

ESTTA Tracking number: **ESTTA535295**

Filing date: **04/30/2013**

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

Proceeding	91210090
Party	Defendant Valor Communication, Inc.
Correspondence Address	THOMAS I ROZSA ROZSA LAW GROUP LC 18757 BURBANK BLVD STE 220 TARZANA, CA 91356-3346 UNITED STATES
Submission	Answer
Filer's Name	Thomas I. Rozsa
Filer's e-mail	amy@rozsaw.com
Signature	/Thomas I. Rozsa/
Date	04/30/2013
Attachments	Answer.pdf ( 25 pages )(642371 bytes )



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1. Answering Paragraph 1 of the Opposition, Applicant admits the allegations of said Paragraph 1 of the Opposition.

2. Answering Paragraph 2 of the Opposition, Applicant admits the allegations of said Paragraph 2 of the Opposition.

3. Answering Paragraph 3 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 3 of the Opposition.

4. Answering Paragraph 4 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 4 of the Opposition.

5. Answering Paragraph 5 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 5 of the Opposition.

6. Answering Paragraph 6 of the Opposition with regards to the statement that "*The goods and services offered by Opposer in association with the SKULLCANDY MARKS are such that the consuming public will likely be confused as to the source of goods offered by Applicant*", Applicant denies each and every, all and singular, the allegations set forth above. With regards to the remaining allegations set forth in Paragraph 6, Application has insufficient information and belief to admit or deny the remaining allegations contained therein and basing its denial on that ground, denies each

1 and every, all and singular, the remaining allegations of said Paragraph 6 of the Opposition.

2  
3 7. Answering Paragraph 7 of the Opposition, Applicant has insufficient  
4 information and belief to admit or deny the allegations contained therein and basing its  
5 denial on that ground, denies each and every, all and singular, the allegations of said  
6 Paragraph 7 of the Opposition.

7  
8 8. Answering Paragraph 8 of the Opposition, Applicant has insufficient  
9 information and belief to admit or deny the allegations contained therein and basing its  
10 denial on that ground, denies each and every, all and singular, the allegations of said  
11 Paragraph 8 of the Opposition.

12  
13 9. Answering Paragraph 9 of the Opposition, Applicant denies each and  
14 every, all and singular, the allegations of said Paragraph 9 of the Opposition.

15  
16 10. Answering Paragraph 10 of the Opposition, Applicant denies each and  
17 every, all and singular, the allegations of said Paragraph 10 of the Opposition.

18  
19 11. Answering Paragraph 11 of the Opposition, Applicant denies each and  
20 every, all and singular, the allegations of said Paragraph 11 of the Opposition.

21  
22 12. Answering Paragraph 12 of the Opposition, Applicant denies each and  
23 every, all and singular, the allegations of said Paragraph 12 of the Opposition.

24  
25 13. Answering Paragraph 13 of the Opposition, Applicant denies each and  
26 every, all and singular, the allegations of said Paragraph 13 of the Opposition.

27  
28 14. Answering Paragraph 14 of the Opposition, Applicant denies each and  
every, all and singular, the allegations of said Paragraph 14 of the Opposition.

15. Answering Paragraph 15 of the Opposition, Applicant denies each and  
every, all and singular, the allegations of said Paragraph 15 of the Opposition.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**AFFIRMATIVE DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

16. As a first, separate and distinct affirmative defense to the Opposition and each claim stated therein, Applicant alleges that the term "SKULL" is a very common term and no one company has exclusivity to use of the term "SKULL" for all products. Attached hereto as **Exhibit 1** is a printout showing that there are over 458 trademark applications or registrations which have used the trademark "SKULL" (some of which have gone abandoned) in all trademark classes. This is clear proof that no one has any exclusivity to the term "SKULL" for all products and all services.

**SECOND AFFIRMATIVE DEFENSE**

17. As a second, separate and distinct affirmative defense to the Opposition and each claim stated therein, Applicant alleges that several other companies have applied for trademarks which include the term "SKULL" in International Classes 9, 35, 25 and 18, "SKULL" is a generic term for use in conjunction with various goods and services in International Classes 9, 35, 25 and 18. Just because Opposer is very litigious and initiates oppositions opposing any pending application which uses the term "SKULL", does not make Opposer entitled to the exclusive right to the word "SKULL" apart from the mark as shown. Their success in filing oppositions does not grant Opposer the exclusive right to use the term "SKULL".

