

ESTTA Tracking number: **ESTTA899976**

Filing date: **05/30/2018**

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	Perfectly Posh, LLC
Granted to Date of previous extension	05/30/2018
Address	222 South Main Street, Suite 1600 Salt Lake City, UT 84101 UNITED STATES

Attorney information	H Matthew Horlacher Holland & Hart LLP P.O. Box 11583 222 South Main Street, Suite 2200 Salt Lake City, UT 84101 UNITED STATES Email: docket@hollandhart.com, mhorlacher@hollandhart.com, cathomas@hollandhart.com, AJTindell@hollandhart.com Phone: 8017995825
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Applicant Information

Application No	87609820	Publication date	01/30/2018
Opposition Filing Date	05/30/2018	Opposition Period Ends	05/30/2018
Applicant	ABNER-PONGRATZ, JACQUELINE 54 MAIN ST ACTON, MA 01720 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bath soaps; Cosmetic preparations for body care; Cosmetics; Perfumes

Applicant Information

Application No	87646907	Publication date	01/30/2018
Opposition Filing Date	05/30/2018	Opposition Period Ends	
Applicant	ABNER-PONGRATZ, JACQUELINE 54 MAIN ST ACTON, MA 01720 UNITED STATES		


Goods/Services Affected by Opposition

<p>Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bath soaps; Cosmetic preparations for body care; Cosmetics; Perfumes</p>
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4348174	Application Date	09/15/2011
Registration Date	06/04/2013	Foreign Priority Date	NONE
Word Mark	PERFECTLY POSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Personal care products, namely, hand lotion, hand balm, hand soap, body lotion, body butter, body balm, body soap, body mist spray, face lotion, face oils, face creams, exfoliating masks, shampoos, hair conditioners, massage cream, massagebalm, massage oil, bath fizzies, bath beads, bath salts, non-medicated foot cream, non-medicated foot balm, non-medicated foot lotion, non-medicated lip balm, lip tint, perfume, perfume oils, nutritional oils for cosmetic purposes, essential oils for personal use, essential oils for aromatherapy use, lip exfoliators, mineral powders for use as cosmetic makeup, mineral makeup, aromatic oils, non-medicated aromatic body mists, aromatic lotions, aromatic bath salts, non-medicated aromatic bombs for the skin and body for adding color and scent to bath water, bath milks, beauty milks, cosmetic milks for the skin and body</p> <p>Class 005. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Scented and perfumed air and room freshener sprays and fresheners</p> <p>Class 010. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Massaging apparatus for personal use</p> <p>Class 035. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Rendering technical assistance in the nature of advertising, marketing, and promotional services by developing advertising campaigns for web pages and print media, for the purpose of assisting in the establishment and operation of distrib-</p>		

	utorships, person to person, wholesale and retail selling services in the field of personal care products
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U.S. Registration No.	4452650	Application Date	09/15/2011
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Registration Date	12/17/2013	Foreign Priority Date	NONE
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Word Mark	PERFECTLY POSH
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Description of Mark	The mark consists of the wording "perfectly posh" surrounded on each end by a curly bracket and asterisk.
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Goods/Services	<p>Class 003. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Personal care products, namely, hand lotion, hand balm, hand soap, body lotion, body butter, body balm, body soap, bodymist spray, face lotion, face oils, face creams, exfoliating masks, shampoos, hair conditioners, massage cream, massagebalm, massage oil, bath fizzies, bath beads, bath salts, non-medicated foot cream, non-medicated foot balm, non-medicated foot lotion, non-medicated lip balm, lip tint, perfume, perfume oils, nutritional oils for cosmetic purposes, essential oils for personal use, essential oils for aromatherapy use, lip exfoliators, mineral powders for use as cosmetic makeup, mineral makeup, aromatic oils, non-medicated aromatic body mists, aromatic lotions, aromatic bath salts, non-medicated aromatic bombs for the skin and body for adding color and scent to bath water, bath milks, beauty milks, cosmetic milks for the skin and body</p> <p>Class 005. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Scented and perfumed air and room freshener sprays and fresheners</p> <p>Class 035. First use: First Use: 2011/09/30 First Use In Commerce: 2011/09/30 Rendering technical assistance in the nature of advertising, marketing, and promotional services by developing advertising campaigns for web pages and print media, for the purpose of assisting in the establishment and operation of distributorships, person to person, wholesale and retail selling services in the field of personal care products</p>
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U.S. Application No.	87689357	Application Date	11/17/2017
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PERFECTLY POSH		
Design Mark			
Description of Mark	The mark consists of the wording "PERFECTLY POSH" with two asterisks, with the wording "PERFECTLY" underlined, all within a shaded circle.		
Goods/Services	<p>Class 003. First use: First Use: 2011/10/00 First Use In Commerce: 2011/10/00 Personal care products, namely, hand lotion, non-medicated balm for use on hands, non-medicated hand soap, body lotion, body butter, skin care preparations namely, body balm, body soap, namely body bath soap and body cream soap, body mist spray, face lotion, face oils, face creams, exfoliating skin masks, shampoos, hair conditioners, massage cream, massage balm not for medical purposes, massage oil, bath fizzies, bath beads, non-medicated bath salts, non-medicated foot cream, non-medicated foot balm, non-medicated foot lotion, non-medicated lip balm, lip tint, perfume, perfume oils, nutritional oils for cosmetic purposes, essential oils for personal use, essential oils for aromatherapy use, non-medicated exfoliating preparations for lips, mineral powders for use as cosmetic makeup, mineral makeup, aromatic oils, non-medicated aromatic body mists, aromatic lotions, aromatic non-medicated bath salts, non-medicated aromatic bath bombs for the skin and body for adding color and scent to bath water, bath milks, beauty milks, cosmetic milks for the skin and body</p> <p>Class 035. First use: First Use: 2011/10/00 First Use In Commerce: 2011/10/00 Rendering technical assistance in the nature of advertising, marketing, and promotional services by developing advertising campaigns for web pages and print media, for the purpose of assisting in the establishment and operation of distributorships, person to person, wholesale and retail selling services in the field of personal care products</p>		

