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

Proceeding	91212361
Party	Plaintiff Cosmetic Warriors Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Cosmetic Warriors Limited,	)	
	)	
Opposer,	)	Opposition No. 91212361
	)	
v.	)	
	)	Serial No.: 85/887,393
Sir Killian Mathew Wells,	)	Mark: <b>LUSH</b>
	)	
Applicant.	)	
	)	

**AMENDED NOTICE OF OPPOSITION**

To The Assistant Commissioner for  
Trademarks  
ATTN: BOX TTAB  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

Cosmetic Warriors Limited, a corporation duly organized and existing under the laws of the United Kingdom, with a mailing address of 29 High Street Poole, Dorset BH15 1AB, United Kingdom, believes that it will be damaged by the registration of LUSH mark shown in Application Serial No. 85/887,393, filed March 27, 2013 by Sir Killian Mathew Wells, with a mailing address of 15401 Keswick Street, Van Nuys, California 91406-2009, and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark LUSH for:

International Class 5: Caffeine preparations for stimulative use; Herbal supplements for boosting energy and relaxation; Vitamin supplement in tablet form for use in making an effervescent beverage when added to water

This application (Serial No. 85/887,393) is based on Applicant's intent-to-use of the mark in commerce.

2. Applicant's Mark published for opposition on August 13, 2013. 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.



, 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. 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.
6. Opposer has for many years sold caffeinated products, such as shower gel made with caffeine, lime juice, and chocolate. Opposer also sells a wide variety of bath products for boosting energy, promoting relaxation or treating hangovers.
7. 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 900 stores worldwide. Opposer also makes substantial sales of its products through its online retail store at [www.lushusa.com](http://www.lushusa.com).
8. Since entering the U.S. market in the mid 1990's, Opposer has consistently used the LUSH mark to identify itself, its business, its corporate identity, and its persona. This has been done in numerous ways, including but not limited to, using the single word LUSH as the store name on retail locations, using the word LUSH on packaging and labelling including shipping containers and bags in which purchased items are taken home. Consumers, customers, and others recognize that the word LUSH points uniquely

and unmistakably to Opposer as an entity. In fact, most consumers are unaware of Opposer's corporate name, Cosmetic Warriors Limited, as they simply refer to Opposer as Lush, refer to themselves as Lushies, and use the word LUSH to refer and relate exclusively to Opposer. Such consumers assume that goods or service rendered under the LUSH mark are connected with Opposer. Opposer is the prior user of the mark LUSH as the designation of identity or persona of Opposer and, there has been an association of the mark LUSH with the Opposer prior to any use of the LUSH mark by Applicant, or any constructive use date accorded Applicant through filing an intention to use application for that mark.

9. Opposer has priority with respect to the mark at issue in this opposition. Opposer has had priority of use of the LUSH mark long before the March 27, 2013 filing date of Applicant's application.
10. Applicant's LUSH mark is 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. Applicant's mark suggests a connection between Opposer and Applicant that does not exist.
11. The marks are identical. 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 mark 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. The use and registration by Applicant of the mark LUSH for Applicant's goods are likely to cause confusion or to cause mistake or the false suggestion of a connection with Opposer among consumers and potential consumers, with Opposer's previously used LUSH marks, again resulting in damage to Opposer.
14. 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 term LUSH by Applicant is likely to cause confusion, or mistake, falsely suggests a connection with Opposer, or that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, connected with or approved by Opposer causing further damage to Opposer.
15. Opposer's LUSH mark is famous and distinctive, and was famous prior to any first use of LUSH mark by Applicant and prior to any constructive use date of Applicant's intent to use application. Opposer's LUSH mark is displayed in prominent letters on the front of each of its retail stores, operated from coast to coast in the United States. The retail locations are visited by the general population of the United States who have seen and come to know the LUSH mark through such advertising, promotion, and wide spread use. Opposer also uses the mark on its website, on packaging and advertising, and in other ways customary in the trade. Such common, widespread, and open use among the general population of the country has created and enhanced the fame of the LUSH mark. Use and registration of the LUSH mark by Applicant will cause dilution by blurring and impair the distinctiveness of Opposer's mark.

16. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer, and could bar Opposer from obtaining a registration of its LUSH mark for additional goods or services, and could dilute Opposer's mark.

17. Registration of the mark shown in Application Serial No. 85/887,393, 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 this application be sustained and that the registration of the proposed mark LUSH 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

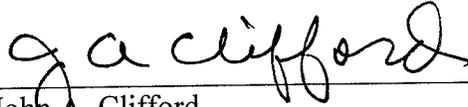
Opposer hereby appoints: John A. Clifford; Danielle I. Mattessich; Heather Kliebenstein, Brian H. Batzli; Gregory C. Golla; Scott W. Johnston; Andrew S. Ehard; Christopher J. Schulte; and Brent Routman as its attorneys with the full power to represent the Opposer in connection with this proceeding.

Respectfully submitted,

COSMETIC WARRIORS LIMITED,

By its attorneys,

Date: Dec 5, 2013

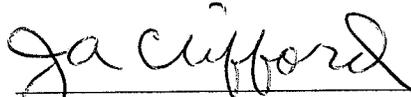


John A. Clifford  
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P.O. Box 2910  
Minneapolis, MN 55402-0910  
Tel. 612.336.4616  
Fax 612.332.9081

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **AMENDED NOTICE OF OPPOSITION** was served via email this 5<sup>th</sup> day of December 2013.

Sir Killian Mathew Wells  
pr@infenorecords.com

  
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John A. Clifford