

ESTTA Tracking number: **ESTTA431624**

Filing date: **09/21/2011**

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	Musidor B.V.
Granted to Date of previous extension	09/21/2011
Address	Herengracht 566 Amsterdam, NL-1017CH NETHERLANDS

Attorney information	Susan L. Heller Greenberg Traurig, LLP 2450 Colorado Ave., Suite 400E Santa Monica, CA 90404 UNITED STATES latm2@gtlaw.com Phone:3105866564
----------------------	--

Applicant Information

Application No	85208202	Publication date	05/24/2011
Opposition Filing Date	09/21/2011	Opposition Period Ends	09/21/2011
Applicant	McMullen, Mark 304 Mill Pond Drive Phenix City, AL 36870 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2010/10/00 First Use In Commerce: 2010/10/00 All goods and services in the class are opposed, namely: Dice games

Grounds for Opposition

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.	1358893	Application Date	01/18/1977
Registration Date	09/10/1985	Foreign Priority Date	NONE
Word Mark	ROLLING STONES		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1971/04/12 First Use In Commerce: 1971/04/12 Phonograph Records and Pre-Recorded Magnetic Tapes, Cartridges and Cassettes Class 041. First use: First Use: 1971/04/12 First Use In Commerce: 1971/04/12 Entertainment Services Rendered by a Musical Group

U.S. Registration No.	2201605	Application Date	10/05/1994
Registration Date	11/03/1998	Foreign Priority Date	NONE

Word Mark	ROLLING STONES
Design Mark	
Description of Mark	NONE
Goods/Services	Class 026. First use: First Use: 1989/08/00 First Use In Commerce: 1989/08/00 Brooches, badges, and ornamental novelty pins, not of precious metal and not being imitation jewelry, and clothing buttons

U.S. Registration No.	3853613	Application Date	10/05/2007
Registration Date	09/28/2010	Foreign Priority Date	NONE

Word Mark	ROLLING STONES
Design Mark	

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 Musical sound recordings; audio-visual recordings, namely, compact discs, tape cassettes, audio cassettes, audio tapes, audio discs, records, CD-ROMs, video discs, DVDs, and MP3s, all featuring music; downloadable musical sound recordings; downloadable video recordings featuring music; magnets; all of the foregoing relating to the Rolling Stones musical group Class 041. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 Entertainment in the nature of a live musical performer, musical band or musical group, entertainment in the nature of live performances by a musical artist, musical group or musical band, entertainment in the nature of visual and audio performances by a musical artist, musical group and musical band; entertainment, namely, live music concerts; entertainment, namely, personal appearances by a musician, musical group or musical band; entertainment services, namely, providing a web site featuring musical performances, musical

	videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing prerecorded music, information in the field of music, commentary and articles about music, all online via a global computer network, entertainment in the nature of traveling tours featuring music; entertainment services, namely, providing pre-recorded music via computer; all of the foregoing relating to the Rolling Stones musical group
--	--

U.S. Application No.	77297207	Application Date	10/05/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ROLLING STONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: Clothing, namely, caps, hats, jackets, T-shirts, tank tops, shirts, sweat shirts, socks, ties, scarves, shorts, skirts, trousers, underwear, pullovers, cardigans, track pants, blouses, dresses; footwear, namely, boots, shoes, sandals, slippers; all of the foregoing relating to the Rolling Stones musical group		

Attachments	77979538#TMSN.jpeg (1 page)(bytes) 77297207#TMSN.jpeg (1 page)(bytes) ROLL-N-STONED_001.pdf (8 pages)(343980 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	/slh/
Name	Susan L. Heller
Date	09/21/2011

The grounds for opposition are as follows:

1. Musidor is the owner of all rights in the marks, registrations and applications for the world-renowned musical group, The Rolling Stones. These rights include rights in the famous mark ROLLING STONES.