Attachments	85978911#TMSN.png(bytes) 85980499#TMSN.png(bytes) 87689357#TMSN.png(bytes) Posh Goth NOO.pdf(285611 bytes)
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Signature	/hmh/
Name	H Matthew Horlacher
Date	05/30/2018

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

PERFECTLY POSH, LLC

Opposer,

v.

JACQUELINE ABNER-PONGRATZ,

Applicant.

Opposition No.: _____

Trademarks: POSH GOTH,



Serial Nos.: 87609820, 87646907

CONSOLIDATED NOTICE OF OPPOSITION

Perfectly Posh, LLC, having its principal place of business located at 185 S. State Street, Suite 800, Salt Lake City, Utah 84111 (“Perfectly Posh” or “Opposer”), believes that it will be damaged by the registration of the trademarks shown in Application Serial Nos. 87609820 and 87646907 for goods in International Class 3 (the “Applications”), and hereby opposes registration of both Applications.

As grounds for its opposition, Opposer alleges that, upon actual knowledge with respect to itself and its own actions, and upon information and belief as to other matters:



PERFECTLY POSH AND ITS MARKS

1. Opposer has established itself as a leading distributor of naturally based pampering skincare, cosmetic, and scented products throughout the United States.
2. Since 2011, Opposer has shipped over 300 million pampering products.
3. Opposer sells its products through its website www.perfectlyposh.com and through Perfectly Posh Independent Consultants who develop businesses promoting and selling

Perfectly Posh products. Opposer provides opportunities for over 50,000 such business owners in the United States.

4. Opposer provides its Independent Consultants with tools, training, support staff, opportunity to oversee a team, and a generous commission and bonus structure.

5. Opposer owns numerous POSH-formative and derivative trademarks, including the following U.S. Applications and Registrations for the PERFECTLY POSH trademark (“Opposer’s PERFECTLY POSH Marks”):

 <p>Filing Date: 11/17/17 Ser. No. 87689357</p>	<p>PERFECTLY POSH</p> <p>Filing Date: 9/15/11 Reg. Date: 6/4/13 Reg. No. 4348174</p>	 <p>Filing Date: 9/15/11 Reg. Date: 12/17/13 Reg. No. 4452650</p>
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6. All applications and registrations claim “Personal care products, namely, hand lotion, non-medicated balm for use on hands, non-medicated hand soap, body lotion, body butter, skin care preparations namely, body balm, body soap, namely body bath soap and body cream soap, body mist spray, face lotion, face oils, face creams, exfoliating skin masks, shampoos, hair conditioners, massage cream, massage balm not for medical purposes, massage oil, bath fizzies, bath beads, non-medicated bath salts, non-medicated foot cream, non-medicated foot balm, non-medicated foot lotion, non-medicated lip balm, lip tint, perfume, perfume oils, nutritional oils for cosmetic purposes, essential oils for personal use, essential oils for aromatherapy use, non-medicated exfoliating preparations for lips, mineral powders for use as cosmetic makeup, mineral makeup, aromatic oils, non-medicated aromatic body mists, aromatic lotions, aromatic

non-medicated bath salts, non-medicated aromatic bath bombs for the skin and body for adding color and scent to bath water, bath milks, beauty milks, cosmetic milks for the skin and body” in Class 3, and Registration Nos. 4452650 and 4348174 claim “Scented and perfumed air and room freshener sprays and fresheners” in Class 5, amongst other goods and services (“Opposer’s Goods”).

