

**This Opinion is Not a
Precedent of the TTAB**

Mailed: November 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Glow Concept Inc.
v.
Too Faced Cosmetics, LLC.
—

Cancellation No. 92067143
—

David H. Faux of Law Office of David H. Faux PC,
for Glow Concept Inc.

Eric Goodman of Goodman Mooney LLP,
for Too Faced Cosmetics, LLC.

—

Before Wolfson, Greenbaum and Larkin,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

I. Background

Too Faced Cosmetics, LLC (“Respondent”) owns a registration on the Principal Register for the mark UNICORN TEARS (in standard characters) for “cosmetics and cosmetic preparations” in International Class 3.¹ On October 11, 2017, Glow Concept

¹ Registration No. 5234883 (“Registration”) issued on July 4, 2017 from an application filed on March 31, 2016, based upon a claim of first use anywhere and first use in commerce since at least as early as December 1, 2015.

Inc. (“Petitioner”) filed a Petition to Cancel the Registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), asserting ownership and prior acquisition of common law rights to the mark UNICORN TEARS for lip gloss and lip glosses (“Asserted Mark”), and likelihood of confusion. 1 TTABVUE 5 ¶ 8.² Petitioner also pleaded ownership of a trademark application for UNICORN TEARS, Serial No. 87638900, which was filed on October 9, 2017, for the same goods (“Application”). 1 TTABVUE 4 ¶ 4. Respondent denied the salient allegations in the Petition to Cancel.³ The case is fully briefed.

II. Evidentiary Objections

Respondent lodged numerous objections to Petitioner’s testimony and evidence. Administrative Trademark Judges decide Board proceedings, and there are no lay jurors who might be easily misled, confused, or prejudiced by flawed evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) (“In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.”). “Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this case, including any inherent limitations, which precludes the need to strike the challenged testimony and evidence

² References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page or paragraph references, if applicable.

³ The Board struck three of the four “Affirmative Defenses” asserted in Respondent’s Answer, and determined that the remainder merely amplified the denials. 14 TTABVUE 3-4 (Denial of Cross-Motions for Summary Judgment). We concur.

if the objection is well-taken.” *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017).

Almost all of the evidence Respondent seeks to exclude post-dates the filing date of Respondent’s Registration. As will become apparent in our discussion of priority below, this evidence is not outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss any of them specifically. Suffice it to say, we have considered all of the testimony and exhibits submitted. In doing so, we have kept in mind the various objections raised by Respondent and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017).

III. Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application file underlying Respondent’s Registration.⁴

During its testimony period, Petitioner submitted the Testimony Declaration of Natalie Mackey, Petitioner’s Chief Executive Officer, with associated exhibits (“Mackey Dec.”), 29-35 TTABVUE (Mackey Dec. is located at 29 TTABVUE 6-9), and the Testimony Declaration of Nicole Lee, Petitioner’s Executive Vice President (“Lee

⁴ In the Notice of Reliance, Respondent states its intention to rely on the “entire and complete” USPTO files for the Registration and Petitioner’s Application, citing Trademark Rule 2.122(b). Trademark Rule 2.122(b) only pertains to the file of an application or registration that is the subject of an opposition or cancellation proceeding. A party who wishes to make the file of a plaintiff’s pleaded application or registration of record may do so under notice of reliance per Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), or as a testimony exhibit. Here, neither party made the file of Petitioner’s Application of record.

Dec.”), 36 TTABVUE. Petitioner also made of record a Notice of Reliance on Petitioner’s pleaded Application and Respondent’s Registration,⁵ printouts of Petitioner’s website and online magazines showing use of the Asserted Mark in association with Petitioner’s lip glosses, printouts from online magazines that reviewed both parties’ lip glosses associated with the wording “unicorn tears,” and printouts from third-party online stores offering both parties’ lip glosses. 28 TTABVUE.

Respondent submitted a Notice of Reliance on the Testimony Declarations⁶ of (1) Eric Hohl, Respondent’s Global Brand President; (2) Somer Tejwani, Respondent’s Vice President of Marketing; and (3) Eric Goodman, Petitioner’s Counsel, with associated exhibits consisting of: Petitioner’s responses to Respondent’s Interrogatories and Document Requests, printouts of third-party websites and Respondent’s website about Respondent’s use of its UNICORN TEARS mark in association with lipstick, printouts of online magazines and Petitioner’s website about Petitioner’s lip gloss associated with the wording “unicorn tears,” 37 TTABVUE, and Respondent’s confidential documents concerning its initial order for and manufacture of its UNICORN TEARS lipstick, and invoices, sales reports, and other documents concerning Respondent’s use of its UNICORN TEARS mark in

⁵ There was no need to submit a copy of Respondent’s Registration as it is automatically of record through operation of Trademark Rule 2.122. We note, however, that Petitioner submitted only Petitioner’s Application, and not the entire file.

