

ESTTA Tracking number: **ESTTA411475**

Filing date: **05/26/2011**

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

Proceeding	92053622
Party	Defendant Siggy Music, Inc.
Correspondence Address	CHARLES W GRIMES GRIMES & BATTERSBY LLC 488 MAIN AVENUE SUITE 300 NORWALK, CT 06851 UNITED STATES rutherford@gandb.com, grimes@gandb.com
Submission	Answer and Counterclaim
Filer's Name	Charles W. Grimes
Filer's e-mail	grimes@gandb.com, rutherford@gandb.com
Signature	/cwg/
Date	05/26/2011
Attachments	Registrant's Answer Affirmative Defenses & Counterclaims.pdf (16 pages) (696238 bytes)

Registration Subject to the filing

Registration No	2881064	Registration date	09/07/2004
Registrant	UMG RECORDINGS, INC. 2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES		
Grounds for filing	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 009. First Use: 1969/04/30 First Use In Commerce: 1969/04/30 All goods and services in the class are requested, namely: MUSICAL SOUND RECORDINGS

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

In the Matter of Registration No. 3,059,241

Mark: J5

-----X		
UMG RECORDINGS, INC.,	:	
	:	
Petitioner,	:	
	:	
-against-	:	Cancellation No. 92053622
	:	
SIGGY MUSIC, INC.,	:	
	:	
Registrant.	:	
-----X		

**REGISTRANT'S ANSWER TO PETITION TO CANCEL,
AFFIRMATIVE DEFENSES, AND COUNTERCLAIM**

Registrant, Sigg Music, Inc. ("Registrant"), by its attorneys, hereby responds to the Petition to Cancel ("Petition") filed by Petitioner, UMG Recordings, Inc. ("Petitioner"), in correspondingly unnumbered and numbered paragraphs as follows:

Registrant admits that it is the owner of Registration No. 3,059,241 (the "Registration") for the mark J5 ("Registrant's Mark") for identified goods in International Class 25, registered on February 14, 2006, by Registrant's predecessor in interest. Registrant lacks knowledge or information sufficient to form a belief as to the remaining allegations contained in the first unnumbered paragraph of the Petition and, on that basis, denies them.

1. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Petition and, on that basis, denies them.
2. Registrant admits that Petitioner purports to be the record owner of the registration referenced in Paragraph 2 of the Petition, admits that Exhibit 1 to the Petition

appears to show the status of the referenced registration as of the date of filing of the Petition, and respectfully refers the Board to said registration for the contents thereof. Registrant denies the remaining allegations contained in Paragraph 2 of the Petition.

3. Registrant denies the allegations contained in Paragraph 3 of the Petition.

4. Registrant denies the allegations contained in Paragraph 4 of the Petition.

5. Registrant admits that, on February 22, 2001, its predecessor in interest, Futurist Entertainment, Inc. (“Applicant”), applied to register the J5 mark based on its bona fide intention to use the mark in commerce in connection with identified goods in International Class 25, which later were amended to include “clothing, namely, footwear, shoes, hats, caps, shirts, and jackets” (the “Application”). Registrant denies the remaining allegations contained in Paragraph 5 of the Petition.

6. Registrant admits that Applicant assigned the Application to Scrusse Investments, Inc. (“Scrusse Investments”) on April 25, 2001. Registrant denies the remaining allegations contained in Paragraph 6 of the Petition.

7. Registrant admits that Applicant did not file an amendment under 15 U.S.C. § 1051(c) to bring the Application into conformity with 15 U.S.C. § 1051(a) and did not file a verified statement of use under section 15 U.S.C. § 1051(d) before assigning the Application to Scrusse Investments. Registrant denies the remaining allegations contained in Paragraph 7 of the Petition.

8. Registrant denies the allegations contained in Paragraph 8 of the Petition.

9. Registrant admits the allegations contained in Paragraph 9 of the Petition.

10. Registrant admits that the Registration was issued on February 14, 2006 and that Scrusse Investments later assigned the Registration to Registrant. Registrant denies the remaining allegations contained in Paragraph 10 of the Petition.

