

ESTTA Tracking number: **ESTTA165247**

Filing date: **09/27/2007**

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	TVN Entertainment Corporation
Granted to Date of previous extension	09/30/2007
Address	4111 W. Alameda Ave., Suite 401 Burbank, CA 91505 UNITED STATES

Correspondence information	Rose Helen Perez Attorney at Law Rose Helen Perez, Attorney at Law 303 43rd Street Newport Beach, CA 92663 UNITED STATES rperez@lawrhp.com Phone:949-650-2321
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Applicant Information

Application No	78785250	Publication date	04/03/2007
Opposition Filing Date	09/27/2007	Opposition Period Ends	09/30/2007
Applicant	PM Productions 5882 Bowcroft Street, #2 Los Angeles, CA 900164907 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2005/12/16 First Use In Commerce: 2005/12/16 All goods and services in the class are opposed, namely: Pre-recorded CD's, video tapes, laser disks and DVD's featuring Stage Plays, Instructional Videos, Inspirational Videos, Music and Dance Recitals, and general amateur entertainment

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Common Law Trademark Infringement; Common Law Unfair Competition; Unlawful Business Practices, Calif. Bus. & Prof. Code Section 17200 et seq.

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77085115	Application Date	01/17/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TVN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: First Use: 1990/01/05 First Use In Commerce: 1990/01/05 Broadcasting services and provision of telecommunication access to movies, events, television programs and other video and audio content provided via a video-on-demand service; video on demand transmission services; satellite and television transmission services; Pay-per-view television transmission services</p> <p>Class 041. First use: First Use: 1990/01/05 First Use In Commerce: 1990/01/05 Cable television programming; distribution of Video on Demand television programming to cable and satellite television systems; distribution of television programming to cable televisions systems</p>		

Attachments	77085115#TMSN.jpeg (1 page)(bytes) Notice of Opposition TVN The Videozation Network 78785250.pdf (16 pages)(1285851 bytes)
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Signature	/rhp/
Name	Rose Helen Perez, Attorney at Law
Date	09/27/2007

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

In the matter of Application Serial No. 78/785250

Filed On January 4, 2006

For the Mark TVN THE VIDEOZATION NETWORK

Published in the Official Gazette on April 3, 2007

TVN ENTERTAINMENT CORPORATION, a)	OPPOSITION NO.
Delaware corporation,)	
)	
Opposer,)	
)	
v.)	
)	
PM PRODUCTIONS, a Sole Proprietorship)	
)	
Applicant.)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Dear Commissioner:

Opposer, TVN Entertainment Corporation (“TVN Entertainment”), is a Delaware corporation located and doing business at 4111 West Alameda Avenue, Suite 401, Burbank, California 91505, and believes that it will be damaged by registration of the mark shown in Serial No. 78/785250, and hereby opposes the same.

As grounds of opposition, it is alleged that:

BACKGROUND FACTS

I. TVN ENTERTAINMENT CORPORATION

1. TVN Entertainment, since at least January 5, 1990, has been, and is now, using the mark “TVN” in connection with its business and the sale of goods and services. Said use has been valid and continuous since at least said date of first use and has not been abandoned.

2. On January 17, 2007, TVN Entertainment filed an application under Serial No. 77/085115 to register the mark “TVN” on the Principal Register in (i) Class 38 for Broadcasting services and provision of telecommunication access to movies, events, television programs and other video and audio content provided via a video-on-demand service; video on demand transmission services; satellite and television transmission services; distribution of television programming to cable television systems; Pay-per-view television transmission services, and (ii) Class 41 for Cable television programming; distribution of Video on Demand television programming to cable and satellite television systems. Attached as Exhibit A is a true and correct copy of the TESS printout of TVN Entertainment’s application under Serial No. 77/085115.

