

ESTTA Tracking number: **ESTTA573712**

Filing date: **11/27/2013**

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	Home Box Office, Inc.
Granted to Date of previous extension	11/27/2013
Address	1100 Avenue of the Americas New York, NY 10036 UNITED STATES

Attorney information	Tamara F. Carmichael LOEB & LOEB LLP 345 Park Avenue New York, NY 10154 UNITED STATES chdoCKET@loeb.com, tcarmichael@loeb.com, jsarowitz@loeb.com, aproVencio@loeb.com Phone:212-407-4000
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**Applicant Information**

Application No	85791578	Publication date	07/30/2013
Opposition Filing Date	11/27/2013	Opposition Period Ends	11/27/2013
Applicant	SSC Apparel, Inc. 2025 Long Beach Ave Los Angeles, CA 90058 CANADA		

**Goods/Services Affected by Opposition**

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, blazers, blouses, cardigans, cargo pants, coats, dresses, sweatshirts, jackets, pants, jumpsuits, overalls, ponchos, robes, rompers, shirts, shorts, skirts, tops, vests, and shoes
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2366388	Application Date	08/23/1999
Registration Date	07/11/2000	Foreign Priority Date	NONE
Word Mark	THE SOPRANOS		

Design Mark	<b>The Sopranos</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/01/10 First Use In Commerce: 1999/01/10 ONGOING DRAMATIC TELEVISION PROGRAM		

U.S. Registration No.	3027491	Application Date	07/12/2004
Registration Date	12/13/2005	Foreign Priority Date	NONE

Word Mark	THE SOPRANOS
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Design Mark	<b>The Sopranos</b>		
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Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 prerecorded [ audiotapes, ] videotapes,compact discs, DVDs [ and multimedia software recorded on CD-ROM ] featuring content from or relating to applicant's dramatic television series of the same name		

U.S. Registration No.	2539014	Application Date	10/25/1999
Registration Date	02/19/2002	Foreign Priority Date	NONE

Word Mark	THE SOPRANOS
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Design Mark	<b>The Sopranos</b>		
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Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/02/26 First Use In Commerce: 1999/02/26 CLOTHING, NAMELY, [ SHIRTS, ] T-SHIRTS [ , TURTLENECKS ] AND HATS		

U.S. Registration No.	4372447	Application Date	12/18/2012
Registration Date	07/23/2013	Foreign Priority	NONE

		Date	
Word Mark	THE SOPRANOS		
Design Mark			
Description of Mark	The mark consists of THE WORD "SOPRANOS" WITH THE WORD "THE" OVER THE "O" AND AGUN IN PLACE OF THE LETTER "R".		
Goods/Services	Class 025. First use: First Use: 2002/01/30 First Use In Commerce: 2002/01/30 clothing, namely, t-shirts, hats		

U.S. Registration No.	4204773	Application Date	09/28/2011
Registration Date	09/11/2012	Foreign Priority Date	NONE
Word Mark	THE SOPRANOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/03/24 First Use In Commerce: 2011/03/24 Protective cases for laptop computers, tablet computers, smart phones and otherportable electronic devices, namely, media players, mobile phones, global positioning systems and personal digital assistants; protective coverings for laptop computers, tablet computers, smart phones and other portable electronic devices,namely, media players, mobile phones, global positioning systems and personal digital assistants		

U.S. Registration No.	3490650	Application Date	08/24/2006
Registration Date	08/19/2008	Foreign Priority Date	NONE
Word Mark	THE SOPRANOS		

Design Mark	<b>The Sopranos</b>
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2006/10/31 First Use In Commerce: 2006/10/31 poker chips and poker sets consisting of a storage case, poker chips, poker cards and dice

U.S. Registration No.	3317641	Application Date	04/24/2006
Registration Date	10/23/2007	Foreign Priority Date	NONE

