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Filing date: **08/01/2016**

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

| | |
|------------------------|---|
| Proceeding | 91228577 |
| Party | Defendant Solskyn Personal Care LLC |
| Correspondence Address | ANUJ DESAI ARNALL GOLDEN GREGORY LLP 171 17TH ST NW STE 2100 ATLANTA, GA 30363-1031 UNITED STATES trademarks@agg.com |
| Submission | Answer and Counterclaim |
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| Signature | /Anuj Desai/ |
| Date | 08/01/2016 |
| Attachments | Answer 91228577.pdf(157275 bytes) |

Registrations Subject to the filing

| | | | |
|--------------------------------|--|---------------------------------|------------|
| Registration No | 4910850 | Registration date | 03/08/2016 |
| International Registration No. | NONE | International Registration Date | NONE |
| Registrant | Ansell Limited Victoria Gardens, AUSTRALIA | | |

Goods/Services Subject to the filing

| | | | |
|---|---|-------------------|------------|
| Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Personal sexual lubricants | | | |
| Registration No | 3525372 | Registration date | 10/28/2008 |
| Registrant | Ansell Limited Victoria Gardens Level 3/678 Victoria St Richmond, 3121 AUSTRALIA | | |

Goods/Services Subject to the filing

| | | | |
|--|--|--|--|
| Class 010. First Use: 2008/04/20 First Use In Commerce: 2008/04/20 All goods and services in the class are requested, namely: Condoms | | | |
|--|--|--|--|

Grounds for Cancellation

| | |
|--------------------|---|
| Fraud on the USPTO | Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:

Application Serial No. **86749213**

For the Mark **SOLSKYN**

Published in the Official Gazette on February 23, 2016

ANSELL LIMITED,

Opposer,

v.

SOLSKYN PERSONAL CARE LLC,

Applicant.

Opposition No. **91228577**

ANSWER, DEFENSES, AND COUNTERCLAIMS

Applicant SolSkyn Personal Care LLC (“SolSkyn”) hereby answers and states its defenses to Ansell Limited’s (“Ansell”) Notice of Opposition, as follows:

ANSWER TO SPECIFIC ALLEGATIONS

In response to the unnumbered introductory paragraph in the Notice of Opposition, SolSkyn admits that it owns the above-referenced application to register the SOLSKYN mark published for opposition on February 23, 2016, but denies that Ansell will be damaged by registration of that mark. SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the remaining factual allegations set forth in the introductory paragraph, and, accordingly, those allegations are denied.

1.

SolSkyn admits that, by way of the application at issue in this Notice of Opposition, it seeks to register the SOLSKYN mark in connection with “Manufacturing services for others in the field of after-sun gels, after-sun lotions, after-sun milks, after-sun oils, indoor sun tanning preparations, self-tanning preparations, spf sun block sprays, sun block, sun block preparations, sun screen, sun screen preparations, sun-block lotions, sun-tanning oils and lotions, sun-tanning preparations, suntan creams, tanning and after-sun milks, gels and oils” in International Class 40 (the “SOLSKYN Sun Block Manufacturing Services”).

2.

SolSkyn admits the factual allegations contained in Paragraph 2 of the Notice of Opposition.

3.

SolSkyn admits the factual allegations contained in Paragraph 3 of the Notice of Opposition.

4.

SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the factual allegations contained in Paragraph 4 of the Notice of Opposition, and, accordingly, those allegations are denied.

5.

SolSkyn admits that Ansell is listed as the owner of record for Registration Nos. 3525372 and 4910850 (the “SKYN Registrations”) at issue in this Opposition. SolSkyn is

without knowledge or information sufficient to form a belief as to the truth of the remaining factual allegations contained in Paragraph 5 of the Notice of Opposition, including, without limitation, whether Ansell is the owner-in-fact of the SKYN mark, and, accordingly, those allegations are denied.

6.

SolSkyn admits the factual allegations contained in Paragraph 6 of the Notice of Opposition.

7.

SolSkyn admits that USPTO records show that Ansell owns U.S. Trademark Registration No. 3525372. Pursuant to SolSkyn's defenses and counterclaims, however, SolSkyn disputes the alleged incontestability of this registration, and, therefore, denies Ansell's remaining factual allegations in Paragraph 7 of the Notice of Opposition.

