

ESTTA Tracking number: **ESTTA544014**

Filing date: **06/19/2013**

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	Home Box Office, Inc.
Granted to Date of previous extension	06/19/2013
Address	1100 Avenue of the Americas New York, NY 10036 UNITED STATES

Attorney information	Tamara F. Carmichael LOEB & LOEB LLP 345 Park Avenue New York, NY 10154 UNITED STATES chdocket@loeb.com, tcarmichael@loeb.com, jsarowitz@loeb.com, aprovenio@loeb.com, ngosselin@loeb.com
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Applicant Information

Application No	85710271	Publication date	02/19/2013
Opposition Filing Date	06/19/2013	Opposition Period Ends	06/19/2013
Applicant	Wade Sr., Antonio M. 19 Carters Grove Ct. Silver Spring, MD 20904 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baseball caps and hats; Button down shirts; Hooded sweat shirts; Knit jackets; Knit shirts; Long-sleeved shirts; Polo shirts; Rain jackets; Rainproof jackets; Rugby shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Track jackets
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration	1312132	Application Date	11/14/1983
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No.			
Registration Date	01/01/1985	Foreign Priority Date	NONE
Word Mark	HBO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1982/03/22 First Use In Commerce: 1982/03/22 Television Films, Videotapes and Video Cassettes Class 041. First use: First Use: 1972/11/08 First Use In Commerce: 1972/11/08 Premium or Pay Television Services		

U.S. Registration No.	2775329	Application Date	12/16/2002
Registration Date	10/21/2003	Foreign Priority Date	NONE
Word Mark	HBO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 HATS, JACKETS, SWEATSHIRTS, SPORT SHIRTS AND T-SHIRTS		

U.S. Registration No.	3996952	Application Date	11/24/2010
Registration Date	07/19/2011	Foreign Priority Date	NONE
Word Mark	HBO		
Design Mark			
Description of Mark	The mark consists of "HBO" letters with bullet "O".		
Goods/Services	Class 009. First use: First Use: 1999/01/10 First Use In Commerce: 1999/01/10 Pre-recorded video discs, DVDs, high definition digital discs, and videotapes, all in the fields of drama, comedy, documentary, sports, music and variety; compact discs and digital audio discs featuring content from or related to television programming or television series; pre-recorded compact discs and digital audio discs featuring soundtracks from or related to television programming or television series		

U.S. Registration No.	3755047	Application Date	02/01/2007
Registration Date	03/02/2010	Foreign Priority Date	NONE
Word Mark	HBO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1995/12/00 First Use In Commerce: 1995/12/00 Streaming of audio and visual material via the Internet; video on demand transmission services		

	Class 041. First use: First Use: 1995/12/00 First Use In Commerce: 1995/12/00 Education and entertainment services, namely, providing information in the field of variety shows, animated series, dramatic series, original programming, sports, comedies, musicals, current events and entertainment news and documentaries over the Internet
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U.S. Registration No.	2837948	Application Date	12/16/2002
Registration Date	05/04/2004	Foreign Priority Date	NONE
Word Mark	HBO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 [METAL KEY HOLDERS] Class 014. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 CLOCKS AND WATCHES Class 016. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 [PENCILS,] PENS [AND DRAWING AND DRAFTING RULERS] Class 018. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 [ATTACHE CASES, DUFFEL BAGS, GARMENT BAGS FOR TRAVEL,] TOTE BAGS [AND UMBRELLAS] Class 020. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 PICTURE FRAMES; [NON-METAL KEY HOLDERS] Class 021. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 MUGS AND THERMAL INSULATED CONTAINERS FOR BEVERAGE Class 024. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 [TOWELS]		

U.S. Registration No.	3848515	Application Date	02/23/2009
Registration Date	09/14/2010	Foreign Priority Date	NONE
Word Mark	HBO GO		
Design Mark			
Description of Mark	The mark consists of the words "HBO" and "GO" in which the letter "O" in both these words contain a circle within the "O".		
Goods/Services	Class 041. First use: First Use: 2010/02/18 First Use In Commerce: 2010/02/18 Entertainment services in the nature of providing entertainment programs and content, namely, television programs, clips, graphics and information relating to television programs in the fields of comedy, drama, action, variety, adventure, sports, musicals, current events and entertainment news, documentary and animation, via the Internet, electronic communications networks, computer networks and wireless communications networks		

