

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

-----X	
ULTRA RECORDS, LLC,	:
	:
Plaintiff	:
	:
- against -	:
	:
ULTRA INTERNATIONAL MUSIC	:
PUBLISHING, LLC,	:
Defendant.	:
	:
-----X	

Case 1:22-cv-09667-ER  
**DEFENDANT’S ANSWER,  
AFFIRMATIVE DEFENSES,  
AND COUNTERCLAIM**

Defendant Ultra International Music Publishing, LLC (“Defendant” or “UIMP”), by and through its attorneys, hereby files this Answer, Affirmative Defenses, and Counterclaim to Plaintiff Ultra Records, LLC’s (“Plaintiff” or “URL”) Complaint, and respectfully shows the Court as follows:

**GENERAL DENIAL**

Pursuant to Fed. R. Civ. P. 8(b)(3), Defendant denies all allegations in Plaintiff’s Complaint except those specifically admitted below.

1. Plaintiff Ultra Records, LLC (“Ultra Records” or the “Company”) is an extraordinarily successful music label with a roster of prominent artists who have had a profound impact not just on music, but popular culture, for decades.

**RESPONSE: Defendant admits that URL is a record label with several prominent artists. Defendant is without sufficient information or knowledge to admit or deny the remaining allegations contained in Paragraph 1 of Plaintiff’s Complaint and therefore denies the same.**

2. Ultra Records was founded in approximately 1995 by Patrick Moxey. Moxey ran Ultra Records as its President from its founding, including after the purchase of a 50% interest in

Ultra Records by Sony Music Entertainment (“SME”) in 2012, until he left the Company when SME bought out his remaining interest in the Company in early 2022.

**RESPONSE: Defendant admits that URL was founded in approximately 1995 by Patrick Moxey and that Moxey was URL’s President from 1995 to early 2022. Defendant is without sufficient information or knowledge to admit or deny the remaining allegations contained in Paragraph 2 of Plaintiff’s Complaint and therefore denies the same.**

3. Notwithstanding that Moxey received a substantial payment as part of the buyout, after which he ceased to have any involvement in the business of Ultra Records, he has sought to perpetuate the falsehood that he remains involved with Ultra Records by wrongfully continuing to use Ultra Records’ ULTRA trademark as part of his music publishing business, defendant Ultra International Music Publishing, LLC (“Ultra International Music Publishing” or “Defendant”). Under the terms of a December 21, 2012 Asset Contribution and Membership Interest Purchase Agreement (the “December 2012 Agreement”), Ultra International Music Publishing and its affiliates were only permitted to use the word “Ultra” under license from Ultra Records. That license was terminated by Ultra Records following the buyout, effective March 29, 2022. Notwithstanding, Ultra International Music Publishing has continued to use the word “Ultra” in a manner that is violative of Ultra Records’ valuable trademark rights under both U.S. and New York law.

**RESPONSE: Defendant admits that it received a letter from URL purporting to cancel a non-existent license. Defendant further admits that Moxey was not involved in the management of URL after the buyout. Defendant denies the remaining allegations in Paragraph 3 of Plaintiff’s Complaint.**

4. Plaintiff Ultra Records is a limited liability company organized under the laws of the State of Delaware that maintains offices at 25 Madison Avenue, New York, New York.

**RESPONSE: Defendant is without sufficient information or knowledge to admit or deny the allegations contained in Paragraph 4 of Plaintiff’s Complaint and therefore denies the same.**

5. Upon information and belief, defendant Ultra International Music Publishing is a limited liability company organized under the laws of the State of New York, having its principal place of business at 137 West 25th Street, 10th Floor, New York, New York. Upon information and belief, Ultra International Music Publishing also does business under the following assumed names registered with the New York Secretary of State: Ultra Music Library, and Ultra Music.

**RESPONSE: Defendant admits that UIMP is a limited liability company organized under the laws of the State of New York, having its principal place of business at 137 West 25th Street, 10th Floor, New York, New York. UMIP admits that it has used Ultra Music Library and Ultra Music as assumed names to some extent, but neither are registered with the New York Secretary of State.**

6. This is a civil action arising out of Defendant’s infringement of certain federally registered trademarks owned and used by Ultra Records, false designations of origin and false representations, and unfair competition, in violation of §§ 32(1) and 43(a)(1)(A) of the Trademark Act of 1946, *as amended* (the “Lanham Act”), 15 U.S.C. §§ 1114(1) and 1125(a)(1)(A); and for trademark infringement and unfair competition under the common law of the State of New York.

