

ESTTA Tracking number: **ESTTA59447**

Filing date: **12/28/2005**

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	Paramount Pictures Corporation
Granted to Date of previous extension	01/07/2006
Address	5555 Melrose Avenue Hollywood, CA 90038 UNITED STATES

Attorney information	Teena H. Lee Davis Wright Tremaine LLP 1633 Broadway, 27th Floor New York, NY 10019 UNITED STATES teenalee@dwt.com Phone:(212) 489-8230
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Applicant Information

Application No	78476812	Publication date	11/08/2005
Opposition Filing Date	12/28/2005	Opposition Period Ends	01/07/2006
Applicant	Agudo Enterprises, LLC Unit B2 235 Woodport Road Sparta, NJ 07871 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 1997/11/01 First Use In Commerce: 1998/04/01 All goods and services in the class are opposed, namely: Providing on-line forums for transmission of messages among computer users, namely, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest

Attachments	agudoopp.pdf (12 pages)
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Signature	/Teena H. Lee/
Name	Teena H. Lee
Date	12/28/2005

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

In the Matter of Application Serial No. 78/476812
Published in the Official Gazette on November 8, 2005
Filed: August 31, 2004
Applicant: Agudo Enterprises, LLC
Mark: PINKLADIES
International Class: 38
For: Providing on-line forums for transmission of messages among computer users, namely, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest (U.S. Classes 100, 101, 104)

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: **PARAMOUNT PICTURES CORPORATION,** : **Opposition No. _____**
: **Opposer,** :
: **- against -** : **NOTICE OF OPPOSITION**
: **AGUDO ENTERPRISES, LLC,** :
: **Applicant.** :
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Paramount Pictures Corporation (“Paramount”), a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 5555 Melrose Avenue, Los Angeles, California 90038, hereby opposes the application of Agudo Enterprises, LLC (“Applicant”), upon information and belief, a limited liability company organized and existing under the laws of New Jersey, with its principal place of business at 235 Woodport Road, Unit B2, Sparta, New Jersey 07871, for registration of the trademark PINKLADIES, Serial Number 78/476812, published in the Official Gazette on November 8, 2005 (the “Agudo Application”).

Paramount believes that it will be damaged by registration of the mark shown in Serial Number 78/476812 and opposes such registration on the following grounds:

Background

1. Paramount is, and has been for many years, engaged in the business of producing and distributing audiovisual entertainment programs including feature motion pictures, and exploiting the rights of those properties throughout the United States and internationally. Among the feature motion pictures produced by Paramount are the world-renowned films *Grease* and its sequel *Grease 2* (collectively, the “Grease Motion Pictures”). *Grease* is set in a fictional American high school, Rydell High School, in the 1950’s.

2. The Grease Motion Pictures make extensive use of the coined names and trademarks PINK LADIES (which refers to the members of a cool clique of high school girls) and T-Birds (which refers to the male gang counterpart of the PINK LADIES). The PINK LADIES mark (the “Mark”) is part of a strong family of trademarks all associated with and/or derived from the Grease Motion Pictures.

The Original Grease Motion Picture

3. The motion picture titled *Grease* was based on the original, critically acclaimed smash Broadway show written by Jim Jacobs and Warren Casey, which premiered on Valentine’s Day 1977 and became one of the longest-running productions in Broadway history.

4. Thereafter, Paramount obtained all rights to create a feature length motion picture entitled *Grease*. The motion picture was first released in the United States on July 7, 1978 and featured John Travolta, who was then known as American’s #1 heartthrob, “Vinnie Barbarino”, on

the top-rated television series “*Welcome Back Kotter*” and who had just finished filming the motion picture titled “*Saturday Night Fever*”. Travolta starred in *Grease* as “Danny Zuko”, the leather-clad leader of the fictional T-Birds gang.

5. International recording star Olivia Newton-John was cast in her first American film as Zuko’s beautiful, innocent love interest, “Sandy Olsson”. Stockard Channing, acclaimed on Broadway and in film, starred as “Rizzo”, the tough-talking, liberal leader of the fictional PINK LADIES gang. The film also features guest stars including, *inter alia*, Eve Arden as Rydell High School’s “Principal McGee”, Frankie Avalon as “Teen Angel”, Sid Caesar as “Coach Calhoun”, and the rock band Sha-Na-Na, as the Fifties group “Johnny Casino and the Gamblers”.

