

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
March 13, 2010

Mailed:  
August 1, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Lush Ltd.  
v.  
Luscious, LLC

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Opposition No. 91158982  
to application Serial No. 78143126  
filed on July 11, 2002

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Cosmetic Warriors Limited  
v.  
Luscious, LLC

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Opposition No. 91169017  
to application Serial No. 78506882  
filed on October 27, 2004

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John A. Clifford, Rachel Zimmerman and Danielle I.  
Mattessich of Merchant & Gould PC for Lush Ltd. and Cosmetic  
Warriors Limited.

Austin G. Bosarge of Turning Point Law for Luscious, LLC.

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Before Kuhlke, Wellington and Lykos, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Luscious, LLC (Luscious), seeks registration  
of the mark LUSCIOUS COSMETICS ("Cosmetics" disclaimed) for

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goods identified as "cosmetics, namely, non-medicated lip balm, lip cream, lip gloss, lip liner, lip stick, lip sheer, lip stain, eye make-up, eye make-up remover, eye pencils, eye shadow, eye liners, eye brow pencils, eye cream, eye gel, eye balm, face powder, face concealers, face foundation, face cleansers, face creams, face emulsions, face masks, face scrubs, pre-moistened cosmetic towelettes, blush, bronzer, highlighter, body powder, cheek stain, mascara, brow gel, hair mascara, bath oil, bath tablets, bath gels, bath soaps, body creams, skin lotion, body masks, body scrub, body gel, hair mask, nail polish, nail lacquer, cuticle cream, nail oil," in International Class 3,<sup>1</sup> and services identified as "online retail store services, retail store services and mail-order retail services all featuring cosmetics, toiletries, spa, skin, hair care, and beauty care products, accessories, apparel, home décor and bags," in International Class 35.<sup>2</sup>

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<sup>1</sup> Serial No. 78143126, filed on July 11, 2002, based on allegations of first use on January 23, 2002 and first use in commerce on June 28, 2002 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). The mark is depicted in typed form. Applicant's amendment to assert a Section 1(b) basis, 15 U.S.C. § 1051(b), for all of the goods, with the exception of nail polish was accepted on April 13, 2006.

<sup>2</sup> Serial No. 78506882, filed on October 27, 2004, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The mark is depicted in standard characters. This application also includes goods in International class 18; however, opposer, Cosmetic Warriors Limited, filed a notice of opposition against only the services listed in International Class 35.

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Opposers, Lush Ltd. (Lush) and Cosmetic Warriors Limited (CWL) separately, in each of their oppositions, opposed registration of applicant's mark on the grounds that, as applied to applicant's goods and services, the mark so resembles opposers' previously used and registered LUSH mark for a wide variety of cosmetic products, including lip balms, bath gels and bath soaps, body powder, face creams and skin lotions, and retail services (mail order, online and brick and mortar all featuring these cosmetic products) as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In its opposition against Serial No. 78143126, in addition to pleading prior use, Lush pleaded ownership of Registration No. 2282428. In its opposition against Serial No. 78506882, opposer CWL pleaded ownership of Registration No. 2853483.

By its answers in each opposition, applicant denies the salient allegations.<sup>3</sup>

As a preliminary matter we note that although consolidated, the proceedings maintain their separate identity. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 511 (3<sup>rd</sup> ed. rev. 2012). Each plaintiff must prove its standing and claim against the specific

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<sup>3</sup> Applicant' "affirmative defenses" are more in the nature of amplifications of its denials.

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application it opposed. Thus, Lush must prove its standing, priority and likelihood of confusion against application Serial No. 78143126, and CWL must prove its standing, priority and likelihood of confusion against application Serial No. 78506882.

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), the files of the opposed applications. Opposers submitted the testimony depositions, with exhibits, of Sarah L. Cole, head of tax and legal for Lush, Brandi Halls, North American Public Relations Manager for Lush Cosmetics NY, LLC, a subsidiary of Lush, and Danielle Ida Mattessich, opposers' outside counsel; and opposers' notice of reliance on files of the subject applications,<sup>4</sup> several of CWL's registrations, applicant's responses to certain interrogatories, the discovery deposition of Charity Vance (applicant's owner), dictionary definitions and an article from a printed publication.