7. Opposer licenses the use of its trademarks to Independent Consultants according to the terms of its Policies and Procedures. Independent Consultants are required to assign to Opposer any mark that is identical to or a derivative of Opposer’s PERFECTLY POSH Marks that they use as a WebID (e.g., a domain name or social media handle). The Policies and Procedures state in relevant part: “Consultants shall not register or attempt to register or reserve any of the Company’s trademarks or trade names, or any derivatives of such trademarks or trade names (collectively “Marks”) for any Internet domain name, URL, subdomain name, email address, or social media handle, address, or name (collectively “Web ID”). If a Consultant does register any of the Company’s Marks in such a fashion, the Consultant agrees and hereby acknowledges that the Company owns, and shall continue to own, all rights in and to the Company’s Marks... The Consultant further agrees to immediately re-assign to the Company any Web ID that the Consultant has registered or reserved in violation of this policy at no charge to the Company.

8. Independent Consultant for Opposer, Andrea Lipomi, has used the domain name poshgoth.po.sh as her consultant website since September 2015. Additionally, Ms. Lipomi has been using the username PERFECTLY POSH GOTH on YouTube for a few years and has been using #POSHGOTH on Instagram, Twitter, and Facebook for several years. This use has been in

connection with her business as a Perfectly Posh Independent Consultant, promoting and selling the goods associated with Opposer's PERFECTLY POSH Marks.

9. Ms. Lipomi has invested significant resources into building her business and generating goodwill in association with the PERFECTLY POSH GOTH and POSHGOTH trademarks. Indeed, Ms. Lipomi has built her own team of Independent Consultants, and her success in generating revenue of thousands of dollars in product in association with the PERFECTLY POSH GOTH and POSHGOTH marks has allowed her to achieve Silver Premier status at Perfectly Posh.

10. Ms. Lipomi has assigned her common law rights, including all associated goodwill, in the PERFECTLY POSH GOTH and POSH GOTH marks to Opposer.

11. Opposer and Ms. Lipomi have expended considerable money and effort in promoting Opposer's PERFECTLY POSH Marks, and the PERFECTLY POSH GOTH and POSH GOTH marks (collectively, "Opposer's Marks"), and goods and services offered in connection with Opposer's Marks, in the United States.

12. Opposer and Ms. Lipomi have sold thousands of dollars' worth of products under Opposer's Marks in the United States.


13. As a result of Opposer's and Ms. Lipomi's longstanding use of Opposer's Marks, Opposer's Marks have come to be associated with Opposer (and Ms. Lipomi) in the United States.

APPLICANT'S MARKS

14. Applicant has filed the following pending intent-to-use applications, all identifying "Bath soaps; Cosmetic preparations for body care; Cosmetics; Perfumes" in International Class 3 ("Applicant's Marks"):

a. Application Serial No. 87609820, for POSH GOTH, filed September 15, 2017;



b. Application Serial No. 87646907, for , filed October 16, 2017;

15. Applicant's marks identical or confusingly similar to Opposer's Marks.

16. The goods listed in the Applications are identical to Opposer's Goods.

17. Opposer enjoys priority as a result of its USPTO applications and registrations, and common law use of Opposer's Marks that precedes the October 16, 2017 and September 15, 2017 filing dates of Applicant's intent-to-use Applications.

APPLICANT'S KNOWLEDGE OF OPPOSER AND ITS BAD FAITH

18. Applicant is an individual having an address at 54 Main St., Acton MA 01720.

19. Applicant sent Ms. Lipomi a message on September 15, 2017 advising Ms. Lipomi to refrain from branding PERFECTLY POSH products with POSH GOTH going forward, and to remove any posts referencing POSH GOTH from all social media accounts.

20. Applicant sent harassing messages to Ms. Lipomi over Instagram on October 2, 2017.

21. Applicant was aware of Opposer's common law and registered rights in Opposer's Marks in association with Opposer's Goods at the time it filed the Applications.

22. Applicant was not the rightful owner of the marks listed in the Applications in association with the identified goods at the time she filed the Applications. Accordingly, Applicant was not entitled to use the marks identified in the Applications in United States commerce.

