

ESTTA Tracking number: **ESTTA736564**

Filing date: **03/29/2016**

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	HRHH IP, LLC
Granted to Date of previous extension	04/02/2016
Address	200 Vesey Street, 11th Floor Three World Financial Center New York, NY 10281-1021 UNITED STATES

Attorney information	Jill M. Pietrini, Esq. Sheppard Mullin Richter & Hampton LLP 1901 Avenue of the Stars, Suite 1600 Los Angeles, CA 90067 UNITED STATES jpietrini@smrh.com, baigboboh@smrh.com, ppost@smrh.com, shwang@smrh.com, mdanner@smrh.com, rwalsh@smrh.com, lmartin@smrh.com Phone:310-228-3700
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Applicant Information

Application No	86693218	Publication date	02/02/2016
Opposition Filing Date	03/29/2016	Opposition Period Ends	04/02/2016
Applicant	Home Box Office, Inc. 1100 Avenue of the Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 015. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: musical instruments; musical instrument accessories, namely, stands, drumsticks, cases, carrying bags; guitar straps; guitar picks

Applicant Information

Application No	86693224	Publication date	02/09/2016
Opposition Filing Date	03/29/2016	Opposition Period Ends	
Applicant	Home Box Office, Inc. 1100 Avenue of the Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. First Use: 0 First Use In Commerce: 0
 All goods and services in the class are opposed, namely: Jewelry; clocks and watches; key chains of precious metal; trinkets in the nature of jewelry charms and rings of precious metals, semi-precious metals or imitation precious metals; ornamental lapel pins

Applicant Information

Application No	86693229	Publication date	02/09/2016
Opposition Filing Date	03/29/2016	Opposition Period Ends	
Applicant	Home Box Office, Inc. 1100 Avenue of the Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0
 All goods and services in the class are opposed, namely: headphones, earphones, ear buds; magnets; computer game cartridges and discs

Applicant Information

Application No	86693234	Publication date	02/02/2016
Opposition Filing Date	03/29/2016	Opposition Period Ends	
Applicant	Home Box Office, Inc. 1100 Avenue of the Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0
 All goods and services in the class are opposed, namely: Entertainment services, namely, providing online video games; online virtual reality games and interactive multiplayer computer games played via computer networks; providing on-line, non-downloadable virtual goods, namely, food and beverage products, clothing, real estate, musical instruments and vehicles, for use in virtual environments on social networking sites

Applicant Information

Application No	86709489	Publication date	12/01/2015
Opposition Filing Date	03/29/2016	Opposition Period Ends	
Applicant	Home Box Office, Inc. 1100 Avenue of the Americas New York, NY 10036 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0
 All goods and services in the class are opposed, namely: Entertainment services in the nature of an ongoing dramatic television series; interactive online entertainment in the nature of a website containing photographic, video and prose presentations and video clips featuring content from or related to a dramatic television series

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4897331	Application Date	12/06/2014
Registration Date	02/09/2016	Foreign Priority Date	NONE
Word Mark	VINYL LAS VEGAS		
Design Mark			
Description of Mark	The mark consists of "VINYL LAS VEGAS" within the shape of a circle.		
Goods/Services	Class 041. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services		

U.S. Registration No.	4897330	Application Date	12/06/2014
Registration Date	02/09/2016	Foreign Priority Date	NONE
Word Mark	VINYL		

Design Mark	VINYL
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services

U.S. Registration No.	4891535	Application Date	12/06/2014
Registration Date	01/26/2016	Foreign Priority Date	NONE

Word Mark	VINYL LAS VEGAS
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Design Mark	
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Description of Mark	The mark consists of "VINYL LAS VEGAS" within the shape of a circle.
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Goods/Services	Class 035. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Promoting, marketing, and advertising live musical performances and theatrical performances of others
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Attachments	86473375#TMSN.png(bytes) 86473372#TMSN.png(bytes) 86473374#TMSN.png(bytes) HBO Notice of Opposition.pdf(823225 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	/Jill M. Pietrini/
Name	Jill M. Pietrini, Esq.
Date	03/29/2016

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

<p><i>In re Matter of Application Nos. 86/693,218, 86/693,224, 86/693,229, 86/693,234 and 86/709,489 for the mark: VINYL in Classes 9, 14, 15, and 41</i></p> <p>HRHH IP, LLC</p> <p>Opposer,</p> <p>vs.</p> <p>Home Box Office, Inc.,</p> <p>Applicant.</p>	<p>Opposition No. _____</p> <p>CONSOLIDATED NOTICE OF OPPOSITION</p>
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Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Commissioner:

Opposer, HRHH IP, LLC, a Delaware limited liability company, having its principal place of business at Three World Financial Center, 200 Vesey Street, 11th Floor, New York, New York 10281-1021 (“Opposer”), believes that it will be harmed by the registration of the mark VINYL, as shown in U.S. Application Serial Nos. 86/693,218, 86/693,224, 86/693,229, 86/693,234 and 86/709,489, in Classes 9, 14, 15, 41 and 41 (collectively, the “Applications”), and hereby opposes its registration on the following grounds:

FACTUAL BACKGROUND REGARDING OPPOSER’S VINYL MARKS

1. Opposer is the entity responsible for operating the highly-successful live performance venue Vinyl Las Vegas at the Hard Rock Hotel & Casino Las Vegas in Las Vegas,

Nevada. Attached hereto as **Exhibit A** are true and correct printouts from Opposer’s website at the domain <www.hardrockhotel.com> about Opposer and Vinyl Las Vegas.

2. Opposer uses the marks VINYL and VINYL & Design (the “VINYL Marks”) for Promoting, marketing, and advertising live musical performances and theatrical performances of others; Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services; and Bar services; restaurant services; providing general purpose facilities for concerts, comedy shows, expositions, and other events and functions. Opposer’s VINYL & Design mark is shown below:



3. Opposer first used the VINYL Marks for entertainment, restaurant, bar and related services as early as August 2012. Since then, Opposer has continuously used the VINYL Marks for its various entertainment and related services. Opposer’s Vinyl Las Vegas has hosted performances by up-and-coming and established national and international entertainers, and other entertainment-related events including award shows. Opposer offers tickets to live events held at Vinyl Las Vegas, including musical performances, through its website and at its box office. Opposer advertises and markets Vinyl Las Vegas and the VINYL Marks extensively including, but not limited to, through its social media accounts available through Facebook, Twitter, and Instagram. Vinyl Las Vegas has received considerable media attention. As such, Opposer has developed common law rights in the VINYL Marks which predate the Applications.

FACTUAL BACKGROUND REGARDING THE APPLICATIONS

4. On July 15, 2015, Applicant Home Box Office, Inc., a Delaware corporation, having an address of 1100 Avenue of the Americas, New York, New York 10036 (“Applicant”) filed the Application Serial No. 86/693,229 seeking registration, on an intent-to-use basis, of VINYL for “headphones, earphones, ear buds; magnets; computer game cartridges and discs” in Class 9 (the “‘229 Application”).

5. The ‘229 Application was published for opposition in the Official Gazette on February 9, 2016. Opposer was granted an extension of time to oppose the ‘229 Application.

6. On July 15, 2015, Applicant filed the Application Serial No. 86/693,224 seeking registration, on an intent-to-use basis, of VINYL for “jewelry; clocks and watches; key chains of precious metal; trinkets in the nature of jewelry charms and rings of precious metals, semi-precious metals or imitation precious metals; ornamental lapel pins” in Class 14 (the “‘224 Application”).

7. The ‘224 Application was published for opposition in the Official Gazette on February 9, 2016. Opposer was granted an extension of time to oppose the ‘224 Application.

8. On July 15, 2015, Applicant filed the Application Serial No. 86/693,218 seeking registration, on an intent-to-use basis, of VINYL for “musical instruments; musical instrument accessories, namely, stands, drumsticks, cases, carrying bags; guitar straps; guitar picks” in Class 15 (the “‘218 Application”).

9. The ‘218 Application was published for opposition in the Official Gazette on February 2, 2016. Opposer was granted an extension of time to oppose the ‘218 Application.

10. On July 15, 2015, Applicant filed the Application Serial No. 86/693,234 seeking registration, on an intent-to-use basis, of VINYL for “entertainment services, namely, providing online video games; online virtual reality games and interactive multiplayer computer games played via computer networks; providing on-line, non-downloadable virtual goods, namely, food and beverage products, clothing, real estate, musical instruments and vehicles, for use in virtual environments on social networking sites” in Class 41 (the “‘234 Application”).

11. The '218 Application was published for opposition in the Official Gazette on February 2, 2016. Opposer was granted an extension of time to oppose the '234 Application.

