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

Proceeding	91227108
Party	Defendant Home Box Office, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

***In the Matter of U.S. Trademark App. Nos. 86693218, 86693224, 86693229, 86693234,
86709489 re: VINYL***

HRHH IP, LLC,)	
)	
Opposer,)	Opposition No. 91227108
)	
v.)	
)	
Home Box Office, Inc.,)	
Applicant.)	

**HOME BOX OFFICE, INC.'S ANSWER
AND AFFIRMATIVE DEFENSES**

Applicant, Home Box Office, Inc. (“HBO”), by their attorneys, Olshan Frome Wolosky LLP, hereby answer the Consolidated Notice of Opposition herein, filed on March 29, 2016 (the “Opposition”), and plead their affirmative defenses thereto, as follows:

FACTUAL BACKGROUND REGARDING OPPOSER’S VINYL MARKS

1. **Paragraph 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, 2 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.”

ANSWER: Without knowledge, therefore denied.

2. **Paragraph 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:”



ANSWER: Without knowledge, therefore denied.

3. **Paragraph 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.”

ANSWER: Without knowledge, therefore denied.

4. **Paragraph 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”).”

ANSWER: Applicant admits that it has a business address of 1100 Avenue of the Americas, New York, New York 10036. United States Patent and Trademark Office documents related to Application Serial No. 86/693,229 speak for themselves. Applicant denies any additional allegations in Paragraph 4.

5. **Paragraph 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.

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,229 speak for themselves. Applicant denies any additional allegations in Paragraph 5.

6. **Paragraph 6:** “On July 15, 2015, Applicant filed the Application Serial No. 686/693,224 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, semiprecious metals or imitation precious metals; ornamental lapel pins” in Class 14 (the “224 Application”).”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,224 speak for themselves. Applicant denies any additional allegations in Paragraph 6.

7. **Paragraph 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.”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,224 speak for themselves. Applicant denies any additional allegations in Paragraph 7.

8. **Paragraph 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”).”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,218 speak for themselves. Applicant denies any additional allegations in Paragraph 8.

9. **Paragraph 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.”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,218 speak for themselves. Applicant denies any additional allegations in Paragraph 9.

10. **Paragraph 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”).”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,234 speak for themselves. Applicant denies any additional allegations in Paragraph 10.

11. **Paragraph 11:** “The ‘218 [sic.] 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.”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/693,218 [and/or 86,693,234] speak for themselves. Applicant denies any additional allegations in Paragraph 11.

12. **Paragraph 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”).”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/709,489 speak for themselves. Applicant denies any additional allegations in Paragraph 12.

13. **Paragraph 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.”

ANSWER: United States Patent and Trademark Office documents related to Application Serial No. 86/709,489 speak for themselves. Applicant denies any additional allegations in Paragraph 13.

FIRST GROUND – LIKELIHOOD OF CONFUSION

14. **Paragraph 14:** “Opposer incorporates the allegations contained in Paragraphs 1 to 13 herein.”

ANSWER: Applicant incorporates its answers to paragraphs 1-13 as if set forth fully herein.

15. **Paragraph 15:** “Applicant’s proposed mark VINYL is confusingly similar to Opposer’s VINYL Marks.”

ANSWER: Denied.

16. **Paragraph 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.”

ANSWER: Denied.

SECOND GROUND – LIKELIHOOD OF DILUTION

17. **Paragraph 17:** “Opposer incorporates the allegations contained in Paragraphs 1 to 16 herein.”

ANSWER: Applicant incorporates its answers to paragraphs 1-16 as if set forth fully herein.

18. **Paragraph 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.”

ANSWER: Denied.

19. **Paragraph 19:** “Applicant’s mark is likely to cause dilution of Opposer’s VINYL Marks and blur the distinctiveness of Opposer’s VINYL Marks.”

ANSWER: Denied.

DAMAGE TO OPPOSER

20. **Paragraph 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.”

ANSWER: Denied.

21. **Paragraph 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.”

ANSWER: Denied.

AFFIRMATIVE DEFENSES

FIRST DEFENSE

Opposer's Notice of Opposition fails to state a claim upon which relief may be granted.

SECOND DEFENSE

Opposer will not be damaged by the registration of Application Serial Nos. 86693218, 86693224, 86693229, 86693234, 86709489 re: VINYL.

THIRD DEFENSE

Opposer's claims are barred by the doctrine of unclean hands.

FOURTH DEFENSE

Opposer's marks are not distinctive and/or famous within the meaning of the Lanham Act for purposes of asserting a dilution claim.

Applicant hereby reserves the right to amend its answer to raise additional affirmative defenses as they become available or apparent to Applicant through discovery in this matter or otherwise.

WHEREFORE, Applicant respectfully requests that the opposition be denied, that the Board issue a Notice of Allowance for the marks shown in Application Serial Nos. 86/693,218, 86/693,224, 86/693,229, 86/693,234, 86/709,489 re: VINYL.

Date: May 9, 2016

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CERTIFICATE OF SERVICE

I, Tamara Carmichael, hereby certify that a copy of the HOME BOX OFFICE, INC.'S ANSWER is being deposited with the United States Postal Service as first class mail, postage pre-paid, on May 9, 2016 in an envelope addressed to the following:

Jill M. Pietrini, Esq.
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Los Angeles, CA 90067

/s/ Tamara Carmichael