

ESTTA Tracking number: **ESTTA648183**

Filing date: **01/05/2015**

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	Take-Two Interactive Software, Inc.
Granted to Date of previous extension	01/04/2015
Address	662 Broadway New York, NY 10012 UNITED STATES

Attorney information	Aryn M. Emert Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES ame@cll.com, jzk@cll.com, mmh@cll.com, las@cll.com, trademark@cll.com Phone:212-790-9200
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Applicant Information

Application No	86205412	Publication date	07/08/2014
Opposition Filing Date	01/05/2015	Opposition Period Ends	01/04/2015
Applicant	The Naked Rockstar LLC 20 Essex Road Elmont, NY 11003 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: On-line retail store services featuring sex toys, sexual aids, educational books in the field of sex, clothing, and videos, all intended for an adult audience; retail store services featuring sex toys, sexual aids, educational books in the field of sex, clothing, and videos all intended for an adult audience

Grounds for Opposition

Other	Please see attached pleading.
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Attachments	ROCKSTAR NAKED - NOO.pdf(57350 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	/Aryn M. Emert/
Name	Aryn M. Emert
Date	01/05/2015

featuring clothing, printed publications, DVDs, toys, music, and games, which are, in part, intended for adults.

2. As set forth in detail below, Opposer, through its affiliated companies, offers such goods and services under trade names, trademarks and service marks comprising or containing the term ROCKSTAR and/or the letter “R” combined with a star design, used alone or with other words or designs (collectively, “Opposer’s ROCKSTAR Marks”). The iteration of Opposer’s ROCKSTAR Marks combining an R and a star design (the “R & Star Design Mark”) denotes and is understood by consumers to stand for the word “Rockstar.”

3. Take-Two is the parent company of the world famous video game developer Rockstar Games, Inc. (“Rockstar”). Rockstar has conducted business under the names and marks ROCKSTAR GAMES and ROCKSTAR since 1998, long prior to any constructive use date claimed in the application herein opposed. Rockstar uses the ROCKSTAR house mark for each of its subsidiary development studios, including Rockstar North, Rockstar London, Rockstar Leeds, Rockstar Lincoln, Rockstar San Diego, Rockstar Toronto and Rockstar New England. Rockstar also uses the ROCKSTAR house mark for numerous products and services, including ROCKSTAR WAREHOUSE (online sales of various goods including clothing), ROCKSTAR PASS (subscription software package), ROCKSTAR GAMES SOCIAL CLUB (online services), ROCKSTAR FILMS (television and movie production), and ROCKSTAR LOFT (entertainment events).

4. Beginning in 1999, Opposer, through its Rockstar subsidiary, has used Opposer’s ROCKSTAR Marks to designate its world famous entertainment software, computer and video games and related products and services. These products marketed in connection with Opposer’s ROCKSTAR Marks include some of the best-selling video games in the world, including the

GRAND THEFT AUTO, RED DEAD, MIDNIGHT CLUB, and MAX PAYNE series of video games. The GRAND THEFT AUTO series of games alone have collectively sold well over 160 million copies, and Rockstar is one of the best recognized and most successful game developers in the world. *Grand Theft Auto V* grossed over \$1 billion in retail sales in only three days after its September 2013 release. As an example of how popular Rockstar is -- and how well known Opposer's ROCKSTAR Marks are -- a Google search for the words ROCKSTAR and GAMES performed on January 5, 2015 resulted in 27,100,000 hits.

5. Since adopting Opposer's ROCKSTAR Marks, Opposer has expanded use of such marks to a broad variety of other products and services, including, without limitation, on-line retail store services; clothing; books; magazines; manuals; guides; periodicals; retail services featuring music; prerecorded video discs; prerecorded digital music files and sound recordings; online streaming of music; music publishing services; animated motion picture films; providing downloadable music, ringtones, graphics, and wallpaper for mobile phones; downloadable image, video and game files; special events and parties; television programs; and websites featuring news, information, tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials.

6. Opposer also operates an online store designated ROCKSTAR WAREHOUSE. Through this store, located at www.rockstarwarehouse.com, Opposer sells and distributes products bearing Opposer's ROCKSTAR Marks, including, clothing, printed publications, DVDs, toys, music, and games, which are, in part, intended for adults.

