

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

In the Matter of Trademark Registration No. 2,337,607)	75545666
For the Mark: WET 'N' WILD U.S.A.)	
Registered: April 4, 2000)	
)	
Mirage Cosmetics, Inc.,)	
Petitioner,)	Cancellation No. _____
)	
v.)	
Markwins Beauty Products, Inc.,)	
Registrant)	
)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
BOX TTAB FEE
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

Mirage Cosmetics, Inc. ("Petitioner"), a corporation of the State of Maryland, with an address at 10721 Tucker St., Beltsville, MD 20705 is being damaged by the continuing registration of the trademark WET 'N' WILD U.S.A. ("the Trademark") for "Cosmetics, namely, pressed powder; mascara applicator containing mascara; eyeliner/eyebrow and eye shadow and lipliner pencils; loose powder; powder and cream eyeshadow; liquid make-up; make-up cover sticks; make-up kits consisting primarily of cream and/or powder blusher and/or eyeshadow; powder blusher; lipstick; liquid lipstick; lip gloss; nail polish; nail strengthener; and press-on nails," Reg. No. 2,337,607, registered on the Principal Register of the U.S. Patent and Trademark Office, and hereby petitions to cancel the same.



08/05/2005 HPHHM1 00000070 2337607

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08-01-2005

To the best of Petitioner's knowledge, the name and address of the current owner of Registration No. 2,337,607 is Markwins Beauty Products, Inc. ("Registrant"), 22067 Ferrero Parkway, City of Industry, CA 91789.

As grounds for cancellation it is alleged that:

1. To the best of Petitioner's knowledge, Registrant's predecessor filed a trademark application for the Trademark on August 31, 1998.
2. In support of that application, Registrant's predecessor submitted a specimen showing a label from a bottle of its nail polish, a copy of which is attached hereto as Exhibit A.
3. A magnified copy of that specimen, attached hereto as Exhibit B, reveals a MADE IN U.S.A./FABRIQUE AUX E.U. designation.
4. In an office action dated March 19, 1999, a copy of which is attached hereto as Exhibit C, the United States Patent and Trademark Office requested that Registrant's predecessor enter a disclaimer of the exclusive right to the term "U.S.A." apart from the mark as shown, on the ground that "applicant's goods come from the geographical place named in the mark."
5. In a response to that office action dated August 15, 1999, Registrant's predecessor, through its counsel, agreed to disclaim "U.S.A." apart from the mark as shown.
6. On May 23, 2005, Registrant filed its Combined Declaration of Use and Incontestability Under Sections 8 & 15 with the PTO, attesting to the continued use and non-infringement of the Trademark.
7. In support of this Declaration, Registrant submitted as a specimen a display showing use of products sold under the Trademark, a copy of which is attached hereto as Exhibit D, but did not submit a specimen showing use of the Trademark on any particular goods.

8. Upon information and belief, as of at least as early as the date of the filing of Registrant's Combined Declaration of Use and Incontestability Under Sections 8 & 15 for the Trademark, most products sold by Registrant bearing the Trademark have been manufactured in China. Attached hereto as Exhibit E are photographs of nail polish, lipstick, mascara, liquid makeup, cover stick, powder blusher, cream blusher, lip gloss, and eyebrow pencils, all bearing the trademark and a "Made in China" designation.

9. Upon information and belief, Registrant sells other products bearing the Trademark that are manufactured in other countries outside the United States. Attached hereto as Exhibit F is a photograph of an eyeliner pencil bearing the Trademark and a "Made in Mexico" designation. Attached hereto as Exhibit G is a photograph of a lipliner pencil bearing the Trademark and a "Made in Brazil" designation.

10. The Trademark is geographically deceptive under Section 2(a) of the Trademark Act (15 U.S.C. § 1052(a)) because (1) it incorporates a term, U.S.A., that denotes a geographical location which is neither obscure nor remote; (2) there is an association between the goods on which the mark is used and the U.S.A.; (3) the goods do not, in fact, originate in the U.S.A.; and (4) the misdescription is likely to affect the customer's purchasing decision.

11. The incontestable status of Reg. No. 2,337,607 was obtained fraudulently by Registrant through its intentionally concealing from the PTO the change in location of the manufacturing of products bearing the trademark. In Registrant's May 23, 2005 submission of its Combined Declaration of Use and Incontestability Under Sections 8 & 15 for the Trademark, Registrant knowingly and intentionally submitted a specimen (as shown in Exhibit D) that would prevent the PTO from discovering that the products identified by the Trademark have been and are being manufactured outside the United States, thus subjecting the Trademark to cancellation

under Sections 2(a) and/or 2(e)(3) of the Trademark Act. Had Registrant submitted a specimen showing the Trademark as used on the products bearing the Trademark as shown in Exhibits E, F and G but not made in the U.S.A., the PTO would have or should have rejected the specimens and cancelled the registration under Sections 2(a) and/or 2(e)(3) because the Trademark is geographically deceptive. Registrant's fraud is reflected further in its near-contemporaneous filing on May 19, 2005, of U.S. Trademark Application Serial No. 78/633,599, for the mark WET N WILD, for which it submitted specimens of products that bear the same WET 'N' WILD U.S.A. mark depicted in the Trademark (attached hereto as Exhibit H) -- but which are all manufactured, as more studious examination shows, in China. Photographs showing the origin of some of the products depicted in Exhibit H are attached as Exhibit I.

12. Petitioner is being injured by the continued registration of the Registration for WET 'N' WILD U.S.A. because Registrant's goods are made in China, Mexico and Brazil, and not in the United States, and the Registration misleads the public as to the national origin of the goods identified by the WET 'N' WILD U.S.A. trademark.

13. The registration of Registrant's WET 'N' WILD U.S.A. trademark and its incorporation of the "U.S.A." element bestows upon Registrant's product an element of patriotism (i.e., a subtly whispered "Buy American") with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product, when, in fact, it is not manufactured in the United States.

14. Petitioner is being further injured because Petitioner manufactures products that are competitive with those of Registrant and Petitioner's products are actually made in the United States and are promoted as being made in the United States.

WHEREFORE, Petitioner believes that it will be damaged by the continuing registration of registrant's said designation and prays that Registration No. 2,337,607 be cancelled under Section 2(a) and Section 14(c) of the Trademark Act.

Please recognize as attorneys for Petitioner in this proceeding, Marc C. Levy, and the law firm of Preston Gates & Ellis LLP, 925 Fourth Avenue, Suite 2900, Seattle, Washington, 98104.

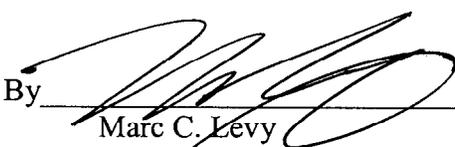
Please address all communications to Marc C. Levy, at Preston Gates & Ellis LLP.

The filing fee believed to be in the amount of \$300.00 is enclosed herein.

DATED this 15th day of August, 2005.

MIRAGE COSMETICS, INC.

By



Marc C. Levy

Attorneys for Petitioner
PRESTON GATES & ELLIS LLP
925 Fourth Ave., Suite 2900
Seattle, WA 98104
(206) 623-7580

CERTIFICATE OF MAILING

I hereby certify that this PETITION FOR CANCELLATION is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to BOX TTAB FEE, Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on the below date.

