

ESTTA Tracking number: **ESTTA551463**

Filing date: **07/31/2013**

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	LIGHTS OUT HOLDINGS, LLC
Granted to Date of previous extension	07/31/2013
Address	10617 BIRCH BLUFF AVENUE SAN DIEGO, CA 92131 UNITED STATES

Attorney information	Andrew D. Skale Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. 3580 Carmel Mountain Road Suite 300 San Diego, CA 92130 UNITED STATES adskale@mintz.com, jddib@mintz.com Phone:858-314-1506
----------------------	--

Applicant Information

Application No	85777061	Publication date	04/02/2013
Opposition Filing Date	07/31/2013	Opposition Period Ends	07/31/2013
Applicant	Franco Manufacturing Company, Inc. 555 Prospect Street Metuchen, NJ 08840 UNITED STATES		

Goods/Services Affected by Opposition

Class 024. All goods and services in the class are opposed, namely: Window treatments in the nature of window panels of polyester, cotton and wool

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4242170	Application Date	04/24/2007
Registration Date	11/13/2012	Foreign Priority Date	NONE
Word Mark	LIGHTS OUT		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 028. First use: First Use: 2007/00/00 First Use In Commerce: 2007/00/00 Action figures; collectable toy figures; molded toy figures; play figures; toy figures Class 035. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Promoting the goods and services of others through licensing of the identity, name, nickname, and image of a sports celebrity

U.S. Registration No.	3990916	Application Date	04/24/2007
Registration Date	07/05/2011	Foreign Priority Date	NONE

Word Mark	LIGHTS OUT
-----------	------------

Design Mark	
-------------	--

Description of Mark	NONE
---------------------	------

Goods/Services	Class 028. First use: First Use: 2002/00/00 First Use In Commerce: 2002/00/00 Footballs Class 035. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Online retail store featuring sporting goods, sports memorabilia, clothing; promoting the goods and services of others through the issuance of product and service endorsements by a sports celebrity, and through advertising appearances for products and services by a sports celebrity Class 038. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Providing an on-line electronic bulletin board for transmission of messages among computer users concerning a professional football player and sports celebrity Class 041. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Providing a website featuring a the biography and biographical information about appearances, accomplishments, exploits, and charitable and philanthropic works of a college and professional football player; entertainment services, namely, personal appearances and speeches by a sports celebrity; entertainment services, namely, radio and television appearances and commentary by a sports celebrity
----------------	---

U.S. Registration No.	2885212	Application Date	02/10/2003
Registration Date	09/14/2004	Foreign Priority Date	NONE

Word Mark	LIGHTS OUT
-----------	------------

Design Mark	
-------------	--

Description of Mark	NONE
---------------------	------

Goods/Services	Class 025. First use: First Use: 2004/06/11 First Use In Commerce: 2004/06/11 Clothing [and shoes] for men, women and children, namely, [anklets, anoraks, athletic footwear, athletic shoes, athletic uniforms, beachwear, belts, blouses, boots,] bottoms, boxer shorts, [brassieres, briefs, bustiers,] caps, [cardigans, coats, footwear, gloves, golf shirts,] hats, [headbands,] headwear, [intimate apparel, jackets, jeans, jerseys, jogging suits, jumpers, knit shirts,] night wear, [overalls, overcoats, pajamas, pants, polo shirts, pullovers, quilted vests, raincoats, robes,] shirts, [shoes,] shorts, sleepwear, [sport coats, sport shirts, sweaters, sweatpants,] sweatshirts, [skirts, socks, sweatsuits,] tank tops, tops,
----------------	---

	[tracksuits, trousers,] T-shirts, underwear, [V-neck sweaters, vests, waistcoats]
--	---