**RESPONSE: Defendant admits that Plaintiff filed a Complaint for trademark infringement, false representations, and unfair competition, in violation of §§ 32(1) and 43(a)(1)(A) of the Trademark Act of 1946, *as amended* (the “Lanham Act”), 15 U.S.C. §§**

**1114(1) and 1125(a)(1)(A) and for trademark infringement and unfair competition under the common law of the State of New York. Defendant denies that Plaintiff has any valid cause of action against it and denies any liability associated with or arising from Plaintiff's alleged claims.**

7. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338 and has supplemental jurisdiction pursuant to 28 U.S.C. § 1367(a).

**RESPONSE: The allegations of Paragraph 7 of the Complaint are legal conclusions to which no response is required. To the extent Paragraph 7 contains statements that are not legal conclusions, Defendant admits that this Court has jurisdiction over the subject matter of this action and expressly denies that Plaintiff has any valid cause of action against Defendant and any liability associated with or arising from Plaintiff's alleged claims.**

8. Upon information and belief, this Court has personal jurisdiction over Defendant pursuant to CPLR 301 and 302 by virtue of its physical location within this State and this District, its commission of tortious conduct as described herein in the State of New York and this District, its transaction of business within the State of New York and this District, and its contracts to supply goods in the State of New York and this District, as described herein. In addition, the December 2012 Agreement contemplates that any actions with respect to that Agreement will be brought in the state or federal courts located in New York, New York.

**RESPONSE: The allegations of Paragraph 8 of the Complaint are legal conclusions to which no response is required. To the extent Paragraph 8 contains statements that are not legal conclusions, for purposes of this action alone, Defendant does not contest personal jurisdiction in this District. Defendant expressly denies that Plaintiff has any valid cause of**

**action against Defendant and any liability associated with or arising from Plaintiff's alleged claims.**

9. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and (c).

**RESPONSE: The allegations of Paragraph 9 of the Complaint are legal conclusions to which no response is required. To the extent Paragraph 9 contains statements that are not legal conclusions, for purposes of this action alone, Defendant does not contest venue in this District. Defendant expressly denies that Plaintiff has any valid cause of action against Defendant and any liability associated with or arising from Plaintiff's alleged claims.**

10. Ultra Records was founded in 1995 by Moxey, an experienced record label executive. Over time, Ultra Records has enjoyed phenomenal success releasing music created by a star-studded array of artists who have generated substantial popular and critical acclaim, as well as significant sales success.

**RESPONSE: Defendant admits that URL was founded in 1995 by Moxey, an experienced record label executive. Defendant is without sufficient information or knowledge to admit or deny the allegations contained in Paragraph 10 of Plaintiff's Complaint and therefore denies the same.**

11. Ultra Records' releases have both won and been nominated for many Grammy and other music industry awards, such as the Best American Music Label award from the International Dance Music Awards, which Ultra Records has won ten consecutive times. Dozens of Ultra Records' releases have received Diamond, Platinum and Gold certifications and achieved substantial success on recording charts both in the U.S. and internationally. Ultra Records' releases are disseminated through all of the most widely used digital streaming services, including Spotify, Pandora and Apple Music, as well as in physical form. Many of Ultra Records' releases

have been featured in films, television and streaming programs, video games and advertisements for well-known brands.