8.

SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the factual allegations contained in Paragraph 8 of the Notice of Opposition, and, accordingly, those allegations are denied.

9.

SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the factual allegations contained in Paragraph 9 of the Notice of Opposition, and, accordingly, those allegations are denied.

10.

SolSkyn is without knowledge or information sufficient to form a belief as to the

truth of the factual allegations contained in Paragraph 10 of the Notice of Opposition, and accordingly, those allegations are denied. To the extent Paragraph 10 sets forth a legal conclusion, it does not require a response.

11.

SolSkyn admits that, according to USPTO records, Ansell's SKYN Registrations were registered before SolSkyn applied to register its SOLSKYN Mark. SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the remaining factual allegations contained in Paragraph 11 of the Notice of Opposition, and accordingly, those allegations are denied. To the extent Paragraph 11 sets forth a legal conclusion, it does not require a response.

12.

SolSkyn denies the factual allegations contained in Paragraph 12 of the Notice of Opposition. To the extent Paragraph 12 sets forth a legal conclusion, it does not require a response.

13.

SolSkyn denies the factual allegations contained in Paragraph 13 of the Notice of Opposition.

14.

SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the factual allegations contained in Paragraph 14 of the Notice of Opposition, and, accordingly, those allegations are denied.

15.

SolSkyn is without knowledge or information sufficient to form a belief as to the truth of the factual allegations contained in Paragraph 15 of the Notice of Opposition, and, accordingly, those allegations are denied.

16.

SolSkyn denies the factual allegations contained in Paragraph 16 of the Notice of Opposition.

17.

SolSkyn denies the factual allegations contained in Paragraph 17 of the Notice of Opposition. To the extent Paragraph 17 sets forth a legal conclusion, it does not require a response.

18.

SolSkyn denies the factual allegations contained in Paragraph 18 of the Notice of Opposition. To the extent Paragraph 18 sets forth a legal conclusion, it does not require a response.

19.

SolSkyn denies the factual allegations contained in Paragraph 19 of the Notice of Opposition. To the extent Paragraph 19 sets forth a legal conclusion, it does not require a response.

20.

SolSkyn admits that if it were granted the applied-for registration, it would obtain the *prima facie* exclusive right to use the SOLSKYN mark in connection with the

SOLSKYN Sun Block Manufacturing Services. SolSkyn denies that such a registration would be a source of damage to Ansell and denies the remaining factual allegations in Paragraph 20 of the Notice of Opposition.

GENERAL DENIAL

SolSkyn denies each and every factual allegation contained in the Notice of Opposition that is not expressly admitted in this Answer. Further, SolSkyn reserves the right to dispute any and all conclusions of law and legal opinions set forth in the Notice of Opposition. SolSkyn does not concede that any such conclusions of law or legal opinions are correct.

FIRST DEFENSE

The SOLSKYN and SKYN marks are different in sound, appearance, meaning, and commercial impression.

SECOND DEFENSE

The respective goods and services of the parties are unrelated and are intended to be marketed through different channels of trade.

THIRD DEFENSE

The SOLSKYN Sun Block Manufacturing Services are intended to be sold to a class of consumers different from those who purchase Ansell's sexual wellness products.

FOURTH DEFENSE

The SKYN mark is weak and, if entitled to any protection, is entitled to only a narrow scope of protection.

FIFTH DEFENSE

The purchasers of the involved goods are sophisticated and, therefore, less apt to be confused by any alleged similarity between the SOLSKYN and SKYN marks.

SIXTH DEFENSE

Upon information and belief, Ansell is guilty of unclean hands because it has engaged in inequitable conduct before the USPTO with respect to the prosecution of its application to register the SKYN mark for personal sexual lubricants. As further described in the allegations supporting SolSkyn's counterclaims below, upon information and belief, Ansell misled the USPTO into accepting Ansell's position that the SKYN mark is suggestive or arbitrary, not an intentional misspelling of the word "skin," and, therefore, not merely descriptive of the lubricant goods applied to one's skin. In reality, upon information and belief, Ansell's SKYN mark is derived from the word "skin" and, therefore, is merely descriptive of Ansell's sexual lubricant and condom goods.