U.S. Application No.	85289437	Application Date	04/07/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LIGHTS OUT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Sports equipment for boxing, martial arts and mixed martial arts, namely, protective headgear; workout and exercise video cassettes, workout and exercise CDs, workout and exercise DVDs</p> <p>Class 018. First use: Luggage; tote bags, duffle bags, gym bags, all-purpose sport bags and backpacks; sports luggage and gym bags</p> <p>Class 025. First use: Clothing, namely, boxing, martial arts and mixed martial arts uniforms, pants, robes, shirts, shorts, and underwear; boxing jerseys; boxing shorts; boxing trunks; briefs; exercise suits; jackets; jogging suits; muscle shirts; sauna suits; socks; sweatpants; sweatshirts; t-shirts, track suits; martial arts uniforms; scarves; gloves; belts, namely, belts made of leather, belts of textile; footwear; boxing shoes; headgear, namely, hats and caps</p> <p>Class 028. First use: Athletic equipment for boxing, martial arts, mixed martial arts and the like, namely, ear and eyebrow protectors, headguards, boxing masks, mouth guards for athletic use, hand wraps, boxing and weight-lifting gloves, sports gloves, boxing gloves, mixed martial arts gloves, workout gloves, fighting gloves, weight lifting gloves, striking bags, body protectors for football, abdominal guards for athletic use, belly protectors, groin protectors, shin guards, athletic supporters, rowing machines, chest weights for athletic use and for exercising, spring bar tension sets for use in exercising, training dummies for boxing, dumbbells, striking-bag platforms, exercise apparatus for the development of the strength of an athlete's grip, medicine balls, boxing bags, punching bags, heavy bags and speed bags, boxing bag swivels, apparatus to support a moving heavy bag, skipping ropes, boxing and wrestling rings, protective bras, punching mitts, weight lifting benches, weightlifting gloves and weightlifting belts; exercise equipment, namely, climbing ropes for strength training and stair-stepping machines; stationary exercise bicycles for sports training; training apparatus for boxing, martial arts, mixed martial arts and similar sports</p>		

U.S. Application No.	85968815	Application Date	06/25/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LIGHTS OUT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Non-medicated cosmetics and skin care products, namely, soaps, creams,</p>		

	lotions, perfume; personal body care products, namely, body polish, massage oil		
U.S. Application No.	85968807	Application Date	06/25/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LIGHTS OUT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: Home furnishings, namely, pillow cases, pillow shams, draperies, curtains, curtains in the nature of curtain panels, textile curtain tie-backs, unfitted fabric furniture covers; bathroom accessories, namely, large bath towels, bath towels, beach towels, towels, bath sheets; bedding accessories, namely, bed linen, bed blankets, bed covers, bed sheets, bed throws, blanket throws, household linen, sheet sets, woolen blankets, bedspreads, duvet cover, comforters, flat bed sheets; top of beds		

Attachments	Notice of Opposition - LIGHTS OUT.pdf(26726 bytes)
-------------	---

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	/Andrew D. Skale/
Name	Andrew D. Skale
Date	07/31/2013

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

In the matter of Application Serial No. 85/777061 for the mark: LIGHTS OUT
Published in the *Official Gazette* April 2, 2013

Lights Out Holdings, LLC

Opposer,

v.

Franco Manufacturing Company, Inc.

Applicant.

Opposition No. _____

Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, Virginia 22314

NOTICE OF OPPOSITION

Lights Out Holdings, LLC (“Opposer”), a California Limited Liability Company, located and doing business at 10617 Birch Bluff Avenue, San Diego, CA 92131, believes that it will be damaged by registration of U.S. Application Serial No. 85/777061 for the mark LIGHTS OUT and hereby opposes the same. The goods for the mark are outlined in Schedule A, attached hereto.

Pursuant to 15 U.S.C. §§ 1052, 1063 and 1125 of the Lanham Act, and 37 C.F.R. §§ 2.101 and 2.104, and predicated upon the following grounds, Opposer alleges the following:

1. Opposer promotes the goods and services of others through licensing of the identity, name, nickname, and image of a sports celebrity; conducts business through and online retail store featuring sporting goods, sports memorabilia, clothing; promoting the goods and services of others through the issuance of product and service endorsements by a sports celebrity, and through advertising appearances for products and services by a sports celebrity; manufactures and sells action figures; collectable toy figures; molded toy figures; play figures; toy figures; sports equipment, and various articles of clothing and will be manufacturing and selling cosmetics, jewelry, home furnishings among others.