**RESPONSE: Defendant admits that some of URL's releases have won and been nominated for Grammys and other music industry awards. Defendant further admits that URL has won the title of International Dance Music Awards' Best American Music Label ten consecutive times. Defendant further admits that some of URL's releases have been featured in films, television, streaming programs, video games, and advertisements. Defendant admits that some of URL's releases are disseminated through digital streaming services like Spotify, Pandora, and Apple Music. Defendant is without sufficient information or knowledge to admit or deny the remaining allegations contained in Paragraph 11 of Plaintiff's Complaint and therefore denies the same.**

12. All of this sales, critical and popular success has resulted in the creation of substantial goodwill among consumers and the trade in the ULTRA trademark owned by Ultra Records. Indeed, Ultra Records has consciously sought over time to create an association among both consumers and the trade between the well-known artists on Ultra Records' roster and the ULTRA trademark. Exhibit 1 attached hereto is an example of how both consumers and the trade associate the ULTRA trademark with the artists signed to its label – a screenshot showing how Spotify tracks “Ultra Records New Releases,” with the ULTRA trademark prominently featured. This is simply one of many ways that consumers and the trade are exposed to and associate the ULTRA trademark with Ultra Records' musical releases, which are heavily advertised and promoted, often in combination with the ULTRA mark. Both consumers and the trade have come to associate the ULTRA trademark with Ultra Records and designating the source of Ultra Records' music releases.

**RESPONSE: Defendant admits the allegations of paragraph 12 of the Complaint to the extent it claims that the mark Ultra owned by URL has to some extent come to represent URL in the record business of Electronic Dance Music (EDM). However, Defendant denies that URL’s rights in the mark Ultra extend beyond that genre on the record business. Defendant also denies that any recognition of the mark Ultra as being related to or representing URL extends beyond the EDM genre of the record business. For example, in the music publishing business, the mark Ultra is associated with UIMP for a wide variety of genres of music. In the music festival business, the mark Ultra is associated with the Ultra Music Festival, which is unrelated to either URL or UIMP.**

13. The ULTRA trademark was first used by Ultra Records or its predecessor company in 1996, and the mark has been continuously used ever since in U.S. commerce. Ultra Records is the owner of trademark registrations issued by the U.S. Patent & Trademark Office on the Principal Trademark Register for the ULTRA trademark, as set forth below:

<u>Reg. No.</u>	<u>Trademark</u>	<u>Goods</u>
3,308,129	ULTRA	pre-recorded audio music compact discs
3,009,876	ULTRA	musical sound recordings

Both of the foregoing trademark registrations are valid and subsisting, as well as incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. The ULTRA trademark is distinctive and symbolizes consumer goodwill whose value to Ultra Records is substantial.

**RESPONSE: Defendant admits that Ultra is registered with the U.S. Patent & Trademark Office (“USPTO”) on the Principal Trademark Register. Defendant further states that the Registration Certificates and documents submitted to the USPTO speak for themselves. Defendant denies that Registration Number 3,308,129 is for Ultra. Defendant**

**further denies that Ultra is distinctive to URL. Defendant is without sufficient information or knowledge to admit or deny the remaining allegations contained in Paragraph 13 of Plaintiff's Complaint and therefore denies the same.**

14. Moxey was the original founder of Ultra Records, and he both ran and was closely associated with Ultra Records for many years. Moxey, Ultra Records and SME, along with another company associated with Moxey, entered into the December 2012 Agreement as part of a transaction that established a global arrangement between SME and Moxey, conducted through Ultra Records, that gave Ultra Records access to SME's domestic and international marketing and promotional resources, while granting SME an ownership interest in Ultra Records. After the relationship was established, Ultra Records, with SME's assistance, achieved even more sales and critical success than had been the case previously.

**RESPONSE: Defendant admits the allegations of paragraph 14 of the Complaint except for the last sentence. Defendant is without sufficient information or knowledge to admit or deny the allegations contained in the last sentence of Paragraph 14 of Plaintiff's Complaint and therefore denies the same.**

15. Between December 21, 2012 and December 20, 2021, Moxey was at all times the Ultra Records executive who managed the day-to-day operations of Ultra Records and served as the public face of the company, holding the title of President. Between December 21, 2012 and December 20, 2021, both SME and Moxey owned a 50% interest in Ultra Records. Upon the effective date of a December 2021 buyout agreement, SME became the sole owner of the Company.



**RESPONSE: Defendant admits the allegations of paragraph 15 of the Complaint, except that Moxey was not in full control of the actions of URL and had to get permission from SME for certain decisions.**

16. During the decade in which Ultra Records was co-owned by SME and Moxey, defendant Ultra International Music Publishing operated a music publishing business using “Ultra” as part of its name. Ultra International Music Publishing was and, upon information and belief, remains owned or controlled by Moxey and/or other entities associated with him, and it was and is operated separately from Ultra Records, with no involvement by SME. Many Ultra Records artists have published their works through Ultra International Music Publishing.

