

ESTTA Tracking number: **ESTTA1261276**

Filing date: **01/20/2023**

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	Black Entertainment Television LLC
Granted to date of previous extension	01/22/2023
Address	1515 BROADWAY, 33RD FLOOR NEW YORK, NY 10036 UNITED STATES
Attorney information	MARKUS HOPKINS 1515 BROADWAY, 33RD FLOOR NEW YORK, NY 10036 UNITED STATES Primary email: markus.hopkins@paramount.com Secondary email(s): trademarks@mtvn.com, trademarks@viacomcbs.com, laverne.newton@paramount.com, asha.dais@paramount.com 212-258-6000
Docket no.	

Applicant information

Application no.	97011801	Publication date	07/26/2022
Opposition filing date	01/20/2023	Opposition period ends	01/22/2023
Applicants	Idmon Yildiz CORWINSTRAAT 7, OVERIJSSEL OLDENZAAL, 7576ZE NETHERLANDS Gabriel Isik CORWINSTRAAT 7, OVERIJSSEL OLDENZAAL, 7576ZE NETHERLANDS		

Goods/services affected by opposition

Class 041. First Use: Mar 7, 2015 First Use In Commerce: Mar 7, 2015 All goods and services in the class are opposed, namely: Marketing and distributing the prerecorded music of others on an online music streaming platform, namely, providing online music, not downloadable

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)

Mark cited by opposer as basis for opposition

U.S. registration no.	1653933	Application date	07/23/1990
Register	Principal		
Registration date	08/13/1991	Foreign priority date	NONE
Word mark	RAP CITY		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Sep 8, 1989 First Use In Commerce: Sep 8, 1989 entertainment services in the nature of a television variety program on rap music		

Attachments	NOO - RAP CITY - Notice of Opposition - LOC Dilution False Connection .pdf(140034 bytes)
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Signature	/Markus Hopkins/
Name	MARKUS HOPKINS
Date	01/20/2023

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

In the matter of Application Serial No. 97/011,801
Mark: RAP CITY

Black Entertainment
Television LLC,

Opposer,
v.

Gabriel Isik and Idmon
Yildiz,

Applicants.

Opposition No.:

NOTICE OF OPPOSITION

BET Entertainment Television LLC, a limited liability company duly organized and existing under the laws of the District of Columbia with a principal place of business at 1515 Broadway, New York, New York 10036 (“BET” or “Opposer”), believes that it will be damaged by the registration of the trademark RAP CITY, the subject mark of Application Serial No. 97/011,801 (“Application”), and hereby opposes the same. As grounds for the opposition, BET alleges as follows:

FACTS

BET’s Marks and Business

1. BET has been operating the groundbreaking, famous, and immediately recognized Black Entertainment Television programming service since 1980 in connection with producing and distributing entertainment content and live events.

2. In 1989, BET became the first to use the mark RAP CITY in the entertainment space when it launched the wildly successful television series RAP CITY. Each episode of the RAP CITY series showcases hip-hop and rap themed music videos, along with live performances and interviews.

3. BET has used the RAP CITY mark in connection with its series and related specials for over 30 years, with the most recent RAP CITY special airing in October of 2022 prior to BET's 2022 HIP HOP AWARDS .

4. BET owns an active U.S. trademark registration for a television variety program on rap music that has been registered since August 13, 1991 ("RAP CITY Mark").

5. Below is BET's federally registered RAP CITY trademark:

Mark	Current Reg Date	Current Reg No	Goods / Services
RAP CITY	08/13/1991	1653933	Class 41 entertainment services in the nature of a television variety program on rap music

6. This registration is valid, subsisting, in full force and effect, and serves as *prima facie* evidence of the validity of the RAP CITY Mark and of BET's exclusive right to use the RAP CITY Mark on the services listed in the registration as well as on goods and services where RAP CITY has certain expansion rights based on those registrations, such as clothing.

7. BET has invested tremendous resources, time, money, and effort in the creation, development and marketing of its goods and services associated with its RAP CITY Mark. ("BET Goods and Services"). The RAP CITY Mark is prominently featured in BET's

advertising, marketing, and promotional materials for the BET Goods and Services. As a result of this long-term, continuous, and extensive advertising and use of the RAP CITY Mark in connection with its television programming services and related goods, consumers have come to closely associate RAP CITY with BET, particularly when used in connection with music-related goods and services.

8. The RAP CITY Mark is a valuable asset of BET's business and has come to represent and symbolize the goodwill and widespread reputation that belongs exclusively to BET. As a result, relevant consumers readily recognize, associate, and identify BET as the single source and origin of the RAP CITY Mark for the BET Goods and Services.

