

ESTTA Tracking number: **ESTTA738264**

Filing date: **04/06/2016**

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	hitbox Entertainment GmbH
Granted to Date of previous extension	04/06/2016
Address	Paulanergasse 13 Vienna, 1040 AUSTRIA

Correspondence information	Raphael A. Gutierrez Foundation Law Group, LLP 11355 W. Olympic Blvd. Suite 106 Los Angeles, CA 90064 UNITED STATES rafa@foundationllp.com
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Applicant Information

Application No	86542777	Publication date	12/08/2015
Opposition Filing Date	04/06/2016	Opposition Period Ends	04/06/2016
Applicant	HITBOX, LLC 2030 Dracena Drive #1 Los Angeles, CA 90027 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 2015/01/12 First Use In Commerce: 2015/01/12 All goods and services in the class are opposed, namely: Business consulting services in the fields of digital marketing and marketing strategy, social media campaigns, media roadmaps and strategies, and audience behavior and trends; Production of advertising materials, namely, creating, designing, producing, and managing commercially produced videos in the nature of advertisements and promotional videos; Business management for others of live video game competitions, trade show events, and product launches</p>
<p>Class 041. First Use: 2015/07/31 First Use In Commerce: 2015/07/31 All goods and services in the class are opposed, namely: Video game production, namely, producing interactive media content in the nature of video games; Video production, namely, creating and producing internet streaming videos and commercially produced videos in the nature of videos produced for hire</p>
<p>Class 042. First Use: 2015/07/31 First Use In Commerce: 2015/07/31 All goods and services in the class are opposed, namely: Computer services, namely, design and development of interactive media content in the nature of computer game software; Designing live events, namely, design of sets and props for production of live video game competitions, trade show events, and product launches</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86802556	Application Date	10/28/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HITBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2014/08/02 First Use In Commerce: 2014/08/02 Business services relating to the provision of sponsorship; Advertisement for others on the Internet</p> <p>Class 038. First use: First Use: 2013/10/01 First Use In Commerce: 2013/10/01 Audiovisual communication services; Data communication by electronic means; Digital communications services; Electroniccommunications services; Interactive broadcasting and communications services</p> <p>Class 041. First use: First Use: 2014/02/08 First Use In Commerce: 2014/02/08 organizing eSports activities and eSports games</p>		

Attachments	86802556#TMSN.png(bytes) 2016.04.06 - 2104.206.401 Notice of Opposition.pdf(108732 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	/Raphael A. Gutierrez/
Name	Raphael A. Gutierrez
Date	04/06/2016

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

<p><i>In re Serial No. 86/542,777 for the mark HITBOX & Design</i></p> <p>hitbox Entertainment GmbH,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>Hitbox, LLC,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. _____</p> <p><u>Notice of Opposition</u></p>
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NOTICE OF OPPOSITION

hitbox Entertainment GmbH (“Opposer”), an Austrian limited liability company having an address of Paulanergasse 13, Vienna, AUSTRIA 1040 brings this Notice of Opposition against Ser. No. 86/542,777 for the mark HITBOX & Design owned by Hitbox, LLC (“Applicant”) having an address of 2030 Dracena Drive #1, Los Angeles, California 90027.

Opposer believes it will be damaged by the registration of application Ser. No. 86/542,777 and hereby opposes the application.

As grounds for the Opposition, Opposer alleges as follows:

1. Applicant is the current listed owner of record of application Ser. No. 86/542,777 (“Applicant’s Application”) for the trademark HITBOX & Design (“Applicant’s Mark”) for use in connection with “Business consulting services in the fields of digital marketing and marketing strategy, social media campaigns, media roadmaps and strategies, and audience behavior and trends; Production of advertising materials, namely, creating, designing, producing, and managing commercially produced videos in the nature of advertisements and promotional videos; Business management for others of live video game competitions, trade show events, and product launches” in

International Class 35; “Video game production, namely, producing interactive media content in the nature of video games; Video production, namely, creating and producing internet streaming videos and commercially produced videos in the nature of videos produced for hire” in International Class 41; and “Computer services, namely, design and development of interactive media content in the nature of computer game software; Designing live events, namely, design of sets and props for production of live video game competitions, trade show events, and product launches” in International Class 42, which was filed on February 23, 2015.

