

ESTTA Tracking number: **ESTTA157884**

Filing date: **08/20/2007**

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	DUB Publishing, Inc.
Granted to Date of previous extension	08/19/2007
Address	16815 Johnson Drive City of Industry, CA 91745 UNITED STATES

Attorney information	Christopher L. Dueringer, Esq. Bryan Cave LLP 120 Broadway, Suite 300 Santa Monica, CA 90401 UNITED STATES cdueringer@bryancave.com Phone:310-576-2100
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Applicant Information

Application No	76602218	Publication date	02/20/2007
Opposition Filing Date	08/20/2007	Opposition Period Ends	08/19/2007
Applicant	JADA TOYS, INC. 938 Hatcher Avenue City of Industry, CA 91748 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 028. All goods and services in the class are opposed, namely: TOY ACTION FIGURES AND ACCESSORIES FOR USE THEREWITH; RADIO-CONTROLLED TOY VEHICLES, FRICTION TOY VEHICLES, WIND-UP TOY VEHICLES AND TOY FIGURES; DOLLS, DOLL CLOTHING, AND DOLL ACCESSORIES; CHILDREN AND INFANTS' MULTIPLE ACTIVITY TOYS, PLUSH TOYS, STUFFED TOYS, PLASTIC AND VINYL TOY CHARACTERS AND TOY ANIMALS, TOY FIGURES, RIDE-ON TOYS, WIND-UP TOYS, BATTERY-OPERATED TOY VEHICLES; BATTERY-OPERATED ACTION TOYS, PUSH TOYS, PULL TOYS, MECHANICAL TOYS, TOY CONSTRUCTION SETS, TOY BUILDING BLOCKS, WATER SQUIRTING TOYS, MUSICAL TOYS, INFLATABLE TOYS, INFANT TOY RATTLES, JIGSAW PUZZLES, EQUIPMENT SOLD AS A UNIT FOR PLAYING BOARD GAMES, PARLOR GAMES, ACTION-TYPE TARGET GAMES, CARD GAMES AND ROLE PLAYING GAMES; SKATEBOARDS; TOY SCOOTERS, TOY SPORTING EQUIPMENT, NAMELY, FOOTBALLS, BASEBALLS, SOCCER BALLS, BASEBALL BATS, GOLF CLUBS, HOCKEY STICKS AND PUCKS, BASKETBALLS, VOLLEYBALLS, GOLF BALLS AND GOLF ACCESSORIES, NAMELY, DIVOT REPAIR TOOLS, FOAM FLYING DISCS AND TOY BALL SHOOTERS; FOAM TOY DISCS AND BALLS FOR USE THEREWITH</p>

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Applicant is not the rightful owner of the mark in the 76/602,218 Application.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2408405	Application Date	10/05/1999
Registration Date	11/28/2000	Foreign Priority Date	NONE
Word Mark	DUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/02/13 First Use In Commerce: 2000/02/13 Printed matter, namely, magazines featuring stories, articles, photography, and advertising pertaining to automotive trends, fashions and culture Class 041. First use: First Use: 2000/02/13 First Use In Commerce: 2000/02/13 [entertainment services, specifically the production of a series of cable television programs]		

Attachments	75816419#TMSN.gif (1 page)(bytes) DUB-Opposition to '218 Application.pdf (6 pages)(30817 bytes)
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Signature	/s/Renee L. Williams, Esq.
Name	Christopher L. Dueringer, Esq.
Date	08/20/2007

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

In re: Serial No. 76/602,218

For the mark: DUB SHOP

Filing date: July 14, 2004

Date Published for Opposition: February 20, 2007

Applicant: Jada Toys, Inc.

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DUB PUBLISHING, INC.,)
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Opposer,)
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v.)
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JADA TOYS, INC.)
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Applicant.)
)
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Opposition No.: _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

DUB Publishing, Inc., a corporation organized under the laws of the State of California, having an office and place of business at 16815 Johnson Drive, City of Industry, California 91745 (“Opposer”), believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 76/602,218 (the “218 Application”) as it relates to the goods in International Class 28 listed in the ‘218 Application, and hereby opposes registration of same.

As grounds therefore, it is alleged that:

1. On October 5, 1999, Opposer, in the name of its founder, Myles Kovacs, filed U.S. Trademark Application Serial No. 75/816,419, which application reserved rights in and to the mark DUB. Commencing at least as early as February 13, 2000, Opposer, through itself and through its founder, Myles Kovacs, used its DUB® mark in connection with magazines (including magazines covering the subject matter of cars, vans and trucks, among other things) and entertainment services and related promotional goods and services. Opposer currently uses or licenses the use of its DUB® mark in connection with a wide variety of goods and services including by way of example only, clothing, car audio and video products, license plate holders, automotive chrome badges, automotive themed calendars, automotive floor mats, other automotive accessories, an automotive trade show and entertainment exhibition and related retail services.
2. On November 28, 2000, Opposer, through its founder, Myles Kovacs, was issued, and continues to own, U.S. Trademark Registration No. 2,408,405 for the mark DUB®, covering “printed matter, namely magazines featuring, stories, articles, photography and advertising pertaining to automotive trends, fashions and culture.”
3. On November 30, 2004, Opposer’s founder, Myles Kovacs, assigned U.S. Trademark Registration No. 2,408,405 for the mark DUB® to Opposer via a Nunc Pro Tunc Trademark Assignment, effective as of October 8, 2001.
4. Opposer has used its DUB® mark extensively in advertising, and in connection with its magazines and a wide variety of other goods and services. Since September 1999, Opposer, through itself and through sponsors, has spent millions of dollars advertising

and promoting products and services bearing the DUB® mark and has recorded sales of such products and services in the tens of millions of dollars.