11. Registrant denies the allegations contained in Paragraph 11 of the Petition.

12. Registrant denies the allegations contained in Paragraph 12 of the Petition.

13. Registrant denies the allegations contained in Paragraph 13 of the Petition.

14. Registrant denies the allegations contained in Paragraph 14 of the Petition.

15. Registrant denies the allegations contained in Paragraph 15 of the Petition.

16. Registrant denies the allegations contained in Paragraph 16 of the Petition.

17. Registrant denies the allegations contained in Paragraph 17 of the Petition.

18. Registrant denies the allegations contained in Paragraph 18 of the Petition.

19. Registrant denies the allegations contained in Paragraph 19 of the Petition.

AFFIRMATIVE DEFENSES

20. Petitioner fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Petition.

21. Scrusse Investments is the successor to the business of Applicant to which Registrant's Mark pertains. Accordingly, Applicant properly assigned the Application in full conformity with 15 U.S.C. § 1060 (a).

22. Scrusse Investments continuously used Registrant's Mark in commerce in connection with the clothing, namely, footwear, shoes, hats, caps, shirts, and jackets, as set forth in the Registration, from at least as early as November 1, 2004 until it assigned all of its rights in the Registered Mark and the Registration to Registrant on November 20, 2009.

23. Since November 20, 2009, Registrant has used and intends to continue to use Registrant's Mark in commerce in connection with the clothing, namely, footwear, shoes, hats, caps, shirts, and jackets, as set forth in the Registration.

24. Registrant has not abandoned its rights in the Registered Mark and has no intention of doing so in the future.

25. Scrusse Investments filed the Application on February 22, 2001.

26. Upon information and belief, Petitioner did not commence use of the mark contained in the registration referenced in Paragraph 2 of the Petition until after February 22, 2001. Accordingly, Petitioner lacks priority, and Registrant's rights are superior to Petitioner's.

27. Registrant's Mark was published for opposition on December 18, 2001.

28. Despite the fact that Petitioner has had knowledge of Registrant's Mark since at least as early as December 18, 2001, Petitioner did not oppose the Application and has never objected to the Registration.

29. In reliance on Petitioner's silence, Registrant and Registrant's predecessor in interest have built up a valuable business and substantial goodwill around the Registered Mark during the past six and a half years.

30. Petitioner has unduly delayed in objecting to the Registration. As a result of Petitioner's undue delay, Registrant would be severely prejudiced by the cancellation of its Registration. Accordingly, Petitioner's claims are barred by laches, estoppel and acquiescence.

31. Upon information and belief, to the extent that Petitioner seeks to assert common law trademark rights in the designations JACKSON FIVE or J5, Registrant alleges that Petitioner does not own trademark rights in either of these designations in connection with any goods or services.

32. Upon information and belief, to the extent that Petitioner or its predecessors in interest have ever used the designations JACKSON 5, JACKSON 5IVE and/or J5 in connection with any goods or services other than musical sound recordings, they have ceased to use the aforementioned designations, with no intention to resume use, in connection with those goods long before Applicant filed the Application and long before any priority date upon which Petitioner can rely.

33. Petitioner abandoned whatever trademark rights it or its predecessors in interest ever could have claimed to have owned in the designations JACKSON 5, JACKSON 5IVE and/or J5 in connection with any goods or services other than musical sound recordings long before Applicant filed the Application and long before any priority date upon which Petitioner can rely.

34. Specifically, Motown Record Company, L.P. failed to renew Registration No. 965,809 for the mark JACKSON 5 for “entertainment services rendered by a vocal group” in International Class 41, registered on August 7, 1973, and the registration expired on May 8, 2004.