3. TVN Entertainment is the owner of cancelled U.S. Trademark Registration No. 1,686,954 for the TVN mark in Class 38 for television broadcasting services via satellite, and in Class 41 for television programming services, filed on January 5, 1990, registered on May 12, 1992, and cancelled on February 15, 2003 because the USPTO did not receive a Section 8 Declaration of Continued Use or a Section 9 Renewal Application within the statutory filing

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period. TVN did not abandon the TVN mark, and has been continuously using the TVN mark in commerce in connection with said services since at least September 4, 1988, and through the date of cancellation to present. Attached as Exhibit B is a true and correct copy of the cancelled U.S. Trademark Registration Certificate for Registration No. 1,686,954 for the TVN trademark in Classes 38 and 41.

4. TVN Entertainment is also the owner of cancelled U.S. Trademark Registration No. 1,612,831 for the TVN mark in Class 9 for electronic receivers for residential use in receiving and unscrambling television signals, filed on January 5, 1990, registered on September 11, 1990, and cancelled on March 17, 1997 because the USPTO did not receive a Section 8 Declaration of Continued Use within the statutory filing period. TVN did not abandon the TVN mark, and has been continuously using the TVN mark in commerce in connection with said services since at least July 1989, and through the date of cancellation to present. Attached as Exhibit C is a true and correct copy of the cancelled U.S. Trademark Registration Certificate for Registration No. 1,612,831 for the TVN trademark in Class 9.

5. The TVN trademark is symbolic of TVN Entertainment's extensive good will and public recognition built up by TVN Entertainment through substantial amounts of time and effort in advertising and promotion. TVN Entertainment extensively promotes and markets the TVN mark and has spent significant time and money on promoting the TVN mark.

6. TVN Entertainment commenced operations at least as early as September 4, 1998, and has used the TVN mark extensively and nationwide since then to identify itself, its business, and its service offerings.

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7. TVN Entertainment uses the TVN mark to identify and promote itself as the largest privately held digital content aggregation, management, delivery, distribution, and service company in the United States.

8. TVN Entertainment uses the TVN mark to deliver video-on-demand (VOD) programming, including movies, children's and Spanish language content, and genre-themed on-demand channels (e.g., Karaoke music video programming), to millions of viewers in the United States through its video distribution affiliates, such as cable television, internet protocol television and satellite direct to home television operators.

9. TVN Entertainment owns the Internet domain name <tvn.com>, where it hosts a website promoting the TVN mark and TVN Entertainment's comprehensive service offerings in video programming entertainment. A search of "TVN" using several popular internet search engines results in TVN Entertainment's website showing up at the top of each of their lists, and reveals that the TVN mark remains in nationwide use by TVN Entertainment in the market of video programming distribution and video programming entertainment.

10. TVN Entertainment's service offerings under the TVN mark have been very successful. Customers and clients of TVN Entertainment include (i) content providers, including major and independent movie studios, broadcast and basic cable networks, premium cable networks, exclusive VOD networks, programmers, producers, and sports events promoters, among others, and (ii) multi-channel video distributors, such as cable television, internet protocol television and satellite direct to home television operators, among others, including major multiple system operators and telecommunications companies.

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II. THE APPLICANT'S BUSINESS

11. Applicant PM Productions (hereinafter "Applicant") identifies itself in its application under Serial No. 78/785250 as a sole proprietorship with an address in Los Angeles, California.

12. Applicant's application under Serial No. 78/785250 is to register the word mark "TVN THE VIDEOZATION NETWORK", in stylized form, on the Principal Register in Class 9 for pre-recorded CD's, video tapes, laser disks and DVD's featuring Stage Plays, Instructional Videos, Inspirational Videos, Music and Dance Recitals, and general amateur entertainment, with a stated first use and first use in commerce date of December 16, 2005, and a filing date of January 4, 2006.

13. TVN Entertainment is informed and believes, and therefore alleges, that Applicant (i) provides production and editing services for video producers, (ii) creates videos, including movies, infomercials, documentaries, commercials, music videos and general amateur entertainment, and (iii) facilitates the purchase and sale of video programming on pre-recorded CD's, video tapes, laser disks and DVD's.