U.S. Registration No.	3848514	Application Date	02/23/2009
Registration Date	09/14/2010	Foreign Priority Date	NONE
Word Mark	HBO GO		

Design Mark	
Description of Mark	The mark consists of the words "HBO" and "GO" in which the letter "O" in both these words contain a circle within the "O".
Goods/Services	Class 038. First use: First Use: 2010/02/18 First Use In Commerce: 2010/02/18 Mobile media services in the nature of electronic transmission, broadcasting and delivery of audio, video and multimedia entertainment content including text, data, images, audio, video and audiovisual files by means of the internet, wireless communication, electronic communications networks and computer networks

U.S. Registration No.	3848513	Application Date	02/23/2009
Registration Date	09/14/2010	Foreign Priority Date	NONE
Word Mark	HBO GO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2010/02/18 First Use In Commerce: 2010/02/18 Entertainment services in the nature of providing entertainment programs and content, namely, television programs, clips, graphics and information relating to television programs in the fields of comedy, drama, action, variety, adventure, sports, musicals, current events and entertainment news, documentary and animation, via the Internet, electronic communications networks, computer networks and wireless communications networks		

U.S. Registration No.	3788398	Application Date	02/23/2009
Registration Date	05/11/2010	Foreign Priority Date	NONE
Word Mark	HBO GO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2010/02/18 First Use In Commerce: 2010/02/18 Mobile media services in the nature of electronic transmission, broadcasting and delivery of audio, video and multimedia entertainment content including text, data, images, audio, video and audiovisual files by means of the internet, wireless communication, electronic communications networks and computer networks		

U.S. Registration No.	3880592	Application Date	01/26/2009
Registration Date	11/23/2010	Foreign Priority Date	NONE
Word Mark	HBO HD		
Design Mark			
Description of Mark	The mark consists of "HBO" Logo with bullet "O" design element and "HD" with bullet "D" design element.		
Goods/Services	Class 041. First use: First Use: 2009/09/14 First Use In Commerce: 2009/09/14 Premium or pay television services, namely, production and distribution of television programs and motion pictures rendered through the media of		

	television, cable and satellite systems, and the Internet; premium and pay television programming services
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U.S. Registration No.	1748977	Application Date	05/18/1992
Registration Date	01/26/1993	Foreign Priority Date	NONE
Word Mark	HOME BOX OFFICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1972/11/08 First Use In Commerce: 1972/11/08 premium or pay television services		

U.S. Registration No.	1018960	Application Date	10/10/1973
Registration Date	08/26/1975	Foreign Priority Date	NONE
Word Mark	HOME BOX OFFICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1972/11/08 First Use In Commerce: 1972/11/08 SUPPLYING AND DISTRIBUTING PROGRAMS TO CABLE TELEVISION AND/OR MASTER ANTENNA SYSTEMS		

U.S. Registration No.	1307806	Application Date	11/14/1983
Registration Date	12/04/1984	Foreign Priority Date	NONE
Word Mark	HOME BOX OFFICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1982/03/22 First Use In Commerce: 1982/03/22 Cinematographic Films, Videotapes and Video Cassettes		

Attachments	1208071_1.pdf(19287 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	/Tamara F. Carmichael/
Name	Tamara F. Carmichael
Date	06/19/2013

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

**In the Matter of Application Serial No. 85/710,271: H B O HELPING BROTHERS OUT
Published in the *Official Gazette* of February 19, 2013**

HOME BOX OFFICE, INC.,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
ANTONIO M. WADE, SR.)	
)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Home Box Office, Inc. (“Opposer”), a Delaware corporation located and doing business at 1100 Avenue of the Americas, New York, New York 10036, believes it will be damaged by the registration of the trademark **H B O HELPING BROTHERS OUT** in International Class 25 in Application Serial No. 85/710,271, filed by Antonio M. Wade, Sr. (“Applicant”), and hereby opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer operates well-known and widely distributed premium television channels and is the producer of original entertainment content.

