

ESTTA Tracking number: **ESTTA857969**

Filing date: **11/13/2017**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Holy City Skin Products, LLC		
Entity	Corporation	Citizenship	South Carolina
Address	1588 Spinnaker Lane Charleston, SC 29407 UNITED STATES		

Attorney information	Natalma M. McKnew / Thomas W. Epting Smith Moore Leatherwood LLP P.O. Box 87 Greenville, SC 29602 UNITED STATES Email: tami.mcknew@smithmoorelaw.com, tom.epting@smithmoorelaw.com, barbara.ballew@smithmoorelaw.com Phone: 864-751-7600
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Applicant Information

Application No	87250354	Publication date	10/31/2017
Opposition Filing Date	11/13/2017	Opposition Period Ends	11/30/2017
Applicant	Secret of the Islands, Inc. 1051 Broad Stone Rd Irmo, SC 29063 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cosmetic preparations, body and beauty care products, namely, salt scrub, body butter, lip balm, face cream, sugar scrub, non-medicated bath salts, creams and lotions for cellulite reduction, body creams and lotions, foot creams and lotions, essential oils, soaps, shampoo, bubble bath, face wash

Grounds for Opposition

The mark is generic	Trademark Act Sections 1, 2 and 45
The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)

Attachments	Notice of Opposition 354.pdf(16485 bytes)
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Signature	/Natalma M. McKnew/
Name	Natalma M. McKnew

Date	11/13/2017
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Holy City Skin Products, LLC,)	Trademark App. No. 87/250,354
)	
Opposer)	Mark: MISCELLANEOUS DESIGN
)	
v.)	Published in the <i>Official Gazette</i> on
)	October 31, 2017.
Secret of the Islands, Inc.,)	
)	
Applicant.,)	

NOTICE OF OPPOSITION

Opposer, Holy City Skin Products, LLC (“Opposer” or “Holy City”), a limited liability company organized pursuant to the laws of South Carolina, with a principal address of 1588 Spinnaker Lane, Charleston, South Carolina 29407, believes it will be damaged by registration of the mark recited in the application referenced above, and hereby opposes same.

As grounds for its opposition, Opposer alleges that:

FACTUAL ALLEGATIONS

1. Applicant filed Trademark Application No. 87/250,354 on November 29, 2016 seeking registration of an illustrated mark, consisting of jar container (the “asserted mark”), for use in connection with “cosmetic preparations, body and beauty care products, namely, salt scrub, body butter, lip balm, face cream, sugar scrub, non-medicated bath salts, creams and lotions for cellulite reduction, body creams and lotions, foot creams and lotions, essential oils, soaps, shampoo, bubble bath, face wash.” On information and belief, Applicant promotes and offers its products for sale at wholesale and retail through distributors, in various places of business, by mail order, and using electronic media, including the Internet, web page sales, and social media.

2. Opposer is in the business of formulating, promoting and offering for sale various skin care products, including but not limited to salt scrubs, bath soaps, hand and body lotions and sanitizers (collectively referred to as “skin care products”).

3. Opposer promotes and offers its products for sale at wholesale and retail through distributors, in various places of business, by mail order, and using electronic media, including the Internet, web page sales, and social media. Opposer has employed such methods of sale and promotion since at least 2009. The channels of distribution employed by Applicant and Opposer are similar.

4. Opposer has packaged many of its skin products in glass containers, commonly referred to as mason jars, since it began selling skin care products. The use of mason jars as packaging for skin care products is common among sellers of such products and is not unique to Opposer or to Applicant. Skin care companies have used mason jars as packaging for skin care products for decades. The asserted mark is generic and does not function as a trademark.

5. Registration of the asserted mark will create confusion between Applicant’s goods and those of the Opposer and others in the skin care industry, for the reasons set forth above.

6. Mason jars are a functional means of packaging skin care products. They providing a readily-accessible container through which product can be seen, with a cover that both permits access to products and protects products from deterioration through, among other things, exposure to air.

7. Opposer’s business, products, marketing, packaging and promotional methods have required significant investment by the Opposer, have been developed and improved throughout the time the Opposer has been in business, and have all contributed to the success of Opposer’s business and products. Opposer’s business methods, products, packaging and

promotional methods are valuable assets of Holy City Skin Products, LLC. Opposer therefore believes that registration of the asserted mark will damage Opposer and its business.

8. Applicant was aware of Opposer's packaging, including the use of mason jars as product packaging, well prior to the Applicant's filing of the application cited above. Applicant initiated litigation against Opposer on February 3, 2017, captioned *Secret of the Islands, Inc. v. Hymans Seafood Company, Inc., Eli Hyman, Aaron Hyman, Brad Gena, Holy City Skin Products, Inc., U.S. Foods, Inc, USA Distributions, LLC*, Civil Action No. 2:17-cv-00542-DCN in the U.S. District Court for the District of South Carolina (the "Litigation"). In the Complaint initiating the Litigation, Applicant admitted Opposer's use of the mason jar packaging for at least two and one-half (2 ½) years prior to Applicant's filing of the Complaint. Applicant further admitted in the Complaint that it has filed a utility patent application with respect to Applicant's "marketing and sales methods," precluding trademark registration.

GROUND FOR OPPOSITION

9. The allegations set forth in paragraphs 1 through 8 of this Opposition are restated and reiterated as fully as if set forth herein.

10. Registration should be denied because the asserted mark is generic to the skin care industry.

11. Registration should be denied because the asserted mark is functional.

12. Registration should be denied because the asserted mark its registration will create confusion between Applicant's products and those of Opposer and others in the industry.

WHEREFORE, Opposer prays that said Application No. 87/250,354 be refused application and that this Opposition be sustained in favor of the Opposer.

This Opposition is submitted together with the statutory filing fee of \$400 (International Class 003). Should any additional fee be required, please charge the same to Deposit Account No. 502190.

SMITH MOORE LEATHERWOOD LLP whose address is 2 West Washington Avenue, Suite 1100, Greenville, South Carolina 29601 is hereby designated Opposer's representative upon whom notice or process in these proceedings may be served.

Opposer appoints Natalma M. McKnew and Thomas W. Epting, along with the firm of Smith Moore Leatherwood LLP, having one of its offices located at 2 West Washington Avenue, Suite 1100, Greenville, South Carolina 29601, to transact all business on its behalf in connection with this Opposition.

CURRENT ADDRESS OF APPLICANT

To the best of Opposer's knowledge, the current address of the Applicant is 1051 Broad Stone Road, Irmo, South Carolina, 29063.

Respectfully submitted,

/Natalma M. McKnew/

Natalma M. McKnew, Esq.

Thomas W. Epting, Esq.

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Dated: November 13, 2017

*ATTORNEYS FOR OPPOSER HOLY CITY SKIN
PRODUCTS, LLC*

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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)	October 31, 2017.
Secret of the Islands, Inc.,)	
)	
_____ Applicant.)	

CERTIFICATE OF MAILING

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Holy City Skin Products, LLC on November 13, 2017 via First Class Mail, postage prepaid to:

Richard Blank, Esq.
19 LedgeWood Commons
Millwood, NY 10546

Secret of the Islands, Inc.
1051 Broad Stone Road
Irmo, SC 29063

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