

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

In The Matter Of U.S. Trademark
Application Serial No. 75/741,795
For The Mark **RUSH NEW MEDIA**

U.S. Patent & TM Office Mail Room #57

09-04-2002

RUSSELL SIMMONS,

Opposer,

v.

KERRY COLIN KEANE,

Applicant.

Opposition No. 91122816

**Response to February 7, 2002 Order
Issued by the Trademark Trial and
Appeal Board**

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TRADEMARK TRIAL AND
APPEAL BOARD

**RESPONSE TO FEBRUARY 7, 2002 ORDER
ISSUED BY THE TRADEMARK TRIAL AND APPEAL BOARD**

Opposer Russell Simmons (“Opposer”), by his attorneys, Pryor Cashman Sherman & Flynn LLP, in response to the Trademark Trial and Appeal Board’s (“the Board”) Order dated February 7, 2002, respectfully responds as follows:

Preliminary Statement

1. Opposer instituted this Opposition Proceeding (the “Opposition”) in order to prevent Applicant’s registration of the mark RUSH NEW MEDIA (the “Mark”) for “providing entertainment in the nature of games; horoscopes; trivia contests; and book, movie and music reviews by means of a global communications network” in Class 41 and “providing advice and surveys dealing with adult social relationships by means of a global communications network” in Class 42 (collectively “Applicants’ Services”).

2. On January 30, 2002, the Board issued an Order re-setting discovery dates. The caption on that Order indicated Opposer as "Rush Media LLC", instead of "Russell Simmons" who is, and has been, the named Opposer in this matter.

3. Counsel for Opposer contacted the Board on February 6, 2002 to inquire about the status of this matter and to request that Opposer's name be corrected to reflect Russell Simmons as the proper Opposer. David Mermelstein, the Board attorney in charge of this matter, agreed to examine the file and make any necessary corrections.

4. On February 7, 2002, the Board issued another Order suspending the proceedings for six-months in light of the parties' settlement discussions. In this Order, the Board requested that Opposer address the following issues: (1) Who is the opposer in the proceeding? (2) Because the extension of time to oppose was filed in the name of DJR Holdings, LLC, is the Notice of Opposition untimely because of lack of privity? (3) To the extent that other identified entities, namely Rush Communications, Inc., Rush Media LLC and Rush Associated Labels, Inc., were intended to be joint opposers, is opposition by each of them untimely because of lack of privity? and (4) If there is more than one opposer that can show privity with the potential opposer, an opposition fee must be submitted for each opposer.

5. Opposer respectfully submits that as the principle owner, majority shareholder and/or controlling member of the entities listed in the Notice of Opposition, he is the real party in interest. Opposer further states that privity exists between himself and the other entities, including DJR Holdings LLC, the entity in whose name the extension of time to oppose was filed; thus, the Notice of Opposition was timely. Opposer also respectfully offers to pay the required fee of \$600.00 in order to properly join the entities with which he has privity.

Background

6. Opposer is presently the principle owner, majority shareholder and/or controlling member of RUSH COMMUNICATIONS, INC., a New York corporation with its principal place of business at 512 Seventh Avenue, 43rd Floor, New York, New York 10018 ("Rush Communications"), RUSH MEDIA, LLC, a New York limited liability company with its principal place of business at 512 Seventh Avenue, 43rd Floor, New York, New York 10018 ("Rush Media"), RUSH ASSOCIATED LABELS, INC., a New York corporation with its principal place of business at 825 Eighth Avenue, New York, New York 10019 ("RAL") and DJR HOLDINGS, LLC, a New York limited liability company with its principal place of business at 512 Seventh Avenue, 43rd Floor, New York, New York 10018 ("DJR," collectively with Rush Communications, Rush Media, and RAL, the "Rush Entities").

7. Opposer is a world famous cultural icon, trend-setting visionary, media mogul and the founder and driving force behind Rush Communications, a multi-media powerhouse and integrated entertainment company. Founded in 1990 as the successor to other "RUSH" entities founded by Opposer, Rush Communications received its distinct name from Opposer, who from a young age was known simply as RUSH. (Simmons Aff. ¶ 3). Building on his successful early entry into the New York rap music scene in the early 1980's through his founding of the Def Jam record label, Opposer -- and Rush Communications (as well as its predecessor "Rush" entity, Rush Productions Co., Inc.) -- became the dominant force in the burgeoning hip-hop industry throughout the 1980's and 1990's.