**THIRD AFFIRMATIVE DEFENSE**

18. As a third, separate and distinct affirmative defense to the Opposition and

1 each claim stated therein, Applicant states that Applicant's total mark is  
2 **SKULLCAP** and Opposer has unfairly dissected the Applicant's mark. Applicant  
3 alleges that Applicant's composite mark and Opposer's mark must be compared by looking  
4 at them in their entirety, although their weak and common elements may be given less  
5 weight. The Applicant's mark and Opposer's mark have the term "SKULL" in common.  
6 However, this commonality of elements is not sufficient to create likelihood of confusion.  
7 There is no one individual that has an exclusivity to the words "SKULL". Opposer's  
8 marks are for "SKULLCANDY". This is totally different in overall visual impression and  
9 meaning from the Applicant's present mark for **SKULLCAP**. The general rule is  
10 that marks in controversy are compared in their entirety. Glow Industries v. Lopez, 273  
11 F. Supp. 2d 1095, 1123 (D. Cal. 2003) (likelihood of confusion "cannot be predicted on  
12 dissection of a mark, that is, on only part of a mark), (citing In re National Data Corp., 753  
13 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985)). On the other hand, it is a well  
14 established rule that where, as here, Applicant's mark consists of more than one element,  
15 each bearing different semantic weight, a tribunal may attach more or less significance to  
16 particular features of one mark in determining similarity between marks, provided the  
17 ultimate decision is based on consideration of the marks as a whole. Sleepmaster  
18 Products Co. v. American Auto-Felt Corp., 241 F.2d 738, 741, 113 U.S.P.Q. 63, 65  
19 (C.C.P.A. 1957) anti-dissection rule "does not bar consideration of the different features of  
20 the marks in determining the importance to be attached thereto". Glow Industries v.  
21 Lopez, 273 F. Supp. 2d 1095, 1123 (D. Cal. 2003) ("although the involved marks must be  
22 regarded in their entirety, it is proper to recognize that one feature of a mark is more  
23 significant than the other features and to give greater force and effect to that dominant  
24 feature") (citing Burger Chef Systems, Inc. v. Sandwich Chef, Inc., 608 F.2d 875, 878,

1 (C.C.P.A. 1979)). Parkcard Press, Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1357  
2 (Fed. Cir. 2000) ("it is not improper to state that, for rational reasons, more or less weight  
3 has been given to a particular feature of the mark, provided the ultimate conclusion rests on  
4 consideration of the marks in their entireties."). See also 3 McCarthy On Trademarks §  
5 23:44 ("one feature of a mark may be more significant and it is proper to give greater force  
6 and effect to that dominant feature"). Further, when the common element between the  
7 two marks is a word that is weak, the likelihood of confusion is accordingly reduced. 3  
8 McCarthy on Trademarks § 23:48.  
9

#### 10 FOURTH AFFIRMATIVE DEFENSE

11  
12 19. As a fourth separate and distinct affirmative defense to the Opposition and  
13 each claim stated therein, comparison of sight and sound show Applicant's mark is not  
14 confusingly similar with the cited registrations. The Applicant's mark and Opposer's  
15 mark have different sounds and meanings as encountered in the marketplace. The degree  
16 of similarity is tested on three levels as encountered in the marketplace; appearance (or  
17 sight), sound and meaning. Dreamwerks Prod. Group v. SKG Studio, 142 F.3d 1127,  
18 1129 (9<sup>th</sup> Cir. 1998), Faberge, Inc. v. Dr. Babor GmbH & Co., 219 U.S.P.Q. 848, 851  
19 (T.T.A.B. 1983). The inquiry depends on taking account of all relevant facts in a  
20 particular case. In re Lamson Oil Co., 6 U.S.P.Q. 2d 1041, 1042 n.4 (T.T.A.B. 1987).  
21 Each of the non-common elements of the present mark has a different appearance and  
22 meaning. Opposer's marks look different from Applicant's **SKULLCAP**. Even  
23 when words in a mark are "virtually identical in pronunciation" to another mark, there may  
24 still exist "no substantial similarity" between the two marks. Mead Data Cent., Inc. v.  
25 Toyota Motor Sales, Inc., 875 F.2d 1026, 1029 (2d Cir. 1989).  
26  
27  
28