14. According to the Applicant's website at <pmproductionsvideos.com>, PM Productions is "Serving the Nation", offering services that include television commercials, infomercials, movie production, documentaries, music videos, animation, and sports events.

15. TVN Entertainment is informed and believes, and therefore alleges, that Applicant intends to use or is using the TVN THE VIDEOZATION NETWORK mark, with the propensity for the Applicant, its customers and/or the public to abbreviate that mark to its root term or acronym "TVN", to target the same or closely related customers as those that are or may

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be served by TVN Entertainment (e.g., program suppliers, content providers, video producers, event promoters) and in the same or closely related market (e.g., video programming distribution, video on demand).

16. TVN Entertainment is informed and believes, and therefore alleges, that Applicant owns The Videozation Network, a membership organization in which members buy and sell videos to and from each other over the internet.

17. TVN Entertainment is informed and believes, and therefore alleges, that Applicant owns The Videozation Network, and promotes it as a subsidiary of PM Productions.

18. TVN Entertainment is informed and believes, and therefore alleges, that Applicant is using the TVN THE VIDEOZATION NETWORK mark, with the propensity for the Applicant, its customers and/or the public to abbreviate that mark to its root term or acronym “TVN”, to deliver video programming to consumers through DVD/VHS videos.

19. TVN Entertainment is informed and believes, and therefore alleges, that Applicant intends to use or is using the TVN THE VIDEOZATION NETWORK mark, with the propensity for the Applicant, its customers and/or the public to abbreviate that mark to its root term or acronym “TVN”, to explore content delivery methods other than DVD/VHS videos, including the need for a video delivery service provider, such as TVN Entertainment, to provide such content delivery services.

20. TVN Entertainment is informed and believes, and therefore alleges, that Applicant intends to use or is using the TVN THE VIDEOZATION NETWORK mark, with the propensity for the Applicant, its customers and/or the public to abbreviate that mark to its root

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term or acronym “TVN”, to offer video-on-demand (VOD) services for members of The Videozation Network.

21. In that the word mark “TVN” is the essence of Applicant’s Mark, and that word mark is the same mark as TVN Entertainment’s TVN trademark, and in view of the related nature of the uses thereof, and the related nature of the services of the respective parties, it is alleged that Applicant’s word mark or the essence of Applicant’s stylized mark so resembles, and/or is the same mark when viewed at its root, or when abbreviated or used as an acronym, as TVN Entertainment’s TVN trademark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

22. Hereinafter, the mark “TVN THE VIDEOZATION NETWORK” shall be referred to as “Applicant’s Mark”, and TVN Entertainment’s trademark “TVN” shall be referred to as the “Opposer’s Mark”.

FIRST CAUSE OF ACTION

(Opposition Based on Lanham Act Section 2(d);

Prior Adoption and Use of Same or Similar Mark or Trade Name, 15 U.S.C. § 1052(d))

23. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 22 as though fully set forth herein.

24. TVN Entertainment owns the TVN trademark described above and is identified with and has established rights to this trademark.

25. By the acts described above, the use and intended use in commerce of the Applicant’s Mark in connection with distribution methods for video programming that is or may be competitive to, or is or may be dependent on TVN Entertainment’s services, is likely to cause

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confusion, mistake, or deception as to the origin, sponsorship, or approval of Applicant's services, network or organization, or the affiliation, connection, or association of Applicant with TVN Entertainment and the Opposer's Mark.

26. Registration of Applicant's Mark would greatly and irreparably damage TVN Entertainment, if Applicant's application under Serial No. 78/785250 is not refused by this Board.

