

ESTTA Tracking number: **ESTTA356281**

Filing date: **07/02/2010**

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	Skullcandy, Inc.
Granted to Date of previous extension	07/03/2010
Address	1441 W. Ute Blvd Suite 250 Park City, UT 84098 UNITED STATES

Attorney information	Matthew A. Barlow Workman Nydegger 60 East South Temple Suite 1000 Salt Lake City, UT 84111 UNITED STATES mfrodsham@wnlaw.com, mbarlow@wnlaw.com Phone:801-533-9800
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**Applicant Information**

Application No	77894049	Publication date	05/04/2010
Opposition Filing Date	07/02/2010	Opposition Period Ends	07/03/2010
Applicant	Exact Science Productions LLC 4130 18th Street San Francisco, CA 94114 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Headwear; Shirts; Sweat shirts
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3381053	Application Date	06/12/2007
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of artistic rendering of a human skull.
Goods/Services	Class 025. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Clothing and headwear, namely t-shirts, sweatshirts, and hats

U.S. Registration No.	3381050	Application Date	06/12/2007
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Clothing and headwear, namely t-shirts, sweatshirts, and hats		

U.S. Registration No.	3168754	Application Date	02/07/2006
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2003/01/12 First Use In Commerce: 2003/01/12 Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets

U.S. Registration No.	3168695	Application Date	01/10/2006
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/01/12 First Use In Commerce: 2003/01/12 Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets		

U.S. Registration No.	3794944	Application Date	02/02/2009
Registration Date	05/25/2010	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a stylized skull.
Goods/Services	Class 018. First use: First Use: 2005/12/01 First Use In Commerce: 2005/12/01 Bags, namely, backpacks, book bags, sports bags, handbags

U.S. Registration No.	3788707	Application Date	01/23/2009
Registration Date	05/11/2010	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2005/12/01 First Use In Commerce: 2005/12/01 Bags, namely, backpacks, book bags, sports bags, and handbags		

Attachments	77204379#TMSN.jpeg ( 1 page )( bytes ) 77204362#TMSN.jpeg ( 1 page )( bytes ) 78809362#TMSN.jpeg ( 1 page )( bytes ) 78788980#TMSN.jpeg ( 1 page )( bytes ) 77979195#TMSN.jpeg ( 1 page )( bytes ) 77979143#TMSN.jpeg ( 1 page )( bytes ) Opposition to 77894049.pdf ( 6 pages )(51418 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Matthew A. Barlow/
Name	Matthew A. Barlow
Date	07/02/2010

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

In the matter of: Trademark Application Serial No. 77/894,049  
Published in the Official Gazette on May 4, 2010 at TM 768  
International Class: 025  
Filed: December 15, 2009

Mark:  (design only)

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SKULLCANDY, INC.,

Opposer,

v.

EXACT SCIENCE PRODUCTIONS LLC,

Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, Skullcandy, Inc. (“Opposer”), a Delaware corporation with its principal place of business at 1441 Ute Blvd Park City, Utah 84098, believes that it will be damaged by registration of the mark shown in United States Trademark Application Serial No. 77/894,049, in International Class 025, and hereby opposes the same. The grounds for the opposition are as follows:

1. Upon information and belief, Applicant Exact Science Productions, LLC (“Applicant”) is a California limited liability company with an address of 4130 18th Street San

Francisco, California 94114. Applicant seeks to register the design “” as a trademark to be

used in International Class 025, as evidenced by the publication of such mark in the Official Gazette at TM 768 of the May 4, 2010 issue, in conjunction with goods identified as “Headwear; Shirts; Sweat shirts” (“Applicant’s Mark”)

2. Applicant filed its intent-to-use application for registration for such mark on December 15, 2009, and received an application serial number of 77/894,049.

3. Since at least as early as 2003, Opposer has developed and continuously used the mark “SKULLCANDY” along with a skull design, on or in connection with various goods, including headsets, headphones, ear buds, earphones, backpacks, book bags, sports bags, handbags, t-shirts, sweatshirts, and hats, in interstate commerce throughout the United States and throughout the world.