12. On July 30, 2015, Applicant filed the Application Serial No. 86/709,489 seeking registration, on an intent-to-use basis, of VINYL for "entertainment services in the nature of an ongoing dramatic television series; interactive online entertainment in the nature of a website containing photographic, video and prose presentations and video clips featuring content from or related to a dramatic television series" in Class 41 (the "'489 Application").

13. The '489 Application was published for opposition in the Official Gazette on December 1, 2015. Opposer was granted extensions of time to oppose the '489 Application.

FIRST GROUND – LIKELIHOOD OF CONFUSION

14. Opposer incorporates the allegations contained in Paragraphs 1 to 13 herein.

15. Applicant's proposed mark VINYL is confusingly similar to Opposer's VINYL Marks.

16. Applicant's mark is likely to cause confusion, mistake, or deception as to the source, origin, affiliation, association, connection, or sponsorship of Applicant's goods and services offered or to be offered under the VINYL mark with Opposer's VINYL Marks, Vinyl Las Vegas, the Hard Rock Hotel & Casino Las Vegas, and/or with Opposer or Opposer's activities.

SECOND GROUND – LIKELIHOOD OF DILUTION

17. Opposer incorporates the allegations contained in Paragraphs 1 to 16 herein.

18. Opposer's VINYL Marks are inherently distinctive and have acquired secondary meaning and are associated with Opposer and the services offered under the VINYL Marks. The VINYL Marks are famous within the meaning of the Federal Trademark Dilution Act. Applicant filed the Applications after Opposer's VINYL Marks had become famous, and Applicant seeks to or does commercially use the applied-for mark VINYL.

19. Applicant's mark is likely to cause dilution of Opposer's VINYL Marks and blur the distinctiveness of Opposer's VINYL Marks.

DAMAGE TO OPPOSER

20. As a result of all of the foregoing, the maturation of the Applications into registrations would cause a likelihood of confusion, mistake, or deception with Opposer and Opposer's VINYL Marks, a likelihood of association, connection or affiliation with Opposer, the services offered by Opposer under the VINYL Marks, or as to the origin, sponsorship or approval by Opposer of Applicant's products or services or commercial activities, and a likelihood of dilution of, Opposer's VINYL Marks.

21. Opposer would be damaged by the registration of the mark shown in the Applications in that such registrations would give Applicant a *prima facie* exclusive right to the use of VINYL, despite the likelihood of confusion, mistake, or deception with Opposer and Opposer's VINYL Marks, and likelihood of dilution described above.

PRAYER

WHEREFORE, Opposer prays that this Opposition be sustained in favor of Opposer, that the Applications be rejected, and that registration of the Applications be refused.

Please charge the requisite \$1,500 opposition filing fee and any additional amounts to Deposit Account No. 50-5691. A duplicate copy of this Consolidated Notice of Opposition is enclosed for this purpose.

Respectfully submitted,

Dated: March 29, 2016

/Jill M. Pietrini/
Jill M. Pietrini
Benjamin O. Aigboboh
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

Attorneys for Opposer HRHH IP, LLC

CERTIFICATE OF SERVICE

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

Judith McCool
Home Box Office, Inc.
1100 Avenue of the Americas
New York, New York 10036-6712

on this 29th day of March, 2016.

/LaTrina A. Martin/
LaTrina A. Martin

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board, through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 29th day of March, 2016.

/LaTrina A. Martin/
LaTrina A. Martin

SMRH:476083119.2

Exhibit A



BACKSTAGE PASS

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LAS VEGAS

STAY DINE ENTERTAINMENT GAME PARTY RELAX SHOP BACKSTAGE PASS EVENTS BLOG MEETINGS DESTINATIONS



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VINYL

SMALL VENUE, BIG TALENT.

STOP BY OUR BOX OFFICE WITH YOUR NEVADA ID FOR NO SERVICE FEES ON ALL VINYL SHOWS!

