

ESTTA Tracking number: **ESTTA140855**

Filing date: **05/16/2007**

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	SONY BMG MUSIC ENTERTAINMENT
Granted to Date of previous extension	05/16/2007
Address	550 Madison Avenue New York, NY 10022 UNITED STATES

Attorney information	Michael Chiappetta Fross Zelnick Lehrman & Zissu, PC 866 United Nations Plaza New York, NY 10017 UNITED STATES ddonahue@frosszelnick.com, mchiappetta@fzlz.com Phone:212-813-5900
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Applicant Information

Application No	78837641	Publication date	01/16/2007
Opposition Filing Date	05/16/2007	Opposition Period Ends	05/16/2007
Applicant	Clum, Jerry 3571 Towerwood Court Springfield, OH 45503 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Production of video cassettes; Production of video discs for others
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Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1692693	Application Date	11/15/1990
Registration Date	06/09/1992	Foreign Priority Date	NONE
Word Mark	L LEGACY		
Design Mark			

Description of Mark	The design portion of the mark comprises a stylized letter "L."
Goods/Services	Class 009. First use: First Use: 1990/10/00 First Use In Commerce: 1990/10/00 musical sound recordings

U.S. Registration No.	2969079	Application Date	11/20/2001
Registration Date	07/19/2005	Foreign Priority Date	NONE
Word Mark	LEGACY L		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1997/06/11 First Use In Commerce: 1997/06/11 computerized online retail store services for musical sound and musical video recordings and downloadable musical sound and musical video recordings via a global computer network; mail order services featuring musical sound and musical video recordings</p> <p>Class 038. First use: First Use: 1996/07/27 First Use In Commerce: 1996/07/27 streaming of audio material on the Internet; streaming of video material on the Internet; audio-on-demand and video-on-demand transmission services; webcasting services</p> <p>Class 041. First use: First Use: 1996/07/27 First Use In Commerce: 1996/07/27 providing online entertainment namely, providing sound and video recordings in the field of music and musical based entertainment; providing a website over a global computer network featuring information on musical artists, tours of musical artists, sound recordings, popular culture and event and musical based entertainment; distribution of digital programs, namely, online radio and television programs</p>		

U.S. Registration No.	3092177	Application Date	08/21/2003
Registration Date	05/16/2006	Foreign Priority Date	NONE
Word Mark	LEGACY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1990/10/00 First Use In Commerce: 1990/10/00 sound and video recordings featuring music and musical based entertainment; downloadable sound and video recordings and DVDs all featuring music and musical based entertainment</p> <p>Class 035. First use: First Use: 1997/06/11 First Use In Commerce: 1997/06/11 computerized online retail store services for musical sound and musical video recordings and downloadable musical sound and musical video recordings via a global computer network; mail order services featuring musical sound and musical video recordings</p> <p>Class 038. First use: First Use: 1996/07/27 First Use In Commerce: 1996/07/27 (Based on Use in Commerce) streaming of audio material on the internet; streaming of video material on the internet; audio-on-demand and video-on-demand transmission services; webcasting services</p> <p>Class 041. First use: First Use: 1996/07/27 First Use In Commerce: 1996/07/27</p>		

	(Based on Use in Commerce) providing online entertainment namely, providing sound and video recordings in the field of music and musical based entertainment; providing a website over a global computer network featuring information on musical artists, tours of musical artists, sound recordings, popular culture and event and musical based entertainment
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Signature	/Michael Chiappetta/
Name	Michael Chiappetta
Date	05/16/2007

under the marks LEGACY and L LEGACY and Design, and the LEGACY RECORDINGS trade name (such trademarks and trade name collectively referred to as the “LEGACY Marks”), in the form of records, audio tapes, videotapes and compact discs, as well as via digital transmission over the Internet. Under the LEGACY Marks, Opposer has released musical recordings by more than 100 of the most influential and prominent artists of all time, including Aerosmith, Johnny Cash, Miles Davis, Neil Diamond, Bob Dylan, Duke Ellington, Heart, Billy Joel, Simon & Garfunkel, Bruce Springsteen and Barbara Streisand to name a few.

