

ESTTA Tracking number: **ESTTA388085**  
 Filing date: **01/12/2011**

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

<b>Name</b>	Universal International Music B.V.
<b>Granted to Date of previous extension</b>	01/12/2011
<b>Address</b>	Gerrit van der Veenlaan 4 Baarn, 3743 DN NETHERLANDS

<b>Attorney information</b>	David Donahue Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES ddonahue@fzlj.com Phone:212-813-5900
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#### Applicant Information

<b>Application No</b>	77964366	<b>Publication date</b>	09/14/2010
<b>Opposition Filing Date</b>	01/12/2011	<b>Opposition Period Ends</b>	01/12/2011
<b>Applicant</b>	Luxuresse, Inc. 301 Clematis St. Ste 3000 West Palm Beach, FL 33401 UNITED STATES		

#### Goods/Services Affected by Opposition

Class 025. First Use: 2009/01/01 First Use In Commerce: 2009/02/01
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All goods and services in the class are opposed, namely: Button-front aloha shirts; Camp shirts; Caps; Coverups; Dresses; Gloves; Golf pants, shirts and skirts; Headwear; Hooded sweat shirts; Polo shirts; Rompers; Sandals; Sarongs; Shirts; Shorts; Sun sleeves; Sweaters; Swimwear

**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**

<b>U.S. Registration No.</b>	3374929	<b>Application Date</b>	11/07/2006
<b>Registration Date</b>	01/29/2008	<b>Foreign Priority Date</b>	NONE
<b>Word Mark</b>	ISLAND		
<b>Design Mark</b>	.		
<b>Description of Mark</b>	NONE		
<b>Goods/Services</b>	<p>Class 009. First use: First Use: 1989/09/01 First Use In Commerce: 1989/09/01 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 music-related entertainment; theatrical and musical sound and video recordings; downloadable ring tones, music, mp3s, graphics, electronic games, and image files and video recordings featuring music and music-related subject matter via wireless communication devices; computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units</p> <p>Class 041. First use: First Use: 1989/09/01 First Use In Commerce: 1989/09/01 Production 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; entertainment services, namely, production 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; 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</p>		

<b>U.S. Registration No.</b>	1734502	<b>Application Date</b>	09/04/1991
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<b>Registration Date</b>	11/24/1992	<b>Foreign Priority Date</b>	NONE
<b>Word Mark</b>	ISLAND		
<b>Design Mark</b>			
<b>Description of Mark</b>	NONE		
<b>Goods/Services</b>	Class 009. First use: First Use: 1989/09/00 First Use In Commerce: 1989/09/00 musical sound recordings and musical video recordings		

<b>U.S. Application/Registration No.</b>	NONE	<b>Application Date</b>	NONE
<b>Registration Date</b>	NONE		
<b>Word Mark</b>	ISLAND		
<b>Goods/Services</b>	a wide variety of goods and services, including, without limitation, clothing, merchandise, and music-related goods and services		

<b>Attachments</b>	74200707#TMSN.gif ( 1 page )( bytes ) UNSUN ISLAND Opposition.pdf ( 11 pages )(94345 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 USPS Express Mail Post Office to Addressee on this date.

<b>Signature</b>	/ddonahue/
<b>Name</b>	David Donahue
<b>Date</b>	01/12/2011

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

In the matter of Application Serial No. 77/964,366  
Mark: UNSUN ISLAND (and design)

UNIVERSAL INTERNATIONAL MUSIC  
B.V.,

Opposer,

- against -

LUXURESSE, INC. D/B/A UNSUN ISLAND,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, Universal International Music B.V., a Netherlands stock company with a business address at Gerrit van der Veenlaan 4, Baarn, 3743 DN, Netherlands, believes that it would be damaged by the issuance of a registration for the mark UNSUN ISLAND (and design) (“Applicant’s Mark”) applied for by Applicant, Luxuresse, Inc. d/b/a UnSun Island (“Applicant”) in Application Serial No. 77/964,366 (the “Application”) for all International Class 25 goods identified therein and therefore opposes the same. As grounds for this notice of opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., states as follows:

1. For many years, Opposer and its predecessors-in-interest and licensees (collectively, “Opposer”) have continuously used, and Opposer is currently using, the ISLAND trademark (“Opposer’s ISLAND Mark”) and the logo depicted below in connection with a wide variety of goods and services, including, without limitation, clothing, merchandise, and music-related goods and services:



(“Opposer’s ISLAND Logo” and, together with Opposer’s ISLAND Mark, “Opposer’s Marks”).

2. As a result of such extensive use of Opposer's Marks and substantial promotion of goods and services offered under the mark, Opposer's Marks have become and is exclusively identified with Opposer and Opposer's goods and services. As such, Opposer's Marks represents significant goodwill of Opposer.

