

ESTTA Tracking number: **ESTTA732376**

Filing date: **03/09/2016**

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	Vice Media Canada Inc.
Granted to Date of previous extension	03/09/2016
Address	127 B KING STREET Montreal, Quebec, H3C2P2 CANADA

Attorney information	Kimberly B. Herman SULLIVAN & WORCESTER LLP One Post Office Square Boston, MA 02109 UNITED STATES kherman@sandw.com, trademark@sandw.com, mpalmisciano@sandw.com, lrobins@sandw.com Phone:617-338-2943
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Applicant Information

Application No	86490497	Publication date	11/10/2015
Opposition Filing Date	03/09/2016	Opposition Period Ends	03/09/2016
Applicant	Morales, Christopher 12428 Maidstone Ave Norwalk, CA 90650 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 041. First Use: 2012/09/15 First Use In Commerce: 2012/09/15 All goods and services in the class are opposed, namely: Entertainment services in the nature of live audio performances by a rock music group; Entertainment services in the nature of live musical performances; Entertainment services in the nature of live visual and audio performances by a rock music group; Entertainment services in the nature of live visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; Entertainment services in the nature of presenting live musical performances; Entertainment, namely, live music concerts; Entertainment, namely, live performances by rock groups; Live performances by a musical group; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Music composition services; Music production services; Music publishing services; Organization of exhibitions for musical entertainment; Production of musical sound recording; Theatrical and musical floor shows provided at performance venues</p>
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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.	3612483	Application Date	06/08/2006
Registration Date	04/28/2009	Foreign Priority Date	NONE
Word Mark	VICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2002/10/22 First Use In Commerce: 2002/10/22 Film production and distribution; provision of entertainment in the nature of concerts, performances, and literary readings; nightclub services; organizing community sporting and cultural events; cultural activities, namely, concerts, performances, and literary readings; provision of information relating to entertainment; organization of quizzes and games; organization of entertainment events, competitions, and recreational and cultural activities in the nature of concerts, performances, and literary readings; all the aforesaid services also provided on-line from a computer database or from the Internet; information services provided on-line from a computer database or from the Internet relating to popular culture, namely, music, fashion shows, social commentary, film and television</p>		

U.S. Registration No.	4662675	Application Date	04/29/2014
Registration Date	12/30/2014	Foreign Priority Date	NONE
Word Mark	VICE		
Design Mark			
Description of Mark	The mark consists of "VICE" in stylized form.		
Goods/Services	Class 041. First use: First Use: 1996/01/00 First Use In Commerce: 2002/10/22		

	Film production and distribution; provision of entertainment in the nature of concerts, performances, and literary readings; nightclub services; organizing community sporting and cultural events; cultural activities, namely, concerts, performances, and literary readings; provision of information relating to entertainment; organization of quizzes and games; organization of entertainment events, competitions, and recreational and cultural activities in the nature of concerts, performances, and literary readings; allthe aforesaid services also provided on-line from a computer database or from the Internet; information services provided on-line from a computer database or from the Internet relating to popular culture, namely, music, fashion shows, social commentary, film and television
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Attachments	78903841#TMSN.png(bytes) 86264863#TMSN.png(bytes) VICEVERSAOpposition.pdf(1098105 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	/Kimberly B. Herman/
Name	Kimberly B. Herman
Date	03/09/2016

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

VICE MEDIA CANADA, INC.)
)
Opposer,)
)
v.)
)
CHRISTOPHER MORALES,)
)
Applicant.)
)

Applicant Serial No.: 86/490,497
Filed: December 24, 2014
Published for Opposition: November 10, 2015
Mark: VICEVERSA

NOTICE OF OPPOSITION

Opposer, Vice Media Canada, Inc. (“Opposer”), a Canadian corporation, having a principal place of business at 127B King Street, Montreal, Quebec, Canada H3C 2P2, believes that it is being damaged, and will be damaged, by Christopher Morales’ (“Applicant”) registration of the mark VICEVERSA shown in Application Serial No. 86/490,497, and hereby opposes the same. As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to Opposer and its own acts, and upon information and belief as to other matters:

Opposer and Its VICE Mark and VICE MEDIA Mark and Trade Name

1. Opposer is a leading global media firm. In connection with its online and broadcast offerings, Opposer provides, *inter alia*, information and programming on music and various other types of entertainment activities. In addition to its media ventures, Opposer organizes, presents, and promotes various entertainment and cultural events including, but not

limited to, live musical performances, live audio and visual performances and other performances, all under its VICE trademark.

2. Since at least as early as October 22, 2002, Opposer has (i) used its VICE mark to offer and promote its various services, and (ii) spent substantial time and resources in promoting its services under its VICE mark.

