

ESTTA Tracking number: **ESTTA662495**

Filing date: **03/23/2015**

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	03/22/2015
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

Applicant Information

Application No	86216967	Publication date	09/23/2014
Opposition Filing Date	03/23/2015	Opposition Period Ends	03/22/2015
Applicant	Craig Duswalt International, Inc. 32129 Lindero Cyn Rd, Ste 205 Westlake Village, CA 91361 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2012/08/31 First Use In Commerce: 2012/08/31 All goods and services in the class are opposed, namely: Book publishing; Electronic publishing services, namely, publication of text and graphic works of others on -line and as ebooks featuring business and leadership
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Grounds for Opposition

Other	Please see attached pleading.
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Attachments	NOO - ROCKSTAR PUBLISHING HOUSE.pdf(27176 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	03/23/2015

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

In re Application Serial No. 86/216,967
Filed: March 10, 2014
For Mark: ROCKSTAR PUBLISHING HOUSE
Published in the Official Gazette: September 23, 2014
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TAKE-TWO INTERACTIVE SOFTWARE, INC., :
Opposer, :

v. :

CRAIG DUSWALT INTERNATIONAL, INC., :
Applicant. :

Opposition No.

NOTICE OF OPPOSITION

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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

TAKE-TWO INTERACTIVE SOFTWARE, INC. (“Take-Two” or “Opposer”), a Delaware corporation with a business address at 622 Broadway, New York, New York 10012, believes it will be damaged by registration of the mark ROCKSTAR PUBLISHING HOUSE, shown in Application Serial No. 86/216,967, for “Book publishing; Electronic publishing services, namely, publication of text and graphic works of others on-line and as ebooks featuring business and leadership” in International Class 41, and having been granted extensions of time to oppose up to and including March 22, 2015, hereby opposes the same.

As grounds of opposition, Take-Two alleges as follows:

1. Take-Two is a leading worldwide publisher, developer and distributor of interactive entertainment software, and accessories, including video and computer games and online interactive video games, interactive video and online entertainment services, and related accessories, products and services.

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 FILMS (television and movie production), ROCKSTAR LOFT (entertainment events), ROCKSTAR WAREHOUSE (online sales of various goods including clothing), ROCKSTAR PASS (subscription software package), and ROCKSTAR GAMES SOCIAL CLUB (online services).

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 125

million copies, and Rockstar is one of the best recognized and most successful game developers in the world. 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 March 19, 2015 resulted in 28,600,000 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, paper goods and printed matter, such as graphic novels and other books. Certain of Opposer's ROCKSTAR Marks are prominently displayed on the covers of such graphic novels and books.

6. Opposer also uses Opposer's ROCKSTAR Marks for: music publishing services; magazines; manuals; guides; periodicals; books; animated motion picture films; prerecorded video discs; prerecorded digital music files and sound recordings; retail services featuring music; online streaming of music; providing downloadable music, ringtones, graphics, and wallpaper for mobile phones; on-line retail store services; 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.

7. Opposer also operates an online store designated ROCKSTAR WAREHOUSE. Through this store, located at www.rockstarwarehouse.com, Opposer sells and distributes promotional products bearing Opposer's ROCKSTAR Marks, including, printed publications, such as graphic novels.

8. 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.

9. 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.

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

- A. Application No. 77/669,436 for ROCKSTAR TV for "providing an on-line forum for transmission of messages among computer users concerning computer games, video games, non-downloadable software, and multimedia content" and "entertainment services, namely, providing online games, providing a website featuring computer games and video games, and news, information, tips, hints, contests, computer interface themes, enhancements, audio-visual content, music, films, videos, television programs, animated series, 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; providing digital video, audio and multimedia entertainment publishing services via the Internet and other communication and wireless networks; entertainment services in the form of providing a series of animated television programs featuring comedy," which was filed on February 12, 2009;
- B. Application No. 85/538,456 for ROCKSTAR TV for "Computer game programs and software; animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; 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," which was filed on February 9, 2012;
- C. 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;

- D. 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;
- E. 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;
- F. 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;
- G. 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;
- H. 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;

- I. Registration No. 3,956,407 for ROCKSTAR LOFT for “arranging and conducting special events and parties,” which issued on May 10, 2011;
- J. 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;
- K. 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;
- L. Registration No. 2,391,635 for the R & Star Design Mark for “computer game software and video game programs,” which issued October 3, 2000;
- M. 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;
- N. 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;
- O. 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;
- P. 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;
- Q. Registration No. 3,695,041 for the R & Star Design Mark for “arranging and conducting special events and parties,” which issued October 13, 2009;
- R. 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;
- S. 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;

- T. 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;
- U. 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.
- V. 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.

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

12. On March 10, 2014, Craig Duswalt International, Inc. (“Applicant”) filed Application Serial No. 86/216,967 (the “Application”), to register the standard character word mark ROCKSTAR PUBLISHING HOUSE (“Applicant’s Mark”) for “Book publishing; Electronic publishing services, namely, publication of text and graphic works of others on -line and as ebooks featuring business and leadership” in International Class 41, claiming a first use date of August 31, 2012.

13. 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 claimed first use date of August 31, 2012.

14. By virtue of Opposer's prior use and 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.

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

16. Applicant's Mark consists of the word ROCKSTAR followed by the words PUBLISHING HOUSE, which are descriptive of Applicant's applied-for services, and thus disclaimed in the Application, making ROCKSTAR the dominant feature of Applicant's Mark.

17. The word ROCKSTAR in Applicant's Mark is identical to certain of Opposer's ROCKSTAR Marks.

18. 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.

19. Opposer's ROCKSTAR Marks are distinctive and famous and enjoyed such fame well prior to August 31, 2012, Applicant's claimed 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 and impair the distinctiveness 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 and 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
March 23, 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 March 23, 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 and Correspondent of Record, Craig Duswalt International, Inc., 32129 Lindero Canyon Rd., Ste. 205, Westlake Village, California 91361, Attention: Craig Duswalt.

/Aryn M. Emert/
Aryn M. Emert