Applicant submitted a notice of reliance on applicant's responses and supplemental responses to certain interrogatories and excerpts from the discovery deposition of Charity Vance (pursuant to Trademark Rule 2.120(j)(5)), opposers' responses to certain interrogatories and requests for admissions, motions and orders from this proceeding,

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<sup>4</sup> The submission of the subject application files was unnecessary as they were already of record pursuant to Trademark Rule 2.122(b).

portions of two of applicant's application files not subject to these proceedings, third-party registrations, and portions of one of opposer's application files not subject to these proceedings.

#### THE PARTIES

The opposers, CWL and Lush, are related companies that develop, produce and sell cosmetic and personal care products.<sup>5</sup> CWL has a master license agreement with Lush to "make use of the intellectual property of [CWL] and to manufacture, distribute and market products under the Lush mark and other marks that [CWL] owns."<sup>6</sup> CWL now owns Registration No. 2282428 issued on October 5, 1999, for the mark LUSH (in typed form) for "perfumes; non-medicated toilet and cosmetic preparations, namely, lotions, powders and creams for use on the skin, personal deodorants, preparations for the care of the hair, shampoos, soaps" in International Class 3, pleaded by Lush in Opposition No. 91158982, and Registration No. 2853483 for the mark LUSH for "bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of

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<sup>5</sup> See, e.g., Cole Test. pp. 7, 10.

<sup>6</sup> Cole Test. p. 7.

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a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries" in International Class 35, pleaded by CWL in Opposition No. 91169017.<sup>7</sup> These registrations are valid and subsisting.<sup>8</sup>

Applicant, Luscious, was originally formed between 1999 and 2000. After selecting the name Luscious in 2000, applicant considered what product line it would pursue, from bikinis to cosmetics.<sup>9</sup> Applicant eventually settled on cosmetics, beginning with nail polish.<sup>10</sup>

**STANDING/PRIORITY**

Because CWL has made its pleaded Registration No. 2853483 of record and has shown that the registration is valid and subsisting and owned by CWL, CWL has established its standing to oppose registration of applicant's mark and its priority is not in issue.<sup>11</sup> See King Candy Co., Inc. v.

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<sup>7</sup> Cole Test. pp. 13-14, Exhs. 31-33.

<sup>8</sup> Id.

<sup>9</sup> App. NOR Exh. 2 (Applicant's Responses to Opposers' Interrogatories).

<sup>10</sup> Opp. NOR, Exh. 7 (Applicant's Responses to Opposers' Interrogatories), Exh. 8 (Charity Vance's Discovery Deposition).

<sup>11</sup> As applicant noted, although opposer introduced status and title copies of several other registrations, it did not plead them. We add that opposer never sought to amend the pleadings to assert these additional registrations. In view thereof, we have only considered the pleaded and proven registrations in making our findings as to standing and priority.

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Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As noted above, Lush pleaded ownership of Registration No. 2282428. However, that registration is now owned by CWL.<sup>12</sup> Thus, Lush may not rely on that registration for standing and priority. However, Lush has proven its standing and priority. The record establishes that Lush is CWL's licensee and that in 1996 Lush first sold, via mail order in the United States, soap, bath bombs, bath melts, and skin preparations under the mark LUSH.<sup>13</sup> Further, the record shows that Lush has continuously sold such products in the United States and has expanded its channels of trade to include the internet, its own brick and mortar stores and third-party department stores).<sup>14</sup>

Accordingly, we turn to the question of likelihood of confusion.

**LIKELIHOOD OF CONFUSION**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In

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<sup>12</sup> Cole Test. p. 13, Exh. 31. Moreover, based on the execution date of the assignment it is not clear that Lush owned the registration at the time it filed the opposition. Nonetheless, Lush asserted prior use based on common law rights.

<sup>13</sup> Cole. Test. pp. 7, 10, 12.

<sup>14</sup> Cole Test. p. 19.

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re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Opposers presented evidence and argument on the factors of the similarity of the marks, the relatedness of the goods and services, channels of trade, classes of purchasers and the strength of the LUSH mark.