Date: 8-1-05

Name: Corinne Boyer

EV297815315US



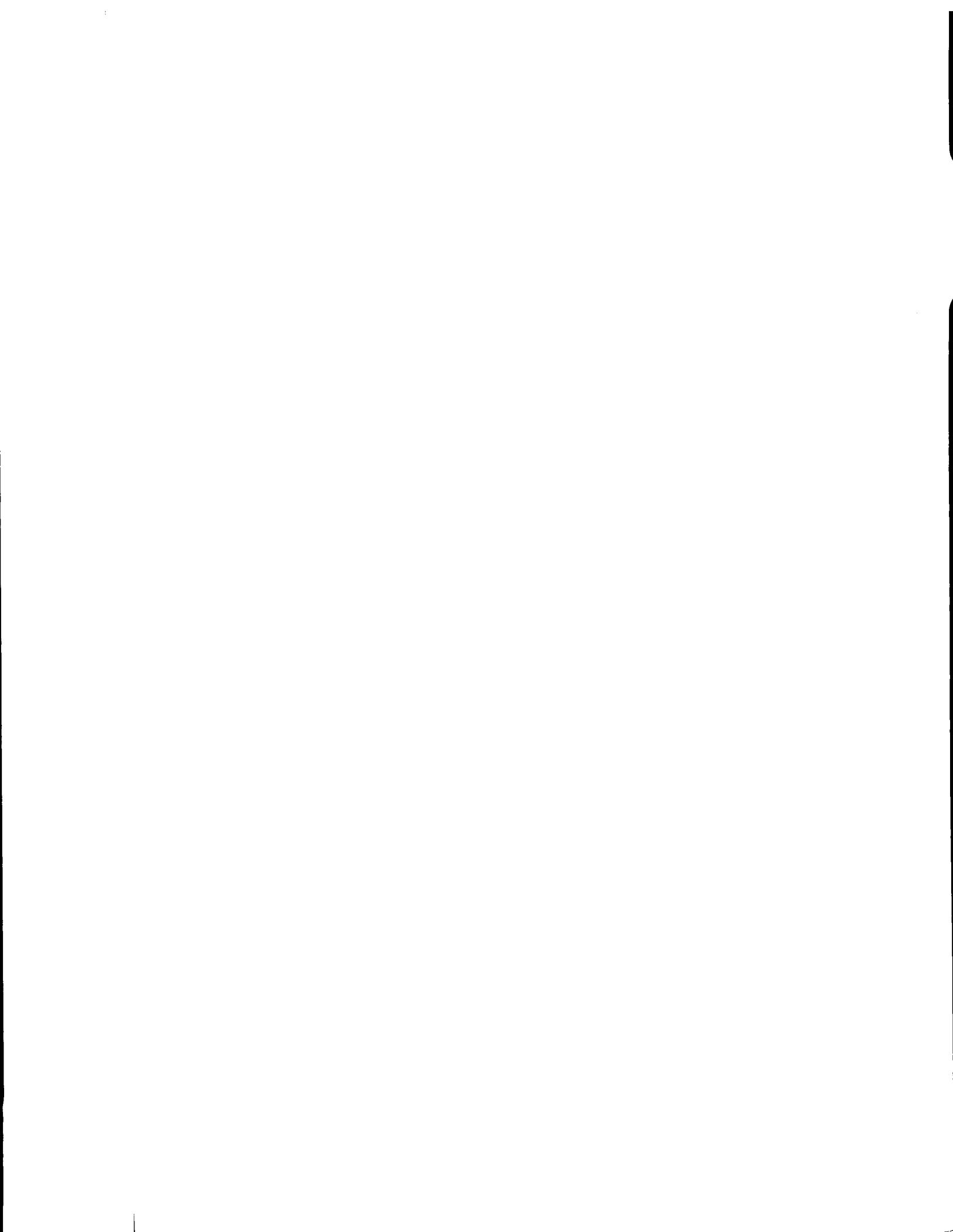
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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

SERIAL NO. 75/545666 Pavior Limited		APPLICANT		PAPER NO.	
MARK WET 'N' WILD U.S.A.		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513		If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
ADDRESS LAWRENCE D. MANDEL, 1400 RIVER AVENUE, LAKEWOOD, NEW JERSEY 08701		ACTION NO. 01		Please provide in all correspondence:	
MAILING DATE 03/19/99		REF. NO.		1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	
FORM PTO-1525 (5-80)		U.S. DEPT. OF COMM. PAT. & TM OFFICE			

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

FIRST OFFICE ACTION

RE: Serial Number: 75/545666 WET 'N' WILD U.S.A.

The assigned examining attorney has reviewed the referenced application and determined the following.

Likelihood of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1158712 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ

WLD
(08)

823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The registered mark is *WET 'N WILD* and the applicant is seeking to register the mark *WET 'N' WILD U.S.A.* The marks are virtually identical in sound, appearance, meaning and connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). Here, the marks are confusingly similar on all accounts, when similarity as to one would be sufficient.

In addition to the marks being confusingly similar, the goods are highly related. The registrant's goods are "lipsticks" and the applicant's goods are "cosmetics, namely, lipstick, liquid lipstick, lip gloss" among other cosmetics. The goods are the types of goods that are directed to the same class of purchasers and flow from the same channels of trade. Therefore, consumers would be likely to mistakenly believe that the goods emanate from one common source and somehow associate the goods with the same producer.

In sum, given that the marks are confusingly similar and the goods are highly related, a likelihood of confusion exists. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988). Therefore, the examining attorney refuses registration on the Principal Register.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Identification of Goods

The identification of goods is indefinite because the applicant uses the wording "including." The identification of goods must be specific. The applicant should amend the identification to replace this wording with "namely." 37 C.F.R. Section 2.71(b); TMEP sections 804 and 804.08(c).

The applicant may amend this wording to "cosmetics, namely, pressed powder; mascara applicator containing mascara; eyeliner/eyebrow and eyeshadow and lipliner pencils; loose powder; powder and cream eyeshadow; cosmetic applicators; liquid make-up; cover stick; make-up kits, *namely*, cream and/or powder blusher and or eyeshadow; powder blusher; lipstick; liquid lipstick; lip gloss; nail polish, *namely*, ridge filler; nail wrap; nail strengthener; nail mending glue; press-on nails.

Prior Registrations

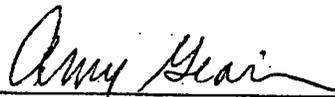
In addition, if the applicant is the owner of Registration Nos. 1867916, 1848183, 1437881, and 1434748, the applicant must submit a claim of ownership. 37 C.F.R. Section 2.36; TMEP section 812.

