ESTTA Tracking number: **ESTTA426190**
Filing date: **08/19/2011**

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

Proceeding	91200616
Party	Defendant SIGGY MUSIC, INC.
Correspondence Address	GARY S. PHILLIPS LAW OFFICES OF GARY S. PHILLIPS 315 S BEVERLY DR STE 415 BEVERLY HILLS, CA 90212-4301 gary@gsphillipslaw.com
Submission	Answer
Filer's Name	Jessica S. Rutherford
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Signature	/jsr/
Date	08/19/2011
Attachments	Answer and Affirmative Defenses.pdf (14 pages)(542848 bytes)

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

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

UMG RECORDINGS, INC.,	:	
Opposer,	:	
-against-	:	Opposition No. 91200616
SIGGY MUSIC, INC.,	:	
Applicant.	:	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES

Applicant, Siggy Music, Inc. ("Applicant"), by its attorneys, hereby responds to the Notice of Opposition ("Opposition") filed by Opposer, UMG Recordings, Inc. ("Opposer"), in correspondingly unnumbered and numbered paragraphs as follows:

Applicant admits that it is the owner of the mark that is the subject of Application Serial No. 77/880,243 (the "Application"). Applicant lacks knowledge or information sufficient to form a belief as to the remaining allegations contained in the first unnumbered paragraph of the Opposition and, on that basis, denies them.

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Opposition and, on that basis, denies them.

2. Applicant admits that Opposer purports to be the record owner of the registration referenced in Paragraph 2 of the Opposition, admits that Exhibit 1 to the Opposition appears to show the status of the referenced registration as of the date of filing of the Opposition, and

respectfully refers the Board to said registration for the contents thereof. Applicant denies the remaining allegations contained in Paragraph 2 of the Opposition.

3. Applicant denies the allegations contained in Paragraph 3 of the Opposition.

4. Applicant denies the allegations contained in Paragraph 4 of the Opposition.

5. Applicant admits that Motown Record Corporation and Motown Record Corporation of California, Inc. entered into an agreement dated January 1, 1980 and titled Settlement Agreement and Mutual Release with, *inter alia*, Sigmund E. Jackson (the "Agreement"). Applicant admits that Sigmund E. Jackson is Applicant's President. Applicant admits that 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. Applicant denies the remaining allegations contained in Paragraph 5 of the Opposition.

6. Applicant admits the allegations contained in Paragraph 6 of the Opposition.

7. Applicant admits the allegations contained in Paragraph 7 of the Opposition.

8. Applicant denies the allegations contained in Paragraph 8 of the Opposition.

9. Applicant denies the allegations contained in Paragraph 9 of the Opposition.

10. Applicant admits the allegations contained in the first two sentences in Paragraph 10 of the Opposition. Applicant denies the remaining allegations contained in Paragraph 10 of the Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Opposition.

12. Applicant denies the allegations contained in Paragraph 12 of the Opposition.

13. Applicant denies the allegations contained in Paragraph 13 of the Opposition.

14. Applicant denies the allegations contained in Paragraph 14 of the Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Opposition.

AFFIRMATIVE DEFENSES

16. Opposer fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Opposition.

17. To the extent that Opposer seeks to assert common law trademark rights in the designation JACKSON 5IVE, upon information and belief, Opposer does not own any trademark rights in this designation in connection with any goods or services.

18. To the extent that Opposer seeks to assert common law trademark rights in the designation J5, upon information and belief, Opposer does not own any trademark rights in this designation in connection with any goods or services.

19. To the extent that Opposer or its alleged predecessors in interest have ever used the designation JACKSON 5 in connection with any goods or services other than musical sound recordings, upon information and belief, Opposer has ceased to use the aforementioned designation, with no intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

20. To the extent that Opposer or its alleged predecessors in interest have ever used the designation JACKSON 5IVE in connection with any goods or services other than musical sound recordings, upon information and belief, Opposer has ceased to use the aforementioned designation, with no intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

21. To the extent that Opposer or its alleged predecessors in interest have ever used the designation J5 in connection with any goods or services other than musical sound recordings, upon information and belief, Opposer has ceased to use the aforementioned designation, with no

intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

22. Opposer abandoned whatever trademark rights it or its alleged predecessors in interest ever could have claimed to have owned in the designation JACKSON 5 in connection with any goods or services other than musical sound recordings long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

23. Opposer abandoned whatever trademark rights it or its alleged predecessors in interest ever could have claimed to have owned in the designation JACKSON 5IVE in connection with any goods or services other than musical sound recordings long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

24. Opposer abandoned whatever trademark rights it or its alleged predecessors in interest ever could have claimed to have owned in the designation J5 in connection with any goods or services other than musical sound recordings long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

25. Registration No. 965,809 for the mark JACKSON 5 for "entertainment services rendered by a vocal group" in International Class 41, registered on August 7, 1973, expired on May 8, 2004 for failure to renew.