**RESPONSE: Defendant admits that it is a music publishing business and has used “Ultra Publishing” in connection with its business. Defendant admits that Patrick Moxey owns UIMP, it is a separate company from URL, and that SME has no ownership interest in UIMP. Defendant further admits that URL and UIMP have co-existed as separate entities for at least 17 years. Any remaining allegations are expressly denied.**

17. The December 2012 agreement stated as follows with respect to the use of the word “Ultra” by defendant Ultra International Music Publishing, in Section 5.8(d):

SME acknowledges that Ultra International Music Publishing LLC (“UIMP”) makes use of and, following the Closing Date, will continue to make use of the “Ultra” name in the corporate names and business activities of the following entities: Ultra Music Publishing Inc., Ultra International Music Publishing LLC, Ultra Music Europe, Ultra Music Publishing Europe and Ultra Music Library. UIMP may continue to use the “Ultra” name only in the foregoing manner and only in connection with its music publishing and music library businesses. In no event will UIMP use the Ultra name in connection with the word “Records”. The Company [Ultra Records] will, and PM [Moxey] will cause UIMP to, negotiate in good faith in order to enter into a non-exclusive, non-transferrable license that incorporates the provisions of this Section 5.8(d) and such other terms as are appropriate for licenses of a similar nature.

Based on the foregoing, the parties agreed that any use of the term “Ultra” by Ultra International Music Publishing was authorized by Ultra Records, subject to certain restrictions, as part of a non-exclusive license and such use thereby inured to Ultra Records’ benefit. No written license agreement was ever executed between Ultra Records and Ultra International Music Publishing concerning the latter’s use of the ULTRA trademark. Rather, Ultra Records, then being managed primarily by Moxey, relied on Moxey’s control over Ultra International Music Publishing to assure the quality of the services offered by Ultra International Music Publishing under the ULTRA mark. At all relevant times, the quality of such services was acceptable to Ultra Records.

**RESPONSE: Defendant admits the allegations of paragraph 17 of the Complaint to the extent it quotes from the agreement, and admits that there is no and has never been a license agreement between itself and URL regarding the use of the term “Ultra” as a trademark and expressly denies that one is required. Defendant denies the remaining allegations in Paragraph 17 of Plaintiff’s Complaint.**

18. As discussed, in late 2021, SME exercised an option under its agreements with Moxey and entities affiliated with him to acquire from them sole ownership of Ultra Records in exchange for a substantial monetary payment, and Moxey exited Ultra Records in early 2022. In light of Moxey’s departure from Ultra Records, the Company decided to terminate the license to use the ULTRA trademark granted to Ultra International Music Publishing in 2012, which had no specified end date and was therefore terminable at will by Ultra Records under New York law, which governs the December 2012 Agreement, on reasonable notice to Ultra International Music Publishing.

**RESPONSE: Defendant denies the allegations of paragraph 18 of the Complaint other than it admits that URL sent a letter purporting to cancel a license which never existed.**

19. Accordingly, on December 29, 2021, Ultra Records sent written notice to Defendant that the license granted to it to use the term “Ultra” in connection with its business would terminate as of March 29, 2022. Thereafter, Defendant, through counsel, disputed the existence of the license memorialized in the December 2012 Agreement, denied that its continued use of the term “Ultra” in connection with its music publishing business was violative of Ultra Records’ valuable trademark rights, and insisted that its use of that term with its business would continue. Upon information and belief, defendant Ultra International Music Publishing, as controlled by Moxey, continues to use the “Ultra” trademark in connection with music publishing services, which are closely related to the services offered by Ultra Records under the ULTRA trademark.