Disclaimer

Furthermore, the applicant must disclaim the geographically descriptive wording "U.S.A." apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.02(a). The wording is primarily geographically descriptive because the primary significance of the term "U.S.A." is geographic, and applicant's goods come from the geographical

place named in the mark. Therefore, a public association of the goods with the place is presumed. *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Amy Gearin
Trademark Attorney
Law Office 107
(703) 308-9107 ext. 159

*** User:-EX79949 *** Serial Number: 73230858 ***

Word Mark

WET 'N WILD

Pseudo Mark

WET WILD

Goods/Services

IC 003; US 051; G & S: Lipsticks; FIRST USE DATE: 1978.03.10; FIRST USE IN
COMMERCE: 1978.03.10

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

73-230858

Filing Date

1979.09.10

Registration Number

1158712

Registration Date

1981.06.30

Owner Name/Address

(REGISTRANT) 7-11 Sales Inc. CORPORATION NEW YORK 14 Cairngorm Rd. New
City NEW YORK 10956

Owner Name/Address

(LAST LISTED OWNER) SANGERS PUBLIC LIMITED COMPANY CORPORATION ASSIGNEE OF
UNITED KINGDOM 60 KNIGHTSBRIDGE LONDON SW1 UNITED KINGDOM

Type of Mark

TRADEMARK

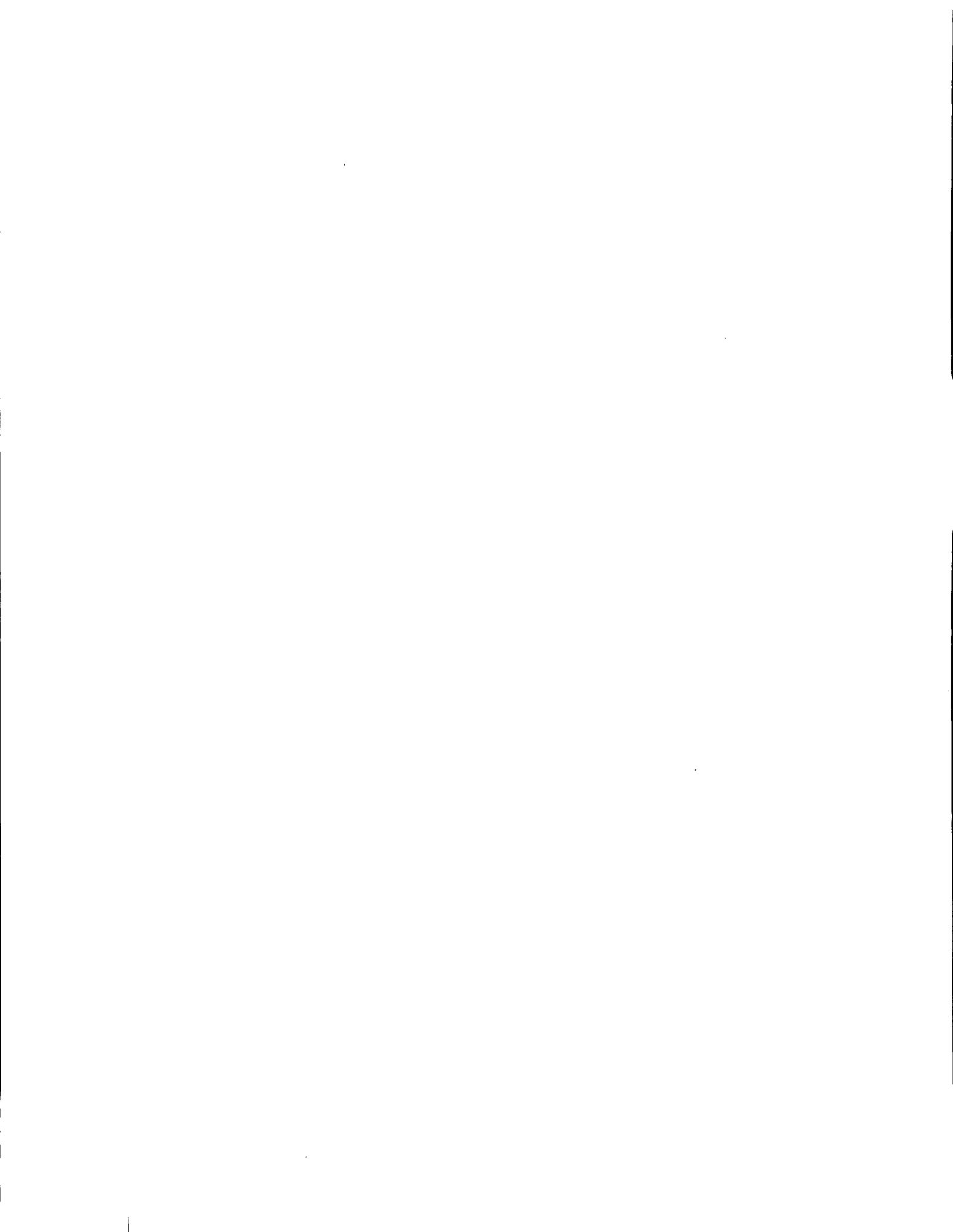
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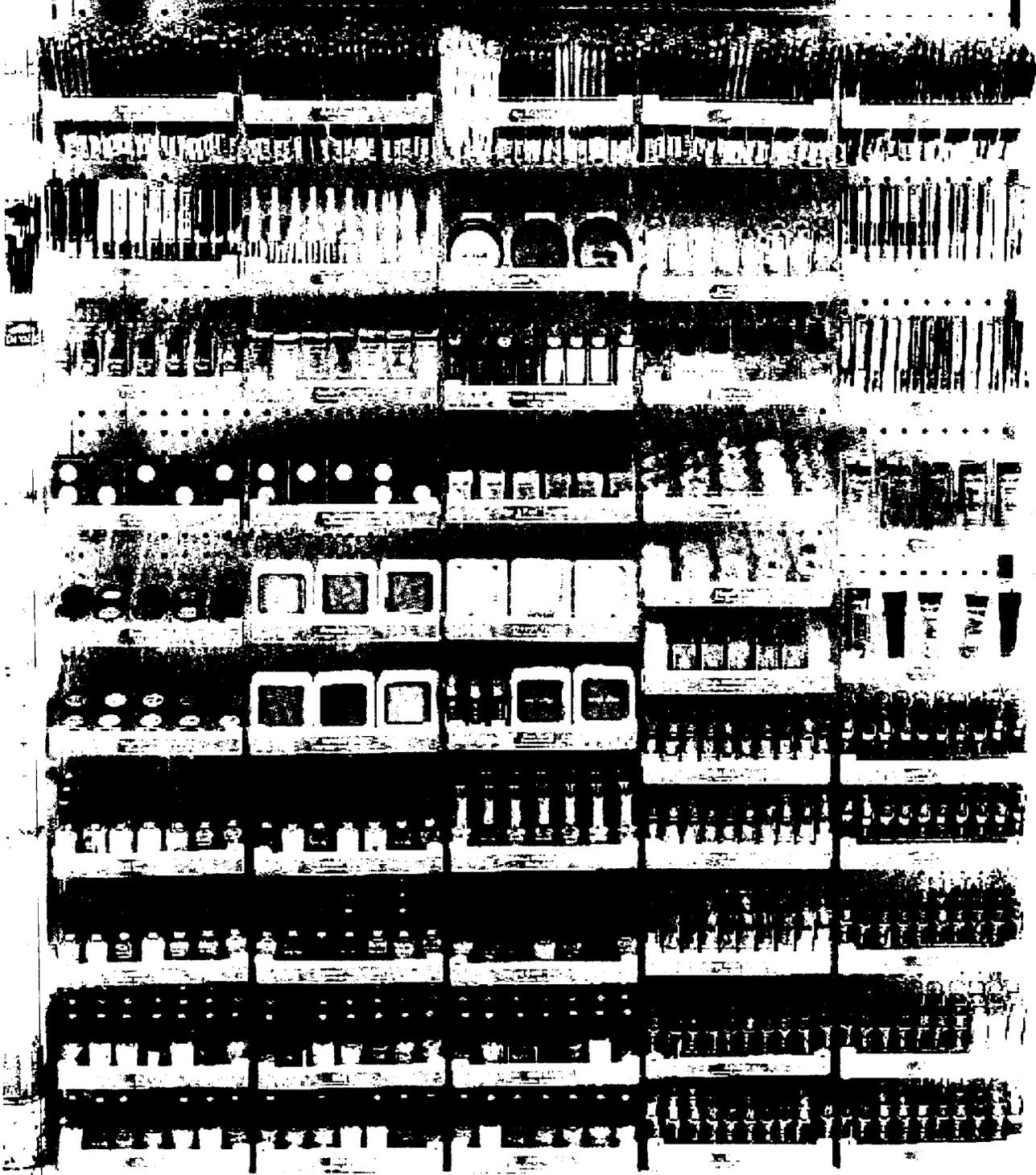
PRINCIPAL

Affidavit

SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

*** Search: 2 *** Document Number: 14 ***





48" WNW



Wet 'n' Wild[®]
U.S.A.

