

ESTTA Tracking number: **ESTTA1015959**

Filing date: **11/15/2019**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Grande Cosmetics, LLC		
Entity	Limited Liability Company	Citizenship	United States
Address	180 South Broadway Suite 102 White Plains, NY 10605 UNITED STATES		

Attorney information	Jessica J. Kastner, Esq. Dorf & Nelson LLP 555 Theodore Fremd Ave Rye, NY 10580 UNITED STATES jkastner@dorflaw.com, slocke@dorflaw.com, arodriguez@dorflaw.com, tlebrun@dorflaw.com 914-381-7600		
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Registration Subject to Cancellation

Registration No.	5611105	Registration date	11/20/2018
Registrant	Giovinetti, Sarah Joy 121 Carillon Hill Lane Sellersville, PA 18960 UNITED STATES		

Goods/Services Subject to Cancellation


Class 003. First Use: 2018/05/07 First Use In Commerce: 2018/05/07 All goods and services in the class are subject to cancellation, namely: Cosmetics, namely, non-medicated cosmetic eyelash preparations, eyelash thickeners, eyelash conditioners, eyelash strengtheners
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88661665	Application Date	10/21/2019
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	GRANDELASH-MD
Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Cosmetic preparations; Cosmetic preparations for eyelashes; Non-medicated serums for use on eyelashes

Attachments	88661665#TMSN.png(bytes) Petition to Cancel with Exhibits 11 15 19.pdf(4446449 bytes)
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Signature	/Jessica J. Kastner/
Name	Jessica J. Kastner
Date	11/15/2019

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

In the Matter of Registration No. 5,611,105
Registered on: November 20, 2018
Mark: DR. LASH-MD

-----	}	<u>Cancellation No.</u>
Grande Cosmetics, LLC		
Petitioner,		
v.		
Giovinetti, Sarah Joy	Registant.	-----

PETITION TO CANCEL

Petitioner Grande Cosmetics, LLC (“Petitioner”), a limited liability company organized and existing under the laws of the State of New York, believes that it has been and will continue to be damaged by the registration identified above, and hereby petitions for cancellation of the registration identified above, U.S. Trademark Registration No. 5,611,105 for the mark DR. LASH-MD, pursuant to Section 14 of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064. As grounds for cancellation, Petitioner alleges the following upon information and belief:

PARTIES

1. Petitioner is a limited liability company having an address of 180 South Broadway, Suite 102, White Plains, NY 10605.
2. Sarah Joy Giovinetti (“Registant”) is an individual with an address of 121 Carillon Hill Lane, Sellersville, PA 18960.
3. The United States Patent and Trademark Office’s Trademark Status and Document Retrieval (TSDR) files lists the following correspondence address for

Registrant: Daniel S. Kirshner, Esq., 332 Cranbury Road, East Brunswick, New Jersey United States 08816, daniel@kirshner.com.

STATEMENT OF FACTS

4. In this Petition, Petitioner seeks to cancel the registration of the mark DR. LASH-MD (“Registrant’s Mark”), bearing Registration No. 5,611,105 (the “‘105 Registration”), registered on November 20, 2018.
5. The ‘105 Registration recites the following goods: “Cosmetics, namely, non-medicated cosmetic eyelash preparations, eyelash thickeners, eyelash conditioners, eyelash strengtheners,” in Class 3 (“Registrant’s Goods”).
6. The ‘105 Registration indicates that Registrant’s Mark was first used in commerce on May 7, 2018.
7. As further explained herein, Petitioner has both a real interest in bringing this petition and a reasonable basis for the belief that it has suffered and will continue to suffer damage if the ‘105 Registration is not cancelled.
8. Petitioner is the owner of the mark GrandeLASH-MD (“Petitioner’s Mark”) and the goodwill associated therewith.
9. Petitioner has used Petitioner’s Mark extensively in association with the promotion and sale of Petitioner’s goods, which include cosmetic preparations, cosmetic preparations for eyelashes; non-medicated serums for use on eyelashes (“Petitioner’s Goods”), since at least September 1, 2009.
10. More particularly, Petitioner has used Petitioner’s Mark in interstate commerce in the United States continuously since September 1, 2009, in connection with the distribution, provision, offering for sale, sale, marketing, advertising, and

