

ESTTA Tracking number: **ESTTA676003**

Filing date: **06/03/2015**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Young Living Essential Oils, LC		
Entity	Limited liability company	Citizenship	Utah
Address	3098 Executive Parkway Lehi, UT 84043 UNITED STATES		

Attorney information	H. Matthew Horlacher Holland & Hart LLP 222 S Main St Ste 2200 Salt Lake City, UT 84101 UNITED STATES docket@hollandhart.com, mhorlacher@hollandhart.com, separk-er@hollandhart.com, sapessey@hollandhart.com, LYHsu@hollandhart.com Phone:801-799-5825
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Registration Subject to Cancellation

Registration No	3931264	Registration date	03/15/2011
Registrant	Cosmed, Inc. Suite 102 Braselton, GA 30517 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2011/01/14 First Use In Commerce: 2011/01/14 All goods and services in the class are cancelled, namely: COSMETICS, NAMELY, LIP ENHANCERS; COSMETIC FACIAL AND BODY SKIN CARE PRODUCTS, NAMELY, SCRUBS, MASKS, CLEANSERS, LOTIONS, SPRAYS, CREAMS, GELS, SERUMS, TONERS, MOISTURIZERS AND SUN SCREEN
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Grounds for Cancellation

Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof	Trademark Act section 2(b)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)

Attachments	Petition to Cancel Y.L.SKIN.pdf(110590 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	/hnh/
Name	H. Matthew Horlacher
Date	06/03/2015

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

Young Living Essential Oils, LC, Petitioner, v. Cosmed, Inc., Respondent.	Cancellation No.: Mark: Y.L.SKIN Reg. No. 3,931,264
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PETITION FOR CANCELLATION

Young Living Essential Oils, LC (“Petitioner”), a limited liability company of the state of Utah, having a business address of 3125 W. Executive Parkway, Lehi, Utah, 84043 believes that it is being damaged by and will continue to be damaged by the continued registration of the mark Y.L.SKIN (“Registered Mark”) shown in U.S. Trademark Registration No. 3,931,264 for “*cosmetics, namely, lip enhancers; cosmetic facial and body skin care products, namely, scrubs, masks, cleansers, lotions, sprays, creams, gels, serums, toners, moisturizers and sun screen,*” in Class 3, and petitions to cancel it. As grounds for its Petition, Petitioner alleges that, upon actual knowledge with respect to itself and its own actions, and upon information and belief as to other matters:

1. Petitioner is a producer and distributor of essential oils, as well as cosmetic, haircare, oral hygiene, and skincare products in the United States.
2. On April 9, 2014, Petitioner filed an application to register the mark YL & Design



based on Section 1(b) covering “*essential oils; massage oils; fragrances; hair care*”

preparations; hair shampoos and conditioners; bar soap; hand soaps; shower gel; body deodorants; cosmetics; non-medicated skin care preparations; skin creams; skin moisturizer; skin lotions; pet shampoo; toothpaste and mouthwashes; all-purpose cleaners; essential oils for aromatherapy use” in International Class 3. The application was assigned Serial No. 86/246880 (“Petitioner’s Application”).

3. In a priority Office Action dated June 5, 2014, the Trademark Examining Attorney cited the Registered Mark as a bar to Petitioner’s Application under Section 2(d) of the Trademark Act.

4. Petitioner submitted arguments against the Section 2(d) refusal on December 2, 2014.

5. On January 5, 2015, the Trademark Examining Attorney made the Section 2(d) refusal final.

6. Upon information and belief, Respondent is a Georgia corporation with a principal place of business at 6342 Grand Hickory Drive, Suite 102, Braselton, Georgia 30517.

COUNT I

Registration Procured by Fraud under 15 U.S.C. § 1064(3)

A. Fraudulent Allegation of Use in Commerce

7. Upon information and belief, Respondent submitted a Statement of Use with the U.S. Patent & Trademark Office (“USPTO”) for Registration No. 3,931,264 on January 14, 2011, in which it declared, under oath, that “Applicant...is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.”

8. Upon information and belief, and based on investigation of Respondent’s business, Respondent had not used the Registered Mark in commerce prior to the filing of

Respondent's Statement of Use on January 14, 2011, and has never used the Registered Mark in commerce in connection with the goods identified in Registration No. 3,931,264.

9. Upon information and belief, and based on investigation of Respondent's business, Respondent's alleged January 14, 2011 date of first use and first use in commerce listed in Registration No. 3,931,264 are based on Respondent's false statements as to its bona fide use of the Registered Mark in the ordinary course of trade and the first use dates of the Registered Mark.

10. Upon information and belief, and based on investigation of Respondent's business, Respondent made the false statements as to the use of the Registered Mark in commerce and the first use dates of the Registered Mark with the intent to procure a registration to which Respondent was not entitled, and Respondent was successful in procuring a registration.