6. The musical motion picture was a smash hit telling the stories of the romantic dilemmas of several T-Birds and PINK LADIES throughout their senior year of high school in 1959. Since its original release in 1978, *Grease* has become a box office success and cultural phenomenon grossing more than \$380 million at theaters worldwide.

The PINK LADIES Characters

7. The PINK LADIES gang featured in the film is a fictional clique of high school girls who evoke “cool”, constantly chewing and snapping gum, and all dressed in a distinct combination of clothing elements, including, *inter alia*, pink satin bowling jackets bearing the PINK LADIES Mark on the back of the jacket in stylized black script lettering, a pink bowling shirt, black Capri pants, a scarf and cats eye sunglasses. Their male counterparts in the *Grease* Motion Pictures are the T-Birds, who identify themselves by their cars and whose only interest in school is in auto shop.

8. In *Grease*, “Sandy” wants to become a PINK LADY and associate with the other PINK LADIES, who socialize with the T-Birds. After she is coached by the PINK LADIES as to the correct stylized clothing, hairstyle, makeup and attitude necessary to become one of them, she is welcomed into the PINK LADIES and unites with the leading T-Bird, “Danny”.

Subsequent *Grease* Motion Pictures and Re-Releases

9. Based on the popularity of the original film, Paramount produced and released the sequel entitled *Grease 2* in 1982, starring Michelle Pfeiffer, Maxwell Caulfield and Lorna Luft. This sequel continued the 1950’s romantic theme among Rydell High School students. *Grease 2* is a love story between a tough PINK LADY gang member and a shy foreign transfer student, who ultimately transforms into a tough, rebellious and cool member of the T-Birds.

10. To celebrate the twentieth anniversary of the release of the original Motion Picture, Paramount re-released *Grease* in theaters in 1998 to great success. To date, it is among the highest grossing motion picture musicals in history. *Grease* and its stars have been nominated for numerous awards including an *Academy Award*® for Best Music; *Golden Globes*® for Best Motion Picture – Musical/Comedy, Best Motion Picture Actor and Actress – Musical/Comedy – John Travolta and Olivia Newton-John, and Best Original Song – Motion Picture. Additional prestigious honors garnered by this film include the *People’s Choice Award* for Favorite Musical Motion Picture in 1979, an award voted on by the American public.

11. Soon after the film’s release, the original *Grease* soundtrack rose to #1 on *Billboard* Magazine’s Top Album chart and remained in that position for 12 weeks, and on the chart for 77 weeks in total. That soundtrack won *Grammy Awards*® for the Album of the Year and Best Pop Vocal Performance – Female for “Hopelessly Devoted To You” by Olivia Newton-John in 1978;

and *Golden Globe*® nominations for Best Original Song “*Grease*” and “*You’re the One That I Want*” that same year. By 1984, the soundtrack went multi-platinum and to date, it is one of the second best selling soundtrack albums, with more than 20 million albums sold.

12. Since its original release, *Grease* has captured and continues to capture new audiences. In the United States, *Grease* is currently licensed by Paramount for broadcast on television networks, in syndication, and on cable stations nationwide. Licensing revenues derived from these broadcasts currently exceed \$22 million. *Grease* has also aired on television in more than 60 countries with licensing revenue currently exceeding \$6 million.

13. The *Grease* Motion Pictures have been released on videocassette and beta tapes (collectively, “VHS”), laser disc and DVD formats and continue to be sold in commerce in the United States. As of 1997 – nearly 20 years since the release of the first Motion Picture – *Grease* was one of the top 10 video titles sold in the United States. More than 10 million units of *Grease* have been sold worldwide to date with revenues reaching nearly \$100 million.

Paramount’s Trademark Rights in the *Grease* Motion Pictures

14. Paramount owns and controls certain rights in and to the *Grease* Motion Pictures, including copyright and trademark interests therein.

15. Paramount owns trademark registrations and applications worldwide for a family of *Grease*-related marks including the following federal trademark registrations: (1) “RYDELL HIGH SCHOOL”, Registration No. 2,181,464 in International Class 25 for “t-shirts”; (2) “GREASE”, Registration No. 2,243,771 in International Class 28 for “posable play figures, dolls, and toy vehicles”; (3) “GREASE & Design”, Registration No. 1,117,682 in International Class 16

for “printed matter – namely, poster magazines, souvenir programs, sheet music and posters”; (4) “GREASE”, Registration No. 1,736,301 in International Class 9 for “entertainment motion picture films and pre-recorded video cassettes”; and (5) “GREASE & Design”, Registration No. 1,738,157 in International Class 9 for “entertainment motion picture films and pre-recorded video cassettes”.