In Mead, the United States Court of Appeals for the Second Circuit found

1 that Toyota's mark LEXUS for a luxury car, did not sound similar to Mead's mark LEXIS  
2 for a legal software database, even though the words in the marks sounded "virtually  
3 identical in pronunciation." Id. The Court first held that "the similarity must be  
4 substantial," id. at 1029, and then held that using "commonsense" commercial speech,  
5 "there is no substantial similarity" between the sounds of the two marks. Id. at 1030.  
6

#### 7 8 FIFTH AFFIRMATIVE DEFENSE

9 20. As a fifth, separate and distinct affirmative defense to the Opposition and  
10 each claim stated therein, Applicant alleges that comparison of meaning show Applicant's  
11 mark is not confusingly similar. In particular the word, "CAP" is extremely important in  
12 view of the nature of Applicant's goods. The visual impression of Applicant's mark is  
13 totally different from Opposer's mark. The similarity or dissimilarity of the various marks  
14 "in their entirety as to connotation" must be weighed in a likelihood of confusion analysis.

15  
16 In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567  
17 (C.C.P.A. 1973) emphasis added). Hart v. New York P'ship, 2006 U.S. App. LEXIS  
18 14315 (Fed. Cir. 2006); Alberto-Culver Co. v. Trevive, Inc., 199 F. Supp. 2d 1004 (D.  
19 Cal. 2002); Miguel Torres, S.A. v. Bodegas Muga, S.A., 176 Fed. Appx. 124 (Fed. Cir.  
20 2006); Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396  
21 F.3d 1369, 1371 (Fed. Cir. 2005); Shen Mfg. Co. v. Ritz Hotel, Ltd., 393 F.3d 1238, 1241  
22 (Fed. Cir. 2004); Herbko Int'l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1165 (Fed. Cir.  
23 2002). See also Luigino's, Inc. v. Stouffer Corp., 170 F.3d 827, 830 (8<sup>th</sup> Cir. 1999) ("The  
24 use of identical dominant words does not automatically mean that two marks are similar...  
25 We must look to the overall impression created by the marks, not merely compare  
26 individual features.") Although Applicant's mark and Opposer's mark contain a very  
27  
28

1 common term, this is not sufficient to make the marks confusingly similar in the overall  
2 impression because as shown above, Opposer's marks and **SKULLCAP** have  
3 very different images in the minds of the relevant consumers. Champagne Louis  
4 Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d, 1459, 1460  
5 (Fed. Cir. 1998). As Professor McCarthy notes "[I]f two conflicting marks each have an  
6 aura of suggestion, but each suggests something different to the buyer, this tends to  
7 indicate a lack of likelihood of confusion. Similarly, marks may be phonetically similar,  
8 but confusion is prevented by the different suggestive connotations of the marks. 3  
9 McCarthy On Trademarks § 23:28. As a result, marks may be found to be dissimilar "[a]s  
10 a result of their different meanings when applied to the goods of the applicant and  
11 registrant." In re Sears, Roebuck Co., 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987).

12  
13 In Sears, the Trademark Trial and Appeal Board found that  
14 CROSS-OVER for bras was not confusingly similar to CROSSOVER for tops, shorts and  
15 pants even though the two marks were "legally identical in sound and appearance" because  
16 CROSS-OVER was suggestive of the constructive of the bras, while CROSSOVER  
17 "convey[ed] no such meaning." Sears at 1314. In Champagne Louis Roederer, the  
18 Federal Circuit affirmed the Board's finding that CRYSTAL CREEK for wine was not  
19 confusingly similar to CRISTAL and CRISTAL CHAMPAGNE for champagne even  
20 though the goods, channels of trade and customers were legally identical, and the opposer's  
21 marks were very strong, because CRISTAL "suggested the clarity of the opposer's wine  
22 within the bottle or the glass of which the bottle itself was made," while CRYSTAL  
23 CREEK "suggested a very clear (and thus probably remote from civilization) creek or  
24 stream." Champagne 148 F.3d at 1375, 47 U.S.P.Q.2d at 1460. Applicant's mark and the  
25 cited mark here are more dissimilar in meaning than were the marks in Sears and  
26  
27  
28

1 Champagne Louis Roederer, and the differences in meaning are more than sufficient to  
2 overcome any similarities in sight and sound.

3  
4 Words that may have the same or similar meaning have been held  
5 not to be confusingly similar. In Dawn Donut Co. v. Day, 450 F.2d 332, (10<sup>th</sup> cir. 1971),  
6 the court held that while DAWN and DAYLIGHT are interchangeable with "early morning  
7 hours," the distinction between the words causes the words to not be confusingly similar.  
8 "Dawn" connotes the first appearance of light at morning. 'Daylight' includes all of the  
9 period when the sun is shining on a particular area of the earth. Although 'Dawn' may  
10 suggest freshness, 'Daylight' does not." Id. at 333.