2. Since long prior to the filing of Applicant’s Application Serial No. 85/710,271, Opposer has marketed, distributed and sold its premium subscription television services and produced original content under the trademarks HBO, HOME BOX OFFICE, HBO GO, and others (collectively the “HBO Marks”).

3. Opposer owns applications and registrations for the HBO Marks for premium subscription television services and other related goods and services with the United States Patent and Trademark Office (“PTO”). Opposer’s registrations include, but are not limited to:

<u>TRADEMARK</u>	<u>REG. NO.</u>
HBO	1,312,132
HBO	2,775,329
HBO	3,996,952
HBO	3,755,047
HBO	2,837,948
HBO GO	3,848,515
HBO GO	3,848,514
HBO GO	3,848,513
HBO GO	3,788,398
HBO HD	3,880,592
HOME BOX OFFICE	1,748,977
HOME BOX OFFICE	1,018,960
HOME BOX OFFICE	1,307,806

These registrations are valid, subsisting, and owned by Opposer. Reg. Nos. 1,307,806, 1,748,977, 1,018,960, 1,312,132, 2,775,329 and 2,837,948 are also incontestable pursuant to 15 U.S.C. §§1064 and 1115(b).

4. By virtue of the popularity of Opposer’s goods and services offered or sold in connection with the HBO Marks, Opposer has built up and now owns an extremely valuable goodwill which is symbolized by its HBO Marks.

5. Applicant’s proposed use of the H B O HELPING BROTHERS OUT mark for “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms;

Baseball caps and hats; Button down shirts; Hooded sweat shirts; Knit jackets; Knit shirts; Long-sleeved shirts; Polo shirts; Rain jackets; Rainproof jackets; Rugby shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Track jackets” in International Class 25 (“Applicant’s Goods”) in App. Ser. No. 85/710,271 is without Opposer’s consent or permission.

Count I – Likelihood of Confusion

6. Opposer realleges the allegations in Paragraphs 1 through 5.

7. Opposer believes that Applicant’s proposed use of H B O HELPING BROTHERS OUT for Applicant’s Goods may cause confusion, mistake, or deception in that consumers may be likely to believe Applicant’s Goods are Opposer’s goods or the goods of a person or company that is sponsored, authorized or licensed by, or in some other way legitimately connected with, Opposer.

Count II. Dilution

8. Opposer realleges the allegations in Paragraphs 1 through 5.

9. Prior to Applicant’s filing date, Opposer’s HBO Marks became distinctive and famous in accordance with 15 U.S.C. § 1125(c).

10. Applicant’s use of H B O HELPING BROTHERS OUT in connection with Applicant’s Goods is likely to cause dilution of Opposer’s famous HBO Marks.

Count III – False Association

11. Opposer realleges the allegations of Paragraphs 1 through 5.

12. Applicant’s H B O HELPING BROTHERS OUT mark contains Opposer’s HBO Mark and is a close approximation of Opposer’s HBO Marks and identity.

13. Applicant's proposed use of H B O HELPING BROTHERS OUT mark for Applicant's Goods falsely suggests a connection with Opposer and Opposer's HBO Marks and related goods and services in violation of Section 2(a) of the Trademark Act.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 85/710,271 be denied registration.

Please debit our Deposit Account No. 502547 for the filing fee and for any additional necessary fees.

Please address all correspondence to Tamara F. Carmichael, Esq., Loeb & Loeb LLP, 345 Park Avenue, New York, New York, 10154.

Date: June 19, 2013

LOEB & LOEB LLP

By: /s/ Tamara F. Carmichael
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*Attorneys for Opposer
Home Box Office, Inc.*

CERTIFICATE OF SERVICE

I, Noreen Gosselin, hereby certify that a copy of this **NOTICE OF OPPOSITION** has been served upon:

WADE SR., ANTONIO M.
19 CARTERS GROVE CT
SILVER SPRING, MARYLAND 20904-6629

via first class mail, postage prepaid, on this 19th day of June, 2013.

/s/Noreen Gosselin

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