

ESTTA Tracking number: **ESTTA351126**

Filing date: **06/04/2010**

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	Musidor B.V.
Granted to Date of previous extension	06/06/2010
Address	Herengracht 566 Amsterdam, 1017 CH NETHERLANDS

Domestic Representative	Susan L. Heller Greenberg Traurig, LLP 2450 Colorado Ave., Suite 400E Santa Monica, CA 90094 UNITED STATES latm2@gtlaw.com Phone:3105867700
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Applicant Information

Application No	77660503	Publication date	12/08/2009
Opposition Filing Date	06/04/2010	Opposition Period Ends	06/06/2010
Applicant	Rolling Stone Licensing LLC 1290 Avenue of the Americas New York, NY 10104 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Hotels; hotel bar and restaurant services; providing convention facilities; providing conference facilities; cocktail lounges; snack bars; arena services, namely, providing facilities for sports, the performing arts, conventions and exhibitions

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1358893	Application Date	01/18/1977
Registration Date	09/10/1985	Foreign Priority Date	NONE
Word Mark	ROLLING STONES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1971/04/12 First Use In Commerce: 1971/04/12 Phonograph Records and Pre-Recorded Magnetic Tapes, Cartridges and Cassettes Class 041. First use: First Use: 1971/04/12 First Use In Commerce: 1971/04/12 Entertainment Services Rendered by a Musical Group

Attachments	Notice of Opposition - ROLLING STONE HOTEL.pdf (7 pages)(124455 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	/gl/
Name	Grace Linker
Date	06/04/2010

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

In the matter of Application Serial No. 77/660,503
Mark: ROLLING STONE HOTEL
Published in the *Official Gazette* on December 8, 2009

Musidor B.V.,)	Opposition No. _____
)	
Opposer,)	
)	
vs.)	
)	
Rolling Stone Licensing LLC,)	
)	
Applicant)	
)	
)	
_____)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer Musidor B.V. (“Musidor”) is a corporation organized and existing under the laws of the Netherlands with its principal place of business at Herengracht 566, 1017 CH Amsterdam, Netherlands.

Musidor believes that it will be damaged if the above-referenced application is registered, and hereby opposes the registration.

Upon information and belief, Applicant Rolling Stone Licensing LLC (“Applicant”) is a Delaware limited liability company with a place of business at 1290 Avenue of the Americas, New York, New York 10104.

The grounds for opposition are as follows:

1. Musidor is the owner of all rights in the marks and registrations for the world-renowned musical group, The Rolling Stones. These rights include rights in the famous mark ROLLING STONES.

2. Musidor also owns common law rights and/or federal registrations and applications for the mark ROLLING STONES in connection with musical entertainment services, as well as a wide variety of related and collateral goods and services. Musidor has continuously used the ROLLING STONES mark in connection with musical entertainment services since at least as early as 1971, and Musidor continues to use the ROLLING STONES mark in connection with such entertainment services.

3. In addition, Musidor owns U.S. Registration No. 1358893 for the ROLLING STONES mark in connection with “phonograph records and pre-recorded magnetic tapes, cartridges and cassettes” in International Class 9 and “entertainment services rendered by a musical group” in International Class 41. This application was filed on January 18, 1977 and registered on September 10, 1985, and is in full force and effect and incontestable within the meaning of § 15 of the Lanham Act.

4. Musidor owns and controls the commercial rights of the world-renowned musical group, The Rolling Stones. The Rolling Stones musical group has offered musical entertainment under the name ROLLING STONES in the United States for over 40 years. Since that time, The Rolling Stones has become one of the most well-known and respected musical groups in the U.S. and abroad. In the U.S. alone, the Rolling Stones has released over twenty studio albums, eight of which charted at number one, as well as numerous compilations and concert albums. The Rolling Stones has also performed hundreds of live musical concerts for over four decades

throughout the United States and internationally, and has also sold more than 200 million albums worldwide. In 1989, The Rolling Stones was inducted into the Rock and Roll Hall of Fame, thereby establishing the group as one of the best-known, most influential, and iconic artists in the music industry.

Musidor also offers a wide variety of collateral goods sold under the name ROLLING STONES, including posters, calendars and other printed goods, pins and buttons, clothing, beverage ware, ornamental novelty items, and keychains, among others. The revenue generated from the musical entertainment and collateral merchandising offered under the ROLLING STONES mark exceeds hundreds of millions of dollars.