⁶ The submission of testimony declarations under a notice of reliance, as Respondent has done, is not the preferred approach, but it is harmless. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, *3 (TTAB 2019).

association with lipstick. 38 TTABVUE (confidential portions of the Declarations and associated exhibits).

Petitioner submitted a Rebuttal Notice of Reliance on portions of the application record underlying Respondent's Registration and of this proceeding.⁷ 39 TTABVUE.

IV. Petitioner's Entitlement to a Statutory Cause of Action⁸

To establish entitlement to a statutory cause of action under Section 14 of the Trademark Act, such as a cause of action for likelihood of confusion, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Petitioner has done so through the testimony of its CEO, Natalie Mackey, and submission of a certified copy of the Application. According to Ms. Mackey, "Petitioner is the owner of the UNICORN TEARS under common law trademark, currently memorialized in application Serial No. 87/638,900 ('Petitioner's Mark'). A true and certified copy of

⁷ These materials were already of record, and their resubmission was unnecessarily duplicative.

⁸ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

the application is attached hereto as Exhibit A.” Mackey Dec., 29 TTABVUE 7 ¶ 3 (Exhibit A is located at 29 TTABVUE 10-19).⁹

The trial record includes neither a copy of an Office Action citing the Registration as a bar to the Application under Section 2(d) of the Trademark Act, nor testimony concerning any such refusal, either of which would have been sufficient to establish Petitioner’s entitlement to a statutory cause of action. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant’s] registration.”). Under appropriate circumstances, however, a plaintiff also may establish its entitlement to a statutory cause of action by submitting testimony or evidence that it filed a pleaded application.

In *Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1874 (TTAB 2010), a case with facts and evidence very similar to those present here, the Board found that the petitioner had established his standing simply by introducing evidence that he owned his pleaded application, even without evidence that the USPTO refused registration under Section 2(d) based on a likelihood of confusion with the respondent’s previously registered identical mark for “at least arguably related” goods. The Board then found that “evidence of such a refusal is not a requirement to establish standing. Rather, it is sufficient if the circumstances are such that it would be reasonable for a petitioner

⁹ Petitioner also submitted a certified copy of the Application as Exhibit A to its Notice of Reliance. 28 TTABVUE 9-18.

to believe that the existence of the respondent's registration would damage him, e.g., ... that the presence on the register of the respondent's mark may hinder the petitioner in using or registering his mark." *Toufigh*, 95 USPQ2d at 1874. *See also Lipton Indus.*, 213 USPQ at 189 ("We regard the desire for a registration with its attendant statutory advantages as a legitimate commercial interest.").

We follow the rationale in *Toufigh*, and find that on this record, where Petitioner filed an application for a mark that is identical to Respondent's registered mark for legally identical goods,¹⁰ Petitioner has demonstrated a real interest in this cancellation proceeding and a reasonable belief of damage, thereby establishing its entitlement to a statutory cause of action under Section 14 of the Trademark Act.

V. Priority

"A party claiming prior use of a registered mark may petition to cancel the registration on the basis of such prior use pursuant to section 14 of the Lanham Act. 15 U.S.C. Section 1064." *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994). However, "a presumption of validity attaches to" Respondent's Registration. *Id.*; *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *See also* Trademark Act Section 7(c), 15 U.S.C. § 1057(c). As the alleged prior user, Petitioner bears the burden of proving its claim of acquisition of prior proprietary rights in the

¹⁰ Respondent essentially has admitted as much: "There is no dispute that [Respondent's] UNICORN TEARS trademark is the same as Petitioner's shade name and that [Respondent] and Petitioner both sell cosmetics through the same channels of trade. Consequently, the determinative issues in this proceeding will be Petitioner's alleged trademark use and priority." 41 TTABVUE 9.

Asserted Mark by a preponderance of the evidence. *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987); *cf. Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013). (“[O]pposer must prove by a preponderance of the evidence that its common law rights were acquired before any date upon which applicant may rely.”).

“As a general matter, priority in a Trademark Act § 2(d) case goes to the party which made first use of its mark on the relevant goods.” *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1139 (TTAB 2013). Here, Respondent may rely on its Registration as proof of constructive use of the mark UNICORN TEARS as of March 31, 2016, which is the filing date of the application that matured into the Registration. *Hydro-Dynamics*, 1 USPQ2d at 1773; *see also* Trademark Act § 7(c).

Because Petitioner does not own a U.S. registration, it bears the burden of demonstrating a proprietary interest acquired through use of the Asserted Mark prior to Respondent’s March 31, 2016 constructive use date.¹¹ *See Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co. v. Univ. Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43-45 (CCPA 1981). This proprietary interest may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Herbko*, 64 USPQ2d at 1378.

¹¹ Although Respondent presented testimony and evidence concerning first use of its UNICORN TEARS mark in early December 2015, in light of our disposition of this proceeding, we need not look beyond Respondent’s constructive use date.