2. Musidor also owns common law rights and/or federal registrations and applications for the mark ROLLING STONES in connection with musical entertainment goods and services, as well as a wide variety of related and collateral goods and services. Musidor has continuously used the ROLLING STONES mark in connection with musical entertainment goods and services for over 40 years. Since that time, Musidor has also introduced and offered a wide variety of related and collateral goods and services under the ROLLING STONES mark. Musidor continues to use the ROLLING STONES mark in connection with musical entertainment goods and services and a wide variety of related and collateral goods and services.

3. In addition, Musidor owns the following U.S. registrations and applications:

a. U.S. Registration No. 1358893 for the mark ROLLING STONES in connection with “phonograph records and pre-recorded magnetic tapes, cartridges and cassettes” in International Class 9 and “entertainment services rendered by a musical group” in International Class 41. This application was filed on January 18, 1977 and registered on September 10, 1985, and is in full force and effect and incontestable within the meaning of § 15 of the Lanham Act.

b. U.S. Registration No. 2201605 for the mark ROLLING STONES in connection with “Brooches, badges, and ornamental novelty pins, not of precious metal and not being imitation jewelry, and clothing buttons” in International Class 26. This application was filed on October 5, 1994 and registered on November 3, 1998, and is in full force and effect and incontestable within the meaning of § 15 of the Lanham Act.

c. U.S. Registration No. 3853613 for the mark ROLLING STONES in connection with “Musical sound recordings; audio-visual recordings, namely, compact discs, tape cassettes, audio cassettes, audio tapes, audio discs, records, CD-ROMs, video discs, DVDs, and MP3s, all featuring music; downloadable musical sound recordings; downloadable video recordings featuring music; magnets; all of the foregoing relating to the Rolling Stones musical group” in International Class 9, and “Entertainment in the nature of a live musical performer, musical band or musical group, entertainment in the nature of live performances by a musical artist, musical group or musical band, entertainment in the nature of visual and audio performances by a musical artist, musical group and musical band; entertainment, namely, live music concerts; entertainment, namely, personal appearances by a musician, musical group or musical band; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing prerecorded music, information in the field of music, commentary and articles about music, all online via a global computer network, entertainment in the nature of traveling tours featuring music; entertainment services, namely, providing pre-recorded music via computer; all of the foregoing relating to the Rolling Stones musical group” in International Class 41. This application was filed on October 5, 2007 and registered on September 28, 2010.

d. U.S. Application Serial No. 77297207 for the mark ROLLING STONES in connection with “Clothing, namely, caps, hats, jackets, T-shirts, tank tops, shirts, sweat shirts, socks, ties, scarves, shorts, skirts, trousers, underwear, pullovers, cardigans, track pants, blouses, dresses; footwear, namely, boots, shoes, sandals, slippers; all of the foregoing relating to the Rolling Stones musical group” in International Class 25. This

application was filed on October 5, 2007 and a Notice of Allowance was issued on March 22, 2011.

4. Musidor owns and controls the commercial rights of the world-renowned musical group, The Rolling Stones. The Rolling Stones musical group has offered musical entertainment under the name ROLLING STONES in the United States for over 40 years. Since that time, The Rolling Stones has become one of the most well-known and respected musical groups in the U.S. and abroad. In the U.S. alone, the Rolling Stones has released over twenty studio albums, eight of which charted at number one, as well as numerous compilations and concert albums. The Rolling Stones has also performed hundreds of live musical concerts for over four decades throughout the United States and internationally, and has also sold more than 200 million albums worldwide. In 1989, The Rolling Stones was inducted into the Rock and Roll Hall of Fame, thereby establishing the group as one of the best-known, most influential, and iconic artists in the music industry.

Musidor also offers a wide variety of collateral goods sold under the name ROLLING STONES, including posters, calendars and other printed goods, pins and buttons, clothing, beverage ware, ornamental novelty items, and keychains, among others. The revenue generated from the musical entertainment and collateral merchandising offered under the ROLLING STONES mark exceeds hundreds of millions of dollars.

As a result of the extensive use of the ROLLING STONES mark, the ROLLING STONES mark is closely associated with The Rolling Stones and, by extension, with Musidor. As such, the purchasing public has come to know, rely upon, and recognize the goods and services of Musidor by this mark. Through many years of use and the expenditure of significant sums and effort, the distinctive ROLLING STONES mark has achieved fame and worldwide recognition and represents enormous value and goodwill.

