

ESTTA Tracking number: **ESTTA254100**

Filing date: **12/10/2008**

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	Triumph International, Inc.
Granted to Date of previous extension	12/10/2008
Address	c/o Venable LLPP.O. Box 34385 Washington, DC 20043 UNITED STATES

Attorney information	Mark Harrison Venable LLP P.O. Box 34385 Washington, DC 20043 UNITED STATES mbharrison@venable.com, jlpatt@venable.com, trademarkdocket@venable.com, tmcarroll@venable.com
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Applicant Information

Application No	77427039	Publication date	08/12/2008
Opposition Filing Date	12/10/2008	Opposition Period Ends	12/10/2008
Applicant	Jackson, Michael Apt #6 2022 Morgan Avenue S.W. Decatur, AL 35601 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 1985/06/29 First Use In Commerce: 2001/06/29 All goods and services in the class are opposed, namely: Entertainment in the nature of live performances by hip hop artist; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring a hip hop artist; Audio recording and production; Production of sound recordings

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
Other	Fraud under Trademark Act section 1(a)(3)

Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MJ		
Goods/Services	Entertainment services in the field of music		

U.S. Registration No.	1908209	Application Date	06/03/1993
Registration Date	08/01/1995	Foreign Priority Date	NONE
Word Mark	MICHAEL JACKSON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/01/01 First Use In Commerce: 1985/01/01 sound recordings; namely, pre-recorded phonograph records, audio tapes, compact discs, videotapes, and motion picture films featuring music and entertainment		

Attachments	Not of Opposition--Triumph Int'l Inc. v. Michael Jackson.pdf (17 pages)(782644 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	/Mark Harrison/
Name	Mark Harrison
Date	12/10/2008

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

Triumph International, Inc.)	
Opposer,)	
v.)	Opposition No. _____
Michael Jackson.)	Serial No. 77/427,039
Applicant.)	Mark: MJ
_____)		
Attorney's Reference 77322-262357		

NOTICE OF OPPOSITION

In the matter of the application for registration of the trademark MJ as shown in Application Serial No. 77/427,387, filed March 20, 2008, and published for opposition in the Official Gazette of August 12, 2008.

Opposer, Triumph International, Inc., a California Corporation, c/o Venable LLP, P.O. Box 34385, Washington D.C. 200043, representative of Michael J. Jackson, believes that it and Michael J. Jackson will be damaged by registration of the mark shown in said Application Serial No. 77/439,387, and hereby opposes the same.

As grounds for opposition it is alleged that:

1. Opposer is the owner of Registration No. 1908209 for the mark MICHAEL JACKSON issued August 1, 1995 in connection with sound recordings; namely, pre-recorded phonograph records, audio tapes, compact discs, videotapes, and motion picture films featuring music and entertainment. This registration is in full force and effect. See Exhibit 1.

2. Michael J. Jackson, an individual, now and for many years has been engaged in the business of entertainment services in the field of music.

3. Michael J. Jackson has been an internationally known musician, singer and entertainer since prior to the claimed date of first use by Applicant.

4. Michael J. Jackson began his career as part of the musical group Jackson 5 in approximately 1966 and began his solo music career in approximately 1979. Michael J. Jackson has achieved world wide recognition and popularity as an entertainer and has extensive goodwill in his name.

5. Upon information and belief, Applicant is an individual with an address of Apt #6 2022 Morgan Avenue S.W., Decatur, AL 35601.

6. Applicant filed Application Serial No. 77/427,039 for the mark MJ on March 20, 2008 which covers "Entertainment in the nature of live performances by hip hop artist; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring a hip hop artist; Audio recording and production; Production of sound recordings" in Class 41 and claiming a date of first use at least as early as June 29, 1985, and first use in commerce at least as early as June 29, 2001. See attached Exhibit 2.

FALSE SUGGESTION OF CONNECTION WITH MICHAEL J. JACKSON

7. Applicant's attempt to register MJ as a trademark in connection with the services listed in his Application Serial No. 77/427,039 falsely suggest a connection with Michael J. Jackson in violation of 15 USC § 1052(a); Section 2(a) of the Trademark Act.

8. Michael J. Jackson is known as, and has been referred to as, MJ and the nickname MJ, even without use of Michael J. Jackson's full name, when used in the music industry

is widely recognized as referring to Michael J. Jackson. The nickname MJ is symbolic of the extensive goodwill and recognition built by Michael J. Jackson through years of promotion and success in the music industry.