27. In that the word mark "TVN" is the essence of Applicant's Mark, and that word mark is the same mark as TVN Entertainment's TVN trademark, and in view of the related nature of the uses thereof, and the related nature of the services of the respective parties, TVN Entertainment has a reasonable belief that registration of its application under Serial No. 78/785250 for TVN Entertainment's TVN trademark previously used in the United States, and not abandoned, may be refused because of Applicant's registration, if registration is permitted to occur, to the great and irreparable damage to TVN Entertainment.

SECOND CAUSE OF ACTION

(Opposition Based on Lanham Act Section 2(a);

Unfair Competition, False Designation of Origin, 15 U.S.C. § 1052(a))

28. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 27 as though fully set forth herein.

29. TVN Entertainment owns the TVN trademark described above and is identified with and has established rights to this trademark.

30. By the acts described above, the use and intended use in commerce of the Applicant's Mark in connection with distribution methods for video programming and other

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related services that is or may be competitive to, or is or may be dependent on TVN Entertainment's services, is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of Applicant's services, network or organization, or the affiliation, connection, or association of Applicant with TVN Entertainment and the TVN mark.

31. In that the word mark "TVN" is the essence of Applicant's Mark, and that word mark is the same mark as TVN Entertainment's TVN trademark, and coupled with the propensity to abbreviate Applicant's Mark to its root term or acronym "TVN", and in view of the related nature of the uses thereof, and the related nature of the services of the respective parties, it is alleged that Applicant's Mark consists of and comprises matter that may disparage and falsely suggest a connection with TVN Entertainment, and as a result is likely to injure TVN Entertainment's reputation, business and relations with its content suppliers, distributors and other customers.

THIRD CAUSE OF ACTION

(Opposition Based on Dilution; 15 U.S.C. § 1125(c); 15 U.S.C. § 1063)

32. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 31 as though fully set forth herein.

33. TVN Entertainment's TVN trademark is famous under 15 U.S.C. § 1125(c).

34. By the acts described above, the use in commerce of Applicant's Mark, which began after Opposer's Mark became famous, has diluted and will continue to dilute the distinctive quality of the Opposer's Mark.

35. The acts described above constitute dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

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36. Applicant's use and intended use of Applicant's Mark are likely to confuse and deceive content providers, producers, distributors and customers, to injure the business of TVN Entertainment, to trade on the business reputation of TVN Entertainment, and to interfere with the business relationships of TVN Entertainment.

37. Registration of Applicant's Mark would greatly and irreparably damage TVN Entertainment, if Applicant's application under Serial No. 78/785250 is not refused by this Board, in that such registration may serve as a complete bar to an action against Applicant, with respect to the Applicant's Mark, that is brought by TVN Entertainment and that seeks to prevent dilution of the distinctiveness of the Opposer's Mark (15 U.S.C. § 1125(c)(3)).

FOURTH CAUSE OF ACTION

(Common Law Trademark Infringement)

38. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 37 as though fully set forth herein.

39. By the acts described above, the use of Applicant's Mark constitutes trademark infringement under the common law of the State of California.

40. Before a court with jurisdiction to enforce such action, TVN Entertainment would be entitled to request injunctive relief in addition to damages, and hereby seeks to reserve its right to request such.

41. Registration of Applicant's Mark would greatly and irreparably damage TVN Entertainment, if Applicant's application under Serial No. 78/785250 is not refused by this Board.

FIFTH CAUSE OF ACTION

(Common Law Unfair Competition)

42. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 41 as though fully set forth herein.

43. By the acts described above, it is alleged that Applicant has engaged in, or may be engaged in, unfair competition in violation of the common law of the State of California.

44. As a consequence, before a court with jurisdiction to enforce such action, TVN Entertainment would be entitled to request injunctive relief in addition to damages, and hereby seeks to reserve its right to request such.

45. Registration of Applicant's Mark would greatly and irreparably damage TVN Entertainment, if Applicant's application under Serial No. 78/785250 is not refused by this Board.

