

ESTTA Tracking number: **ESTTA457557**

Filing date: **02/21/2012**

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	Shure Incorporated		
Entity	Corporation	Citizenship	Illinois
Address	5800 West Touhy Avenue Niles, IL 60714 UNITED STATES		

Attorney information	Katherine L. Fink Banner & Witcoff, Ltd. 10 South Wacker Drive, Suite 3000 Chicago, IL 60606 UNITED STATES kfink@bannerwitcoff.com, hminsker@bannerwitcoff.com, bwptotm@bannerwitcoff.com, bwlitdocket@bannerwitcoff.com, sdease@bannerwitcoff.com Phone:312-463-5000
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Applicant Information

Application No	85356371	Publication date	02/21/2012
Opposition Filing Date	02/21/2012	Opposition Period Ends	03/22/2012
Applicant	U Flakey Entertainment 277 NE 116ST Miami, FL 33161 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Recording studio services; Entertainment services in the nature of presenting live musical performances
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2163185	Application Date	05/20/1996
Registration Date	06/09/1998	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	The mark consists of a design of a microphone, specifically, the housing having an arrangement of eight generally horizontal parallel slots around the middle portion of the housing and six generally vertical parallel slots on the top and bottom of the housing.
Goods/Services	Class 009. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 microphones

Attachments	75106877#TMSN.gif (1 page)(bytes) Notice of Opposition - U Flakey Entertainment.pdf (10 pages)(274547 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	/Katherine L. Fink/
Name	Katherine L. Fink
Date	02/21/2012

Attorney Docket:
010886.01486

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

In the Matter of Trademark Applicant)
U Flakey Entertainment)
Mark: U FLAKEY .ENT. and Design)
Serial No.: 85/356,371)
Filed: June 26, 2011)
Published in the Official Gazette dated February 21, 2012)
_____)
SHURE INCORPORATED,)
Opposer,)
vs.)
U FLAKEY ENTERTAINMENT,)
Applicant.)
_____)

Opposition No. _____

NOTICE OF OPPOSITION

Sir:

Opposer, Shure Incorporated, whose address is 5800 West Touhy Avenue, Niles, Illinois, 60714-4608, believes it will be damaged by registration of the above-identified mark (hereinafter “Applicant’s Mark”) and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer is the owner of U.S. Trademark Registration No. 2,163,185, issued on June 9, 1998, for a mark consisting of "...a design of a microphone, specifically, the housing having an arrangement of eight generally horizontal parallel slots around the middle portion of the housing and six generally vertical parallel slots on the top and bottom of the housing." A copy of Registration No. 2,163,185 is attached as Exhibit 1, and the mark as shown in the registration is as follows:

Reg. No. 2163185



2. The mark shown in Registration No. 2,163,185 (hereinafter the "55SH Design Mark" or "Opposer's Mark") is the configuration of goods known by Opposer's trademark "55SH" and said configuration mark has been in use continuously in interstate commerce since at least as early as 1951.

3. Shure has brought other successful oppositions based on the 55SH Design Mark, including the following:

	<p>SN 78440605 Opp. No. 91172313</p>
	<p>SN 76438405 Opp. No. 91157778</p>
	<p>SN 78802022 Opp. No. 91175285</p>
	<p>SN 78967404 Opp. No. 91179026</p>
	<p>SN 77145347 Opp. No. 91182265</p>
	<p>SN 77178685 Opp. No. 91182264</p>
	<p>SN 77352323 Opp. No. 91185874</p>

	<p>SN 78794202 Opp. No. 91187658</p>
	<p>SN 77759438 Opp. No. 91193922</p>
	<p>SN 85016660 Opp. No. 91196595</p>
	<p>SN 85033789 Opp. No. 91197079</p>
	<p>SN 85118278 Opp. No. 91200070</p>
	<p>SN 85009106 Opp. No. 91200695</p>

Opposition Nos. 91172313, 91179026, 91182264, 91193922, and 91197079 were terminated with the voluntary withdrawal of the application by the Applicant; Opposition Nos. 91157778, 91175285, 91182265, 91185874, 91196595, 91200070, and 91200695 resulted in decisions sustaining the oppositions; and Opposition No. 91187658 was terminated with the voluntary amendment of the application by the Applicant.