Word Mark	THE SOPRANOS
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Design Mark	<b>THE SOPRANOS</b>
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Description of Mark	NONE
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Goods/Services	Class 009. First use: First Use: 2000/12/12 First Use In Commerce: 2000/12/12 Pre-recorded [ audiotapes, videotapes, ] compact discs and DVDs, all featuring an ongoing dramatic television series; images held in electronic format, namely, images related to an ongoing dramatic television series in the nature of downloadable electronic photographs, and electronic photographs and graphics stored or recorded on electronic or computer media; electronic game programs; [ downloadable ring tones and downloadable ring back tones, pre-recorded video clips, pre-recorded audio clips, animated ringtones, video ringtones, audio shorts, video shorts] and animated screensavers, all downloadable via a global computer network and featuring content from or relating to an ongoing dramatic television series; downloadable pre-recorded audio, video, text and graphics held in electronic personal computers and handheld wireless devices featuring content from or relating to an ongoing dramatic television series Class 041. First use: First Use: 1999/01/10 First Use In Commerce: 1999/01/10 Entertainment services in the nature of an ongoing dramatic television series
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U.S. Registration No.	3674535	Application Date	09/13/2005
Registration Date	08/25/2009	Foreign Priority Date	NONE

Word Mark	THE SOPRANOS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2005/12/16 First Use In Commerce: 2005/12/16 video game discs, images held in electronic format, namely, images related to adramatic television series in the nature of downloadable electronic photographs, electronic photographs and graphics stored or recorded on electronic or computer media; electronic game programs; downloadable ringtones available via a global computer network and wireless devices featuring content related to a dramatic television series; pre-recorded graphics, all downloadable via the internet, held in electronic personal computers and handheld wireless devices and all featuring content from or relating to Applicant's dramatic television series of the same name

U.S. Registration No.	2970739	Application Date	06/24/2004
Registration Date	07/19/2005	Foreign Priority Date	NONE

Word Mark	THE SOPRANOS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2000/01/20 First Use In Commerce: 2000/01/20 Series of fiction books, [ calendars ] and posters

Attachments	75782431#TMSN.gif( bytes ) 78449139#TMSN.jpeg( bytes ) 75830672#TMSN.gif( bytes ) 85804945#TMSN.jpeg( bytes ) 85433817#TMSN.jpeg( bytes ) 78959417#TMSN.jpeg( bytes ) 78867796#TMSN.jpeg( bytes ) 78711604#TMSN.jpeg( 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	/Tamara F. Carmichael/
Name	Tamara F. Carmichael
Date	11/27/2013

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

**In the Matter of Application Serial No. 85/791,578: SOP ANO  
Published in the *Official Gazette* of July 30, 2013**

HOME BOX OFFICE, INC.,	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	
SSC Apparel, Inc.,	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Home Box Office, Inc. (“Opposer”), a Delaware corporation, located and doing business at 1100 Avenue of the Americas, New York, New York 10036, believes it will be damaged by the registration of the trademark and design SOP ANO<sup>1</sup>, in International Class 25 for “Clothing, namely, blazers, blouses, cardigans, cargo pants, coats, dresses, sweatshirts, jackets, pants, jumpsuits, overalls, ponchos, robes, rompers, shirts, shorts, skirts, tops, vests, and shoes” in Application Serial No. 85/791,578 (the “SOPRANO Ribbon Mark”), filed by SSC Apparel, Inc. (“Applicant”), and hereby opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer operates well-known and widely distributed premium television channels and is the producer of the renowned, critically acclaimed and award-winning original television series “The Sopranos.”

2. Since long prior to the filing of Applicant’s Application Serial No. 85/791,578, Opposer has produced and extensively marketed and distributed The Sopranos television series,

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<sup>1</sup> As set forth in the Application, “The mark consists of the letters ‘SOP’ appearing in red text followed by a pink ribbon followed by the letters ‘ANO’ in red text.”

as well as related goods and services, under the trademark THE SOPRANOS, with its attendant trade dress, logos, and designs (“THE SOPRANOS Marks”).

3. Opposer owns registrations and applications for THE SOPRANOS Marks & design and service marks with the United States Patent and Trademark Office (“PTO”).