As a result of the extensive use of the ROLLING STONES mark, the ROLLING STONES mark is closely associated with The Rolling Stones and, by extension, with Musidor. As such, the purchasing public has come to know, rely upon, and recognize the goods and services of Musidor by this mark. Through many years of use and the expenditure of significant sums and effort, the distinctive ROLLING STONES mark has achieved fame and worldwide recognition and represents enormous value and goodwill.

5. Musidor also owns many registrations throughout the world for the mark ROLLING STONES.

6. Musidor has provided goods and services under the mark ROLLING STONES throughout the United States through numerous channels of trade. In addition, Musidor has devoted substantial advertising dollars to promote its goods and services under the ROLLING STONES mark and foster wide recognition of the mark by consumers. As a result of these efforts, as well as the inherent and acquired distinctiveness of the ROLLING STONES mark, the

ROLLING STONES mark has become well-known and famous, and is therefore entitled to a broad scope of protection.

7. The public associates the mark ROLLING STONES with Musidor's goods and services. The ROLLING STONES mark therefore functions as an indicator of source for Musidor's goods and services, and as such, it is the exclusive property right of Musidor.

8. Trademark Application Serial No. 77/660,503, sought to be opposed, is for the mark ROLLING STONE HOTEL ("Applicant's Mark") for use in connection with "Hotels; hotel bar and restaurant services; providing convention facilities; providing conference facilities; cocktail lounges; snack bars; arena services, namely, providing facilities for sports, the performing arts, conventions and exhibitions" in International Class 43. This application was filed on January 30, 2009 on an Intent-to-Use basis, and currently remains on an Intent-to-Use basis.

9. The instant application was published for opposition on December 8, 2009, and Musidor was subsequently granted two extensions of time to file an opposition at the Trademark Trial and Appeal Board, which expires June 6, 2010. Accordingly, Applicant has timely filed this Notice of Opposition.

10. The instant application was filed without Musidor's authorization, consent, or prior knowledge.

11. Musidor's first use in commerce of the mark ROLLING STONES in connection with musical entertainment services (at least as early as 1971) predates Applicant's filing date of the mark ROLLING STONE HOTEL for "Hotels; hotel bar and restaurant services; providing convention facilities; providing conference facilities; cocktail lounges; snack bars; arena services,

namely, providing facilities for sports, the performing arts, conventions and exhibitions” (January 2009).

12. Applicant’s Mark is nearly identical to Musidor’s ROLLING STONES mark. Applicant’s Mark wholly incorporates Musidor’s ROLLING STONES mark with the exception of the letter “s,” and merely adds the descriptive and disclaimed term “HOTEL.”

13. Applicant’s Mark will be used in connection with services that are closely related to and commonly associated with Opposer’s musical entertainment services under the ROLLING STONES brand. In particular, Applicant’s Mark is intended to be used in connection with common venues in which musical groups often perform, including but not limited to facilities for performing arts, hotels, hotel bars and restaurants, and cocktail lounges--all of which commonly feature musical entertainment and musical performances. As such, the marks are likely to target the same audience through overlapping channels of trade.

14. Because the marks are nearly identical and both are used in connection with related services, it is likely that consumers will mistakenly believe that Applicant’s Mark is connected to or associated with Musidor and/or The Rolling Stones, or that Musidor and/or The Rolling Stones has, to some degree, sponsored or endorsed Applicant’s services. Accordingly, the registration and concurrent use of Applicant’s Mark is likely to cause, confusion, mistake and/or deception among the consuming public regarding the source, affiliation and/or sponsorship between Musidor and its services, and Applicant and its services.

15. In addition, because of the fame acquired by the ROLLING STONES mark, registration of Applicant’s Mark will dilute the value and distinctive quality of the ROLLING STONES mark.

16. The registration of Applicant's mark for the services identified would be inconsistent with Musidor's rights in its ROLLING STONES mark, and will cause damage to Musidor and Musidor's rights in its ROLLING STONES mark.

17. By virtue of the foregoing, Applicant's application should be rejected, and registration of Applicant's Mark should be denied and refused.

Submitted herewith is the amount of \$300.00 representing the required filing fee paid by deposit account. Authorization is hereby provided to charge any deficiency to Deposit Account 50-2638.

Respectfully submitted,

GREENBERG TRAURIG, LLP



Dated: June 4, 2010

By: _____

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Attorneys for Musidor B.V.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 4 , 2010, addressed as follows:

Colleen M. Keegan, Esq.
Davis Wright Tremaine LLP
1633 Broadway, 27 Floor
New York, New York 10019-6708



Grace Linker
Sr. Trademark Paralegal