**RESPONSE: Defendant admits that it received a letter on or around December 29, 2021 from URL’s attorney and that Defendant’s counsel responded to that letter. Defendant states that the communications speak for themselves. Defendant admits that it uses the phrase “Ultra Publishing” in connection with its business. Defendant denies that Plaintiff has any valid cause of action against it and denies any liability associated with or arising from Plaintiff’s alleged claims. Any remaining allegations are expressly denied.**

20. Defendant, in common with the rest of the trade, is obviously well aware of Ultra Records’ ULTRA trademark, and of the goodwill represented and symbolized thereby. Notwithstanding said awareness, and in fact by reason of same, Defendant is knowingly perpetuating its use of the term “Ultra” to foster a false connection with the business with which it was once associated. Such use has not been authorized by Ultra Records and is occurring in a

manner designed to confuse consumers and that violates the terms of the license Ultra Records terminated as of March 29, 2022.

**RESPONSE: Defendant denies the allegations of paragraph 20 of the Complaint, but admits it is aware of URL's Ultra trademark, and of the goodwill it has in the limited area of the record business in EDM music.**

21. Defendant's offering of music publishing and related services under the ULTRA trademark is intended to, and is likely to, cause confusion, mistake or deception of the trade and public and to cause them to believe that Defendant's services are authorized, sponsored or approved by Ultra Records or are otherwise affiliated or connected with Ultra Records and/or the ULTRA trademark.

**RESPONSE: Denied.**

22. Defendant's activities have caused and will continue to cause irreparable harm to Ultra Records and to the substantial goodwill embodied in the ULTRA trademark, and said acts will continue unless restrained by this Court.

**RESPONSE: Denied.**

23. Ultra Records has no adequate remedy at law for such infringement.

**RESPONSE: Denied.**

24. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

25. Defendant's conduct constitutes infringement of Ultra Records' ULTRA trademark in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

**RESPONSE: Denied.**

26. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

27. Defendant's conduct constitutes infringement, unfair competition and the use of false designations of origin and false descriptions and representations in violation of Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), with respect to Ultra Records' ULTRA trademark.

**RESPONSE: Denied.**

28. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

29. Defendant's conduct constitutes infringement of Ultra Records' ULTRA trademark under common law.

**RESPONSE: Denied.**

30. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

31. Defendant's bad faith conduct with respect to Ultra Records' ULTRA trademark constitutes unfair competition by passing off, misappropriation and unprivileged imitation under common law.

**RESPONSE: Denied.**

32. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

33. Defendant's conduct with respect to the ULTRA trademark will improperly dilute the value of such mark in violation of New York General Business Law § 360-l.

**RESPONSE: Denied.**

34. Ultra Records repeats and realleges each and every allegation set forth in the preceding paragraphs as if fully set forth herein.

**RESPONSE: Defendant repeats and incorporates by reference each and every response set forth in the preceding paragraphs as if fully set forth herein.**

35. In December 2012, Ultra Records granted Defendant the right to use the ULTRA trademark in connection with the business of Ultra International Music Publishing through a license, whether express or implied.

**RESPONSE: Denied.**

36. Thereafter, Ultra Records fully performed its obligations as licensor.

**RESPONSE: Denied.**

37. Since March 29, 2022, Defendant has breached the obligation inherent in such license to cease all use of the ULTRA trademark following the separation of Ultra Records from Ultra International Music Publishing.

**RESPONSE: Denied.**

38. Ultra Records has sustained damages resulting from such breach in an amount to be determined at trial.

**RESPONSE: Denied.**

### **AFFIRMATIVE DEFENSES**

Ultra International Music Publishing, LLC states the following defenses and affirmative defenses to the allegations in the Complaint, without prejudice to the denials in this Answer and without admitting any allegations of the Complaint not otherwise admitted, and hereby reserves the right to supplement or amend these defenses before trial:

1. Plaintiff's claims are barred by the doctrines of estoppel, waiver and/or acquiescence.
2. Plaintiff's claims are barred by the doctrine of laches.
3. Plaintiff's claims are barred by the doctrine of unclean hands. UIMP is the owner of the mark Ultra in the music publishing arena. Upon information and belief, SME fraudulently induced the sale of URL by agreeing that URL would give UIMP a perpetual license to use the mark Ultra in the music publishing arena in return for assigning the rights to the mark Ultra in the music publishing arena when it had no intention of making such an exchange.
4. Even if UIMP is not the owner of the mark Ultra in the music publishing arena, UIMP has at least a perpetual license to use the mark in the music publishing arena.
5. Plaintiff's claims are barred because Plaintiff has not suffered any damages.