2. Opposer owns the following U.S. registrations and applications for its family of LIGHTS OUT marks:

Registration / Application No.	Mark	Goods / Services
Reg. No. 4,242,170 Issued: November 13, 2012	LIGHTS OUT	28: Action figures; collectable toy figures; molded toy figures; play figures; toy figures. 35: Promoting the goods and services of others through licensing of the identity, name, nickname, and image of a sports celebrity.

<p>Reg. No. 3,990,916 Issued: July 5, 2011</p>	<p>LIGHTS OUT</p>	<p>Class 28: Footballs.</p> <p>Class 35: Online retail store featuring sporting goods, sports memorabilia, clothing; promoting the goods and services of others through the issuance of product and service endorsements by a sports celebrity, and through advertising appearances for products and services by a sports celebrity</p> <p>Class 38: Providing an on-line electronic bulletin board for transmission of messages among computer users concerning a professional football player and sports celebrity.</p> <p>Class 41: Providing a website featuring a the biography and biographical information about appearances, accomplishments, exploits, and charitable and philanthropic works of a college and professional football player; entertainment services, namely, personal appearances and speeches by a sports celebrity; entertainment services, namely, radio and television appearances and commentary by a sports celebrity.</p>
<p>Reg. No. 2,885,212 Issued: September</p>	<p>LIGHTS OUT</p>	<p>Class 25: Clothing for men, women and children, namely, bottoms, boxer shorts, caps, hats,</p>

Registration / Application No.	Mark	Goods / Services
14, 2004		headwear, night wear, shirts, shorts, sleepwear, sweatshirts, tank tops, tops, t-shirts, underwear
Application No. 85/289437 Filed: April 7, 2011	LIGHTS OUT	<p>Class 9: Sports equipment for boxing, martial arts and mixed martial arts, namely, protective headgear; workout and exercise video cassettes, workout and exercise CDs, workout and exercise DVDs.</p> <p>Class 18: Luggage; tote bags, duffle bags, gym bags, all-purpose sport bags and backpacks; sports luggage and gym bags.</p> <p>Class 25: Clothing, namely, boxing, martial arts and mixed martial arts uniforms, pants, robes, shirts, shorts, and underwear; boxing jerseys; boxing shorts; boxing trunks; briefs; exercise suits; jackets; jogging suits; muscle shirts; sauna suits; socks; sweatpants; sweatshirts; t-shirts, track suits; martial arts uniforms; scarves; gloves; belts, namely, belts made of leather, belts of textile; footwear; boxing shoes; headgear, namely, hats and caps.</p> <p>Class 28: Athletic equipment for boxing, martial arts, mixed martial</p>

Registration / Application No.	Mark	Goods / Services
		<p>arts and the like, namely, ear and eyebrow protectors, headguards, boxing masks, mouth guards for athletic use, hand wraps, boxing and weight-lifting gloves, sports gloves, boxing gloves, mixed martial arts gloves, workout gloves, fighting gloves, weight lifting gloves, striking bags, body protectors for football, abdominal guards for athletic use, belly protectors, groin protectors, shin guards, athletic supporters, rowing machines, chest weights for athletic use and for exercising, spring bar tension sets for use in exercising, training dummies for boxing, dumbbells, striking-bag platforms, exercise apparatus for the development of the strength of an athlete's grip, medicine balls, boxing bags, punching bags, heavy bags and speed bags, boxing bag swivels, apparatus to support a moving heavy bag, skipping ropes, boxing and wrestling rings, protective bras, punching mitts, weight lifting benches, weightlifting gloves and weightlifting belts; exercise equipment,</p>