11. Upon information and belief, and based on investigation of Respondent's business, Respondent's false statements were made knowingly. Respondent made knowing false statements as to the use of its Registered Mark in commerce and the first use dates of that mark with the intent to procure a registration to which Respondent was not entitled, and Respondent was successful in procuring a registration.

12. Accordingly, Respondent's application to register the Registered Mark was materially false, made in bad faith, and made in a concerted attempt to perpetrate a fraud upon the USPTO.

13. As a result of this fraud, Respondent's Registration No. 3,931,264 was invalidly obtained and should be cancelled.

B. Fraudulent Specimen of Use

14. Applicant submitted an alleged specimen of use on January 14, 2011. The alleged specimen consisted of a photograph of a shipping label displaying the mark in connection with

the alleged sale of the goods recited in Registration No. 3,931,264. The Statement of Use also included a signed declaration stating: “The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 01/14/2011, and first used in commerce at least as early as 01/14/2011, and is now in use in such commerce.”

15. Upon information and belief, and based on investigation of Respondent’s business, the specimen of use that Respondent submitted in support of Registration No. 3,931,264 is a photo of a token or nominal use of the Registered Mark. Upon information and belief, and based on investigation of Respondent’s business, in reality, Respondent never made any bona fide use of the Registered Mark in the ordinary course of trade, and Respondent’s token use was made merely to reserve rights in the Registered Mark.

16. Upon information and belief, and based on investigation of Respondent’s business, the alleged specimen of use filed on January 14, 2011 was not in use in commerce at least as early as January 14, 2011, the filing date of the Statement of Use, and the first use date set forth in Registration No. 3,931,264.

17. Upon information and belief, and based on investigation of Respondent’s business, Respondent made the false statements as to the use of the specimen with the intent to procure a registration to which Respondent was not entitled, and Respondent was successful in procuring Registration No. 3,931,264.

18. Upon information and belief, and based on investigation of Respondent’s business, Respondent’s false statements were made knowingly. Respondent made knowing false statements as to the use of the specimen with the intent to procure a registration to which Respondent was not entitled, and Respondent was successful in procuring Registration No. 3,931,264.

19. Accordingly, Respondent's application to register the Registered Mark was materially false, made in bad faith, and made in a concerted attempt to perpetrate a fraud upon the USPTO.

20. As a result of this fraud, Respondent's Registration No. 3,931,264 was invalidly obtained and should be cancelled.

COUNT II

Lack of *Bona Fide* Use of the Y.L.SKIN Mark In Commerce under 15 U.S.C. § 1051(a)

21. Petitioner repeats and realleges the allegations set forth in the preceding paragraphs of this Petition for Cancellation.

22. Respondent obtained a registration for the Registered Mark under Section 1(a) of the Lanham Act based solely on its sworn declaration that it was using the mark in commerce.

23. Upon information and belief, and based on investigation of Respondent's business, Respondent was not using the Registered Mark on the goods identified Registration No. 3,931,264 at any time prior to the filing of Respondent's Statement of Use on January 14, 2011.

24. Upon information and belief, and based on investigation of Respondent's business, Respondent has never used the Registered Mark in commerce in connection with the goods identified by Registration No. 3,931,264.

25. Accordingly, Registration No. 3,931,264 was improperly obtained and is void, *ab initio*, in its entirety.

COUNT III

Abandonment based on Non-Use under 15 U.S.C. §1064(3)

26. Petitioner repeats and realleges the allegations set forth in the preceding paragraphs of the Petition for Cancellation.

27. Upon information and belief, and based on investigation of Respondent's business, Respondent has never used, does not intend to use, and has no intent to resume use of the Registered Mark in connection with the goods identified in Registration No. 3,931,264.

28. Consequently, Respondent has abandoned any rights or priority it may have had in the Registered Mark.

29. Petitioner is being and will be damaged by the continued presence of Registration No. 3,931,264 on the Principal Register.

WHEREFORE, Petitioner respectfully requests that Registration No. 3,931,264 for the mark Y.L.SKIN be cancelled.

Dated this 3rd day of June, 2015.

Respectfully submitted,

/H. Matthew Horlacher/
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**Attorney for Petitioner
Young Living Essential Oils, LC**

CERTIFICATE OF SERVICE

I certify that on June 3, 2015, I served a copy of the above PETITION FOR CANCELLATION to the following by:

- | | |
|-------------------------------------|----------------------------|
| <input checked="" type="checkbox"/> | U.S. Mail, postage prepaid |
| <input type="checkbox"/> | Hand Delivery |
| <input type="checkbox"/> | Fax |

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/s/

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