SEVENTH DEFENSE

The SKYN mark is not inherently distinctive, is merely descriptive of the associated goods, and had not acquired secondary meaning as of the date(s) it was registered with the USPTO or at any time since then.

EIGHTH DEFENSE

In the alternative, SolSkyn is entitled to register the SOLSKYN mark under Section 18 of the Lanham Act based upon the following limitation on the SOLSKYN Sun Block Manufacturing Services: "sold in non-retail channels of trade and directly to

commercial and industrial customers.” This proposed limitation on channels of trade and consumer type further alleviates any alleged likelihood of confusion between the subject marks.

NINTH DEFENSE

SolSkyn respectfully reserves the right to assert any and all additional defenses as may be determined to be applicable during the course of discovery.

* * *

COUNTERCLAIMS

Responding further to the Notice of Opposition, and without waiving any defense raised above, SolSkyn asserts the following counterclaims against Ansell:

INTRODUCTION

1.

SolSkyn is a Delaware limited liability company with an address of 1725 North Brown Road, Lawrenceville, Georgia 30043.

2.

Upon information and belief, Ansell is an Australian corporation, with an address of Victoria Gardens, Level 3, 678 Victoria Street, Richmond, Victoria 3121, AU.

3.

SolSkyn is the owner of the following sixteen intent-to-use trademark applications for the SOLSKYN and SOLSKYN PERSONAL CARE marks:

| Trademark | Class | Status | Goods and Services | Application Number |
|--------------------------|--------------|---------------|--|---------------------------|
| SOLSKYN PERSONAL CARE | 3 | Opposed | INT. CL. 3 BATH GELS; BATH OILS; BODY LOTIONS; BODY MASK CREAM; BODY MASK LOTION; BODY SPRAY USED AS A PERSONAL DEODORANT AND AS FRAGRANCE; BODY SPRAYS; BODY SPRAYS, NAMELY, WATER IN ATOMIZED CONTAINERS USED TO PRODUCE A COOLING EFFECT; BODY WASH; ESSENTIAL OILS FOR AROMATHERAPY USE; FACIAL LOTION; FACIAL MOISTURIZER WITH SPF; FACIAL MOISTURIZERS; HAND CREAMS; HAND LOTIONS; LIP BALM; LIP CREAM; MASSAGE CREAMS; MASSAGE LOTIONS; MOISTURIZING CREAMS; NON-MEDICATED LIP CARE PREPARATIONS; NON-MEDICATED LIP PROTECTORS; NON-MEDICATED SKIN CARE PREPARATIONS; NON-MEDICATED SKIN CREAMS WITH ESSENTIAL OILS FOR USE IN AROMATHERAPY; PERFUME OILS; SHAVE CREAMS; SHAVING FOAM; SHAVING GELS; SHAVING PREPARATIONS; SKIN CLARIFIERS; SKIN CONDITIONERS; SKIN CREAMS; SKIN LOTIONS; SKIN MOISTURIZER; SKIN MOISTURIZING GEL; SKIN TONERS | App 86749195 |
| SOLSKYN | 40 | Opposed | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF HAIR CARE PREPARATIONS, HAIR SHAMPOO, HAIR SHAMPOOS AND CONDITIONERS, HAIR CARE LOTIONS, AND NON-MEDICATED PREPARATIONS ALL FOR THE CARE OF SKIN, HAIR AND SCALP | App 86749199 |
| SOLSKYN | 3 | Opposed | INT. CL. 3 HAIR CARE LOTIONS; HAIR CARE PREPARATIONS; HAIR SHAMPOO; HAIR SHAMPOOS AND CONDITIONERS; NON-MEDICATED PREPARATIONS ALL FOR THE CARE OF SKIN, HAIR AND SCALP | App 86749197 |
| SOLSKYN | 3 | Opposed | INT. CL. 3 BATH GELS; BATH OILS; BODY LOTIONS; BODY MASK CREAM; BODY MASK LOTION; BODY SPRAY USED AS A PERSONAL DEODORANT AND AS FRAGRANCE; BODY SPRAYS; BODY SPRAYS, NAMELY, WATER IN ATOMIZED CONTAINERS USED TO PRODUCE A COOLING EFFECT; BODY WASH; ESSENTIAL OILS FOR AROMATHERAPY USE; FACIAL LOTION; FACIAL MOISTURIZER WITH SPF; FACIAL MOISTURIZERS; HAND CREAMS; HAND LOTIONS; LIP BALM; LIP CREAM; MASSAGE CREAMS; MASSAGE LOTIONS; MOISTURIZING CREAMS; NON-MEDICATED LIP CARE PREPARATIONS; NON-MEDICATED LIP | App 86749200 |