4. Applicant seeks to register a design mark in the opposed application, No. 85/356,371, that consists of the words U FLAKEY .ENT. and the design of two microphones that are virtually identical to Opposer's 55SH Design Mark. Applicant's Mark incorporates Opposer's registered 55SH Design Mark, without Opposer's permission, and Opposer's Mark forms the dominant part of the image shown in the opposed mark, as shown below:

SN 85/356,371



5. The opposed application, No. 85/356,371, was filed on June 26, 2011. On December 15, 2011, the applicant indicated that it was filed pursuant to Section 1(b) of the Trademark Act.

6. Applicant seeks to register its mark for “Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Recording studio services; Entertainment services in the nature of presenting live musical performances” in International Class 041.

7. Opposer’s 55SH Design Mark is known and widely used in the entertainment and music industry and widely recognized by the general public.

8. As a result of Opposer’s and its predecessors’ long use and registration of its 55SH Design Mark, Opposer has developed substantial goodwill in said mark, and the public has come to associate the 55SH Design Mark with the microphones of Opposer.

9. Applicant’s Mark, which is dominated by two microphones that are virtually identical to Opposer’s registered 55SH Design Mark, so nearly resembles Opposer’s Mark, that when the mark is applied to the services identified in Applicant’s application in International Class 041, it is to be likely to be confused with Opposer’s mark. Applicant’s mark is deceptively similar to Opposer’s Mark, so as to cause confusion and to lead to deception as to the origin of Applicant’s goods bearing Applicant’s mark. As such, Applicant’s use and registration of its mark will inevitably lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of the Trademark Act of 1946, as amended, all to Opposer’s grave and irreparable damage.

10. As a further ground for opposition, Opposer’s registered 55SH Design Mark, which has been in use in commerce for more than fifty years, is famous within the meaning of Lanham Act Section 43(c), 15 USC 1125(c). Opposer’s Mark became famous prior to the date when Applicant commenced any use of Applicant’s Mark, and prior to the filing date of the application for Applicant’s Mark. Applicant’s use of its mark, which incorporates Opposer’s famous mark

in its entirety, causes dilution by lessening the capacity of Opposer's Mark to identify and distinguish Opposer's goods, in violation of Section 43(c), 15 USC 1125(c) of the Lanham Act.

11. If Applicant is permitted to register its mark, the registration would give Applicant a prima facie exclusive right to the use of Applicant's Mark for the goods set forth in the application. Such registration would damage and injure Opposer.

12. By reason of the foregoing, Applicant's registration of the design mark herein opposed will cause injury and damage to Opposer's rights to its registered 55SH Design Mark and to its use thereof described above.

WHEREFORE, Opposer respectfully prays that the present opposition be sustained and that the registration sought by the Applicant be refused.

Please charge the statutory fee of \$300 to our firm's deposit account, No. 19-0733. Please also charge any additional fees, or credit any overpayments, to our firm's deposit account, No. 19-0733.

Respectfully submitted,
BANNER & WITCOFF, LTD.
Attorneys for Opposer

Date: February 21, 2012

By: /Katherine L. Fink/
Helen Hill Minsker
J. Pieter van Es
Katherine L. Fink
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606
Telephone: 312-463-5000

Enclosure: Exhibit 1
Copy of Reg. No. 2,163,185

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of February, 2012, a copy of the foregoing Notice of Opposition was served on Applicant, by first class mail, postage prepaid, addressed as follows:

U FLAKEY ENTERTAINMENT
277 NE 116TH ST
MIAMI, FL 33161

/Katherine L. Fink/

Exhibit 1

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,163,185

United States Patent and Trademark Office

Registered June 9, 1998

**TRADEMARK
PRINCIPAL REGISTER**



SHURE BROTHERS, INC. (ILLINOIS CORPORATION)
222 HARTREY AVENUE
EVANSTON, IL 602043696

FOR: MICROPHONES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 0-0-1951; IN COMMERCE 0-0-1951.

THE LINING IN THE DRAWING IS USED TO INDICATE SHADING TO SHOW THE MARK IN THREE DIMENSIONAL FORM.

THE MARK CONSISTS OF A DESIGN OF A MICROPHONE, SPECIFICALLY, THE HOUS-

ING HAVING AN ARRANGEMENT OF EIGHT GENERALLY HORIZONTAL PARALLEL SLOTS AROUND THE MIDDLE PORTION OF THE HOUSING AND SIX GENERALLY VERTICAL PARALLEL SLOTS ON THE TOP AND BOTTOM OF THE HOUSING.

SEC. 2(F).

SER. NO. 75-106,877, FILED 5-20-1996.

ANDREW LAWRENCE, EXAMINING ATTORNEY