8. Through Rush Communications, Opposer has positioned himself as a leader in cutting edge entertainment, media and content development. Opposer has, over the years, successfully

broadened Rush Communications' base, creating subsidiary organizations and collaborative partnerships, many of which transact business under the RUSH moniker.

9. Opposer has used RUSH as a trademark and tradename in connection with Rush Communications since at least as early as 1990. (Simmons Aff. ¶ 9). Rush Communications is a diversified multi-media company with business operations covering music, television, film, advertising and fashion. Opposer and Rush Communications continue to exploit the RUSH mark through these interests. Id.

10. Opposer also founded Def Jam Recordings ("Def Jam") in 1985, which, prior to Def Jam's sale to Universal Music Group in or about 1999, was Rush Communications' largest and most well known subsidiary. Rush Associated Labels, Inc. (as distinguished from Rush Communications) was the corporate entity created by Opposer in 1990 to operate the various Def Jam record labels (i.e., Def Jam, Def Soul, Def Reggae and Def Songs, to name a few). (Simmons Aff. ¶ 5). Yet another "RUSH" entity, Rush Associated Labels Recordings, a partnership, took over the business operations of Def Jam in 1994. Rush Communications, Def Jam and Rush Associated Labels, Inc. have been collectively and continuously using the RUSH mark since at least as early as 1990, while Rush Associated Labels Recordings has been using that mark since 1994. (Simmons Aff. ¶ 6).

11. Opposer also created an entity called Rushtown Music, Inc., a music publishing company formed in 1989, which ultimately became a Rush Communications subsidiary owned by Mr. Simmons through Def Jam and Rush Associated Labels. (Simmons Aff. ¶ 7). Rushtown Music, prior to its sale to Universal in or about 1999, owned four music catalogs, each owning

the publishing rights to such notable artists as LL Cool J, Slick Rick and Public Enemy.

Rushtown Music had used and commercially exploited the RUSH mark as a service mark and tradename since at least as early as 1989.

12. Another "RUSH" entity called Rush Media, LLC, a division of Rush Communications, was founded by Opposer, among others, in 1995 as a full service, marketing driven advertising agency whose success is best illustrated by its series of commercials for the Coca Cola Company, each of which were tied directly to the content of the 38th Grammy Award telecast. (Simmons Aff. ¶ 8). As part of its efforts, Rush Media has, in the past, utilized the Rush Street Team, formerly an affiliate of Def Jam/Rush Associated Labels, to provide full service marketing and promotion strategies in 25 urban regions throughout the United States. Rush Media and Rush Street Team have each been using the RUSH mark as service mark since at least as early as 1995.

13. Opposer, through himself and through his multiple business enterprises, has continuously and substantially used the RUSH trademark and tradename in interstate commerce since at least as early as 1981 in connection with all forms of media and entertainment services and has continuously and substantially used the RUSH trademark and tradename in interstate commerce since at least as early as 1995 in connection with its advertising, marketing and philanthropic services. (Simmons Aff. ¶ 9).

Response To Board's Inquiry

Who is the opposer in the proceeding?

14. Opposer respectfully submits that he, Russell Simmons, is the appropriate opposer in this proceeding. As stated above, Opposer is the principle owner, majority shareholder and/or controlling member of the Rush Entities. As the principle owner, majority shareholder and/or controlling member of the Rush Entities, Opposer has a real interest in protecting the valuable trademark rights to the mark RUSH as it is used in the media and entertainment industries. (Simmons Aff. ¶ 10). Consequently, Opposer believes that he will be damaged by the registration of Applicant's mark, RUSH NEW MEDIA, Serial No. 75/741,795. Id. Because he has a real and personal interest in preventing registration of the Mark and because he believes that he will be damaged by registration thereof, Opposer is the proper Opposer. See 15 U.S.C. §1063(a); TBMP §§303.01, 303.03.

