

ESTTA Tracking number: **ESTTA647767**

Filing date: **12/31/2014**

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

Proceeding	91212905
Party	Defendant OCC Establishment
Correspondence Address	CHRISTOPHER WEIMER FULBRIGHT & JAWORSKI LLP 98 SAN JACINTO BLVD SUITE 1100 AUSTIN, TX 78701 UNITED STATES orbitmarks@nortonrosefulbright.com
Submission	Answer
Filer's Name	Christopher Weimer
Filer's e-mail	orbitmarks@nortonrosefulbright.com
Signature	/Christopher Weimer/
Date	12/31/2014
Attachments	Answer.pdf(27523 bytes)

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

EMI (IP) LIMITED	§	Opposition No. 91212905
	§	
Opposer / Petitioner,	§	Application Serial No. 78/835,315
	§	MUSIC NOW
v.	§	Publication Date: June 11, 2013
	§	
OCC Establishment	§	Registration No. 2,100,606
	§	MN MUSIC NOW & Design
	§	Registered: September 30, 1997
Applicant, Respondent.	§	

Pursuant to Federal Rule of Civil Procedure 8(b) and Trademark Rule 2.106, Applicant and Respondent OCC Establishment (“Applicant” or “OCC”) answers the Combined Notice of Opposition and Petition to Cancel (“Combined “Notice”) filed by EMI (IP) Limited (“Opposer” or “EMI”). The paragraph numbers below correspond to those in the Combined Notice. OCC reserves the right to amend or supplement this Answer as appropriate. To the extent any averment in the Combined Notice is not specifically admitted herein, any such averment is denied.

I. ANSWER

Introductory Paragraph: To the extent any response is required to the statements in the introductory paragraph to the Combined Notice, OCC is without knowledge or information sufficient to form a belief as to the place of incorporate or address of EMI. OCC denies that EMI would be damaged by the issuance of a registration to OCC Establishment (“OCC”) for the MUSIC NOW word mark set forth in Application Serial No. 78/835,315 (the “Application”) and further denies that EMI is being damaged and will continue to be damaged by OCC’s registration

for the MUSIC NOW and Design mark set forth in Registration No. 2,100,606 (the “Registration”).¹

1. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 of the Combined Notice and therefore denies each and every allegation contained therein.

2. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 of the Combined Notice and therefore denies each and every allegation contained therein.

3. Denied.

4. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4 of the Combined Notice and therefore denies each and every allegation contained therein.

5. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 and therefore denies each and every allegation contained therein.

6. OCC admits that USPTO records indicate that EMI is the owner of: (1) U.S. Reg. No. 2,112,881 for NOW in International class 9; (2) U.S. Reg. No. 4,211,879 for NOW in International Classes 9, 35, 38, 41 and 45; (3) U.S. Reg. No. 2,484,158 for NOW! MUSIC in International Classes 9; (4) U.S. Reg. No. 2,462,073 for NOW DANCE in International Class 9; (5) – (6) U.S. Reg. Nos. 3,506,405 and 2,089,508 for NOW THAT’S WHAT I CALL MUSIC in International Classes 41 and 9; and (7) U.S. Reg. No. 3,370,350 for NOW ¡ESTO

¹ OCC adopts for purposes of this Answer EMI’s convention of referring to the Application and Registration

ES MUSICA! LATINO in International Class 9. OCC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 6 of the Combined Notice and therefore denies each and every remaining allegation contained therein.

7. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegation that “the foregoing registrations are valid, subsisting, and in full force and effect.” The remaining allegations in Paragraph 7 constitute legal conclusions to which no response is required. To the extent that any response is required, the allegations are denied.

8. OCC admits deletion of the Section 1(b) filing basis eliminated the requirement of providing a specimen of use prior to registration.

9. Denied.

10. Admitted.

11. OCC admits that on or about March 30, 2004 it submitted a Declaration Under Section 8 Based on Excusable Nonuse along with Comments in Support of the Declaration Under Section 8 Based on Excusable Nonuse. OCC denies the remaining allegations in Paragraph 11 of the Combined Notice.

12. OCC admits that on or about March 31, 2008, OCC submitted the document titled Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9 containing an explanation of excusable nonuse made of record. The remaining allegations in Paragraph 12 are denied.

13. Denied.

14. OCC admits that there has been at least one period of three years in which OCC did not use the MUSIC NOW and Design Mark in the United States. OCC denies the remaining allegations in Paragraph 14.

15. Denied.

16. Admitted.

17. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 17 of the Combined Notice and therefore denies each and every allegation contained therein.

18. OCC admits that the Application was published for opposition on June 11, 2013 and that EMI's time to oppose the Application was extended until October 9, 2013.

19. Denied.

20. Denied.

21. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 21 and therefore denies each and every allegation contained therein.

22. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 22 and therefore denies each and every allegation contained therein.

23. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 23 and therefore denies each and every allegation contained therein.

24. Denied.

25. OCC denies that the NOW Marks are distinctive. OCC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 25 of the Combined Notice.

26. Denied.

27. Denied.

28. Denied.

29. Denied.

30. Denied.

31. Denied.

32. OCC is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 32 of the Combined Notice and therefore denies each and every allegation contained therein.

Prayer: To the extent that any response is required to the final paragraph of EMI's Combined Notice, OCC denies that the Board should sustain EMI's Combined Notice and that EMI is entitled to any relief.

II. AFFIRMATIVE DEFENSES

1. EMI's claims are barred by the doctrines of laches, acquiescence, estoppel, and waiver.

2. EMI's claims are barred in whole or in part due to EMI's failure to adequately police against third-party uses of "NOW" and similar phrases. EMI's failure to adequately police

its own marks is such that it has abandoned, in whole or in part, its rights to enforce its trademarks.

3. EMI's claims are barred because it has acquiesced to third-party use of "NOW" and NOW-formative marks in connection with goods and services more closely related to EMI's goods and services than to the services marked in connection with the MUSIC NOW mark.

Date: December 31, 2014

Respectfully submitted,

By: /s Christopher M. Weimer /
Christopher M. Weimer
Texas Bar No. 24061894
Orbitmarks@nortonrosefulbright.com
FULBRIGHT & JAWORSKI L.L.P.
98 San Jacinto Blvd., Suite 1100
Austin, TX 78701
Tel. (512) 474-5201
Fax (512) 536-4598

Attorney for OCC ESTABLISHMENT

CERTIFICATE OF SERVICE I hereby certify that a true and correct copy of the foregoing,

“Answer” has been served on Opposer by mailing said copy on December 31, 2014, via email to:

Brent S. LaBarge
Business and Legal Affairs – Trademark Group
Universal Music Group
2220 Colorado Avenue
Santa Monica, California 90404
Brent.LaBarge@umusic.com

/s Christopher M. Weimer /
Christopher M. Weimer