3. Opposer owns, *inter alia*, the following United States trademark registrations for its VICE marks (printouts from the PTO TESS/TARR databases are attached as Exhibit A):

Mark	Registration Number Registration Date	Class
VICE	3,612,483 04/28/09	Class 41
VICE LOGO	4,662,675 12/30/14	Class 41

4. The foregoing registrations are valid and subsisting, constitute prima facie evidence of Opposer's ownership of, and exclusive rights to use, its VICE mark in commerce in connection with the services recited in the registrations, and, in the case of Registration No. 3,612,483, is incontestable.

5. Opposer's rights to its VICE mark long predate Applicant's claimed first use date of September 15, 2012 and its filing date of December 24, 2014. Opposer has used its VICE mark continuously in commerce since long prior to Applicant's filing date.

6. Through use of its VICE mark in the United States in connection with services highly related to those of Applicant over the last 14 years, Opposer has established extremely valuable goodwill and recognition in its mark by virtue of its quality services offered thereunder.

Applicant and Its VICEVERSA Mark

7. Applicant is identified as an individual residing at 12428 Maidstone Avenue, Norwalk, CA 90650.

8. On December 24, 2014, Applicant filed Application Serial No. 86/490,497 to register the mark VICEVERSA for “entertainment services in the nature of live audio performances by a rock music group; entertainment services in the nature of live musical performances; entertainment services in the nature of live visual and audio performances by a rock music group; entertainment services in the nature of live visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; entertainment services in the nature of presenting live musical performances; entertainment, namely, live music concerts; entertainment, namely, live performances by rock groups; live performances by a musical group; multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; music composition services; music production services; music publishing services; organization of exhibitions for musical entertainment; production of musical sound recording; theatrical and musical floor shows provided at performance venues” in Class 41. The services listed in the application are identical, substantially similar and/or closely related to services Opposer offers under its VICE mark, as reflected in Registration Nos. 3,612,483 and 4,662,675.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

9. Opposer repeats and alleges each and every allegation set forth in Paragraphs 1 through 8 above.

10. Opposer has used its VICE mark continuously in commerce since prior to the filing date of the opposed application.

11. Opposer’s Registration No. 3,612,483 issued prior to the filing date of the opposed application.

12. Applicant's VICEVERSA mark is confusingly similar in sound, appearance, connotation, and overall commercial impression to Opposer's VICE mark and covers services identical, substantially similar, and/or closely related to those offered by Opposer under its mark.

13. Applicant's VICEVERSA mark so resembles Opposer's previously used and registered VICE mark as to be likely, when used in connection with Applicant's services covered by Application Serial No. 86/490,497, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it is being damaged, and will be damaged, by the registration of the mark shown in Application Serial No. 86/490,497, requests that the opposition to the application be sustained, and that registration to Applicant be refused.

A filing has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 500751.

Respectfully submitted,

VICE MEDIA CANADA, INC.

By its attorneys,

Dated: March 9, 2016

/Kimberly B. Herman/

Kimberly B. Herman

kherman@sandw.com

SULLIVAN & WORCESTER LLP

One Post Office Square

Boston, MA 02109

Tel: (617) 338-2800

Fax: (617) 338-2880

Attorneys for Opposer

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Notice of Opposition is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 9th day of March, 2016.

/Kimberly B. Herman/ _____

Kimberly B. Herman

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing Notice of Opposition was served by first class mail, postage prepaid, on this 9th day of March, 2016, on Applicant at the following address of record listed below:

Harry Finkel
Harry Finkel Law
5042 Wilshire Blvd., #26291
Los Angeles, CA 90048

/Kimberly B. Herman/ _____

Kimberly B. Herman

EXHIBIT A

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 3,612,483

United States Patent and Trademark Office

Registered Apr. 28, 2009

**SERVICE MARK
PRINCIPAL REGISTER**

VICE

VICE MAGAZINE PUBLISHING INC. (CANADA CORPORATION)
SUITE 500
24, MONT-ROYAL STREET WEST
MONTREAL, CANADA H2T 2S2

FOR: FILM PRODUCTION AND DISTRIBUTION; PROVISION OF ENTERTAINMENT IN THE NATURE OF CONCERTS, PERFORMANCES, AND LITERARY READINGS; NIGHTCLUB SERVICES; ORGANIZING COMMUNITY SPORTING AND CULTURAL EVENTS; CULTURAL ACTIVITIES, NAMELY, CONCERTS, PERFORMANCES, AND LITERARY READINGS; PROVISION OF INFORMATION RELATING TO ENTERTAINMENT; ORGANIZATION OF QUIZZES AND GAMES; ORGANIZATION OF ENTERTAINMENT EVENTS, COMPETITIONS, AND RECREATIONAL AND CULTURAL ACTIVITIES IN THE NATURE OF CONCERTS, PERFORMANCES, AND LITERARY READINGS; ALL THE AFORESAID SERVICES

ALSO PROVIDED ON-LINE FROM A COMPUTER DATABASE OR FROM THE INTERNET; INFORMATION SERVICES PROVIDED ON-LINE FROM A COMPUTER DATABASE OR FROM THE INTERNET RELATING TO POPULAR CULTURE, NAMELY, MUSIC, FASHION SHOWS, SOCIAL COMMENTARY, FILM AND TELEVISION, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-22-2002; IN COMMERCE 10-22-2002.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,312,005.