Opposer’s registrations include, but are not limited to:

	Mark	Reg. No.	Goods/Services
1.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	2366388	Class 041 - ongoing dramatic television program.
2.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	3027491	Class 009 - prerecorded [ audiotapes, ] videotapes, compact discs, DVDs [ and multimedia software recorded on CD-ROM ] featuring content from or relating to applicant's dramatic television series of the same name.
3.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	2539014	Class 25 - clothing, namely, [ shirts, ] t-shirts [, turtlenecks ] and hats.
4.	<b>THE SOPRANOS</b> <b>Sopranos</b>	4372447	Class 25 - clothing, namely, t-shirts, hats.
5.	<b>THE SOPRANOS</b>	4204773	Class 009 - protective cases for laptop computers, tablet computers, smart phones and other portable electronic devices, namely, media players, mobile phones, global positioning systems and personal digital assistants; protective coverings for laptop computers, tablet computers, smart phones and other portable electronic devices, namely, media players, mobile phones, global positioning systems and personal digital assistants.
6.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	3490650	Class 028 - poker chips and poker sets consisting of a storage case, poker chips, poker cards and dice.
7.	<b>THE SOPRANOS</b>	3317641	Class 28 - poker chips and poker sets consisting of a storage case, poker chips, poker cards and dice.

	Mark	Reg. No.	Goods/Services
8.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	3674535	Class 009 - video game discs, images held in electronic format, namely, images related to a dramatic television series in the nature of downloadable electronic photographs, electronic photographs and graphics stored or recorded on electronic or computer media; electronic game programs; downloadable ringtones available via a global computer network and wireless devices featuring content related to a dramatic television series; pre-recorded graphics, all downloadable via the internet, held in electronic personal computers and handheld wireless devices and all featuring content from or relating to Applicant's dramatic television series of the same name.
9.	<b>THE SOPRANOS</b> <b>The Sopranos</b>	2970739	Class 016 - Series of fiction books, [ calendars ] and posters.

The registrations are valid, subsisting, and owned by Opposer.

4. Opposer has built up and now owns an extremely valuable goodwill which is symbolized by its THE SOPRANOS Marks.

5. Applicant's proposed use and/or use of the SOPRANO Ribbon Mark for "Clothing, namely, blazers, blouses, cardigans, cargo pants, coats, dresses, sweatshirts, jackets, pants, jumpsuits, overalls, ponchos, robes, rompers, shirts, shorts, skirts, tops, vests, and shoes" ("Applicant's Goods") is without Opposer's consent or permission.

6. Applicant's use of the SOPRANO Ribbon Mark in connection with Applicant's Goods is likely to cause confusion, mistake, or deception in that consumers are likely to believe Applicant's Goods are Opposer's goods or the goods or services of a person or company that is sponsored, authorized or licensed by, or in some other way legitimately connected with, Opposer.

**WHEREFORE**, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 85/791,578 be denied registration.

Please debit our Deposit Account No. 502547 for the filing fee and for any additional necessary fees.

Please address all correspondence to Tamara F. Carmichael, Esq., Loeb & Loeb LLP, 345 Park Avenue, New York, New York, 10154.

Date: November 27, 2013

LOEB & LOEB LLP

By: /s/ Tamara F. Carmichael  
Tamara F. Carmichael  
Jodi R. Sarowitz  
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New York, New York 10154  
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Facsimile: (212) 407-4990

*Attorneys for Opposer  
Home Box Office, Inc.*

**CERTIFICATE OF SERVICE**

I, Angela Provencio, hereby certify that a copy of this **NOTICE OF OPPOSITION** has been served upon:

KEVIN KEENER  
KEENER MCPHAIL SALLES, LLC  
161 N CLARK ST STE 4700  
CHICAGO, ILLINOIS 60601-3201

via first class mail, postage prepaid, and electronic mail on this 27<sup>th</sup> day of November, 2013.

/s/ Angela Provencio

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