Because the extension of time to oppose was filed in the name of DJR Holdings, LLC, is the Notice of Opposition untimely because of lack of privity?

15. Opposer respectfully submits that the Notice of Opposition is not untimely because privity exists between Opposer and each and every member of the Rush Entities, including DJR Holdings, LLC. See 37 C.F.R. §2.102(b). Privity is created by virtue of the fact that each of the Rush Entities are related to Opposer as the principle owner, majority shareholder and/or controlling member. See 15 U.S.C. §§ 1055, 1127.

16. DJR Holdings, LLC is the entity that owns the trademarks associated with the Def Jam record label. Pursuant to an agreement between Opposer and Universal Music Group, Opposer, through DJR, licenses the trademarks it owns to Universal. (Simmons Aff. ¶ 5).

Opposer, however, in connection with Universal, controls the nature and quality of the goods and services offered under those marks. Id. In fact, as further evidence of the continued association between DJR and Opposer as well as of Opposer's continued active managing role of DJR, Opposer, the Rush Entities and DJR all share the same business address, 512 Seventh Avenue, 43rd Floor, New York, New York 10018. Not surprisingly, the use and exploitation of goods and services owned by DJR inure to the benefit of Opposer, Russell Simmons, among others.

17. Opposer has expended a substantial amount of time and money in advertising and promoting his association with the Def Jam label and the marks currently owned by DJR. As a result, Def Jam and DJR have become synonymous with Opposer and have generated significant brand loyalty and critical acclaim, with strong profit margins. Clearly, privity exists between Opposer and DJR. As a result, even though the extension of time to opposer Applicant's mark was inadequately filed by DJR, the Opposition brought by Opposer is still timely given opposers ownership and/or control of DJR and the Rush Entities.

To the extent that other identified entities, namely, Rush Communications, Inc., Rush Media, LLC and Rush Associated Labels, Inc., were intended to be joint opposers, is opposition by each of them untimely because of lack of privity?

18. Opposer respectfully submits that opposition by each of the Rush Entities is timely because there is privity between Opposer and each and every member of the Rush Entities. See 37 C.F.R. §2.102(b). Privity is created by virtue of the fact that Opposer has a real interest in and is related to each of the Rush Entities as the principle owner, majority shareholder and/or controlling member. See 15 U.S.C. §§ 1055, 1127.

19. As stated above, Opposer founded Rush Communications in 1990. Because of Opposer's vision and creativity, Rush communications has enjoyed meteoric success since its

inception. Rush Communications is owned by Opposer and, as a result, Opposer controls the nature and quality of the goods and services offered by that entity. (See Simmons Aff. ¶ 4). The success generated by Rush Communications inures to the benefit of Opposer.

20. In addition to DJR, (as discussed above) Rush Communications has spawned other profitable and renowned entities. For example, Opposer co-founded Rush Media, a division of Rush Communications, in 1996. (Simmons Aff. ¶ 8). Rush Media is a full service, marketing driven advertising agency that draws upon in-house entertainment resources. Therefore, Rush Media is able to leverage the creative and business expertise of the various entertainment interests of Rush Communications to create successful brand image campaigns for its clients. As founder of Rush Media, Opposer controls the nature and quality of the goods and services offered by those entities. The success generated by these entities inures to the benefit of Opposer. Id.

21. Opposer also founded Def Jam Recordings ("Def Jam") in 1985, which, prior to Def Jam's sale to Universal Music Group in or about 1999, was Rush Communications' largest and most well known subsidiary. (Simmons Aff. ¶ 5). Rush Associated Labels, Inc. (as distinguished from Rush Communications) was the corporate entity created by Opposer in 1990 to operate the various Def Jam record labels (i.e., Def Jam, Def Soul, Def Reggae and Def Songs, to name a few). Despite the sale of the Def Jam record label and Rush Associated Labels to Universal, Opposer to this day, still retains his role as managing member of DJR and the Rush Entities and, in conjunction with Universal, jointly controls the nature and quality of the goods and services offered by those entities as these goods and services pertaining to the recorded music industry. Id. Opposer solely controls the nature and quality of all other non-music related

uses of the Rush Entities. All of the success generated by DJR and Rush Associated Labels inures to the benefit of Opposer, among others.