SER. NO. 78-903,841, FILED 6-8-2006.

LINDA ORNDORFF, EXAMINING ATTORNEY



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VICE

Word Mark VICE
Goods and Services IC 041. US 100 101 107. G & S: Film production and distribution; provision of entertainment in the nature of concerts, performances, and literary readings; nightclub services; organizing community sporting and cultural events; cultural activities, namely, concerts, performances, and literary readings; provision of information relating to entertainment; organization of quizzes and games; organization of entertainment events, competitions, and recreational and cultural activities in the nature of concerts, performances, and literary readings; all the aforesaid services also provided on-line from a computer database or from the Internet; information services provided on-line from a computer database or from the Internet relating to popular culture, namely, music, fashion shows, social commentary, film and television. FIRST USE: 20021022. FIRST USE IN COMMERCE: 20021022

Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 78903841
Filing Date June 8, 2006
Current Basis 1A
Original Filing Basis 1B
Published for Opposition February 10, 2009
Registration Number 3612483

Registration Date April 28, 2009

Owner (REGISTRANT) Vice Magazine Publishing Inc. CORPORATION CANADA Suite 500 24, Mont-Royal Street West Montreal CANADA H2T 2S2

(LAST LISTED OWNER) VICE MEDIA CANADA INC. CORPORATION CANADA 127 B KING STREET MONTREAL, QUEBEC CANADA H3C 2P2

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Kimberly B. Herman

Prior Registrations 2312005

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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United States of America

United States Patent and Trademark Office



Reg. No. 4,662,675

VICE MEDIA CANADA INC. (CANADA CORPORATION)
127 B KING STREET

Registered Dec. 30, 2014

MONTREAL, QUEBEC, CANADA H3C2P2

Int. Cl.: 41

SERVICE MARK

PRINCIPAL REGISTER

FOR: FILM PRODUCTION AND DISTRIBUTION; PROVISION OF ENTERTAINMENT IN THE NATURE OF CONCERTS, PERFORMANCES, AND LITERARY READINGS; NIGHTCLUB SERVICES; ORGANIZING COMMUNITY SPORTING AND CULTURAL EVENTS; CULTURAL ACTIVITIES, NAMELY, CONCERTS, PERFORMANCES, AND LITERARY READINGS; PROVISION OF INFORMATION RELATING TO ENTERTAINMENT; ORGANIZATION OF QUIZZES AND GAMES; ORGANIZATION OF ENTERTAINMENT EVENTS, COMPETITIONS, AND RECREATIONAL AND CULTURAL ACTIVITIES IN THE NATURE OF CONCERTS, PERFORMANCES, AND LITERARY READINGS; ALL THE AFORESAID SERVICES ALSO PROVIDED ON-LINE FROM A COMPUTER DATABASE OR FROM THE INTERNET; INFORMATION SERVICES PROVIDED ON-LINE FROM A COMPUTER DATABASE OR FROM THE INTERNET RELATING TO POPULAR CULTURE, NAMELY, MUSIC, FASHION SHOWS, SOCIAL COMMENTARY, FILM AND TELEVISION, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 1-0-1996; IN COMMERCE 10-22-2002.

OWNER OF U.S. REG. NOS. 2,312,005, 3,339,714 AND OTHERS.

THE MARK CONSISTS OF "VICE" IN STYLIZED FORM.

SER. NO. 86-264,863, FILED 4-29-2014.

SAMUEL PAQUIN, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
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Word Mark VICE
Goods and Services IC 041. US 100 101 107. G & S: Film production and distribution; provision of entertainment in the nature of concerts, performances, and literary readings; nightclub services; organizing community sporting and cultural events; cultural activities, namely, concerts, performances, and literary readings; provision of information relating to entertainment; organization of quizzes and games; organization of entertainment events, competitions, and recreational and cultural activities in the nature of concerts, performances, and literary readings; all the aforesaid services also provided on-line from a computer database or from the Internet; information services provided on-line from a computer database or from the Internet relating to popular culture, namely, music, fashion shows, social commentary, film and television. FIRST USE: 19960100. FIRST USE IN COMMERCE: 20021022
Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number 86264863
Filing Date April 29, 2014
Current Basis 1A
Original Filing Basis 1A
Published for Opposition October 14, 2014
Registration Number 4662675
Registration Date December 30, 2014
Owner

(REGISTRANT) **Vice Media** Canada Inc. CORPORATION CANADA 127 B KING STREET
 Montreal, Quebec CANADA H3C2P2

Attorney of Record Kimberly B. Herman

Prior Registrations 2312005;3324340;3339714;AND OTHERS

Description of Mark Color is not claimed as a feature of the mark. The mark consists of "VICE" in stylized form.

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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