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COLOR

Vernis à
ongles

1.0 oz. / 14 ml. e

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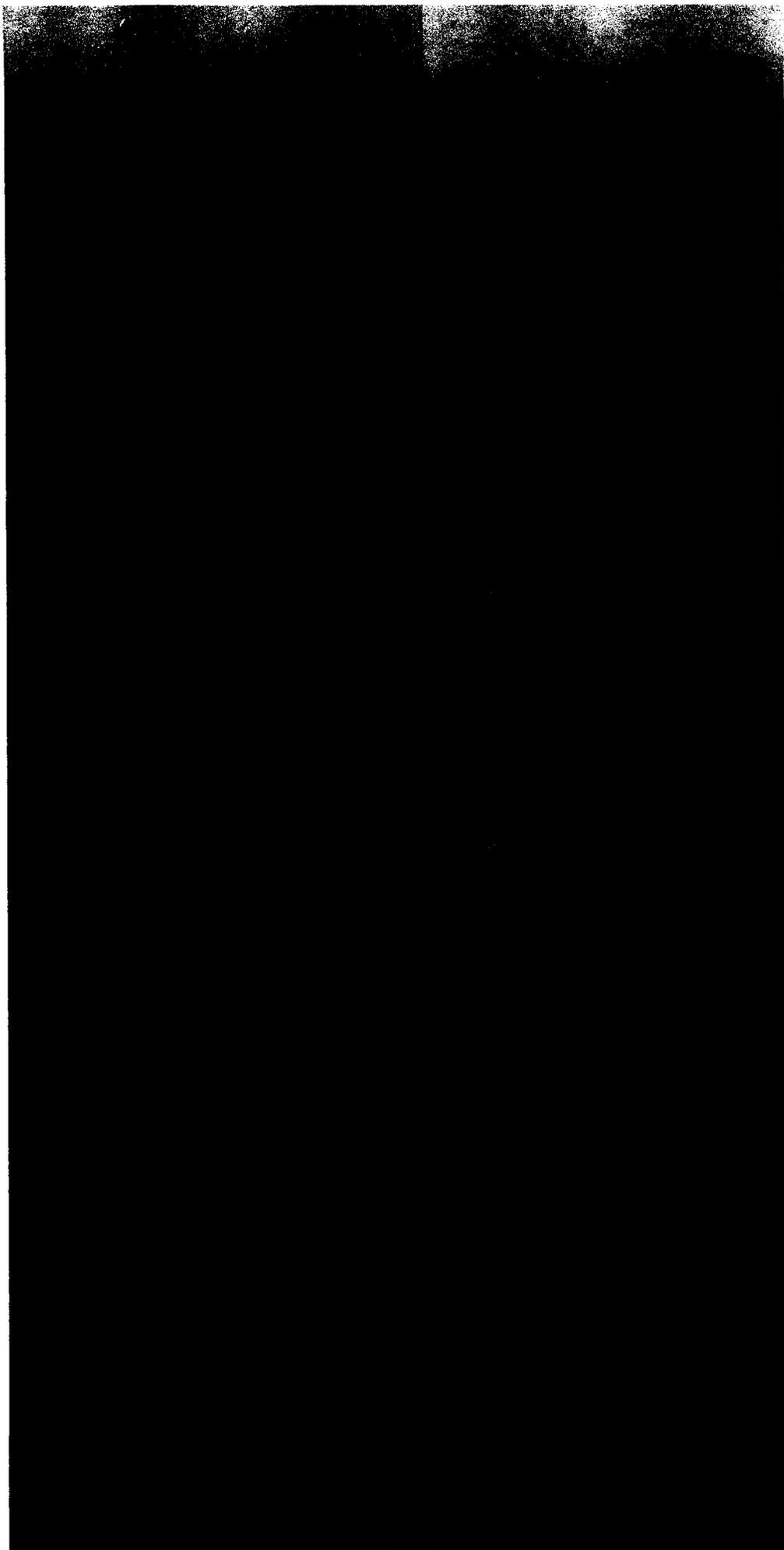
INDUSTRIE, CA 91788 USA. MADE IN CHINA / FABRIQUE IND. CHINE
AVOID HEAT & FLAME / ÉLOIGNER DE LA CHALEUR ET DE FLAMME

SALES DIVISION, FORT WORTH, TEXAS

INDUSTRY, CA 91789 USA MADE IN CHINA / FABRIQUE AUX CHINE

AVOID HEAT & FLAME / ÉLOIGNER DE LA CHALEUR ET DE FLAMME





1000 10 Wink
MeowWink™

Net Wt 0.3 Oz

Made in China

Senegal

ENTS - WATER (ASHTA) (1977) (1977) (1977)
OF COMPASSION (WATER) (1977) (1977) (1977)





Made in China

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Bare/Chair

1. 100% pure natural **smooth skin**

2. 100% pure natural **fresh**

3. 100% pure natural **locking skin**

4. 100% pure natural

5. 100% pure natural

6. 100% pure natural

7. 100% pure natural **cucumber extract**

8. Shake well, apply and blend with

9. 100% pure natural

10. **resserrement de la peau unique**

11. **lisse, magnifiquement naturel.**

12. **une peau douce, d'apparence saine**

13. 100% pure natural

14. **plantes.**

15. 100% pure natural

16. **Égypte et extrait de concombre.**

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Le crime de maquillage

Par **YVES ROYER** - **Maître à Paris**

Le maquillage est un art. Mais il est aussi un crime. Un crime qui se commet tous les jours, dans tous les pays, dans toutes les villes.

NOI LESIED UN ANIMAL

NOI LESIED SUR DES ANIMAUX



802 Medium/Moyen

(Caster) Seed Oil, Ozocerine
Cereals (Paraffinum Liquidum)
Carnauba (Carnauba) Wax
Ascorbyl Palmate
77491 77492 77499
Made in China - Fabriqué en Chine

(Castor) Seed Oil, U.S.P.