Because Petitioner has not alleged use analogous to trademark use, we focus on whether Petitioner acquired proprietary rights to the wording UNICORN TEARS through actual use as a trademark (a/k/a “technical trademark” use). *See Cent. Garden & Pet Co.*, 108 USPQ2d at 1142 (“claims of use analogous to service mark use must be pleaded”). It is the commercial usage of a trademark which creates trademark rights. *Reflange Inc. v. R-Con Int’l*, 17 USPQ2d 1125, 1130 (TTAB 1990).

To function as a trademark under Section 45 of the Trademark Act, 15 U.S.C. § 1147, a “word, name, symbol, or device, or any combination thereof” must, by definition, “identify and distinguish [the] goods ... from those manufactured or sold by others and ... indicate the source of the goods, even if that source is unknown.” Here, Respondent argues that Petitioner uses the wording “UNICORN TEARS” solely “as a shade name for a lip gloss sold under its Winky Lux house mark and Glossy Boss trademark” and not as an indicator of source. 41 TTABVUE 9.

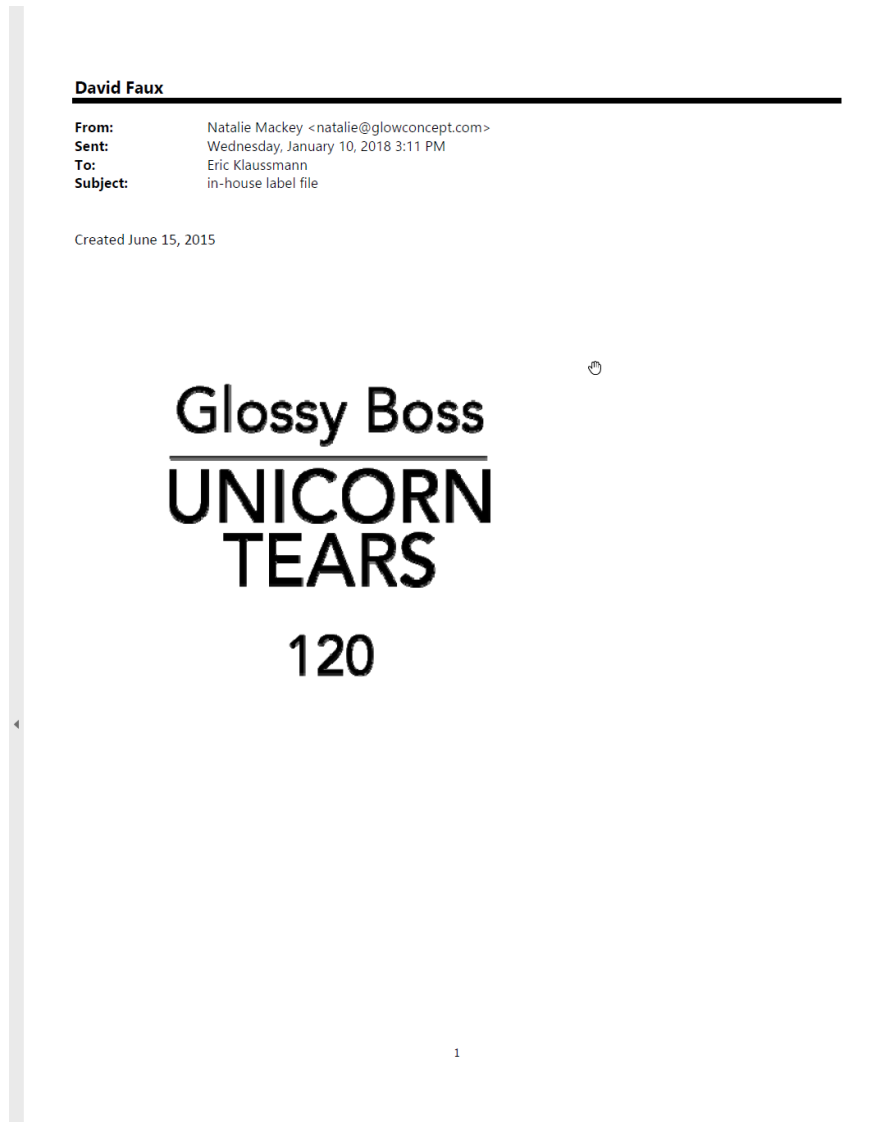
A shade name may be registered as a trademark if the evidence shows that it is “an arbitrary designation which does not in itself have a connotation of color as used on and in connection with the goods in question **and that it is applied in the manner of a trademark to the product.**” *In re Champion Int’l Corp.*, 183 USPQ 318, 320 (TTAB 1974) (citing *In re Clairol Inc.*, 457 F.2d 509, 173 USPQ 355 (CCPA 1972) (emphasis added). Although *Champion* and *Clairol* applied these criteria in the context of **registration** of color designations, they addressed the same question now before us: how to determine whether a shade name functions as a trademark, i.e.,

whether it performs a source-identifying function. At bottom, this determination rests on how the shade name is used.