11  
12  
13 SIXTH AFFIRMATIVE DEFENSE

14 21. As a sixth, separate and distinct affirmative defense to the Opposition and  
15 each claim stated therein, Applicant alleges that the Opposition and each and every  
16 paragraph stated therein fails to state a cause of action against the Applicant.

17  
18 SEVENTH AFFIRMATIVE DEFENSE

19 22. As a seventh, separate and distinct affirmative defense to the Opposition and  
20 each claim stated therein, Applicant alleges that the Opposer sustained no damage, injury  
21 or prejudice as a result of Applicant's trademark application for **SKULLCAP**.

22  
23  
24 EIGHTH AFFIRMATIVE DEFENSE

25 23. As a eighth, separate and distinct affirmative defense to the Opposition and  
26 each claim stated therein, Applicant alleges that the use of the term "SKULL" is very  
27 common and there is no exclusivity to this term. Therefore, Opposer and Applicant can  
28

ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

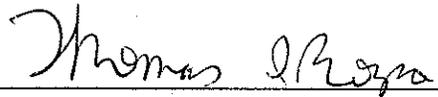
1 peacefully coexist with their respective uses for their marks for their respective products in  
2 the classes as referenced above.

3  
4  
5 WHEREFORE, Applicant requests that the Opposition to Trademark Application  
6 Serial No. 85/739,358 be denied and that Opposer take nothing by way of its Opposition.

7  
8 If there is any charge required for the filing of this Answer to Notice of Opposition,  
9 the Commissioner of Patents and Trademarks is hereby authorized to charge my Deposit  
10 Account No. 18-2222 for the appropriate fee.

11  
12 Please send all correspondence concerning this Opposition to Thomas I. Rozsa, at  
13 the address listed below.

14  
15 Respectfully submitted,

16 

17 Date: April 30, 2013

18 Thomas I. Rozsa  
19 Registration No. 29,210  
20 Attorney for Applicant  
21 Valor Communication, Inc.  
22 18757 Burbank Boulevard, Suite 220  
23 Tarzana, California 91356-3346  
24 Telephone: (818) 783-0990  
25 Telecopier: (818) 783-0992  
26  
27  
28

ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

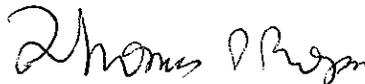
1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

CERTIFICATE OF SERVICE

I hereby certify that a copy of the document entitled ANSWER TO NOTICE OF  
OPPOSITION was sent on April 30, 2013 via first class mail, postage prepaid, to the  
attorneys for the Opposers at the following address:

Michael J. Frodsham  
Matthew A. Barlow  
WORKMAN NYDEGGER  
60 East South Temple, Suite 1000  
Salt Lake City, Utah 84111

Dated: April 30, 2013

  
Thomas I. Rozsa  
Registration No. 29,210

In Re Opposition No. 91210090

ans.opp

# EXHIBIT 1



United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System(Tess)

TESS was last updated on Mon Apr 29 02:47:26 EDT 2013

Logout [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [ADVANCED DICH](#) [SEARCH LOG](#) [PREV LIST](#) [NEXT LIST](#) [BACK TO HIT LIST](#) [BOTTOM](#) [HELP](#)

Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record:

Total documents in the Image Library are: 458. (This page: 1 ~ 100)

<p>Skull Rock</p> <p>85910575</p>	<p>RED SKULL</p> <p>85909990</p>	<p>3 SKULL</p> <p>85822718</p>
<p>SEVEN SKULLS MC</p> <p>85821295</p>	<p>SKULL</p> <p>85252745</p>	<p>SKULL &amp; BONES BACK</p> <p>85778267</p>

SkullCrazy

85688170

CASTLE GRAYSKULL

85902680

Skull Sugar Cosmetics

85814296



85495251



85770283

CASTLE GRAYSKULLMAN

85683520

SKULLFACE

85575450

SKULLSAW

85428623



85790370

<p><b>SKULL SOAP</b></p> <p>85708179</p>	<p>SKULTIMATE ROLLER MAZE</p> <p>85660706</p>	<p><b>BLACK N SKULL</b></p> <p>85600705</p>
<p><b>SKULLS AND SAND</b></p> <p>85808479</p>	<p></p> <p>2ND SKULL</p> <p>85752625</p>	<p><b>2ND SKULL</b></p> <p>85689026</p>
<p><b>SKULL GAP</b></p> <p>85739358</p>	<p><b>RED SKULL</b></p>	<p></p>