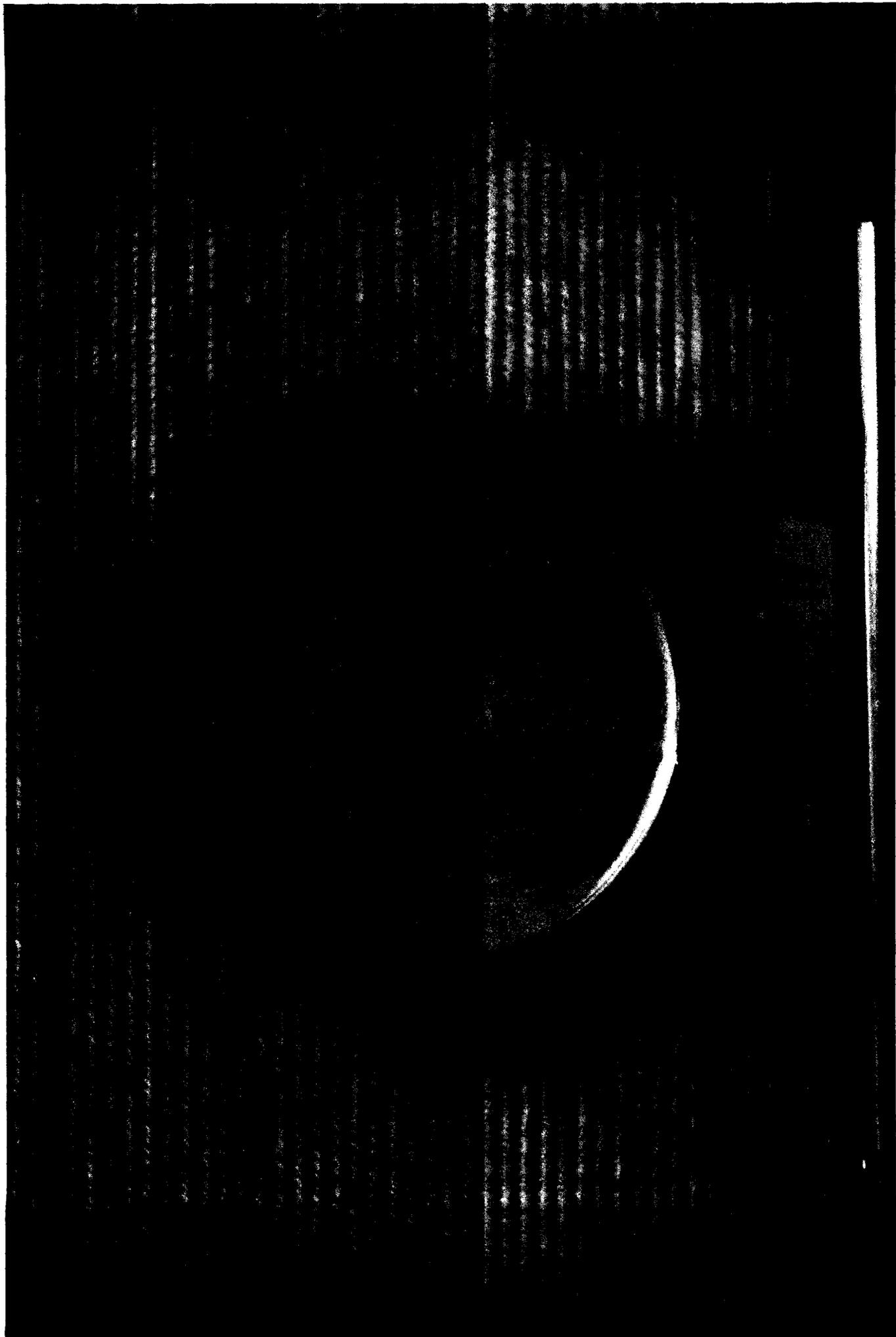
Mineral (Paraffinum Liquidum)

