skin balancing tonics and moisture infusion serums; liquid and powder make-up; self sun-tanning creams; shaving creams and gels; aftershave lotion for men</p> <p>Class 010. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00 Microdermabrasion tools, namely, dermabrader skin treatment heads</p> <p>Class 021. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00 Microdermabrasion sponges for scrubbing the skin</p>

U.S. Registration No.	3470660	Application Date	06/28/2007
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	ZIA TREATMENTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; facial masks; skin exfoliants; non-medicated microdermabrasion skin scrub creams, skin balancing tonics and moisture infusion serums</p> <p>Class 010. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00</p>		

	Microdermabrasion tools, namely, dermabrader skin treatment heads Class 021. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00 Microdermabrasion sponges for scrubbing the skin
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Attachments	75095631#TMSN.gif (1 page)(bytes) 78743015#TMSN.jpeg (1 page)(bytes) 77273051#TMSN.jpeg (1 page)(bytes) 77217840#TMSN.jpeg (1 page)(bytes) 77217847#TMSN.jpeg (1 page)(bytes) 77217829#TMSN.jpeg (1 page)(bytes) AZIA Opposition.pdf (7 pages)(192880 bytes)
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Certificate of Service

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

Signature	/Robert W. Smith/
Name	Robert W. Smith, Esq.
Date	10/18/2010

2. Opposer owns the following U.S. registrations for marks consisting of or including the term "ZIA" (collectively, the "ZIA Marks") as used in connection with natural skin care products:

MARK	REG. NO.	REG. DATE	GOODS	CLASS
ZIA & Design	2,422,418	January 23, 2001 (now incontestable)	Cosmetics, namely, skin moisturizing lotions, creams and gels, enzyme peels, liquid and powder make-up, cleansers, toners, essential oils for personal use, facial masks, hydrating creams, tanning creams, sun block creams and lotions, eye oils and body lotions.	3
ZIA BRILLIANCE	3,326,784	October 30, 2007	Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels, lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles, toner, cleanser, eye cream, sun block and sunscreen preparations.	3

ZIA SKIN BASICS	3,452,667	June 24, 2008	Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; creams to smooth wrinkles and diminish the appearance of wrinkles; skin toners, skin cleansers; eye creams and gels; skin exfoliants; sun block and sunscreen preparations.	3
ZIA ULTIMATES	3,452,456	June 24, 2008	Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; skin toners; skin cleansers; eye creams and gels; sun block and sunscreen preparations; facial masks; skin exfoliants; self sun-tanning creams.	3

ZIA	3,470,661	July 22, 2008	<p>Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; facial masks; skin exfoliants; non-medicated microdermabrasion skin scrub creams, skin balancing tonics and moisture infusion serums, in Class 3;</p> <p>Microdermabrasion tools, namely, dermabrader skin treatment heads, in Class 10; and</p> <p>Microdermabrasion sponges for scrubbing the skin, in Class 21.</p>	3, 10 & 21
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ZIA TREATMENTS	3,470,660	July 22, 2008	<p>Cosmetics, skin care products and facial care products, namely, skin moisturizing, softening, conditioning, smoothing, contouring, and firming lotions, creams and gels; lotions, creams and gels to smooth wrinkles and diminish the appearance of wrinkles; facial masks; skin exfoliants; non-medicated microdermabrasion skin scrub creams, skin balancing tonics and moisture infusion serums, in Class 3;</p> <p>Microdermabrasion tools, namely, dermabrader skin treatment heads, in Class 10; and</p> <p>Microdermabrasion sponges for scrubbing the skin, in Class 21.</p>	3, 10 & 21
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3. By reason of the long and extensive promotion, print and internet advertising, and provision of high-quality products manufactured and distributed by Opposer in conjunction with the ZIA Marks, the public and the trade have come to recognize products offered in conjunction with these marks as signifying Opposer and its natural skin care products.

4. Notwithstanding Opposer's long prior rights in the ZIA Marks, Applicant has filed an application, Serial No. 85/018,839, for registration of AZIA for “bath and body personal care products, namely bath oil and gel, body lotion, gel and creams, body butter, skin sugar scrub, after bath oil, body and massage oils, non-medicated bust enhancing and firming gels and lotions, hair shampoo and conditioner, hair conditioning oil, body fragrances,” in Class 3.

Applicant's AZIA mark was published for opposition in the Official Gazette on October 5, 2010 at TM 445.

5. There is no issue as to priority. Applicant's intent to use filing date for its AZIA mark is April 20, 2010, long after the dates when Opposer first used and registered its ZIA Marks.

6. The trademark proposed for registration by the Applicant, AZIA, is similar in appearance, sound and commercial impression to Opposer's ZIA Marks, and is used on or in connection with goods that are similar to those of Opposer and is likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer's ZIA Marks so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing Applicant's AZIA mark.

7. If Applicant is permitted to use and register its AZIA mark for its goods in Class 3 as specified in the Application herein opposed, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applicant's AZIA mark and the Opposer's ZIA Marks. Accordingly, consumers will associate Applicant's goods with those of Opposer, and think that such goods are provided or endorsed by, or otherwise affiliated with, Opposer.

8. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its AZIA mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, the Opposer, ZIA Cosmetics, Inc., prays that this Opposition be sustained and that Application Serial No. 85/018,839 for the AZIA mark be refused registration for the goods therein specified in International Class 3 and for such other relief as may be deemed just and proper.

Respectfully submitted,

ZIA COSMETICS, INC.

By: _____


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Dated: October 18, 2010