

ESTTA Tracking number: **ESTTA1320426**Filing date: **11/06/2023**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91287329
Party	Defendant BEAUTY 21 COSMETICS, INC.
Correspondence address	LINDA H. LIU KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES Primary email: <a href="mailto:efiling@knobbe.com">efiling@knobbe.com</a> 949-760-0404
Submission	Answer
Filer's name	Charles K. Crane
Filer's email	<a href="mailto:efiling@knobbe.com">efiling@knobbe.com</a>
Signature	/Charles K. Crane/
Date	11/06/2023
Attachments	Answer.pdf(122344 bytes ) Exhibit A - CERCAT.098M.pdf(1274707 bytes ) Exhibit B -CERCAT.098M.pdf(493443 bytes )

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

CHRISTINA L ROSE DBA KBSHIMMER,	)	
	)	Opposition No.: 91287329
Opposer,	)	
	)	Serial No.: 97/627995
v.	)	
	)	Mark: SHADE SHIFTER
BEAUTY 21 COSMETICS, INC.,	)	
	)	
Applicant.	)	
_____	)	

**ANSWER TO NOTICE OF OPPOSITION  
AND AFFIRMATIVE DEFENSES**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Beauty 21 Cosmetics, Inc. (“Applicant”) hereby submits this Answer to the Notice of Opposition (“Opposition”) filed by Christina L Rose DBA KBshimmer (“Opposer”) against Applicant’s U.S. Serial No. 97/627995 (“Applicant’s Application”) for the mark SHADE SHIFTER as set forth below.

1. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 1 of the Opposition and, on that basis, denies these allegations.
2. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 2 of the Opposition and, on that basis, denies these allegations.
3. Applicant admits the allegations in Paragraph 3 of the Opposition.
4. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 4 of the Opposition and, on that basis, denies these allegations.

5. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 5 of the Opposition and, on that basis, denies these allegations.

6. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 6 of the Opposition and, on that basis, denies these allegations.

7. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 7 of the Opposition and, on that basis, denies these allegations.

8. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 8 of the Opposition and, on that basis, denies these allegations.

9. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 9 of the Opposition and, on that basis, denies these allegations.

10. Applicant admits that Opposer uses the phrase “SHADE SHIFTER” as a noun to refer to a nail polish that changes shades depending on the light and angle. Opposer’s advertising materials state “Shade Shifter is a multichrome that changes depending on light and angle from cyan, to blue, to red-orange, to purple, and more...” *See Exhibit A.* Applicant also admits that Opposer is neither the first nor the only party using the phrase “SHADE SHIFTER” in connection with nail polish products and that ORLY International Inc., a third party, appears to also offer nail products under the SHADE SHIFTER mark. *See Exhibit B.* Applicant denies any and all remaining allegations in Paragraph 10 of the Opposition.

11. Applicant admits that Exhibit B of the Opposition appears to be a copy of TSDR record of U.S. Application Serial No. 98/144025 for the mark SHADE SHIFTER in connection with “Cosmetics and cosmetic preparations; Nail polish” in International Class 003 (“Opposer’s Application”), filed on August 22, 2023, which is well after the filing date of Applicant’s Application and the first use date of Applicant’s SHADE SHIFTER mark. Applicant lacks

sufficient knowledge or information to admit or deny the remaining allegations in Paragraph 11 of the Opposition and, on that basis, denies any and all remaining allegations.

12. Applicant admits that Applicant filed U.S. Application Serial No. 97/627995 for the mark SHADE SHIFTER in connection with “Cosmetics and makeup preparations; Eye shadow” (“Applicant’s Goods”) in International Class 003, nearly a year before the filing date of Opposer’s Application.

13. Applicant admits that Applicant’s Application was filed on a use basis and claims a date of first use *at least as early as* September 7, 2022 in connection with Applicant’s Goods.

14. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 14 of the Opposition and, on that basis, denies these allegations.

15. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 15 of the Opposition and, on that basis, denies these allegations.

16. Applicant incorporates its responses to Paragraphs 1-15 of the Opposition as set forth above. Except where explicitly admitted as qualified in paragraphs 3, 10, 11, 12, and 13, Applicant denies any and all remaining allegations in Paragraph 16 of the Opposition.

17. Applicant admits that Applicant has been using SHADE SHIFTER as a trademark and Opposer has been using the phrase “SHADE SHIFTER” as a noun to refer to a nail polish that changes shades. Applicant lacks sufficient knowledge or information to admit or deny the remaining allegations in Paragraph 17 of the Opposition and, on that basis, denies any and all remaining allegations.

18. Applicant admits that Applicant has been using SHADE SHIFTER as a trademark and Opposer has been using the phrase “SHADE SHIFTER” as a noun to refer to a nail polish that changes shades. Applicant lacks knowledge or information to admit or deny the remaining

allegations in Paragraph 18 of the Opposition and, on that basis, denies any and all remaining allegations.

19. Applicant admits that Applicant has been using SHADE SHIFTER as a trademark and Opposer has been using the phrase “SHADE SHIFTER” as a noun to refer to a nail polish that changes shades. Applicant lacks sufficient knowledge or information to admit or deny the remaining allegations in Paragraph 19 of the Opposition and, on that basis, denies any and all remaining allegations.

20. Applicant admits that Applicant has been using SHADE SHIFTER as a trademark and Opposer has been using the phrase “SHADE SHIFTER” as a noun to refer to a nail polish that changes shades. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 20 of the Opposition and, on that basis, denies any and all remaining allegations.

21. Applicant admits that it is the owner of Applicant’s Application for the SHADE SHIFTER mark in connection with “Cosmetics and makeup preparations; Eye shadow” in International Class 003.

22. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 22 of the Opposition and, on that basis, denies these allegations.

23. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 23 of the Opposition and, on that basis, denies these allegations.

24. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 24 of the Opposition and, on that basis, denies these allegations.

25. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 25 of the Opposition and, on that basis, denies these allegations.

26. Applicant lacks sufficient knowledge or information to admit or deny the allegations in Paragraph 26 of the Opposition and, on that basis, denies these allegations.

Unless specifically admitted herein, all allegations in the Notice of Opposition are denied. Applicant further denies that Opposer is entitled to any relief, including the relief requested in this Notice of Opposition.

### **APPLICANT'S AFFIRMATIVE DEFENSES**

Applicant alleges the following affirmative defenses. There may be additional affirmative defenses to the claims alleged by Opposer that are currently unknown to Applicant. Therefore, Applicant reserves the right to amend its Answer to allege any additional affirmative defenses currently unknown to Applicant, in the event that discovery of additional information indicates that they are appropriate.

#### **First Affirmative Defense**

The Notice of Opposition, including each and every claim alleged therein, fails to state a claim upon which relief can be granted.

#### **Second Affirmative Defense**

The Opposition is barred by the doctrine of laches, estoppel, acquiescence and/or waiver.

#### **Third Affirmative Defense**

The Opposition is barred by the abandonment and loss of Opposer's alleged rights due to Opposer's failure to police its alleged mark.

///

///

**CONCLUSION**

WHEREFORE, Applicant prays that Opposer's Notice of Opposition be dismissed in its entirety.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 6, 2023

By: /Charles K. Crane/

Linda H. Liu  
Charles K. Crane  
2040 Main Street, Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
efiling@knobbe.com

Attorneys for Applicant,  
BEAUTY 21 COSMETICS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES** has been served on Opposer's counsel of record on November 6, 2023 via electronic mail to:

A. Garrett Hutchinson  
Taft Stettinius & Hollister, LLP  
One Indiana Square, Suite 3500  
Indianapolis, IN 46204  
United States  
[ghutchinson@taftlaw.com](mailto:ghutchinson@taftlaw.com), [mgordon@taftlaw.com](mailto:mgordon@taftlaw.com)

Signature: /Lisa Helmle/

Name: Lisa Helmle

Date: November 6, 2023

57626983



# Exhibit A

SPEND \$75 OR MORE  
TO GET FREE USPS SHIPPING!



LOGIN REGISTER 0 ITEM(S) / \$0.00

NAIL POLISH | TOP & BASE COATS | HAND & CUTICLE CARE | TOOLS & SWAG | PBE | PPU | GIFT CERTIFICATES



Click to expand

## Shade Shifter Nail Polish

Home > Nail Polish

Price: \$12.00

19 reviews

Quantity

ADD TO CART

SHARE:

Add To Wish List

Shade Shifter is a multichrome that changes depending on light and angle from cyan, to blue, to red-orange, to purple, and more. I most often see a cyan blue shade.

Type: Multichrome

Base: 5-Free

Glitter Load: None

Glitter Size: None

Recommended Coats: Best in 2-3 coats, or 1 coat over black, this polish is one you will have to see to believe!

Notes: None



### Additional Information

This listing is for a standard full-sized 15ml / .5oz bottle with our glitter grabbing flat brush. Two stainless steel balls are included in every polish bottle.

Ingredients: Ethyl Acetate, Butyl Acetate, Nitrocellulose, Adipic Acid/Neopentyl Glycol/Trimellitic, Anhydride Copolymer, Isopropyl Alcohol, Acetyl Tributyl Citrate, Silica, Benzophenone-3, N-Butyl Alcohol, Violet 2 May Contain: Aluminum Powder, Mica, Iron Oxide, Ferric Ferrocyanide, Ultramarines, Red 6, Red 22, Red 30, Red 28, Red 34, Red 7, Orange 5, Yellow 5, Yellow 11, Yellow 6, Yellow 10, Blue 1, Black 2, Violet 2 Ext, Titanium Dioxide, Synthetic Fluorophylogopite, Calcium Sodium Borosilicate, Polyethylene Terephthalate, Polyurethane 33, Silver, Chromium, Magnesium Fluoride, Bismuth Oxychloride.

Please note: while we do our best to ensure colors match on several devices on our end, the device you view this listing on may not accurately reflect the color of the polish. Photos are provided to us for use by the respective bloggers, and colors may show differently depending on lighting, skin tones, and camera equipment used.

### Product Reviews

Login or Register to write a review.



Best Nail Polish I have Tried!



# Exhibit B



ORLY / ORLY GEL SHADE SHIFTER



# ORLY Gel Shade Shifter

★★★★★ 3 Reviews

ORLY gel color changing coat. Clear if your hot, dark if you're not. Simply paint a coat of Shade Shifter over your gel color and cure. Feeling a chill? Shade Shifter stays dark on your nail. Temperature running hot? Shade Shifter goes clear, revealing the gel color underneath. Works exclusively with ORLY Gel colors only.

~~\$19.99~~ \$13.93 Sale

or 4 interest-free payments of \$3.48 with [afterpay](#) ⓘ

30030 0.3oz

Add to Cart

## Related Products



BONDER

24110 | 0.6oz

\$13.00



SUNKISSED

2010010 | 0.6oz

\$11.00



ALL DAHLIA'D UP

2060030 |

\$11.00



BUBBLY BOMBSHELL

20093 | 0.6oz

\$10.50



SHE'S A WILDFLOWER

2060031 |

\$11.00



TREATMENT + SHINE

24903 | 0.6oz

\$11.00

AA website uses cookies to ensure you get the best experience on our website. [Privacy Policy](#)

Ask Us a Question

Preferences

Accept