Keeping the foregoing framework in mind, we review Petitioner's evidence and testimony about its use of the term "UNICORN TEARS" in association with lip gloss prior to Respondent's constructive use date of March 31, 2016.

A. Petitioner's Use of "Unicorn Tears" in June 2015

Petitioner's CEO, Natalie Mackey, testified that in June 2015, she "invented" the Asserted Mark, which Petitioner used in-house to identify a specific lip gloss. Mackey Dec. ¶ 4, 29 TTABVUE 7. On June 15, 2015, Petitioner created its first label with the Asserted Mark for affixation to lip glosses, submitted as Exhibit B. *Id.*, ¶ 7. Exhibit B, located at 29 TTABVUE 20 and reproduced below, appears to be a January 10, 2018 email from Ms. Mackey to Eric Klaussmann, the subject of which is "in-house label file."



As stated above, trademark rights are acquired through commercial usage. *Reflange*, 17 USPQ2d at 1130. The act of “inventing” a mark does not create prior rights. *Hydro-Dynamics*, 1 USPQ2d at 1774 (“Mere invention, creation, or discussion of a trademark does not create priority rights.” (internal citation omitted)). And Petitioner’s use of the Asserted Mark on an in-house label does not constitute use in the manner of a trademark as there is no testimony or evidence to show whether,

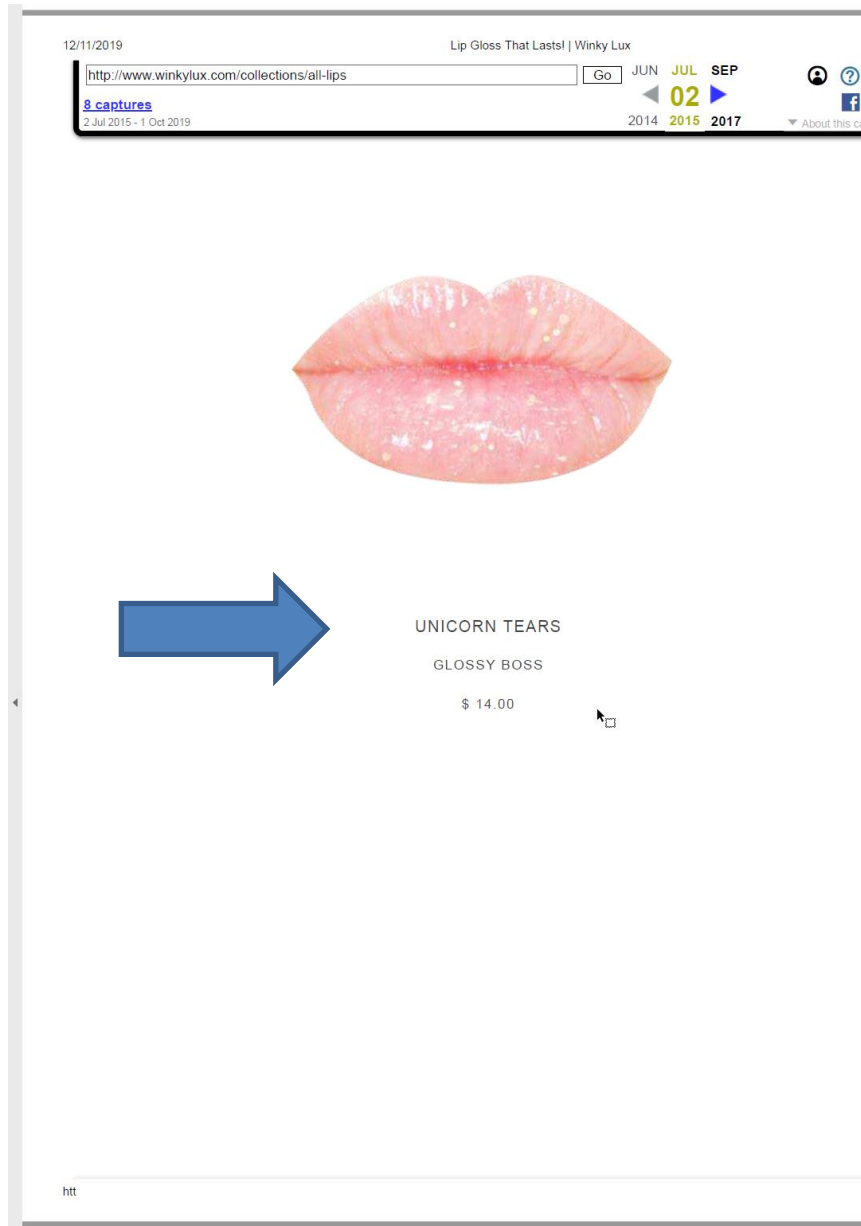
when or how the label was commercially used in connection with lip gloss, or otherwise exposed to prospective purchasers.