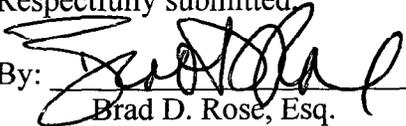
22. Because Opposer controls the nature and quality of the RUSH marks used by each of the Rush Entities and because the use of the RUSH marks by each of the Rush Entities inures to the benefit of Opposer, clearly privity is established between Opposer and each of the Rush Entities.

If there is more than one opposer that can show privity with the potential opposer, an opposition fee must be submitted for each opposer.

23. Opposer respectfully submits that he is the proper opposer in this matter based upon his real interest in and ownership and/or control of the other Rush Entities. However, if the Board feels that each of the Rush Entities should be considered as joint opposers by virtue of their privity with Opposer, Opposer will pay the required fee of \$600.00 to join each of the Rush Entities.

If the Board has any further questions or requires any further clarification, it is invited to contact the undersigned.

Respectfully submitted,

By: 
Brad D. Rose, Esq.

Pryor Cashman Sherman & Flynn LLP
410 Park Avenue
New York, NY 10022
212.326.0875

Attorney for Opposer,
Russell Simmons

2. As a principle owner, majority shareholder and/or controlling member of the Rush Entities, I personally assist in the operation of each of the Rush Entities and have expended a substantial amount of time, money and effort creating strong, profitable entities with positive reputations in the public and the trade. I believe that each of the Rush Entities is a reflection of myself and, as a result, I assist in controlling the nature and quality of the goods and services offered under the RUSH marks used by the Rush Entities. Indeed, the use and development of such goods and services by the Rush Entities inure to my benefit.

3. In 1990, I founded Rush Communications as the successor to other "RUSH" entities. I chose the name "Rush Communications" because, as a young boy, I was known simply as RUSH. Rush Communications is a diversified multi-media company with business operations covering music, television, film, advertising and fashion. Through Rush Communications, I have positioned myself as a leader in cutting edge entertainment, media and content development. I have, over the years, successfully broadened Rush Communications' base, creating subsidiary organizations and collaborative partnerships, many of which transact business under the RUSH moniker.

4. I have used RUSH as a trademark and tradename in connection with Rush Communications and its affiliates since at least as early as 1990 and I control the nature and quality of the goods and services they offer. Through Rush Communications and its affiliates, I continue to use and exploit the RUSH mark. I have expended a substantial amount of time and money in advertising and promoting Rush Communications and its affiliates and advertising my

association with those entities. As a result, Rush Communications and its affiliates have become synonymous with me and have generated significant brand loyalty and critical acclaim with strong profit margins.

5. In 1985, I founded Def Jam Recordings ("Def Jam"), which, prior to Def Jam's sale to Universal Music Group in or about 1999, was Rush Communications' largest and most well known subsidiary. Rush Associated Labels, Inc. was the corporate entity I created in 1990 to operate the various Def Jam record labels (i.e., Def Jam, Def Soul, Def Reggae and Def Songs, to name a few). DJR Holdings, LLC was the entity I founded to own the marks that are associated with the record company. Through my agreement with Universal, DJR Holdings will own the marks and license them to Universal. Despite the sale of the Def Jam and RAL to Universal, I retained joint control, along with Universal, of these entities.

6. Yet another "RUSH" entity, Rush Associated Labels Recordings, a partnership, took over the business operations of Def Jam in 1994. Rush Communications, Def Jam and Rush Associated Labels, Inc. have been collectively and continuously using the RUSH mark since at least as early as 1990, while Rush Associated Labels Recordings has been using that mark since 1994.

7. I also created an entity called Rushtown Music, Inc., a music publishing company formed in 1989, which ultimately became a Rush Communications subsidiary that I own and control through Def Jam and Rush Associated Labels. Rushtown Music, prior to its sale to Universal in or about 1999, owned four music catalogs, each owning the publishing rights to such notable artists as LL Cool J, Slick Rick and Public Enemy. Rushtown Music had used and

commercially exploited the RUSH mark as a service mark and tradename since at least as early as 1989.