3. Opposer owns the following federal registrations for Opposer's Marks for use in connection with various music-related goods and services: Registration No. 3,374,929 for ISLAND in connection with identified goods in International Classes 9 and 41; and Registration No. 1,734,502 for ISLAND (and design) in connection with identified goods in International Class 9. True and correct copies of printouts from the U.S. Patent and Trademark Office online Trademark Applications and Registrations Retrieval ("TARR") database showing the foregoing registrations are attached hereto as Exhibit 1.

4. The foregoing registrations of Opposer are valid, subsisting, and in full force and effect. These registrations constitute evidence of the validity of the registered marks and of the registrations thereof, of Opposer's ownership of the marks, and of Opposer's exclusive right to use the marks in commerce in connection with the identified goods and services pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b). Such registrations place others on constructive notice of Opposer's claim of ownership thereof pursuant to Section 22 of the Lanham Act, 15 U.S.C. § 1072.

5. Opposer's Registration No. 1,734,502 is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus serves as *conclusive* evidence of Opposer's exclusive right to use the identified mark in connection with the goods identified in the registration pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

6. On March 22, 2010—long after Opposer obtained exclusive rights in Opposer’s Marks—Applicant filed the Application pursuant to Section 1(a) of the Lanham Act, seeking to register Applicant’s Mark in connection with “Button-front aloha shirts; Camp shirts; Caps; Coverups; Dresses; Gloves; Golf pants, shirts and skirts; Headwear; Hooded sweat shirts; Polo shirts; Rompers; Sandals; Sarongs; Shirts; Shorts; Sun sleeves; Sweaters; [and] Swimwear” in International Class 25 (“Applicant’s Goods”) based upon its alleged first use in commerce of Applicant’s Mark as of February 1, 2009.

7. Opposer acquired rights in Opposer’s Marks long before Applicant filed the Application, long before any commercial use by Applicant of Applicant’s Mark, and long before any priority date upon which Applicant may rely.

8. Applicant’s Mark incorporates Opposer’s ISLAND Mark and is highly similar to each of Opposer’s Marks in sight, sound and commercial meaning.

9. Applicant’s Goods are closely related to the goods and services offered by Opposer under Opposer’s Marks.

10. Applicant’s use and/or registration of the Applicant’s Mark for Applicant’s Goods is likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

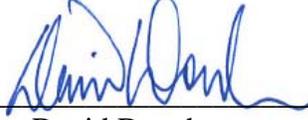
11. Registration to Applicant of Applicant’s Mark would be inconsistent with Opposer’s prior exclusive rights in Opposer’s Marks and would threaten to destroy Opposer’s investment and goodwill in such marks. Opposer therefore will be injured by registration of Applicant’s Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial Nos. 77/964,366 be denied registration.

Dated: New York, New York  
January 12, 2011

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:  \_\_\_\_\_  
David Donahue

866 United Nations Plaza  
New York, New York 10017  
Telephone: (212) 813-5900  
Email: ddonahue@frosszelnick.com

*Attorneys for Opposer Universal International  
Music B.V.*

# EXHIBIT 1

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-01-10 19:01:36 ET

Serial Number: [74200707 Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: 1734502

Mark



(words only): ISLAND

Standard Character claim: No

Current Status: [This registration has been renewed.](#)

Date of Status: 2003-03-12

Filing Date: 1991-09-04

Transformed into a National Application: No

Registration Date: 1992-11-24

Register: Principal

Law Office Assigned: LAW OFFICE 4

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 40S -Scanning On Demand

Date In Location: 2008-04-16

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#### LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. UNIVERSAL INTERNATIONAL MUSIC B.V.

**Address:**

UNIVERSAL INTERNATIONAL MUSIC B.V.

GERRIT VAN DER VEENLAAN 4

3743 DN BAARN

Netherlands

**Legal Entity Type:** Company

**State or Country Where Organized:** Netherlands

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#### GOODS AND/OR SERVICES

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**International Class:** 009

**Class Status:** Active

musical sound recordings and musical video recordings

**Basis:** 1(a)

**First Use Date:** 1989-09-00

**First Use in Commerce Date:** 1989-09-00

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#### ADDITIONAL INFORMATION

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**Design Search Code(s):**

**01.05.01** - Sun, rising or setting (partially exposed or partially obstructed); Sunrise

**05.01.03** - Palm trees

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-04-16 - Case File In TICRS

2006-05-24 - Attorney Revoked And/Or Appointed  
2006-05-24 - TEAS Revoke/Appoint Attorney Received  
2003-03-12 - First renewal 10 year  
2003-03-12 - Section 8 (10-year) accepted/ Section 9 granted  
2002-11-29 - Combined Section 8 (10-year)/Section 9 filed  
2002-11-29 - PAPER RECEIVED  
1999-04-12 - Section 8 (6-year) accepted & Section 15 acknowledged  
1998-11-23 - Section 8 (6-year) and Section 15 Filed  
1992-11-24 - Registered - Principal Register  
1992-09-01 - Published for opposition  
1992-07-31 - Notice of publication  
1992-06-11 - Approved for Pub - Principal Register (Initial exam)  
1992-05-14 - Communication received from applicant  
1992-01-23 - Non-final action mailed  
1991-12-17 - Assigned To Examiner  
1991-12-12 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

DeAnne Ozaki, Esq.