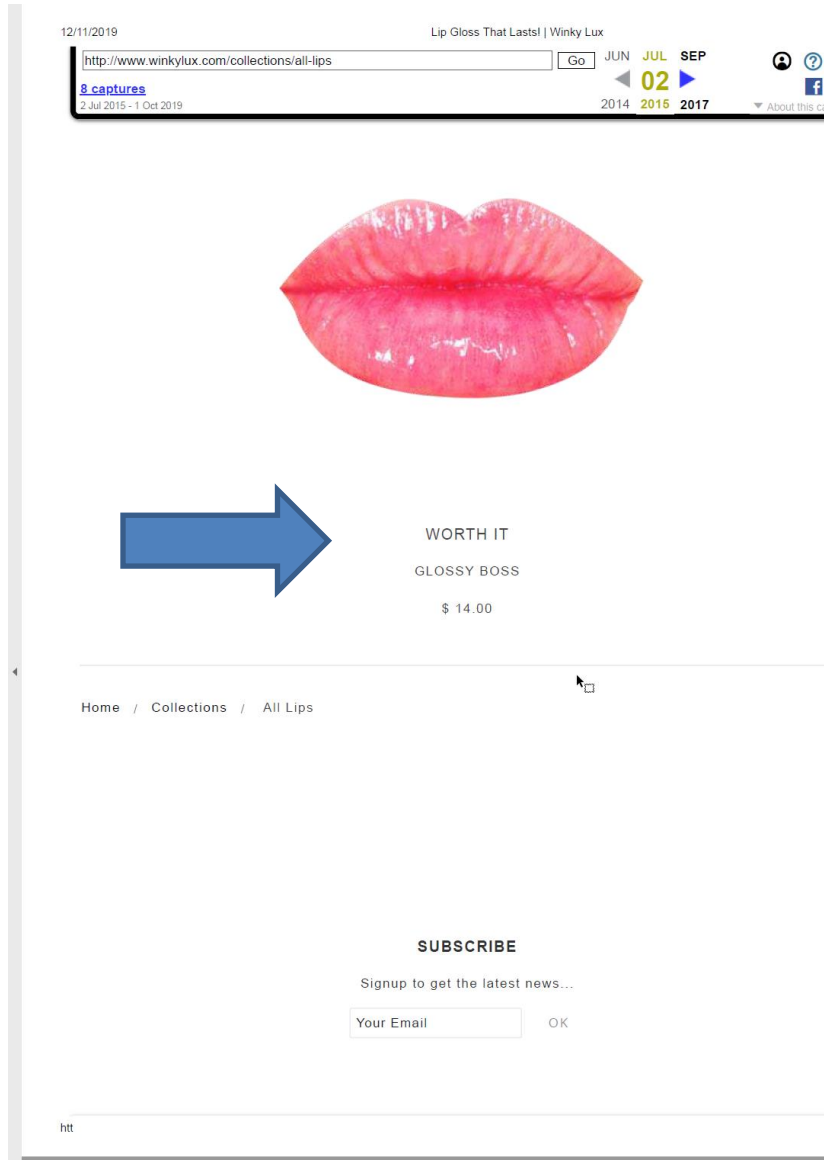
B. Petitioner's Use of "Unicorn Tears" in July 2015

Next, Ms. Mackey testifies that Petitioner began selling lip gloss under the Asserted Mark at least as early as July 2015.¹² Mackey Dec. ¶ 8, 29 TTABVUE 7. As support, Petitioner submitted as Exhibit C printouts from Petitioner's website.¹³ Exhibit C, located at 29 TTABVUE 21-32, shows the name WINKY LUX on the first page in all capital, large pink letters at the top of the page directly above four icons, including a shopping cart. Each page includes a header with the wording "Lip Gloss That Lasts! Winky Lux," and a large graphic of lips modeling a particular shade of lip gloss, with the name of the color or shade in all capital letters on the next line (e.g., "CHAMPAGNE FIGHT," "GEORGIA PEACHES," "GRAPEFRUIT GLAM," and "HANGOVER"), the name GLOSSY BOSS in all capital letters on the next line, and the price on the bottom line. The layout on each page is identical. We reproduce below the webpages for "UNICORN TEARS" (29 TTABVUE 30) and for the sake of comparison, "WORTH IT." 29 TTABVUE 31 (blue arrow accents added).

¹² Nicole Lee corroborated this testimony. Lee Dec. ¶ 2, 36 TTABVUE 6.

¹³ The webpage indicates that it was accessed from "https:web.archive.org" and that it was active on July 2, 2015.