35. Moreover, Petitioner is contractually estopped from using any such designations in connection with any goods or services other than musical sound recordings, pursuant to a settlement agreement and mutual release, dated January 1, 1980, between Registrant’s President and Petitioner’s predecessor in interest.

36. Upon information and belief, to the extent that Petitioner or its predecessor in interest has ever used the designations JACKSON 5IVE or J5 in connection with musical sound recordings, it has ceased to use the aforementioned designations, with no intention to resume use,

in connection with those goods long before Applicant filed the Application and long before any priority date upon which Petitioner can rely.

37. Upon information and belief, to the extent that Petitioner or its predecessor in interest has ever used the designation J5 in connection with musical sound recordings, it has failed to police the unauthorized use of the designation J5 in connection with musical sound recordings by third parties.

38. Petitioner abandoned whatever trademark rights it ever could have claimed to have owned in the designations JACKSON 5IVE or J5 in connection with musical sound recordings long before Applicant filed the Application and long before any priority date upon which Petitioner can rely.

39. Most significantly, there is no likelihood of confusion between Registrant's Registered Mark and the JACKSON 5 mark contained in the registration referenced in Paragraph 2 of the Petition.

40. The marks are sufficiently different such that confusion is unlikely. Although both marks contain the number "5", exclusive rights in the number "5" in the registration referenced in Paragraph 2 of the Petition are disclaimed apart from the mark as shown, because it is descriptive of the 5 members of the vocal group performing on the musical sound recordings. Accordingly, the JACKSON 5 mark must be considered in its entirety. When considered in its entirety, the JACKSON 5 mark is not confusingly similar to Registrant's J5 mark. The JACKSON 5 mark consists of 3 syllables containing 7 letters plus the number "5"; Registrant's mark consists of only 2 syllables containing 1 letter plus the number "5". Accordingly, the marks differ in appearance and pronunciation.

41. Moreover, the goods are sufficiently different such that confusion is unlikely. Musical sound recordings are completely dissimilar from the clothing identified in the Registration. Moreover, the goods are sold through different channels of trade. As such, there is little proximity between the respective goods, and the registrations can safely co-exist without a hint of possible consumer confusion.

42. As further proof that Registrant's Mark is unlikely to cause confusion with the mark contained in the registration referenced in Paragraph 2 of the Petition, Registrant alleges that, upon information and belief, the marks have been used concurrently for more than six and half years without any evidence of actual confusion.

COUNTERCLAIM

43. Registrant owns U.S. Registration No. 3,059,241 for the mark J5 in connection with "clothing, namely, footwear, shoes, hats, caps, shirts, and jackets" in International Class 25 ("Registrant's Registration"). A true and correct printout of Registrant's Registration from the U.S. Patent and Trademark Office online Trademark Applications and Registration Retrieval ("TARR") database is attached hereto as Exhibit A.

44. Registrant's Registration is valid, subsisting, and in full force and effect. Registrant's Registration constitutes evidence of the validity of the J5 mark and of the registration itself, of Registrant's ownership of the J5 mark, and of Registrant's exclusive right to use the J5 mark in commerce in connection with the identified goods pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b).

45. Petitioner asserts in Paragraph 2 of the Petition that Petitioner is the owner of U.S. Registration No. 2,881,064 for the mark JACKSON 5 in connection with "musical sound recordings" in International Class 9.

46. U.S. Registration No. 2,881,064 was obtained fraudulently in that in the formal application papers filed by Petitioner's attorney of record, under notice of 18 USC § 1001, it was stated that "the trademark was first used in connection with the identified goods at least as early as April 30, 1969, and was first used on the identified goods in interstate commerce at least as early as April 30, 1969."