9. Based on BET's use, promotion, and the popularity and success of the RAP CITY series, BET's RAP CITY Mark has also become famous within the industry and the meaning of 15 U.S.C. § 1125(c) and is entitled to a broad scope of protection.

Applicants and Application

10. Upon information and belief, Gabriel Isik and Idmon Yildiz ("Applicants") are individuals residing at Corwinstraat 7, Overijssel Oldenzaal Netherlands 7576ZE.

11. On or about September 3, 2021, Applicants filed the Application pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), to register the mark RAP CITY ("Applicant's Mark") for use in connection with "Marketing and distributing the prerecorded music of others on an online music streaming platform, namely, providing online music, not downloadable." in Class 41 ("Applicants' Services").

12. On or about July 26, 2022, Applicants' Mark was published for opposition in the Official Trademark Gazette.

COUNT I
LIKELIHOOD OF CONFUSION

13. BET repeats and realleges each and every allegation set forth in paragraphs 1 through 12 herein.

14. The RAP CITY Mark is famous in the United States and throughout the world, due to the extensive distribution and success of the BET Goods and Services using the RAP CITY Mark over a period of thirty years.

15. BET commenced use of the RAP CITY Mark well before Applicants filed the Application or commenced use of Applicants' Mark, giving BET priority in the rights to the RAP CITY Mark over Applicants.

16. Applicants' Mark is identical to the RAP CITY Mark in sight, sound, connotation, and overall commercial impression.

17. Applicants' Services are essentially identical to some of the BET Goods and Services with which BET is using the RAP CITY Mark, and complementary or related to many of the other BET Goods and Services.

18. Applicants' Services identified in the Application overlap with some of the BET Goods and Services for which the RAP CITY Mark is registered in the U.S., and are complementary or related to many of the other BET Goods and Services for which the RAP CITY Mark is registered in the U.S.

19. The channels of trade and class of consumers for Applicants' Services are not restricted. Accordingly, Applicants' Services are provided via at least some of the same channels of trade as the BET Goods and Services, and are likely to be provided to consumers familiar with BET, BET's RAP CITY Mark, and the BET Goods and Services.

20. Thus, registration of Applicants' Mark is likely to cause confusion, mistake, or deception as to the source of Applicants' services in violation Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II
DILUTION

21. BET repeats and realleges each and every allegation set forth in paragraphs 1 through 20 herein.

22. The RAP CITY Mark is highly distinctive in relation to the BET Goods and Services.

23. Through BET's extensive advertisement, promotion, and substantial sales of the BET Goods and Services, the RAP CITY Mark has become famous in the United States and throughout the world.

24. The RAP CITY Mark became famous before any constructive use date for Applicants' Mark as established by the filing date of the Application or otherwise.

25. Any use by Applicants of Applicants' Mark, to the extent that such use actually exists, occurred after the RAP CITY Mark became famous.

26. Relevant consumers are likely to make an association between Applicants' Mark and BET's RAP CITY Mark.

27. Applicants' Mark is likely to impair the distinctiveness of BET's RAP CITY Mark.

28. Applicants' Mark is likely to blur or tarnish the public's positive associations with BET's RAP CITY Mark.

29. Thus, Applicants' registration or use of Applicants' Mark is likely to cause dilution of the distinctive quality of BET's RAP CITY Mark in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(c), causing injury to BET.

COUNT III
FALSE SUGGESTION OF CONNECTION

30. BET repeats and realleges each and every allegation set forth in paragraphs 1 through 29 herein.

31. Applicants' Mark creates the same or similar commercial impression as it is identical to BET's RAP CITY Mark.

32. The public will recognize Applicants' Mark as the same or a close approximation of BET's RAP CITY Mark, in that Applicants' Mark points uniquely and unmistakably to BET.

33. BET is not connected in any way with Applicants' Services provided by Applicants using Applicants' Mark.

34. Due to the fame of BET and the RAP CITY Mark, when Applicants' Mark is used in commerce, a connection with BET will be presumed by the consuming public. Thus, Applicants' registration or use of Applicants' Mark is likely to create a false sense of connection with BET in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

WHEREFORE, based upon the foregoing, registration of Applicants' Mark is likely to cause injury and damage to BET and BET requests that the registration of Applicant's Mark be denied and that this Opposition against the Application be sustained.

DATED this 19th day of January, 2023.

Respectfully submitted,
Black Entertainment Television LLC
Opposer

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