16. Also among the family of *Grease* marks is the well known PINK LADIES Mark. On or about February 12, 2003, Paramount filed for the federal trademark registration for the PINK LADIES Mark, Serial No. 78/214,102 in International Class 28 for “toy vehicles, poseable play figures, dolls, toy action figures, plush toys, board games, card games” (the “Paramount Application”). The Paramount Application was published for opposition on December 9, 2003. There have been no notices of opposition filed to date.

17. Based on the world-renown of the Grease Motion Pictures, the PINK LADIES Mark is among the instantly recognizable well-known trademarks associated with the Grease Motion Pictures.

Paramount’s Merchandising of the *Grease* Marks

18. Paramount is, and has been for many years, engaged in the business of licensing to others the right to use titles and other elements of its audiovisual entertainment programs on or in connection with various products and services. Such a campaign is commonplace and well known to the general public and throughout the industry to exploit a successful entertainment property as well as assist in consumer awareness of the property.

19. Through its licensees, Paramount has manufactured and sold numerous products under the *Grease* marks and copyrights in interstate commerce including, *inter alia*, PINK

LADIES signature jackets, t-shirts and caps; calendars; dolls and figurines; die-cast assembled car and model kits; salt and pepper shakers prominently including the PINK LADIES and T-Birds marks on the shakers in the form of the respective PINK LADIES and T-Birds jackets and on the packaging of the boxed set; bubblegum trading cards; *Grease* movie posters; books; downloadable images for screensavers and mobile phones; and other collectible items.

20. Since its introduction in the original Motion Picture, the Mark has been widely associated by the public with the *Grease* Motion Pictures and related merchandise and with Paramount as its source, and has acquired secondary meaning. Consumers specifically seek out such collectible merchandise featuring the *Grease* marks, including the PINK LADIES Mark, solely because they are associated with the *Grease* Motion Pictures.

21. The Mark has been used and will continue to be used by Paramount in its promotional and marketing efforts including on television, videos, DVDs, collectible merchandise or otherwise: the cover photograph for the *Grease 2* soundtrack and the promotional poster for the sequel Motion Picture depict the PINK LADIES jacket worn by Michelle Pfeiffer, and the programs dedicated to the *Grease* Motion Pictures contain footage including the PINK LADIES and T-Birds gangs and characters.

22. Paramount's promotional activities also include the official *Grease* website, www.greasemovie.com. The website features a synopsis of the plot of the original *Grease* Motion Picture, production trivia and biographies of the various stars and producers. It also offers *Grease* fans an on-line game, downloadable still photographs from the original Motion Picture and downloadable official *Grease* desktop patterns, one of which prominently features the PINK

LADIES Mark interspersed throughout the pattern in stylized pink lettering, along with other design elements.

23. Over the past several years, revenues derived from sales of merchandise sold by Paramount and/or its licensees under and in connection with the *Grease* marks have exceeded \$1.3 million.

The Fame of the *Grease* Family of Marks

24. The fame of the *Grease* Motion Pictures and Paramount's active merchandising campaign for the *Grease* family of marks have led to a "*Grease* culture" spawning *Grease* fan clubs; fifties style *Grease* parties; conventions and reunions based on the characters in the *Grease* Motion Pictures including the PINK LADIES and T-Birds; and hundreds of amateur productions.

25. There are *Grease* fan clubs devoted solely to the PINK LADIES characters. Many of the *Grease* fan clubs maintain websites and host message boards on the Internet.

26. VH1 has produced and aired several documentary series celebrating the continued popularity of the *Grease* Motion Pictures and culture. These include "Where Are They Now: The Girls of *Grease*" (2000), which features clips of the PINK LADIES characters in the *Grease* Motion Pictures, and has been and continues to be broadcast repeatedly on VH1.

27. From July to September of 2002, the Franklin Mint Museum located in Pittsburgh, Pennsylvania featured a *Grease* exhibition at which the PINK LADIES jacket that appeared in the original Motion Picture was exhibited.

28. Didi Conn, who played "Frenchy", one of the PINK LADIES, authored a book entitled "Frenchy's *Grease* Scrapbook", which provides an inside account of the making of the

original Grease Motion Picture. The book includes numerous still photographs from the Grease Motion Pictures, authorized by Paramount, and contributions from John Travolta, Olivia Newton-John, Stockard Channing, Jeff Conaway, Dinah Manoff and other cast members.

