

ESTTA Tracking number: **ESTTA745493**

Filing date: **05/10/2016**

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 requests to cancel indicated registration.

Petitioner Information

Name	Skullcandy, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1441 Ute Blvd., Suite 250 Park City, UT 84908 UNITED STATES		

Attorney information	Christopher M. Dolan Barnes & Thornburg LLP PO Box 2786 Chicago, IL 60690-2786 UNITED STATES cdolan@btlaw.com, enolan@btlaw.com, mballesteros@btlaw.com, trademarks-ch@btlaw.com Phone:312.357.1313		
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Registration Subject to Cancellation

Registration No	4222545	Registration date	10/09/2012
Registrant	Argento SC By Sicura Inc Suite 2201 New York, NY 10018 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2010/07/01 First Use In Commerce: 2010/07/01 All goods and services in the class are cancelled, namely: Audio speakers; headphones, earbuds and earphones; automotive mounts for GPS devices; holders, armbands, clips, and carrying cases specially adapted for cellular phones and portable handheld digital devices; automobile stereo adapters, cell phone battery chargers, and electrical connectors, wires and cables for cellular phones and portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, audio, image and video files

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)
Dilution by tarnishment	Trademark Act Sections 14(1) and 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3168695	Application Date	01/10/2006
Registration Date	11/07/2006	Foreign Priority	NONE

		Date	
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.	3726304	Application Date	07/30/2008
Registration Date	12/15/2009	Foreign Priority Date	NONE
Word Mark	SKULLCANDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/01 First Use In Commerce: 2003/03/01 Retail store services, kiosks and online retail store services featuring 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, covers for portable media players, digital phones, earphones, and headphones, protective helmets, [protective helmets for sports, sports helmets, watches,] sacks or bags, namely, backpacks, messenger bags, all purpose sports and athletic bags, [sunglasses,] clothing and headwear, namely, t-shirts, sweatshirts, * and * hats[, and bandanas]		

Attachments	78788980#TMSN.png(bytes) 77534577#TMSN.png(bytes) EAR CANDY Ex A.pdf(769323 bytes) EAR CANDY Ex B.pdf(43942 bytes)
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	Cancellation.pdf(17144 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	/Christopher M. Dolan/
Name	Christopher M. Dolan
Date	05/10/2016

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

<p>Skullcandy, Inc.,</p> <p style="text-align:center">Petitioner,</p> <p style="text-align:center">v.</p> <p>Argento SC By Sicura Inc,</p> <p style="text-align:center">Respondent.</p>	<p>Cancellation No.:</p> <p>U.S. Registration No.: 4,222,545</p>
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PETITION FOR CANCELLATION

Skullcandy, Inc., a corporation duly organized and existing under the laws of Delaware, with an office at 1441 Ute Blvd., Suite 250, Park City, Utah 84908 ("Skullcandy" or "Petitioner"), believes that it has been and will continue to be damaged by United States Trademark Registration No. 4,222,545 registered on October 9, 2012, by Argento SC by Sicura Inc. a corporation of New York with a place of business at 1407 Broadway, Suite 2201, New York, New York 10018 ("Respondent") and therefore petitions to cancel such registration pursuant to 15 U.S.C. § 1063. In support of its petition, Petitioner states as follows:

1. Respondent is the owner of U.S. Trademark Registration, No. 4,222,545 for the mark EAR CANDY in International Class 9 ("EAR CANDY Mark").
2. Since long prior to Respondent's January 28, 2011 filing date, and alleged July 1, 2010 first use date, of the EAR CANDY Mark, Skullcandy has continuously and extensively used, in interstate commerce throughout the United States, the SKULLCANDY mark, alone and in connection with other words and designs (collectively the "SKULLCANDY Marks"), on and in connection with the advertising, promotion, offer and sale of various goods and services,

including without limitation headsets, headphones, ear buds, earphones, audio equipment and retail services (“Skullcandy’s Goods and Services”).

3. Skullcandy has invested considerable money, time, and effort into the use, advertising, and promotion of the SKULLCANDY Marks for use in connection with Skullcandy’s Goods and Services. As a result of extensive investment in the SKULLCANDY Marks, Skullcandy owns strong common law rights in the SKULLCANDY Marks, embodying very valuable goodwill, and the SKULLCANDY Marks have become well-known in the United States.