9. The nickname MJ is unmistakably associated with Michael J. Jackson when used in connection with musical entertainment services. Moreover, given Michael J. Jackson's extensive fame and popularity, Applicant's use and registration of the mark MJ in connection with the services covered by Applicant's application will cause consumers to associate Applicant's services with Michael J. Jackson.

10. The mark shown in Applicant's Application Serial No. 77/427,039 is identical to Michael J. Jackson's nickname MJ.

11. Applicant's services listed in its Application Serial No. 77/427,039 and Michael J. Jackson's musical entertainment services are the same or related.

12. Michael J. Jackson is not connected in any way to Applicant or his services.

13. Upon information and belief, Applicant uses the mark MJ with the intent to trade off the goodwill and fame of Michael J. Jackson and to commercially exploit Michael J. Jackson's nickname in connection with the promotion and sale of his services.

**ATTEMPT TO REGISTER MICHAEL J. JACKSON'S NICKNAME WITHOUT
CONSENT**

14. Opposer incorporates the allegations set forth in paragraphs numbered 1 through 13 as if fully set forth herein.

15. Applicant's attempt to register MJ as a trademark in connection with the services listed in his Application Serial No. 77/427,039 without Michael J. Jackson's consent is in violation of 15 USC § 1052(c); Section 2(c) of the Trademark Act.

16. Michael J. Jackson has not consented to the use or registration of the nickname by Applicant.

FRAUD BY APPLICANT

17. Opposer incorporates the allegations set forth in paragraphs numbered 1 through 17 as if fully set forth herein.

18. Upon information and belief, Applicant knowingly and intentionally submitted false statements in its Application Serial No. 77/427,039 in violation of 15 U.S.C. § 1051; Section 1(a)(3) of the Trademark Act.

19. Upon information and belief, Applicant had knowledge of the public recognition of the term MJ as referring to Michael J. Jackson when it filed its application.

20. Applicant in its application stated that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive”. Applicant’s sworn statement is false in that Applicant was aware of Michael J. Jackson’s nickname used in connection with same or related services at the time the applicant signed the declaration in its application.

21. Upon information and belief, Application Serial No. 77/427,039 was approved and published with Applicant’s knowingly false or fraudulent statements, which statements were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to approve the Application.

WHEREFORE, Opposers prays that said Application Serial No. 77/427,039, be rejected, that no registration be issued thereon to applicant, and that this opposition be sustained in favor of the Opposer.

Please deduct the statutory filing fee of \$300.00 from our Deposit Account No. 22-0261.

Opposer appoints Mark B. Harrison, Jacqueline Levasseur Patt, Janet Satterthwaite, Marcia A. Auberger, Andrew D. Price, Ellen Woodward, Julie Hopkins and Rebecca Liebowitz and along with the law firm of Venable LLP to transact all business on its behalf in connection with this Opposition.

Respectfully submitted,



Date: December 10, 2008

By: _____

Mark B. Harrison
Venable LLP
P.O. Box 34385
Washington, D.C. 20043
Telephone: (202) 344-4000
Facsimile (202) 344-8300

Attorneys for Opposer

Triumph International, Inc. v. Michael Jackson
Serial No. 77/427,039
Mark: MJ

EXHIBIT 1



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Typed Drawing

Word Mark	MICHAEL JACKSON
Goods and Services	IC 009. US 021 026 036 038. G & S: sound recordings; namely, pre-recorded phonograph records, audio tapes, compact discs, videotapes, and motion picture films featuring music and entertainment. FIRST USE: 19850101. FIRST USE IN COMMERCE: 19850101
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74398145
Filing Date	June 3, 1993
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	May 9, 1995
Registration Number	1908209
Registration Date	August 1, 1995
Owner	(REGISTRANT) Triumph International, Inc. CORPORATION CALIFORNIA c/o ALVIN MALNIK 6301 N. OCEAN BLVD. OCEAN RIDGE FLORIDA 33435
Attorney of Record	KATHERINE L. MCDANIEL
Prior Registrations	1443941
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040918.
Renewal	1ST RENEWAL 20040918
Other Data	The name shown in the mark, identifies a living individual whose consent is of record.
Live/Dead Indicator	LIVE

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Serial Number: 74398145 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1908209