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|--------------------------|----|---------|---|---------------------|
| | | | PROTECTORS; NON-MEDICATED SKIN CARE PREPARATIONS; NON-MEDICATED SKIN CREAMS WITH ESSENTIAL OILS FOR USE IN AROMATHERAPY; PERFUME OILS; SHAVE CREAMS; SHAVING FOAM; SHAVING GELS; SHAVING PREPARATIONS; SKIN CLARIFIERS; SKIN CONDITIONERS; SKIN CREAMS; SKIN LOTIONS; SKIN MOISTURIZER; SKIN MOISTURIZING GEL; SKIN TONERS | |
| SOLSKYN | 40 | Opposed | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF BATH GELS, BATH OILS, BODY LOTIONS, BODY MASK CREAM, BODY MASK LOTION, BODY SPRAY USED AS A PERSONAL DEODORANT AND AS FRAGRANCE, BODY SPRAYS, BODY SPRAYS, NAMELY, WATER IN ATOMIZED CONTAINERS USED TO PRODUCE A COOLING EFFECT, BODY WASH, ESSENTIAL OILS FOR AROMATHERAPY USE, FACIAL LOTION, FACIAL MOISTURIZER WITH SPF, FACIAL MOISTURIZERS, HAND CREAMS, HAND LOTIONS, LIP BALM, LIP CREAM, MASSAGE CREAMS, MASSAGE LOTIONS, MOISTURIZING CREAMS, NON-MEDICATED LIP CARE PREPARATIONS, NON-MEDICATED LIP PROTECTORS, NON-MEDICATED SKIN CARE PREPARATIONS, NON-MEDICATED SKIN CREAMS WITH ESSENTIAL OILS FOR USE IN AROMATHERAPY, PERFUME OILS, SHAVE CREAMS, SHAVING FOAM, SHAVING GELS, SHAVING PREPARATIONS, SKIN CLARIFIERS, SKIN CONDITIONERS, SKIN CREAMS, SKIN LOTIONS, SKIN MOISTURIZER, SKIN MOISTURIZING GEL, AND SKIN TONERS | App 86749204 |
| SOLSKYN PERSONAL CARE | 3 | Opposed | INT. CL. 3 AFTER-SUN GELS; AFTER-SUN LOTIONS; AFTER-SUN MILKS; AFTER-SUN OILS; INDOOR SUN TANNING PREPARATIONS; SELF-TANNING PREPARATIONS; SPF SUN BLOCK SPRAYS; SUN BLOCK; SUN BLOCK PREPARATIONS; SUN SCREEN; SUN SCREEN PREPARATIONS; SUN-BLOCK LOTIONS; SUN-TANNING OILS AND LOTIONS; SUN-TANNING PREPARATIONS; SUNTAN CREAMS; TANNING AND AFTER-SUN MILKS, GELS AND OILS | App 86749208 |
| SOLSKYN | 3 | Opposed | INT. CL. 3 AFTER-SUN GELS; AFTER-SUN LOTIONS; AFTER-SUN MILKS; AFTER-SUN OILS; INDOOR SUN TANNING PREPARATIONS; SELF-TANNING PREPARATIONS; SPF SUN BLOCK SPRAYS; SUN BLOCK; SUN BLOCK PREPARATIONS; SUN SCREEN; SUN SCREEN PREPARATIONS; SUN-BLOCK LOTIONS; SUN-TANNING OILS AND LOTIONS; SUN-TANNING PREPARATIONS; SUNTAN CREAMS; TANNING | App 86749212 |