6. Defendant's alleged actions were justified, lawful and legal, and immune from liability.

7. Plaintiff's damages, if any, were the result of its own conduct. Plaintiff's claims are barred, in whole or in part, due to its failure to mitigate its alleged damages. Alternatively, Plaintiff's claims are barred, in whole or in part, due to its complete mitigation of its alleged damages.

8. Plaintiff is not entitled to injunctive relief because any alleged injury to Plaintiff is not immediate or irreparable, and Plaintiff has an adequate remedy at law.

9. Defendant reserves the right to assert additional defenses upon discovery of further information concerning Plaintiff's claim.

WHEREFORE, Defendant Ultra International Music Publishing, LLC respectfully requests that this Court enter judgment in its favor and against Plaintiff and dismiss this action with prejudice as frivolous and unjustified and order Plaintiff, pursuant to, among other things, 15 USC § 1117, to pay Defendant such costs, attorneys' fees, and expenses incurred by Defendant, and interest thereon in defending this lawsuit, and such other further relief as this Court deems just and proper.

**JURY DEMAND**

UIMP demands a trial by jury on all of its claims so triable.



## **COUNTERCLAIM**

In accordance with Rule 13 of the Federal Rules of Civil Procedure, Defendant/Counter-claimant Ultra International Music Publishing, LLC (“UIMP”), incorporates by reference its responses to the complaint stated above as if fully set forth herein, and asserts the following counterclaim against Plaintiff/Counter-defendant Ultra Records, LLC (“URL”), as follows:

### **INTRODUCTION**

1. Patrick Moxey developed two separate and successful companies. One was URL, a record label that usually represents artists in their performance of music. The other company was UIMP, which publishes music under the mark Ultra Publishing. A music publisher usually represents artists and songwriters with respect to their creation of music.

2. These two companies were successful in their respective fields, but were separate entities with separate businesses; each have its own staff, infrastructure, and company culture. In addition, URL focused its record company activity exclusively in the genre of Electronic Dance Music (EDM). UIMP’s music publishing business adopted a much wider remit, including, but not limited to Hip-Hop, Pop, Jazz, Reggae, R&B, and EDM.

3. UIMP is widely acknowledged as being one of the world’s leading independent music publishers having enjoyed almost two decades of commercial and critical acclaim, with a catalogue of over 40,000 songs. UIMP represents songs co-written with Drake, Post Malone, Ed Sheeran, Madonna, Chris Brown, Kanye West, Rihanna, Katy Perry, Migos, Future, Gucci Mane, Kygo, Young Thug, Gunna, Cardi B, Nikki Minaj, and many other superstar artists. UIMP represents songs which appear on hundreds of Gold, Platinum, and Multi-Platinum album and singles and represents multiple songs which have been #1 in the USA, and multiple songs which have been #1 International hits from UK, France, Germany, Sweden, Australia, and other

countries. UIMP songwriters have been nominated for over 100 Grammy Awards, and UIMP writers have won multiple Grammy Awards. UIMP published material appears in commercials, videogames, movies, TV shows, and many other entertainment industry uses. For example, in 2022, UIMP published songs appeared in ads for Peloton, Apple, Amazon, McDonalds, and Hulu trailers.

4. UIMP is well known for its studio facilities and the writing camps it runs for its artists and songwriters; such camps are attended by Grammy award winning artists.

5. The vast majority of UIMP artists and songwriters are not represented by URL. In fact, less than 5% of UIMP songs are also represented by URL. Other record companies have more, including Universal Music.

6. URL was the owner of the mark Ultra in the record business and UIMP was the owner of the mark Ultra in the music publishing business. This separate ownership is reflected in the fact that when URL registered the mark Ultra in the USPTO, it only registered that mark for the record business services and not for the music publishing business. This is consistent with the fact that there are a number of other users of the mark Ultra in the music business, including the famous Ultra Music Festival, an annual electronic dance music live event which takes place in Miami.

