

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

HARTNETT/BUTLER

Mailed: June 20, 2014

Opposition No. 91214782

Skullcandy, Inc.

v.

Subjekt LLC

By the Trademark Trial and Appeal Board:

Subjekt LLC (“Applicant”) seeks registration on the Principal Register for the mark displayed below,



for goods identified in the application as follows:

“Headphones; Audio headphones; Headphones including attached lanyard; Personal headphones for sound transmitting apparatuses; Personal headphones for use with sound transmitting systems; Stereo headphones; Earphones; Audio earphones; Earphones including attached lanyard; Personal earphones for use with sound transmitting systems; Stereo earphones; Protective covers and cases for cell phones, tablet computers and media players” in International Class 9.¹

¹ Application Serial No. 85884443, filed on March 22, 2013, based upon an assertion of use in commerce under Section 1(a) of the Trademark Act and alleging March 9, 2009 as the date of first use anywhere and date of first use in commerce. The mark

On February 5, 2014, Skullcandy, Inc. (“Opposer”) filed a notice of opposition opposing the registration of Applicant’s mark on the grounds of priority and likelihood of confusion under Trademark Act Section 2(d). In support of its asserted claim Opposer claims ownership of the following previously used and registered mark:



for “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 9.²

In lieu of filing an answer to the notice of opposition, Applicant filed a motion to dismiss on March 17, 2014, pursuant to Fed. R. Civ. P. 12(b)(6), for failure to state a claim upon which relief can be granted. Opposer filed a timely response to Applicant’s motion on April 7, 2014.

In support of its motion, Applicant maintains that Opposer has failed to plead sufficient factual matter that would establish standing to bring the opposition. Similarly, Applicant asserts that Opposer’s pleadings are merely conclusory and lack factual support for establishing the statutory grounds for

is describe as consisting of “an alien head wearing headphones. The alien has irregular shaped eyes that touch in the center of its face.”

² Registration No. 3168754, issued on November 7, 2006. Opposer describes its mark as a “skull design.”

priority of use and likelihood of confusion. In view of the foregoing, Applicant requests that the opposition be dismissed with prejudice.

Decision

A motion under Fed. R. Civ. P. 12(b)(6) is a test solely of the legal adequacy of a complaint, and not whether the alleged evidence is sufficient to prove a plaintiff's claims. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (“The purpose of the rule is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail...”). *See also* TBMP § 503.02. Whether the plaintiff has offered enough factual support to prove its allegation is not to be determined during a 12(b)(6) analysis, but instead should be determined at final hearing or upon summary judgment, after the parties have been given the opportunity to submit evidence. *See Advanced Cardiovascular*, 988 F.2d at 1160, 26 USPQ2d at 1041. *See also* TBMP § 503.02.

In order to withstand a motion to dismiss under Fed. R. Civ. P. 12(b)(6), a complaint need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the sought registration. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011). *See also* TBMP § 503.02. Specifically, a complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544,

570 (2007)). An opposer need only plead enough to “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

A. Standing

In order to establish standing an opposer must allege facts sufficient to show a “real interest” in the proceeding and must have a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. Opposer must allege a “direct and personal stake” in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); TBMP § 309.03(b).

Allegations of standing are sufficient where a plaintiff pleads a claim of likelihood of confusion that is not wholly without merit, including claims based upon the current ownership of a valid and subsisting registration or prior use of a confusingly similar mark. *See* TBMP § 309.03(b).

Here, in its notice of opposition, Opposer alleges common law rights and ownership of a valid registration for its  mark. Opposer alleges that registration of Applicant’s mark for similar goods would violate Opposer’s rights in its own mark. The Board finds that the aforementioned allegations are sufficient to establish standing to oppose.

In view thereof, Applicant’s motion to dismiss, to the extent it pertains to Opposer’s allegations regarding its standing, is **DENIED**.

B. Priority and Likelihood of Confusion

In order to properly state a claim of likelihood of confusion, Opposer must plead (and later prove) that (1) Applicant's mark, as applied to its goods or services, so resembles Opposer's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) it has priority of use. *See* Fed. R. Civ. P. 8; *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

For a proper claim of priority of use, Opposer must plead (and later prove) facts showing proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark. In an opposition, priority is not in issue where the opposer pleads (and later proves) that it owns a registration for its pleaded mark. *See King Candy*, 182 USPQ at 110; and TBMP § 303.03(c). Here, Opposer alleges ownership of a registered mark.³ In view of Opposer's pleaded registration, and the absence of a counterclaim to cancel said registration, opposer has sufficiently alleged priority. *See, e.g., L'Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1436 (TTAB 2012) (priority not disputed where registration properly introduced and no counterclaim exists).

³ The Board acknowledges Opposer's submission of a copy of its certificate of registration. While the copy provides additional notice to Applicant of Opposer's claim, it is not the proper submission to introduce the registration into evidence. In order to introduce a registration into evidence with the complaint, the plaintiff must submit a current status and title copy of the registration prepared by the Office or attach a current printout from the USPTO's electronic database, TSDR, to show current status and title. Trademark Rule 2.122(d); 37 C.F.R. § 2.122(d). *See also* TBMP § 317. In this case, opposer did not do so. Consequently, opposer must introduce the registration either at summary judgment or at trial. *See* TBMP §§ 528.05(d) and 704.03(b)(1)(A), respectively.

Within the notice of opposition Opposer identifies its own mark and goods, as well as the Applicant's mark and goods, alleging that issuance of a registration to Applicant will lead to likelihood of confusion. ¶¶ 1-5 of the notice of opposition. Opposer alleges, *inter alia*, that the opposed mark is confusingly similar to its own in appearance and commercial impression, ¶ 6; that the goods for each party are either identical or closely related and are offered to similar or overlapping classes of purchasers, ¶ 7; and that the mark when used with Applicant's goods is likely to cause confusion and mistake, mislead consumers, and generally deceive the trade and public, all of which would damage the Opposer, ¶ 8.

The Board finds that foregoing allegations are sufficient to plead a claim of priority of use and likelihood of confusion. Accordingly, Applicant's motion to dismiss, to the extent it pertains to Opposer's allegations regarding its ground for opposition, is **DENIED**.

Proceedings are resumed and dates, including Applicant's time to answer, are reset below.

Trial Schedule

Time to Answer	7/16/2014
Deadline for Discovery Conference	8/15/2014
Discovery Opens	8/15/2014
Initial Disclosures Due	9/14/2014
Expert Disclosures Due	1/12/2015
Discovery Closes	2/11/2015
Plaintiff's Pretrial Disclosures	3/28/2015
Plaintiff's 30-day Trial Period Ends	5/12/2015
Defendant's Pretrial Disclosures	5/27/2015
Defendant's 30-day Trial Period Ends	7/11/2015

Plaintiff's Rebuttal Disclosures
Plaintiff's 15-day Rebuttal Period Ends

7/26/2015
8/25/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.