Carnauba (Carnauba) Wax

Ascorbyl Palmitate

77491 77492 77499

Made in China



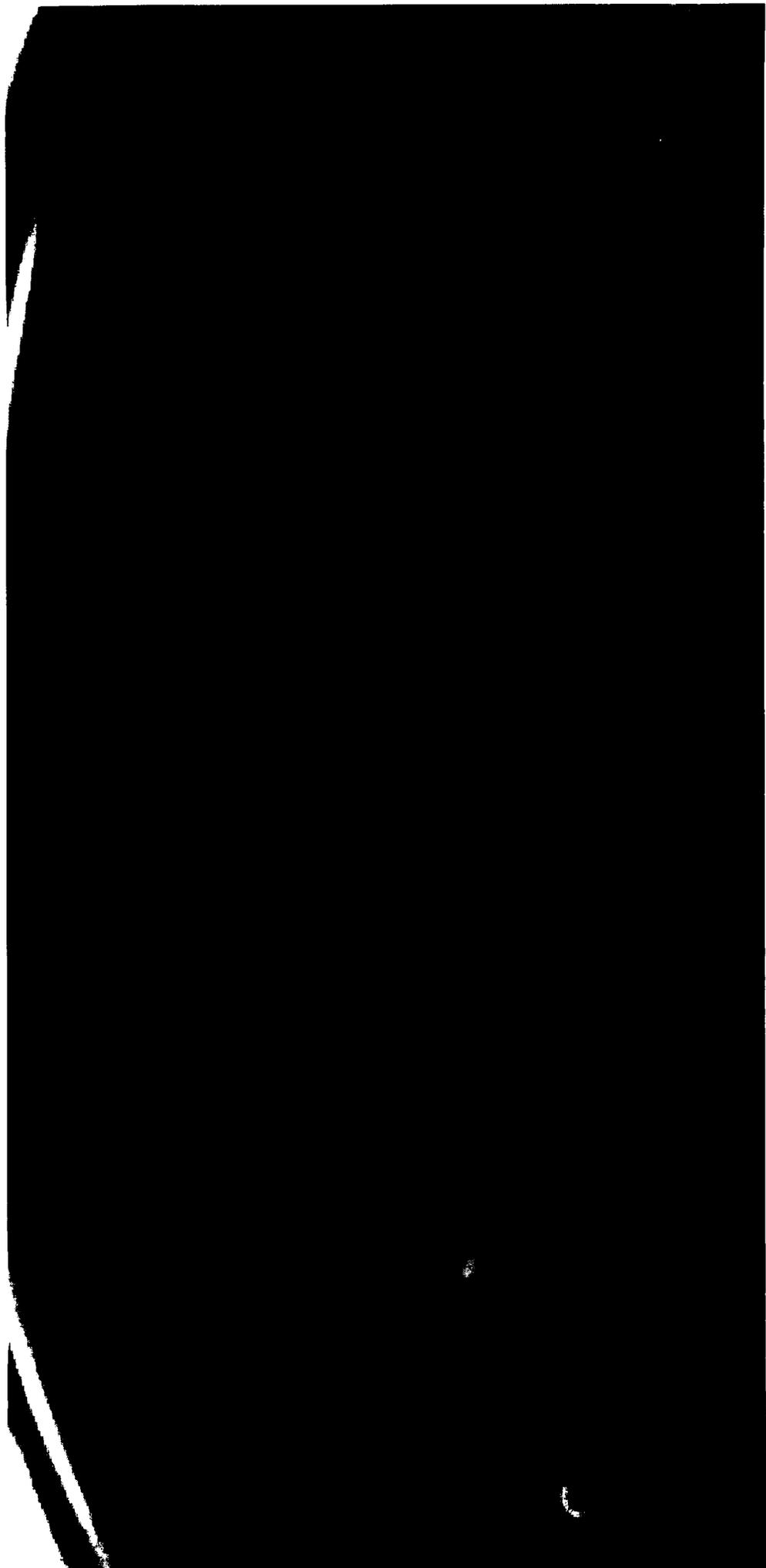


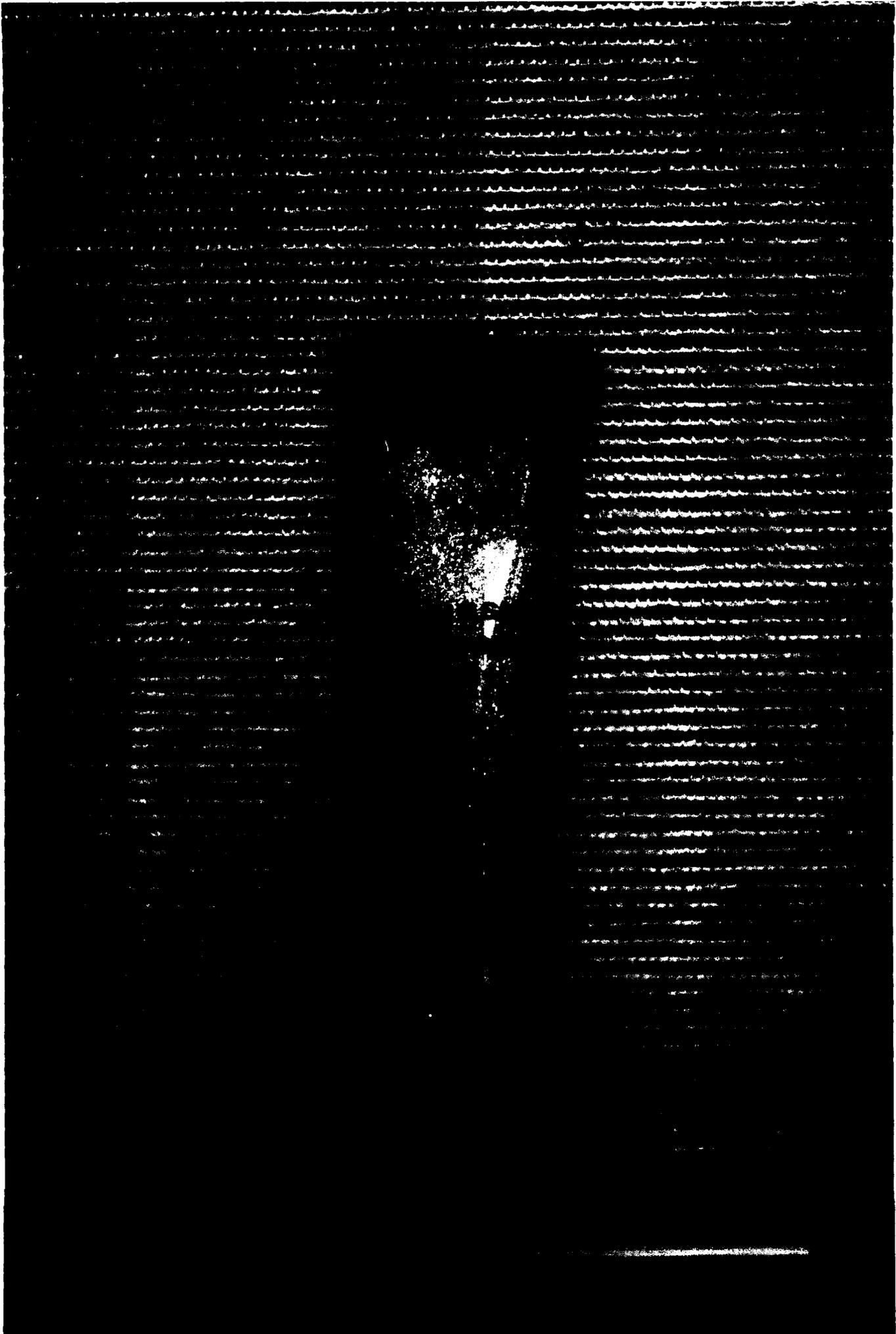