| | | | | |
|--------------------------|----|--|---|---------------------|
| | | | AND AFTER-SUN MILKS, GELS AND OILS | |
| SOLSKYN | 40 | Opposed | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF AFTER-SUN GELS, AFTER-SUN LOTIONS, AFTER-SUN MILKS, AFTER-SUN OILS, INDOOR SUN TANNING PREPARATIONS, SELF-TANNING PREPARATIONS, SPF SUN BLOCK SPRAYS, SUN BLOCK, SUN BLOCK PREPARATIONS, SUN SCREEN, SUN SCREEN PREPARATIONS, SUN-BLOCK LOTIONS, SUN-TANNING OILS AND LOTIONS, SUN-TANNING PREPARATIONS, SUNTAN CREAMS, TANNING AND AFTER-SUN MILKS, GELS AND OILS | App 86749213 |
| SOLSKYN PERSONAL CARE | 40 | Published for Opposition on February 23, 2016 | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF HAIR CARE PREPARATIONS, HAIR SHAMPOO, HAIR SHAMPOOS AND CONDITIONERS, HAIR CARE LOTIONS, AND NON-MEDICATED PREPARATIONS ALL FOR THE CARE OF SKIN, HAIR AND SCALP | App 86749193 |
| SOLSKYN PERSONAL CARE | 40 | Published for Opposition on February 23, 2016 | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF BATH GELS, BATH OILS, BODY LOTIONS, BODY MASK CREAM, BODY MASK LOTION, BODY SPRAY USED AS A PERSONAL DEODORANT AND AS FRAGRANCE, BODY SPRAYS, BODY SPRAYS, NAMELY, WATER IN ATOMIZED CONTAINERS USED TO PRODUCE A COOLING EFFECT, BODY WASH, ESSENTIAL OILS FOR AROMATHERAPY USE, FACIAL LOTION, FACIAL MOISTURIZER WITH SPF, FACIAL MOISTURIZERS, HAND CREAMS, HAND LOTIONS, LIP BALM, LIP CREAM, MASSAGE CREAMS, MASSAGE LOTIONS, MOISTURIZING CREAMS, NON-MEDICATED LIP CARE PREPARATIONS, NON-MEDICATED LIP PROTECTORS, NON-MEDICATED SKIN CARE PREPARATIONS, NON-MEDICATED SKIN CREAMS WITH ESSENTIAL OILS FOR USE IN AROMATHERAPY, PERFUME OILS, SHAVE CREAMS, SHAVING FOAM, SHAVING GELS, SHAVING PREPARATIONS, SKIN CLARIFIERS, SKIN CONDITIONERS, SKIN CREAMS, SKIN LOTIONS, SKIN MOISTURIZER, SKIN MOISTURIZING GEL, AND SKIN TONERS | App 86749206 |
| SOLSKYN PERSONAL CARE | 5 | Notice of Allowance Issued | INT. CL. 5 ANTI-INSECT SPRAY; INSECT REPELLENTS; PREPARATIONS FOR REPELLING INSECTS | App 86749211 |
| SOLSKYN | 40 | Published for Opposition on | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF INSECT REPELLANTS, ANTI-INSECT SPRAY, AND PREPARATIONS FOR REPELLING INSECTS | App 86749218 |

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|-----------------------|----|---|---|---------------------|
| | | February 23, 2016 | | |
| SOLSKYN PERSONAL CARE | 3 | Published for Opposition on February 23, 2016 | INT. CL. 3 HAIR CARE LOTIONS; HAIR CARE PREPARATIONS; HAIR SHAMPOO; HAIR SHAMPOOS AND CONDITIONERS; NON-MEDICATED PREPARATIONS ALL FOR THE CARE OF SKIN, HAIR AND SCALP | App 86749192 |
| SOLSKYN PERSONAL CARE | 40 | Published for Opposition on February 23, 2016 | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF AFTER-SUN GELS, AFTER-SUN LOTIONS, AFTER-SUN MILKS, AFTER-SUN OILS, INDOOR SUN TANNING PREPARATIONS, SELF-TANNING PREPARATIONS, SPF SUN BLOCK SPRAYS, SUN BLOCK, SUN BLOCK PREPARATIONS, SUN SCREEN, SUN SCREEN PREPARATIONS, SUN-BLOCK LOTIONS, SUN-TANNING OILS AND LOTIONS, SUN-TANNING PREPARATIONS, SUNTAN CREAMS, TANNING AND AFTER-SUN MILKS, GELS AND OILS | App 86749210 |
| SOLSKYN PERSONAL CARE | 40 | Notice of Allowance Issued | INT. CL. 40 MANUFACTURING SERVICES FOR OTHERS IN THE FIELD OF INSECT REPELLANTS, ANTI-INSECT SPRAY, AND PREPARATIONS FOR REPELLING INSECTS | App 86749188 |
| SOLSKYN | 5 | Notice of Allowance Issued | INT. CL. 5 ANTI-INSECT SPRAY; INSECT REPELLENTS; PREPARATIONS FOR REPELLING INSECTS | App 86749215 |

4.

