

ESTTA Tracking number: **ESTTA545297**

Filing date: **06/26/2013**

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

Notice of Opposition

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

Opposer Information

Name	Cosmetic Warriors Limited
Granted to Date of previous extension	06/26/2013
Address	29 High Street, Poole Dorset, BH15 1AB UNITED KINGDOM

Attorney information	John A. Clifford Merchant & Gould PC PO Box 2910 Minneapolis, MN 55402-9944 UNITED STATES jclifford@merchantgould.com, aavery@merchantgould.com, dockmpls@merchantgould.com Phone:612.336.4616
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Applicant Information

Application No	85733971	Publication date	02/26/2013
Opposition Filing Date	06/26/2013	Opposition Period Ends	06/26/2013
Applicant	Miracle Fruit Oil, LLC 1228 Alton Road Miami Beach, FL 33139 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 2012/09/12 First Use In Commerce: 2012/09/12 All goods and services in the class are opposed, namely: Cosmetic oils; Cosmetic preparations; Cosmetic preparations for the hair and scalp; Cosmetics; Cosmetics and cosmetic preparations; Hair care preparations; Hair conditioners; Hair nourishers; Hair oils; Hair shampoos and conditioners; Oils for cosmetic purposes; Oils for hair conditioning

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

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

U.S. Registration No.	3001303	Application Date	04/27/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1996/05/00 First Use In Commerce: 1996/06/00 Catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags		

U.S. Registration No.	2282428	Application Date	02/25/1997
Registration Date	10/05/1999	Foreign Priority Date	NONE
Word Mark	LUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, [dentifrices, cosmetic depilatory creams,] personal deodorants, preparations for the care of the hair, shampoos, soaps [, and essential oils for personal use] Class 005. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 [medicated hair care, skin care, teeth care and nail care preparations]		

U.S. Registration No.	3102767	Application Date	01/06/2005
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	LUSH FRESH HANDMADE COSMETICS		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 003. First use: First Use: 1996/06/00 First Use In Commerce: 2002/12/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use
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U.S. Registration No.	3008685	Application Date	04/27/2004
Registration Date	10/25/2005	Foreign Priority Date	NONE

Word Mark	LUSH
Design Mark	
Description of Mark	NONE

Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 Perfumes; non-medicated toilet and cosmetic preparations, namely lotions, powders and creams for use on the skin; preparations for cleansing and care of the skin; bath oils in solid and liquid form; personal deodorants; hair care preparations; oil based massage bars that melt on contact with the skin; solid skin moisturizers and skin conditioners in the form of a paste or face mask; bath bars that melt on contact with hot water to produce a soapy or oily suspension; soaps; and essential oils for personal use
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U.S. Registration No.	3987808	Application Date	11/04/2005
Registration Date	07/05/2011	Foreign Priority Date	06/21/2005

Word Mark	LUSH
Design Mark	
Description of Mark	NONE

Goods/Services	Class 044. First use: Hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; Beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; Beauty salon services; Aromatherapy services; Skin care salon services; Massage services; Nail care and manicure services; Trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; Counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations
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U.S. Registration No.	4118438	Application Date	08/09/2011
Registration Date	03/27/2012	Foreign Priority Date	NONE

Word Mark	LUSH
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1995/04/10 First Use In Commerce: 1996/06/00 Cosmetics

Related Proceedings	91211294
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Attachments	2013 06 26 Notice of Opposition.PDF(367573 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	/John A. Clifford/
Name	John A. Clifford
Date	06/26/2013

International Class 3: Cosmetic oils; Cosmetic preparations; Cosmetic preparations for the hair and scalp; Cosmetics; Cosmetics and cosmetic preparations; Hair care preparations; Hair conditioners; Hair nourishers; Hair oils; Hair shampoos and conditioners; Oils for cosmetic purposes; Oils for hair conditioning

These applications (Serial Nos. 85/732,415 and 85/733,971) are based on Applicant's alleged first use of the marks in commerce on September 12, 2012.

2. Applicant's Marks were published for opposition on February 26, 2013 and Opposer obtained extensions of time to oppose the applications. This Notice of Opposition is timely filed.
3. Opposer is the owner of the following U.S. Trademark Registrations:

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

LUSH, U.S. Reg. No. 3,001,303, used in connection with catalogues listing and illustrating cosmetics and toiletry products; printed product lists featuring cosmetic products and toiletry products; printed point of sales display in the nature of signs and display boards; and paper bags, in International Class 16. Said registration registered on the Principal Register on September 27, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on April 27, 2004 alleging a date of first use of May 1996, which is a date prior to the date of filing of Applicant's application.

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



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

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

LUSH, U.S. Reg. No. 3,987,808, for hair salon services, namely, hair styling, coloring, washing, shampooing, conditioning, applying hair masks, head massages, and scalp massages; beauty salon therapy services, namely, cleansing of the skin, applying face masks, applying back pack masks, skin peelers, steam treatments, toning, shaving, exfoliation treatments, treatments using creams and lotions against problem skin or older skin, and facial and body treatments consisting of a combination of creams/lotions and massage; beauty salon services; aromatherapy services; skin care salon services; massage services; nail care and manicure services; trichology services, namely, providing advice and consultancy relating to hair disorders in the nature of greasy hair, lank hair, dry hair, dandruff and split hairs; counseling, advisory and information services in the field of beauty and cosmetics, and providing information about beauty by way of beauty demonstrations, in International Class 44. Said registration registered on the Principal Register on July 5, 2011 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

LUSH, U.S. Reg. No. 4,118,438, for cosmetics in International Class 3. Said registration registered on the Principal Register on October 25, 2005 and was based on an application filed in the U.S. Patent and Trademark Office on March

27, 2012 alleging a date of first use of April 10, 1995, which is a date prior to the date of filing of Applicant's application.