2. Opposer is the record owner of incontestable trademark Registration No. 1,692,693 for L LEGACY (Stylized) for “musical sound recordings” in International Class 9 and Registration No. 2,969,079 for L LEGACY (Stylized) for a variety of online and downloadable entertainment related goods and services in International Classes 35, 38 and 41. Opposer also owns Registration No. 3,092,177 for the word mark LEGACY in connection with, *inter alia*, “sound and video recordings featuring music and musical based entertainment” in International Class 9 and “providing online entertainment, namely sound and video recordings in the field of music and musical based entertainment” and other services in International Class 41, as well as other music and entertainment related goods and services in International Classes 35 and 38.

3. Moreover, as set forth above, Opposer and its predecessors in interest have been making common law use in commerce of the LEGACY Marks in the United States in relation to musical sound recordings and related goods and services since before any date upon which Applicant may rely. Hence, Opposer has federal and common law rights in the well-known LEGACY Marks in the United States.

4. As a result of Opposer's extensive use of the LEGACY Marks throughout the world and in the United States, the LEGACY Marks have attained widespread fame and notoriety in the United States long prior to the filing date of Applicant's trademark application for Applicant's Mark for "production of video cassettes; production of video discs for others."

5. On May 15, 2006, Applicant filed an application to register Applicant's Mark for "production of video cassettes; production of video discs for others" in International Class 41 based on an alleged intent to use the mark. Applicant's application date, the earliest date on which it may rely, is long after Opposer obtained Registration Nos. 1,692,693 and 2,969,079 for the mark L LEGACY (Stylized), long after the filing date for Opposer's application that gave rise to Registration No. 3,092,177 for the mark LEGACY and long after the dates of first use alleged in all of those registrations.

6. Applicant's Mark is confusingly similar to Opposer's LEGACY Marks, particularly considering the prominence of the MYLEGACY PRODUCTIONS component, which incorporates Opposer's LEGACY mark in its entirety, and the de-emphasis and disclaimer of the "AFFORDABLE VIDEO BIOGRAPHIES" component in Applicant's design mark. The marks are confusingly similar in meaning, appearance and sound. Consumers are likely to think goods or services offered under Applicant's Mark originate with or are authorized by Opposer.

7. Not only are the marks at issue highly similar, but the goods and services identified by the marks are closely related. Applicant states that it intends to use Applicant's Mark for "production of video cassettes; production of video discs for others." Such goods are closely related to the goods sold and services provided by Opposer, including, but not limited to,

Opposer's video recordings in the field of music and musical based entertainment and the provision of such recordings on the Internet in connection with the LEGACY Marks.

8. Upon information and belief, Applicant applied to register Applicant's Mark with full knowledge of Opposer's rights to the well-known LEGACY Marks and with full knowledge of Opposer's then-existing federal trademark registrations for the LEGACY Marks.

9. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of Applicant's Mark is inconsistent with the prior rights of Opposer in the well-known LEGACY Marks and the rights of Opposer flowing from its own federal trademark registrations.

10. The use by Applicant of a mark confusingly similar to Opposer's trademarks and trade name for identical goods is likely to create the mistaken impression that Applicant's goods originate from, come from, or are otherwise associated with Opposer's goods and services or that Applicant's goods are endorsed, sponsored, or in some way connected with Opposer.

11. Any such use or registration of Applicant's Mark is likely to cause confusion or mistake or to deceive the public into believing that the goods and/or services offered under Applicant's Mark come from or are otherwise authorized or sponsored by Opposer and would violate Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. Furthermore, any such use or registration of Applicant's Mark by the Applicant is likely to cause dilution of the distinctive quality of the well-known LEGACY Marks and thus would violate Section 13(a) in connection with Section 43(c) of the Lanham Act, 15 U.S.C. § 1063(a) and 1125 (c)(1).

13. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's Mark to Applicant.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant, Application Serial No. 78-837,641, be denied.

This notice of opposition is being filed electronically and the requisite filing fee is submitted herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' Deposit Account No. 23-0825 be charged with any deficiency.

Dated: New York, New York
May 16, 2007

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSO, P.C.

By: 

David Donahue

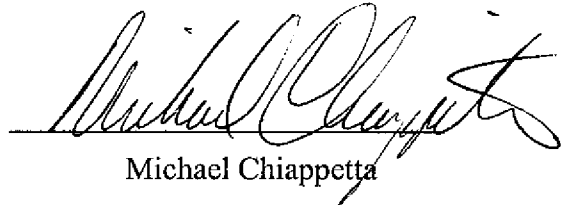
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CERTIFICATE OF TRANSMITTAL

I hereby certify that this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the following date:

May 16, 2007



Michael Chiappetta