341 Bushing / Rougissante

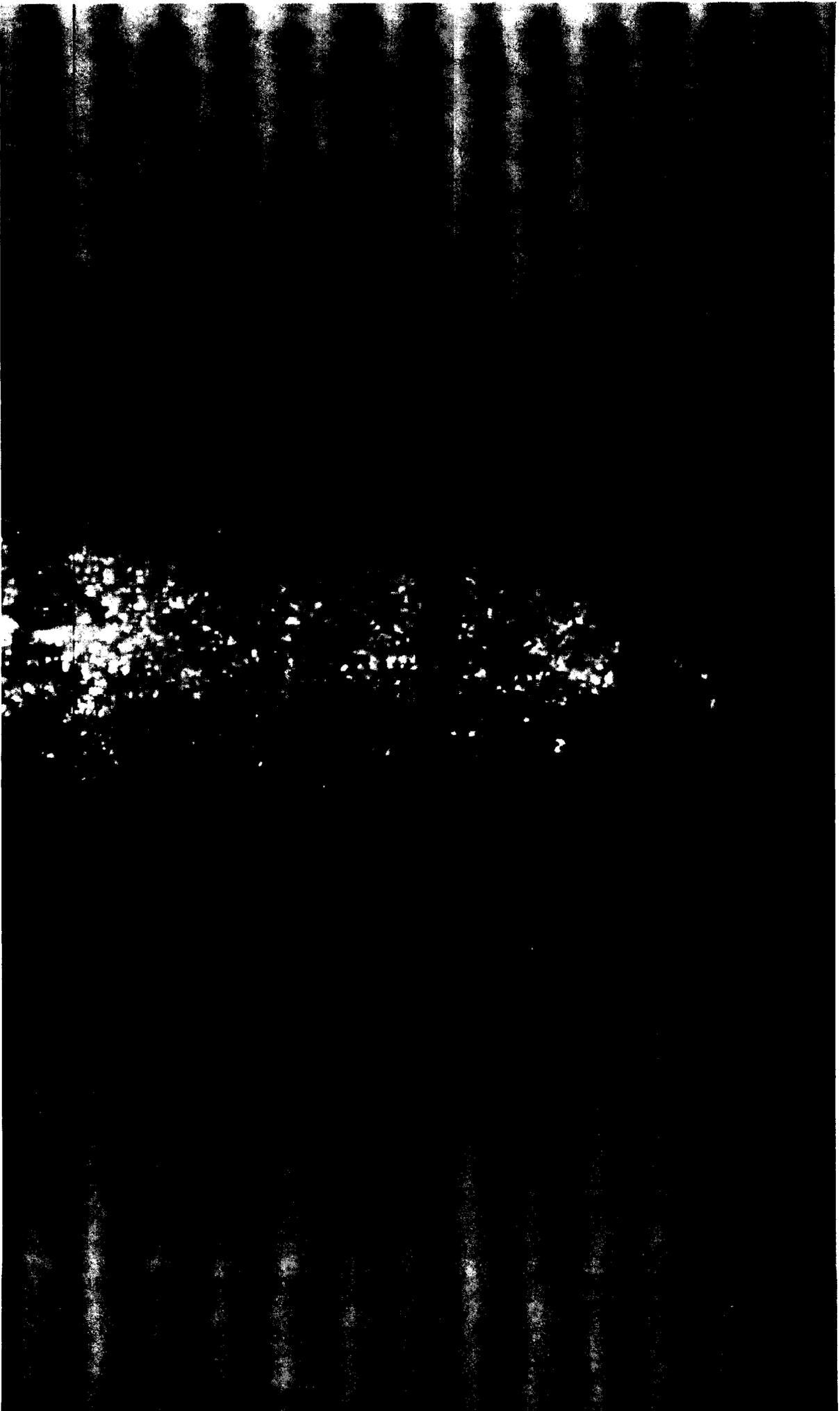


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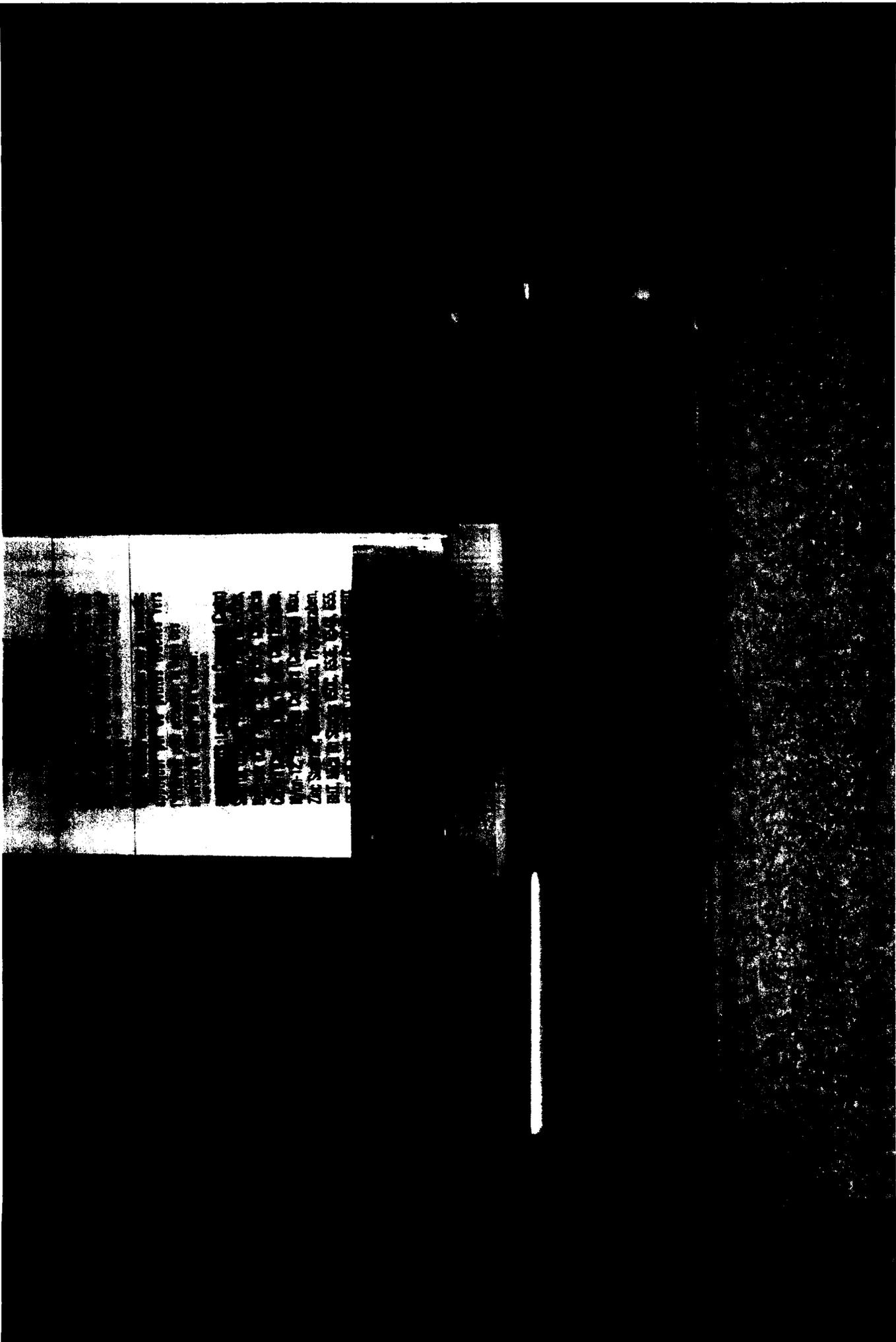