- promotion of Petitioner's Goods. Attached hereto as **Exhibit A** are true and correct copies of representative samples of materials showing Petitioner's use of Petitioner's Mark in connection with Petitioner's Goods.
11. Petitioner has expended substantial time, money, and resources marketing, advertising, and promoting Petitioner's Goods sold under Petitioner's Mark.
 12. For instance, during the time period of January through September 2019 alone, Petitioner has expended in excess of \$4,900,000.00 on the marketing, advertising, and promotion of Petitioner's Goods sold under Petitioner's Mark. Similarly, Petitioner spent in excess of \$3,900,000.00 in 2018, \$1,840,000.00 in 2017, and \$1,075,000.00 in 2016.
 13. Also for the time period starting in January 2019 and projected through the end of this year, Petitioner will generate approximately \$26,400,000.00 in revenue from the sale of Petitioner's Goods sold under Petitioner's Mark. Similarly, Petitioner generated approximately \$21,600,000.00 in 2018, \$14,400,000.00 in 2017, and \$8,800,000.00 in 2016.
 14. Further, Petitioner has received significant publicity related to Petitioner's Goods sold under Petitioner's Mark, as evidenced by true and correct copies of public material annexed hereto as **Exhibit B**.
 15. As a result of its widespread, continuous, and exclusive use of the Petitioner's Mark to identify Petitioner's Goods, and Petitioner as their source, Petitioner owns valid and subsisting rights to Petitioner's Mark.
 16. Petitioner's Mark is distinctive both to the consuming public and in Petitioner's trade as being source-identifying.

17. Petitioner's Mark is recognized as strong and immediately conveys to the purchasing public that goods associated with Petitioner's Mark are of high quality.
18. As a result of its distinctiveness and widespread use and promotion throughout the United States, Petitioner's Mark is a famous trademark and became famous prior to the filing date of Registrant's application for the '105 Registration, or any other priority date on which Registrant may rely.
19. In addition, on October 21, 2019, Petitioner filed an application with the United States Patent and Trademark Office ("USPTO") to register Petitioner's Mark in connection with Petitioner's Goods in Class 3.
20. The USPTO assigned serial number 88/661,665 (the "'665 Application") to Petitioner's trademark application filed on October 21, 2019.
21. According to the USPTO's website, as the date of this petition, the '665 Application has not yet been assigned to an examiner.
22. Petitioner's Mark was first in use and first used in interstate commerce, no later than September 1, 2009.
23. Petitioner's first use of Petitioner's Mark predates the filing date of Registrant's application for the '105 Registration, as well as any other date on which the Registrant may rely for purposes of priority.
24. In this regard, as requested herein, Petitioner asserts it is entitled to cancellation of Registrant's '105 Registration for Registrant's Mark.

CANCELLATION BASED ON LIKELIHOOD OF CONFUSION

25. Petitioner repeats and reiterates each and every allegation contained in the foregoing paragraphs with the same force and effect as if set forth fully herein.
26. Pursuant to 15 U.S.C. § 1052(d), Petitioner seeks the cancellation of the '105 Registration based on a likelihood of confusion with and Petitioner's prior use of Petitioner's Mark.
27. Registrant's Goods recited in the '105 Registration are substantially similar to Petitioner's Goods marketed and sold in connection with Petitioner's Mark.
28. The '105 Registration is unrestricted as to consumers and trade channels. As such, it is presumed that Registrant's Goods, identified in the '105 Registration are sold to all consumers of said goods, including consumers of Petitioner's Goods, and travel in all ordinary trade channels, including the Petitioner's trade channels, through which Petitioner sells Petitioner's Goods under Petitioner's Mark.
29. Upon information and belief, Registrant sells goods through at least some of the same channels that Petitioner sells Petitioner's Goods.
30. Registrant's Mark is confusingly similar to Petitioner's Mark, when used in connection with Registrant's Class 03 Goods, while like Petitioner's Goods include cosmetics for eyelashes, and, as such, is likely to cause confusion to consumers of said goods, or to cause mistake, and/or to deceive consumers, under Section 2(d) of the Lanham Act, as amended, as to the origins of said goods and/or sponsorship and/or affiliation.