SolSkyn believes it will be damaged if Ansell is allowed to prevail on its claims in this Opposition proceeding because Ansell has sought to oppose registration of the first eight SOLSKYN and SOLSKYN PERSONAL CARE trademark applications set forth in the table above in their entirety.

5.

Ansell's Opposition is premised upon its alleged ownership and rights in Registration Nos. 3525372 and 4910850 for the SKYN mark in connection with condoms and personal sexual lubricants, respectively. As set forth below, those registrations should be cancelled and be held invalid and unenforceable against SolSkyn.

THE SKYN CONDOM APPLICATION

6.

On October 3, 2007, Ansell filed Application Serial No. 77294975 to register the SKYN mark for condoms (the "SKYN Condom Application"), and, in that application, Ansell did not provide any translation for the wording "SKYN."

7.

After it filed the SKYN Condom Application, the USPTO notified Ansell that the pseudo mark SKIN had been assigned to the application. Ansell did not submit any response to this notice.

8.

Thereafter, the USPTO issued an office action against the SKYN Condom Application, stating, as follows:

Applicant must submit an English translation of all foreign wording in the mark. 37 C.F.R. §2.61(b); TMEP §809. In the present case, the wording "SKYN" needs translating for the record. The following translation statement is suggested: "The English translation of SKYN in the mark is SENSE."

9.

In its response to this office action, Ansell accepted the USPTO's suggested translation and added the following translation statement to the SKYN Condom Application: "The foreign wording in the mark translates into English as SENSE."

10.

Subsequently, a Notice of Allowance was issued for the SKYN Condom Application and, in response, Ansell filed a Statement of Use with the specimen shown

below:



11.

The SKYN Condom Application matured to registration on October 28, 2008 (Registration No. 3525372).

THE SKYN LUBRICANT APPLICATION

12.

On October 3, 2014, Ansell filed Application Serial No. 79160750 to register the SKYN mark for personal sexual lubricants (the “SKYN Lubricant Application”), and, in that application, Ansell did not provide any translation for the wording “SKYN.”

13.

Thereafter, the USPTO issued an office action against the SKYN Lubricant Application, refusing registration under Section 2(e)(1) on the ground that the “applied-for mark merely describes the purpose of applicant’s goods.”

14.

The office action further stated that “‘skin’ is commonly used to describe the area

of the body affected by applicant's goods" and that "Applicant's mark has replaced the letter 'i' in 'skin' with the letter 'y'."

15.

The office action asserted that the SKYN mark was "the phonetic equivalent of the descriptive word 'skin'" and concluded, as follows:

Therefore, the mark SKYN, as applied to the identified goods, merely describes the purpose of applicant's goods, namely, to lubricate skin. Accordingly, the proposed mark is merely descriptive, and registration is refused on the Principal Register under Section 2(e)(1).

16.

In its response to the office action, Ansell asserted:

Applicant respectfully disagrees that the mark in this case is descriptive of the goods and contends that the mark is entitled to registration based on the fact that the Applicant, a global company, has applied for its trademark based on foreign wording that does not mean "skin" when translated into the English language, and as such the trademark is considered arbitrary or suggestive to the goods at issue.

17.

Ansell further wrote in its response to the office action that "the mark SKYN does not stand in place of the word "skin," but is the foreign wording "skyn," which translates to "sense" or "awareness" in English." In its response, Ansell notified the USPTO of this translation in its earlier Registration No. 3525372 and asked that the same translation be added to the SKYN Lubricant Application.

18.

Following Ansell's office action response, the USPTO withdrew its refusal under Section 2(e)(1). The SKYN Lubricant Application matured to registration on March 8,

2016 (Registration No. 4910850).

19.

Upon information and belief, however, the genesis of Ansell's SKYN mark is, in fact, the phonetically equivalent word "skin," and Ansell understands the meaning of its SKYN mark to be the same as the meaning of the word "skin."