4. In addition to its common law trademark rights, Skullcandy owns, among others, the following federal trademark registrations for its well-known SKULLCANDY Marks:

Mark	Reg. No.	Reg. Date	Goods
SKULLCANDY	3,168,695	Nov. 7, 2006	Class 9: Devices for hands-free use of mobile phones; Headphones
SKULLCANDY	3,726,304	Dec. 15, 2009	Class 35: Retail store services, kiosks and online retail store services featuring 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, covers for portable media players, digital phones, earphones, and headphones, protective helmets, sacks or bags, namely, backpacks, messenger bags, all purpose sports and athletic bags, clothing and headwear, namely, t-shirts, sweatshirts, and hats

5. Current copies of the TSDR printouts for the foregoing registrations are attached as Exhibit A. These federal registrations are valid, subsisting and in full force and effect.

Registration No. 3,168,695 is incontestable pursuant to 15 U.S.C. § 1065, and serves as

conclusive evidence of Skullcandy's ownership and exclusive right to use the subject mark in commerce in connection with the goods referenced in the registration.

6. Notwithstanding Skullcandy's prior rights in and to the SKULLCANDY Marks, on January 28, 2011, Respondent filed an application for registration of the EAR CANDY mark which registered on October 9, 2012 reciting the following goods in International Class 9:

Audio speakers; headphones, earbuds and earphones; automotive mounts for GPS devices; holders, armbands, clips, and carryings cases specially adapted for cellular phones and portable handheld digital devices; automobile stereo adapters, cell phone battery chargers, and electrical connectors, wires and cables for cellular phones and portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, audio, image and video files.

At the time it filed its application, Respondent had at least constructive knowledge of Skullcandy's rights in the SKULLCANDY Marks.

7. Respondent's EAR CANDY Registration issued less than five (5) years from the date of filing this Petition. A copy of the current status report and Certificate of Registration are attached as Exhibit B.

8. Skullcandy's rights in the SKULLCANDY Marks predate Respondent's rights in the EAR CANDY Mark.

9. The EAR CANDY Mark is confusingly similar, in appearance, sound, meaning, and commercial impression to Skullcandy's SKULLCANDY Marks. The continued registration and use of the EAR CANDY Mark by Respondent in association with the recited goods is likely to cause confusion as to the source or origin of Respondent's goods and is likely to mislead consumers, all to Skullcandy's damage.

10. The goods and services that Skullcandy provides under the SKULLCANDY Marks, and the goods and services for which the SKULLCANDY Marks are registered, are

identical or, at a minimum, closely related, to the goods listed in the EAR CANDY Registration and the goods and services are offered to similar or overlapping classes of purchasers.

11. The EAR CANDY Mark, when used in connection with Respondent's registered goods, is likely to cause confusion, to cause mistake, and to deceive the trade and public, who, upon seeing the EAR CANDY Mark in connection with the registered goods, would believe that such goods originate with, are approved, sponsored, or endorsed by, or have some connection or affiliation with Skullcandy. Accordingly, the continued use and registration of the EAR CANDY Mark would damage Skullcandy and therefore, the EAR CANDY Mark should be cancelled pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

12. The EAR CANDY Mark, when used in connection with Respondent's goods is likely to cause dilution of Skullcandy's famous SKULLCANDY Marks, be lessening the capacity of the SKULLCANDY Marks to identify and distinguish Skullcandy's goods and services and by harming the reputation of the SKULLCANDY Marks, all to Skullcandy's detriment. Skullcandy's SKULLCANDY Marks were famous prior to the filing date of the EAR CANDY Mark. Accordingly, the EAR CANDY Mark should be cancelled based on a likelihood of dilution by blurring and tarnishment, pursuant to 15 U.S.C. § 1125(c).

WHEREFORE, Skullcandy believes that it is and will continue to be damaged by the EAR CANDY Mark and therefore respectfully requested that Registration No. 4,222,545 be cancelled.

The Director is hereby authorized to charge the filing fee for this Petition for Cancellation to Deposit Account No. 12-0913.

Respectfully submitted,

SKULLCANDY, INC.