4. Opposer's registered marks are valid and subsisting, and are prima facie evidence of Opposer's exclusive right to use said mark in commerce on the goods and services specified in each registration. In addition, Reg. Nos. 2,853,483 and 2,282,428, are incontestable under §15 of the Lanham Act (15 U.S.C. §1065), and are therefore conclusive evidence of the validity of the registered marks, of registration of the marks, of Opposer's ownership of the marks, and of Opposer's exclusive right to use the marks in commerce under §33(b) of the Lanham Act (15 U.S.C. §1115(b)).
5. On August 1, 2012, the Trademark Trial and Appeal Board issued a decision in Opposition Nos. 91158982 and 91169017 involving Cosmetic Warriors Limited and its LUSH trademarks. In that decision, the Trademark Trial and Appeal Board found that Opposer's "mark LUSH is very strong and widely known. In view thereof, we accord the mark a broad scope of protection" (at pages 9-10). The decision of the Trademark Trial and Appeal Board is not a precedent of the Trademark Trial and Appeal Board, but the decision is relevant to show the strength of the LUSH mark at that time.
6. Opposer sells a variety of hair treatments, hair conditioners, and products that compete directly with the goods listed in the subject application. For example, Opposer sells a "big solid conditioner" consisting of sea salt and coconut oil for conditioning hair. Opposer also sells coconut cream shampoo, a variety of moisturizers and hair conditioners. Many of Opposer's products include fruit oils, fruit scents, or fruit oil infusions.
7. Since at least as early as April 10, 1995, Opposer has used the LUSH mark in the United States. Said use has been continuous since the date of first use and has not been abandoned.

Opposer's products and the products listed by Applicant in its applications are closely related.

8. Opposer has advertised and promoted its LUSH mark extensively. Opposer has also made substantial sales under said mark. As a result of such use and promotion, Opposer's LUSH mark has developed and represents valuable goodwill inuring to the benefit of Opposer. Opposer operates over 105 brick-and-mortar retail stores in at least 33 states under its LUSH trademark in the United States, and will soon open more stores. Opposer operates nearly 800 stores worldwide. Opposer also makes substantial sales of its products through its online retail store at www.lushusa.com.
9. Opposer has priority with respect to the marks at issue in this opposition. Opposer has had priority of use of the LUSH mark long before the September 19, 2012 and September 20, 2012 filing date of Applicant's applications.
10. Applicant's FRUITYLUSHUS and FRUITYLUSHUS & DESIGN marks are confusingly similar to Opposer's LUSH marks. The marks have an overall confusingly similar appearance, sound, meaning and commercial impression. Applicant's goods are highly and closely related to Opposer's goods and services.
11. Applicant's marks are deceptively similar to Opposer's marks. The marks have a confusingly similar appearance, sound, meaning and commercial impression. Consumers will mistakenly believe that Applicant's goods are offered by, affiliated with and/or sponsored by Opposer when the same is not true.
12. Due to the highly similar nature of Applicant's marks and Opposer's marks, the closely related nature of the goods provided by the respective parties, consumers and potential consumers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

13. Upon information and belief, the goods and services provided by Opposer under its LUSH marks and the goods intended to be provided by Applicant under its FRUITYLUSHUS and FRUITYLUSHUS & DESIGN marks will be promoted and sold in the same channels of trade to the same consumers or class of consumers.
14. The use and registration by Applicant of the marks FRUITYLUSHUS and FRUITYLUSHUS & DESIGN for Applicant's goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used LUSH marks, again resulting in damage to Opposer.
15. Because of the highly related nature of the goods, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, use and registration of the terms FRUITYLUSHUS and FRUITYLUSHUS & DESIGN by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.
16. Opposer's LUSH mark is famous and distinctive, and was famous prior to any first use of the FRUITYLUSHUS and FRUITYLUSHUS & DESIGN marks by Applicant. Use and registration of the FRUITYLUSHUS and FRUITYLUSHUS & DESIGN marks by Applicant will cause dilution by blurring and impair the distinctiveness of Opposer's mark.
17. If Applicant is granted registration of the marks herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged marks. Such registrations would be a source of further damage and injury to Opposer.

18. Registration of the marks shown in Application Serial Nos. 85/732,415 and 85/733,971 will result in damage to Opposer under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. § 1052, §1125 pursuant to the allegations stated above.

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

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

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

Respectfully submitted,

COSMETIC WARRIORS LIMITED,

By its attorneys,

Date: 26 JUNE 2013



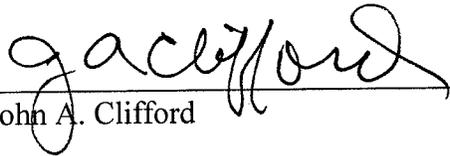
John A. Clifford
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
Tel. 612.336.4616
Fax 612.332.9081

JAC/aja

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served, via first-class mail, postage prepaid on Miracle Fruit Oil, LLC this 26th day of June 2013.

Miracle Fruit Oil, LLC
1228 Alton Rd
Miami Beach, FL 33139-3810



John A. Clifford