26. Opposer has never registered or even applied for a registration of the JACKSON 5IVE designation for any goods or services.

27. Opposer has never registered or even applied for a registration of the J5 designation for any goods or services.

28. To the extent that Opposer is the heir, representative, successor or assign of Motown Record Corporation and/or Motown Record Corporation of California, Inc., Opposer is

contractually prohibited from using "The Jackson-Five" in connection with any goods or services other than musical sound recordings, pursuant to the Agreement.

29. To the extent that Opposer or its alleged predecessor in interest has ever used the designation JACKSON 5IVE in connection with musical sound recordings, upon information and belief, Opposer has ceased to use the aforementioned designation, with no intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

30. To the extent that Opposer or its alleged predecessor in interest has ever used the designation J5 in connection with musical sound recordings, upon information and belief, Opposer has ceased to use the aforementioned designation, with no intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

31. To the extent that Opposer or its alleged predecessor in interest has ever used the designation J5 in connection with musical sound recordings, upon information and belief, Opposer has failed to police the unauthorized use of the designation J5 in connection with musical sound recordings by third parties.

32. Opposer abandoned whatever trademark rights it ever could have claimed to have owned in the designation JACKSON 5IVE in connection with musical sound recordings long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

33. Opposer abandoned whatever trademark rights it ever could have claimed to have owned in the designation J5 in connection with musical sound recordings long before Applicant filed the Application and long before any priority date upon which Opposer can rely.

34. There is no likelihood of confusion between the J5 mark that is the subject of the Application ("Applicant's J5 Mark") and the JACKSON 5 mark contained in the registration referenced in Paragraph 2 of the Opposition (the "JACKSON 5 Mark").

35. Applicant's J5 Mark and the JACKSON 5 Mark are sufficiently different such that confusion is unlikely.

36. Exclusive rights in the number "5" in the JACKSON 5 Mark are disclaimed apart from the mark as shown, because it is descriptive of the 5 members of the vocal group performing on the musical sound recordings.

37. The JACKSON 5 Mark, when considered in its entirety, is not confusingly similar to Applicant's J5 Mark.

38. The JACKSON 5 Mark consists of 3 syllables containing 7 letters plus the number "5".

39. Applicant's J5 Mark consists of only 2 syllables containing 1 letter plus the number "5".

40. The JACKSON 5 mark and Applicant's J5 Mark differ in appearance and pronunciation.

41. The goods are sufficiently different such that confusion is unlikely.

42. Musical sound recordings are completely dissimilar from the various goods identified in the Application.

43. The goods are sold through different channels of trade.

44. There is little proximity between the respective goods.

45. Applicant's J5 Mark and the JACKSON 5 Mark can safely co-exist without a hint of possible consumer confusion.

46. Applicant is also the owner of U.S. Registration No. 3,059,241 for the mark J5 in connection with "clothing, namely, footwear, shoes, hats, caps, shirts, and jackets" in International Class 25 ("Applicant's Registration"). A true and correct printout of Applicant's Registration from the U.S. Patent and Trademark Office online Trademark Applications and Registration Retrieval ("TARR") database is attached hereto as Exhibit A.

47. Applicant's Registration is valid, subsisting, and in full force and effect.

48. Applicant's Registration constitutes evidence of the validity of the J5 mark and of the registration itself, of Applicant's ownership of the J5 mark, and of Applicant's exclusive right to use the J5 mark in commerce in connection with the identified goods pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b).

49. The mark contained in Applicant's Registration, namely J5 ("Applicant's Registered Mark"), is identical to Applicant's J5 Mark, namely J5.

50. As further proof that Applicant's J5 Mark is unlikely to cause confusion with the JACKSON 5 Mark, Applicant alleges that, upon information and belief, Applicant's Registered Mark and the JACKSON 5 Mark have been used concurrently for more than six and half years without any evidence of actual confusion.

WHEREFORE, Applicant prays that Opposer's Opposition be dismissed in its entirety with prejudice.

Dated: Norwalk, Connecticut
August 19, 2011

Respectfully submitted,

By: Jessica S. Rutherford

Charles W. Grimes, Esq.
Jessica S. Rutherford, Esq.
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Attorneys for the Applicant, Siggy Music, Inc.

Exhibit A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-08-19 15:24:56 ET

Serial Number: 76214316 Assignment Information Trademark Document Retrieval

Registration Number: 3059241

Mark(words only): J5

Standard Character claim: No

Current Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

Date of Status: 2011-02-15

Filing Date: 2001-02-22

Transformed into a National Application: No

Registration Date: 2006-02-14

Register: Principal

Law Office Assigned: LAW OFFICE 107

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: 650 -Publication And Issue Section

Date In Location: 2006-01-06

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

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1. SIGGY MUSIC, INC.

Address:
SIGGY MUSIC, INC.
284-C EAST LAKE MEAD PARKWAY SUITE 175
HENDERSON, NV 89015
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Nevada

GOODS AND/OR SERVICES

International Class: 025
Class Status: Active
Clothing, namely, footwear, shoes, hats, caps, shirts, and jackets
Basis: 1(a)
First Use Date: 2004-11-01
First Use in Commerce Date: 2004-11-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

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.

2011-02-15 - Cancellation Instituted No. 999999

2009-12-02 - Automatic Update Of Assignment Of Ownership

2009-11-25 - Automatic Update Of Assignment Of Ownership

2006-02-14 - Registered - Principal Register

2006-01-05 - Law Office Registration Review Completed

2005-12-30 - Assigned To LIE

2005-12-28 - Allowed for Registration - Principal Register (SOU accepted)

2005-12-09 - Amendment From Applicant Entered

2005-12-02 - Communication received from applicant

2005-12-02 - PAPER RECEIVED

2005-07-26 - NON-FINAL ACTION E-MAILED

2005-07-26 - SU - Non-Final Action - Written

2005-07-05 - Amendment From Applicant Entered

2005-06-20 - Communication received from applicant

2005-06-20 - PAPER RECEIVED

2005-04-21 - NON-FINAL ACTION E-MAILED

2005-04-21 - SU - Non-Final Action - Written

2005-04-07 - Statement Of Use Processing Complete

2005-03-07 - Use Amendment Filed

2005-03-07 - PAPER RECEIVED

2004-10-01 - Extension 5 granted

2004-09-10 - Extension 5 filed

2004-09-16 - PAPER RECEIVED

2004-08-19 - TEAS Change Of Correspondence Received

2004-07-21 - Case File In TICRS

2004-04-26 - Assigned To Examiner

2004-03-02 - Extension 4 granted

2004-02-17 - Extension 4 filed

2004-02-19 - PAPER RECEIVED

2003-09-17 - Extension 3 granted

2003-08-25 - Extension 3 filed

2003-08-25 - PAPER RECEIVED

2003-06-13 - Extension 2 granted

2003-03-11 - Extension 2 filed

2003-03-11 - Extension 1 granted

2002-09-12 - Extension 1 filed

2003-03-27 - PAPER RECEIVED

2003-04-28 - Petition To Revive-Granted

2003-03-17 - Communication Received From Petitioner

2003-03-17 - PAPER RECEIVED

2003-03-20 - Petition to Revive - Incomplete petition letter mailed

2003-01-21 - Petition To Revive-Received

2003-01-21 - PAPER RECEIVED

2003-01-13 - Abandonment - No use statement filed

2002-09-19 - Late filed extension request

2002-09-23 - PAPER RECEIVED

2002-03-12 - NOA Mailed - SOU Required From Applicant

2001-12-18 - Published for opposition

2001-11-28 - Notice of publication

2001-07-02 - Approved For Pub - Principal Register

2001-06-27 - Communication received from applicant

2001-06-27 - Examiner's amendment mailed

2001-06-20 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
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Correspondent
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NORWALK, CT 06851
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CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of August, 2011, I caused a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition and Affirmative Defenses to be sent by U.S. Mail, First Class, postage prepaid, in an envelope addressed to the attorneys of record for Opposer as follows:

Brent S. LaBarge
DeAnne Ozaki
Universal Music Group
2220 Colorado Avenue
Santa Monica, CA 90404

and further certify that the foregoing Applicant's Answer to Notice of Opposition and Affirmative Defenses was filed on the same date via the Board's electronic filing system.

Jessica S. Rutherford

Jessica S. Rutherford