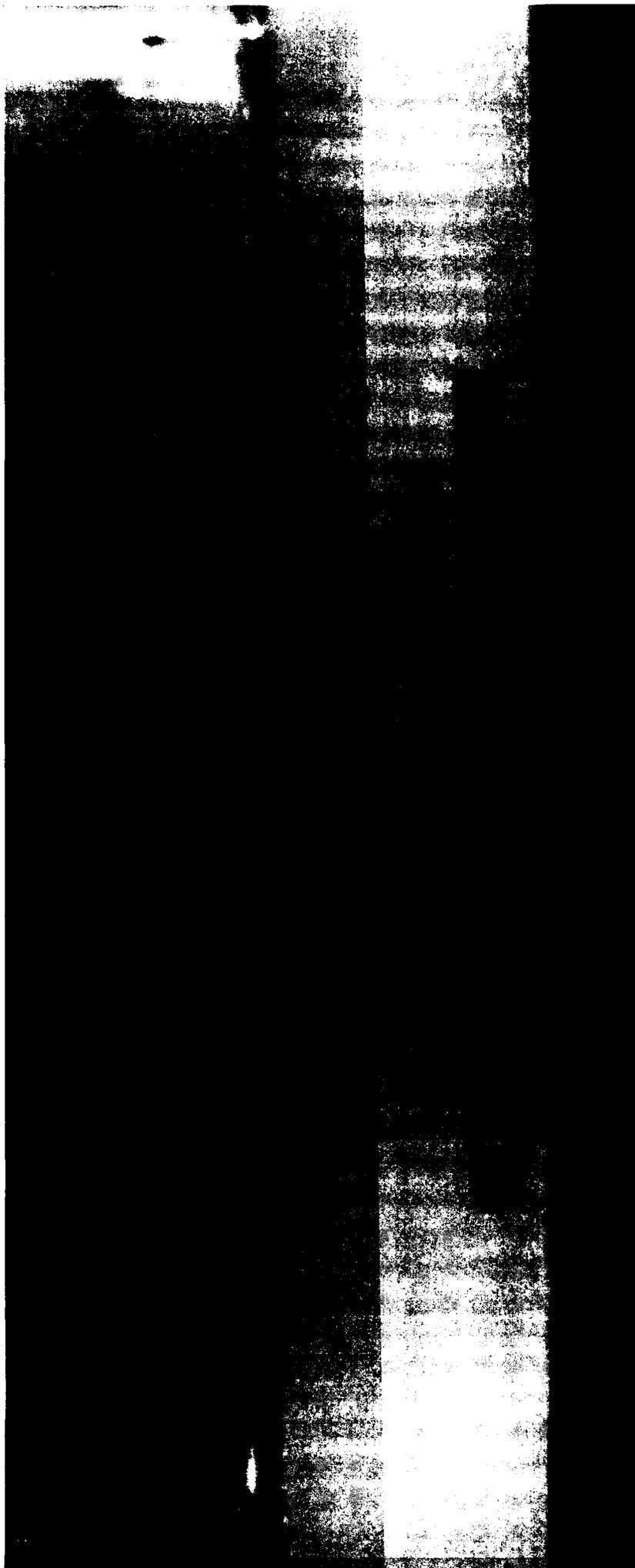




NEW
FORMULA
nouveau

you/sourcels
Black/Noir

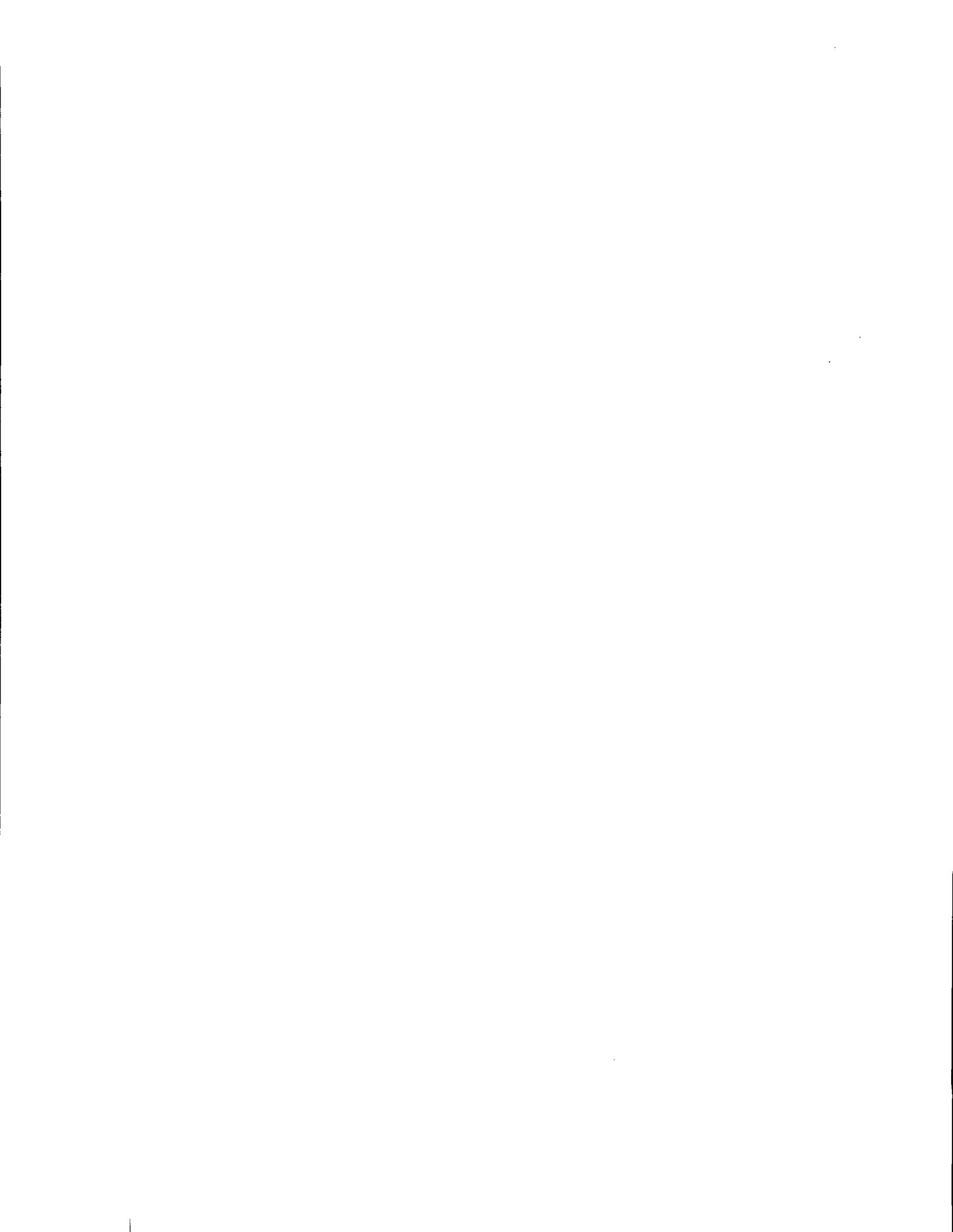






659 6.104-50' 6.1014 Net wt / Poids net 0.04 oz / 1.40 Made in Mexico/Fait en Mexique

Made in Mexico/Fait en Mexique



711

711 G. lot 'w' G. lild ☺

Net wt / Poids net 0.040z. / 1.40

Made in Brazil / Fait au Brésil

Made in Brazil / Fait au Brésil



Wet 'n' Wild®

Discover Your Wild Side!

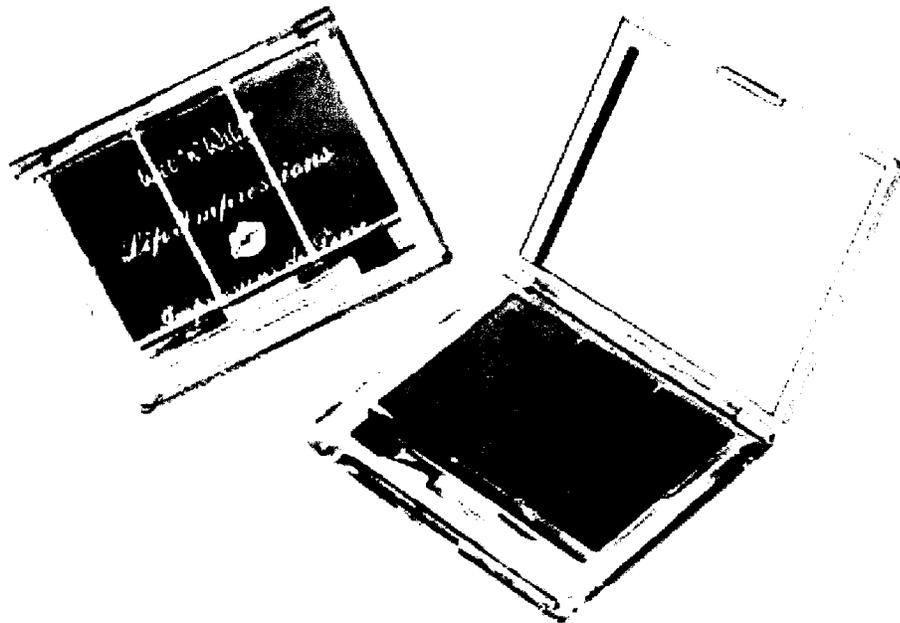
FACE STYLING BRUSH KIT

A must-have quintet of the makeup brushes you use most – in one clever kit sized to fit snugly in your cosmetic bag. Includes blush brush, lip brush, eyeliner brush, shadow brush, and angle-cut shadow brush.



LIP IMPRESSIONS

Seven beauty tools. One very bright idea. With this sleek new compact tucked away in your pocket or purse, you're ready to glow anywhere! Inside: four Wild Shine lipcolors, a MegaGlo Face Illuminator to touch on anywhere, plus full-size mirror and dual-ended applicator with small and medium brushes.



Wet 'n' WildTM
Discover Your Wild Side! USA

BRONZZERTM COMPACT

Look like a sun goddess — without the sun damage! Bronzzer adds a healthy believable glow you can keep year-round. Day or night, brush just a touch of color on cheeks, forehead and nose for a light, sun-kissed effect, or dust a bit more all over to create a richer tanned look.



Wet 'n' Wild®
Discover Your Wild Side! USA

DUAL PENCIL SHARPENER

This smart little beauty tool combines two sharpeners — one for thick pencils, another for thin. Razor-sharp blades keep pencils perfectly shaped, so you're always in control.





Wet 'n' Wild®
Discover Your Wild Side! USA

EYELASH CURLER

Don't let its small size fool you! This compact eyelash curler packs a whole lot of power. It's specially designed to throw even the most stubbornly straight lashes a curve, without pinching or pulling surrounding skin. Take it along — you never know when you'll need some extra flirty curl!

