

ESTTA Tracking number: **ESTTA436057**

Filing date: **10/17/2011**

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	Domo Records, Inc.
Granted to Date of previous extension	10/16/2011
Address	11340 West Olympic Blvd Suite 270 Los Angeles, CA 90064 UNITED STATES
Attorney information	Nichole Davis Chollet Kilpatrick Townsend & Stockton LLP 1100 Peachtree St NE STE 2800 Atlanta, GA 30309 UNITED STATES nchollet@ktslaw.com, jtrigg@ktslaw.com, apawlenty-altman@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com

Applicant Information

Application No	77002483	Publication date	04/19/2011
Opposition Filing Date	10/17/2011	Opposition Period Ends	10/16/2011
International Registration No.	NONE	International Registration Date	NONE
Applicant	NHK Enterprises Inc 4-14 Kamiyama-cho, Shibuya-ku Tokyo, 150-0047 JAPAN		


Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: (Based on Intent to Use) computer software featuring programs used for animation design applications; computer software featuring games; mobile computers and cellular telephone accessories, namely, carrying cases; (Based on Intent to Use) (Based on 44(e)) musical recordings; content for mobile applications, namely, still and animated wallpapers, ring tones, screen savers, games and audio-visual programs, all for mobile devices; sound recordings; video and multi-media recordings featuring an animated character, songs and bonus features; video game software</p>
<p>Class 041. All goods and services in the class are opposed, namely: (Based on Intent to Use) (Based on 44(e)) television show production; multi-media production, namely, production of interactive TV-based games; mobile content production, namely, production of interactive games; entertainment services, namely, providing on-line computer games</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2144176	Application Date	09/30/1996
Registration Date	03/17/1998	Foreign Priority Date	NONE
Word Mark	DOMO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1994/09/06 First Use In Commerce: 1994/09/06 [prerecorded audio cassette tapes,] prerecorded compact discs, [prerecorded audio-visual records in analog magnetic tape configurations,] and prerecorded audio-visual records in digital disc configurations, all containing music</p> <p>Class 041. First use: First Use: 1994/09/06 First Use In Commerce: 1994/09/06 entertainment services, namely, producing for others [prerecorded audio cassette tapes,] prerecorded compact discs,[prerecorded audio-visual records in analog magnetic tape configurations,] and prerecorded audio-visual records in digital disc configurations, all containing music</p>		

U.S. Application No.	77429936	Application Date	03/24/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DOMO MUSIC GROUP		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 009. First use: First Use: 2006/11/07 First Use In Commerce: 2006/11/07 prerecorded compact discs and prerecorded audio-visual records in digital disc configurations, all containing music</p> <p>Class 041. First use: First Use: 2006/11/07 First Use In Commerce: 2006/11/07 entertainment services, namely producing for others prerecorded compact discs and prerecorded audio-visual records in digital disc configurations, all containing music</p>
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Attachments	<p>75174271#TMSN.gif (1 page)(bytes)</p> <p>77429936#TMSN.jpeg (1 page)(bytes)</p> <p>Domo Records, Inc. v. NHK Enterpries Inc. - Notice of Opposition (DOMO).pdf (7 pages)(39793 bytes)</p>
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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	/Nichole Davis Chollet/
Name	Nichole Davis Chollet
Date	10/17/2011

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

In the matter of Application Serial No. 77/002,483: DOMO,
Published in the Official Gazette of April 19, 2011

DOMO RECORDS, INC.,)	
)	
Opposer,)	
v.)	
)	Opposition No. _____
NHK ENTERPRISES INC.,)	
)	
Applicant.)	

NOTICE OF PARTIAL OPPOSITION

Opposer Domo Records, Inc. (hereinafter “Opposer”) will be damaged by the registration by NHK Enterprises Inc. (hereinafter “Applicant”) of the mark DOMO filed under Application Serial No. 77/002,483 and published in the *Official Gazette* on April 19, 2011, and hereby opposes the same in International Classes 9 and 41 only, pursuant to the provisions of 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104.

The grounds for this Opposition are as follows:

1.

Opposer is a corporation incorporated under the laws of California, located and doing business at 11340 West Olympic Blvd., Suite 270, Los Angeles, California 90064.

2.

Upon information and belief, Applicant is a foreign corporation incorporated under the laws of Japan, located and doing business at 4-14 Kamiyama-cho, Shibuya-ku, Tokyo, Japan 150-0047.

3.

At least as early as 1994, Opposer has used the DOMO word mark and the distinctive DOMO (stylized) mark, as depicted below, to identify the source of its music recordings, audio-visual recordings, and related music and audio-visual production services.



4.

Opposer owns a U.S. trademark registration for the mark DOMO (Stylized) under Registration No. 2,144,176, registered on March 17, 1998, in International Class 9 for “prerecorded compact discs, and prerecorded audio-visual records in digital disc configurations, all containing music” and in International Class 41 for “entertainment services, namely, producing for others prerecorded compact discs, and prerecorded audio-visual records in digital disc configurations, all containing music.” Affidavits have been filed pursuant to Sections 8 and 15 of the Lanham Act, 15 U.S.C. §§ 1058 and 1065, and this registration is incontestable.