Dated: May 10, 2016

By: /Christopher M. Dolan/

Christopher M. Dolan
Genevieve E. Charlton
BARNES & THORNBURG LLP
One North Wacker Drive, Suite 4400
Chicago, IL 60606
(312) 357-1313

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 10, 2016, a true and correct copy of the foregoing PETITION FOR CANCELLATION was served upon Respondent via Respondent's attorneys of record, by United States Mail, First Class service, sufficient postage prepaid, in an envelope addressed as follows:

Terrence A. Oved, Esq.
Oved & Oved LLP
101 Avenue Of The Americas, Floor 15
New York, New York 10013-1941

/Christopher M. Dolan/

Exhibit A

The "Maintenance Tab" has been temporarily removed while it undergoes improvements. It will be returned to TSDR when the improvements are complete.

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Generated on:	This page was generated by TSDR on 2016-05-09 15:20:18 EDT		
Mark:	SKULLCANDY		
	SKULLCANDY		
US Serial Number:	78788980	Application Filing Date:	Jan. 10, 2006
US Registration Number:	3168695	Registration Date:	Nov. 07, 2006
Filed as TEAS Plus:	Yes	Currently TEAS Plus:	Yes
Register:	Principal		
Mark Type:	Trademark		
TM5 Common Status	LIVE/REGISTRATION/Issued and Active		
Descriptor:	 The trademark application has been registered with the O		
Status:	A Sections 8 and 15 combined declaration has been accepted and acknowledged.		
Status Date:	Dec. 04, 2012		
Publication Date:	Aug. 22, 2006		

[▲ Mark Information](#)
[▼ Expand All](#)

[▲ Related Properties Information](#)

[▲ Goods and Services](#)

[▲ Basis Information \(Case Level\)](#)

[▼ Current Owner\(s\) Information](#)

Owner Name:	Skullcandy, Inc.		
Owner Address:	1441 W. Ute Blvd Suite 250 Park City, UTAH UNITED STATES 84098		
Legal Entity Type:	CORPORATION	State or Country Where Organized:	DELAWARE

[▲ Attorney/Correspondence Information](#)

[▲ Prosecution History](#)

▲ [Maintenance Filings or Post Registration Information](#)

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Generated on:	This page was generated by TSDR on 2016-05-09 15:17:15 EDT		
Mark:	SKULLCANDY		
	SKULLCANDY		
US Serial Number:	77534577	Application Filing Date:	Jul. 30, 2008
US Registration Number:	3726304	Registration Date:	Dec. 15, 2009
Register:	Principal		
Mark Type:	Service Mark		
TM5 Common Status Descriptor:		LIVE/REGISTRATION/Issued and Active	
		The trademark application has been registered with the O	
Status:	A Section 8 declaration has been accepted.		
Status Date:	Jan. 29, 2016		
Publication Date:	Dec. 23, 2008	Notice of Allowance Date:	Mar. 17, 2009

▲ **Mark Information** [Expand All](#)

▲ **Related Properties Information**

▲ **Goods and Services**

▲ **Basis Information (Case Level)**

▼ **Current Owner(s) Information**

Owner Name:	Skullcandy, Inc.		
Owner Address:	1441 Ute Blvd Suite 250 Park City, UTAH UNITED STATES 84098		
Legal Entity Type:	CORPORATION	State or Country Where Organized:	DELAWARE

▲ **Attorney/Correspondence Information**

▲ **Prosecution History**

▲

- ▲ [Maintenance Filings or Post Registration Information](#)
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Exhibit B

United States of America
United States Patent and Trademark Office

EAR CANDY

Reg. No. 4,222,545

Registered Oct. 9, 2012

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

ARGENTO SC BY SICURA INC (NEW YORK CORPORATION)
SUITE 2201
1407 BROADWAY
NEW YORK, NY 10018

FOR: AUDIO SPEAKERS; HEADPHONES, EARBUDS AND EARPHONES; AUTOMOTIVE MOUNTS FOR GPS DEVICES; HOLDERS, ARMBANDS, CLIPS, AND CARRYING CASES SPECIALLY ADAPTED FOR CELLULAR PHONES AND PORTABLE HANDHELD DIGITAL DEVICES; AUTOMOBILE STEREO ADAPTERS; CELL PHONE BATTERY CHARGERS, AND ELECTRICAL CONNECTORS, WIRES AND CABLES FOR CELLULAR PHONES AND PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING, MANIPULATING AND REVIEWING TEXT, DATA, AUDIO, IMAGE AND VIDEO FILES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 7-1-2010, IN COMMERCE 7-1-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 85-228,649, FILED 1-28-2011.

MICHAEL ENGEL, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office