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

Proceeding	91228578
Party	Plaintiff Ansell Limited
Correspondence Address	Charles P. Guarino Moser Taboada 1030 Broad Street - Suite 203 Shrewsbury, NJ 07702 UNITED STATES docketing@mtiplaw.com
Submission	Other Motions/Papers
Filer's Name	Charles P. Guarino
Filer's e-mail	docketing@mtiplaw.com
Signature	/Charles P. Guarino/
Date	06/30/2016
Attachments	SOLSKYN - 204 - Notice of Opposition.pdf(16787 bytes)

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

Serial No.: 86-749204
Mark: SOLSKYN
Filing Date: September 7, 2015

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ANSELL LIMITED,

Opposer,

Opposition No.: _____

v.

SOLSKYN PERSONAL CARE LLC,

Applicant.

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**NOTICE OF OPPOSITION
PURSUANT TO 15 U.S.C. § 1063**

Opposer, Ansell Limited (“Ansell” or “Opposer”), with an address of Victoria Gardens, Level 3, 678 Victoria Street, Richmond, Victoria, 3121, AU, believes it will be damaged by registration of the mark shown in U.S. Trademark Application Serial No. 86/749204 (“the Opposed Application”) owned by Solskyn Personal Care LLC (“Applicant”). The Opposed Application published for opposition on February 23, 2016. Ansell, a corporation organized and existing under the laws of Australia, opposes the registration of this mark pursuant to 15 U.S.C. §1063 (Lanham Act § 13).

As grounds of opposition, Opposer alleges that:

1. By way of the Opposed Application, Applicant seeks to register the mark SOLSKYN (the “Opposed Mark”) for “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” in International Class 40 (the “Opposed Services”).

2. The filing date of the Opposed Application is September 7, 2015.
3. The Opposed Application is based on an intent-to-use the Opposed Mark in the future, not actual past use of the Opposed Mark.
4. Ansell markets and sells personal sexual lubricants and condoms under the SKYN mark.
5. Ansell is the owner of the SKYN trademark for personal sexual lubricants and condoms, and all goodwill of the business associated therewith.
6. Ansell has registered and owns U.S. Trademark Registration No. 4,910,850 for the mark SKYN in connection with “personal sexual lubricants” in Class 5 (Exhibit A).
7. Ansell has also registered and owns incontestable U.S. Trademark Registration No. 3,525,372 for the mark SKYN in connection with “condoms” in Class 10 (Exhibit B).
8. Since at least as early as April 2008, well prior to any date upon which Applicant can rely, Ansell has continuously and exclusively used the mark SKYN in interstate commerce in connection with condoms.

9. Since at least as early as April 30, 2015, well prior to any date upon which Applicant can rely, Ansell has continuously and exclusively used the mark SKYN in interstate commerce in connection with personal sexual lubricants.

10. By virtue of the SKYN registrations listed above, and Ansell's extensive and continuous use and promotion of its SKYN marks, SKYN has become distinctive of and closely associated in the public mind with Opposer's products.

11. As set forth above, Ansell's SKYN marks and registrations have priority over the Opposed Application.

12. The Opposed Mark, which incorporates the entirety of Opposer's SKYN mark, is highly similar in appearance, sound, and commercial impression to Opposer's SKYN mark.

13. The Opposed Services are closely related to goods in connection with which the Ansell has used and continues to use its SKYN marks, and the goods specified in Opposer's registrations for such marks.

14. Sales of Ansell's products bearing the SKYN mark in the United States have totaled in the millions of dollars. Opposer has spent and continues to spend substantial sums of money in advertising and promoting its products bearing the SKYN mark.

15. By reason of Ansell's extensive sales, promotion, and advertising of products bearing Opposer's SKYN mark, and the high quality of such products, valuable goodwill has been established in Opposer's SKYN mark, and an enviable reputation has been established for products sold under and distinguished by Opposer's SKYN trademark. Members of both the trade and the public recognize and understand that products bearing the SKYN mark originate with the Opposer.

16. By incorporating the entirety of Ansell's SKYN mark into the Opposed Mark, the Opposed Mark creates confusion with Opposer's SKYN mark.

17. Based on the similarities of the marks, consumers are likely to confuse or associate the Opposed Services sold by Applicant under the Opposed Mark with Ansell and Ansell's SKYN products, or to believe that the Opposed Services are offered, sponsored, endorsed, or licensed by Ansell, or that there is some relationship between the Applicant and Opposer.

18. For the above reasons, any use or registration of the Opposed Mark is likely to cause confusion or mistake, or to deceive the purchasing public into mistakenly believing that the services described in the Opposed Application originate from, come from, or otherwise are associated with Opposer's goods, in violation of Section 2(d) of the Lanham Act.

19. If Applicant were permitted to use or register the Opposed Mark for the Opposed Services, it would cause damage and injury to Ansell's business reputation and would injure and impair Opposer's rights in its SKYN mark and registrations, because said use or registration is likely to cause confusion or mistake, or to deceive by creating the erroneous impression that the Applicant's services originate with Opposer or from the same source as Opposer's products, or that Applicant's services are authorized, licensed, endorsed by, or connected in some way with Opposer or its products.

20. If Applicant were granted the registration applied for, it would thereby obtain, at least, the *prima facie* exclusive right to use the Opposed Mark on the Opposed Services. Such registration would thus be a source of damage and injury to Opposer, and would be inconsistent with Opposer's rights in its SKYN mark and the registrations therefor.

WHEREFORE, Opposer prays that this Opposition be sustained, that the Opposed Application be rejected, and that registration of the Opposed Mark be refused and denied in all respects.

Dated: June 22, 2016

Respectfully submitted,

/Charles P. Guarino/
Charles P. Guarino, Esq.
MOSER TABOADA
1030 Broad Street, Suite 203
Shrewsbury, New Jersey 07702
Telephone: 732-945-9498
Email: cguarino@mtiplaw.com
Attorneys for Opposer Ansell Limited