Vinyl Photos

(Click to see larger photos)



See more images

Events



The Sword w/ Royal Thunder
Vinyl | Doors 8:00 P.M. | Ages 6 +
March 22, 2016 at

BUY TICKETS



Monster Energy Outbreak Tour
2016 Presents: Issues w/ Crown
The Empire, One OK Rock, Night
Verses
Vinyl | Doors 6:00 P.M. | Ages 6+
March 23, 2016 at

BUY TICKETS



Brumby w/ Jill & Julia, John Allred
Vinyl | 7:00 P.M. | Ages 6+
March 25, 2016 at

BUY TICKETS



Masters of Puppets; World
Famous Metallica Tribute w/
Desire the Fire
Vinyl | Doors 9:00 P.M. | Ages 6+
March 26, 2016 at

BUY TICKETS



The Black Lillies w/ Seth Turner &
The High Desert Drifters
Vinyl | Doors 8:00 P.M. | Ages 6 +
March 29, 2016 at

BUY TICKETS

ALL EVENTS AT VINYL

Meetings & Private Events

Specials



Vinyl Las Vegas on Instagram

Stay In Tune

Sign up to be the first to find out about upcoming shows and special offers at Vinyl from Hard Rock Hotel & Casino Las Vegas.

* First Name

First Name [input]

* Last Name

Last Name [input]

* Email

Email [input]

Entertainment Preferences:

- Alternative/Indie
- Rock
- Country
- Pop
- Comedy Shows
- Boxing/MMA
- Classic Rock
- Latin Performers
- Reggae
- Punk
- Heavy Metal
- Rap/Hip hop
- EDM

SUBMIT

Box Office Hours

10:00 am to 8:00 pm Daily
Closed the 15th of each month from 1pm
to 2pm
Tel: [702.693.5000](tel:702.693.5000) ext. 6914

Contact

4455 Paradise Road
Las Vegas, NV 89169
Box Office: [702.693.5000](tel:702.693.5000) ext 6914
Send us an email: mvlp@hrtlvegas.com

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Keyword From To

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Tuesday Mar 22, 2016



The Sword w/ Royal Thunder
VINYL | DOORS 8:00 P.M. | AGES 6+

BUY TICKETS

VIEW ALL
UPCOMING
CONCERTS

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Wednesday Mar 23, 2016



Monster Energy Outbreak Tour 2016
Presents: Issues w/ Crown The Empire, One
OK Rock, Night Verses
VINYL | DOORS 6:00 P.M. | AGES 6+

BUY TICKETS

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Friday Mar 25, 2016



Brumby w/ Jill & Julia, John Allred
VINYL | 7:00 P.M. | AGES 6+

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CONCERTS

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Saturday Mar 26, 2016



Masters of Puppets: World Famous Metallica
Tribute w/ Desire the Fire
VINYL | DOORS 9:00 P.M. | AGES 6+

BUY TICKETS

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Tuesday Mar 29, 2016



The Black Lillies w/ Seth Turner & The High Desert Drifters
VINYL | DOORS 8:00 P.M. | AGES 6 +

BUY TICKETS

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Saturday Apr 02, 2016



Bag Raiders w/ Plastic Plates
VINYL | DOORS 8:00 P.M. | MUST BE 18+ W/ VALID ID

BUY TICKETS

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Tuesday Apr 05, 2016



WHK presents The Tuesday Blend
VINYL | DOORS 10:30 P.M. | 18+ WITH VALID ID



TICKETS FOR APRIL 5

TICKETS FOR MAY 3

TICKETS FOR JUNE 7

[View Event Details](#)
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Wednesday Apr 06, 2016



Las Vegas Jam Band Society presents Dead Winter Carpenters
VINYL | NO COVER | DOORS 8:00 P.M. | AGES 6+

NO COVER

[View Event Details](#)
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Friday Apr 08, 2016



OTEP w/ Lacey Sturm, September Mourning, Doll Skin
VINYL | DOORS 7:00 P.M. | AGES 6 +

BUY TICKETS

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Saturday Apr 09, 2016



Olate Dogs - Winners of America's Got Talent
VINYL | DOORS 7:00 P.M. | AGES 6+

BUY TICKETS

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Wednesday Apr 20, 2016



Enter Shikari w/ Hands Like Houses, The White Noise

VINYL | DOORS 6:30 P.M. | AGES 6+



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Monday Apr 25, 2016



Mondays Dark with Mark Shunock

VINYL | DOORS 8:30 PM | AGES 6+



[Visit Official Website](#)

BUY TICKETS

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[View Event Details](#)
[View](#)

Wednesday Apr 27, 2016



DevilDriver w/ Holy Grail, Incite, Hemlock

VINYL | DOORS 8:00 P.M. | AGES 6+

BUY TICKETS

VIEW ALL UPCOMING CONCERTS

[View Event Details](#)
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Saturday Apr 30, 2016



Tumpike Troubadours w/special guests

Jason Boland & the Stragglers

VINYL | DOORS 8:00 P.M. | AGES 6+

BUY TICKETS

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