5. Musidor also owns many registrations and applications throughout the world for the mark ROLLING STONES.

6. Musidor has provided goods and services under the mark ROLLING STONES throughout the United States through numerous channels of trade. In addition, Musidor has devoted substantial advertising dollars to promote its goods and services under the ROLLING STONES mark and foster wide recognition of the mark by consumers. As a result of these efforts, as well as the inherent and acquired distinctiveness of the ROLLING STONES mark, the ROLLING STONES mark has become well-known and famous, and is therefore entitled to a broad scope of protection.

7. The public associates the mark ROLLING STONES with Musidor's goods and services. The ROLLING STONES mark therefore functions as an indicator of source for Musidor's goods and services, and as such, it is the exclusive property right of Musidor.

8. Trademark Application Serial No. 85/208,202, sought to be opposed, is for the mark ROLL-N-STONED ("Applicant's Mark") for use in connection with "Dice games" in International Class 28. This application was filed on December 30, 2010, and lists a first use date of October 2010.

9. The instant application was published for opposition on May 24, 2011, and Musidor was subsequently granted a Request for a Ninety Day Extension of Time to File an Opposition at the Trademark Trial and Appeal Board, which expires September 21, 2011. Accordingly, Applicant has timely filed this Notice of Opposition.

10. The instant application was filed without Musidor's authorization, consent, or prior knowledge.

11. Musidor's first use of the mark ROLLING STONES in connection with musical entertainment goods and services and a variety of related and collateral goods and services

predates Applicant's first use of Applicant's Mark. In addition, Musidor's registrations and applications for the mark ROLLING STONES were all filed prior to the filing date of Applicant's application.

12. Applicant's Mark is confusingly similar to Musidor's ROLLING STONES mark.

13. The goods identified in Applicant's application are commercially related to and/or associated with the goods and services offered by Musidor under its ROLLING STONES mark, and/or are a natural expansion of the goods and services offered by Musidor under its ROLLING STONES mark. Furthermore, both parties use overlapping channels of trade and target similar classes of consumers.

14. In light of the foregoing, it is likely that consumers will view Applicant's Mark as an extension of the famous ROLLING STONES brand. It is likely that consumers will mistakenly believe that Applicant's Mark is connected to or associated with Musidor and/or The Rolling Stones, or that Musidor and/or The Rolling Stones has, to some degree, sponsored or endorsed Applicant's goods. Accordingly, the registration and concurrent use of Applicant's Mark is likely to cause confusion, mistake and/or deception among the consuming public regarding the source, affiliation and/or sponsorship between Musidor and its goods and services, and Applicant and its goods.

15. In addition, because of the fame acquired by the ROLLING STONES mark, registration of Applicant's Mark will dilute the value and distinctive quality of the ROLLING STONES mark.

16. The registration of Applicant's Mark for the goods identified in the Application would be inconsistent with Musidor's rights in its ROLLING STONES mark, and will cause damage to Musidor and Musidor's rights in its ROLLING STONES mark.

17. By virtue of the foregoing, Applicant's application should be rejected, and registration of Applicant's Mark should be denied and refused.

Submitted herewith is the amount of \$300.00 representing the required filing fee paid by deposit account. Authorization is hereby provided to charge any deficiency to Deposit Account 50-2638.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Dated: September 21, 2011

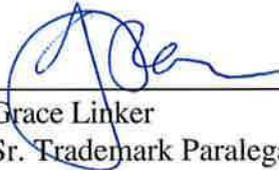
By: 
Susan L. Heller
Joseph Geisman
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Tel: (310) 586-6568
Fax: (310) 586-0568
hellers@gtlaw.com

Attorneys for Musidor B.V.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on September 21, 2011, addressed as follows:

Matthew H. Swyers
The Trademark Company
344 Maple Avenue West
Vienna, VA 22180-5612



Grace Linker
Sr. Trademark Paralegal