20.

For example, as depicted in the specimen that Ansell submitted in connection with its SKYN Condom Application, Ansell replaced the word "skin" with "skyn" in its tag line - "For That SKYN-TO-SKYN Sensation."



21.

Upon information and belief, Ansell did not conceive the SKYN mark from the Icelandic word "skyn," which roughly translates to the English word "sensation."

22.

The SKYN mark merely describes the purpose of Ansell's condom and sexual lubricant goods and "skin" is commonly used to describe the area of the body affected by Ansell's condom and sexual lubricant goods.

23.

Upon information and belief, Ansell has used and presently uses the "skyn" term

descriptively to refer to skin in advertising and promoting its condom and sexual lubricant products.

COUNT I: FRAUD

24.

SolSkyn repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

25.

Upon information and belief, Ansell's response to the office action issued against the SKYN Lubricant Application was false at the time it was submitted to the USPTO.

26.

Upon information and belief, Ansell's response to the office action issued against the SKYN Lubricant Application was made with the intent of deceiving the USPTO into believing that the SKYN mark is not a misspelling of the word "skin" and is not merely descriptive of the associated sexual lubricant goods applied to a person's skin.

27.

Upon information and belief, Ansell's response to the office action issued against the SKYN Lubricant Application constitutes a material misrepresentation that caused the USPTO to withdraw its refusal under Section 2(e)(1) and grant Ansell a registration of the SKYN Lubricant Application (Registration No. 4910850).

28.

Moreover, by intentionally referring to and relying upon the translation for the "skyn" term in Registration No. 3525372 in the office action response, upon information

and belief, Ansell made that earlier registration an instrument of its aforementioned intentional misrepresentations to the USPTO with the intent to deceive the USPTO into withdrawing its refusal to register the SKYN Lubricant Application.

29.

SolSkyn has been damaged – and is being damaged – by the USPTO’s reliance on Ansell’s misrepresentations, as evidenced by Ansell’s Oppositions to eight different trademark applications for the SOLSKYN and SOLSKYN PERSONAL CARE marks instituted on the basis of the SKYN Registrations.

30.

Therefore, pursuant to 15 U.S.C. § 1064(3), SolSkyn respectfully requests that the Board cancel Registration Nos. 3525372 and 4910850 for the SKYN mark.

COUNT II: MERELY DESCRIPTIVE MARK

31.

SolSkyn repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

32.

The SKYN mark is phonetically equivalent to the word “skin.”

33.

Upon information and belief, the genesis of the SKYN mark is from the word “skin” and Ansell understands the meaning of its SKYN mark to be the same as the meaning of the word “skin.”

34.

Upon information and belief, Ansell did not conceive the SKYN mark from the Icelandic word “skyn,” which roughly translates to the English word “sensation.”

35.

The SKYN Mark is merely descriptive of Ansell’s sexual lubricant goods because Ansell’s SKYN Mark immediately conveys knowledge of a quality, feature, function, or characteristic of the goods for which they are used.

36.

Specifically, the SKYN mark merely describes the purpose of Ansell’s sexual lubricant goods and “skin” is commonly used to describe the area of the body affected by Ansell’s sexual lubricant goods.

37.

Therefore, pursuant to Section 2(e)(1), the Board should cancel Registration No. 4910850 because the SKYN mark is merely descriptive of the associated sexual lubricant goods and the SKYN mark had not acquired secondary meaning at the time it was registered in connection with the aforementioned goods or at any time since then.

38.

Unless this registration is cancelled, SolSkyn will continue to be damaged, as evidenced by Ansell’s Oppositions to eight different trademark applications for the SOLSKYN and SOLSKYN PERSONAL CARE marks instituted on the basis of the SKYN Registrations.

PRAYER FOR RELIEF

WHEREFORE, SolSkyn respectfully requests that Ansell's Prayer for Relief be denied, that Ansell's Registration Nos. 3525372 and 4910850 for the SKYN mark be canceled, that Ansell's Opposition be dismissed with prejudice, and that registration of SolSkyn's above-referenced application issue without further delay.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, on August 1, 2016, a copy of the foregoing pleading was sent via United States Mail and e-mail to Opposer Ansell Limited's counsel of record, as follows:

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