Registration / Application No.	Mark	Goods / Services
		namely, climbing ropes for strength training and stair-stepping machines; stationary exercise bicycles for sports training; training apparatus for boxing, martial arts, mixed martial arts and similar sports
Application No. 85/968815 Filed: June 25, 2013	LIGHTS OUT	Class 3: Non-medicated cosmetics and skin care products, namely, soaps, creams, lotions, perfume; personal body care products, namely, body polish, massage oil.
Application No. 85/968807 Filed: June 25, 2013	LIGHTS OUT	Class 24: Home furnishings, namely, pillow cases, pillow shams, draperies, curtains, curtains in the nature of curtain panels, textile curtain tie-backs, unfitted fabric furniture covers; bathroom accessories, namely, large bath towels, bath towels, beach towels, towels, bath sheets; bedding accessories, namely, bed linen, bed blankets, bed covers, bed sheets, bed throws, blanket throws, household linen, sheet sets, woolen blankets, bedspreads, duvet cover, comforters, flat bed sheets; top of beds.

3. Upon information and belief, Franco Manufacturing Company, Inc. (“Applicant”) is a New Jersey corporation with an address at 555 Prospect Street, Metuchen, NJ

08840. Applicant seeks to register the mark LIGHTS OUT (the “Mark”) for “window treatments in the nature of window panels of polyester, cotton and wool” in Class 24 pursuant to an intent to use application filed November 12, 2012.
4. Opposer’s rights in its family of LIGHTS OUT marks predate the November 12, 2012 filing date of Applicant’s application. Therefore, Opposer has prior and superior rights in this matter.
 5. Applicant’s mark for LIGHTS OUT is confusingly similar to Opposer’s family of LIGHTS OUT marks and is used or intended to be used on products identical to or likely to be confused with Opposer’s products and services. When used on the goods and set forth in Applicant’s application, Applicant’s mark LIGHTS OUT is likely to cause confusion and mistake and to deceive purchasers and potential purchasers of Applicant’s goods and Opposer’s goods and services into erroneously believing that there is a relationship between Opposer and Applicant, or that Opposer has authorized, sponsored, or licensed Applicant’s use of the mark LIGHTS OUT, in violation of 15 U.S.C. § 1052(d).
 6. Registration of Applicant’s mark will damage Opposer since such registration will give color of exclusive statutory rights to Applicant in the mark LIGHTS OUT in derogation and violation of the prior and superior rights of Opposer.
 7. WHEREFORE, Opposer believes that it will be damaged by the registration of Applicant’s Mark and requests that judgment be entered in its favor and against Applicant on all counts and that Application Serial No. 85/777061 for the mark LIGHTS OUT be denied registration.

Respectfully submitted,

LIGHTS OUT HOLDINGS, LLC

By: /Andrew D. Skale/
Andrew D. Skale
Mintz, Levin, Cohn, Ferris, Glovsky, and
Popeo, P.C.
3580 Carmel Mountain Road
Ste 300
San Diego, CA. 92130
Tel: 858-314-1506
Fax: 858-314-1501
E-mail: adskale@mintz.com
Attorneys for Opposer
Lights Out Holdings, LLC

Dated: July 31, 2013

SCHEDULE A

Lights Out Holdings, LLC v. Franco Manufacturing Company, Inc.

Opposition No.

Applicant's Mark and Applied for Goods

Serial No.	Mark	Goods / Services
85/777061	LIGHTS OUT	Class 24: Window treatments in the nature of window panels of polyester, cotton and wool.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served by U.S. mail, first class, postage prepaid, on this 31st day of July, 2013 on the Applicant at the address listed in the current U.S. Trademark Office Records as follows:

GWYNNE B. SUGG

MALDJIAN LAW GROUP LLC

36 BINGHAM AVENUE

RUMSON, NEW JERSEY 07760

_____/Shannon Thrash /_____
Shannon Thrash