4. Opposer is the owner of the following relevant trademarks which have been registered with the United States Patent and Trademark Office (collectively, “the SKULLCANDY marks”):

<b>Registration No.</b>	<b>Mark</b>	<b>Goods and Services</b>
3,381,053		Clothing and headwear, namely t-shirts, sweatshirts, and hats. (in International Class 025)
3,381,050	SKULLCANDY	Clothing and headwear, namely t-shirts, sweatshirts, and hats. (in International Class 025)
3,168,754		Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets. (in International Class 009)
3,168,695	SKULLCANDY	Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely,

		MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets. (in International Class 009)
3,794,944		Bags, namely, backpacks, book bags, sports bags, handbags (in International Class 018)
3,788,707	SKULLCANDY	Bags, namely, backpacks, book bags, sports bags, handbags (in International Class 018)

5. Since Opposer's initial use of the SKULLCANDY Marks, Opposer has made a substantial investment in marketing and promoting its goods and services under its SKULLCANDY Marks. Opposer has used, advertised, promoted and offered for sale goods and services in association with its SKULLCANDY Marks with the result that Opposer's customers and the general public have come to know and recognize the SKULLCANDY Marks and that the public associates these marks with Opposer and/or its goods and services.

6. Opposer has used the SKULLCANDY Marks to distinguish its products, including, but not limited to, t-shirts, sweatshirts, and hats, from other goods of the same type. Opposer's SKULLCANDY Marks are distinctive and serve as a unique designation of origin with respect to the goods and services offered by Opposer. Opposer has acquired substantial goodwill in the SKULLCANDY Marks through use thereof.

7. Notwithstanding the inherent distinctiveness of the SKULLCANDY Marks, Opposer's SKULLCANDY Marks have also acquired secondary meaning to the public indicating Opposer as the source of goods and services bearing the SKULLCANDY Marks.

8. Applicant's mark identified in its application is confusingly similar to the SKULLCANDY Marks. Applicant's mark is the image of a skull, much like the design mark claimed by Opposer in United States Trademark Registration Nos. 3,381,053, 3,168,754, 3,794,944. Applicant's design further incorporates headphones, a product sold with great

success by Opposer. Accordingly, Applicant's mark is likewise similar in appearance and connotation with the SKULLCANDY Marks owned by Opposer.

9. As evidenced by the goods and services identified in Applicant's registration, the mark proposed for registration by Applicant, is or will be applied to goods that are identical to the goods and services provided by Opposer, namely, shirts, sweatshirts, and hats. Applicant's mark coupled with the goods for which registration is sought so nearly resembles the SKULLCANDY Marks as to be likely to be confused therewith and mistaken therefore and to confuse, mislead, and deceive the consuming public as to the source or origin of Applicant's goods, cause confusion or mistake as to the origin, sponsorship or approval of Applicant's goods, services and/or commercial activities, and/or cause confusion or mistake as to the affiliation, connection or association of Applicant and Opposer.

10. Applicant's use of the mark identified in its application and in the manner described therein creates a likelihood of confusion with the SKULLCANDY Marks. The likelihood of confusion in the marketplace exists between the SKULLCANDY Marks and Applicant's Mark when applied to the goods and services of the respective parties.

11. Applicant's use of the mark identified in its application and in the manner described therein will also dilute the distinctive and famous nature of the SKULLCANDY Marks.

12. If Applicant is permitted to register its mark for its goods as specified in the application herein opposed, such registration would result in confusion in the trade by reason of the similarity between Applicant's Mark and the SKULLCANDY Marks, thereby damaging and injuring Opposer. Any such confusion may result in the loss of business to Opposer. Furthermore, any defect, objection or fault in the goods sold by Applicant under its mark may

reflect upon and injure the reputation which Opposer has established for its products sold in association with or using the SKULLCANDY Marks.

13. If Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* right to the use of its mark. Such registration would be a further source of damage to Opposer.

14. In view of the foregoing, Applicant is not entitled to federal registration of its claimed mark because Applicant's Mark as used upon its identified goods is not entitled to protection. Further, Applicant does not have a right to exclusive use of said mark in commerce on Applicant's goods. Applicant's claimed mark does not and cannot function to identify such goods and to distinguish them from goods offered by Opposer.

WHEREFORE Opposer prays that this opposition be sustained and that the Application be refused, and for such other and further relief at law or in equity as the Commissioner of Patents and Trademarks shall deem necessary or appropriate under the circumstances.

The fee required under 37 C.F.R. § 2.6(17) is being submitted herewith.

DATED this 2nd day of July, 2010.

Respectfully submitted,

By: /Matthew A. Barlow/  
Michael J. Frodsham (Reg. No. 48,699)  
Matthew A. Barlow

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Attorneys for Opposer  
SKULLCANDY, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant by mailing true copies thereof to Applicant and to its attorney of record, via First Class Mail, postage prepaid this 2nd day of July, 2010, in envelopes addressed as follows:

/Matthew A. Barlow/

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