47. Said statement was false in that the true facts were as follows:

- (a) Upon information and belief, Petitioner had not used the mark JACKSON 5 in connection with the identified goods at least as early as April 30, 1969;
- (b) Upon information and belief, Petitioner had not used the mark JACKSON 5 in connection with the identified goods until December 1998 at the earliest;
- (c) Upon information and belief, Petitioner had not used the mark JACKSON 5 in connection with the identified goods in interstate commerce at least as early as April 30, 1969;
- (d) Upon information and belief Petitioner had not used the mark JACKSON 5 in connection with the identified goods in interstate commerce until December 1998 at the earliest;
- (e) To the extent that Petitioner seeks to claim that it is the successor in interest to the Motown record label (and thus entitled to rely upon the earlier activities of Motown), Petitioner failed to so state in its declaration, as required under 37 C.F.R. § 2.38(a) (for the record—Motown did not even commence use of the mark JACKSON 5 as of April 30, 1969—Motown's first use was not until October 7, 1969 when the single "I Want You Back" performed by the vocal group "The Jackson Five" was released by the Motown record label).

48. Said statement was made by an authorized agent of Petitioner with the knowledge and belief that said statement was false. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to Petitioner.

49. Registrant was damaged by said false statement and the registration issued in reliance thereon in that, since November 1, 2004, Registrant or Registrant's predecessor in interest has continuously used Registrant's Mark in connection with "clothing, namely, footwear, shoes, hats, caps, shirts, and jackets" in International Class 25, and Registrant's continued and legal use of Registrant's Mark will be impaired by the continued registration of the JACKSON 5 mark by Petitioner.

50. U.S. Registration No. 2,881,064 was obtained fraudulently in that the formal application papers, as amended by authority granted by Petitioner's attorney of record on March 1, 2004, it was stated that "[Petitioner] is the owner of U.S. Registration No. 0965809."

51. Said statement was false in that the true facts were that, upon information and belief, Motown Record Company, L.P. was the owner of record of U.S. Registration No. 0965809 on March 1, 2004 and remained the owner of record until the expiration of U.S. Registration No. 0965809 on May 8, 2004.

52. Said statement was made by an authorized agent of Petitioner with the knowledge and belief that said statement was false. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to Petitioner.

53. Registrant was damaged by said false statement and the registration issued in reliance thereon in that, since November 1, 2004, Registrant or Registrant's predecessor in interest has continuously used Registrant's Mark in connection with "clothing, namely, footwear, shoes, hats, caps, shirts, and jackets" in International Class 25, and Registrant's continued and legal use of Registrant's Mark will be impaired by the continued registration of the JACKSON 5 mark by Petitioner.

WHEREFORE, Registrant prays that Petitioner's Petition be dismissed in its entirety with prejudice, that the Counterclaim be sustained, and that Registration No. 2,881,064 be canceled.

Dated: Norwalk, Connecticut
May 26, 2011

Respectfully submitted,

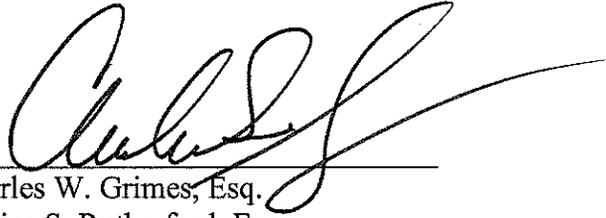
By: 
Charles W. Grimes, Esq.
Jessica S. Rutherford, Esq.
Grimes & Battersby, LLC
488 Main Avenue, Third Floor
Norwalk, CT 06851
(203) 849-8300
Attorneys for the Registrant, Siggy Music, Inc.

Exhibit A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-05-26 19:16:35 ET

Serial Number: 76214316 Assignment Information Trademark Document Retrieval

Registration Number: 3059241

Mark(words only): J5

Standard Character claim: No

Current Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

Date of Status: 2011-02-15

Filing Date: 2001-02-22

Transformed into a National Application: No

Registration Date: 2006-02-14

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-01-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SIGGY MUSIC, INC.