2. Applicant has claimed dates of first use of Applicant’s Mark of January 12, 2015 (Class 35) and July 31, 2015 (Classes 41 and 42).

3. Opposer is the owner of the HITBOX trademark (“Opposer’s Mark”) used in connection with advertising services, communication and broadcasting services, and a number of services related to eSports, including organization and interactive streaming of e-sports games and tournaments.

4. On October 28, 2015, Opposer filed an application for Opposer’s Mark for “Business services relating to the provision of sponsorship; Advertisement for others on the Internet” in International Class 35; “Audiovisual communication services; Data communication by electronic means; Digital communications services; Electronic communications services; Interactive broadcasting and communications services” in International Class 38; and “organizing eSports activities and eSports games” in International Class 41 (“Opposer’s Application”).

5. On November 18, 2015, Opposer sent a cease and desist letter to Opposer’s attorney of record at the USPTO, David D’Zurilla, Esq.

6. On December 8, 2015, the USPTO published Applicant’s Application.

7. On December 29, 2015, Opposer received a letter from Terrance Newby, Esq., directing that all correspondence related to Applicant’s Application be directed to Mr. Newby.

8. On January 6, 2016, Opposer filed an extension of time to oppose Applicant’s Application with Applicant’s consent.

9. On February 18, 2016, the Examining Attorney issued an office action indicating that Opposer's Application may be refused registration because of a likelihood of confusion with Applicant's Application.

FIRST GROUND – PRIORITY AND LIKELIHOOD OF CONFUSION

10. Opposer incorporates the allegations contained in Paragraphs 1-9 herein.

11. Opposer has offered its services in the United States using Opposer's Mark since at least as early as October 2013 (Class 38), February 2014 (Class 41) and August 2014 (Class 35), all of which predate the filing date of Applicant's Application and Applicant's claimed dates of first use.

12. As such, Opposer has priority of use of its HITBOX trademark based upon its use of the mark in the United States before the filing date of Applicant's Application and before Applicant's claimed dates of use.

13. The word portion of Applicant's Mark is identical to Opposer's Mark.

14. The services listed in Applicant's Application are identical to, or closely related to, the services listed in Opposer's Application.

15. Since Applicant's Mark is identical to Opposer's mark, and Applicant's services are the same as, or closely related to, Opposer's services, Opposer believes Applicant's Mark is likely to cause confusion with Opposer's Mark, or cause mistake or deception as to the source, origin, affiliation, connection or association of Applicant's services with Opposer.

16. In light of the foregoing, Opposer believes it will be damaged by the registration of Applicant's Application.

SECOND GROUND – FRAUD ON THE TRADEMARK OFFICE

17. Opposer incorporates the allegations contained in Paragraphs 1-16 herein.

18. When it submitted its application on February 23, 2015, Applicant, through its attorney of record, signed a sworn statement indicating that "[t]he signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive."

19. On information and belief, Opposer alleges that said statement was false because Applicant was aware of Opposer and Opposer's HITBOX trademark, used in connection with the services identified in Opposer's Application.

20. On information and belief, Opposer alleges that Applicant filed Applicant's Application after learning of the unfiled status of Opposer's Mark.

21. On information and belief, Opposer alleges that Applicant made the false statement with the intention of deceiving the USPTO to register Applicant's Application and, relying on the false statement, the USPTO published Applicant's Application on December 8, 2015.

22. In light of the foregoing, Opposer believes it will be damaged by the registration of Applicant's Application.

WHEREFORE, by and through its counsel, Opposer respectfully requests that this Notice of Opposition be sustained and that registration of Applicant's Application be refused.

Date: April 6, 2016

Respectfully submitted,

/Raphael A. Gutierrez/
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon the following parties by First Class Mail on this April 6, 2016.

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