

ESTTA Tracking number: **ESTTA419036**

Filing date: **07/11/2011**

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

Name	UMG Recordings, Inc.
Granted to Date of previous extension	07/10/2011
Address	2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES

Attorney information	Brent S. LaBarge c/o Universal Music Group 2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES brent.labarge@umusic.com, deanne.ozaki@umusic.com, nicole.villacorta@umusic.com
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Applicant Information

Application No	77880243	Publication date	01/11/2011
Opposition Filing Date	07/11/2011	Opposition Period Ends	07/10/2011
Applicant	SIGGY MUSIC, INC. 284-C East Lake Mead Parkway Suite 175 Henderson, NV 89015 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Colognes, perfumes and cosmetics
Class 014. All goods and services in the class are opposed, namely: Jewelry
Class 016. All goods and services in the class are opposed, namely: Books in the field of entertainment and musical performances; Calendars; Comic books; Gift cards; Musical greeting cards; Posters; Printed music books; Story books; Talking children's books
Class 018. All goods and services in the class are opposed, namely: Canvas shopping bags; Carrying cases; Gentlemen's handbags; Handbags; Handbags, purses and wallets; Keycases; Leather bags and wallets; Luggage; Purses
Class 021. All goods and services in the class are opposed, namely: Cups and mugs
Class 028.

All goods and services in the class are opposed, namely: Card games; Musical toys; Parlor games; Party games; Plush toys; Positionable toy figures; Toy action figures and accessories therefor; Toy cars; Toy furniture; Toy houses; Toy model guitars; Toy pianos; Toy record players; Toy watches

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Applicant is contractually barred from using the mark that it is attempting to register.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2881064	Application Date	08/13/2003
Registration Date	09/07/2004	Foreign Priority Date	NONE
Word Mark	JACKSON 5		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1969/04/30 First Use In Commerce: 1969/04/30 MUSICAL SOUND RECORDINGS		

Related Proceedings	Cancellation No. 92053622
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Attachments	76536394#TMSN.gif (1 page)(bytes) 2011-07-11 Notice of Opposition Against Ser. No. 77880243.pdf (10 pages) (59903 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	/Brent S. LaBarge/
Name	Brent S. LaBarge
Date	07/11/2011

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

In the matter of Application Serial No. 77/880,243
Mark: J5

UMG RECORDINGS, INC.,

Opposer,

v.

SIGGY MUSIC, INC.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

UMG Recordings, Inc. (“Opposer”), a Delaware corporation with a business address at 2220 Colorado Avenue, Santa Monica, California 90404, believes that it would be damaged by the issuance of a registration to Siggy Music, Inc. (“Applicant”) for the mark that is the subject of Application Serial No. 77/880,243 (the “Application”) and hereby opposes registration of the same under the provisions of Section 13 of the Lanham Act, 15 U.S.C. § 1063, and Section 2.101 of the Trademark Rules of Practice, 37 C.F.R. § 2.101.

As grounds for this opposition, Opposer alleges as follows:

1. For decades, Opposer and its predecessors in interest (collectively, “Opposer”) have continuously used, and Opposer is currently using, the trademarks and service marks JACKSON 5, JACKSON FIVE, and J5 (collectively, “Opposer’s Marks”) in connection with musical sound recordings, among other related goods and services. As a result of such extensive use of Opposer’s Marks and substantial promotion of goods and services offered under the marks, Opposer’s Marks have become and currently are famous and exclusively identified with

Opposer and Opposer's goods and services. As such, Opposer's Marks represent significant goodwill of Opposer.

2. Opposer owns U.S. Registration No. 2,881,064 for the mark JACKSON 5 in connection with "musical sound recordings" in International Class 9 ("Opposer's Registration"). A true and correct printout of Opposer's Registration from the U.S. Patent and Trademark Office's ("USPTO") online Trademark Applications and Registrations Retrieval database is attached hereto as Exhibit 1.

3. Opposer's Registration is valid, subsisting, and in full force and effect. Opposer's Registration constitutes evidence of the validity of the JACKSON 5 mark and of the registration itself, of Opposer's ownership of the JACKSON 5 mark, and of Opposer's exclusive right to use the JACKSON 5 mark in commerce in connection with the identified goods pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b).

4. Opposer's Registration 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 JACKSON 5 mark in connection with the goods identified in Opposer's Registration pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

5. On or about January 1, 1980, Motown Record Corporation and Motown Record Corporation of California, Inc. (predecessors in interest to the Opposer named herein) entered into an agreement with, *inter alia*, Applicant's president, Sigmund E. Jackson (the "Agreement"). The Agreement inures to the benefit of, and is binding upon, each party thereto, its or his heirs, representatives, successors, and assigns, including Opposer and Applicant. The Agreement memorializes, among other things, the termination of Applicant's President's right to use the mark at issue herein. The Agreement also is intended to avoid any likelihood of

confusion between Opposer's use of Opposer's Marks, and Applicant's President's use of his personal and family names.