23. Applicant is currently not the rightful owner of marks identified in the Applications in association with the identified goods.

24. Notwithstanding Applicant's knowledge that it was not the rightful owner of the marks identified in the Applications, Applicant intentionally filed them with the intent to deceive the United States Patent and Trademark Office and to obtain trademark registrations to which Applicant is not entitled.

25. Applicant lacks bona fide intent to use the marks identified in the Applications in association with the identified goods because Applicant is not the owner of the marks.

26. Applicant also lacks bona fide intent to use the marks identified in the Applications in association with the identified goods because Applicant is fully aware that such use will infringe upon Opposer's established common law and registered rights in Opposer's Marks.

COUNT I
Likelihood of Confusion
15 U.S.C. § 1052(d)

27. Opposer realleges and incorporates by reference the preceding allegations of its Notice of Opposition.

28. Registration of the trademarks shown in Application Serial Nos. 87609820 and 87646907 by Applicant will injure Opposer by causing the public to be confused or to believe, erroneously, that the goods and services provided by Applicant are endorsed or sponsored by Opposer. Opposer has no control over the nature and quality of the products and services offered by Applicant under the identical and confusingly similar marks shown in the Applications, and Opposer's reputation and goodwill will be damaged and the value of Opposer's Marks jeopardized, all to Opposer's detriment.

29. Since well prior to the filing date of the Applications, Opposer and Ms. Lipomi have used Opposer's Marks in connection with Opposer's Goods, which goods are identical to those listed in Applicant's Applications.

30. Registration of the marks herein opposed will damage Opposer because the trademarks shown in Application Serial Nos. 87609820 and 87646907 are likely, when used on or in connection with the goods described in the Applications, to cause confusion, or to cause mistake or to deceive. Thus, the marks shown in the Applications are unregistrable under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and should be refused registration.

COUNT II
Applications Are Void Ab Initio
15 U.S.C. § 1051(b)

31. Opposer realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

32. Applicant was not the owner of the trademarks shown in Application Serial Nos. 87609820 and 87646907, and accordingly not entitled to use the trademarks shown in the Applications in United States commerce at the time it filed the Applications. Applicant is not currently the owner of the trademarks shown in the Applications.

33. Applicant lacks bona fide intent to use the marks identified in the Applications in U.S. commerce in association with the identified goods because Applicant has knowledge that such use will infringe upon Opposer's established registered and common law rights in Opposer's Marks.

34. Accordingly, Application Serial Nos. 87609820 and 87646907 are void ab initio pursuant to 15 U.S.C. § 1051(b) and 37 C.F.R § 2.71(d).

COUNT III
Fraud on the USPTO
15 U.S.C. § 1063

35. Opposer realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

36. Pursuant to 15 U.S.C. § 1051(b)(3), Applicant submitted a declaration to the USPTO for the Applications in which it declared, under oath, being warned that willful false statements, and the like, may jeopardize the validity of the application, that Applicant believes that she is “the owner of the mark sought to be registered,” and that “no other persons . . . have the right to use the mark in commerce.”

37. Applicant had full knowledge of Opposer and of Opposer’s Marks when Applicant submitted this declaration, and Applicant intentionally withheld this information while knowingly making false and fraudulent statements to the USPTO with the intent to procure registrations for the POSH GOTH marks.

38. Accordingly, Applicant’s Applications were intentionally and materially false, made in bad faith, and made in a concerted attempt to perpetrate a fraud upon the USPTO.

39. As a result of this fraud, Applicant’s Applications should be refused.

WHEREFORE, Opposer believes that it will be damaged by registration of the trademarks shown in Application Serial Nos. 87609820 and 87646907 and respectfully requests that the opposition be sustained, and that registration to Applicant be refused.

The filing fee is being transmitted electronically with this submission. Any deficiency in the fee should be charged to Deposit Account No. 08-2623.

May 30, 2018

Respectfully submitted,

/H. Matthew Horlacher/

H. Matthew Horlacher
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**Attorneys for Opposer
Perfectly Posh LLC**

NOTICE REGARDING SERVICE

Consistent with the Trademark Trial and Appeal Board Manual of Procedure Rule 309.02(c)(1) (amended January 14, 2017), service of the above NOTICE OF OPPOSITION will be effected by the Board. To facilitate the Board, the following physical address and email address(es) are available as Applicant's correspondence address via TSDR:

Erik J. Heels
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/H. Matthew Horlacher/
H. Matthew Horlacher