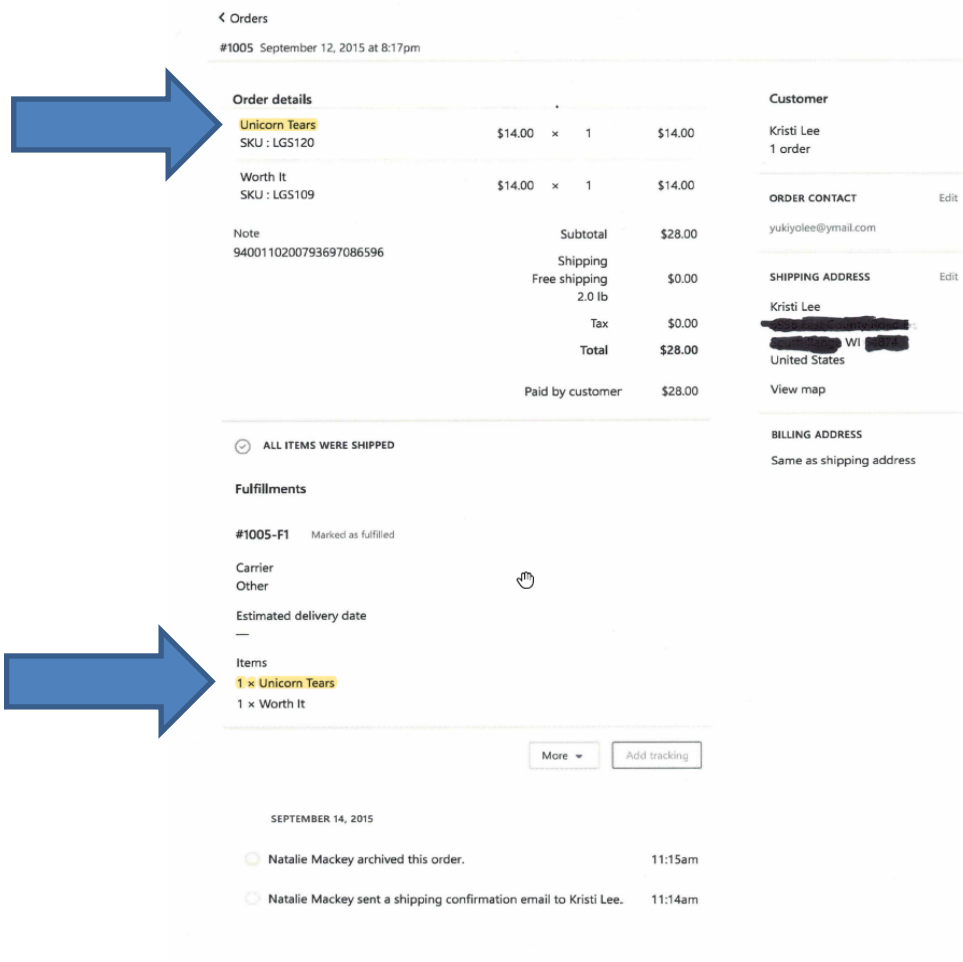




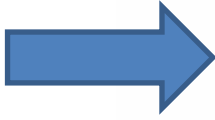
The display of “UNICORN TEARS” on the July 2, 2015 archived webpage shows use of the wording merely as a shade or color name for lip gloss sold as part of the GLOSSY BOSS line from the WINKY LUX brand of cosmetics, one of many such lip gloss shades or colors, and not as a source indicator.

C. Petitioner’s Use of “Unicorn Tears” in September 2015

Ms. Mackey testified that Petitioner first sold lip gloss with the Asserted Mark “affixed” on September 12, 2015.¹⁴ ¶ 11. As proof of sale, Petitioner submitted as Exhibit D a copy of what appears to be an internal invoice dated September 12, 2015 for an order and receipt (with redactions) for one “Unicorn Tears” and one “Worth It” to a purchaser in Wisconsin. We reproduce Exhibit D below (highlights and blue arrow accents added).



¹⁴ Nicole Lee corroborated the first sale of lip gloss with the Asserted Mark “affixed” occurred “at least as early as September of 2015.” 36 TTABVue 6 ¶ 3.