6. On November 24, 2009, Applicant filed an intent-to-use application under Section 1(b) of the Lanham Act for the J5 mark ("Applicant's Proposed Mark") for use in association with "colognes, perfumes and cosmetics" in International Class 3; "jewelry" in International Class 14; "books in the field of entertainment and musical performances; calendars; comic books; gift cards; musical greeting cards; posters; printed music books; story books; [and] talking children's books" in International Class 16; "canvas shopping bags; carrying cases; gentlemen's handbags; handbags; handbags, purses and wallets; keycases; leather bags and wallets; luggage; [and] purses" in International Class 18; "cups and mugs" in International Class 21; and "card games; musical toys; parlor games; party games; plush toys; positionable toy figures; toy action figures and accessories therefor; toy cars; toy furniture; toy houses; toy model guitars; toy pianos; toy record players; [and] toy watches" in International Class 28, which was assigned Serial No. 77/880,243.

7. The Application was published for opposition on January 11, 2011; Opposer's time to oppose the Application has since been extended to Monday, July 11, 2011.

8. Opposer acquired rights in Opposer's Marks, and these marks became famous, long before Applicant filed the Application, long before any commercial use by Applicant of Applicant's Proposed Mark, and long before any priority date upon which Applicant may rely.

9. Applicant's Proposed Mark is identical to Opposer's J5 mark.

10. During the prosecution of the Application, on March 11, 2010, Applicant submitted to the USPTO a declaration signed by its President stating, in part, that Applicant's Proposed Mark would be "use[d] in connection with the applied-for goods and services as an

indicator of secondary source or sponsorship of the JACKON 5 mark.” Written statements to similar effect were also made during the prosecution of the application that matured into Registration No. 3,059,241, which is the subject of Cancellation No. 92053622 currently pending before the Board. Applicant’s Proposed Mark and Opposer’s JACKSON 5 and JACKSON 5IVE marks are functionally identical and have identical commercial impressions.

11. The goods identified in the Application are closely related to the goods offered by Opposer under Opposer’s Marks.

12. Applicant’s use and/or registration of Applicant’s Proposed Mark for the goods identified in the Application 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).

13. Applicant’s use and/or registration of Applicant’s Proposed Mark for the goods identified in the Application is likely to dilute the distinctiveness of Opposer’s Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

14. Applicant’s use and/or attempted registration of Applicant’s Proposed Mark violates the terms of the Agreement, breaching Applicant’s President’s and Applicant’s obligations thereunder. Pursuant to Section 7 of the Agreement, Applicant’s President “forever waive[d] and relinquish[ed his] right to use the name ‘The Jackson-Five.’” By Applicant’s own admission, Applicant’s Proposed Mark is “associated with” and an “indicator of secondary source or sponsorship of”—and thus inseparable from and functionally and legally equivalent to—the famous JACKSON 5 vocal group and corresponding mark to which Opposer owns rights. Applicant’s efforts to obtain a registration for the Application are thus barred by, and in breach of, the Agreement.

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 2011-07-11 16:56:18 ET

Serial Number: 76536394 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2881064

Mark (words only): JACKSON 5

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-09-08

Filing Date: 2003-08-13

Transformed into a National Application: No

Registration Date: 2004-09-07

Register: Principal

Law Office Assigned: LAW OFFICE 114

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

Current Location: M50 -TMO Law Office 114

Date In Location: 2010-09-08

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

1. [UMG RECORDINGS, INC.](#)

Address:

[UMG RECORDINGS, INC.](#)

[2220 Colorado Avenue](#)

[Santa Monica, CA 90404](#)

[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Delaware](#)

GOODS AND/OR SERVICES

International Class: [009](#)

Class Status: [Active](#)

MUSICAL SOUND RECORDINGS**Basis:** 1(a)**First Use Date:** 1969-04-30**First Use in Commerce Date:** 1969-04-30

ADDITIONAL INFORMATION

Disclaimer: "5"**Prior Registration Number(s):**

965809

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

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

2011-06-10 - Counter claim canc.for Proceeding

2010-09-08 - Section 8 (6-year) accepted & Section 15 acknowledged

2010-09-07 - Case Assigned To Post Registration Paralegal

2010-08-18 - TEAS Section 8 & 15 Received

2004-09-07 - Registered - Principal Register

2004-06-15 - Published for opposition

2004-05-26 - Notice of publication

2004-04-02 - Approved for Pub - Principal Register (Initial exam)

2004-03-02 - Examiner's amendment mailed

2004-02-21 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

DeAnne Ozaki

Correspondent

DeAnne Ozaki

Universal Music Group
2220 Colorado Avenue
Santa Monica CA 90404
Phone Number: 310-865-1709
Fax Number: 310-865-1791

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant by mailing said copy on July 11, 2011, via First Class Mail, postage prepaid, to:

Gary S. Phillips, Esq.
Law Offices of Gary S. Phillips
315 S. Beverly Drive; Suite 415
Beverly Hills, CA 90212-4301

s/Brent S. LaBarge/

Brent S. LaBarge