8. In 1996, I co-founded an entity called Rush Media, LLC, a division of Rush Communications. Rush Media is a full service, marketing driven advertising agency whose success is best illustrated by its series of commercials for the Coca Cola Company, each of which were tied directly to the content of the 38th Grammy Award telecast. Rush Media is a unique advertising agency in that it draws upon in-house entertainment resources. Therefore, Rush Media is able to leverage the creative and business expertise of the various entertainment interests of Rush Communications to create successful brand image campaigns for its clients. Rush Media has been using the RUSH mark as service mark since at least as early as 1995. I control the nature and quality of the goods and services offered by Rush Media and benefit from its success.

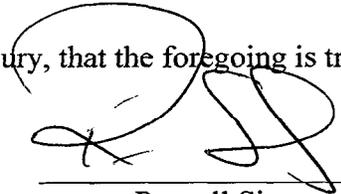
9. I personally and through my multiple business enterprises have continuously and substantially used the RUSH trademark and tradename in interstate commerce since at least as early as 1981 in connection with all forms of media and entertainment services. In addition, I have continuously and substantially used the RUSH trademark and tradename in interstate commerce since at least as early as 1995 in connection with its advertising, marketing and philanthropic services.

10. As the principle owner, majority shareholder and/or controlling member of the Rush Entities, I have a real and personal interest in protecting the valuable trademark rights to the mark RUSH as it is used in the media and entertainment industries. Consequently, I believe that

I, both personally and through my interests in the Rush Entities, will be damaged by the registration of Applicant's mark, RUSH NEW MEDIA, Serial No. 75/741,795.

11. Based upon all of the foregoing facts and for all of the foregoing reasons, I respectfully submit that I have privity with each and every Rush Entity. As such, the instant opposition is timely and I am the proper opposer in this matter. However, to the extent that the Board believes that the Rush Entities should be joined as joint opposers, I will pay any fee required to join them.

I declare, under the penalty of perjury, that the foregoing is true and correct.



Russell Simmons

Certificate of Mailing by Express Mail

I, Eugene Koenig, hereby certify that a *Response to February 7, 2002 Order Issued by the Trademark Trial and Appeal Board with a Declaration of Russell Simmons* is being deposited as "Express Mail" with the United States Postal Service addressed to:

Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, Box TTAB—No Fee, on the date indicated below:

Signed: Eugene Koenig

Date of Deposit: September 4, 2002

"Express Mail" Label No.: ET 547920521 US

Certificate of Mailing by Express Mail

"Express Mail" mailing label No. _____ ET 547920946 US — _____

I, Eugene Koenig, hereby certify that a true and correct copy of a *Response to February 7, 2002 Order Issued by the Trademark Trial and Appeal Board with a Declaration of Russell Simmons* is being served by "Express Mail" by depositing the same as Express Mail with the United States Postal Service and addressed to counsel for Applicant Kerry Colin Keane, on September 4, 2002 at the address set forth below:

G. Roxanne Elings, Esq.
Greenberg Traurig LLP
885 Third Avenue
New York, New York 10022-4834

Signed: Eugene Koenig

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Flab

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TRADemark TRIAL AND
APPEAL BOARD

September 4, 2002

VIA EXPRESS MAIL (ET547920521US)

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
Attn: Trademark Trial and Appeal Board

**RE: Opposition No. 91122816 to the
Mark RUSH NEW MEDIA, Ser. No. 75/741,795**

Dear Sir/Madam:

In connection with the above-referenced opposition proceeding, enclosed are the following documents:

1. Response to February 7, 2002 Order Issued by the Trademark Trial and Appeal Board with attached Declaration of Russell Simmons; and
2. A self-addressed return postcard.

Please acknowledge receipt of the enclosed materials by placing your receiving date stamp on the enclosed postcard and returning it to our office.

Sincerely,



Nicole E. Miller
Attorney for Opposer
Russell Simmons

Enclosures

cc: David Mermelstein, Esq.