31. As explained herein, Petitioner's Mark and use thereof has priority over Registrant's Mark because Petitioner's use of Petitioner's Mark predates the filing date of Registrant's application for the '105 Registration, as well as the "first use date" for Registrant's Mark.
32. By reason of Registrant's '105 Registration and use of the mark recited therein, Petitioner is being and will continue to be damaged by maintenance of U.S. Trademark Registration No. 5,611,105, on the Principal Register of the USPTO.
33. Accordingly, on the grounds stated herein, Petitioner respectfully requests cancellation of Registrant's '105 Registration.

WHEREFORE, Petitioner respectfully prays that U.S. Trademark Registration No. 5,611,105 be cancelled, and that Petitioner be granted such further relief as may be deemed appropriate. Accompanying this petition is the requisite fee for a petition for cancellation of a trademark.

Dated: Rye, New York
November 15, 2019

Respectfully submitted,
DORF & NELSON LLP



By: _____

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EXHIBIT A

Grande Cosmetics

FREE GROUND SHIPPING ON ORDERS \$100+

GIFTS ▾ BEST SELLERS LASHES LIPS BROWS HAIR EXPLORE ▾

2019 COSMOPOLITAN MAKEUP AWARDS

GrandeLASH-MD Lash Enhancing Serum

\$65.00

★★★★★ 360 Reviews

Sizes
2 mL (3 Month Supply) ▾

QTY
- 1 +

ADD TO CART

ADD TO WISHLIST (40)

DESCRIPTION HOW TO USE INGREDIENTS

Lash Enhancing Serum

An award-winning lash enhancing serum infused with a proprietary blend of vitamins, peptides, and amino acids to promote naturally longer, thicker looking lashes in just 4-6 weeks, with full results in 3 months. It's a favorite for helping to enhance short or thinning lashes and is also ideal for improving the appearance of brittle or damaged lashes. The carefully designed soft-tip brush delivers the perfect amount of product effortlessly to the upper lash line. GrandeLASH-MD is water based, so it is safe to use with lash extensions, false lashes, and contacts. Its safe, easy, and effective formula is ophthalmologist tested & approved.

More Products to Love

Resolving host...

1:35 PM 11/8/2019

Found at: https://grandecosmetics.com/collections/lashes/products/grandelash-md?gclid=EAIaIQobChMIzu7U3cbb5QIVVP_jBx1I0QwMEAAAYASAAEgLvC_D_BwE

GrandeLASH™ - MD Lash Enhancing Serum - P419219

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Makeup > Eye > Mascara



GrandeLASH™ - MD Lash Enhancing Serum

ITEM 1923275

★★★★★ 1K reviews | ❤️ 60K loves

SIZE: 12 Weeks Supply- 0.067 oz/ 2mL

Standard size

12 Weeks Supply- 0.067 oz/ 2mL

Mini size

6 Week Supply- 0.03 oz / 1.0 mL

\$65.00

FREE SHIPPING

1

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Details How to Use Ingredients About the Brand Shipping & returns

Found at: <https://www.sephora.com/product/grandlash-tm-md-lash-enhancing-serum-P419219>

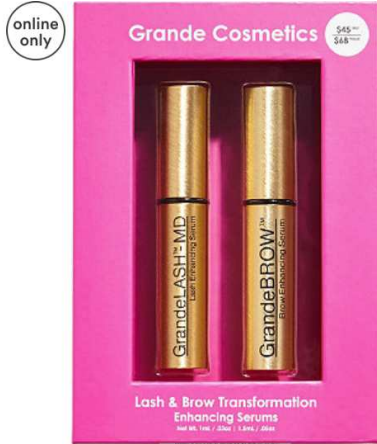


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Holiday Gift Guide

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- Beauty Tips
- SPARKED at Ulta Beauty
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- Book Appointment

Home / Gifts / By Category / Makeup Gifts / Online Only Lash & Brow Transformation Set



Grande Cosmetics

Online Only Lash & Brow Transformation Set

Item 2544859

★★★★☆ REVIEWS

\$45.00 (\$68 value)