29. As a result of Paramount's expansive merchandising program and the fame generated in connection therewith and from the Grease Motion Pictures themselves, the consuming public has come to recognize the name and Mark PINK LADIES as part of the *Grease* properties and to associate that name with the Grease Motion Pictures and Paramount.

The Agudo Application

30. On or about August 31, 2004, Applicant filed the Agudo Application, Serial No. 78/476812, to register the mark, "PINKLADIES" for "providing on-line forums for transmission of messages among computer users, namely, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest" in International Class 38. Applicant claims a first use date of November 1, 1997 and a first use in commerce date of April 1, 1998. The Agudo Application was published for opposition on November 8, 2005.

31. Applicant's claimed mark "PINKLADIES" is virtually identical to Paramount's Mark visually and exactly identical aurally. While visually Applicant's claimed mark differs from Paramount's in that Applicant's mark lacks a space between the words "PINK" and "LADIES", that difference is insignificant, and Applicant's mark is therefore confusingly similar to Paramount's.

32. Upon information and belief, Applicant maintains a website at www.pinkladies.com, which purportedly serves as a general online forum for women. Its

members range from women with an interest in the color pink, cheerleaders, models, women who make, trade and/or sell hats and quilts and women interested in promoting breast cancer awareness. The website allows members to post stories and messages and join in chat rooms, provides members with an email account and free webpage and facilitates social gatherings amongst its members. It also features on-line games.

33. As recently as November 2005, Applicant offered for sale through the “Pinkladies Online Store” featured on its website a pink satin bowling jacket bearing the mark “PINK LADIES” in stylized black script lettering. The jacket offered was remarkably similar to the jacket worn by the PINK LADIES characters in the Grease Motion Pictures.

34. Upon learning of the filing of the Agudo Application and of Applicant’s sale of “PINK LADIES” jackets on Applicant’s website, Paramount notified Applicant by letter dated March 3, 2005 of its trademark rights in and to the PINK LADIES Mark and of the confusingly similar nature of Applicant’s proposed mark, and demanded that Applicant withdraw its Application with prejudice.

35. By another letter dated November 16, 2005, Paramount advised Applicant of the strength and fame of its PINK LADIES Mark and the strong presence the Mark, as associated with the Grease Motion Pictures and Paramount, enjoys on the Internet. To date, Applicant appears to have ceased offering for sale “PINK LADIES” jackets, but has otherwise refused to comply with Paramount’s demands.

36. Applicant’s continued intent to file the Agudo Application despite knowledge and awareness of Paramount’s Mark, demonstrates Applicant’s intent to trade on the tremendous good

will associated with the Grease Motion Pictures and Paramount and to usurp Paramount's valuable intellectual property.

37. As noted above, Paramount's Mark has a strong presence on the Internet, and the Agudo Application seeks to register virtually the same mark for use on the Internet. Indeed, Applicant's claimed and actual use of its proposed mark on the Internet is to support online forums, chat rooms and messages – similar activities of *Grease* fan clubs that also, as discussed above, maintain websites and host message boards. To grant Applicant a registration therefore would not only violate Paramount's rights, which are superior to those of Applicant, but also cause confusion, irreparably harming Paramount and its ability to exercise its rights in and to its Mark.

38. As noted above, Paramount's Mark is famous, and to grant Applicant a registration would also dilute Paramount's Mark in that it will likely lessen the capacity of the Mark to identify and distinguish Paramount's or its licensees' goods and services.

39. For the foregoing reasons, Paramount would be seriously injured by the issuance of registration to the Agudo Application because Applicant's mark:

- a. Would be likely to cause confusion, to cause mistake or to deceive;
- b. Would falsely and erroneously suggest a connection with Paramount;
- c. Would be likely to dilute Paramount's famous Mark; and
- d. Would tend to damage and interfere with Paramount's valuable goodwill associated with its PINK LADIES Mark and associated goods.


WHEREFORE, Paramount, by its undersigned attorneys, respectfully requests that its opposition be sustained and the application for registration by Applicant Agudo Enterprises, LLC

be denied.

The filing fee for this Opposition is enclosed.

Dated: New York, New York
December 28, 2005

Respectfully submitted,
DAVIS WRIGHT TREMAINE LLP

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