5.

Opposer owns a U.S. trademark application Serial No. 77/429,936 to register the DOMO MUSIC GROUP & Design mark, as depicted below, filed on March 24, 2008 in International Class 9 for “prerecorded compact discs and prerecorded audio-visual records in digital disc configurations, all containing music” and in International Class 41 for “entertainment services, namely producing for others prerecorded compact discs and prerecorded audio-visual records in digital disc configurations, all containing music.”



Applicant's application Serial No. 77/002,483 has been cited by the U.S. Patent and Trademark Office as a potential obstacle to the registration of Opposer's pending application Serial No. 77/429,936, and on January 14, 2009, a Notice of Suspension was issued against Opposer's application Serial No. 77/429,936 pending the final disposition of Applicant's application Serial No. 77/002,483. Opposer's DOMO, DOMO (Stylized), and DOMO MUSIC GROUP & Design marks, including the marks underlying Opposer's Reg. No. 2,144,176 and Serial No. 77/429,936, are collectively referred to herein as "Opposer's DOMO Marks."

6.

On September 19, 2006, Applicant filed an application to register the mark DOMO (Serial No. 77/002,483) in the following International Classes:

International Class 9: Computer software featuring programs used for animation design applications; computer software featuring games; mobile computers and cellular telephone accessories, namely, carrying cases; musical recordings; content for mobile applications, namely, still and animated wallpapers, ring tones, screen savers, games and audio-visual programs, all for mobile devices; sound recordings; video and multi-media recordings featuring an animated character, songs and bonus features; video game software;

International Class 16: printed publications, namely, books and magazines in the fields of fiction, coloring and activity, gifts, puzzles, and games; graphic novels; (Based on Intent to Use) school supplies and stationery, namely, note pads, pencils, pens, pencil cases, binder erasers; posters, prints; decals for application onto fabric; stickers;

International Class 18: bags, namely, sports bags, knapsacks, school bags, tote bags;

International Class 21: glassware, namely, tumblers and mugs;

International Class 24: bed linens; towels, home accessories, namely, curtains, and bed blankets and blanket throws;

International Class 25: men's, women's and children's clothing, namely, hats, socks, shirts, jackets, bathing suits, underwear, pants, shorts and pajamas;

International Class 27: area rugs;

International Class 28: toys, namely, action figures, dolls, puzzles, stuffed and plush toys; board games;

International Class 35: administration and provision of promotional contests;

International Class 41: television show production; multi-media production, namely, production of interactive TV-based games; mobile content production, namely, production of interactive games; entertainment services, namely, providing on-line computer games; and

International Class 42: computer software design for others; video game design for others; providing a web site featuring temporary use of non-downloadable software allowing web site users to host and develop images and video.

Applicant's trademark application was first published for opposition in the *Official Gazette* on April 19, 2011.

7.

Applicant's DOMO mark is highly similar to Opposer's DOMO Marks in sound, appearance, and overall commercial impression.

8.

The goods and services in International Classes 9 and 41 of Applicant's application to register the DOMO mark are closely related to the goods and services associated with Opposer and Opposer's DOMO Marks.

9.

Applicant's use of the DOMO Mark is likely to create confusion, mistake and deception among the relevant consuming public, and is likely to create the erroneous impression that Applicant's goods and services are those of Opposer or are otherwise affiliated with Opposer and Opposer's DOMO Marks.

10.

Opposer will be damaged by the registration of Applicant's mark because the mark so resembles Opposer's DOMO Marks as to be likely to cause confusion, mistake, and/or deception. Consumers familiar with Opposer's DOMO Marks, and with Opposer's products and services, would be likely, erroneously, to believe that Applicant's goods and services in International Classes 9 and 41 are the goods and services of Opposer or are authorized, endorsed, sponsored, or licensed by Opposer. Thus, registration of Applicant's mark on the Principal Register in International Classes 9 and 41 would be inconsistent with Opposer's rights in Opposer's DOMO Marks.

11.

There is no issue as to priority. Opposer began using the DOMO mark in commerce at least as early as 1994, well prior to the September 19, 2006 filing date of Applicant's application.

12.

The opposition fee in the amount of \$600 for a notice of opposition against International Classes 9 and 41 is filed herewith. The Commissioner is authorized to debit Kilpatrick Townsend & Stockton LLP's Deposit Account No. 20-1430 if there is a deficiency in the filing fee.

WHEREFORE, Opposer requests that the Board refuse registration to the application of the DOMO Mark (Serial No. 77/002,483) in International Classes 9 and 41 and that this Opposition be sustained in favor of Opposer.

Dated: October 17, 2011

Respectfully submitted,

/Nichole Davis Chollet/
James A. Trigg

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being filed electronically through the U.S. Patent and Trademark Office's ESTTA system on October 17, 2011.

BY: /Nichole Davis Chollet/
Nichole Davis Chollet

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF PARTIAL OPPOSITION was served on the Applicant on October 17, 2011 via first class mail, postage pre-paid, addressed as follows:

Melissa A. Vallone
Barnes & Thornburg LLP
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Chicago, IL 60690-2786

/Nichole Davis Chollet/
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