Add To Bag



Found at: https://www.ulta.com/lash-brow-transformation-set?productId=pimprod2003439&sku=2544859&cmpid=PS_Non!google!Product_Listing_Ads&cagpspn=pla&CATCI=pla-617798296217&CAAGID=64383224543&CAWELAID=330000200001693979&CATARGETID=330000200001693638&CADevice=c&gclid=EAiaIQobChMIzu7U3cbb5QIVVP_jBx1I0QwMEAQYAyABEgKaL_D_BwE

grandelash-md - Google Search x Amazon.com: Grande Cosmetics x 12 Best Eyelash Serums — Eyelash x

amazon.com/Grande-Cosmetics-GrandeLASH-MD-Month-Supply/dp/B00325D0WK/ref=asc_df_B00325D0WK/?tag=hyprod-20&linkCode=df0&hvadid=312094681845&hvpos=1o4&hvnetw=g&hvrnd=5785928560909586459&hvpone=&hvptwo=&hvqmt=...

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Refinery 29's Top 100 Home gifts

Beauty & Personal Care > Makeup > Eyes > Mascara



Grande Cosmetics

GrandeLASH-MD Lash Enhancing Serum

★★★★☆ 2,301 ratings | 217 answered questions

Amazon's Choice for "lash growth serum"

Price: **\$65.00** (\$95.88 / Fl Oz) & **FREE Shipping** Details

Coupon Save an extra \$6.50 when you apply this coupon. Details

Luxury Beauty

Size: **0.07 Fl Oz**

\$65.00 \$130.00

1 new from \$65.00

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Want it Sunday, Nov. 10? Order within **10 hrs 26 mins** and choose **Two-Day Shipping** at checkout. Details

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EXHIBIT B

See the following links for examples of publicity and recognition of Petitioner's Goods sold under Petitioner's Mark:

The screenshot shows a web browser window displaying an article on Harper's Bazaar. The article title is "The 9 Best Eyelash Serums" and the subtext reads "That is, if you diligently remember to apply them." The author is Jenna Rosenstein, dated May 23, 2019. The article features a carousel of products, with the fifth slide highlighted. This slide is for "GrandeLASH™ - MD Lash Enhancing Serum" by Grande Cosmetics, priced at \$65.00. The product is shown as a gold tube and a black applicator. A testimonial states: "Have you ever noticed that babies have the best eyelashes? We can't promise the same result, but after committing to this lash serum for several weeks, our natural lashes did look significantly longer and thicker." A "SHOP NOW" button is present. To the right, there is a promotional image for "EXPRESS Warmth" with another "SHOP NOW" button. The browser's address bar shows the URL: <https://www.harpersbazaar.com/beauty/makeup/g27529191/best-eyelash-serum/?slide=5>. The Windows taskbar at the bottom shows the time as 1:46 PM on 11/8/2019.

<https://www.harpersbazaar.com/beauty/makeup/g27529191/best-eyelash-serum/>



Makeup's latest lash and brow serum features hemp-derived cannabis seed extract to help hydrate and condition.



7

UNDER \$75
Grande Cosmetics GrandeLash MD Lash Enhancing Serum

amazon.com
\$65.00

[SHOP NOW](#)

GrandeLash has a solid fan-base on Sephora.com, with 81 percent of users recommending the serum to others. The award-winning serum promises longer, thicker lashes in four to six weeks.

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<https://www.womenshealthmag.com/beauty/g22128287/best-eyelash-growth-serums/>

mirror aerobics. - AK



BEST LASH TREATMENT

LASH ENHANCING SERUM
GrandeLASH™ - MD
\$65.00

SHOP NOW

"I swear my lashes looked way longer after using this for three months. And most important, I didn't experience any redness or itchiness on my eyelids like I had when using other lash-enhancing serums." - LB



BEST PENCIL LINER

WATERPROOF EYE PENCIL
CLARINS
\$22.95

SHOP NOW

"I got caught in a tsunami-level downpour wearing this liner, and my cat eye didn't even notice. For a formula so blendable and silky, it was surprisingly resistant. Unlike my hair." - CM



BEST EYE SHADOW

CHROMAFUSION® EYE SHADOW
Mary Kay

SHOP NOW

"I love the texture of these powder shadows. They feel really soft and creamy and give insane color payoff (aka they actually show up on skin) even when I just quickly tap them on using my fingers." - LB


juice THE FRAGRANCE COLLECTION SERVED BY COSMOPOLITAN SHOP NOW

https://www.cosmopolitan.com/style-beauty/beauty/a27288703/cosmo-makeup-awards-2019/

12 Eyelash Serums That May Have You Ditching Mascara

And (maybe) the falsies too.

