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

Proceeding	91224569
Party	Plaintiff Traxxas LP
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Submission	Motion to Amend Pleading/Amended Pleading
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Attachments	TRAX 3105018 First Amended Grounds For Opposition as Filed 12-18-2015.pdf(179092 bytes)

As its first amended grounds for this Opposition, Opposer alleges:

1. Traxxas LP (“Opposer”) has since at least November 28, 1999, used and continues to use the mark “T-MAXX” to identify, advertise, and promote its radio-controlled model vehicles and parts therefor. Opposer registered its mark T-MAXX on November 7, 2006 (Reg. No. 3169710) for the same goods after making an application for registration on December 15, 2004. Opposer’s right to use its T-MAXX mark has become incontestable.

2. Opposer has since at least December of 1999 used and continues to use the mark “MAXX” to identify, advertise, and promote its radio-controlled model vehicles and parts therefor. Opposer registered its mark MAXX on January 2, 2007 (Reg. No. 3191106) for the same goods after making an application for registration on December 15, 2004. Opposer’s right to use its MAXX mark has become incontestable.

3. Opposer has since at least December 4, 2000, used and continues to use the mark “E-MAXX” to identify, advertise, and promote its radio-controlled model vehicles and parts therefor. Opposer registered its mark E-MAXX on May 12, 2009 (Reg. No. 3619270) for the Goods after making an application for registration on October 7, 2008. Opposer’s right to use its E-MAXX mark has become incontestable.

4. Opposer has since at least July 17, 2009, used and continues to use the mark “MINI MAXX” to identify, advertise, and promote its parts for radio controlled scale model vehicles. Opposer registered its mark MINI MAXX on October 13, 2009 (Reg. No. 3697101) for the same goods after making an application for registration on July 15, 2003.

5. It has come to the attention of Opposer that the entity Kidztech Toys Manufacturing Limited (“Applicant”) has applied for registration of the stylized words “TOPMAXX Racing” (the “TOPMAXX RACING mark”), in the United States Patent and

Trademark Office, as shown in U.S. Application Ser. No. 86/537,763 (the “Application”), having a filing date of February 18, 2015 and indicating an earliest use date of October 2013. As example of this mark is shown below:



The Application for the TOPMAXX RACING mark seeks registration in Class 28 for: *Toys, namely, construction toys, electric action toys, electronic learning toys; radio controlled toy vehicles; scale model vehicles; toy vehicles; remote control toys, namely, cars, race cars, airplanes,; games, namely, card games, board games, chess games; mechanical, electronic and electromechanical toys, namely, mechanical action toys; electronic hand-held toys and games, namely, hand-held electronic games adapted for use with television receivers only; outdoor toys, namely, outdoor activity game equipment sold as a unit comprising sports balls for playing games* (the “Applicant’s Goods”).

6. Applicant seeks to register the TOPMAXX RACING mark for Applicant’s Goods in International Class 028 as evidenced by the publication of the Application in the Official Gazette on September 15, 2015.

7. The TOPMAXX RACING mark is confusingly similar to Opposer’s T-MAXX, MAXX, E-MAXX, and MINI MAXX marks when the marks are viewed as a whole. The TOPMAXX RACING mark and Opposer’s T-MAXX, MAXX, E-MAXX, and MINI MAXX marks all include the term “MAXX.”

8. By virtue of Opposer's prior and senior rights arising from use of the T-MAXX, MAXX, E-MAXX, and MINI MAXX marks, the Applicant is barred from obtaining a registration of the TOPMAXX RACING mark, because the use and attempt to register by Applicant of the TOPMAXX RACING mark for the Applicant's Goods, without authorization by Opposer, creates a likelihood of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), that there exists a common source, affiliation, and sponsorship with the goods provided by Opposer in connection with its marks T-MAXX, MAXX, E-MAXX, and MINI MAXX.

9. If Applicant is permitted to obtain the registration sought, and thereby obtain the *prima facie* exclusive right to use the TOPMAXX RACING mark in commerce for the Applicant's Goods, Opposer believes it will be harmed in that a cloud will be placed on Opposer's title in and to its T-MAXX, MAXX, E-MAXX, and MINI MAXX marks and its right to enjoy the free and exclusive use thereof, and Opposer will be unfairly restricted in its rights to its T-MAXX, MAXX, E-MAXX, and MINI MAXX marks. Additionally, if Applicant is permitted to obtain the registration, Opposer believes it will be harmed by the appearance of and, indeed, actual dilution or diminution of its right to oppose other applications to federally register marks confusingly similar to Opposer's TOPMAXX RACING mark and to seek relief from infringement of its T-MAXX, MAXX, E-MAXX, and MINI MAXX marks. Further, the use of the TOPMAXX RACING mark, unauthorized by Opposer, misappropriates the goodwill of Opposer and unfairly gives the goods of Applicant a ready acceptance in the marketplace that is undeserved.

10. On August 4, 2015, Applicant filed a Response to Office Action (the “Response”) in the Application. The Response proposed amending the listing of goods/services in the Application to Applicant’s Goods.

11. In the Response, Applicant falsely stated: “The applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with the identified goods and/or services.”

12. Use in commerce on or in connection with all of Applicant’s Goods was required by § 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

13. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with construction toys.

14. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with electronic learning toys.

15. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with remote control toy airplanes.

16. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with card games.

17. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with board games.

18. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with chess games.

19. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection with hand-held electronic games adapted for use with television receivers only.

20. As of the filing of the Response, Applicant had not used in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) the TOPMAXX RACING mark on or in connection without outdoor activity game equipment sold as a unit comprising sports balls for playing games.

21. Because there was no bona fide use in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) of the TOPMAXX RACING mark on or in connection with all of Applicant's Goods prior to the filing of the Application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), Applicant is barred from obtaining a registration of the TOPMAXX RACING mark.

22. When filing the Response, Applicant knew there had been no bona fide use in commerce (as defined in § 45 of the Trademark Act, 15 U.S.C. § 1127) of the TOPMAXX RACING mark on or in connection with all of Applicant's Goods.

23. Applicant made the false statement in the Response intending to cause the USPTO to grant a trademark registration for the TOPMAXX RACING mark.

24. Applicant made the false statement in the Response intending to induce the USPTO to grant a trademark registration for the TOPMAXX RACING mark.

25. On or before September 15, 2015, the USPTO approved the Application for publication in the *Official Gazette*. On September 15, 2015, the USPTO issued a Notice of Publication of the TOPMAXX RACING mark. The USPTO relied on Applicant's false statement in approving the Application and in issuing the Notice of Publication. The USPTO would not have approved the Application and issued the Notice of Publication if the USPTO had been aware Applicant had not used the TOPMAXX RACING mark in commerce on or in connection with all of Applicant's Goods.

26. Because Applicant committed fraud during prosecution of the Application, Applicant is barred from obtaining a registration of the TOPMAXX RACING mark.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing first amended grounds for this Opposition is being served on Kidztech Toys Manufacturing Limited by mailing said copy on December 18, 2015, via First Class Mail, postage prepaid to:

P. Jay Hines
Muncy Geissler Olds and Lowe PC
4500 Legato Road Suite 310
Fairfax, VA 22033
United States

//Tammy S. McCarthy//