**Correspondent**

DeAnne Ozaki, Esq.  
Universal Music Group  
Third Floor, Suite 350  
10 Universal City Plaza  
Universal City CA 91608  
Phone Number: 818 286-5209  
Fax Number: 818 286-5480

**Domestic Representative**

DeAnne Ozaki, Esq.  
Phone Number: 818 286-5209  
Fax Number: 818 286-5480

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## United States Patent and Trademark Office

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## Trademark Assignment Abstract of Title

## Total Assignments: 1

Serial #: [74200707](#)

Filing Dt: 09/04/1991

Reg #: [1734502](#)

Reg. Dt: 11/24/1992

Registrant: Polygram International Music B.V.

Mark: ISLAND

## Assignment: 1

Reel/Frame: [2109/0733](#)

Received: 07/27/2000

Recorded: 06/28/2000

Pages: 5

Conveyance: CHANGE OF NAME

Assignor: [POLYGRAM INTERNATIONAL MUSIC B.V.](#)

Exec Dt: 04/29/1999

Entity Type: NETHERLANDS COMPANY

Citizenship: NONE

Entity Type: NETHERLANDS COMPANY

Citizenship: NONE

Assignee: [UNIVERSAL INTERNATIONAL MUSIC B.V.](#)

GERRIT VAN DER VEENLAAN 4

3743 DN BAARN, NETHERLANDS

Correspondent: ANNE B. NIELSEN

100 UNIVERSAL CITY PLAZA

UNIVERSAL CITY, CA 91608

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v2.1  
Web interface last modified: Apr 30, 2009 v2.1

Search Results as of: 01/10/2011 07:02 PM

[.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-01-10 19:00:13 ET

Serial Number: 77038947 [Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: 3374929

Mark

# ISLAND

(words only): ISLAND

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2008-01-29

Filing Date: 2006-11-07

Transformed into a National Application: No

Registration Date: 2008-01-29

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-01-29

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#### LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Universal International Music B.V.

**Address:**

Universal International Music B.V.

Gerrit van der Veenlaan 4

DN Baarn 3743

Netherlands

**Legal Entity Type:** Joint Stock Company

**State or Country Where Organized:** Netherlands

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#### GOODS AND/OR SERVICES

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**International Class:** 009

**Class Status:** Active

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 music-related entertainment; theatrical and musical sound and video recordings; downloadable ring tones, music, mp3s, graphics, electronic games, and image files and video recordings featuring music and music-related subject matter via wireless communication devices; computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units

**Basis:** 1(a)

**First Use Date:** 1989-09-01

**First Use in Commerce Date:** 1989-09-01

**International Class:** 041

**Class Status:** Active

Production 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; entertainment services, namely, production 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; 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

**Basis:** 1(a)

**First Use Date:** 1989-09-01

**First Use in Commerce Date:** 1989-09-01

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#### ADDITIONAL INFORMATION

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**Prior Registration Number(s):**

1420517

1420518  
1734502

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2008-01-29 - Registered - Principal Register  
2007-11-13 - Published for opposition  
2007-10-24 - Notice of publication  
2007-10-07 - Law Office Publication Review Completed  
2007-10-07 - Assigned To LIE  
2007-09-08 - Approved for Pub - Principal Register (Initial exam)  
2007-09-07 - Teas/Email Correspondence Entered  
2007-09-07 - Communication received from applicant  
2007-09-07 - TEAS Response to Office Action Received  
2007-03-14 - Non-final action e-mailed  
2007-03-14 - Non-Final Action Written  
2007-03-05 - Assigned To Examiner  
2006-11-13 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

DeAnne Ozaki

**Correspondent**

DEANNE OZAKI  
UNIVERSAL MUSIC GROUP  
10 UNIVERSAL CITY PLZ  
UNIVERSAL CITY, CA 91608-1009  
Phone Number: 818 286-5209

**Domestic Representative**

DeAnne Ozaki  
Phone Number: 818 286-5209

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## CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of January 2011, I caused a true and correct copy of the foregoing **NOTICE OF OPPOSITION** to be sent by U.S. Express Mail, postage pre-paid, in an envelope addressed to Applicant's correspondent of record as follows:

LUXURESSE, INC.  
301 CLEMATIS ST STE 3000  
WEST PALM BEACH, FL 33401-4609



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David Donahue