By Celia Fernandez Jul 30, 2019




7 of 12

GrandeLASH-MD Lash Enhancing Serum

sephora.com
\$65.00

[SHOP NOW](#)

A Sephora customer favorite, this serum is said to promote naturally longer, thicker-looking lashes in just four to six weeks. "It not only stimulates healthy growth of new lashes, but it strengthens and hydrates lashes you currently have," says Dr. Joshua Zeichner, Director of Cosmetic and Clinical Research at the Department of Dermatology at The Mount Sinai Hospital.



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ULTA

GRANDE COSMETICS GRANDELASH-MD LASH-ENHANCING SERUM

I've been using this for almost a year straight and get stopped mid-sentence all the time by people asking if my lashes are real. I recommend it to everyone and have gotten approximately 30 people hooked. You've been warned.

BUY IT (\$65)



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BEAUTY

Apr 16, 2019

By Tore Northman

44,201

HERE'S HOW I GREW MY LASHES LONG AND LUSCIOUS IN ONLY THREE WEEKS

Fool-proof.

If you, like me, are all about lashes – I've found the product for you. I've always loved dramatic eyelashes, whether its through a pair of falsies or layers of mascara, and the lift it instantly gives your eyes and face even without makeup. For a long time I've been looking for a way to naturally grow my lashes, because extensions are time-consuming and expensive, which is when I came across Grande Lash MD. To be honest, I've never been a big believer in serums and "miracle products," but something in me told me to give it a chance.

After doing my research, I found that the serum claimed to result in "longer, thicker and batted eyelashes," with "effects visible after two weeks of application," with loads of people raving about the product online. After taking a look at before-and-after shots, I definitely believed the hype and knew that it would be worth testing out. In addition, the product is made up from ingredients that are safe for both your skin and eyes, and won't leave an irritation or mess with your face. "An award-winning eyelash growth serum. Formulated with a blend of vitamins, antioxidants and amino acids, LASH-MD Lash Enhancing Serum is proven to deliver longer, thicker looking lashes," states the website – so I decided to give it a try to see what all the hype was about.

After applying the clear serum, just like you would apply your regular eyeliner, before going to bed for two



<https://hypebae.com/2019/4/how-to-grow-eyelashes-serum-review>



Nars Radiant Creamy Concealer Mini (\$13)

SHOP

The only concealer you'll ever need comes in tiny form too. Fun fact: [Pete Davidson](#) strutted down the Alexander Wang runway this month wearing this ride-or-die concealer. Welcome to the fan club, Pete.

07 GrandeLASH-MD Lash Enhancing Serum

of 14



Grande Cosmetics GrandeLASH-MD Lash Enhancing Serum Mini (\$34)

SHOP

Get used to saying, "They're real". This lash enhancer is the best one out there by far. Simply put: This really works.

08 Embryolisse Lait Crème


of 14

<https://www.byrdie.com/best-travel-sized-beauty-products-4690913>

Hot Skincare Summer: What This x +

perezhilton.com/skincare-beauty-summer-trends-2019/#grande-cosmetics

PEREZHILTON Galleries Quizzes PerezTV CocoPerez FitPerez TeddyHilton Perezito



Which of these travel destination would you consider visiting?

- Saudi
- Maldives
- USA
- Dubai
- Vietnam
- None of the above

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Ready to achieve your #LashGOALS? GrandeLASH-MD is here to help! It only takes one swipe a day for 3 months to see full result! Shop our 30% off selected items sale and get a 6-month supply of GrandeLASHMD for only \$69.

#GrandeCosmetics #GrandeLASHMD #GrandeLASH

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This summer is all about achieving our goals, and for some people, that includes enhancing your lashes! GrandeLash-MD (available [HERE](#)) is doing the thang, so you'll have an enviable set of flutters by fall!



These Are The Least Humble Housewife Taglines Of ...

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Resolving host...

1:41 PM 11/8/2019

<https://perezhilton.com/skincare-beauty-summer-trends-2019/#grande-cosmetics>