Natalie Mackey fulfilled 2 items. ▾ 11:14am

Items

- 1 × Unicorn Tears LGS120
- 1 × Worth It LGS109

Service
Manual

SEPTEMBER 12, 2015

○ Order confirmation email was sent to Kristi Lee. 8:17pm

A \$28.00 USD payment was processed on PayPal Express Checkout. ▾ 8:17pm

Order

#1005

Authorization key

Message

Success

Amount

\$28.00

Gateway

PayPal Express Checkout

Status

success

Type

sale

Created

Sep 12, 2015, 8:17PM

Information from the gateway

○ Kristi Lee placed this order on Online Store (checkout #2527404099). 8:17pm

Transaction details September 12, 2015 at 8:17:40 PM EDT | Transaction ID: 7HN14562G50843258

Payment received from Kristi Lee Gross amount
Payment Status: Completed \$28.00 USD
Payment Type: Checkout

OK to ship to Seller protection
Kristi Lee Eligible
[Redacted]
[Redacted] WI [Redacted]
United States
218-390-8478
Confirmed

Order details	Quantity	Price	Subtotal
Unicorn Tears	1	\$14.00 USD	\$14.00 USD
Worth It	1	\$14.00 USD	\$14.00 USD
Purchase Total			\$28.00 USD

Payment details	
Purchase Total	\$28.00 USD
Sales Tax	\$0.00 USD
Shipping Amount	\$0.00 USD
Handling Amount	\$0.00 USD
Insurance Amount	\$0.00 USD
Gross Amount	\$28.00 USD
PayPal Fee	-\$1.11 USD
Net Amount	\$26.89 USD

Reversals - Please be aware that payment can still be reversed (e.g. if it is subject to a chargeback), even after you have sent the item(s) to your buyer. Complying with PayPal's Seller Protection and following the trading guidelines on our Security page helps to protect you from things like chargebacks.

Refund information - Please accept or refuse this payment. If you accept this payment now and need to refund it later, the Issue a Refund link will available on transaction details page for 180 days after the payment was originally sent.

Invoice ID c2527404099.1

Paid by Kristi Lee
The sender of this payment is **Unverified**
[Redacted]

Custom Shopify

Ms. Mackey's use of the word "affixed" is vague, and there is no documentary evidence, such as a photograph of use of the Asserted Mark on or in connection with the goods, that would support a finding that Petitioner used the term "Unicorn Tears" as a trademark on September 12, 2015, rather than simply to refer to the shade or color of a particular lip gloss. Exhibit D does not aid Petitioner, as there is no evidence that this apparent internal company invoice was included in the shipment of the lip glosses to, or otherwise shared with, the purchaser.

D. Petitioner's Uses of "Unicorn Tears" November 2015 Through March 31, 2016

Ms. Mackey also testified that in November 2015, she instructed Petitioner's Executive Vice President, Nicole Lee, to market Petitioner's "latest products, including Petitioner's Lip Gloss, to a variety of vendors." Mackey Dec. ¶¶ 12-14, 29 TTABVUE 7-8. Ms. Mackey refers to Ms. Lee's emails from November 2015 (Exhibits E, 29 TTABVUE 36-63) and "line sheets" attached thereto (Exhibit F, 29 TTABVUE 64-75) as evidence of Petitioner's marketing activities, which resulted in additional sales in December 2015 (Exhibit G, 29 TTABVUE 76-88).¹⁵

Ms. Mackey's testimony and supporting marketing materials do not demonstrate Petitioner's use of the wording "Unicorn Tears" as a source indicator. Rather, Exhibits E and F show repeated references by Petitioner to the lip glosses as "glossy bosses" (*see* 29 TTABVUE 36-37, 39, 49, 53, 61 and 69) and a "new line" or "new brand" "called Winky Lux" (*see* 29 TTABVUE 40, 47, 49, 53, 54). *See also* 29 TTABVUE 64-73 (multiple references to Petitioner's lip glosses using the "Winky Lux" and "Glossy Boss" brand names). As Respondent points out in its Brief, of the approximately 40 pages comprising Petitioner's Exhibits E and F, there are only two references to the term "unicorn tears," "both of which plainly refer to 'unicorn tears' as a shade name." 41 TTABVUE 23.

We have reproduced the two pages that refer to "unicorn tears" below (blue arrow accents added). The first is a November 20, 2015 internal email from Nicole Lee to

¹⁵ Nicole Lee corroborated this testimony. Lee Dec. ¶¶ 4-6, 36 TTABVUE 6.

Nathan Newman (both @glowconcept.com) asking "Nate" to send several items to "my selfridges buyer," including "unicorn tears," "radiant pink," and "meow." 29 TTABVUE 62-63.

David Faux

From: Nicole Lee <nicole@glowconcept.com>
Sent: Wednesday, January 10, 2018 3:08 PM
To: Natalie Mackey
Cc: Eric K
Subject: Re: aerie and selfridges

I've already sent this Eric - in addition I sent Sephora and mini luxe

Nicole Lee
[REDACTED]

On Jan 10, 2018, at 2:47 PM, Natalie Mackey <natalie@glowconcept.com> wrote:

Can you get me any correspondence you had with Selfridges and Aerie before Dec 1, 2015 that includes mention of Unicorn Tears? Including but not limited to emails where you sent them line sheets, correspondence around SKUs etc....