We begin with the strength of opposers' LUSH mark in order to determine the scope of protection to be accorded opposers' mark as we analyze the other du Pont factors. The strength of a mark "may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

As noted above, the record shows that the LUSH brand has been growing in success over the past 16 years. In promoting its brand, opposers have employed both somewhat untraditional as well as more traditional advertising methods. Promotion of the mark began with catalog/newsletters and word of mouth, which included a celebrity fan base.<sup>15</sup> Over time the extent of its advertising has grown to include all types of traditional

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<sup>15</sup> Halls Test. pp. 12, 20; Cole Test. pp. 34-35.

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and social media (print, radio, internet - website, Facebook, Twitter, YouTube - and television), including being featured on various morning and afternoon talk shows (e.g., Ellen). In print, the LUSH mark is featured in prominent advertising in a wide variety of nationally distributed magazines (Cosmo Girl, Nylon, Allure, Better Homes and Gardens, American Baby, Family Circle).<sup>16</sup> The LUSH mark also receives exposure through opposers' various charitable campaigns, most notably its "charity pot" program whereby proceeds from the sale of specific products go to support various charities and non-governmental organizations within a community.<sup>17</sup> The manner in which opposers put the brand in front of consumers is also designed to attract attention. For example, their "naked campaign," addressing the issue of excess packaging, involved employees promoting the products in front of the stores attired only in their shop aprons.<sup>18</sup>

On balance we find that while this record does not support a finding of fame such that it "plays a 'dominant' role in the process of balancing the du Pont factors," *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), it does establish that opposers' mark LUSH is

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<sup>16</sup> Halls Test. pp. 21-38; Cole Test. p. 35.

<sup>17</sup> Cole Test. pp. 34, 45.

<sup>18</sup> Cole Test. p. 43.

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very strong and widely known.<sup>19</sup> In view thereof, we accord the mark a broad scope of protection.

We now consider whether the marks LUSH and LUSCIOUS COSMETICS are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. In making this finding, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

The first part of applicant's mark LUSCIOUS is identical in sound and very similar in appearance to the first part of opposers' mark LUSH. *Hercules Inc. v. National Starch & Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) ("considering the marks NATROL and NATROSOL in their entireties, the clearly dominant aspect of both marks is that the first four letters and the final two are the same."). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689; *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("there are also similarities between them in that both start with the term 'KID' a matter

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<sup>19</sup> Applicant's arguments regarding the timing of opposers' fame are misplaced. For purposes of a claim under Section 2(d), a plaintiff may rely on the establishment of fame through the trial period.

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of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

More importantly, both marks include in their definitions the words "luxurious," "aromatic" and "sensuous."<sup>20</sup> As such, the connotation of the marks, viewed in connection with the relevant goods and services, is identical. Notably, one of the definitions of the word "lush" is "luscious" and the words are used interchangeably.<sup>21</sup> Opposers' uses of the various terms derived from LUSH further demonstrate the close connotation between the marks. For example, opposers have employed the word LUSHIOUSLY in one of their advertising campaigns. Applicant quite rightly argues that the use of this form began after applicant's use of its LUSCIOUS mark. We simply note this use in further support of our finding that the respective marks have identical connotations. Further, the additional word "cosmetics" in applicant's mark simply names the goods and does not serve to distinguish the marks. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (It is well settled that one feature of a mark may be more significant than another, and it is not

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<sup>20</sup> Opp. NOR Exh. 9 Webster's Third New International Dictionary of the English Language (2002).

<sup>21</sup> Id.; Opp. NOR Exh. 10 Merriam-Webster's Collegiate Thesaurus (1988).

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improper to give more weight to this dominant feature when evaluating the similarities of the marks.) Given the identical connotation and the similarities in sound and appearance we find the overall commercial impression to be similar. In view thereof, we find the marks in their entireties to be similar, which favors finding a likelihood of confusion.

This brings us then to our consideration of the similarities between opposers' and applicant's goods and services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods and services as they are recited in the applications and registrations. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Because each proceeding has a different plaintiff challenging a different application with different goods and services we make our analysis separately and begin with

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CWL's opposition to application Serial No. 78506882. As noted above, applicant's services are identified as "online retail store services, retail store services and mail-order retail services all featuring cosmetics, toiletries, spa, skin, hair care, and beauty care products, accessories, apparel, home décor and bags." CWL's services are identified in its pleaded Registration No. 2853483 as "bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods in a retail cosmetics and toiletries store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a mail order catalogue, or from an Internet web site, specializing in the marketing of cosmetics and toiletries" in International Class 35. Both parties' services include retail services in the field of cosmetics and toiletries provided in store, online and via mail order, as such, they are legally identical.