5. On October 8, 2001, Opposer entered into a Trademark License Agreement with Applicant whereby Opposer granted Applicant an exclusive, non-transferable license to use Opposer's DUB® mark, and approved variations thereof, in connection with the distribution, manufacture and sale of die cast and toy cars, vans, and trucks (the "License Agreement"). Thereafter, Applicant performed (and continues to perform) at least some of its obligations under the License Agreement, including activities relating to the distribution, manufacture and sale of DUB® branded die cast toy vehicles.
6. On July 14, 2004, well after Opposer and Applicant finalized the License Agreement, Applicant filed various applications with the U.S. Patent and Trademark Office for marks consisting of or incorporating Opposer's DUB® mark, including an application for the mark DUB SHOP for the exact goods covered by the License Agreement, plus additional related toy goods in Int'l Class 28, with full knowledge of Opposer's rights in and to its DUB® mark.
7. Paragraph 2.2 of the License Agreement specifically states that Opposer "shall retain the entire right, title and interest in and to the Marks". The License Agreement defines "Marks" as the "trademark and design mark for "DUB" and any related variations thereof". Paragraph 5.4 of the License Agreement states that Opposer "agrees to pay all expenses in connection with any application, registration, and maintenance of the Marks, and [Applicant] agrees to *cooperate fully and in good faith* with [Opposer] for the purposes of securing and preserving [Opposer's] rights in and to the Marks" (emphasis added).

8. Applicant is not, and was not, at the time of the filing of its application for registration, the rightful owner of the mark the '218 Application, making the '218 Application void and unregistrable to Applicant. Despite the fact that the Applicant is not, nor was ever, the rightful owner of the registered mark, Applicant filed, inter alia, an application seeking registration of the mark DUB SHOP in connection with die cast toy cars, toy trucks and toy vehicles, and related toy goods, in International Class 28.
9. The terms of the License Agreement clearly dictate that Opposer is the rightful owner of the DUB® mark and variations thereof. Accordingly, Applicant's claim of ownership of the mark DUB SHOP is also likely to cause confusion, mistake, or deception in the minds of the purchasing public as to the ownership of the DUB® mark and/or the source of the parties' goods and services, in view of Opposer's long prior use of its DUB® mark and the well-developed recognition, good will and secondary meaning therein; and Applicant's statements of ownership and exclusive rights in and to DUB SHOP are false, misleading and inconsistent with the terms, conditions, limitations and undertakings set forth in the License Agreement.
10. Pursuant to the terms of the License Agreement, any use by Applicant of the DUB® mark, or any variations thereof, has inured to the benefit of Opposer.
11. Opposer will be damaged by the confusion that has and/or will result in the public if Applicant is permitted to register the mark DUB SHOP for the specified goods; and a cloud will be placed on Opposer's title in and to its DUB® mark, and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods and services, all to the great injury of the Opposer.

WHEREFORE, Opposer believes that it is or will be damaged by the registration of Serial No. 76/602,218 and opposes the application for registration thereof.

Please charge the fee of \$300, as set forth in 37 CFR 2.6(a)(17), for filing of this Notice to Deposit Account No. 02-4467. It is believed that no other fees are due with this Notice of Opposition. However, if there are any such other fees, they may be charged on Deposit Account No. 02-4467.

Opposer hereby appoints Christopher L. Dueringer, Evan Y. Chuck, Paul Tauger, Mark Paskar, Andrew Klungness, Lindsay E. Cohen and Renee L. Williams, all members of the Bars of the States of California, Illinois and/or Missouri, and all of the law firm of Bryan Cave LLP as its attorneys with full powers of substitution and revocation to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office, and requests that all correspondence regarding the opposition be directed to Christopher L. Dueringer, Esq. at Bryan Cave LLP, 120 Broadway, Suite 300, Santa Monica, CA 90401.

Respectfully submitted,

BRYAN CAVE LLP

Date: August 20, 2007

By: /s/Renee L. Williams
Christopher L. Dueringer
Mark A. Paskar
Renee L. Williams

Attorneys for Opposer Dub Publishing, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 20th day of August, 2007, I have caused to be mailed, by first class-mail, postage-prepaid, a true and correct copy of the Electronic System for Trademark Trials and Appeals Receipt for Notice of Opposition, to:

Michael T. Purleski, Esq.
Squire, Sanders & Dempsey L.L.P.
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Los Angeles, CA 90071-2300
Attorneys for Registrant

/s/Renee L. Williams
Renee L. Williams