7. Opposer has continuously and prominently used Opposer's ROCKSTAR Marks since their adoption. Opposer has extensively advertised and promoted Opposer's ROCKSTAR

Marks in connection with the many goods and services described above, and has achieved significant sales, exposure and recognition of the above described goods and services.

8. By virtue of Opposer's longstanding use, advertisement and promotion of Opposer's ROCKSTAR Marks and the goods and services they designate, these marks have developed enormous goodwill in the trade and among consumers and have become famous and associated in the mind of the public with Opposer's well-known products and services.

9. Opposer owns numerous federal trademark registrations and applications for Opposer's ROCKSTAR Marks, including without limitation:

- A. Registration No. 3,956,411 for ROCKSTAR WAREHOUSE and Design for "online retail store services featuring computer games, DVDs, posters, printed publications, bags, toys and apparel, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets, and headgear, namely, hats and caps," which issued on May 10, 2011;
- B. Application No. 78/886,446 for ROCKSTAR WAREHOUSE for "Online retail store services featuring computer games, dvds, and apparel, namely shirts, t-shirts, sweatshirts, casual and leisure jackets; headgear, namely hats and caps," which was filed on May 18, 2006;
- C. Registration No. 2,456,387 for ROCKSTAR GAMES for "computer games software and video game programs," which issued May 29, 2001, and has achieved incontestable status;
- D. Registration No. 2,855,543 for R ROCKSTAR GAMES and Design for "computer game software and video game programs," which issued June 22, 2004, and has achieved incontestable status;
- E. Registration No. 4,037,654 for ROCKSTAR GAMES for "animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; computer and video game software, and related programs and software, namely, screensavers, digital music files, videos, films and other multimedia materials, all featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes, all delivered via pre-recorded discs and other pre-recorded media and via downloadable delivery on global computer networks and wireless networks; pre-recorded discs and other prerecorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary

themes,” and “entertainment services, namely, providing a website featuring use of non-downloadable computer and video games, and news, information, tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials, all non-downloadable and all in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games,” which issued October 11, 2011;

- F. Registration No. 3,956,407 for ROCKSTAR LOFT for “arranging and conducting special events and parties,” which issued on May 10, 2011;
- G. Application No. 85/419,485 for ROCKSTAR STUDIOS for “Computer and video game programs and software; downloadable computer and video game programs and software; downloadable digital materials namely, ring tones, wallpapers, screensavers, digital music files, and graphics, videos, films, multimedia files, animated films in the field of video games and computer games, all delivered via global computer networks and wireless networks; pre-recorded digital media featuring computer games and video games, ring tones, wallpapers, screensavers, digital music files, and graphics, videos, films, multimedia files, animated films in the field of video games and computer games; and pre-recorded video discs and other pre-recorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes” and “printed materials, namely, books, pamphlets, periodicals, magazines, and manuals in the field of video games; posters,” and “clothing, headgear, and footwear” and “entertainment services, namely, providing online games, providing a website featuring nondownloadable computer and video games, and news, information, tips, hints, contests, computer enhancements for games, audiovisual content, music, films, videos, television programs, animation and other multimedia materials in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games; and animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes,” which was filed on September 9, 2011;
- H. Application No. 77/715,935 for the ROCKSTAR and Design Mark for “clothing, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets; headgear, namely, caps,” which was filed on April 17, 2009;
- I. Application No. 77/142,681 for ROCKSTAR for “clothing, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets; headgear, namely, hats and caps,” which was filed on March 28, 2007;
- J. Registration No. 2,391,635 for the R & Star Design Mark for “computer game software and video game programs,” which issued October 3, 2000;