Address:
SIGGY MUSIC, INC.
284-C EAST LAKE MEAD PARKWAY SUITE 175
HENDERSON, NV 89015
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Nevada

GOODS AND/OR SERVICES

International Class: 025**Class Status:** Active

Clothing, namely, footwear, shoes, hats, caps, shirts, and jackets

Basis: 1(a)**First Use Date:** 2004-11-01**First Use in Commerce Date:** 2004-11-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-02-15 - Cancellation Instituted No. 999999

2009-12-02 - Automatic Update Of Assignment Of Ownership

2009-11-25 - Automatic Update Of Assignment Of Ownership

2006-02-14 - Registered - Principal Register

2006-01-05 - Law Office Registration Review Completed

2005-12-30 - Assigned To LIE

2005-12-28 - Allowed for Registration - Principal Register (SOU accepted)

2005-12-09 - Amendment From Applicant Entered

2005-12-02 - Communication received from applicant

2005-12-02 - PAPER RECEIVED

2005-07-26 - NON-FINAL ACTION E-MAILED

2005-07-26 - SU - Non-Final Action - Written

2005-07-05 - Amendment From Applicant Entered
2005-06-20 - Communication received from applicant
2005-06-20 - PAPER RECEIVED
2005-04-21 - NON-FINAL ACTION E-MAILED
2005-04-21 - SU - Non-Final Action - Written
2005-04-07 - Statement Of Use Processing Complete
2005-03-07 - Use Amendment Filed
2005-03-07 - PAPER RECEIVED
2004-10-01 - Extension 5 granted
2004-09-10 - Extension 5 filed
2004-09-16 - PAPER RECEIVED
2004-08-19 - TEAS Change Of Correspondence Received
2004-07-21 - Case File In TICRS
2004-04-26 - Assigned To Examiner
2004-03-02 - Extension 4 granted
2004-02-17 - Extension 4 filed
2004-02-19 - PAPER RECEIVED
2003-09-17 - Extension 3 granted
2003-08-25 - Extension 3 filed
2003-08-25 - PAPER RECEIVED
2003-06-13 - Extension 2 granted
2003-03-11 - Extension 2 filed
2003-03-11 - Extension 1 granted
2002-09-12 - Extension 1 filed
2003-03-27 - PAPER RECEIVED

2003-04-28 - Petition To Revive-Granted
2003-03-17 - Communication Received From Petitioner
2003-03-17 - PAPER RECEIVED
2003-03-20 - Petition to Revive - Incomplete petition letter mailed
2003-01-21 - Petition To Revive-Received
2003-01-21 - PAPER RECEIVED
2003-01-13 - Abandonment - No use statement filed
2002-09-19 - Late filed extension request
2002-09-23 - PAPER RECEIVED
2002-03-12 - NOA Mailed - SOU Required From Applicant
2001-12-18 - Published for opposition
2001-11-28 - Notice of publication
2001-07-02 - Approved For Pub - Principal Register
2001-06-27 - Communication received from applicant
2001-06-27 - Examiner's amendment mailed
2001-06-20 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
HARVEY S. HERTZ

Correspondent
CHARLES W GRIMES
GRIMES & BATTERSBY LLC
488 MAIN AVENUE SUITE 300
NORWALK, CT 06851
Phone Number:
Fax Number: (310) 278-5430

CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of May, 2011, I caused a true and correct copy of the foregoing Registrant's Answer to Petition to Cancel, Affirmative Defenses, and Counterclaim to be sent by U.S. Mail, First Class, postage prepaid, in an envelope addressed to the correspondent of record and the owner of record for Registration No. 2,881,064, as well as to the attorney of record for Petitioner as follows:

DeAnne Ozaki
Universal Music Group
2220 Colorado Avenue
Santa Monica, CA 90404
(correspondent of record/owner of record for Registration No. 2,881,064)

David Donahue, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017
(attorney of record for Petitioner)

and further certify that the foregoing Registrant's Answer to Petition to Cancel, Affirmative Defenses, and Counterclaim was filed on the same date via the Board's electronic filing system.


Jessica S. Rutherford