

ESTTA Tracking number: **ESTTA186487**

Filing date: **01/14/2008**

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	Universal International Music B.V.
Granted to Date of previous extension	01/16/2008
Address	Gerrit van der Veenlaan 4 Baarn, 3743 NETHERLANDS
Domestic Representative	DeAnne H. Ozaki Universal Music Group 2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES deanne.ozaki@umusic.com Phone:310-865-1709

**Applicant Information**

Application No	77125239	Publication date	09/18/2007
Opposition Filing Date	01/14/2008	Opposition Period Ends	01/16/2008
Applicant	Steven M. Soares 43 Hanson Road Newton Center, MA 024593516 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: musical sound recordings and audiovisual recordings of musical performances
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1734502	Application Date	09/04/1991
Registration Date	11/24/1992	Foreign Priority Date	NONE
Word Mark	ISLAND		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 1989/09/00 First Use In Commerce: 1989/09/00 musical sound recordings and musical video recordings

U.S. Registration No.	1420517	Application Date	04/08/1986
Registration Date	12/09/1986	Foreign Priority Date	NONE
Word Mark	ISLAND PICTURES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1982/05/00 First Use In Commerce: 1982/05/00 [ MOTION PICTURE PRODUCTION AND DISTRIBUTION, HOME VIDEO PRODUCTION AND ] DISTRIBUTION [, AND SYNDICATION OF FILMS FOR COMMERCIAL TELEVISION ]		

U.S. Registration No.	1420518	Application Date	04/08/1986
Registration Date	12/09/1986	Foreign Priority Date	NONE
Word Mark	ISLAND PICTURES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1982/05/00 First Use In Commerce: 1982/05/00 MOTION PICTURE PRODUCTION AND DISTRIBUTION, HOME VIDEO PRODUCTION AND DISTRIBUTION, AND SYNDICATION OF FILMS FOR COMMERCIAL TELEVISION		

Attachments	74200707#TMSN.gif ( 1 page )( bytes ) 73592249#TMSN.gif ( 1 page )( bytes ) ISLAND WAVE RECORDS.PDF ( 5 pages )(468058 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/dho/
Name	DeAnne H. Ozaki
Date	01/14/2008

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

IN THE MATTER OF APPLICATION FOR U.S. TRADEMARK REGISTRATION  
SERIAL NO.: 77/125,239  
TRADE MARK: ISLAND WAVE RECORDS  
SERVICES: Musical sound recordings and audiovisual recordings of musical performances in Class 9  
FILING DATE: March 8, 2007  
PUBLICATION DATE: September 18, 2007

UNIVERSAL INTERNATIONAL MUSIC B.V., Opposer  v.  STEVEN M. SOARES, Applicant	}	Opposition No.  _____
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NOTICE OF OPPOSITION

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
Attention: TTAB

Dear Sir or Madam:

Universal International Music B.V. (“Opposer”), a Netherlands stock company, with a business address at Gerrit Van der Veenlaan 4, 3743 DN Baarn, Netherlands, believes that it will be damaged by the registration by Steven M. Soares (“Applicant”) of the mark which is the subject of the above-identified application (the “Application”), and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer has used in interstate and foreign commerce since at least as early as September 1, 1989, and is presently using, the trademarks ISLAND, ISLAND RECORDS, ISLAND PICTURES, ISLAND DEF JAM MUSIC GROUP, ISLAND and Design, and/or ISLAND PICTURES and design (collectively, the "Island Marks"), in connection with the following goods and services (collectively, "Opposer's Goods and Services"): pre-recorded audio tapes, discs and cassettes, video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings; downloadable ring tones, music, mp3s, graphics, games, images and videos for wireless communication devices; and/or computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges and cassettes in International Class 9 and/or production, distribution and publishing of music; fan clubs; audio and sound recording and production; record production; videotape production; production of motion picture films; distribution of motion picture films; educational and entertainment services, namely, production and presentation of television shows, sports events, fashion shows, game shows, music shows, award shows and comedy shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; and/or entertainment services, namely, providing prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network, in International Class 41.

2. The Island Marks are the subject of U.S. Trademark Registration No. 1,734,502 for ISLAND and Design for musical sound recordings and musical video recordings in Class 9; Reg. No. 1,420,517 for ISLAND PICTURES and Design for motion picture production

and distribution, home video production and distribution, and syndication of films for commercial television in Class 41; Reg. No. 1,420,518 for ISLAND PICTURES for motion picture production and distribution, home video production and distribution, and syndication of films for commercial television.

3. Opposer also has common law rights in the Island Marks based on its extensive use and promotion of such marks since at least as early as September 1, 1989, including but not limited to the trademark ISLAND RECORDS (the “Records Mark”).

4. By virtue of Opposer's extensive and continuous use of the Island Marks, considerable efforts and the expenditure of large sums for promotional activities, and by virtue of the quality of the goods and services offered under the Island Marks, the Island Marks have developed extensive goodwill and consumer recognition and/or have become famous and well-known, in the United States and in foreign countries.

5. There is no question regarding the priority of Opposer’s rights. Opposer commenced use of the Island Marks, in interstate and foreign commerce, prior to March 8, 2007, the filing date of Application, which would be Applicant's constructive date of first use (assuming that Applicant ever commences use in commerce) of the proposed ISLAND WAVE RECORDS mark (“Applicant’s Proposed Mark”), and such use by Opposer has been and is continuous.

6. As the Island Marks demonstrate, Opposer has a family of marks containing the word ISLAND, and given the number of Island Marks, it is likely that consumer will believe that Applicant’s Proposed Mark is part of Opposer’s family of ISLAND marks.

7. Applicant's Proposed Mark is confusingly similar to the Island Marks. In particular, Applicant's Proposed Mark and Opposer's Records Mark are nearly identical, and Applicant's proposed goods are highly related (and, in certain circumstances, identical) to Opposer's Goods and Services and are likely to be sold, marketed and/or offered to the same class of people (i.e., people interested in music) and through the same or similar channels of trade (e.g., the Internet, record stores, trade journals, etc.).

8. Applicant's Proposed Mark is deceptively similar to the Island Marks so as to cause confusion and deceive the public as to origin of Applicant's proposed goods to be offered under Applicant's Proposed Mark. Consumers and persons in the trade will assume, contrary to fact, that Applicant's proposed goods are associated with, endorsed by, or in some other way related to, Opposer and/or Opposer's goods and services.

9. Opposer alleges and believes, for the reasons set forth above, that if Applicant is permitted to use and/or register Applicant's Proposed Mark in connection with his proposed goods, as specified in the Application, confusion in the trade would occur, resulting in damage and injury to Opposer.

10. If Applicant is granted registration of the application herein opposed, he would thereby obtain at least a prima facie exclusive right to the use of Applicant's Proposed Mark. Such registration would be a source of damage and injury to Opposer.

11. Opposer alleges and believes that, if Applicant is granted the registration herein opposed, it would weaken the strength and reputation of the Island Marks, resulting in damage and injury to Opposer.

12. By reason of the foregoing, Applicant is not entitled to registration of Applicant's Proposed Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained in favor of Opposer and that registration of Applicant's Proposed Mark be rejected and denied.

Dated: January 14, 2008

Respectfully submitted,

UNIVERSAL INTERNATIONAL MUSIC B.V.

By: 

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c/o Universal Music Group  
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