7. In 2012, Sony purchased a 50% interest in URL. In the Agreement relating to the sale, there was a provision that assured UIMP of the continued use of the mark Ultra and the continued use of websites using the mark Ultra. That provision also provided a process whereby UIMP, while assured of the continued use of the mark Ultra, would give up its ownership of the mark Ultra in return for a license reflecting that continued use.

8. When Moxey proposed a license between URL and UIMP as provided for in the Agreement, he was required to get SME's approval. Despite repeated requests, SME did not respond to the requests for such approval; SME did not approve the license or even propose different terms. Thus, the exchange of ownership for a perpetual license was never consummated and UIMP remained the owner of the mark Ultra in the music publishing business.

9. When the remainder of the ownership of URL was sold to SME, the issue was raised again by UIMP and Moxey, but SME refused to even discuss the issue. After the sale of the remainder of URL to SME, URL sent a letter to UIMP where it stated that it was cancelling the "license" with about three months' notice; giving UIMP three months to transition its reputation and goodwill to a new mark where UIMP had spent over 20 years developing its reputation and goodwill in the Ultra mark in the publishing arena. UIMP responded that there was no license to cancel because UIMP – not URL – owned the trademark Ultra in the publishing arena and UIMP did not need a license from URL to continue to use the mark Ultra. URL waited about a year, and brought this action.

#### **PARTIES, JURISDICTION, AND VENUE**

10. UIMP is a limited liability company organized under the laws of the State of New York, having its principal place of business at 137 West 25th Street, 10th Floor, New York, New York.

11. On information and belief, URL is a limited liability company organized under the laws of the State of Delaware that maintains offices at 25 Madison Avenue, New York, New York.

12. This counterclaim arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 et seq. and the trademark laws of the United States, including the Lanham Act, 15 U.S.C. § 1051 et seq.

13. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338, and 2202.

14. This Court also has personal jurisdiction over URL at least because it has availed itself of the benefit of the Court for the present action.

15. Venue for this counterclaim is proper in this judicial district pursuant to 28 U.S.C. § 1391.

**FIRST COUNTERCLAIM**

**(For Declaratory Judgment)**

16. UIMP repeats and re-alleges the allegations of the preceding paragraphs in this Counterclaim as if fully set forth herein.

17. An actual controversy has arisen and now exists between UIMP and URL in that URL contends, and UIMP denies that UIMP's use of the word "Ultra" in connection with music publishing infringes URL's alleged trademark rights to the mark "Ultra" in the music publishing business.

18. URL does not have trademark rights in the mark "Ultra" in the music publishing business; rather, UIMP has rights to that mark in the music publishing business.

19. In view of the long co-existence of these two uses of the term Ultra in the music business and in view of the other uses of the term Ultra in the music business by third parties, there is no likelihood of confusion between the use of Ultra in the record business by URL and the use of Ultra in the music publishing business by UIMP.

20. As a result of the acts described in the foregoing paragraphs, there exists an actual and justiciable controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

21. UIMP seeks a judicial determination and declaration of the respective rights and duties of the parties based on URL's contentions as set forth in the paragraphs above. Such a determination and declaration are necessary and appropriate at this time so that the parties may ascertain their respective rights and duties regarding the non-infringement of the trademark rights in the mark "Ultra" in the music publishing business.

WHEREFORE, UIMP requests the Court grant the following relief:

- a) An order declaring that URL has no rights to the word "Ultra" as a trademark in the music publishing business but rather that UIMP has such rights;
- b) In the alternative, an order declaring that UIMP has a perpetual license to use the mark "Ultra" as a trademark in the music publishing business;
- c) An order declaring that UIMP's use of "Ultra" in connection with music publishing does not infringe any alleged trademark rights URL claims to have;
- d) An award of attorneys' fees to UIMP; and
- e) Such further relief as the Court deems just and proper.

Respectfully submitted, this 19<sup>th</sup> day of January, 2023.

By: /s/ Ethan Horwitz  
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***Attorneys for Defendant Ultra  
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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that the foregoing pleading was electronically filed with the Clerk by using the CM/ECF system, which will send a notice of electronic filing to all registered users of the CM/ECF system.

This 19th day of January, 2023.

/s/ Ethan Horwitz  
Ethan Horwitz