

ESTTA Tracking number: **ESTTA378759**

Filing date: **11/16/2010**

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	Rush Productions		
Entity	Partnership	Citizenship	Canada
Composed Of:	Lerxst Music Inc., Dirk Music Inc., and Pratt Music Inc., all corporations of Canada		
Address	189 Carlton Street c/o Anthem Entertainment Group Inc. Toronto, Ontario, M5A 2K7 CANADA		

Attorney information	Mark J. Liss Leydig, Voit & Mayer, Ltd. 180 N. Stetson Ave., Two Prudential Plaza, Suite 4900 Chicago, IL 60601 UNITED STATES trademark@leydig.com, mliss@leydig.com, abaylin@leydig.com Phone:312-616-5639
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Applicant Information

Application No	77842990	Publication date	10/19/2010
Opposition Filing Date	11/16/2010	Opposition Period Ends	11/18/2010
Applicant	ALDO MAURICIO MONTOYA CHÃ#VEZ Manuel Barragan 1600, Col Las Misiones Nicolas de los Gza, NL, 66428 MEXICO		

Goods/Services Affected by Opposition

Class 041. First Use: 2009/10/00 First Use In Commerce: 2009/10/00 All goods and services in the class are opposed, namely: Sound and musical video recording services; organizing and conducting events featuring live music performances

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Priority and likelihood of confusion with a trade name and trademark/service mark under common law

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2548645	Application Date	09/25/1995
Registration Date	03/19/2002	Foreign Priority	NONE

		Date	
Word Mark	RUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1970/09/30 First Use In Commerce: 1974/06/28 entertainment in the nature of a musical and vocal group		

U.S. Registration No.	2543644	Application Date	09/25/1995
Registration Date	03/05/2002	Foreign Priority Date	NONE
Word Mark	RUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1973/11/30 First Use In Commerce: 1974/06/28 series of pre-recorded phonograph records, audio and video cassettes, audio tapes and compact discs featuring music and vocals		

U.S. Registration No.	2020507	Application Date	09/25/1995
Registration Date	12/03/1996	Foreign Priority Date	NONE
Word Mark	RUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1976/02/28 First Use In Commerce: 1976/03/31 clothing, namely, T-shirts, hats, sweatshirts and jackets		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	RUSH PRODUCTIONS		
Goods/Services	Advertisement and promotion of a live musical and vocal group, phonographic records, audio and video cassettes, audio tapes and compact discs featuring music and vocals, and clothing		

Attachments	RUSH scanned Notice of Opp.pdf (7 pages)(230962 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 Overnight Courier on this date.

Signature	/Mark J. Liss/
Name	Mark J. Liss

Date	11/16/2010
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RUSH PRODUCTIONS,)	
)	
Opposer,)	
)	
v.)	Application Serial No. 77/842,990
)	Filing Date: October 6, 2009
)	
)	Opposition No. _____
ALDO MAURICIO MONTOYA)	
CHAVEZ,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

In the matter of Application Serial No. 77/842,990 for registration of the mark “BEAT RUSH PRODUCTIONS & Design” in International Class 41 by Aldo Mauricio Montoya Chavez (hereinafter referred to as “Applicant”), which was published in the *Official Gazette* on October 19, 2010, at page TM 1193, Rush Productions, a partnership organized under the laws of Canada, located and doing business at 189 Carlton Street, Toronto, Ontario M5A 2K7 Canada, (hereinafter referred to as “Opposer”), believes it will be damaged by registration of this mark for the services listed in the application and therefore opposes the same.

As grounds for the opposition, Opposer alleges as follows:

1. Applicant seeks to register the mark “BEAT RUSH PRODUCTIONS & Design” for “Sound and musical video recording services; organizing and conducting events featuring live

music performances” in International Class 41, as evidenced by the publication of the mark in the *Official Gazette* October 19, 2010 issue. Applicant claims first use in October, 2009

2. Opposer has adopted and continuously used the mark “RUSH” since at least as early as June, 1974 (more than 35 years prior to Applicant’s claimed first use) in connection with entertainment in the nature of a live musical and vocal group, phonographic records, audio and video cassettes, audio tapes and compact discs featuring music and vocals, and clothing, as further detailed herein in Paragraph 5.

3. Opposer has very extensively promoted, advertised, and used the “RUSH” mark in a variety of media throughout the United States for over 36 years, and has continuously used such mark to distinguish its services and goods from those offered by others. Opposer has spent considerable time and money in advertising and promoting its services and goods offered in connection with the “RUSH” mark.

4. As a result of Opposer’s substantial advertising and promotional efforts spanning a period of over 36 years, including the performance of live musical and vocal acts across the U.S. and around the world, and its substantial record sales in the U.S. and around the world, Opposer’s “RUSH” mark is favorably recognized and relied upon by the relevant trade and consuming public as indicating services and goods originating exclusively from Opposer. Thus, due to Opposer’s efforts, its “RUSH” mark has earned very valuable goodwill and is famous among the relevant trade and consuming public.