Begin forwarded message:

From: Nicole Lee <nicole@laqaandco.com>
Subject: Re: aerie and selfridges
Date: November 20, 2015 at 4:09:44 PM EST
To: Nathan Newman <nathan@glowconcept.com>
Cc: Nathan Newman <nate@glowconcept.com>, Natalie Mackey <natalie@glowconcept.com>

Thanks for your help on this Nate. I'm gonna be in San Fran this coming week and I've got a few other accounts I'll need to send samples to, just waiting to hear back now. I hope that ok?

Have a great weekend and speak soon.

Nicole Lee

On Nov 20, 2015, at 3:19 PM, Nathan Newman <nathan@glowconcept.com> wrote:

I literally have one unit of [REDACTED] left. It will take a couple of weeks but should be here in time for their order if they want it. I will send the last one today when I send [REDACTED] today.

From: Nicole@laqaandco.com [mailto:nicole@laqaandco.com]
Sent: Friday, November 20, 2015 3:12 PM
To: Nathan Newman
Cc: Natalie Mackey
Subject: aerie and selfridges

Hey Nate,

Can you pop in the mail to Aerie to the NYC addr [REDACTED]
[REDACTED] and [REDACTED]...also maybe [REDACTED].

Emily Geller
Aerie/American Eagle

[REDACTED]

Also, I won't have time to send the line to my selfridges buyer before I leave for San fran, is it possible for you to get the below to her:

rainbow brow kit
medium no filter
radiant pink
meow
bunny
city
Royal
Blue Moon
unicorn tears and american pie



I know that seems like a lot for a sample, but [REDACTED]

Emily Saunders
[REDACTED]

Nicole Lee
[REDACTED]
nicole@lagaandco.com

<image001.png>

<image001.png>

The second is marketing material (possibly a “line sheet”) bearing the “Winky Lux” name in the upper right corner of each page, and smaller versions of the graphic of lips modeling the particular shade above the name of the shade (e.g., “Unicorn Tears,” “American Pie,” “Blood Orange,” “Worth It”), a line for the “SKU” (which is blank), and a line for the prices, next to a small artistic representation of a rectangular lip gloss. 29 TTABVUE 69-70.

WINKY LUX

GLOSSY BOSS

Um, yes please! This light weight uber-glossy lip gloss is perfection! It's got vitamin E so it's super good for your lips and doesn't have any of the nasties either! (parabens, talc, gluten). We're also pretty happy that it's made in the USA



WINKY LUX



Unicorn Tears
SKU:
\$7.5/\$14



American Pie
SKU: LPS
\$7.5/\$14



Blood Orange
SKU:
\$7.5/\$14



Worth it
SKU:
\$7.5/\$14



Champaign Fight
SKU:
\$7.5/\$14



Georgia Peaches
SKU:
\$7.5/\$14



Petitioner's other evidence of use of the Asserted Mark prior to Respondent's constructive use date of March 31, 2016 consists of (1) several documents submitted as Exhibit G showing additional sales in December 2015, akin to the document submitted as Exhibit D (Exhibit G is located at 29 TTABVUE 76-88), and (2) Exhibit H, a January 1, 2016 update of the webpage that Petitioner submitted as Exhibit C, showing the same usage of "UNICORN TEARS" as in Exhibit C (Exhibit H is located at 29 TTABVUE 89-97; "UNICORN TEARS" appears on page 91). Exhibits G and H face the same evidentiary deficiencies as discussed above per Exhibits D and C, and do not demonstrate Petitioner's use of the Asserted Mark as a source indicator.

Neither Petitioner nor Respondent pointed to any other evidence of Petitioner's use of the Asserted Mark prior to Respondent's constructive use date of March 31, 2016, and we have found none.

VI. Conclusion

We have considered all of the testimony and evidence pertaining to Petitioner's use of the words "UNICORN TEARS" in association with lip gloss prior to Respondent's constructive use date of March 31, 2016, including Petitioner's first sale on September 15, 2015. *See West Fla. Seafood*, 31 USPQ2d at 1663. As discussed above, however, all such use is as a shade name for one of Petitioner's lip glosses rather than as a source identifier of that particular product. While a shade name may also function as a trademark, *see, e.g., Champion*, 183 USPQ at 320, the record does not support such a finding here.

In addition, oral testimony, even of a single witness, if sufficiently probative, may be sufficient to establish priority of use. *Powermatics, Inc. v. Global Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). *See also Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017). Here, however, the testimony of Ms. Mackey is not particularly clear, and the corroborating testimony of Ms. Lee does not illuminate the manner in which Petitioner used the Asserted Mark as a trademark on or in connection with lip gloss and lip glosses prior to March 31, 2016.

Because Petitioner has not demonstrated the threshold element that it acquired proprietary rights in the Asserted Mark before Respondent's constructive use date of March 31, 2016, Petitioner cannot prevail in its claim of likelihood of confusion under Section 2(d) of the Trademark Act.

Decision: The Petition for Cancellation is denied.