- K. Registration No. 3,351,855 for the R & Star Design Mark for “entertainment software, namely, game discs and downloadable game software for use with personal computers, video game consoles, hand held gaming devices,” which issued December 11, 2007, and has achieved incontestable status;
- L. Registration No. 3,631,311 for the R & Star Design Mark for “men, women and children's clothing, namely, shirts, t-shirts, sweatshirts, casual and leisure jackets; headgear, namely, hats and caps,” which issued June 2, 2009;
- M. Registration No. 3,619,405 for the R & Star Design Mark for “downloadable music, ringtones, graphics, and wallpaper via the Internet and mobile devices” and “on-line retail store services featuring downloadable sound, music, image, video and game files,” which issued May 12, 2009;
- N. Registration No. 3,616,037 for the R & Star Design Mark for “printed matter, namely books, pamphlets, strategy guides and manuals in the field of video games; posters; stickers,” which issued May 5, 2009;
- O. Registration No. 3,695,041 for the R & Star Design Mark for “arranging and conducting special events and parties,” which issued October 13, 2009;
- P. Registration No. 3,843,554 for the R & Star Design Mark for “entertainment services; provision of online entertainment; providing online computer games and online video games; providing information on entertainment in the field of computer games and video games; production of multimedia for entertainment purposes; design and production of computer games, video games and software for entertainment purposes; computer programming services; production and distribution of motion pictures,” which issued September 7, 2010;
- Q. Registration No. 3,950,918 for the R & Star Design Mark for “sound recordings featuring music and digital music downloadable for the internet and wireless devices,” which issued April 26, 2011;
- R. Registration No. 3,992,563 for the R & Star Design Mark for “entertainment services, namely, providing on-line prerecorded nondownloadable, music, films, and movies via a global computer network,” which issued July 12, 2011;
- S. Registration No. 4,034,074 for the R & Star Design Mark for “animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; computer and video game programs and software, and related programs and software, namely, screensavers, digital music files, videos, films and other multimedia materials, all featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes, all delivered via pre-recorded discs and other pre-recorded media and via

downloadable delivery on global computer networks and wireless networks; pre-recorded discs and other pre-recorded digital and electronic media in the field of live action programs, motion pictures, or animation featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes,” and “entertainment services, namely, providing online computer and video games, providing a website featuring use of nondownloadable computer and video games, and news, information, tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials, all non-downloadable and all in the field of computer games and video games; providing information, news and commentary in the field of computer games and video games,” which issued on October 4, 2011.

T. Registration No. 4,216,755 for the R & Star Design Mark for “games, toys, and playthings, namely, dolls, toy action figures and accessories therefor,” which issued on October 2, 2012.

10. The above applications and registrations are valid and subsisting, and are in full force and effect and are owned by Opposer.

11. On February 26, 2014, The Naked Rockstar LLC (“Applicant”) filed Application Serial No. 86/205,412 (the “Application”), on an intent-to-use basis, to register the standard character word mark THE NAKED ROCKSTAR (“Applicant’s Mark”) for “on-line retail store services featuring sex toys, sexual aids, educational books in the field of sex, clothing, and videos, all intended for an adult audience; retail store services featuring sex toys, sexual aids, educational books in the field of sex, clothing, and videos all intended for an adult audience” in International Class 35.

12. Upon information and belief, Applicant did not use Applicant’s Mark in United States commerce in connection with the services covered by the Application prior to its constructive first use date of February 26, 2014.

13. By virtue of Opposer's prior use, promotion of and registrations for Opposer's ROCKSTAR Marks, Opposer has rights in Opposer's ROCKSTAR Marks prior and superior to any alleged rights of Applicant in Applicant's Mark covered by the Application.

14. The services covered by the Application are identical and/or closely related to goods bearing and services offered in connection with Opposer's ROCKSTAR Marks.

15. The use of ROCKSTAR as the dominant element in Applicant's Mark is closely and confusingly similar to the dominant "Rockstar" element of Opposer's ROCKSTAR Marks.

16. Applicant's Mark so resembles Opposer's ROCKSTAR Marks as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would therefore be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

17. Opposer's ROCKSTAR Marks are distinctive and famous and enjoyed such fame well prior to February 26, 2014, Applicant's constructive first use date. Opposer would be further injured by the granting of a certificate of registration for Applicant's Mark, because such mark is likely to dilute the distinctive quality of Opposer's ROCKSTAR Marks through blurring and tarnishment of the distinctive quality of Opposer's ROCKSTAR Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and respectfully requests that its opposition be sustained and that the application for said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Jonathan Z. King, Midge Hyman, Aryn M. Emert and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Dated: New York, New York
January 5, 2015

Respectfully submitted,
COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Aryn M. Emert/

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on January 5, 2015, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney and Correspondent of Record, Stephanie Y. Grenald, 372 Stuyvesant Ave., Apt 1, Brooklyn, New York 11233-1723.

/Aryn M. Emert/
Aryn M. Emert