Mark (words only): MICHAEL JACKSON

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-09-18

Filing Date: 1993-06-03

Transformed into a National Application: No

Registration Date: 1995-08-01

Register: Principal

Law Office Assigned: LAW OFFICE 15

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: 900 -File Repository (Franconia)

Date In Location: 2004-09-27

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

1. Triumph International, Inc.

Address:

Triumph International, Inc.
c/o ALVIN MALNIK 6301 N. OCEAN BLVD.
OCEAN RIDGE, FL 33435
United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

sound recordings; namely, pre-recorded phonograph records, audio tapes, compact discs, videotapes, and motion picture films featuring music and entertainment

Basis: 1(a)

First Use Date: 1985-01-01

First Use in Commerce Date: 1985-01-01

ADDITIONAL INFORMATION

Name Portrait Consent: The name shown in the mark, identifies a living individual whose consent is of record.

Prior Registration Number(s):
1443941

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.

2004-09-18 - First renewal 10 year
2004-09-18 - Section 8 (10-year) accepted/ Section 9 granted
2004-08-12 - Combined Section 8 (10-year)/Section 9 filed
2004-08-12 - TEAS Section 8 & 9 Received
2002-07-10 - PAPER RECEIVED
2001-09-08 - Section 8 (6-year) accepted & Section 15 acknowledged
2001-08-06 - Section 8 (6-year) and Section 15 Filed
1995-08-01 - Registered - Principal Register
1995-05-09 - Published for opposition
1995-04-07 - Notice of publication
1994-11-28 - Approved for Pub - Principal Register (Initial exam)
1994-11-28 - Previous allowance count withdrawn
1994-11-14 - Approved for Pub - Principal Register (Initial exam)
1994-11-12 - Previous allowance count withdrawn
1994-10-30 - Approved for Pub - Principal Register (Initial exam)
1994-09-19 - Communication received from applicant
1994-03-14 - Non-final action mailed

1994-02-14 - Communication received from applicant

1993-09-16 - Non-final action mailed

1993-08-25 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

KATHERINE L. MCDANIEL

Correspondent

KATHERINE L. MCDANIEL

KATTEN MUCHIN ZAVIS ROSENMAN

2029 CENTURY PARK EAST

SUITE 2600

LOS ANGELES, CA 90067

Phone Number: 310 768-4400

Fax Number: 310 768-4471



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For Serial Number: 74398145

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Triumph International, Inc. v. Michael Jackson
Serial No. 77/427,039
Mark: MJ

EXHIBIT 2

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Serial Number: 77427039 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

MJ

(words only): MJ

Standard Character claim: Yes

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2008-08-29

Filing Date: 2008-03-20

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 102

Attorney Assigned:
CLARKE NANCY L

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-07-10

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

1. Jackson, Michael

Address:
Jackson, Michael

Apt #6 2022 Morgan Avenue S.W.
Decatur, AL 35601
United States

Legal Entity Type: Individual
Country of Citizenship: United States
Phone Number: (404) 324-0132
Fax Number: (256) 301-0341

GOODS AND/OR SERVICES

International Class: 041

Class Status: Active

Entertainment in the nature of live performances by hip hop artist; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring a hip hop artist; Audio recording and production; Production of sound recordings

Basis: 1(a)

First Use Date: 1985-06-29

First Use in Commerce Date: 2001-06-29

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.

2008-08-29 - Extension Of Time To Oppose Received

2008-08-12 - Published for opposition

2008-07-23 - Notice of publication

2008-07-10 - Law Office Publication Review Completed

2008-07-08 - Assigned To LIE

2008-07-08 - Approved for Pub - Principal Register (Initial exam)

2008-06-25 - Assigned To Examiner

2008-03-26 - Notice Of Pseudo Mark Mailed

2008-03-25 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

MICHAEL JACKSON

APT 6

2022 MORGAN AVE SW

DECATUR, AL 35601

Phone Number: (404) 324-0132

Fax Number: (256) 301-0341

CERTIFICATE OF SERVICE

The undersigned, attorney for Opposer, hereby certifies that a true and complete copy of foregoing Notice of Opposition has been served on this 10th day of December, 2008 via first-class mail, postage prepaid to Applicant:

Michael Jackson
Apt #6 2022 Morgan Avenue S.W.
Decatur, AL 35601



Mark B. Harrison