Further, in view of the absence of any limitations and the identical nature of the services we must presume that the channels of trade and classes of purchasers overlap. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers,

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these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade."); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

With regard to Lush's opposition to application Serial No. 78143126, Lush's soaps and skin preparations encompass many of the goods in the application (e.g., bath oil, bath tablets, bath gels, bath soaps, body creams, skin lotion, body gel), and therefore are legally identical. Furthermore, it is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

With regard to the channels of trade and classes of purchasers, in view of the absence of restrictions in the application as to trade channels and purchasers, we must presume that applicant's goods would be sold in all ordinary channels of trade and offered to all ordinary classes of consumers for these goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir.

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2002); and Octocom, 16 USPQ2d 1783. Such trade channels would include department stores like Macy's.

Certainly, Lush's types of goods are routinely sold in department stores. In fact, in addition to selling its goods via mail order, online and in its own stores, Lush also sells its products in the cosmetic section of Macy's department stores.<sup>22</sup> Further, Lush's consumers include people of all ages.<sup>23</sup> Thus, for purposes of our analysis, the channels of trade overlap, at a minimum, in department stores, and the goods are offered to some of the same classes of consumers.

As to the conditions of sale, Lush products range in price from five dollars to eighty five dollars.<sup>24</sup> Applicant's products sell for approximately twenty dollars.<sup>25</sup> Inasmuch as the goods are relatively inexpensive, purchasers are less likely to exercise care in the purchasing process.

Thus, the relatedness of the goods and services, channels of trade, classes of purchasers and conditions of sale all favor a finding of likelihood of confusion as to both applications.

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<sup>22</sup> Cole Test. pp. 28, 110.

<sup>23</sup> Cole Test. p. 62.

<sup>24</sup> Cole Test. p. 30.

<sup>25</sup> Cole Test. Exh. 72.

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Applicant argues that while opposers have taken action against third parties using marks that contain some form of the word LUSH, opposers did not take action to prevent applicant's other marks LUSCIOUS-LITE and LUSCIOUS BLOOMS from registering. Opposers counter that applicant's other marks create a different commercial impression and that while they challenge marks that create a similar commercial impression to the LUSH mark they also encourage competition in the market place. Reply Br. p. 5. Further, opposers argue that "[t]he fact that [opposers have] not opposed certain marks because they connote a different commercial impression from its LUSH mark - i.e., marks that combine LUSCIOUS with non-generic terms - is not inconsistent with [opposers'] right to oppose marks that have the same commercial impression as its LUSH mark, such as the LUSCIOUS COSMETICS mark at issue here." Reply Br. p. 5.

As noted by opposers, "it is entirely reasonable for the opposer to object to the use of certain marks in use on some goods which it believes would conflict with the use of its marks on its goods and services while not objecting to use of a similar mark on other goods which it does not believe would conflict with its own use." *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899-1900 (TTAB 1989). Similarly, it is entirely reasonable for opposers to object to the mark LUSCIOUS combined with a generic term while not

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objecting to marks that incorporate the term LUSICOUS with other matter.

Finally, applicant argues that despite being in the same "geographical and service areas" since 2004 there have been no instances of actual confusion. However, there is no evidence in the record to support a finding that there has been a meaningful opportunity for confusion to occur. In fact, the record supports the opposite conclusion inasmuch as applicant's use has been limited to nail polish and there is no evidence of applicant's "appreciable and continuous use" of its mark. *Gillette Can., Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In view thereof we consider this factor to be neutral.

Considering the respective marks in their entireties, the strength of opposers' mark, the relatedness of the goods and services, and the overlap in trade channels and purchasers, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a likelihood of confusion between opposers' LUSH mark and applicant's LUSCISOUS COSMETICS mark.

**Decision:** The oppositions are sustained. Application Serial No. 78143126 will be abandoned and Serial No. 78506882 will proceed only as to the goods listed in International Class 18.