5. To protect the goodwill long ago established in the mark “RUSH,” Opposer has obtained the following registrations in the U.S. for the mark :

- U.S. Registration No. 2,548,645 with a registration date of March 19, 2002 and a filing dated of September 25, 1995 for “RUSH” for “entertainment in the nature of a musical and vocal group” in International Class 41. This registration is based

on Opposer's use of the mark in commerce since at least as early as June 28, 1974.

- U.S. Registration No. 2,543,644 with a registration date of March 5, 2002 and a filing date of September 25, 1995 for "RUSH" for "series of pre-recorded phonograph records, audio and video cassettes, audio tapes and compact discs featuring music and vocals" in International Class 9. This registration is based on Opposer's use of the mark in commerce since at least as early as June 28, 1974.
- U.S. Registration No. 2,020,507 with a registration date of December 3, 1996 and a filing date of September 25, 1995 for "RUSH" for "clothing, namely, T-shirts, hats, sweatshirts and jackets" in International Class 25. This registration is based on Opposer's use of the mark in commerce since at least as early as March 31, 1976.

6. Opposer has also adopted and continuously used the mark and trade name "RUSH PRODUCTIONS" for many years in connection with the advertisement and promotion of its live musical and vocal group, phonographic records, audio and video cassettes, audio tapes and compact discs featuring music and vocals, and clothing.

7. On October 6, 2009, many years subsequent to Opposer's use of its "RUSH" and "RUSH PRODUCTIONS" marks, and registration of Opposer's "RUSH" mark, Applicant filed its U.S. Application No. 77/842,990 for "BEAT RUSH PRODUCTIONS & Design" under Section 1(a).

8. Opposer, through its use of its "RUSH" and "RUSH PRODUCTIONS" marks in connection with its services and goods, and through its federal applications for "RUSH" that have matured to registration, enjoys actual and constructive use that far predates Applicant's filing date of October 6, 2009.

9. Applicant's and Opposer's marks are highly similar in appearance and sound. Indeed, Applicant's "BEAT RUSH PRODUCTIONS & Design" mark fully incorporates Opposer's identical famous "RUSH" mark and its "RUSH PRODUCTIONS" trade name and mark. As is

shown in Application Serial No. 77/842,990, “RUSH” makes up the dominant portion of Applicant’s “BEAT RUSH PRODUCTION & Design” mark - the “RUSH” portion of Applicant’s mark is presented in the center of the mark in much larger, bolder and more eye-catching lettering than the words “Beat” and “Productions”. Applicant has also disclaimed the “Productions” portion of the mark. Applicant’s and Opposer’s marks also create very similar overall commercial impressions. Further, Applicant’s services overlap with, are closely related to and/or are complementary to or competitive with Opposer’s services and goods. Due to the similarities of the marks, similar commercial impressions created by the marks, and the overlapping, related and/or complementary or competitive nature of the services and goods, which are likely to be offered by both parties to the same types of consumers in the same channels of trade, Applicant’s registration of its “BEAT RUSH PRODUCTIONS & Design” mark is likely to cause confusion among consumers and the trade.

10. If Applicant is permitted to register the mark “BEAT RUSH PRODUCTIONS & Design” as specified in the application herein opposed, likelihood of confusion resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between Applicant’s mark and Opposer’s mark. If Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of the mark. Such registration would be a source of damage and injury to Opposer.

11. In view of the above, Applicant is not entitled to federal registration of its alleged mark “BEAT RUSH PRODUCTIONS & Design” as (1) Opposer has priority of use of the marks “RUSH” and “RUSH PRODUCTIONS” in commerce in connection with overlapping, related and/or complementary or competitive services and goods, and Applicant’s mark is confusingly similar thereto; and as (2) Opposer has obtained prior federal registrations for “RUSH” for

overlapping, related and/or complementary or competitive services and goods, and Applicant's mark is confusingly similar thereto.

12. By reason of all the foregoing, Opposer will be gravely damaged by Applicant's registration of the "BEAT RUSH PRODUCTIONS & Design" mark.

WHEREFORE, by its undersigned attorneys, Opposer respectfully requests that this Notice of Opposition be sustained and that registration of the mark "BEAT RUSH PRODUCTIONS & Design," as depicted in Serial No. 77/842,990, be refused.

Please charge the filing fee of \$300, and any deficiencies, to USPTO deposit account No. 12-1216.

Respectfully submitted,

Date: November 16, 2010



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CERTIFICATE OF ELECTRONIC FILING

The undersigned attorney hereby certifies that this **NOTICE OF OPPOSITION** is being electronically filed with the United States Patent and Trademark Office Trademark Trial and Appeal Board on November 16, 2010.



CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that this **NOTICE OF OPPOSITION** is being served on Applicant this 16th day of November, 2010 via courier to Applicant at:

Aldo Mauricio Montoya Chavez
Manuel Barragan 1600, Col Las Misiones
Nicolas de los Gza, NL 66428
MEXICO

and via courier to Applicant's Domestic Representative at:

Elsa Torres
1209 San Dario Ave., PMB A-215
Laredo, Texas 78040-4515