SIXTH CAUSE OF ACTION

(Unlawful Business Practices, Calif. Bus. & Prof. Code § 17200 *et seq.*)

46. TVN Entertainment realleges and incorporates by reference paragraphs 1 through 45 as though fully set forth herein.

47. By the acts described above, it is alleged that Applicant has engaged in, or may be engaged in, unlawful and unfair business practices and has performed, or may be performing, unfair, deceptive and misleading acts that threaten to injure TVN Entertainment in its business.

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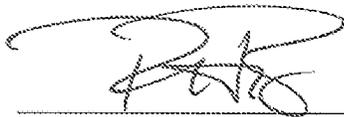
48. As a consequence, before a court with jurisdiction to enforce such action, TVN Entertainment would be entitled to request injunctive relief in addition to damages, and hereby seeks to reserve its right to request such.

49. Registration of Applicant's Mark would greatly and irreparably damage TVN Entertainment, if Applicant's application under Serial No. 78/785250 is not refused by this Board.

PRAYER FOR RELIEF

50. WHEREFORE, Opposer prays that said application Serial No. 78/785250 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

By:



Rose Helen Perez (California SBN 112,357)
Attorney for Opposer TVN Entertainment Corporation

Rose Helen Perez, Attorney at Law
303 43rd Street
Newport Beach, CA 92663

Date: September 26, 2007



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TVN

Word Mark

TVN

Goods and Services

IC 041. US 100 101 107. G & S: Cable television programming; distribution of Video on Demand television programming to cable and satellite television systems; distribution of television programming to cable televisions systems. FIRST USE: 19900105. FIRST USE IN COMMERCE: 19900105

IC 038. US 100 101 104. G & S: Broadcasting services and provision of telecommunication access to movies, events, television programs and other video and audio content provided via a video-on-demand service; video on demand transmission services; satellite and television transmission services; Pay-per-view television transmission services. FIRST USE: 19900105. FIRST USE IN COMMERCE: 19900105

Standard Characters Claimed

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Serial Number 77085115
Filing Date January 17, 2007
Current Filing Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) TVN Entertainment Corporation CORPORATION DELAWARE
4111 W. Alameda Avenue, #401 Burbank CALIFORNIA 94505
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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EXHIBIT B

Int. Cls.: 38 and 41

Prior U.S. Cls.: 104 and 107

United States Patent and Trademark Office **Reg. No. 1,686,954**
Registered May 12, 1992

**SERVICE MARK
PRINCIPAL REGISTER**

TVN

TVN ENTERTAINMENT (DELAWARE CORPO-
RATION)
100 WILSHIRE BOULEVARD
SUITE 1600
SANTA MONICA, CA 90401

FOR: TELEVISION BROADCASTING SERV-
ICES VIA SATELLITE, IN CLASS 38 (U.S. CL.
104).

FIRST USE 9-4-1988; IN COMMERCE
9-4-1988.

FOR: TELEVISION PROGRAMMING SERV-
ICES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 9-4-1988; IN COMMERCE
9-4-1988.

SN 74-016,448, FILED 1-5-1990.

THOMAS V. SHAW, EXAMINING ATTORNEY

EXHIBIT C

Int. Cl.: 9

Prior U.S. Cl.: 21

United States Patent and Trademark Office

Reg. No. 1,612,831
Registered Sep. 11, 1990

**TRADEMARK
PRINCIPAL REGISTER**

TVN

TVN ENTERTAINMENT CORPORATION
(DELAWARE CORPORATION)
SUITE 1600
100 WILSHIRE BOULEVARD
SANTA MONICA, CA 90401

SCRAMBLING TELEVISION SIGNALS, IN
CLASS 9 (U.S. CL. 21).
FIRST USE 7-0-1989; IN COMMERCE
7-0-1989.

FOR: ELECTRONIC RECEIVERS FOR RESI-
DENTIAL USE IN RECEIVING AND UN-

SER. NO. 74-016,442, FILED 1-5-1990.
THOMAS V. SHAW, EXAMINING ATTORNEY