<p>85383218</p>	<p>85888575</p>
<p>SKULL RIOT</p>	<p>HOLLYWOOD SKULLYZ</p>
<p>85764014</p>	<p>85690846</p>
<p>SKULL JELLY</p>	<p>Everything Skullbase</p>
<p>85668112</p>	<p>85878251</p>
<p>SKULLS &amp; SWORDS</p>	<p>Krull Corp.</p>
<p>85484106</p>	<p>85878251</p>

CALAVERA CUTLERY

85877771



85060632



85057544

Skull Shaver

85675526

SKULL CASHMERE

85830406

GREYSKULL BREWING COMPANY

85789772

SKULLS & ROSES

85509023

Skullcrusher Beer



Skullcrusher Beer

85481096

SUGAR SKULL

85871716



SKULLETTE

85868064

SKULLS ON FIRE

85861447

SKULLCANDY

85603313

Skull Krushers

85857264

SKULL THEATRE

85855686

SKULL BLASTER

85854167

Language Skull

85363303

MR. SKULL

85718982

REALSKULL

85588374

Skull Mezcal

85733987

CASTLE GRAYSKULL

85237249



SKULLHEADS

85533609

SOFTSKUL

famous skulls



<p>85483029</p>	<p>85831621</p>	<p>85824689</p>
<p>CASTLE GRAYSKULL</p>	<p>SKULLCANDY</p>	<p>SKULLCRUSHER</p>
<p>85237246</p>	<p>85812037</p>	<p>85812015</p>
<p>SKULLCAP</p>	<p>Lucky Skull</p>	<p>EVERYBODY LOVES THE SKULL</p>
<p>85739351</p>	<p>85496753</p>	<p>85714303</p>

Skull Shine

85608316

SKULL MONKEY GEAR

85571831



85676954

Sugar Skulls Salon

85662086



85414139

SKULL STEAMER

85666647

SKULTIMATE ROLLER MAZE

85442149



85425279

SKULL WIZARD

85520863

SKULLCANDY

85447177

COME TO WHERE THE TALENT  
IS SUGAR SKULLS SALON

85681007



85584256

SKULL CRUSH

85422752

BEERSKULL

85652675

SKULL WAX

85320215

Affordable Skulls

85376804

SKULL JACK

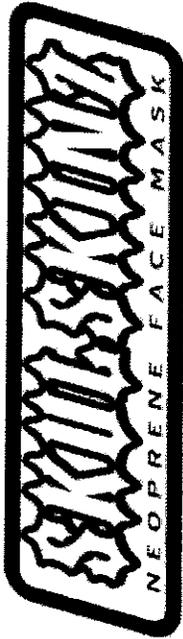
85317012

GRIM SKULL

85370109

<p>Skullboy</p> <p>85528725</p>	<p>LAS CALAVERAS</p> <p>85483329</p>	<p>Skul</p> <p>85460537</p>
<p>SkullShield</p> <p>85442109</p>	<p>SKULL SPLITTER</p> <p>85084443</p>	<p>SKULLXBONES</p> <p>85152145</p>
<p>WHAT'S IN URSKULL?</p>	<p>URSKULL</p>	<p>SKULL CAP</p>

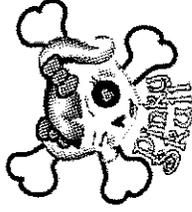
<p>85586381</p>	<p>85586362</p>	<p>85498030</p>
<p>SKULLEBRITIES</p>	<p>WISKULLSIN</p>	<p>SKULL SHORES</p>
<p>85518618</p>	<p>85484661</p>	<p>85365617</p>
<p>SKULL BASE FOUNDATION</p>	<p>SKULL BOUND</p>	<p>SkullBase</p>
<p>85465203</p>	<p>85301869</p>	<p>85317562</p>



85440181



85319998



85231292

# NorthSkull

85080248

TESS HOME | NEW USER | STRUCTURED | FREE FORM | BROWSE DICT | SEARCH LOG | PREV LIST | NEXT LIST | BACK TO HIT LIST | TOP | HELP

| HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY