

ESTTA Tracking number: **ESTTA430286**

Filing date: **09/14/2011**

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	S.B.O. Pictures, Inc. dba Wicked Pictures
Granted to Date of previous extension	09/17/2011
Address	9040 Eton Avenue Canoga Park, CA 91304 UNITED STATES
Attorney information	Jonathan W. Brown, Esq. Lipsitz Green Scime Cambria LLP 42 Delaware Avenue, Suite 120 Buffalo, NY 14202 UNITED STATES ip@lglaw.com Phone:716-849-1333 Ext. 371

Applicant Information

Application No	85249331	Publication date	07/19/2011
Opposition Filing Date	09/14/2011	Opposition Period Ends	09/17/2011
Applicant	SCG Communications, LLC Suite 277 9 West Ridgely Road Timonium, MD 21093 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Downloadable adult-themed photographs and videos

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2322874	Application Date	12/03/1997
Registration Date	02/29/2000	Foreign Priority Date	NONE

Word Mark	WICKED PICTURES
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 ON-LINE ORDERING SERVICES FEATURING ADULT NOVELTIES AND ENTERTAINMENT PRODUCTS Class 041. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 PROVIDING AN ON-LINE GLOBAL COMPUTER WEBSITE FEATURING ADULT ENTERTAINMENT GRAPHICS, PICTURES, AND PHOTOS Class 042. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 [COMPUTER SERVICES, NAMELY, PROVIDING ON-LINE VIA A GLOBAL COMPUTER NETWORK MAGAZINE ARTICLES IN ADULT ENTERTAINMENT]

U.S. Registration No.	2322871	Application Date	12/03/1997
Registration Date	02/29/2000	Foreign Priority Date	NONE

Word Mark	WICKED PICTURES
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1993/03/01 First Use In Commerce: 1993/03/01 PRERECORDED VIDEOCASSETTE TAPES, COMPACT DISC-READ ONLY MEMORY (CD-ROM), DIGITAL VIDEO DISC (DVD), FEATURING ADULT ENTERTAINMENT

U.S. Registration No.	2408286	Application Date	08/10/1999
Registration Date	11/28/2000	Foreign Priority Date	NONE

Word Mark	WICKED PICTURES		
Design Mark	WICKED PICTURES		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1993/03/01 First Use In Commerce: 1993/03/01 PRERECORDED VIDEOCASSETTE TAPES, [COMPACT DISC-READ ONLY MEMORY (CD-ROM),] DIGITAL VIDEO DISC (DVD), FEATURING ADULT ENTERTAINMENT		

U.S. Registration No.	2459144	Application Date	08/10/1999
Registration Date	06/12/2001	Foreign Priority Date	NONE

Word Mark	WICKED PICTURES		
Design Mark	WICKED PICTURES		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/03/01 First Use In Commerce: 1993/03/01 MOTION PICTURE FILM PRODUCTION		

U.S. Registration No.	2551490	Application Date	01/14/1999
Registration Date	03/26/2002	Foreign Priority Date	NONE

Word Mark	WICKED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 ON-LINE ORDERING SERVICES FEATURING ADULT ENTERTAINMENT GOODS AND SERVICES</p> <p>Class 041. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 PROVIDING AN ON-LINE GLOBAL COMPUTER WEBSITE FEATURING ADULT ENTERTAINMENT GRAPHICS, PICTURES, PHOTOS, AND AUDIO-VISUAL WORKS</p> <p>Class 042. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 COMPUTER SERVICES, NAMELY, PROVIDING ON-LINE VIA A GLOBAL COMPUTER NETWORK MAGAZINE ARTICLES IN ADULT ENTERTAINMENT</p>		

U.S. Registration No.	2473950	Application Date	05/15/1998
Registration Date	07/31/2001	Foreign Priority Date	NONE
Word Mark	WICKED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 1999/01/07 First Use In Commerce: 1999/01/07 Gels for use as personal lubricant</p> <p>Class 010. First use: First Use: 2000/09/06 First Use In Commerce: 2000/09/06 Personal vibrators; sexual aids, namely, devices for massaging and stimulating the genitals, anus and other parts of the body; devices for aiding in copulation and masturbation, namely, reproductions of the parts of the male and female anatomy; pumps; stimulators; body prostheses</p> <p>Class 020. First use: First Use: 2000/09/06 First Use In Commerce: 2000/09/06 Adult sexual novelties, namely, dolls, genital replica toy figures, and promotional game cards</p>		

Attachments	75399118#TMSN.gif (1 page)(bytes) 75399115#TMSN.gif (1 page)(bytes) 75772045#TMSN.gif (1 page)(bytes) 75772043#TMSN.gif (1 page)(bytes) 75486052#TMSN.gif (1 page)(bytes) int40.PDF (7 pages)(206993 bytes)
-------------	---

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	/Jonathan W. Brown/
Name	Jonathan W. Brown, Esq.
Date	09/14/2011

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

In re Application No. 85249331
Filed: February 23, 2011
Published: July 19, 2011 in the Official Gazette
For: **WICKED OBSESSIONS**

SBO PICTURES, INC.

Opposer,

NOTICE OF OPPOSITION

vs.

Opposition No. _____

SCG Communications, LLC,

Applicant.

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

SBO PICTURES, INC. d/b/a WICKED PICTURES (“WICKED” or “Opposer”), a California corporation, located and doing business at 9040 Eton Avenue, Canoga Park, California 91304-1616, believes that it will be damaged by the registration on the principal register of the mark “**WICKED OBSESSIONS**” shown in Application Serial No. 85249331. Said Application was filed by SCG Communications, LLC (“Applicant”), a Maryland Limited Liability Company, with a mailing address at 9 West Ridgely Road, Suite 277, Timonium, Maryland 21093, and published for opposition in the Official Gazette; WICKED hereby opposes registration thereof.

As grounds for opposition, WICKED alleges:

1. WICKED is the owner of Registration No. 2322874 for **WICKED PICTURES** for “providing an on-line global computer website featuring adult entertainment graphics, pictures, and photos” in International Class 41. WICKED’s application for said registration was filed on December 3, 1997, and progressed to registration on February 29, 2000, and is now deemed incontestable. WICKED has used the mark **WICKED PICTURES** on and in connection with the sale of the aforementioned goods since at least as early as March 1, 1996.

2. WICKED is the owner of Registration No. 2322871 for **WICKED PICTURES** for “prerecorded videocassette tapes..., digital video disc (DVD), featuring adult entertainment” in International Class 9. WICKED’s application for said registration was filed on December 3, 1997, and progressed to registration on February 29, 2000. WICKED has used the mark **WICKED PICTURES** on and in connection with the sale of the aforementioned goods since at least as early as March 1, 1993.

3. WICKED is also the owner of Registration No. 2408286 for **WICKED PICTURES** for “prerecorded videocassette tapes..., digital video disc (DVD), featuring adult entertainment” in International Class 9. WICKED’s application for said registration was filed on August 10, 1999 and progressed to registration on November 28, 2000. WICKED has used the mark **WICKED PICTURES** on and in connection with the sale of the aforementioned goods since at least as early as March 1, 1993.

4. WICKED is the owner of Registration No. 2459144 for **WICKED PICTURES** for “motion picture film production” in International Class 41. WICKED’s application for said registration was filed on August 10, 1999, and progressed to

registration on June 12, 2001. WICKED has used the mark **WICKED PICTURES** on and in connection with the aforementioned services since as early as March 1, 1993.

5. WICKED is the owner of Registration No. 2551490 for **WICKED** for “on-line order services featuring adult entertainment goods and services” in International Class 16; “providing an on-line global computer website featuring adult entertainment graphics, pictures, photos and audio-visual works” in International Class 41; and “computer services, namely, providing on-line via global computer network magazine articles in adult entertainment” in International Class 42. WICKED’s application for said registration was filed on January 14, 1999, and progressed to registration on March 26, 2002. WICKED has used the mark **WICKED** on and in connection with the aforementioned services since as early as March 1, 1996.

6. WICKED is the owner of Registration No. 2473950 for **WICKED** for “gels for use as personal lubricant” in International Class 5; “personal vibrators; sexual aids, namely, devices for massaging and stimulating the genitals, anus and other parts of the body; devices for aiding in copulation and masturbation, namely, reproductions of the parts of the male and female anatomy; pumps; stimulators; body prostheses” in International Class 10; and “adult sexual novelties, namely, dolls, genital replica toy figures, and promotional game cards” in International Class 20. WICKED’s application for said registration was filed on July 31, 2001, and progressed to registration on July 31, 2001. WICKED has used the mark **WICKED** on and in connection with the aforementioned services since as early as January 7, 1999, as pertains to Class 5, and September 6, 2000, as pertains to Classes 10 and 20.

7. The WICKED marks referred to hereinabove will be collectively referred to as the “WICKED MARKS.”

8. As a result of WICKED’s extensive advertising, sales, and marketing of goods and services bearing the WICKED MARKS, said Marks have become famous and well-known to purchasers.

9. By virtue of WICKED’s extensive use and promotion of the WICKED MARKS, it has established valuable goodwill in the WICKED MARKS, and the public has come to associate the WICKED MARKS with WICKED. As such, the public has come to know the WICKED MARKS as an indication of goods and services that originate from WICKED.

10. On February 23, 2011, Applicant filed U.S. Trademark Application Serial No. 85249331, based on its intent to use the mark “**WICKED OBSESSIONS**” in connection with “downloadable adult-themed photographs and videos” in International Class 9. Applicant’s mark referred to hereinabove will be referred to collectively as “Applicant’s mark” or the “Application.”

11. The goods identified in the Application are identical and/or highly related to the goods and services identified in WICKED’s registrations and applications, and with which WICKED has been using for many years.

12. Applicant’s “**WICKED OBSESSIONS**” applied-for mark is extremely similar to the WICKED MARKS. The “OBSESSIONS” component of Applicant’s “**WICKED OBSESSIONS**” mark does not sufficiently distinguish itself from the WICKED MARKS, especially when used with the mark “WICKED” and in connection with highly related and/or identical goods and services.

13. On information and belief, Applicant selected the “WICKED” portion of its applied-for mark as a direct reference to the WICKED MARKS, which was intended to profit from WICKED’s name and goodwill by creating a misleading association of Applicant’s mark and Applicant’s goods with WICKED, and thereby blurring and tarnishing WICKED’s valuable marks.

14. Among other things, WICKED began use of the WICKED MARKS in connection with adult-themed photographs and videos well prior to Applicant’s February 23, 2011 filing date of its Application.

15. As a result of the similarity between the WICKED MARKS and Applicant’s mark and the highly related nature of the goods and services identified by the parties’ marks, Applicant’s mark is likely to cause confusion, mistake or deception in the trade and among ordinary purchasers as to the source, origin or sponsorship of the parties’ respective goods and services.

16. Registration of the mark in the Application and use of Applicant’s mark is likely to dilute and tarnish WICKED’s famous marks.

17. Registration of Applicant’s mark will result in damage to WICKED under the provisions of 15 U.S.C. §§ 1114, 1115 and 1125, pursuant to the allegations stated above, and registration should be denied pursuant to 15 U.S.C. § 1052(d).

18. If Applicant’s mark is permitted to obtain registration, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the “**WICKED OBSESSIONS**” mark. Such registrations would cause confusion among consumers as to the separate and distinct sources of Applicant’s goods and services and WICKED’s goods and services and the relationship of WICKED to Applicant, thereby

damaging WICKED's goodwill in the WICKED MARKS, diluting the value thereof, and resulting in irreparable harm to WICKED's business and reputation, all to the detriment of WICKED which has expended considerable sums and effort in promoting the WICKED MARKS.

WHEREFORE, WICKED prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 85249331 be denied.

Dated: September 14, 2011

Respectfully submitted,

SBO PICTURES, INC., by its counsel
Lipsitz Green Scime Cambria LLC

By: /Jonathan W. Brown, Esq./
Jonathan W. Brown, Esq.
42 Delaware Avenue, Suite 120
Buffalo, NY 14202
(716) 849-1333 Ext. 371

CERTIFICATE OF FILING AND SERVICE

I, Lori Vangelov, hereby certify that on September 14, 2011, I caused a true copy of the foregoing Notice of Opposition to be filed electronically with the United States Patent and Trademark Office and served upon Applicant, SCG Communications, LLC, by United States First Class Mail addressed to 9 West Ridgely Road, Suite 277, Timonium, Maryland 21093.

Dated: September 14, 2011

/Lori Vangelov/

Lori Vangelov

1352739-v1
36971.0117